

# Brett Joseph Trout

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## Professional Profile

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<i>Trademarks</i>	<i>Patents</i>	<i>Strategic Planning</i>
<i>Technology Licensing</i>	<i>Software Licensing</i>	<i>IP Portfolio Management</i>
<i>IT Security/Privacy</i>	<i>Copyrights</i>	<i>IP Policy Implementation</i>
<i>eCommerce Compliance</i>	<i>Trade Secrets</i>	<i>IP Licensing</i>
<i>Website Policies</i>	<i>Software Protection</i>	<i>Settlement Negotiation</i>
<i>Technology Litigation</i>	<i>Consulting</i>	<i>Opinion Letters</i>

## Career History

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*Founder, Senior Patent Attorney/Founder*, AV-Rated Law Offices of Brett J. Trout P.C., Des Moines, Iowa, 2001 to present.

*Founding Shareholder, Senior Patent Attorney/Founder*, Gunderson, Sharp, Trout & Rhein, Des Moines, Iowa, 2000 to 2001.

*Shareholder, Senior Patent Attorney*, Brown, Winick, Graves, Gross, Baskerville & Schoenebaum, P.L.C., Des Moines, Iowa, 1998 to 2000.

*Shareholder, Patent Attorney*, Shearer, Templer & Pingel P.C., Des Moines, Iowa, 1995-1998.

*Associate Patent Attorney*, Davis, Wine, Brown, Koehn & Shors P.C., Des Moines, Iowa, 1992-1995.

## Educational History

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*The University of Iowa*, College of Law, Iowa City, Iowa  
J.D. with distinction, 1992

*Grinnell College*, Grinnell, Iowa

- B.A. Chemistry, 1988
- Organic Chemistry, Inorganic Chemistry, and Mathematics.
- Background in Physics, Computer Programming, and Genetics



## ***Patent***

- Registered patent attorney-*USPTO Registration Number 37,250*
- Infringement litigation - United States Letters Patent No. 5,915,878
  - Five year litigation
  - Patent validated
  - Jury verdict overturned
  - Infringement found
  - Attorney fees, costs, punitive damages awarded
  - Costs contained at less than \$200K
- Negotiating settlement agreements
- Prosecuting 100+ patents toward subsequent registration
- Anticipating future USPTO guidelines toward drafting business method patent applications having broad, allowable claim coverage
- Working with clients to develop unique claim protection strategies
- Successful record of appeals to the United States Board of Patent Appeals and Interferences
- Developing broad, complimentary patent portfolios
- Limiting client infringement exposure
- Maximizing efficiency through effective utilization of staff
- Successfully interviewing Patent Examiners
- Developing patent department for one of Iowa's largest law firms
- Negotiating patent licensing agreements
- Litigating complex patent issues
- Prosecuting patent interference action

## ***Information Technology***

- Authoring Iowa's only comprehensive Information Technology Legal Resource Guide
- Providing exclusive intellectual property services for Emerging Growth Group Information Technology incubator
- Negotiating equity-driven international IT joint ventures
- Drafting business method patents for IT clients
- Creating information technology due diligence and audit reports
- Negotiating and drafting IT core technology license, assignment and settlement agreements
- Defending and prosecuting complex information technology cases in Federal Court
- Marshalling IT intellectual property resources for strategic market placement
- Assisting clients in developing and marketing websites
- Negotiating the sale and transfer of domain names
- Conducting due diligence for websites, domain names and trademarks
- Drafting novel privacy policies and security strategies
- Drafting website usage agreements for large scale corporate clients



## ***Software***

- Developing licensing strategy and custom contracts for software developers
- Developing software rights purchase agreements for buyers
- Negotiating complex licensing issues toward successful resolution
- Relieving clients from burdensome licensing restrictions
- Advising clients as to appropriate pre-licensing protection of software
- Negotiating architecture, ownership, server and development schedule issues
- Lecturing on complex software licensing and liability issues

## ***Trademark***

- Drafting applications which reduce costs and facilitate enforcement
- Leveraging technology resources to maximize efficiency and reduce costs
- Securing trademark opinions on an expedited basis
- Successfully litigating trademark disputes
- Negotiating trademark dispute settlements toward the desired resolution
- Providing full maintenance and support services for trademark clients
- Negotiating domain name disputes toward successful conclusion
- Facilitating domain name transfers

## ***Copyright***

- Advising clients of appropriate copyright protection strategies
- Successfully litigating copyright infringement matters
- Filing copyright registrations for serials, text, software, brochures, architectural works and three dimensional works
- Providing copyright protection strategies for software programs
- Negotiating settlements for client copyright claims

## ***Trade Secret***

- Drafting employee non-competition/nondisclosure agreements
- Drafting employee exit agreements covering retained trade secrets
- Consulting clients on reasonable measures to protect trade secrets
- Successfully litigating trade secret case against client's former employee
- Providing opinion letters to clients regarding trade secret misappropriation

## ***Litigation (Illustrative cases)***

- *Devon Distributing Corp. v. Miner*, 331 F. Supp. 2d 791 (S.D. Iowa 2004) – Patent Infringement – Awarded treble damages and attorney fees.
- *American Hunting Innovations LLC v. Horton Manufacturing Company LLC* – Patent Infringement – Successful settlement
- *Bakko Bros., Inc. et al v Jacobs Corp.* – Patent Infringement, Multiple Patents - Pending
- *Bakko Bros., Inc. et al v Jacobs Corp. et al* - False Patent Marking – Pending
- *Allied Machine & Engineering Corporation v. Jewell Machine & Fabrication, Inc.* – Patent Infringement Defense – Pending - Patent currently invalidated
- *Kimberly Hutchison v. The Printer Inc.* – Trade Secret Defense – Successful settlement
- Co-litigating Trade Secret case to successful jury verdict
- Obtaining multi-year payouts in multiple patent infringement cases
- Successfully obtaining Summary Judgment ruling on validity of United States Letters Patent Number 5,915,878
- Litigating multiple Trademark cases
- Litigating complex Information Technology cases
- Consultant on Copyright, Trade Secret and Design Patent litigation
- Litigating domain name cybersquatting issues
- Litigating Copyright Infringement matters
- Admitted to Practice
  - United States Supreme Court
  - U.S. Court of Appeals - Federal Circuit
  - U.S. Court of Appeals - Eighth Circuit
  - Iowa - U.S. District Court, Northern and Southern Districts of Iowa

## ***Consulting***

- Preparing intellectual property due diligence reports
- Preparing freedom to operate opinions
- Negotiating software development and licensing strategies
- Negotiating and non-compete agreements for employees and employers
- Drafting confidentiality agreements
- Negotiating licensing provisions for various Intellectual Property owners
- Fostering close working relationship with several in-house attorneys to better provide full-scale service to larger corporate clients
- Advising in-house clients on Intellectual Property portfolio maintenance
- Developing and administering Intellectual Property portfolio audits

## *Professional*

- Fellow-Iowa Academy of Trial Lawyers
- AV–Rating Martindale Hubbell
- The Best Lawyers in America® 2010-Present
- Marquis Who’s Who In American Law
- Iowa State Bar Association, 1992 to present
  - Iowa State Bar Association Technology Committee
    - Chair 2003 to 2006
    - Member, 1999 to present
    - Organized 2004 Iowa Bar Association Annual Meeting Technology Track
    - Orchestrated largest event in ISBA Tech Committee History
  - Intellectual Property Section, 1992 to 2002
  - Corporate Counsel Section, 1998 to 2002
  - eCommerce Section Council 2015 to Present
  - Young Lawyers Division
    - Publicity Committee 2001 to 2003
    - 5C District Representative 1999 to 2000
    - Membership Committee 1998 to 2000
- Admitted-Courts
  - Northern/Southern Districts of Iowa
  - Court of Appeals for the Federal Circuit
  - Court of Appeals for the Eighth Circuit
  - United States Supreme Court
- Member of Polk County Bar Association, 1992 to present
  - Special Projects Committee – Website Development
    - Chair 2005 to 2006
- Member of Iowa Intellectual Property Law Association, 1992 to present
  - Director, 1999 to 2001
  - President 2001 to 2002
  - Director 2002 to 2003
- Registered Patent Attorney, 1993 to present
- Blackstone Inn of Court, 1994 to present
  - Master of the Bench
  - President 2015 to 2016
  - Treasurer 2013 to 2014
  - Secretary 2011 to 2012
- Journal of Corporation Law, 1991-92
  - Articles Editor

## ***Publications***

### **Hard Copy**

- The Ethical Lawyer and the Tao of Technology.
  - 2015 Symposium - 48 Creighton L. Rev. 709
- Cyber Law: A Legal Arsenal For Online Business
  - Comprehensive desk reference on all aspects of Internet laws
  - 2007 World Audience Publishers
- E-Marketing, Judy Strauss and Raymond Frost
  - Contributing Author
  - 2008 Prentice Hall
- yBlawg: The Nuts and Bolts of Lawyer Blogging
  - 2006 co-authored with Rush Nigut
  - Comprehensive tutorial on the ethics and advantages of starting a law blog
- What No One Ever Tells You About Blogging and Podcasting: Real-Life Advice from 101 People who Successfully Leverage the Power of the Blogosphere, 2006 Contributing Author
- Internet Laws Affecting Your Company, 2005 Brett J. Trout
  - Broad coverage of legal technology issues
- Internet Laws Affecting Iowa Companies, 2002 Brett J. Trout
  - First publication addressing Internet law impact on Iowa
- The E-Business Legal Arsenal: Practitioner Agreements and Checklists, American Bar Association, Contributing Author, 2004
- Find it Fast and Free on the Internet 2006, Lorman, Contributing Author
- Computer Based Legal Education in Iowa, Iowa Lawyer, October, 2003
- E-Commerce in Iowa 2001, NBI, Contributing Author
- Intellectual Property in Cyberspace, Iowa State Bar Association, Contributing Author
- The Law of the Internet in Iowa 2000, NBI, Contributing Author
- The Law of the Internet in Iowa 1999, NBI, Contributing Author
- Intellectual Property Lawyers Honor Inventors, Iowa Lawyer, December 2002
- Comment: A Patient Seeks a Portion of the Biotechnological Patent Profits in: Moore v. Regent's of the University of California. 17 J. Corp. L. 513 (1992)

### **Digital**

- Internet Law: The Complete Guide
  - Co-author - 2014
  - Largest mutli-volume treatise on Internet Law
- Blawg IT –2003 to Present
  - blog.brettrout.com
  - Weblog Award Finalist – Best Law Blog
  - Rated 6<sup>th</sup> best law blog in the world
  - Oldest law blog in Iowa

- Law Offices of Brett J. Trout
  - [www.bretttrout.com](http://www.bretttrout.com)
  - Site Design and Content Contributor
  - Reached number one on Google w/o paid sponsorship
  - Achieved one of the highest Google page ranks of any Iowa law firm
- Lawopportunities
  - [www.lawopportunities.com](http://www.lawopportunities.com)
  - First eCommerce only Continuing Legal Education company
  - Sponsored world's first all-day law blog CLE tutorial
- Patently-O
  - Guest Contributor
- IowaBiz.com
  - Internet Law Columnist
- yBlawg
  - Co-founder
  - World's first all-day law blog CLE tutorial
- LawlaCart
  - [www.Lawlacart.com](http://www.Lawlacart.com)
  - Iowa's first online continuing legal education provider
  - Site Creator
  - Content Provider
  - Site Manager
- [www.businessknowhow.com](http://www.businessknowhow.com) *Top Ten Legal Oversights That Can Shut Down Your Website*, 2005
- [www.askdavetaylor.com](http://www.askdavetaylor.com) *Are Shrink Wrap Agreements Valid?* 2005
- [www.dearesq.com](http://www.dearesq.com) *Trademark Registration: What is a Trademark?* 2005
- [Locker gnome Digital Media](http://Locker gnome Digital Media),
  - Electronic Newsletter with over 40,000 subscribers
  - Weekly content provider 2002-03

## ***Broadcast***

- Robotics, Artificial Intelligence, and the Future of Work
  - Ethical Perspectives in the News
  - KCRG, Cedar Rapids
  - October 2017
- *The Death of Digital Rights Management*
  - The David Lawrence Show
  - Nationally syndicated radio program
  - October 2007
- *Cyber Law: A Legal Arsenal for Online Business*
  - Chris Pirillo – Video Broadcast
  - October 2007
- *How to Protect Your Business*

- Fearless Ambition T.V.
- August 2009
- *Legal Pitfalls of Social Media*
  - SocialMedialogy Conversations
  - September 2008
- *Staying Out of Trouble Online*
  - KCCI Channel 8 interview with Marcus McIntosh
  - November 2007
- *BlogWorld Expo Speaker Video Blog*
  - WebProNews
  - November 2007
- *Cyber Law*
  - The Iowa Business Hour with Jim Goodman
  - November 2007
- *Recent Rulings in the Microsoft Case,*
  - The David Lawrence Show
  - Nationally syndicated radio program
  - November 2006
- *eDiscovery*
  - RushOnBusiness
  - Blog Talk Radio
  - Inaugural broadcast
- *Expanding Technology Use in Iowa,*
  - WHO 1040 radio broadcast with Van Harden and Chuck Offenburger
  - February 2003
- *How to Keep Your Blog Out of Legal Hot Water*
  - The Iowa Business Hour with Jim Goodman
  - February 2007

## ***Lectures***

- *The Upcoming Onslaught of Online Regulation*
  - 140 Character Conference, October 2009
  - Los Angeles, California
  - World's Largest Twitter Conference
- *Keeping Your Blog Out of Court*
  - BlogWorld Expo, November 2007
  - Las Vegas, Nevada
  - World's Largest Blogging Conference
- *Intellectual Property Law*
  - Iowa Academy of Trial Lawyers 2013 Annual Meeting
- *The Ethical Lawyer and the Tao of Technology*

- Creighton Law Review 2015 Symposium - Ethics and Electronics: Navigating Legal Ethics and New Technology, March 2015
- Omaha, Nebraska
- *Ethics: Think About It: What Happens When You Hit 'Send' (or 'Post')*?
  - Iowa Bench-Bar Conference, May 2014
  - Dubuque, Iowa
- *Legal Pitfalls for Startups*
  - I/OWA Conference, October 2014
  
- *Ethics and Electronic Media*
  - Iowa State Bar Association Annual Meeting, June 2012
  - Plenary Track Lecture Series
- *Information Assurance Law vs. Ethics*
  - Iowa State University, May 2013
  - Ames, Iowa
- *Ethical Risks of Online Communications: Facebook, Twitter, Firm Websites and Blogs*
  - National Continuing Legal Education Teleconference 2009
  - Expert panel including Michael Downey and Mark Fucile
- *Information Assurance Law vs. Ethics*
  - Iowa State University, February 2010
  - Ames, Iowa
- *Legal Ramifications of the Social Web*
  - Drake University, February 2010
    - Des Moines, Iowa
- *Online Mistakes Law Firms Make*
  - Iowa State Bar Association Small Firm Seminar, July 2009
  - Moravia, Iowa
- *Keeping Your Corporate Website Out of Legal Trouble*
  - Iowa State Bar Association Corporate Counsel/Trade Regulation Seminar, September 2008
- *Top Ten Things That Will Shut Down Your Client's Website*
  - Iowa State Bar Association Annual Meeting, June 2008
  - Corporate Track Lecture Series
- *Are Your Clients Blogging Their Way Into Court?*
  - Iowa State Bar Association e-Commerce Seminar, December 2007
- *yBlawg: The Nuts and Bolts of Lawyer Blogging*,
  - Lawppportunities, November 2006
  - First Ever Day-Long Tutorial on Lawyer Blogging
- *Ethical Risks of Online Communications by Law Firms: Websites, Blogs and Online Networking*
  - National Continuing Legal Education Teleconference 2008
  - Expert panel including John Steele and Diane Karpman

- *Ethical Risks of Law Firm Websites and Blogs: Staying on the Right Side of the Ethics Line*
  - National Continuing Legal Education Teleconference 2007
  - Expert panel including John Steele and Ben Cowgill
- *Blogging For Lawyers*
  - Polk County Bar Association, November 2007
- *eDiscovery*
  - Infraguard – Des Moines Chapter, January 2007
- *Patents, Trademarks and Copyrights*
  - Central Iowa SCORE Chapter, 2008
- *Online Legal Ethics*
  - Iowa State Bar Association – eCommerce Section 2006 Annual Seminar
- *Copyright in the Age of Grokster: New Rules for a New Game*
  - Iowa State Bar Association – eCommerce Section 2006 Annual Seminar
- *Lawyer Blogging*, Iowa State Bar Association eCommerce Program, Urbandale, IA, December 2006
- *Discover the Invisible Web*, National Business Institute Lecture Series December 2006
- *Free Legal Research Online*, National Business Institute Lecture Series December 2006
- *Ethical Risks of Law Firm Websites and Blogs*, National Business Institute Lecture Series December 2006
- *Law Blog Basics*
  - Polk County Bar Association Annual Meeting, November 2006
- *Why is No One Reading My Law Blog?*
  - Iowa State Bar Association – eCommerce Section Annual Seminar
- *Top Ten Legal Oversights That Can Shut Down Your Website*, Iowa Society of Association Executives, November 2006
- *Online Security Issues and the Law*,
  - Iowa State Bar Association Annual Meeting, June 2004
  - Bar Technology Track Lecture Series
    - Chair, Moderator and Presenter
- *The Impact of the Patent Reform Act*, Iowa Inventor's Group, Cedar Falls, IA January 2006
- *Legal Oversights Online*, Iowa State Bar Association eCommerce Program, Urbandale, IA, December 2005
- *Discover the Invisible Web*, National Business Institute Lecture Series December 2005
- *Free Legal Research Online*, National Business Institute Lecture Series December 2005
- *How to Search Like a Pro*, National Business Institute Lecture Series December 2005

- *Top Ten Legal Oversights That Can Shut Down Your Website*, Iowa Intellectual Property Law Association 2005 Annual Meeting, Cedar Rapids, IA, November 2005
- *Online Comparative Advertising*, Iowa Intellectual Property Law Association 2005 Annual Meeting, Cedar Rapids, IA, November 2005
- *Educational Copyright Policies*, AIB College of Business 2005
- *Online Legal Resources for In-house Counsel*, ISBA Corporate Counsel Meeting 2005
- *Avoiding Online Legal Pitfalls*, ASWA, Urbandale, IA, 2005
- *Find it Fast and Free on the Internet*, Lorman Education 2004
- *IT Based Reverse Class Actions*, Iowa Trial Lawyers Seminar 2004
- *Intellectual Property in Cyberspace*,
  - Iowa State Bar Association Annual Meeting, June 2000
  - Highest-rated presenter of the ISBA Annual Meeting
- *Ethics: Iowa Lawyers and Their Websites—Do's and Don'ts*, Iowa Bar Association eCommerce Committee Annual Program, December 2003
- *IT Security Issues: What Can You Do, What Can They Do*, Academy of Private Investigators 2004
- *Online Legal Ethics in Iowa*, Polk County Bar Association CLE November 2003
- *Storytelling Your Way into Federal Court*, Iowa Professional Storytellers, October 2003
- *Who Stole My House?*, Construction Specifications Institute, November 2003
- *IT Legal Issues Affecting Small Business*, Lorman Seminar, November 2003
- *eCommerce Legal Issues*, Quad Cities Computer Society, April 2003
- *Cyberspace and the Law*, Central Iowa Computer Users Group, April 2003
- *Cyber Security and Legal Liability*, Iowa Contingency Planners, Jan. 2003
- *eCommerce Legislative Transformation in Iowa*, Expert Panel Discussion, Development Strategies to Build a Tech-Based Economy Legislative Seminar, January 2003
- *Director and Officer CyberLiability*, Iowa State Bar Association eCommerce Section Annual Seminar, December 2002
- *Cybersecurity Laws*, ITEC Showcase Sponsored by FBI's Infraguard, October 2002
- *Cybersecurity Panel Discussion*, ITEC Showcase Sponsored by FBI's Infraguard, October 2002
- *Ethics Panel Discussion*, Iowa State Bar Association Trade Regulation Annual Seminar, September 2002
- *Information Security Laws*, Iowa State University Information Assurance Center, July 2002
- *Internet Basics for the Iowa Lawyer*, National Business Institute, June 2002.
- *Trademark Law and the Internet*, ISBA Bridge the Gap Seminar, May 2002.
- *Using the Internet to Enhance Your Practice*, Iowa State Bar Corporate Counsel Section, March 2002

- *Protecting Information Technology*, National Business Institute, Feb. 2002.
- *E-Commerce in Iowa*, National Business Institute, Nov. 2001
- *Internet Essentials*, National Business Institute, Dec. 2000
- *Defamation, Privacy and Right of Publicity on the Net*, National Business Institute, Dec. 2000
- *Intellectual Property Issues on the Internet*, National Business Institute, Dec. 2000
- *Employee Privacy in an Online World*, Iowa ICN live statewide broadcast, Jan. 2000
- *Intellectual Property in Cyberspace*, NBI, Dec. 1999
- *Defamation and Right of Publicity on the Net*, NBI, Dec. 1999
- *The Internet: Then, Now and Tomorrow*, NBI, Dec. 1999
- *Online Liability*, Construction Specifications Institute, 1999
- *eLawyering*, Iowa Trade Regulation Seminar, 1998
- *Using the Internet in Your In-house Practice*, ISBA Corporate Counsel Meeting, 1998
- *Intellectual Property*, Iowa Legal Administrators, 1998
- *Copyright Fact and Fiction*, Construction Specifications Institute, 1997