



Shane Delsman

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Practice Areas

Copyrights, Publishing and Entertainment

E-Commerce and Information Technology

Emerging Companies

Intellectual Property

Intellectual Property Litigation

Patents

Trademarks and Advertising

Technology & Digital Business

Admissions

Illinois

Wisconsin

United States Patent and Trademark Office

Education

Juris Doctor, University of Wisconsin Law School, 2007

Bachelor of Science, University of Wisconsin-Madison, 2003



Shane Delsman is a nationally recognized leader in intellectual property law and the Practice Group Leader of the firm's Intellectual Property Practice Group. Shane's unique career path has allowed him to gain significant experience and expertise across the vast intellectual property law spectrum. His expansive experience and expertise provides a unique perspective which enables him to deliver greater value to his clients. Some examples of the types of matters Shane regularly leads include:

- Prosecution of patent, trademark and copyright applications
- Federal intellectual property litigation
- Cancellation and opposition proceedings before the Trademark Trial and Appeal Board
- Inter partes review proceedings before the Patent Trial and Appeal Board
- Freedom to operate, validity, patentability and registrability opinions
- Development and licensing agreements
- Take down enforcement through Amazon, eBay and other e-commerce websites
- Domain name disputes before the Uniform Domain Name Dispute Resolution Policy
- Legislative and regulatory policy review

Currently, Shane is the Chair of the American Bar Association Trademark Division, a member of the Richard Linn American Inn of Courts in Chicago and serves on the executive board of the Eastern District of Wisconsin Bar Association. Shane previously served as president of the Wisconsin Intellectual Property Law Association. He has been named a Best Lawyer and Rising Star and has the highest peer review rating from Martindale-Hubbell. Shane has also twice been recognized by the American Bar Association's Section of Intellectual Property Law with the Outstanding Leadership Contribution Award.

Through leadership positions in numerous organizations, Shane has also worked directly with Congress on intellectual property-related legislation that has been signed into law, as well as pending legislation and proposed rule changes for the U.S. Patent and Trademark Office.

Shane is also a published author including the Mechanical Patents chapter of the book, *Drafting Patents for Litigation and Licensing*, the *Copyright Chapter* of the book, *Intellectual Property in Wisconsin* and the *Internet Law* chapter of the book, *Commercial and Consumer Transactions in Wisconsin*. Shane is also an editor for *Landslide*, the intellectual property magazine published by the American Bar Association.

Prior to joining Godfrey & Kahn, Shane practiced law in Chicago at a large intellectual property law firm.

Patent, trademark, copyright, trade secret and unfair competition litigation

Shane's experience in the patent, trademark, copyright, trade secret and unfair competition arena runs deep. From cases relating to agricultural equipment, software and color trademarks to radio frequency electronics, encryption and military vehicles, Shane has served as counsel on numerous lawsuits protecting clients' intellectual property throughout the U.S. He has also successfully represented clients in contested matters before the U.S. Trademark Trial and Appeal Board as well as the Patent Trial and Appeal Board. His experience in this area enables him to regularly author freedom to operate, validity, patentability and registrability opinions, and he is a preferred legal counsel for an intellectual property insurance company.

Managing intellectual property portfolios

Managing and developing large intellectual property portfolios is also a key focus of Shane's law practice. He regularly assists clients in prosecuting and obtaining both domestic and international patents, trademarks and copyrights. Shane also has experience preparing development and licensing agreements with large technology companies and sports organizations.

Mergers and acquisitions

Shane personally supports the intellectual property-related matters for billions of dollars of mergers, acquisitions and divestitures each year. His work includes performing due diligence and negotiating purchase agreements.

Internet and e-commerce

Shane also helps clients protect their intellectual property online. Such work includes representing clients in Uniform Domain Name Dispute Resolution Policy (UDRP) proceedings and take down enforcement through Amazon, eBay and other e-commerce websites.

Representative Experience

Representative Contested Proceedings Experience

Gentex Corp v. Traffic and Parking Control Co., Inc. (E.D.WIS.2019). Represented defendant in a patent infringement action involving traffic signs. Settlement was reached.

Beachfunds Patents LLC and Lasermarx, Inc. v. H. H. & A. Sports, Inc. (W.D. Wis. 2018). Represented defendant in a patent infringement action involving archery arrow rests. Settlement was reached.

American Orthodontics Corp. v. Dentsply Int'l Inc. (PTAB 2018). Represented petitioner to invalidate all claims of an asserted patent related to orthodontic appliances. All claims held unpatentable. IPR2016-01652.

Life Techs. Corp v. Promega Corp. (2017). Filed an Amicus Brief on behalf of the Wisconsin Alumni Research Foundation with the United States Supreme Court.

R.D. Jones, Stop Experts, Inc. et al. v. Traffic & Parking Control Co. Inc. (M.D. Fla. 2016). Represented defendant in a patent infringement action involving lighted roadway signs. Settlement was reached.

Ruehl et al. v. AM General LLC (N.D. Ind. 2014)(Fed. Cl. 2015). Representing the plaintiffs in a patent infringement action involving military vehicles. Case is currently pending.

Delta Education, LLC v. Geneva Area Recreational, Educational and Athletic Trust (T.T.A.B. 2012-2014). Represented the petitioner in an opposition proceeding. Settlement was reached resulting in a narrowing amendment to the identification of services.

Representative Contested Proceedings Experience

ARI Network Services, Inc. v. Nichols et al. (E.D. Wis. 2013). Represented the plaintiff in a copyright infringement action involving various powersport equipment taxonomies. Settlement was reached.

Transcenic, Inc. v. Google, Inc., Microsoft Corp., AOL Inc. & Mapquest, Inc. (D. Del. 2011). Represented the plaintiff in a patent infringement action involving spatially referenced street-level imagery for web mapping applications. Settlement was reached.

Chamberlain Group, Inc. v. GMI Holdings, Inc. and Overhead Door Corp. (N.D. Ill. 2011). Represented the plaintiff in a patent infringement action involving obstruction-sensing systems for garage doors. Settlement was reached.

Chamberlain Group, Inc. v. Decko Products, a division of Michel Sales Company and Guardian Access Corporation (N.D. Ill. 2010). Represented the plaintiff in a patent infringement action involving garage door positioning systems. Settlement was reached.

Deere & Company v. Great Plains Manufacturing, Inc. (S.D. Iowa 2010). Represented the plaintiff in a patent infringement action involving the design of agricultural seed tubes. Settlement was reached.

Deere & Company v. Bush Hog, LLC and Great Plains Manufacturing, Inc. (S.D. Iowa 2009). Representing the plaintiff in a patent infringement action involving the design of pull-behind rotary cutters. Case is pending.

McDavid Knee Guard, Inc. et al. v. Nike USA, Inc. (N.D. Ill. 2008). Represented the plaintiff in a patent infringement action related to protective athletic apparel.

WMH Tool Group, Inc. v. Woodstock International, Inc. and Grizzly Industrial, Inc. (N.D. Ill. 2007). Represented the plaintiff in a trade dress infringement action related to color in woodworking and metalworking tools. Settlement was reached.

Representative M&A Experience

Represented ARI Network Services, Inc. (NASDAQ: ARIS) (Milwaukee, Wisconsin) in its purchase of the assets of Auction 123 Inc. (Weston, Florida).

Represented Landec Corporation in its acquisition of O Olive Oil.

Represented Hufcor, Inc. (Janesville, Wisconsin) in the sale of the company to OpenGate Capital (Los Angeles, California).

Represented ARI Network Services, Inc. (NASDAQ: ARIS) (Milwaukee, Wisconsin) in its purchase of the assets of Direct Communications, Incorporated (Des Moines, Iowa).

Represented Brass Ring Capital (Milwaukee, Wisconsin) in its acquisition of Creative Learning Systems (Longmont, Colorado).

Represented Prairie Capital Fund VI (Chicago, Illinois) in its investment in BOTE, LLC (Destin, Florida).

Represented Mason Wells Buyout Fund IV (Milwaukee, Wisconsin) in its investment in L.B. White (Onalaska, Wisconsin).

Represented ARI Network Services (NASDAQ: ARIS) (Wisconsin) in sale of shares of common stock and warrants to institutional and accredited investors in a private placement.

Representative M&A Experience

Represented privately-held manufacturer of sporting goods and accessories in its acquisition of a privately-held company.

Represented Mason Wells Buyout Fund IV (Milwaukee, Wisconsin) in its investment in EastPoint Sports Ltd.

Represented privately-held software company in its sale to a private equity firm.

Represented a Fortune 200 automotive supplier in its acquisition of a global automotive seating business.

Represented Classic Brands, LLC (Denver, Colorado) in the acquisition of Droll Yankees, Inc. (Plainfield, Connecticut).

Represented Digital Measures, LLC (Milwaukee, Wisconsin) in its sale to a private equity firm (transaction not public).

Represented a Wisconsin-based software company in its sale to a private equity firm (transaction not public).

Represented Hufcor, Inc. (Janesville, Wisconsin) in the sale of the company to OpenGate Capital (Los Angeles, California).

Represented private equity owned technology company in its acquisition of a website solutions business in a corporate divestiture (transaction not public).

Represented Jason Industries, Inc. (NASDAQ: JCI) (Milwaukee, Wisconsin) in its acquisition of Schaffner Manufacturing Company, Inc. (Pittsburgh, Pennsylvania)

Represented global (\$500M+ revenue) privately-held manufacturer based in Wisconsin in a joint venture for the development of a new product line (transaction not public).

Represented Northern Star Industries, Inc. in sale of BOSS Snowplows Division to the Toro Company

Represented Landec Corporation in its acquisition of Yucatan Foods, L.P. and Camden Fruit

Representative Procurement Experience

Manages a number of international portfolios of patents, trademarks and applications including for clients in the fishing, powersport and marine industries.

Significant experience with expedited patent application processes before the United States Patent and Trademark Office.

Successfully appealed final rejections of claims before the United States Patent and Trademark Office.

Experience with diverse technologies including computer, electrical, electro-mechanical, software, wireless signals, hand and power tools, marine, firearms and archery, exercise and bicycling, and automotive and motorcycle sectors.

Court Admissions

United States Court of Appeals, Federal Circuit

United States Court of Federal Claims

United States District Court, Northern District of Illinois

United States District Court, Eastern District of Wisconsin

United States District Court, Western District of Wisconsin

United States Supreme Court

Professional Association Memberships

Eastern District of Wisconsin Bar Association
Richard Linn America Inn of Court
Wisconsin Intellectual Property Law Association

Activities

Wisconsin Intellectual Property Law Association – Past President and Secretary/Treasurer

Eastern District of Wisconsin Bar Association – Executive Board Member and Programming Committee Chair (formerly Membership Committee Chair)

American Bar Association

House of Delegates - Wisconsin State Bar Delegate
Trademark Division Chair (formerly Vice-Chair)
Patent Litigation Committee – Vice Chair (formerly Claim Construction Co-Chair)
Editorial Board (Issue Editor for Landslide Magazine)
2020 Nominating Committee
Trademark Transactions – Past Chair
Trademark Litigation Committee – Past Co-Vice Chair
Intellectual Property Law Section – Past CLE Board Member
Young Lawyer Action Group – Past Vice Chair
Intellectual Property and Internet Law Committee of the Young Lawyer Division – Past Chair

Shane has introduced numerous intellectual property law policies that have been adopted at the Intellectual Property Law Section level and even the American Bar Association as a whole. Shane regularly writes letters to and meets with the US Patent and Trademark Office (USPTO) and congress on behalf of the ABA regarding intellectual property law matters.

Schlitz Audubon Nature Center – Board Member (2014 - present)

Manitowoc County Bar Association – Intellectual Property Primer

Chicago Bar Association – Intellectual Property Law Committee – Past Chair

Honors

Awarded the ABA IPL Recognition of Outstanding Leadership Contribution (2015, 2017)
Recognized by *Super Lawyers* as a *Wisconsin Rising Star* (2015 - present)
Recognized as an *Illinois Rising Star* (2013)
University of Wisconsin's Iron Cross Award Recipient (2003)
AV Preeminent® Peer Review Rated by Martindale-Hubbell®
Listed in *Best Lawyers* (Litigation, Intellectual Property, 2021)