

James M. Hinshaw

Partner



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Indianapolis

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Overview

James M. Hinshaw is a member of Dentons' Litigation and Dispute Resolution group where he litigates complex business disputes, with an emphasis on intellectual property disputes. He has been repeatedly recognized over the years in *Benchmark Litigation*, *Best Lawyers* and *Indiana Super Lawyers* for his strong and effective work as an advocate in business litigation and intellectual property matters.

James' litigation experience covers a variety of intellectual property disputes, including patent infringement, trademark infringement, copyright infringement, trade dress infringement, trade secret misappropriation, breach of licensing agreements and misappropriation of rights of publicity. Outside of the intellectual property fields, his experience covers matters including disputes over complex real estate transactions, zoning matters, environmental contamination claims, unfair competition claims, false advertising claims, products liability, data security breaches, retail operations and breach of contract claims.

James' litigation experience includes jury trials, bench trials, arbitrations, mediations and appeals. This experience not only helps him in asserting his clients' position in the courtroom, but also helps his clients in the boardroom – to avoid litigation where possible, to reduce the cost of litigation where they can and to make insightful and informed decisions throughout the progress of the case. James works directly with his clients to make sure that the litigation strategies being developed and executed match with the client's desired objectives.

James serves as co-chair of the Firm's Litigation department for the Indiana, Kentucky and Ohio offices.

Experience

Representative Cases/Experience

Intellectual Property

- Represented the estate of a famous photographer who had been commissioned by Marilyn Monroe to take a series of some of her iconic photographs (e.g., the windblown dress while standing over the subway air vents). The photographer's estate was sued for misappropriation of rights of publicity by a publicity-licensing

agency who claimed, in error, that it had acquired the rights to such through probate.

- Represented nationwide college sports association in asserting claims against global beer company for misappropriation of trademarks, inducement of license violations and inducement of trespass in conducting an unauthorized sweepstakes ticket promotion. Achieved judgment for injunction and award of damages in favor of client.
- Represented a large distribution company and its subsidiary in defending against claims for trademark infringement and copyright infringement in the novelty products industry (e.g., cigarette lighters emblazoned with an image of stylized flames), and presenting counterclaims for malicious prosecution, abuse of process and antitrust violations. Achieved complete dismissal of claims for over \$12 million in damages and obtained show cause order for payment of all our clients' attorneys' fees incurred across nearly three years of intense litigation.
- Represented pet products manufacturing company against claims that it had infringed the design patents held by a competitor. After claim construction and summary judgment proceedings demonstrating invalidity and noninfringement of the asserted patents, the case was favorably resolved by agreement.
- Represented global transmissions re-manufacturer against claims that it and its business partner, the US Postal Service, had infringed device and method patents held by an inventor. The patents related to converting a transmission shift system from a left-side-driver vehicle to a right-side-driver vehicle. After claim construction proceedings laid the foundation for summary judgment proceedings to demonstrate invalidity and noninfringement of the asserted patents, and discovery demonstrated a strong on-sale defense, the case was favorably resolved by agreement.
- Represented a pharmaceutical company as co-counsel against claims of patent infringement for its ANDA application for medicine relating to treatments for men experiencing low testosterone, and for medical devices relating to the application of such medicine. Defenses of non-infringement, invalidity and indefiniteness were presented. After a two-week bench trial, judgment was entered in favor of our client and affirmed on appeal.
- Represented entrepreneur and developer in the 3D printing industry who developed a polymer to be used in providing certain water-soluble support structures in the 3D printing process. After successfully obtaining a patent related to such, he was sued for trade secret misappropriation and breach of contract by the company who provided the base materials and lab services for the newly developed polymer - despite their having signed an agreement that recognized that our client maintained all ownership rights in the new polymer, including any patent rights. The plaintiff sought over \$10 million in damages and an assignment of the patent. We obtained summary judgment for our client, which was then affirmed after hearing on appeal.

Environmental

- Represented national utility company against claims that a subsidiary our client had acquired somehow caused or contributed TCE contamination to an industrial site where it had operated decades ago and which had since had numerous intervening owners/operators who had used TCE at this site.
- Represented large bus manufacturing company against claims it had contributed or caused contamination to an industrial site. After demonstrating that the claims were premised on mistaken corporate identity and that our client had never in fact owned or operated at the site, both the state agency and the private parties dropped their claims against our client.
- Represented large pharmaceutical company that owned and maintained a wastewater treatment pond at its plant site that contained PCBs. After a 100-year flood eroded the embankments of that pond, pond sediments were then allegedly released and deposited into a nearby creek and at numerous properties located downstream.

Breach of Contract

- Represented large distribution company against claims relating to competitor's claims that client was contractually obligated to produce certain sales and customer information. Achieved judgment in favor of

client after bench trial.

- Represented a company whose principals had acquired a bulk mail bundling business from the plaintiff-seller. The company and its new owners were accused of breach of contract and fraud for alleged improper accounting and payouts in the earn-out phase of the post-closing transition. While the claims exceeded \$2 million, after arbitration an award of only \$8,000 was awarded.
- Represented a Toronto-based commercial design firm who served as the manufacturer representative for a large furniture company in the United States. After our client successfully procured a contract valued at over \$25 million for a national Canadian bank to refurbish all its branches with newly designed furniture, the manufacturer terminated our client and refused to pay the commissions owed. After a 10-day jury trial in federal court, a verdict against the manufacturer was obtained for the commissions owed to our client, plus interest. The case was then settled favorably on appeal.

Data Security Breach

- Represented nationally recognized casino and resort operator against a class-action lawsuit seeking damages for a data security breach whereby hackers obtained resort guests' credit card information. Obtained complete dismissal of the lawsuit through a Motion to Dismiss.

Products Liability

- Represented steel blast furnace owner/operator against product liability and negligence claims when contractor broke his back in a 20-foot fall while demolishing portions of a blast furnace that had experienced a severe "blow out" event. Obtained summary judgment in favor of the blast furnace company.

Personal Injury

- Represented the CEO of a major company owning and operating multiple radio broadcasting stations throughout the nation. The CEO was sued because of injuries that occurred when the plaintiff fell off of a polo horse he was "test driving" that was owned by the client – after exaggerating his experience level in handling such highly trained horses and voicing no concern over using the English tack provided for the ride. We obtained a complete verdict in favor of the client after a five-day jury trial.

Real Estate

- Represented privately owned nature preserve that sought rezoning approval for a small sliver of its land that was immediately adjacent to a highly developed retail commercial zone, to generate funds needed to continue operating its nature preserve. The city council approved the rezoning (PUD), but the mayor vetoed the ordinance allowing for such. After we filed summary judgment, argued our client's position at hearing and received the court's "guidance" on how it intended to rule, the mayor conceded, withdrew the veto and agreed to allow the rezoning to proceed.
- Represented national retail convenience store/pharmacy, and its commercial real estate agent, against claims presented by a speculative real estate developer for tortious interference with his options contract to acquire a parcel of property, trade secret misappropriation and unjust enrichment.

Recognition

News

- 77 Attorneys Across All Six Bingham Greenebaum Doll Offices Named to 2020 Edition of Best Lawyers in America©

- 26 Bingham Greenebaum Doll Lawyers Named to 2019 Indiana Super Lawyers® Lists
- 21 Bingham Greenebaum Doll Lawyers Recognized by Benchmark Litigation® 2019
- Eight Bingham Greenebaum Doll Lawyers Named "Lawyers of the Year" in the 25th Edition of The Best Lawyers in America©
- 13 Bingham Greenebaum Doll Lawyers Recognized by Benchmark Litigation® 2018
- Eleven Bingham Greenebaum Doll Lawyers Named 2018 "Lawyers of the Year" in the 24th Edition of The Best Lawyers in America©
- 27 Bingham Greenebaum Doll Lawyers named to 2017 Indiana Super Lawyers List
- Latest USLAW Retail And Hospitality Compendium Features BGD Summations

Honors and Awards

- Selected for inclusion in *Indiana Super Lawyers*® in the field of Business Litigation, 2007-2009 and 2014-2020
- Recognized as an Indianapolis Bar Foundation Distinguished Fellow, 2018
- Recognized as a "Local Litigation Star," Intellectual Property, *Benchmark Litigation*, 2015-2016 and 2018
- Selected for inclusion in *The Best Lawyers in America*®, 2015-2020, in the field of Commercial Litigation, Litigation - Intellectual Property and Litigation - Real Estate
- Indiana Law Journal
- Order of the Coif
- Indianapolis Bar Association, Pro Bono Attorney of the Year Award, 1997
- Ardath Burkhardt Board Leadership Series, 1998-1999

In the Media

- "Willful wrong? SCOTUS to resolve circuit split on profits," *Indiana Lawyer*, December 11, 2019
- "NDA Doesn't Bar Info From 3D Printer's Patent App: 7th Circ.," *Law360*, October 3, 2018

Insights

- Co-Author, Indiana Chapter, USLAW Retail Compendium of Law, 2014 - Present
- Chapters: Underground Storage Tanks, RCRA Generator Requirements, Environmental Crimes, and Stratospheric Ozone Depletion Regulations; *Indiana Chamber of Commerce Environmental Handbook*, Summer 1994, updated November 1996
- Commercial Litigation in Indiana; *Law Practice Handbooks, Inc.*, Chapter on Discovery, Fall 1995
- "The Dormant Commerce Clause After Garcia: An Application to the Interstate Commerce of Sanitary Landfill Space;" 67 *Indiana Law Journal* 511, 1991

Activities and Affiliations

- USLAW Network, Inc. (Primary Contact)

- American Intellectual Property Law Association
- Indianapolis, Indiana State, and American Bar Associations, Litigation and Intellectual Property Sections
- Seventh Circuit Bar Association
- Defense Trial Counsel of Indiana

Presentations

- Moderator and presenter, USLAW, "Hot Topics in Business Litigation," 2009
- Moderator and presenter, ICLEF, "Masters of Litigation," 2009
- Moderator and presenter, USLAW, "Trademark Infringement and Internet Domain Names," 2008
- Contributing author, ICLEF, "Vignettes of Legal Ethics," 2005
- Author and speaker, ICLEF, "2004 Year in Review - Intellectual Property Litigation," 2004
- Author and speaker, ICLEF, "State and Federal Procedure," 2004
- Author and speaker, ICLEF, "Rule 4.2 and Ex Parte Communication with Former Employees," 2001
- Chair and presenter, ICLEF, "Business Litigation," 2001

Memberships

- Heroes Foundation (cancer research), 2020-present
- Sigma Nu (Beta Beta) Housing Corporation, 1997-present
- Lawrence Township School Foundation, 2007-2011
- Marion County Commission on Youth (MCCOY), 1995-2007
- DePauw University Board of Fraternal Affairs, 1997-2000

Areas of focus

Practices

- E-Discovery
- Venture Technology and Emerging Growth Companies
- Commercial Litigation
- Alternative Dispute Resolution (ADR)
- Privacy and Cybersecurity
- Professional Liability Litigation
- Environmental Litigation
- Intellectual Property and Technology
- Copyright
- Intellectual Property Litigation

- Technology Procurement, Development and Licensing
- Patents
- Trademarks
- Employment Disputes
- Labor Relations and Collective Labor Law Negotiation with Unions and Employee Representatives
- Unfair Competition
- Real Estate Litigation and Dispute Resolution
- Franchising and Distribution
- Real Estate

Industry sectors

- Professional Liability
- Media, Entertainment and Sports
- Manufacturing
- Consumer Products
- Financial Institutions
- Hotels and Leisure
- Insurance
- Life Sciences and Health Care
- Technology

Education

- Indiana University Maurer School of Law, 1992, JD, *magna cum laude*, Order of the Coif
- DePauw University, 1989, BA (Economics), *magna cum laude*

Admissions and qualifications

- Indiana
- US Court of Appeals for the Eleventh Circuit
- US Court of Appeals for the Ninth Circuit
- US Court of Appeals for the Seventh Circuit
- US Court of Federal Claims
- US District Court for the Eastern District of Michigan
- US District Court for the Northern District of Indiana
- US District Court for the Southern District of Indiana