

## Reed R. Heimbecher

Member

### Minneapolis

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### Areas Of Practice

Patent Prosecution  
Trademark  
Portfolio Due Diligence  
Copyright  
Intellectual Property Litigation  
Intellectual Property

### Bar Admissions

Minnesota  
Colorado

### Court Admissions

U.S. Patent and Trademark Office  
U.S. Supreme Court  
U.S. Court of Appeals, Federal Circuit  
U.S. District Court, District of Colorado  
U.S. District Court, Central District of California

### Education

University of California, Hastings  
College of the Law, J.D.

- Editor in Chief, *Hastings Communications & Entertainment Law Journal*
- American Jurisprudence Award, Trial Advocacy II
- 1066 Foundation Scholarship

University of Colorado, B.S., with Honors

- Tau Beta Pi

Reed R. Heimbecher is the Leader of Dykema's Intellectual Property Transactional Practice Group and the Office Managing Member of Dykema's Minneapolis office. He has over 30 years of experience in all aspects of worldwide IP law. His practice currently focuses on patent and trademark prosecution and portfolio management, client counseling, and intellectual property due diligence. He also provides all types of opinions, including patentability, enforceability, availability, noninfringement, and invalidity. Mr. Heimbecher also does agreement work, and he handles appeals before the Patent Trial and Appeal Board.

Prior to joining Dykema, Mr. Heimbecher managed his own firm, which St. Jude Medical (a Fortune 500 company now part of Abbott Laboratories) selected in 2012 as a "Go-To Law Firm for Patent Prosecution" (as recognized by American Lawyer Media). Mr. Heimbecher had previously served for seven years as Vice President, Intellectual Property, and Chief Patent Counsel for St. Jude Medical's Atrial Fibrillation Division. Before his seven-year tenure with St. Jude Medical and before he managed his own firm, Mr. Heimbecher was a partner in the Intellectual Property practice group of a 700+ attorney, international law firm, and was Patent Practice Group head for that firm's Colorado and Montana offices. Mr. Heimbecher clerked for the Hon. Giles S. Rich of the United States Court of Appeals for the Federal Circuit. Judge Rich was one of the primary drafters of the 1952 Patent Act and was often referred to as the "Dean of Patents."

Before attending law school, Mr. Heimbecher worked as an aerospace engineer for a large military contractor, where he carried out performance and aerodynamic analysis, and six-degrees-of-freedom trajectory simulations of Tomahawk cruise missiles and of launch vehicles for putting large payloads into outer space. He held a Department of Defense Secret clearance.

### Experience

Mr. Heimbecher has extensive experience drafting and prosecuting patent applications in the following primary areas: medical devices; designer window coverings; package design and manufacture; Internet and computer software/hardware; business methods; vacuum technology; flight control equipment; sporting equipment; fluid handling systems; automotive mechanical systems; and electronic cigarettes.

Reed R. Heimbecher (Cont.)

- Sigma Gamma Tau
- Merit Scholarship

Mr. Heimbecher also has extensive experience handling reissues, reexaminations, interferences, and appeals including the following sample matters in the U.S. Patent and Trademark Office and in U.S. federal court:

- *Huang v. Colson* (Bd. Pat. App. & Inter.) (representing senior party as lead attorney in an interference concerning honeycomb insulating panels; priority awarded to client following preliminary motion phase)
- *Ex parte Colson & Swiszczy* (Bd. Pat. App. & Inter.) (appealing final rejection of claims; all claims allowed following oral argument)
- *Treated Dredged Material Patents* (USPTO/CRU) (representing patent owner as lead attorney in two *ex parte* reexaminations initiated by a third-party requester; successfully obtained reexamination certificates for two patents at the core of a \$500MM+ lawsuit)
- *First Bank Systems, Inc. v. Frazzel* (D. Colo.) (asserting service mark infringement, dilution, and unfair competition; settled before trial)
- *Arete Corporation v. Laser Products, Inc.* (D. Colo.) (seeking declaratory judgment of patent invalidity, unenforceability, and noninfringement; settled before trial)
- *Hunter Douglas Architectural Products Inc. v. G.J.P Enterprises, Inc.* (D. Md.) (asserting patent infringement; settled before trial)
- *International Communications Manufacturing Corporation v. Capewell Components Company L.P.* (D. Colo.) (defending against patent infringement; settled before trial)
- *MacPike v. American Honda Motor Co., Inc.* (N.D. Fla.) (defending against patent infringement; directed verdict for defendant after jury trial)

## Seminars & Speeches

Innovation Fellows Program of the Medical Device Center at the University of Minnesota, Advisor  
2011-2014

*America Invents Act and Med Tech Innovation*, Moderator, 12th Annual Design of Medical Devices Conference  
April 2013

*Patents and Medical Device Innovation from an In-House Perspective*, Speaker, 11th Annual Design of Medical Devices Conference  
April 2012

*Three-in-Five Competition*, Panel Judge, 11th Annual Design of Medical Devices Conference  
April 2012

*Practical Considerations in Formulating Patentability, Noninfringement and Invalidity Opinions*, Speaker, American Bar Association, Section of Intellectual Property Law  
April and October 2002

*Recent Trends in Patent Prosecution: Software & Business Methods*, Speaker, American Corporate Counsel Association  
September 1999

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## Publications

*FCC Citator (2nd ed.)*, 13 Hastings Comm/Ent L.J. 325 (1991)

*Proposed Prior Art legislation for Computer Program Patent Applications:  
Creating a Potential for Coexisting Patents*, 13 Hastings Comm/Ent. L.J. 57 (1990)

## News

Reed Heimbecher Warns of Patent Promoters in *Bloomberg Law*  
December 5, 2018

Reed Heimbecher Discusses His Vision for Dykema's Minneapolis Office with *Minneapolis Star Tribune*  
February 16, 2018

Reed Heimbecher and Tania Shapiro-Barr Author Article for *Metropolitan Corporate Counsel*  
June 1, 2015

Dykema's Minneapolis Office Profiled in *Minneapolis Star Tribune* Feature  
January 13, 2014

Dykema's Energy Industry Group Announces Creation of Fracking Team  
September 26, 2013

## Memberships & Involvement

Institute for Engineering in Medicine at the University of Minnesota, Industry Advisory Board, Member (3-year appointment commencing in 2012)

Association of Former law Clerks and Technical Advisors of the Court of Appeals for the Federal Circuit

American Intellectual Property Law Association, Member

American Bar Association, Section of Intellectual Property Law, Member

Colorado Bar Association, Intellectual Property Section

## Awards & Recognition

Recognized in *The Best Lawyers In America*® for Patent Law, 2016-Present. Copyright 2015 by Woodward/White, Inc., Aiken, SC

Recipient of an AV® Preeminent™ Rating by *Martindale-Hubbell*