



James D. Borchardt Shareholder

MILWAUKEE

OFFICE:
414.298.8160

jborchardt@reinhartlaw.com

LinkedIn:
<https://www.linkedin.com/pub/james-borchardt/2a/9a5/568>

James Borchardt is a shareholder and registered patent attorney in Reinhart's Intellectual Property Practice. His practice is focused on helping his clients succeed in the marketplace.

He utilizes his in-depth knowledge of intellectual property law, patent office procedure and technology to develop a customized approach for each client. He is explicitly focused on protecting his clients' investment in new product development, helping them to make cost-justified patent filing decisions and to navigate third-party patent portfolios. James works with clients to develop utility and design patenting strategies to protect new products both in the United States and abroad.

He regularly counsels on product clearance, patent infringement analysis and patent validity analysis, and prepares and prosecutes patent reexaminations before the U.S. Patent and Trademark Office. James successfully uses these proceedings as part of dispute resolution strategies for his clients. He is also a member of the Artificial Intelligence (AI) team.

Prior to attending law school, James earned a biomedical engineering degree, and this broad technical education enables him to quickly grasp complex technologies. He works with clients in a wide range of areas including industrial and consumer products, advanced materials, product packaging, optical fibers, orthopedic medical devices, cardiac medical devices, patient monitoring systems, robotic surgical systems, drug delivery devices, and drug packaging and distribution systems.

James loves finding creative ways to adapt to his clients' needs and serve as an efficient legal partner. When he's not working, he is training for triathlons, hiking with his dogs and cooking.

Education

- J.D., with highest distinction, University of Iowa College of Law (Order of the Coif)
- B.S., University of Iowa College of Engineering (Biomedical Engineering)



Bar Admissions

Wisconsin

Court Admissions

- United States Patent & Trademark Office

Practices

- Intellectual Property

Services

- Inter Partes Review and Post Grant Review
- Patent Preparation and Prosecution
- Patent Searches - Patentability, Right-to-Use and Validity
- Trade Secret and Nondisclosure Counseling
- Artificial Intelligence

Matters

- Successfully worked with a small manufacturing client to develop and enforce patent portfolio, preventing much larger customers from second sourcing and switching suppliers.
- Drafted and prosecuted a family of *ex parte* and *inter partes* re-examinations on behalf of a Fortune 500 company. This work resulted in the elimination of a competitor patent portfolio protecting a nine-figure product market.
- Part of a Reinhart team that successfully invalidated a biotechnology patent in one of the first-ever filed *inter partes* review proceedings before the U.S. Patent and Trademark Office.

Honors & Affiliations

Honors

- University of Iowa College of Law - ABA/BNA Award for Excellence in the Study of Intellectual Property, Class of 2007

Affiliations

- State Bar of Wisconsin
- Milwaukee Bar Association
- American Intellectual Property Law Association

- Wisconsin Intellectual Property Law Association

Presentations

- "Protecting the Attorney-Client Privilege when Conducting Patent Due Diligence Activities," Wisconsin Bar approved CLE course, co-presenter, 2010
- "*Bilski v. Kappos*, Recent Developments and Practical Implications," Wisconsin Bar approved CLE course, co-presenter, 2010

Publications

- "[Civil and Criminal Penalties Possible for the Unwary Sender of Patent Demand Letters](#)," Reinhart e-alert, co-author, April 2014
- "[Wisconsin Legislature Approves Bill with Potential Implications for Senders and Receivers of Patent Demand Letters](#)," Reinhart e-alert, co-author, April 2014
- "[U.S. Switches to First to File Patent System on March 16, 2013](#)," Reinhart e-alert, co-author, February 2013
- "A Head Start for Medical Device Start-ups - Using the '1-3-15' patent approach, new companies can give themselves an edge in attracting investors" published in MX: Medical Device and Diagnostic Industry, January 21, 2011