



## Roger M. Masson

### Senior Counsel

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Roger Masson is an engineer and lawyer with a passion for innovation and helping large and small companies navigate the regulatory maze in order to innovate and thrive. He focuses his practice on intellectual property and craft brewery and distillery law.

Roger handles patent, trade secret, and trademark matters, including arbitration, litigation, opinion, and prosecution work.

**Patent Prosecution:** Roger has written and successfully prosecuted patent applications — in the United States, China, Europe, and Japan — relating to alarm systems, cloud operating systems, data mining, dispensing, food and chemical processing, food products, fraud prevention, night vision, ophthalmic solutions, orthoses, and restaurant equipment.

**Intellectual Property Dispute Resolution:** Roger represents clients in litigation and arbitration involving patents, trade secrets, copyrights, and trademarks, as well as sending and responding to cease-and-desist letters. Disputes have concerned chemical processing equipment, consumer goods, contact lenses, food, golf clubs, insurance, night vision equipment, specialty chemicals, and telephony.

**Intellectual Property Opinions:** Roger advises clients on patent strategies, avoiding infringement and licensing in a wide variety of fields, including artificial intelligence, fine chemicals, food products, nutraceuticals, orthoses, and restaurant equipment.

Prior to joining Hinshaw, Roger was an associate at an intellectual property boutique firm in Chicago.

Before beginning his legal career, Roger was a licensed professional engineer and held environmental and chemical engineering positions at two engineering firms. In those roles, he managed cleanup at a state Superfund site, designed several cleanup systems, and obtained approval to produce two new chemicals from the U.S. Environmental Protection Agency (EPA). During his undergraduate studies, Roger gained technical engineering experience through two co-op programs with one of the largest manufacturers in the United States and one of the world's largest petroleum companies.

### Practices

Copyright  
Environmental  
Intellectual Property  
Patent  
Sustainability & ESG  
Technology  
Trade Secrets  
Trademark  
Transactional Insurance

### Industries

Cannabis

### Education

J.D., DePaul University College of Law, 2004

- Intellectual Property Law Society, Webmaster and Digest Editor, 2002–2003

B.S., Chemical Engineering, Northwestern University, 1991

### Admissions

Illinois

U.S. Court of Appeals for the Federal Circuit

U.S. District Court for the District of Columbia

U.S. District Court for the Northern District of Illinois

U.S. District Court for the Western District of Michigan

U.S. Patent and Trademark Office

### Languages

French



## Representative Matters

### Patent Prosecution

- Established client patent program, including educating potential inventors on patent law and on completing invention disclosure forms for patentability searching and patent filings.
- Successfully prosecuted patents for a natural food product for a Fortune 100 company. Highlights included defeating a post-grant opposition proceeding before the EPO and overcoming rejection by the Venezuelan patent office by writing arguments partially in Spanish, referencing the specific wording of substantive Venezuelan patent law.
- Successfully prosecuted patents in the United States and the European Patent Office (EPO) for a solo inventor, obtaining broad coverage in the material sciences. The EPO successfully overcame a unity of invention rejection, allowing broad coverage to be achieved in a single patent.
- Successfully drafted and prosecuted patents for a user interface for restaurant equipment for a Fortune 150 company in the United States, Australia, Canada, China, and Japan.

### Dispute Resolution

- Successfully had two patent trolls dismiss their software patent lawsuits without any settlement. In the first lawsuit, effectively filed a motion to dismiss based on the asserted patent being abstract. In the second lawsuit, successfully threatened to file a motion to dismiss based on the asserted patent being abstract and a lack of factual allegations of infringement.
- Negotiated a favorable settlement prior to filing an answer, as statutory damages were unavailable to the photographer plaintiff because the client's use of a photo began after the photo was published and before the effective date of the copyright registration.
- As second chair, achieved a multimillion-dollar award for breach of a patent license relating to optics in a complex International Chamber of Commerce arbitration seated in London between an American licensor client and a French defense contractor.
- Discovered massive spoliation of evidence in trade secrets civil litigation relating to fine chemicals. This discovery culminated in the defendant pleading guilty to four criminal counts of unauthorized possession of stolen trade secrets and agreeing to a permanent injunction and a multimillion-dollar judgment for our client.
- Successfully defended a home brew store against a trademark owner's infringement assertions in two cease-and-desist letters.

### Other

- Performed environmental due diligence for the purchase of an American chemical company by a European purchaser and provided guidance to the purchaser for obtaining approval from the Committee on Foreign Investment in the United States and the Directorate of Defense Trade Controls.

## Presentations

- "Patents During a Pandemic," State Bar of Wisconsin's IP Protections Conference, Virtual Event, January 12, 2021
- "Brewery and Distillery Law in Illinois," National Business Institute, Naperville, Illinois, March 21, 2017

## Publications

- "Advertising Law Crash Course for Craft Breweries," *Craft Brewing Business*, August 16, 2017
- "The 'Trump Effect' on IP," *Intellectual Property Magazine*, February 1, 2017