

Thomas J. Pienkos

Milwaukee, WI

414.847.6172 | tpienkos@amundsendavislaw.com



PARTNER

Overview

Tom counsels clients on the strategic protection, licensing and enforcement of intellectual property rights both domestically and abroad. His experience includes preparing and prosecuting many U.S. and international patent applications and securing patent rights for clients in relation to a wide variety of technologies, including engine, construction, printing, commercial and residential heating and cooling, and computer-related technologies. Tom has supervised and conducted intellectual property due diligence investigations for corporate mergers, acquisitions and financings. He also drafts and negotiates patent license, nondisclosure and joint development agreements.

As a member of the firm's Intellectual Property Service Group, Tom represents clients in a range of industries, including transportation, commercial and residential kitchen and washroom, technologies, and industrial manufacturing. Tom leads and enjoys participating in patent review committees charged with strategically evaluating inventions for possible patent prosecution. He advises clients on policing and protecting copyright, trade dress, trade secret and trademark rights. Tom is active in the Wisconsin Intellectual Property Law Association (WIPLA) and the Wisconsin Association of Mutual Insurance Companies (WAMIC), presenting to members regarding developments with Insurance Data Security Model Law.

As a member of the Cryptocurrency, Blockchain and FinTech group, Tom has experience counseling clients in regard to patent and other intellectual property protection, and related contractual issues, in a wide array of software-implemented technologies, including the Internet of Things (IoT), Artificial Intelligence (AI), Machine Learning (ML). Tom is registered to practice as a patent attorney before the U.S. Patent and Trademark Office. He is also a member of the Cybersecurity and Data Privacy Service Group.

SERVICES

Cryptocurrency, Blockchain & FinTech

Cybersecurity & Data Privacy

Intellectual Property

Manufacturing & Food Processing

EDUCATION

University of Wisconsin Law School, J.D., 1999

University of Notre Dame, B.S.M.E., 1996, *cum laude*

ADMISSIONS

Wisconsin

U.S. Patent and Trademark Office

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Experience

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

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

Provides Counsel for Filing in Patents and Trademark Matters

Conducted Due Diligence and the Preparation of all Documents to Complete the Transfer of a Domain Name

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

Membership & Involvement

- Board of Governors: Wisconsin State Bar, representing District 2 (Milwaukee), 2021-2023; State Bar Board of Governors Liaison Public Utilities Section Board, present
- Intellectual Property Owners Association (IPO): Chair, IP Professionals with Disabilities and Advocates Resource Group of the IPO Diversity & Inclusion Committee, present; Member, International Patent Law & Trade Committee, present; Member, Trade Secrets Committee, present
- Member: Wisconsin Association of Mutual Insurance Companies (WAMIC); Wisconsin State Bar, Past Member of the Intellectual Property Law Section Board; Knights of Columbus, 4th Degree Member
- Past President: Wisconsin Intellectual Property Law Association, 2005-2006
- Past Co-Chair: Licensing Executive Society International, Wisconsin Chapter

Honors

- Selected to *The Best Lawyers in America*® in Patent Law: 2020, 2021, 2022, 2023, 2024
- Selected to *The Best Lawyers in America*® in Litigation - Intellectual Property: 2024

Firm News

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

41 Amundsen Davis Attorneys Recognized by *Best Lawyers in America*© 2023 Firm News, August 18, 2022

34 Amundsen Davis Attorneys Recognized by *Best Lawyers in America*© 2022
August 19, 2021

30 Amundsen Davis Attorneys Recognized in *Best Lawyers in America*© 2021
August 20, 2020

19 Amundsen Davis Attorneys Named to *Best Lawyers in America*© 2020
August 15, 2019

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

In the Media

Tom Pienkos Weighs In on 2023 Trends in Intellectual Property

Alerts

Invention Disclosure Form: Why Does It Matter?

Speaking Engagements

Intellectual Property Overview and Key IP Protection Considerations
Speaking Engagement, Marquette University; Milwaukee, WI, February 9, 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

Cyber Security

Wisconsin Association of Mutual Insurance Companies, Leadership Retreat; Lake Geneva, WI, October 20, 2021

Hybrid, Remote and Post-Pandemic (Eventually!) Return to In-Person Work Arrangements: A Panel Discussion on Key Topics for Those with Disabilities
Intellectual Property Owners Association, Webcast, August 20, 2021

Short Course: Cybersecurity Legal Considerations for the Insurance Sector
Wisconsin Association of Mutual Insurance Companies (WAMIC); Stevens Point, Wisconsin, July 13, 2021

Your Employee Asked to Work Remotely Indefinitely (or Short Term): Important Legal Considerations Before You Say Yes
Event, Amundsen Davis, Webcast, June 23, 2021

Handling Poor Employee Performance & Behavior in a Post-Pandemic Workforce without Inviting a Lawsuit
Independent Pharmacy Cooperative; Webcast, June 16, 2021

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Critical Legalese for Start-ups: Organization, Agreements and IP
Irontek, Webcast, April 28, 2020

Intellectual Property Primer and Key IP Protection Considerations
Marquette University; Milwaukee, WI, March 7, 2020

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

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