

## Austen Zuege

### Patent & Trademark Attorney, Officer

#### Overview

Austen Zuege practices intellectual property (IP) law in prosecution, transactional, and litigation settings, including patent, trademark, copyright, trade secret, and domain name matters. This includes international IP filings and prosecution such as Paris Convention patent applications, PCT applications and related national stage patent applications, Madrid protocol extensions, as well as the coordination and supervision of global IP portfolios. He is a registered U.S. patent attorney and has familiarity with a variety of technical areas.

Austen has extensive experience organizing and conducting complex freedom-to-operate studies, advising on IP strategies, preparing invalidity/non-infringement opinions of counsel, negotiating agreements, enforcing rights and defending clients in contentious IP disputes, and creating strategic plans. He embraces processes and systems from an engineering and process improvement standpoint. He also regularly writes and speaks about IP issues, and can translate complex legal issues into actionable tips and strategies for clients and their inside counsel.

In his spare time, Austen is an avid cyclist. He commutes to work by bike year-round, including in snowy Minnesota winters.

#### Areas of Practice

- Patents
- Trademarks
- Copyrights
- Trade Secrets
- Domain Name Disputes
- Freedom-to-Operate Studies
- Validity/Non-infringement Opinions
- IP Litigation
- PCT National Phase Filings and Paris Convention Filings in the USA
- Global Patent & Trademark Portfolio Management and Strategy
- USPTO Trial Proceedings (TTAB/PTAB)
- Local Counsel for IP Disputes in the District of Minnesota
- IP Licensing, Transfers & Agreements

#### Selected Areas of Technical Expertise

- Mechanical Devices
- Electrical Systems, Electronics, and Electromechanical Devices
- Software
- Aerospace Technologies
- Airfoils and Fans
- Medical Devices
- Automotive Technologies
- 3-D Printing & Additive Manufacturing
- Communications and Networking
- Data Storage (e.g., Hard Drives)
- Sensors, Transducers, & Control Systems
- Agricultural Equipment
- Building Systems Including Elevators and Moving Walkways/Escalators
- Office Products
- Recreational Equipment
- Environmental Systems (e.g., HVAC)



#### Contact Information

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Legal blog: [blueovergray.com](http://blueovergray.com)

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#### Bar Admissions

United States Patent and  
Trademark Office

Minnesota State Bar

Federal Courts for the District of  
Minnesota and E.D. of Wis.

Court of Appeals for the Federal  
Circuit

#### Education

University of Illinois College of Law,  
Juris Doctor, *cum laude*

University of Wisconsin-Madison,  
B.S. Industrial Engineering

## Honors & Recognitions

Recognized in *The Best Lawyers in America*® (2018-23) in the field of patent law  
Minnesota Super Lawyers®, Rising Star (2013-2018)  
Top Patent Prosecutor, Patent Buddy® (2011)

## Professional Affiliations

American Intellectual Property Law Association (AIPLA)  
Minnesota Intellectual Property Law Association (MIPLA) – Board Member (2021-present)  
Minnesota State Bar Association (MSBA)  
Hennepin County Bar Association (HCBA)  
International Trademark Association (INTA)

## Community Service

Board Member, Minneapolis Civilian Police Review Authority, 2008-2012

## Personal Interests

Bicycling  
Music

## Representative Matters

- *Patent Prosecution* - Prepared, prosecuted and supervised hundreds of patent applications, including PCT and foreign counterparts, on a variety of technologies on behalf of multi-national corporations, medium-sized businesses, small businesses, and individual inventors
- *Patent Prosecution* - Filed and prosecuted utility and design applications in the United States based on foreign priority filings, including PCT national phase entries and Paris Convention filings
- *Patent Risk Management* - Coordinated patent clearance/freedom-to-operate studies for billion-dollar product lines; advised client regarding risk management and patent avoidance strategies, and prepared associated opinions of counsel
- *Patent Litigation* - Worked on litigation team for a leading automotive component business asserting multiple patents against competitor; negotiated settlement of all claims; also successfully defended the patents-in-suit in five concurrent *ex parte* and *inter partes* reexaminations
- *Patent Litigation* - Defended international maker of optical identification systems against non-practicing entity in the Eastern District of Texas, in a case involving most competitors in the industry; negotiated settlement resolving all claims
- *TM Prosecution* - Prosecuted trademark registrations in the U.S. and managed global trademark portfolios; represented foreign applicants in U.S. Madrid protocol extensions
- *TM Prosecution* – Conducted searches and analyses of numerous proposed marks to assess registrability and potential infringement risks
- *TM Litigation* - Implemented trademark policing and enforcement program for photo booth service company; successfully pursued infringement action with a default judgment obtained over Defendant’s active opposition
- *TM Litigation* - Successfully defended registration and application of software startup in consolidated Trademark Trial & Appeal Board (TTAB) cancellation and opposition proceeding through Accelerated Case Resolution (ACR)
- *Domain Disputes* - Obtained cancellation of domain name registration by client’s competitor in UDRP arbitration
- *Copyright Registration* - Filed and obtained copyright registrations for a variety of types of works, including successful requests for reconsideration of refusals
- *Copyright Litigation* - Defended nonprofit in copyright infringement dispute
- *IP Agreements* - Prepared assignments, licenses, and service agreement terms covering various types of IP; reviewed IP provisions of contracts
- *Due Diligence* - Performed IP due diligence for seller in 9-figure acquisition; performed patent due diligence for potential buyer in medical device industry

## Exemplary Patents

- U.S. Pat. No. 7,214,192 “Vascular Testing System”
- U.S. Pat. No. 7,648,279 “Journal Air Bearing”
- U.S. Pat. No. 7,821,437 “Line Noise Analysis and Detection and Measurement Error Reduction”
- U.S. Pat. No. 7,929,248 “Top Bond Pad for Transducing Head Interconnect”
- U.S. Pat. No. 7,966,807 “Vapor Cooled Static Turbine Hardware”
- U.S. Pat. No. 7,984,656 “NSMS Flight Laser Detector System”
- U.S. Pat. No. 8,030,807 “Electromechanical Energy Harvesting System”
- U.S. Pat. No. 8,246,302 “Teeter-Restraint Device for Wind Turbines”
- U.S. Pat. No. 8,315,058 “Capacitive Touch Interface Assembly”
- U.S. Pat. No. 8,337,989 “Layered Thermal Barrier Coating With Blended Transition”
- U.S. Pat. No. 8,430,154 “Nano-Particle Wave Heat Pipe”
- U.S. Pat. No. 8,578,362 “Method For Downloading Software To An Electronics Product”
- U.S. Pat. No. 8,855,952 “Ram Air Turbine With Flux Regulated Permanent Magnet Generator and Testing Method”
- U.S. Pat. No. 9,154,228 “Method and Apparatus for Signal Reception with Ambient Light Compensation”
- U.S. Pat. No. 9,415,880 “Actuator for RAT Deployment”
- U.S. Design Pat. No. D830,719 “Plant Stand”
- U.S. Pat. No. 10,415,587 “Composite Fan and Method of Manufacture”
- U.S. Pat. No. 10,839,999 “Electromagnetic Coil Connection Assembly”
- U.S. Pat. No. RE48,623 “Viscous Clutch with Return Bore Through Rotor”
- U.S. Pat. No. 11,129,533 “Secure Communications and Records Handling System and Associated Method”

## Publications

- [Willful Patent Infringement: Lingering Questions](#), *Landslide*, Vol. 14, Issue 4 (ABA, June/July 2022)
- [The Delicious Ironies of Food Product Configuration Protection](#), *Bench & Bar of Minnesota Digital Edition, Volume LXXVIII Number XI* (Dec. 2021)
- **Intellectual Property Issues for Businesses**, *The Complete Business Lawyer’s Quick Answer Book* (Minnesota CLE 2021)
- [Copyright Pitfalls](#), *Innovate Magazine*, Vol. 11 (AIPLA, Oct. 2021)
- [Considerations for Patent Assignments After Minerva Ruling](#), *Law360*<sup>®</sup> (Aug. 4, 2021), with Benjamin Edlavitch
- [Understanding Patent and Commercial Warranty Liability Stemming from Pending Patent Applications](#), *18 Wake Forest Journal of Business and Intellectual Property Law* 444 (Spring 2018)
- [Patent Freedom to Operate Searches, Opinions, Techniques, and Studies](#) (ABA 2017), editor and lead co-author
- **Beyond the Looking Glass: Patent-Eligible Subject Matter After *Alice* and *Mayo***, *Intellectual Property Today, Vol. 21, No. 11* (November 2014), with Erik Wright
- [A New Theory for Patent Subject Matter Eligibility: A Veblenian Perspective](#), *5 Cybaris* 211 (2014)
- [Strategic Third-Party Submissions Against Patent Applications](#), *Intellectual Property Today*, Vol. 19, No. 12 (December 2012)
- **A New Era for Patent-Eligible Subject Matter**, *Intellectual Property Today*, Vol. 19, No. 5 (May 2012)
- **No Short-Cuts: Weighing the Facts Under §103**, *Journal of the Patent and Trademark Office Society*, Vol. 91, No. 6 (June 2009), with Carolyn Beck
- **Untying Patents from the Sherman Act: *Illinois Tool Works, Inc. v. Independent Ink, Inc.***, *The IP Book, 4th Edition* (2006), with Thomas Stueber and Jessica Kwak
- **Implications of *SmithKline Beecham v. Apotex Corp.* on the Experimental Use and Inherent Anticipation Doctrines**, *The IP Book, 3rd Edition* (2005), with Michael Pape and Jessica Kwak
- **The “Written Description” Requirement: Recent Cases and Their Practice Implications**, *The IP Book, 2nd Edition* (2004), with D. Fairbairn and A. DeMaster
- [Intellectual Property Law for Business Lawyers](#), Thomson Reuters<sup>®</sup>, annual (former contributing author and chief editor, 2002-2016)
- [Federal Intellectual Property Laws and Regulations](#), Thomson Reuters<sup>®</sup>, annual (former chief editor, 2009-2016)

## Presentations

- [Where Are We Now? Understanding \*Minerva\* and Assignor Estoppel for Patent Assignments](#), with Jeanette Roorda, 2022
- [Structuring Freedom to Operate Opinions: Reducing Risk of Patent Infringement](#), with Stuart A. Nelson, 2022
- **Intellectual Property Issues for Businesses** - [The Complete Business Lawyer](#), Minnesota CLE, 2021
- [Patent Searching: \(Almost\) Everything You Need to Know](#), AIPLA, 2021
- **7 Things In-House Counsel Must Know About Patents** - [IP for In-House Counsel](#), Minnesota CLE, 2021
- [Advanced Patent Searching: \(Almost\) Everything You Need to Know](#), MIPLA Patent Prosecution Section, 2021
- [Structuring Freedom to Operate Opinions: Reducing Risk of Patent Infringement](#), with John M. Fleming, 2020
- [Structuring Freedom to Operate Opinions: Reducing Risk of Patent Infringement](#), with Michael S. Cuvillo & John M. Fleming, 2019
- [The “Patent Troll” Debate](#) - Intellectual Property: Advanced Topics for Businesses in a Changing Legal Landscape, 2014
- [Oracle v. Google and Its Impact on Software Development and Protection](#) - Intellectual Property: Key Topics for In-House Counsel and Business Lawyers Today, 2013
- [Design Patents: Review & Developments](#) - Intellectual Property: Key Topics for In-House Counsel and Business Lawyers Today, 2013
- **And Now from the Peanut Gallery: Understanding New Avenues for Third-Party Attacks on Pending Patent Applications** - Hennepin County Bar Association Corporate Counsel Section, 2013
- [The New Paradigm for Patentable Subject Matter](#) - Intellectual Property Strategies: Seizing Opportunities and Managing Risks, 2012
- **Practical Copyrights for Small Businesses** and **Copyright and Street Art** - Intellectual Property Law: Beyond the Basics, 2011
- **Patent Reexamination: A View from the Trenches** - Intellectual Property Law: Beyond the Basics, 2010
- **State of the USPTO** - Intellectual Property Law: Beyond the Basics, 2009
- **Myths of Copyright Law** and **Pushing the Bounds of Copyright** - Intellectual Property Law for Business Lawyers, 2008
- **Pushing the Boundaries of Copyright Law** - Midwest Intellectual Property Institute, with Thomas Stueber, 2007
- ***eBay v. MercExchange*: Injunctive Relief** - Intellectual Property Law for Business Lawyers, 2007
- **Copyright Basics** and **Top Patent Cases** - Intellectual Property Law for Business Lawyers, 2006

