



**Tom Donovan advises on patent and trademark litigation and prosecution, unfair competition and trade secret litigation, as well as a variety of licensing-related matters. Regardless of the client or the complexity of the matter at hand, Tom provides his clients with the guidance they need, in a way they can understand and apply to their daily business operations.**

Tom's technical depth means he quickly understands even the most sophisticated innovation, allowing him to focus on writing patents that are both viable and enforceable.

Tom also has significant negotiation and drafting experience with software licensing, as well as patent, trademark and copyright licensing, and in rendering patent validity and infringement opinions. Tom is valued by clients and colleagues for his grasp of the nuances of different types of licensing transactions. He delivers wide experience in negotiating with deal constituents in order to effectively close transactions while incorporating his client's underlying objectives.

In the event a dispute arises, Tom aggressively defends clients not only by protecting their IP assets, but also by mitigating potential loss and maximizing their potential for recovery. Tom is skilled in litigating IP disputes in federal and appellate courts and in alternative dispute resolution forums, and in advocating client positions before the U.S. Patent and Trademark Office (USPTO), Trademark Trial and Appeal Board, (TTAB) and International Trade Commission (ITC). He is experienced in both prosecution and defense, from initial pre-suit investigation through conclusion.

Tom represents companies involved in a wide variety of industries, ranging from manufacturing to technology and software. His tech experience includes advising businesses involved in the development, manufacture and marketing of plastics and packaging, exercise equipment and other health and fitness products, financial clearing software, products used in the manufacture of semiconductors, battery components, and beverage dispensing equipment and other food service equipment.

## Thomas J. Donovan

### Partner

One N. Wacker Drive  
Suite 4400  
Chicago, IL 60606-2833

P 312-214-8329  
F 312-759-5646  
thomas.donovan@btlaw.com

### EDUCATION

University of Illinois Urbana-Champaign,  
(B.S.), 1982

Chicago-Kent College of Law, (J.D.),  
with honors, 1987

### BAR ADMISSIONS

Illinois

U.S. Patent and Trademark Office

### COURT ADMISSIONS

U.S. Court of Appeals for the Federal  
Circuit

U.S. District Court for the Central District  
of Illinois

U.S. District Court for the Northern  
District of Illinois

### LANGUAGES

English

### PRACTICES

Administrative

Advertising and Marketing

Antitrust and Competition Law

Arbitration/Alternative Dispute Resolution

Commercial Litigation

Copyright Litigation

Copyrights

Corporate

Emerging Companies and Venture

In addition, Tom is familiar with high performance racing components used in NASCAR, Formula 1 and other racing, sports marketing, packaging and other industrial equipment, as well as a wide range of consumer goods, automotive and aerospace parts and equipment. He also represents clients in the entertainment and advertising industries.

Tom is a former member of the firm's Management Committee and former chair of the Intellectual Property department.

**Professional and Community Involvement**

Member and former alumni advisory board president, Department of Mechanical

Science and Engineering at the University of Illinois

Adjunct faculty member, Chicago-Kent College of Law

Guest lecturer, University of Notre Dame

Member, Intellectual Property Law360 Editorial Advisory Board

Member, PTAB Bar Association

Member, International Trademark Association (INTA)

**Honors**

The Best Lawyers in America 2012-2024

Illinois Super Lawyers, 2006-2012, 2014-2020, 2022-2024

Leading Lawyers Network

Intellectual Property Law Society, Alumni Awards, 2012

Managing Intellectual Property IP Stars, Patent and Trademark Star – Illinois, 2019-2021

- Capital
- Intellectual Property
- International IP
- International IP Litigation
- Internet and Technology
- IP Strategy and Management
- Japanese Services
- Licensing
- Litigation
- Mergers and Acquisitions - Intellectual Property
- Nanotechnology
- Opinions
- Patent Litigation
- Patent Services - Counseling and Prosecution
- Software and Technology Transactions
- Technology Transactions
- Trade Dress
- Trade Secret Litigation
- Trade Secrets
- Trademark Litigation and Unfair Competition
- Trademark Oppositions and Cancellations
- Trademarks

**INDUSTRIES**

- Motorsports
- Renewable Energy
- Telecommunications