

Jennifer E. Lacroix

Chicago, IL

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PARTNER

Overview

Every time Jennifer conducts post-issuance challenges in the Patent and Trademark Office, initiates or defends a proceeding, or argues an appeal, she knows she is working to help the intellectual property system fix itself. That is what draws her to practice intellectual property law; the challenge and reward that comes with impacting the industry.

Jennifer is not afraid to ask questions. Her clients appreciate that she learns their business and their technology. She studied engineering as an undergrad and is drawn to helping clients in the technology industry. Many of her clients are innovating in areas such as software, medical devices, pharmaceuticals, automotive manufacturing, chemical processing, and diagnostic and testing equipment.

As a member of the firm's Intellectual Property Service Group, Jennifer assists clients with intellectual property procurement, licensing and enforcement. Her experience includes patent and trademark prosecution, transactional counseling and negotiation, technology licensing such as software products and SaaS, acting as an IP specialist for M&A transactions, negotiating and drafting terms for transaction documents, drafting opinions regarding IP infringement and validity, and counseling clients with respect to other IP and technology issues. Jennifer has also handled numerous contested administrative proceedings at the U.S. Patent Office involving technologies such as GPS for automotive applications, riveting machines, and computer processing optimization.

Jennifer is on the Program Board for the Illinois YMCA Youth & Government Program, which draws about 1,000 high school students from all over Illinois. She has assisted in running the judicial aspect of the program for the last 20 years, helping students take a mock case through trial and appeal. Their motto is "Democracy must be learned by each generation," and they do their best to teach them.

SERVICES

Intellectual Property

Manufacturing & Food Processing

EDUCATION

Northwestern University School of Law, J.D., *cum laude*, 2000

Worcester Polytechnic Institute, B.S., with *high distinction*, 1997

ADMISSIONS

Illinois

U.S. Patent & Trademark Office

Jennifer E.
Lacroix

Experience

Represented the Shareholders of a Risk Management Information System Provider for Health Care Organizations in the Sale of Their Business

Represented an Electronic Discovery and Digital Forensics Company in its Sale to a Private Equity Backed Platform

Represented an Ophthalmology Start-up in Breach of Non-disclosure Agreement and Other Theories

Represented a Direct Marketing Company in a \$50 Million Cash-Out Merger and Sale to a Private-Equity Backed Competitor

Serves as Primary Outside Counsel to Manufacturer of Commercial Washroom Hardware and Sanitary Technologies

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

Serves as Outside Counsel for Client's Patent Matters

Membership & Involvement

- Member: American Bar Association; Illinois State Bar Association; Chicago Bar Association; Association of Patent Law Firms; Intellectual Property Owners Association; American Intellectual Property Law Association
- Program Board Member: Illinois YMCA State Youth and Government program

Honors

- Selected to the Leading Lawyers Network as an "Emerging Lawyer" in Intellectual Property Law
- Selected to the Illinois Super Lawyer List: 2014, 2015
- Listed in *Chicago Magazine's* Top Attorneys: Illinois' Outstanding Young Lawyers: 2014
- Selected to the Illinois Rising Stars List: 2009, 2010, 2011
- Recognized as Woman of the Year by the National Association of Professional Women: 2012

Alerts

Rule Changes Under the Trademark Modernization Act

Moral Rights: Considerations for Companies in the United States

Tense Situations: Failure to Clarify Working Prototypes Can be Fraud

Invention Disclosure Form: Why Does It Matter?

Circle Up - When and How Trademark Symbols Should Be Used

Speaking Engagements

Protecting IP Through Employment Contracts and HR Best Practices
Event, Amundsen Davis, Webcast, November 1, 2018

Published Works

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

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