

## **WILLIAM J. JACOB, P.E.,J.D.**

5008 Walnut St., Kansas City, MO 64112

Phone: (816) 204-6430

Email: [wjj@jacoblbc.com](mailto:wjj@jacoblbc.com)

Citizenship: United States

### **LEGAL EXPERIENCE**

#### **Jacob & Associates, LLC (SLJ, LLC) Kansas City, MO (state law practice only)**

*Member, 1/04 – Present*

- Litigation Support Counsel – Langdon & Emison
- Outside Patent Counsel for General Motors Corporation (2004-2012)
- Prepare patent applications in the complex mechanical, light electrical/network arts; Draft patentability and infringement opinions. Have prepared/prosecuted *over 100 patent applications* (see attached list of exemplary publications).
- Provide legal advice regarding start-up formation and protection of intellectual property.
- Commercial contracts review and drafting: mergers/acquisition, business formation, UCC sales agreement.
- Draft intellectual property licensing agreements, nondisclosure/confidentiality agreements.
- Counsel clients regarding copyright, trademark, unfair competition and trade secret matters.
- Prepare copyright and trademark registrations.
- General Litigation in federal and state court matters.

#### **Hovey Williams LLP, Kansas City, MO**

*Patent Prosecution Associate, 1/03 – 12/03*

- Prepared patent applications in the complex mechanical arts.
- Responded to various types of office actions.
- Drafted patentability and infringement opinions, and cease and desist letters.
- Agency appellate practice: prepared appeal brief.
- Provided patent litigation support.

#### **Husch & Eppenberger, LLC, Kansas City, MO**

*Litigation Associate, 8/01- 11/02*

*Summer Associate, Summers of 1999 and 2000*

- Drafted pleadings in state and federal court on employment and construction matters.
- Took and defended depositions of plaintiffs, and third parties.
- Prepared and argued motions, and second chaired a trial.
- Commercial/ Construction contracts review and drafting.
- 50 state survey: False Claims Act

### **ENGINEERING EXPERIENCE**

#### **City of Kansas City, Missouri, Public Works Department, Kansas City, MO**

*Professional Engineer, 1/94 - 8/98*

- Managed projects including bridges, developments.
- Reviewed development plans, including street, storm and sanitary sewers, and grading design, maintaining a docket of over 100 pending projects.
- Performed public works estimates/analysis.
- Performed construction inspection of developments, street, storm and sanitary sewers, bridges, grading and sewage treatment facilities.

## **LICENSES**

Law: United States Patent & Trademark Office (10/01) – Registration No. 51,173; Missouri (9/19/01) – License No. 51115; Kansas (4/02) – License No. 20517 (inactive); Maryland (6/16)

P.E.: Missouri (8/97) – License No. EN 028675 (active); Texas (7/99) – License No. 86734 (inactive)

## **EDUCATION**

**University of Missouri, Kansas City**, Kansas City, Missouri  
JD, May 2001

Intellectual Property Law Society, Environmental Law Society, Fredrick Douglas Moot Court regional quarter-finalist (2000, 2001), Deans List (Spring 2000, Fall 2001), China abroad program (Summer 2001).

**University of Missouri, Columbia**, Kansas City, Missouri  
M.S. Civil/Structural Engineering (*G.P.A.* 3.3), May 1997

**Northwestern University**, Evanston, Illinois  
B.S. Mechanical Engineering, June 1993: Varsity Baseball, Airforce Type I Scholarship, ASME

## **ADDITIONAL COURSE WORK**

**CCNA Certification Training:** Metropolitan Community College - Kansas City; 2013 - present

- 1) CSIS 113 - *Routing Protocols and Concepts CCNA Exploration 2* (4 credits):  
Course focused on "routing and routing protocols," developed "an understanding of how a router learns about remote networks and determines the best path to those networks." This course included both static routing and dynamic routing protocols;
- 2) CSIS 213 - *Accessing the WAN CCNA Exploration 4* (4 credits):  
Course focused on WAN technologies and network services required by converged applications in enterprise networks, utilizing Cisco Network Architecture to introduce integrated network services. Explains how to select the appropriate devices and technologies to meet network requirements, how to implement and configure common data link protocols, and how to apply WAN security concepts, principals of traffic, access control, and addressing services.

*Automotive Electrical Systems*, Auto 166, Longview Community College (6 cr), Kansas City, MO, Fall 2005: Course focused on theory, construction, and repair of modern automotive electrical systems. Operational theory, testing and repair of batteries, charging systems, starting systems, lighting systems, wiring and accessories was stressed.

*Ross T. Roberts Trial Academy*, KCMBA, 2012-2013

*Principals of Mechanical Systems Design*, HVAC 111, Business & Technology Community College (3 cr), Kansas City, MO, Summer 2005;

## **TEACHING/OTHER ENGAGEMENTS:**

Chair, Missouri Bar, Patent, Trademark, & Copyright Law Committee (2014-2015)

Instructor, *Intellectual Property Law*, Penn Valley Community College, Paralegal Program, Spring Semester 2005

Missouri Supreme Court Disciplinary Committee – Region IV, *Chairman* 2013-14, committee member

01/08 – 01/13

Missouri Young Lawyers Council (1/06-01/09)

Board of Directors/President, UMKC, School of Interdisciplinary Computing and Engineering Alumni

Volunteer Staff – Sheffield Family Life Center, Kansas City, Missouri

**PUBLICATIONS/ SPEAKING ENGAGEMENTS:**

“*Engineering & the Law*,” Kansas State University School of Engineering, Multicultural Engineering Program, February 2003 (presenter);

“*Increased Access to Corporate Constituents Under New Model Rule 4.2*,” The Professional Lawyer, American Bar Association, Winter 2003 (author);

“*Engineering & the Law*,” University of Missouri at Kansas City, School of Computer Science and Engineering, February 2004 (presenter);

“*Professional Ethics before the United States Patent & Trademark Office: A Discussion for New Practitioners*,” The Professional Lawyer, American Bar Association, Spring 2005 (author);

“*Professional Ethics before the United States Patent & Trademark Office*,” Complex Intellectual Property Licensing conference, Law Seminars International (LSI), Chicago, IL, April 6-7, 2006 (presenter); and

“*Ethics in Patent and Trademark Practice*,” Kansas City Metropolitan Bar Association, Continuing Legal Education, Kansas City, MO, June 30, 2005.

“*Master Series: Trade Secrets: Keeping Secrets & Protecting Confidential Information*,” MoBarCLE, May 5, 2015 (presenter)

*Angel Fish*, Zharme Publishing, June 2016 (a sci-fi novel)

**REFERENCES/ TESTIMONIALS:**

Alan L. Browne  
GM Technical Fellow  
Vehicle Systems Research Laboratory  
General Motors Research & Development  
Phone: (586) 651-2938  
Email: alan.l.browne@yahoo.com.  
Inventor relationship: 2007 - 2013  
Testimonial: “. . . you consistently turn out documents of the highest quality.”

Dr. Irwin N. Boe, DDS,  
Shawnee Dental, Owner  
14442 Chadwick St.

Leawood, KS 66224  
Phone (913) 962-4400  
Inventor relationship: 2009 – present

Helen L. Betts  
T.Y.L. Innovations, LLC  
Phone: 913.563.0333  
Inventor relationship: 2014 – present  
Testimonial: “. . . you exceeded my expectations!!!”

Honorable Kenneth R. Garrett  
Circuit Judge, Division 2

Jackson County Courthouse  
415 E. 12th St.  
Kansas City, MO 64106  
(816) 881-3685

Mark Emison  
Langdon & Emison  
911 Main St.  
Lexington, MO 64067  
Mark@lelaw.com

Bruce Rooney  
USA Manufacturing Co  
35704 Metcalf Rd.  
Louisburg, Kansas 66053  
Office: 913-980-2852

Testimonial: *"Thank you for always addressing our patenting needs in a prompt and courteous manner."*

**EXEMPLARY LIST OF PATENT PUBLICATIONS:**

2012/0318605 ADJUSTABLY ATTENUATING EAR PLUG

2012/0258426 DENTAL PROSTHETIC DEVICE WITH REMOLDABLE BASE  
(PCT/US2013/026551)

2010/0106867 REMOTE CONTROL DEVICE COMMUNICATION THROUGH TRANSLATION  
INTO HID PACKETS

2009/0047197 ACTIVE MATERIAL BASED BODIES FOR VARYING SURFACE TEXTURE AND  
FRICTIONAL FORCE LEVELS

2008/0059476 METHOD FOR PROTECTING USER PRIVACY IN SHORT RANGE  
COMMUNICATION

2007/0273608 ANISOTROPIC FREQUENCY SELECTIVE GROUND PLANE FOR ORTHOGONAL  
PATTERN CONTROL OF WINDSHIELD ANTENNA

2007/0043489 SYSTEM AND METHOD FOR CONTROLLING ACCESS TO MOBILE DEVICES

2006/0215032 NETWORK-BASED BROADCAST SYSTEM AND METHOD

D672041 TONGUE CLEANER

D652143 MULTI-LAYER INTERNAL NASAL DILATOR WITH TUBULAR EXPANDERS  
AND COMPOUND DELIVERY PROTRUSIONS

D567298 SEPTEMBER 11, 2001 COMMEMORATIVE CHESS SET

8789314 ACTIVE SEAL ARCHITECTURES

8766564 METHOD OF REDUCING THE EFFECT OF PREHEAT TIME VARIATION  
DURING SHAPE MEMORY ALLOY ACTUATION

8754740 CIRCUIT IMPLEMENT UTILIZING ACTIVE MATERIAL ACTUATION

8720652 BRAKE RETRACTION UTILIZING ACTIVE MATERIAL ACTUATION

8687340 ACTUATION AND PROTECTION UTILIZING ACTIVE MATERIAL ACTIVATION  
DURING LIGHTNING STRIKES AND SIMILAR EVENTS

8607744 ACTIVE AIR VENT UTILIZING SMART MATERIAL ACTUATION

8656713 ACTIVE MATERIAL-BASED IMPULSE ACTUATORS

8592733 INDUCTION WELD ASSEMBLY OF CLOSURE PANELS

8572895 RECEIVER/EMITTER COVER UTILIZING ACTIVE MATERIAL ACTUATION

8550519 MECHANICAL GRIPPERS UTILIZING ACTIVE MATERIAL ACTIVATION

8491622 MULTI-LAYER INTERNAL NASAL DILATOR WITH TUBULAR EXPANDERS  
AND COMPOUND DELIVERY PROTRUSIONS

8485581 ACTIVE MATERIAL BASED HOLDING FIXTURES

8484790 EXHAUST GAS RECIRCULATION COOLER CLEANER HAVING ACTIVE MATERIAL ACTUATOR

8465065 ACTIVE MATERIAL ENABLED SELF-PRESENTING HANDLES

8459696 DEPLOYABLE PROTECTION SYSTEM FOR VEHICLES WITH OVERHEAD GLASS

8446065 TUBULAR ACTUATORS UTILIZING ACTIVE MATERIAL ACTIVATION

8427429 ACTIVE INTERFACE CONTROLS HAVING BI-STABLE ACTUATION AND INTRINSIC SENSING CAPABILITY

8414366 ACTIVE MATERIAL ENABLED PRESSURE RELEASE VALVES AND METHODS OF USE

8393895 TRANSVERSE OVEN AND METHOD OF BAKING WORKPIECES

8390305 METHODS OF DETERMINING MID-STROKE POSITIONS OF ACTIVE MATERIAL ACTUATED LOADS

8388773 APPARATUS FOR AND METHOD OF CONDITIONING SHAPE MEMORY ALLOY WIRE

8382192 REVERSIBLY DEPLOYABLE SPOILER

8355852 SLOW OR STOPPED VEHICLE AHEAD ADVISOR WITH DIGITAL MAP INTEGRATION

8344868 MAINTENANCE OF PROPER TIRE INFLATION PRESSURE THRU ACTIVE MATERIAL ACTUATION

8340889 SYSTEM AND METHOD FOR AGGREGATING PROBE VEHICLE DATA

8336912 SYSTEMS FOR AND METHODS OF FACILITATING A LATERAL MANEUVER BY A VEHICLE

8281585 CONTROLLING HEAT TRANSFER IN ACTIVE MATERIAL ACTUATORS USING EXTERNAL ELEMENTS

8272214 SHAPE MEMORY ALLOY CABLES

8262133 BELT RETRACTOR UTILIZING ACTIVE MATERIAL ACTUATION

8261892 CUSTOMIZABLE STRUT ASSEMBLIES AND ARTICLES THAT EMPLOY THE SAME

8256829 ACTIVE MATERIAL INSERTS FOR USE WITH HOLLOW STRUCTURES

8240677 ACTIVE MATERIAL BASED SEAL ASSEMBLIES

8220301 TOOL FOR AND METHOD OF FORMING A TAPPED HOLE IN A SINGLE PASS

8201850 ADJUSTABLE BELT TENSIONING UTILIZING ACTIVE MATERIAL ACTUATION

8192336 COMPRESSIVE DEVICE AND CARRYING COMPARTMENT FOR USE DURING EXERCISE

8188844 RECONFIGURABLE TACTILE INTERFACE UTILIZING ACTIVE MATERIAL ACTUATION

8188757 METHOD OF CONTROLLING A SHAPE MEMORY ALLOY ACTUATOR UTILIZING RESISTANCE CHANGE

8179018 ACTIVE MATERIAL ACTUATOR REGULATION UTILIZING PIEZOELECTRIC AND PIEZORESISTIVE EFFECT

8112219 SYSTEM FOR AND METHOD OF MONITORING REAL TIME TRAFFIC CONDITIONS USING PROBE VEHICLES

8111147 LANE DEPARTURE WARNING AND CHANGE ASSIST SYSTEM UTILIZING ACTIVE MATERIALS

8109567 ACTIVE MATERIAL ACTUATED HEADREST UTILIZING BAR LINKAGE DEPLOYMENT SYSTEM

8109318 METHODS OF DEPLOYING A COVER UTILIZING ACTIVE MATERIAL AND AN EXTERNAL HEAT SOURCE

8109219 ADJUSTABLE THREADING UTENSIL AND STRUCTURE UTILIZING SHAPE MEMORY ACTUATION

8109087 OVERHEATING PROTECTION FOR SHAPE MEMORY ALLOY ACTUATORS

8109042 METHODS FOR VARYING SEAL FORCE IN ACTIVE SEAL ASSEMBLIES FOR DOORS

8104793 PYROTECHNIC TRIGGERING OF THERMALLY ACTIVATED SHAPE MEMORY MATERIALS FOR SELECTIVELY CHANGING A STRUCTURAL AND/OR MECHANICAL PROPERTY OF A VEHICLE MEMBER

8104278 ENERGY HARVESTING, STORING, AND CONVERSION UTILIZING SHAPE MEMORY ACTIVATION

8100471 ADJUSTABLE SEAT RAMP UTILIZING ACTIVE MATERIAL ACTUATION

8061550 RECONFURABLE STORAGE BINS HAVING A STRUCTURAL COMPONENT FORMED OF A SHAPE MEMORY MATERIAL

8056961 PEDESTRIAN IMPACT MITIGATION SYSTEM AND METHOD OF USE

8052112 FORE-AFT POSITION ADJUSTER UTILIZING ACTIVE MATERIAL ACTUATION

8042833 STEERING WHEEL RELEASE/STROKING USING ACTIVE MATERIAL ACTUATION

8030624 PHOTOLUMINESCENT COATING FOR VEHICLES

8025339 ACTIVE MATERIAL BASED SEATBELT WEBBING PRESENTER

8015404 SYSTEM AND METHOD FOR COLLECTING TRAFFIC DATA USING PROBE VEHICLES

7984746 COVER DEPLOYING SYSTEM UTILIZING ACTIVE MATERIAL ACTUATION

7967339 ACTIVE MATERIAL BASED SAFETY BELT BUCKLE PRESENTER

7950488 HOOD ASSEMBLY UTILIZING ACTIVE MATERIALS BASED MECHANISMS

7931337 RECLINER RELEASE ACTUATION THROUGH ACTIVE MATERIALS

7909403 MANIPULABLE SEAT BOLSTER UTILIZING ACTIVE MATERIAL ACTUATION

7905547 MANIPULABLE LUMBAR SUPPORT UTILIZING ACTIVE MATERIAL ACTUATION

7884341 MODULAR HEADREST AND MULTI-LIGHT APPARATUS

7882833 PERIPHERY VIEW MASK AND REMOTE BREATHING ASSEMBLY

7854467 AIRFLOW CONTROL DEVICES BASED ON ACTIVE MATERIALS

7845648 DISCRETE ACTIVE SEAL ASSEMBLIES

7823972 RECLINER ADJUSTMENT UTILIZING ACTIVE MATERIAL SENSORS

7815233 DOOR CLOSURE ASSIST ASSEMBLIES

7787488 SYSTEM AND METHOD OF OPTIMIZING THE STATIC SEGMENT SCHEDULE AND CYCLE LENGTH OF A TIME TRIGGERED COMMUNICATION PROTOCOL

7775583 FORCE AND DECELERATION DELIMITING DEVICES AND METHODS FOR OPERATING THE SAME

7775582 PIVOTALLY DEPLOYABLE AIR DAM UTILIZING ACTIVE MATERIAL ACTUATION

7758121 ACTIVE MATERIAL BASED CONFORMABLE AND RECONFIGURABLE SEATS

7758092 COVER HAVING COLLAPSIBLE STORAGE BINS

7739036 SPEED LIMIT ADVISOR

7714736 ADAPTIVE FILTER ALGORITHM FOR PREDICTING BATTERY LIFE

7714701 ACTIVE MATERIAL BASED HAPTIC ALERT SYSTEM



7706963 SYSTEM AND METHOD OF UPDATING TRAFFIC DATA USING PROBE VEHICLES HAVING EXTERIOR SENSORS

7694803 BRAKING CONVEYOR SYSTEM

7686120 HOOD LIFT MECHANISMS UTILZING ACTIVE MATERIALS AND METHODS OF USE

7655170 ADJUSTABLE SHIMS AND WASHERS

7638921 ACTIVE MATERIAL NODE BASED RECONFIGURABLE STRUCTURES

7637559 VOLUME-FILLING MECHANICAL ASSEMBLIES AND METHODS OF OPERATING THE SAME

7628116 SHAPE MEMORY POLYMER TEMPERATURE SENSING DEVICES AND METHODS OF USE

7594697 ACTIVE MATERIAL ACTUATED HEADREST ASSEMBLIES

7587805 RECONFIGUARABLE FIXTURE DEVICE AND METHODS OF USE

7556117 HOOD LIFT MECHANISMS UTILIZING ACTIVE MATERIALS AND METHODS OF USE

7555833 SYSTEM AND METHOD FOR PROGRAMMABLE POGO SELFPIERCING RIVETING

7548551 SYSTEM AND METHOD OF OPTIMIZING THE BANDWIDTH OF A TIME TRIGGERED COMMUNICATION PROTOCOL WITH HOMOGENEOUS SLOT SIZES

7546754 METHOD OF FABRICATING TUBULAR STRUCTURE FROM HYBRID MATERIAL

7546182 INTERVEHICULAR AD HOC ROUTING PROTOCOL AND COMMUNICATION SYSTEM

7546146 CONTROL SYSTEM AND METHOD FOR DIVERSITY ANTENNA SYSTEM

7498926 REVERSIBLY OPENING AND CLOSING A GRILLE USING ACTIVE MATERIALS

7234463 PERIPHERY VIEW GOGGLE AND REMOTE BREATHING ASSEMBLY