

# Thomas C. McDonough

Partner | Intellectual Property

## OVERVIEW

Tom is a registered patent attorney who develops and protects complex patent, trademark and copyright portfolios maintained by domestic and global businesses. He has significant experience in negotiating and drafting software licenses, patent and trademark licenses and transfers, non-compete and confidentiality agreements, product development agreements, joint venture agreements and all related agreements that include critical intellectual property components. He also regularly performs thorough product clearance searches on behalf of clients. Tom represents clients in all aspects of intellectual property disputes, with an emphasis on patent, trademark, trade dress and copyright infringement litigation.

Tom has extensive experience in the mechanical and electromechanical fields, where he has drafted and prosecuted hundreds of patent applications with a particular focus on hydraulic drive systems, transaxles, pumps, motors and related control systems, differentials and gearing systems, vehicle engines, rail transportation equipment, automotive components and systems, snow throwers, agricultural equipment and kitchen and household products.

Clients appreciate Tom's aptitude for understanding their businesses and goals, and for finding efficient, cost-effective strategies for developing and protecting their intellectual property. His experience in all aspects of intellectual property law enables him to provide a comprehensive understanding of the issues involved in each project.

He is an active volunteer and also serves as a member of the Board of Directors for Lawyers for the Creative Arts, an



**tmcdonough@nge.com**

D. (312) 269-5282

F. (312) 578-4946

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## EDUCATION

University of Wisconsin Law School  
(J.D., 1988), with honor

University of Illinois at Urbana-  
Champaign (B.S., 1985), with honor

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## ADMISSIONS

Illinois

U.S. Patent and Trademark Office

organization that provides pro bono legal services to low income artists and arts organizations.

## EXPERIENCE

- Won summary judgment in a trademark and copyright case for a ball bearing manufacturer in Federal Court in Connecticut. The plaintiff's trademark claims were found to be barred by laches and the allegedly copied materials were found not protectable under copyright. This decision was affirmed by the Second Circuit Court of Appeals.
- Was lead counsel in a successful patent interference proceeding at the Patent Trial and Appeal Board, where the client was able to invalidate a competitor's patent. This victory was affirmed by the Court of Appeals for the Federal Circuit.
- *Pivot Point Int'l Inc. v. Charlene Products, Inc.*, 372 F.3d. 913 (7th Cir. 2005) – represented the plaintiff in one of the leading decisions on the issue of conceptual separability under copyright law where our client's copyright on a mannequin head was upheld.
- Obtained and enforced an *ex parte* seizure with the United States Marshals against an individual creating and distributing counterfeit diamond certification forms.
- Represented the plaintiff in a case involving eight patents on hydraulic pump technology; case was favorably settled.
- Represented a major cell phone manufacturer in a patent case involving camera phones; case was favorably settled.
- Represented a manufacturer as declaratory judgment plaintiff in a patent case involving truck technology. Case was favorably settled after we prevailed on a key claim construction issue.
- Represented a defendant in an eight-day patent trial involving remote control technology, where the plaintiff's patent was held not infringed.
- Represented a major golf club manufacturer in more than 30 cases filed in federal courts around the country alleging trade dress, trademark and patent rights. Obtained various temporary restraining orders, *ex parte* seizure and inspection orders, preliminary and permanent injunctions, and damages in several cases. Worked with U.S. Customs Service to educate agents to prevent importation of counterfeit goods.

## RECOGNITIONS

- *Chambers USA: America's Leading Lawyers for Business*, recommended in "Intellectual Property," 2009-2010



- *The Best Lawyers in America*, recommended in "Trademark Law," 2013
- *The Legal 500 United States*, recommended in "Trademark Litigation" since 2021
- *World Trademark Review 1000*, recommended in "Trademark Prosecution and Strategy" since 2022
- *Intellectual Asset Management's (IAM) Patent 1000* in Prosecution since 2023

## NEWS & INSIGHTS

**May 30, 2025 Firm News**

*IAM Patent 1000* Recognizes Four Intellectual Property Attorneys

**January 31, 2025 Firm News**

*World Trademark Review 1000* Ranks Six Neal Gerber Eisenberg Attorneys

**August 15, 2024 Firm News**

60 Neal Gerber Eisenberg Attorneys Included in 2025 *Best Lawyers In America*

**June 7, 2024 Firm News**

Four Intellectual Property Attorneys Recognized in *IAM Patent 1000*

**February 8, 2024 Firm News**

Neal Gerber Eisenberg Intellectual Property Practice Places Six Attorneys in *World Trademark Review 1000*

**August 17, 2023 Firm News**

55 Neal Gerber Eisenberg Attorneys Included in 2024 *Best Lawyers In America*

**June 29, 2023 Firm News**

Neal Gerber Eisenberg Intellectual Property Practice Places Four Attorneys in *IAM Patent 1000*

**June 12, 2023 Firm News**

The Legal 500 United States 2023 Edition Recommends Four Neal Gerber Eisenberg Practices and 23 Attorneys

**02.13.2023 Firm News**

Neal Gerber Eisenberg Intellectual Property Practice Places Five Attorneys in *World Trademark Review 1000*

**October 25, 2022 Firm News**

NGE Advises National Medical Billing Services in Its Acquisition of MedTek, LLC

**August 19, 2022 Firm News**

NGE Advises Upfront Healthcare in Its Acquisition of PatientBond

**August 18, 2022 Firm News**

60 Neal Gerber Eisenberg Attorneys Included in 2023 *Best Lawyers*

**June 10, 2022 Firm News**

The Legal 500 United States 2022 Edition Recommends Four Neal Gerber Eisenberg Practices and 19 Attorneys

**February 28, 2022 Firm News**

Neal Gerber Eisenberg Intellectual Property Practice Places Four Attorneys in *World Trademark Review 1000*



**October 15, 2021 Firm News**

NGE Represents Savencia Fromage & Dairy in Acquisition of Hope Foods

**August 18, 2021 Firm News**

52 Neal Gerber Eisenberg Attorneys Included in 2022 Best Lawyers

**June 10, 2021 Firm News**

The Legal 500 United States 2021 Edition Recommends Four Neal Gerber Eisenberg Practices and 15 Attorneys

**February 15, 2021 Firm News**

Neal Gerber Eisenberg Intellectual Property Practice Once Again Earns Gold Band Status in *World Trademark Review 1000*

**August 19, 2020 Firm News**

46 Neal Gerber Eisenberg Attorneys Included in 2021 Best Lawyers

**June 3, 2020 Publication**

Update: USPTO Trademark Relief Under the CARES Act

**April 30, 2020 Publication**

USPTO Trademark Deadline Extensions Under the CARES Act

**August 15, 2019 Firm News**

45 Neal Gerber Eisenberg Attorneys Included in 2020 Best Lawyers

**August 15, 2018 Firm News**

45 Neal Gerber Eisenberg Attorneys Included in 2019 Best Lawyers

**August 1, 2018 Publication**

Client Alert: Supreme Court Removes Good Faith Belief of Patent Invalidity as Defense to Induced Patent Infringement

**August 1, 2018 Publication**

Client Alert: Supreme Court Affirms that a Patent Holder Cannot Charge Royalties for Post-Expiration Use of the Invention

**July 9, 2018 Firm News**

46 Neal Gerber Eisenberg Attorneys Included in 2016 Best Lawyers

**July 9, 2018 Firm News**

Firm Represents Fonterra Co-operative Group in Sale of Interest in DairyConcepts

**July 9, 2018 Firm News**

45 Neal Gerber Eisenberg Attorneys Included in 2017 Best Lawyers

**July 6, 2018 Firm News**

44 Neal Gerber Eisenberg Attorneys Included in 2018 Best Lawyers

**June 27, 2018 Event**

Patent Claim Drafting