



## Jack B. Hicks

### *Profile*

Jack Hicks has significant experience in counseling clients in all areas of patent, trademark, copyright and trade secret law. A licensed patent attorney, Jack assists clients in determining the type and scope of intellectual property protection that is best suited for their business goals. A substantial portion of his practice includes the preparation and prosecution of U.S. and foreign patent and trademark applications, as well as litigation in various jurisdictions and forums. He also has served as a Mediator for intellectual property disputes.

### *Areas of Practice*

*Patent, Trademark and  
Copyright Law*

### *Contact Information*

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Named as one of *The Best Lawyers in America*, Jack counsels clients in a wide range of industries, including those involving the general mechanical, electro-mechanical, manufacturing processes, chemical and “business methods” arts. Specific industries in which Jack is active include aerospace, pharmaceutical, electronics, home furnishings (including furniture), banking, computer software, leather goods, publishing, telecommunications and textiles.

An award winning author, Jack’s recognized expertise in his field leads to frequent invitations to speak or write on legal issues to intellectual property, licensing and general attorneys, as well as industry trade associations and universities. Jack will serve as the patent panelist at the upcoming Carolina Nanotechnology Commercialization Conference to be held March 31 – April 1, 2010, in Greensboro, NC. Jack also serves as an Adjunct Professor at Elon University School of Law, teaching Intellectual Property Law.

Prior to working as an attorney, Jack was employed as a design engineer on airborne radar and optics applications by Texas Instruments in Dallas, Texas. In 1987, he joined the Business Litigation Group of Womble Carlyle. In 1989, he became a licensed patent attorney, joining the patent boutique firm of Rhodes, Coats & Bennett in March 1993 and then Womble Carlyle again in July 2001.

### *Honors and Awards*

The Best Lawyers in America; North Carolina Super Lawyers; The Legal Elite, *Business North Carolina Magazine*.

### *Teaching Experience*

Adjunct Professor, Elon University School of Law, Intellectual Property Law; Guest Lecturer, University of Virginia School of Engineering and Applied Sciences, *Financial Aspects of Engineering*, and *Invention and Design* Classes, Charlottesville, VA; Guest Lecturer, High Point University, Home Furnishings Marketing Class, High Point, NC.

Jack is a co-author of the Womble Carlyle Furniture Law Blog.

### ***Professional Activities***

Board Member of the American Home Furnishings Alliance Suppliers Division (2004-2008).

Vice Chair of the Industrial Design Committee of the American Intellectual Property Law Association (2006-2008).

Bar Associations: North Carolina Bar Association, Councils of the Intellectual Property Section and Business Law Section, Technology Liaison, 1998-2002; Carolina Patent, Trademark and Copyright Lawyers Association, Board of Managers, 1995-1998; International Trademark Association; Licensing Executive Society; American Society of Mechanical Engineers.

Admitted to the bar 1987, North Carolina. Admitted to practice before the U.S. District Court, Middle and Eastern Districts of North Carolina; U.S. Court of Appeals for the Federal Circuit; registered to practice before U.S. Patent and Trademark Office.

### ***Education***

B.S., Mechanical Engineering, 1979, University of Virginia, with high distinction; Tau Beta Pi; Pi Tau Sigma; Sigma Xi; General Electric Foundation Merit Scholarship; American Society of Mechanical Engineers; Raven Society; Sigma Chi.

M.S., Mechanical Engineering, 1980, University of Virginia.

J.D., 1987, University of Texas at Austin School of Law, with honors; Associate Editor, *Texas Law Review*; Order of the Coif; Board of Advocates.

### ***Prior Legal Experience***

Partner, Rhodes & Mason, PLLC, Greensboro, NC, 1996-2001; Associate, Rhodes, Coats & Bennett, PLLC, Greensboro, NC, 1993-1996; Associate, Womble Carlyle Sandridge & Rice, PLLC, Winston-Salem, NC, 1987-1993.

### ***Prior Business Experience***

Design Engineer, Texas Instruments, Dallas, TX, 1980-1984.

Designed and analyzed thermal and vibrations characteristics for high-density electronics packaging for optics, thermal imaging and radar avionics.

### ***Presentations***

Jack will serve as the patent panelist at the upcoming **Carolina Nanotechnology Commercialization Conference** to be held March 31 – April 1, 2010, in Greensboro, NC. Information on this event can be found at <http://www.ncscitech.com/ncncc/index.htm>.

“Nanoscience Patents Needs Assessment: Where Are We and Where Do We Go From Here?”, Society for the Study of Nanoscience and Emerging Technologies Conference, Sept. 8-11, 2009, University of Washington at Seattle, WA.

“Getting a Firm Grasp on Obviousness and Overcoming Office Action Rejections,” September 22-23, 2008, ACI’s USPTO Boot Camp: Patent Edition, Washington, DC. (invited)

“Development on International Design Registration – Geneva Act Implementation,” Industrial Design Committee Joint Meeting, May 14, 2008, AIPLA Spring Meeting, Houston, TX.

“Is it Time for the U.S. to Adopt a Registration System for the Protection of the Appearance of Useful Articles?” AIPLA (Panel Moderator), October 18-20, 2007, AIPLA Annual Meeting, Washington, DC.

AIPLA Board Meeting Presentation: Fashion Protection Design Piracy Prohibition Act (H.R. 2033), July 19, 2007, Arlington, VA.

“U.S. Design Protection Are Existing Options Adequate?” Fordham Annual Conference on International Intellectual Property Law & Policy, April 12-13, 2007, New York, NY.

Presenter at Duke Law Intellectual Property & Cyberlaw Societys Hot Topics in Intellectual Property Law Symposium, February 23, 2007.

“Fashion Industry Gets Tough,” Design Piracy Prohibition Act (H.R. 5055, 109th Congress (2006)), AIPLA 30th Mid-Winter Institute, New Orleans, LA, January 24-27, 2007.

“Patent Strategies in Home Furnishings Industry, A Day of Design Dynamics” Patent Examiner’s Forum, United States Patent and Trademark Office, Washington, D.C, August 10, 2006.

“A Dialogue on Selected Ethics Topics.” Carolina Patent Trademark Copyright Law Association Spring Meeting, Charlotte, NC, April 23, 2004.

“IP Due Diligence – Kicking the IP Tires in Business Transactions,” The Laws of Science, North Carolina Biotechnology Center, Research Triangle Park, NC, March 26, 2003.

“Design and Patent Strategy in the Furniture Industry,” Patent Examiner Forum 2002, United States Patent and Trademark Office, Washington, D.C., May 12, 2002.

“Intellectual Property and Furniture: What You Can and Cannot Knock-off,” High Point University, High Point, North Carolina, February 19, 2002.

“Identifying and Protecting Proprietary Property,” North Carolina A&T University, Greensboro, North Carolina, January 28, 2002.

"Radical Changes in the Law of Infringement (Festo)," Tennessee Intellectual Property Law Association Annual Meeting 2001 Spring Symposium, Pikeville, TN, May 4-5, 2001.

"Intellectual Property Capital in the New Economy; Radical Changes in the Law of Infringement," Licensing Executives Society (USA and Canada), Inc. 2001 Winter Meeting, Atlanta, GA, February 21-23, 2001.

"Promoting Entrepreneurship in North Carolina," North Carolina Bar Association Business Law Section Annual Meeting, Pinehurst, NC, February 16, 2001.

"Looking for Patents and Trademarks Before You Leap," American Furniture Manufacturers Association (AFMA) Finance Management Seminar, Greensboro, NC, September 27-28, 2000.

"New Developments in Intellectual Property Law: Patents Track – Brightening the Line for the On-Sale Bar (*Pfaff v. Wells Electronics, Inc.*)," North Carolina Bar Foundation Continuing Legal Education, Southern Pines, NC, April 9, 1999.

### ***Publications***

"PATENTING NANOTECHNOLOGY: Is there Really Plenty of Room at the Bottom?" *IP Links*, NCBA Intellectual Property Law Section Newsletter, Section Vol. 21, No. 1, TBD 2010 (accepted for publication) (co-author with Gregory Grissett, and Bernard A. Brown, II\*)

"Will Design Piracy Prohibition Act Send Designer Copycats Out of Style? An Analysis of the Current and Future State of Intellectual Property Protection for Fashion Design" *IP Links*, NCBA Intellectual Property Law Section Newsletter, Section Vol. 21, No. 1, November 2009 (co-author with Tiffani Otey).

Patent Reform 2007: Only Certain "New" Designs Receive Protection, Furniture Executive, American Home Furnishings Alliance (November 30, 2007) (co-author with Robert D. Mason, Jr.).

"Patent Reform 2007: Important Changes are Coming for U.S. Patent Law," Furniture Executive, American Home Furnishings Alliance (November 2, 2007) (co-author with Martina Tyreus).

"Challenges to Protecting Novel Designs - Only Certain Designs Receive Protection," *IP Links*, NCBA Intellectual Property Law Section, Section Vol. 19, No. 1, November 2007 (co-author with Robert D. Mason, Jr.).

"The Materiality Standard for Intellectual Property Disclosings: How Pending is That Patent?" *Notes Bearing Interest* - Newsletter of the NCBA's Business Law Section, Vol. 23, No. 1, February 2002 (co-author with Robert S. Thomas).

"Intellectual Property for the Business Lawyer: A Space Age Primer," *Notes Bearing Interest* -- The Newsletter of the NCBA's Business Law Section, Vol. 19, No. 3, May 1999 (co-author with Amy H. Fix)..

"Furniture Copying: Will it Ever End? Recent Trends Confirm That New Designs Are Best Protected by Patents," *IP Links* – The Newsletter of the NCBA's Intellectual Property Law Section, Vol. 8, No. 2, January 1997.

"NC Legislature Considers Anti-Counterfeiting Bill," *Business Life* – The Business Magazine of the Piedmont Triad, August 1995.

"North Carolina Enacts Anti-Counterfeiting Statute," *IP Links* – The Newsletter of the NCBA's Intellectual Property Law Section, Vol. 7, No. 1, October 1995.

"Seller Beware – *Sharrard v. Suz's (Dec. 10, 1990)*," *IP Links* – The Newsletter of the NCBA's Intellectual Property Law Section, Vol. 2, No. 2, January 1991.

"Copyright and Computer Databases: Is Traditional Compilation Law Adequate?" *65 Texas Law Review* 993 (1987), ASCAP Copyright Law Symposium No. 37, Vol. 65, No. 5, April 1987.