

## Gerald W. Roberts



**Gerald W. Roberts is the Founder and Managing Member of the firm.** He focuses his practice on intellectual property protection and commercial litigation, including applying for, registering, licensing, and/or litigating patent, copyright, trademark, trade secret, and unfair competition interests, as well as general business disputes, and has represented a wide range of entities (from Fortune 500 companies all the way down to startups) operating in diverse industries and markets in Texas, nationally, and internationally.

Mr. Roberts has more than 17 years of legal experience, including experience preparing and prosecuting patent, copyright, and trademark applications, and including experience litigating intellectual property issues in federal courts, in the International Trade Commission, before the Trademark Trial and Appeal Board, and Before the Board of Patent Appeals and Interferences. He has previously been a partner in a full service law firm based in Dallas, Texas, has previously been the Managing Attorney, Intellectual Property and Commercial Litigation in a boutique law firm based in Dallas, and has previously been a partner in the Dallas-based intellectual property trial group of an Am Law 200 law firm.

Mr. Roberts has worked hard over the course of his legal career to acquire a broad technological background, including patent application preparation/prosecution and/or litigation in a number of electrical and mechanical arts, including digital audio signal processing, digital video signal processing, semiconductor devices, CATV networking and signal processing, smart power metering, electro-mechanical appliance controls, radio frequency identification and tracking, fluid flow and level measurement, internet use, medical devices, and orthopedics. He also has more than 10 years of prior experience as an electrical engineer and engineering manager in an international military and commercial aircraft engine company, including gas turbine engine controls development, FAA certification work, test facilities monitor and control systems automation and design, and electrical circuit design. Immediately upon completion of his undergraduate engineering studies, he passed the Indiana Board of Registration for Professional Engineers and Land Surveyors' examination in fundamental engineering subjects and became officially enrolled with said Board as an Engineer-In-Training. He is also a former holder of a U.S. Department of Defense Secret Security Clearance (honorably deactivated).

### **Selected Legal Experience(s)**

- Patent, trademark, and copyright application preparation and prosecution
- Non-infringement, invalidity, and patentability analyses and opinions
- Trademark clearance opinions and infringement/non-infringement analyses
- Representation of a global foods company in patent litigation

## Gerald W. Roberts (*continued*)

- Representation of an international electronic banking equipment provider in patent litigation
- Representation of an international semiconductor integrated circuits manufacturer in U.S. International Trade Commission patent litigation
- Representation of an international electronic security systems provider in patent litigation
- Representation of a multi-state real estate financing company in software trade secrets and copyright litigation
- Representation of an international wireless telephone equipment manufacturer in patent litigation
- Representation of an R&B musical group in trademark and unfair competition litigation against a world-renowned musical artist, musical group, and major record label
- Representation of a gospel music artist and record label in copyright litigation
- Representation of a medical diagnostics equipment manufacturer in a trademark opposition proceeding
- Participation in the defense of a CATV services provider against claims of excessive late fees
- Participation in the defense of a medical devices company in tortious interference, unfair competition, and breach of contract litigation
- Representation of insurance defense clients in negligence litigation
- Representation of an *in forma pauperis* prison inmate in excessive force litigation
- Representation of a bullied pre-teen in school board disciplinary proceedings
- Appellate representation of an accounting firm in professional malpractice litigation

### Education

- J.D., *cum laude*, Indiana University School of Law at Indianapolis (1996)
- Earned *Corpus Juris Secundum* Award for Excellence in Property
- Earned American Jurisprudence Award for Excellence in Property II
- Achieved Moot Court Order of the Barristers
- B.S.E.E., Rose-Hulman Institute of Technology (1985) (ranked by *U.S. News & World Report* for more than a decade as the number one college or university offering a bachelor's or master's degree as its top degree in engineering)

### Bar/Court Admissions

- United States Patent and Trademark Office
- United States Court of Appeals for the Fifth Circuit
- United States District Courts for the Eastern District of Texas, Northern District of Texas, Northern District of Indiana, and Southern District of Indiana
- State Courts of Texas
- State Courts of Indiana

### Selected Professional Activities/Memberships

- American Intellectual Property Law Association
- Texas State Bar Association
- Dallas Bar Association
- J.L. Turner Legal Association (2013 Board Member and Treasurer, 2012 Board Member and Treasurer)
- Patrick E. Higginbotham American Inn of Court (2012-2013, 2011-2012, 2010-2011)
- Dallas Diversity Task Force (2012 member, 2011 Chairperson, 2010 member)
- Rose-Hulman Humanities and Social Sciences External Advisory Board
- Rose-Hulman National Board of Advisors (1998-2000)

**Selected Presentations/Publications/Press**

- “Voir Dire,” mock trial demonstration/CLE, J.L. Turner Legal Association Trial Advocacy Seminar Series, Dallas, TX, March 11, 2014
- “Affirmative Action Ruling Near, Blacks’ Progress Remains Slow,” interviewed/quoted in print article by Nelson D. Schwartz and Michael Cooper, *The New York Times*, May 28, 2013 (also published on-line as “Racial Diversity Efforts Ebb for Elite Careers, Analysis Finds” on May 27, 2013)
- “Opening Statements,” mock trial demonstration/CLE, J.L. Turner Legal Association Trial Advocacy Seminar Series, Dallas, TX, April 9, 2013
- “Closing Arguments,” mock trial demonstration/CLE, J.L. Turner Legal Association Trial Advocacy Seminar Series, Dallas, TX, September 11, 2012
- “The Measure of a Plan -- Data Shows Lack of Progress on Hiring and Retention of Minority Attorneys in Dallas,” pictured/quoted in print and on-line article (while chairing the Dallas Diversity Task Force) by Miriam Rozen, *Texas Lawyer*, December 12, 2011
- “Expert Testimony,” mock trial demonstration/CLE, J.L. Turner Legal Association Trial Advocacy Seminar Series, Dallas, TX, August 16, 2011
- “Intellectual Property Overview for Small Business Lawyers,” presentation, J.L. Turner Legal Association Annual Meeting of Members and Board of Directors, Dallas, TX, September 9, 2010
- “Bullied Pre-Teen Says Punishment Unfair,” interviewed/quoted in television and on-line news coverage (while representing a bullying victim in school board proceedings), by FOX 4 Television/News (Dallas, TX), May 20 and 21, 2009
- “Written Discovery: ‘The Sport of Kings!’ [?],” presentation, American Intellectual Property Law Association Spring Meeting, Houston, TX, May 14, 2008
- “Greater Discretion to Deny Permanent Injunctions in Patent Cases,” internet article/posting, May 24, 2006
- “Intellectual Property Law for Engineering Managers,” adjunct lecture, Rose-Hulman Institute of Technology Masters in Engineering Management Program, Indianapolis, IN, 2002