



## Jack B. Hicks

### *Profile*

A licensed patent attorney with more than 20 years of experience, Jack Hicks counsels clients to determine the type and scope of intellectual property protection that meets their business goals. A substantial portion of his practice includes the preparation and prosecution of U.S. and foreign patent and trademark applications. Although Jack started his career as a successful trial lawyer, his practice currently focuses upon counseling clients in national and international intellectual property evaluation, protection and enforcement. Jack's honors and awards include being ranked among the leading lawyers in his field by The Best Lawyers in America, North Carolina Super Lawyers and North Carolina Legal Elite.

### *Areas of Practice*

*Patent, Trademark and  
Copyright Law*

### *Contact Information*

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### **Global Aerospace Industry**

Jack regularly counsels clients who are manufacturers and suppliers of civil, military and business aircraft, helicopters, unmanned aerial vehicles and related components, equipment, services and avionics. Sample projects include:

- Successfully prosecuted U.S. and worldwide patents pertaining to numerous components on jet engine aircraft
- Conducted state of the art studies for carbon nanotube composite aircraft structures
- Enforced patents directed to commercial aircraft seating configurations
- Obtained strategic patents for essential equipment used in major air freight and cargo systems aircraft providers
- Coordinated intellectual property protection for specialized equipment designed for large commercial single-aisle and dual-aisle aircraft
- Incorporated noise reduction studies and proof of concept tests in patent protection for low noise aerodynamic profiles
- Managed patent portfolio for fuel reducing inventions pertaining to variable air flow jet engine designs

Jack brings a client's perspective to aerospace patent matters. Prior to becoming an attorney, Jack was a design engineer on airborne radar and optics applications by a major government contractor based in Texas. His engineering responsibilities included complex design, thermal analysis and vibrations monitoring and modeling for range of airborne equipment.

### *Recent Trade Shows/Conferences*



- Aircraft Interiors Expo 2010, Hamburg, Germany (May 2010)
- Farnborough International Airshow (FIA), Farnborough, UK (July 2010)

### **Nanotechnology Innovation**

Jack currently is working with numerous clients in the emerging area of nanotechnology. He helps companies prepare and prosecute patents and other suitable intellectual property protection.

One recent matter involved preparing and filing multiple US and international patent applications for a leading aerospace manufacturer on use of carbon nanotubes in complex composite structures. Other projects include nanofibers for drug delivery and filter technologies.

Womble Carlyle's nanotechnology clients include universities, research facilities, start-up ventures and established businesses in such fields as pharmaceuticals, life sciences, petroleum, electronics, computer software and air & space technology.

### ***Recent Speeches/Papers/Trade Shows/Conferences***

- Department of Materials Science and Metallurgy, University of Cambridge, Cambridge, UK (Guest Lecturer: "Patents and Nanotechnology: Is There Still Room at the Bottom?")
- Carolina Nanotechnology Commercialization Conference, April 1, 2010, Greensboro, N.C. (Speaker - "The 'Business' Side of Nanotechnology")
- "Patenting Nanotechnology: Is There Really Plenty of Room at the Bottom?" *IP Links*, NCBA Intellectual Property Law Section Newsletter, Section Vol. 21, No. 1, May 2010 (co-author with Gregory Grissett, and Bernard A. Brown, II)
- Society for the Study of Nanoscience and Emerging Technologies Conference September 2009, University of Washington, (Speaker - "Nanoscience Patents Needs Assessment: Where Are We and Where Do We Go From Here?")
- Nanotech 2008, Nano Science and Technology Institute, Boston, May-June, 2008

### **Design Protection & Home Furnishings**

Jack has more than 20 years of experience guiding home furnishing and design companies through all stages of the intellectual property process. He has written and prosecuted patents, trademarks and copyrights on literally hundreds of furniture-related designs.

Jack's proximity to High Point, N.C., the capital of the U.S. furniture industry, helps him better serve the home furnishings industry. He is a frequent author and speaker on furniture- and design-related patent issues, and is a co-author of the Womble Carlyle Furniture Law Blog.

### ***Recent Speeches/Papers/Trade Shows/Conferences***

- "Strategies for Pursuing Design Protection in Europe," Industrial Designs Committee Meeting, American Intellectual Property Lawyers Association, October 2010
- USPTO Global Intellectual Property Academy Patent Industrial Design Program, March 2010, Alexandria, Va. (Speaker: "Design Protection through US Copyrights: Industrial Design or Applied Art?")
- "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)
- "Are You Selling a Design Knockoff? Get Ready to Be Sued!," Las Vegas Furniture Market, February 2009
- American Intellectual Property Law Association AIPLA Spring Meeting, May 2008, Houston. (Speaker: "Development on International Design Registration – Geneva Act Implementation")
- AIPLA, October 2007, AIPLA Annual Meeting, Washington, DC. (Panel Moderator: "Is it Time for the U.S. to Adopt a Registration System for the Protection of the Appearance of Useful Articles?")
- Fordham Annual Conference on International Intellectual Property Law & Policy, April 2007, New York. (Speaker: "U.S. Design Protection Are Existing Options Adequate?")
- Patent Examiner's Forum, United States Patent and Trademark Office, Washington, D.C, August 2006. (Speaker: "Patent Strategies in Home Furnishings Industry, a Day of Design Dynamics")

### **International Patent & Design Protection**

Jack has considerable experience helping companies prepare and prosecute patents in international venues, particularly in Europe and in Asia.

Jack spent the summer of 2010 on a working sabbatical in Europe, an experience which has greatly benefitted his international patent prosecution clients.

His trip included working at the European Patent Offices in Germany and the European Union's Designs Department in Spain. At both institutions, he worked on

*eLearning* modules intended to help US clients pursue targeted and cost-effective intellectual property protection throughout Europe.

Jack also traveled extensively in Vietnam and Singapore in the First Quarter of 2011, visiting with clients, law firms and government officials, with a planned trip in January 2012 to Hong Kong and China.

### ***Recent International Speeches/Papers/Trade Shows/Conferences***

- “Successful EPO Prosecution from U.S. Perspective,” North Carolina Bar Association Intellectual Property Annual Meeting, Concord, N.C., March 2011
- Department of Materials Science and Metallurgy, University of Cambridge, Cambridge, Great Britain (Guest Lecturer: “Patents and Nanotechnology: Is There Room at the Bottom?”)
- “Tips for US Patent Attorneys Pursuing Protection within the European Patent Office,” eLearning Module for European Patent Academy of European Patent Office
- “Tips for US Design Practitioners Seeking Design Protection in Europe,” eLearning Module for Designs Department of European Union Office for Harmonization in the Internal Market
- “Strategies for Pursuing Design Protection in Europe,” Industrial Designs Committee Meeting, American Intellectual Property Lawyers Association, October 2010
- USPTO Global Intellectual Property Academy Patent Industrial Design Program, March 2010, Alexandria, Va. (Speaker: “Design Protection through US Copyrights: Industrial Design or Applied Art?”)
- Aircraft Interiors Expo 2010, Hamburg, Germany, May 2010
- Farnborough International Airshow (FIA), Farnborough, UK, July 2010

### **Pedagogy & Intellectual Property**

In addition to his active legal practice, Jack serves as an Adjunct Professor of Intellectual Property Law at the Elon University School of Law. He also lectured in 2010 on nanotechnology patent issues at Cambridge University in England.

Other teaching engagements include serving as a guest lecturer at the University of Virginia School of Engineering and Applied Sciences, speaking on the topics of “Financial Aspects of Engineering” and “Invention and Design,” as well as guest lecturing at High Point University’s Home Furnishings Marketing Class on topics related to designs protection in the home furnishings industry.

Jack also is a frequent contributor to Patent Academies at both the United States Patent and Trademark Office and the European Patent Office.

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.

### ***Recent Speeches/Papers/Trade Shows/Conferences***

- “Successful EPO Prosecution from U.S. Perspective,” North Carolina Bar Association Intellectual Property Annual Meeting, Concord, N.C., March 2011
- Oxford Nanotechnology Summer School, University of Oxford, Great Britain, July 2010. (Speaker: “Nanotechnology for Energy and Carbon Management”)
- Duke Law Intellectual Property & Cyberlaw Society’s Hot Topics in Intellectual Property Law Symposium, February 2007 (Speaker)
- Carolina Patent Trademark Copyright Law Association Spring Meeting, Charlotte, N.C., April 2004. (Speaker: “A Dialogue on Selected Ethics Topics”)

### ***Professional Activities***

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

Member, US-EPO Council (2011-present).

Chair, International Intellectual Property Committee, North Carolina Bar Association Intellectual Property Section (2011-present).

Chair, Intellectual Property Law Professors Sub-Committee, Education Committee, American Intellectual Property Law Association (AIPLA) (2010-present).

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

Bar Associations: North Carolina Bar Association; 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.

### ***Honors and Awards***

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