

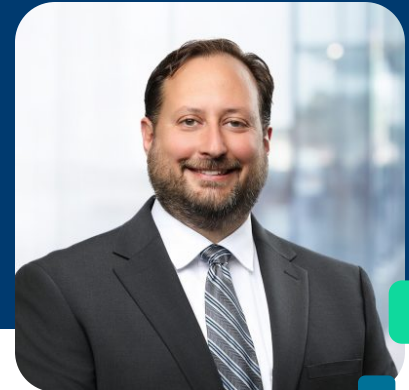
Partner

Mark A. Borsos

✉ mborsos@fitcheven.com

☎ 312.577.7000

📍 Chicago, IL



Profile

“In patent law it is important to be able to focus on the nuances of an issue while still remaining cognizant of the big picture, and to think creatively when analyzing technical subjects.”

Mark Borsos has a particularly broad spectrum of skills to assist clients of various sizes with all facets of intellectual property. His experience includes patent litigation, patent prosecution, freedom-to-operate analysis, post-grant patent proceedings (including reissue, reexamination, and *inter partes* review proceedings), trademark litigation, trademark prosecution, trade secret litigation, copyright litigation, arbitration, and mediation.

Mark’s experience in strategic patent portfolio creation and management complements his comprehensive patent litigation experience in discovery, summary judgment briefing, pretrial preparation, settlement negotiations, and trial work as a member of both large and small litigation teams. Mark is also skilled at employing reissue, reexam, and other post-grant mechanisms to advance licensing and litigation objectives, both offensively and defensively.

Mark’s patent prosecution, litigation, and freedom-to-operate analysis experience extends to a wide array of technical fields, including, among others:

- Medical devices and therapies
- Biotechnology and gene therapy
- Security systems and device encryption
- Construction and building products
- Chemistry and polymer technology
- Food products, processing, and packaging
- Printers and ink cartridges
- Semiconductors and fabrication
- Inventory management systems
- Irradiation chambers
- Lighting technology
- Protective and athletic garments
- Automobile parts and accessories

Mark also has broad experience in trademark and copyright protection and enforcement. Mark has experience both in defending clients accused of infringement and in enforcing clients’ trademark and trade dress rights, and assists clients in trademark prosecution, freedom-to-operate analysis, litigation, and licensing. He counsels trademark clients from a holistic viewpoint in order to help clients to understand not only the extent of their rights, but also the importance of specific trademark assets to their overall branding strategy. Likewise, Mark has helped both copyright holders and accused infringers to understand and protect their rights in a wide variety of circumstances.

In all situations, Mark seeks to help clients develop strong positions with respect to intellectual property while also making sure that the scope and cost of legal representation makes sense in view of the client’s long-term goals.

Education

J.D., University of Michigan Law School, 2002

B.S., Biology, University of Michigan, 1999

Bar Admissions

Illinois

U.S. Patent and Trademark Office

U.S. Court of Appeals, Federal Circuit

U.S. Court of Appeals, Fourth Circuit

U.S. District Court, Northern District of Illinois

U.S. District Court, Western District of Michigan

Recognition

Selected for inclusion in Illinois Super Lawyers – Rising Stars for Intellectual Property Law and Intellectual Property Litigation (2008–17)

Selected as an Emerging Lawyer in Intellectual Property Law, Leading Lawyers Network (2015 and 2016)

Services

Copyrights

International IP Protection

IP Litigation

Appellate Practice

Brand Enforcement

Commercial + Technology Disputes

Copyright Disputes

IP Professional Responsibility + Malpractice

ITC Section 337 Disputes

Northern District of Illinois Local Counsel Services

Patent Litigation

Standard Essential Patents

Trade Secret Litigation

IP Portfolio Management

Mark is a member of Fitch Even's Recruiting and Employment Committee.

Representative Matters

- Represents a mid-sized medical device company in patent prosecution matters, product clearance for new devices, licensing, and miscellaneous intellectual property issues.
- Counsels a large supplier to the construction industry with respect to product clearance issues.
- Counsels a small pharmaceutical manufacturer with respect to patent prosecution and litigation.
- Prosecutes a variety of U.S. patent applications originating outside of the United States.
- Prosecutes reissue applications to broaden the scope of patent protection and make other corrections to patents for various clients.
- Represented a mid-sized medical device company in patent infringement litigation and licensing discussions relating to interspinous implants.
- Represented a small technology company in litigation for trade secret misappropriation and breach of contract.
- Represented a Fortune 500 company in a lawsuit regarding patent infringement and license issues relating to reissue patents for cardiac stimulation devices.
- Represented a mid-sized medical device company in patent infringement litigation relating to orthopedic screws.
- Represented a large food processing company in patent infringement litigation relating to a family of patents for processing and packaging of liquid egg products.

IP Strategy Development

IP Transactions

Patent Preparation + Prosecution

Product Clearance + Legal Opinions

Reissue + Reexamination Proceedings

Trade Secrets

Trademark + Brand Protection

Industries

Biotechnology + Pharmaceuticals

Chemicals + Chemical Engineering

Food + Agricultural Sciences

Material Science

Mechanical Engineering + Manufacturing

Medical Devices + Diagnostics

Presentations + Publications

Presentations

- "Linking an Invention to the Evidence: Strategic Considerations from Prosecution to Litigation," Fitch Even Webinar, with Evan Kline-Wedeem, April 23, 2020.
- "How Late Is Too Late? Setting the Timeline for Patent Protection," Fitch Even Webinar, with Vincent Meyer, August 29, 2019.
- "Widening Your Moat: Using Continuation Applications to Protect Commercially Successful Products," Fitch Even Webinar, with Jonathan H. Urbanek, September 28, 2017.
- "101 Post-*Alice*: How the USPTO and Practitioners Are Reacting," Intellectual Property Law Association of Chicago/U.S. Patent and Trademark Office program at Techweek Chicago, IIT Chicago-Kent College of Law, June 26, 2015.
- "Strategies for the Use of Expert Evidence in Post-Issuance Proceedings," Fitch Even Webinar, May 27, 2015.
- "Understanding the Limits of Your Patent: An Overview of Claim Construction for Prosecution and Litigation," Fitch Even Webinar, June 27, 2013.

Publications

- "Patent Protection Strategy" in *Early Drug Development: Bringing a Preclinical Candidate to the Clinic* (Hoboken, N.J.: Wiley, 2018).

Memberships

- Chicago Bar Association
- Intellectual Property Law Association of Chicago