

John T. Pienkos

Milwaukee, WI

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PARTNER

Overview

For more than 25 years, John has counseled clients on patent law and corporate transactions relating to intellectual property law. As a member of the firm's Intellectual Property Service Group, John provides extensive client counseling in relation to the pursuit and utilization of intellectual property rights, and advises clients on corporate transactions involving the purchase or sale of intellectual property assets.

John prepares and prosecutes numerous domestic and foreign patent applications in complicated technologies, resulting in hundreds of issued patents, in mechanical, electrical and software-related technologies on behalf of companies of all sizes, from Fortune 500 to small entrepreneurs. John manages patent portfolios for a variety of companies and provides strategic counsel in regard to the filing, procurement, and maintenance of patent rights, both domestically and abroad.

John also prepares patent opinions and provides guidance regarding the scope of intellectual property rights, and counsels clients in the area of post-grant proceedings such as *inter partes* review proceedings. In his career he has rendered numerous patent-related opinions, including patentability, non-infringement, and invalidity opinions, including opinions in anticipation of, or in the context of patent litigation.

In addition, John prepares and negotiates agreements relating to intellectual property, including license agreements, assignment agreements, purchase agreements, joint development and collaboration agreements, and confidentiality agreements. Further, John counsels clients regarding trademark rights, prepares trademark applications, and conducts related review of issues pertaining to securing trademark rights.

John has technical knowledge in the areas of electrical and mechanical engineering, including computer hardware, software and the Internet. His experience includes work in the areas of mobile devices, wireless

SERVICES

Cryptocurrency, Blockchain & FinTech

Intellectual Property

Manufacturing & Food Processing

EDUCATION

Harvard Law School, J.D., 1997

University of Wisconsin-Madison, M.S. Electrical Engineering, 1994

Marquette University, B.S. Electrical Engineering, 1992

ADMISSIONS

Illinois

Wisconsin

U.S. Patent and Trademark Office

communications, electromagnetics, optics, semiconductors, control systems, including industrial controllers and motor controllers, and a variety of complex systems, including imaging systems, heating and cooling systems, automotive systems, and agricultural systems, as well as engines, motors, and generators. Additionally, John has significant experience working with matters involving artificial intelligence and machine learning, including neural networks and intelligent agents, as well as with FinTech matters, including technologies relating to insurance, benefits, and payment services.

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Experience

Represented a Startup in the Marine Industry in Regards to the Company's Intellectual Property Matters During an Acquisition

Prepared Petitions for Inter Partes Review Proceedings

Managed a Team in a Multi-Year Effort to Oppose the Registration of Product Configuration

Served as Primary Outside Counsel to a Large Insurance Company in Respect to the Company's Patent Matters

Provides Strategic Counsel for Patent Matters to a Manufacturer of Industrial Equipment

Provides Counsel for Filing in Patents and Trademark Matters

Provides Counsel for Intellectual Property Rights

Serves as Outside Counsel for Client's Patent Matters

Provides Strategic Counsel for Filing and Procurement of Patent Rights Relating to FinTech Innovations

Membership & Involvement

- Board of Directors: Milwaukee Youth Symphony Orchestra (MYSO)
- Founder and Co-chair: Wisconsin Chapter of the Licensing Executives Society
- Member: Wisconsin Intellectual Property Law Association; American Intellectual Property Law Association; American Bar Association; Intellectual Property Owners Association

Honors

- Selected to *The Best Lawyers in America*® in Litigation - Intellectual Property: 2024, 2025
- Selected to *The Best Lawyers in America*® in Litigation - Patent: 2024, 2025
- Selected to *The Best Lawyers in America*® in Patent Law: 2024, 2025

Firm News

100 Amundsen Davis Attorneys Recognized by Best Lawyers® in 2025 in America
Firm News, August 15, 2024

82 Amundsen Davis Attorneys Recognized by Best Lawyers® in 2024 in America
Firm News, August 17, 2023

John Pienkos and Tom Pienkos Join AD's Intellectual Property Practice Group
March 25, 2019

Speaking Engagements

Recent Developments at the PTAB
Speaking Engagement, International Property Owners Association, Seminar;
Chicago, IL, September 24, 2024

Overview Regarding Duty of Disclosure Pertaining to U.S. Patent Applications
Speaking Engagement, Beijing, China, September 18, 2024

What is Generative AI & How Does it Work?
Speaking Engagement, Brookfield, WI, September 12, 2024

Ethics Missteps in IP -- *A Moderated Discussion of Practical Ways to Address or
Altogether Avoid Various IP Ethics Mistakes*
Speaking Engagement, ACC-WI; Milwaukee, WI, November 2, 2023

Legal Issues for Startups and Emerging Companies
Startup Week; Beloit, WI, November 11, 2019

Published Works

Protecting Inventions Relating to Artificial Intelligence: Best Practices
Intellectual Property Owners Association Law Journal, February 25, 2022

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