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#### Areas of Law

Corporate and Finance  
Information Technology, Internet  
and E-Commerce  
Intellectual Property and Technology  
Litigation  
Manufacturing  
Patents  
Post-Grant Proceedings  
Technology Transfer and Licensing  
Trademarks, Copyrights and Brand  
Protection  
Data Privacy and Cybersecurity

#### Bar Admissions

Minnesota  
U.S. Patent and Trademark Office  
U.S. District Court, Minnesota

#### Education

William Mitchell College of Law,  
St. Paul, MN; 2001, J.D.

University of Wisconsin, Madison, WI;  
1998, B.S. Industrial Engineering

#### Faculty Appointments

Adjunct Professor,  
University of Minnesota School of Law,  
IP Transactions Pro-Seminar  
(Spring 2016)

#### Professional Associations & Memberships

Minnesota Intellectual Property Law  
Association, board member

#### Community Involvement

Robotics Alley, Advisory Board Member,  
2016-present

Catchwind Pediatric Innovations,  
Advisory Board Member

LegalCORPS, Pro Bono Volunteer

Edina Park Board, Former Chair

## Todd R. Fronек

Todd R. Fronек advises businesses – from small and emerging companies to large, multinational technology corporations. He provides strategic advice to clients in determining the value and importance of intellectual property assets to business objectives. In his practice, Todd routinely develops an integrated approach among investors, engineers, marketers and business executives to analyze, develop and implement effective IP commercialization and protection strategies.

#### Representative Experience:

##### IP Strategy & Portfolio Development

- Drafted, filed and prosecuted hundreds of US, PCT and foreign patent applications in diverse technical areas including medical device, computer hardware and software, optical inspection systems, internet of things, mechanical systems, electrical and electro-mechanical systems.
- Assisted a multinational medical equipment provider in performing a landscape evaluation of patent rights surrounding respiratory therapy systems.
- Represented global medical device company in product design selection, freedom-to-operate opinions and pursuit of competitive advantage.
- Developed internal IP compliance policy documents for training employees about a company's intellectual property vision, policies, procedures and contacts regarding patents, trademarks, copyrights and trade secrets.
- Prepared and filed ex parte reexamination proceedings for an optical inspection equipment manufacturer in support of patent infringement litigation.

##### IP Licensing & Transactions

- Led IP due diligence for client's 25 million dollar acquisition of high performance computing technology.
- Represented an industrial manufacturing company in evaluating rights to patents, trademarks and technical information as part of a joint venture agreement with a US subsidiary of a foreign corporation.
- Drafted and negotiated patent license to window component with a large window manufacturer.
- Represented owner of patented technology related to secure financial payments in licensing campaign to derive value for patent portfolio.
- Drafted assumption of license agreement for acquisition of university patent portfolio.

# Todd R. Fronek

## *Continued*

- Drafted and negotiated license agreement for worldwide portfolio related to athletic equipment.
- Provide strategic advice to investors regarding patent portfolio of medical monitoring software company.

### **Internet, E-commerce and Information Technology**

- Successfully represented trademark owners in UDRP proceedings resulting in the cancellation and transfer of registrations.
- Prepared software developer agreement for cloud services provider.
- Evaluated, drafted and revised terms of use, terms of service, privacy policy documents and DMCA policy documents.
- Reviewed, analyzed and drafted co-location agreements for data center provider.