

**PARTNER**

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EDUCATION

J.D., *cum laude*
Georgetown University, 2002

B.S., Mechanical Engineering
The George Washington
University, 2004

ADMISSIONS

Oregon, 2008

Minnesota, 2002 (inactive)

U.S.P.T.O. (Reg. No. 47,735), 2001

U.S. District Court for the District
of Oregon

U.S. District Court for the Eastern
District of Texas

PRACTICE AREAS

Patents

Litigation

Post-Grant USPTO Proceedings

Intellectual Property Counseling

Trademarks

Copyrights

TECHNOLOGY AREAS

Mechanical Engineering

Medical Devices & Diagnostics

Mobile Devices & Applications

Consumer Products

Nanotechnology

Agriculture & Food Science

Green Tech & Renewable Energy

Deakin T. Lauer

Deakin practices in all aspects of intellectual property law, with an emphasis on patent prosecution and patent litigation. Deakin is also an active member of the Post-Grant Practice Group at Klarquist, which represents both patent owners and patent challengers in *inter partes* reviews (IPR), covered business method (CBM) reviews, and reexamination proceedings.

Deakin represents a broad range of clients and industries, including mechanical and electromechanical devices, medical devices and related delivery systems, laboratory and diagnostic equipment, processes and manufacturing equipment, and consumer products. Before law school, he worked in Washington, D.C. as an engineer at a firm that provided engineering services involving the design of telecommunications networks and related FCC compliance requirements.

With more than 15 years of experience in intellectual property law and a deep understanding of a wide range of science and technology areas, Deakin delivers efficient and effective counseling on the issues that matter to his clients. Recognizing that not all clients are the same, his goal isn't just to find solutions but to find the solution that best serves each client's specific business needs.

Deakin joined Klarquist in 2008 as a lateral associate and became partner in 2011.

ARTICLES AUTHORED

- "Licensing of exclusive rights can eliminate standing to sue for copyright infringement," Klarquist's Oregon IP Blog (February 21, 2018)
- "PTAB's alternative claim construction saves the day," Klarquist's PTAB Blog (February 21, 2018)
- "Federal Circuit affirms Board's grant of adverse judgment based on pre-institution disclaimer," Klarquist's PTAB Blog (January 24, 2018)
- "Patent Owners Now Can Appeal Time-Bar Decisions (No Shenanigans Required)," Klarquist's PTAB Blog (January 9, 2018)
- "Patent Owner sinks infringement theory with statements made in IPR," Klarquist's PTAB Blog (September 14, 2017)

- "Inventor of self-cleaning home, and former Klarquist client, passes away at 101," Klarquist's Oregon IP Blog (July 20, 2017)
- "Sovereign immunity requires dismissal of University of Minnesota, but IPR proceeding will continue as to co-owner Toyota," Klarquist's PTAB Blog (July 17, 2017)
- "Failure to challenge 'new' arguments during an IPR proceeding may waive APA procedural objections on appeal," Klarquist's PTAB Blog (May 9, 2017)
- "Uncertainty is the only certainty when it comes to IPR estoppel," Klarquist's PTAB Blog (March 9, 2017)
- "Mild discouragement of combination, without evidence of inoperability, does not amount to a 'teaching away,'" Klarquist's PTAB Blog (March 7, 2017)
- "Is IPR estoppel losing even more teeth? District Court finds it applies only to instituted grounds," Klarquist's PTAB Blog (December 26, 2016)
- "The Supreme Court hears arguments on constitutionality of denying registrations for 'disparaging' trademarks," Klarquist's Oregon IP Blog (January 20, 2017)
- "To avoid running afoul of the APA, patent owners must be permitted to respond to 'new' grounds of unpatentability," Klarquist's PTAB Blog (November 18, 2016)
- "Portland-based Tranxition's 'PC migration' patents found invalid for claiming an abstract idea," Klarquist's Oregon IP Blog (November 17, 2016)
- "Supreme Court to consider Oregon band's right to register 'disparaging' name," Klarquist's Oregon IP Blog (October 1, 2016)
- "Coppola objects to Copa Di Vino's use of black wine labels with gold elements," Klarquist's Oregon IP Blog (September 9, 2016)
- "PTAB's denial of motion to amend was arbitrary and capricious," Klarquist's PTAB Blog (September 8, 2016)
- "On remand, PTAB says it did consider an exhibit submitted to show the 'state of the art,'" Klarquist's PTAB Blog (September 2, 2016)
- "Attorney fees denied: \$1,000 for one download of The Cobbler is enough," Klarquist's Oregon IP Blog (August 24, 2016)
- "En banc Federal Circuit to review standards for amending claims in PTAB proceedings," Co-author, Klarquist's PTAB Blog (August 17, 2016)
- "Burn the bus if you must, but you may want to keep the mural," Klarquist's Oregon IP Blog (August 1, 2016)
- "Obviousness prior art: From many comes one?" Klarquist's PTAB Blog (July 29, 2016)
- "Put it all in the Petition, and with particularity. PTAB authority is limited to unpatentability theories spelled out with specificity in the petition," Klarquist's PTAB Blog (July 27, 2016)
- "Post Grant Review on the rise?" Klarquist's PTAB Blog (July 26, 2016)
- "In a sea of orange, Oregon State University finds blue," Klarquist's Oregon IP Blog (July 15, 2016)
- "Debut of new PTAB filing and case management system - PTAB E2E," Klarquist's PTAB Blog (July 12, 2016)
- "Combining the names of your children to create new marks can avoid confusion in the wine industry," Klarquist's Oregon IP Blog (June 26, 2016)
- "Supreme Court issues Cuozzo decision: BRI stands; institution decisions not reviewable," Klarquist's PTAB Blog (June 20, 2016)
- "Vermont and Oregon craft beer dispute - The Shed v. Brew Shed," Klarquist's Oregon IP Blog (May 18, 2016)
- "Oral Arguments heard by Supreme Court in Cuozzo Speed," Klarquist's PTAB Blog (April 26, 2016)

- "Adidas files three IPR petitions challenging Nike patents," Klarquist's Oregon IP Blog (April 19, 2016)
- "Patent Grants To Oregon Inventors On The Rise," Klarquist's Oregon IP Blog (March 1, 2016)
- "Motions to Amend - The Federal Circuit discusses the Who (has the Burden), What (Prior Art needs to be distinguished), and How (does the PTAB need to address secondary considerations)," Klarquist's PTAB Blog (February 20, 2016)
- "Nike sues Skechers for design patent infringement," Klarquist's Oregon IP Blog (February 1, 2016)
- "The reason a claim is obvious isn't always obvious-Federal Circuit requires PTAB (and, in turn, petitioner) to spell it out," Klarquist's PTAB Blog (January 25, 2016)
- "Supreme Court accepts first IPR review-will the BRI standard survive?"Klarquist's PTAB Blog (January 19, 2016)
- "What does 'is' mean? Federal Circuit disagrees with Board construction and reverses IPR decision cancelling claims." Klarquist's PTAB Blog (November 25, 2015)
- "315(b) applies when a complaint has been served more than one-year earlier-even if some claims were dismissed without prejudice," Klarquist's PTAB Blog (September 17, 2015)