



## George R. McGuire

### Member

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### Profile

**George is a registered patent attorney and chair of the firm's intellectual property and technology practice.**

He concentrates his practice in all facets of intellectual property law, including, for example, patent and trademark preparation and prosecution, litigation involving intellectual property issues, patent and trademark clearance opinions, patent novelty, validity and (non)infringement opinions, due diligence investigations in merger and acquisition, asset purchase, or other financial transactions, proceedings before the Patent Trial and Appeal Board and the Trademark Trial and Appeal Board, negotiating and drafting technology transfer and license agreements, and internet and computer law matters.

George practiced for five years as a patent agent before receiving his law degree.

In addition to his practice, George is also an adjunct professor at Syracuse University College of Law where he has been teaching a course on Internet Law since 2004, and prior to that taught and lectured on courses in computer law, entertainment law, trademark and unfair competition law, intellectual property and technology transfer.

### Representative Matters

#### Representative Patents

- US 7,722,446 System and device for thinning wafers that have contact bumps
- US 6,782,931 Tubeless tire compound and a system and method for retrofitting non-tubeless tires
- US 7,766,308 Theater rigging system
- US 6,801,335 Method of controlling impact printer noise
- US 8,032,523 Method and system for data migration
- US 7,088,008 Electronic package with optimized circuitization pattern
- US 7,937,609 Disaster recovery in a data processing system
- US 8,086,675 Generating a fingerprint of a bit sequence
- US 7,459,190 Fire protection containers incorporating novel low free water insulation materials
- US 7,196,783 Optical fiber bundle utilizing electromagnetic radiation feedback

### Education

- Syracuse University College of Law (J.D., *magna cum laude*, 1996)
- Syracuse University (B.S. in Aerospace Engineering 1991)

### Bar/Court Admissions

- New York
- U.S. Court of Appeals for the Federal Circuit
- U.S. Court of Appeals for the Second Circuit
- U.S. District Court for the Eastern District of New York
- U.S. District Court for the Northern District of New York
- U.S. District Court for the Southern District of New York
- U.S. District Court for the District of Colorado
- U.S. Patent and Trademark Office

### Practices

- Higher Education
- Intellectual Property and Technology
- Cybersecurity and Data Privacy
- Business and Transactions

- US 7,785,409 Fire-resistant ground cover and fire-resistant coatings for biomass, wood and organic mulches
- US 7,391,333 System for monitoring quality of water system
- US 7,825,853 Man-portable counter mortar radar system
- US 7,289,691 Lithium-Niobate fiber optic sensor and system
- US 8,137,380 Closure device, deployment apparatus, and method of deploying a closure device
- US 7,083,574 Non-invasive device and method for the diagnosis of pulmonary vascular occlusions

### **Representative Litigation Matters**

- *ProtectConnect, Inc. v. Leviton Manufacturing Co, Inc., et al.*, (S.D. Ca.) (Lead counsel in defense of Pass & Seymour, Inc. – a leading manufacturer and provider of ground fault circuit interrupters, wiring devices, electrical switches and outlets, and other electrical wiring devices – against patent infringement claims brought by a non-practicing entity and assisted with successfully settling the case prior to trial and after successfully invalidating two and narrowing one of the asserted patents in an ex parte reexamination proceeding at the USPTO).
- *Wacoh Company v. Kionix, Inc.*, (N.D.N.Y.) (Lead counsel in defense of leading manufacturer and provider of micro-electromechanical systems (MEMS) sensors against a claim of patent infringement and assisted with successfully settling the case prior to trial. Case was originally brought against multiple parties in the District of Delaware and was successful in severing Kionix from that case and in getting the case transferred to the N.D.N.Y.).
- *Ameranth, Inc. v. PAR Technology Corp., et al.*, (E.D. Tex.) (Lead counsel in defense of leading manufacturer and provider of point of sale software systems and other technology solutions for hospitality companies against a claim of patent infringement brought by a non-practicing entity and assisted with successfully settling the case prior to trial).
- *The Metraflex Company v. Flex-Hose Company, Inc.*, (N.D. Ill.) (Lead counsel in defense of leading manufacturer and provider of HVAC products against a claim of patent infringement and assisted with successfully settling the case prior to trial).
- *Total Containment Systems, LP v. Central Painting Inc. et al.*, (E.D. Wis.) – (Represented patent owner in a patent infringement action involving bridge platform systems against one of its competitors and an alleged contributory infringer; case was successfully settled after the lawsuit was filed).
- *In re Certain Ground Fault Circuit Interrupters & Prods. Containing Same*, Inv. No. 337-TA-615 (Int'l Trade Comm'n) (Represented patent owner/complainant Pass & Seymour, Inc. in a proceeding for patent infringement and obtained exclusion order against foreign manufacturers after a bench trial).
- *Hubbell Inc. v. Pass & Seymour, Inc.*, (D. Conn.) (Lead counsel for leading manufacturer and provider of ground fault circuit interrupters, wiring devices, electrical switches and outlets, and other electrical wiring devices. Obtained summary judgment of patent non-infringement and patent invalidity in favor of nationally known electrical wiring device manufacturer).
- *D & D Group Pty Ltd et al v. Nationwide Industries Inc.*, (S.D. Ca.) – (Lead

counsel for leading manufacturer of fence products. Obtained summary judgment of non-infringement, affirmed at Federal Circuit. Also used ex parte reexamination at USPTO to narrow asserted patent).

- *Pass & Seymour, Inc. v. Hubbell, Incorporated*, (N.D.N.Y.) (Lead counsel for leading manufacturer and provider of ground fault circuit interrupters, wiring devices, electrical switches and outlets, and other electrical wiring devices. Prosecuted patent infringement claims involving ground fault circuit interrupters with case settling prior to trial).
- *Kernius et al. v. International Electronics, Inc.*, (D. Md.) Obtained favorable construction of asserted patent claims at a Markman hearing as well as finding of non-infringement as a matter of law;
- *Leonardi Mfg. Co. Inc. v. CMD*, (N.D.N.Y.) -- Obtained favorable construction of asserted patent claims at a Markman hearing and settled case prior to trial.

## Honors & Affiliations

- Listed in:
  - *The Best Lawyers in America*® 2020, Litigation - Intellectual Property; Litigation - Patent; Patent Law (listed for 10 years)
  - *New York Super Lawyers 2019*®, Intellectual Property (listed for more than 10 years)
  - *Who's Who in America*
  - *Who's Who In American Education*
  - *Who's Who in American Law*
  - *Who's Who in Emerging Leaders*
  - *Martindale-Hubbell*®, AV Preeminent Rated
- American Bar Association
- New York State Bar Association
- Onondaga County Bar Association
- American Intellectual Property Law Association
- Central New York Patent Law Association, President
- Rochester Intellectual Property Law Association
- Justinian Honorary Law Society

## Representative Presentations

- Intellectual Property Law 101, New York State Bar Association CLE Program, December 16, 2019
- Overview of the Patent Systems in the United States and Effective Strategies for Chinese Applicants, The 10th Japan-U.S. Europe China-Korea Global Patent Seminar, Qindao, China, October 26, 2019
- Key Differences Between Patent Systems and Practices and Utilizing a Particular System to Obtain Strong Patents, Korean Electronics Association IP Seminar, Seoul, South Korea, October 24, 2019
- Patenting method for AI related invention in Japan, US, Europe, China and Korea, The 10th Japan-U.S. Europe China-Korea Global Patent Seminar, Tokyo,

Japan, October 22, 2019

- Patents in Artificial Intelligence Related Inventions, Arbeitskreis Patente, Stuttgart, Germany, September 27, 2019
- Intellectual Property Law 101, Bridging the Gap, New York State Bar Association CLE Program, October 17, 2019
- Basic Intellectual Property Issues for Marketing and Social Media, Empire State Society of Association Executives, April 5, 2019
- Effective IP Strategies and Practical Tips for doing business in Foreign Jurisdictions, Los Angeles Intellectual Property Law Association, March 5, 2019
- Intellectual Property Law 101, Bridging the Gap, New York State Bar Association CLE Program, December 12, 2018; December 19, 2018; January 17, 2019
- Patent Validity Challenges in the United States, Japanese Seminar, November 2, 2018; Korean Electronics Association Seminar, November 5, 2018; Chinese Seminar, November 7, 2018
- Basics of Intellectual Property Law: What All Lawyers Should Know about IP, Copyright and Trademarks in Advising Clients, Bridging the Gap - New York State Bar Association CLE Program, July 12, 2018
- Panel Member, The 4th annual Entertainment & Sports Law Symposium, Presented by the Entertainment & Sports Law Society, Syracuse University College of Law, April 6, 2018
- Structuring Trademark Clearance Opinions, Webinar, March 1, 2018
- Trademarks and Intellectual Property Basics for New York Lawyers, Bridging the Gap, New York State Bar Association, March 2018
- Panel Member, Protecting IP: Timing, Validity Challenges, International Decisions, NEXT-SYR The Event for Technology, Manufacturing and Biotech, November 17, 2017
- Using Universities for Research - Things to Know and Consider, Rochester Intellectual Property Law Association CLE Program, November 10, 2017
- Panel Member, Intellectual Property Management and How it Affects Contract Negotiations, NCURA Region II 2017 Spring Meeting, May 1, 2017
- Panel Member, Managing Intellectual Property - Pre-Award Office, What to Look for in Contract Negotiations, NCURA Region II 2017 Spring Meeting, April 30, 2017
- Legal Issues Surrounding Blockchain Technology, Rochester Institute of Technology, March 28, 2017
- Intellectual Property | Copyright 101, New York State Bar Association Bridging the Gap CLE, March 7, 2017
- Overview of aspects of U.S. Patent Practice of interest to Foreign Entities: Subject Matter Eligibility; Post-Grant Proceedings; International Trade Commission Investigations, 2017 International IP Seminar: Tokyo, Japan, February 17, 2017; Seoul, Korea, February 20, 2017; Guangzhou, China, February 22, 2017
- Strangers in a Strange Lab: Identifying and Addressing Concerns with University Visitors, National Association of College and University Attorneys (NACUA) Conference - Academic Sponsored Research and Technology Transfer: Accountability, Transparency, and Resilience in the Research Enterprise,

November 16-18, 2016

- Panel Member, Patent Protection, NEXT 2016 - The Event for Technology, Manufacturing & Innovation, October 11, 2016
- Intellectual Property 101 - Patents and Trademarks, New York State Bar Association CLE, March 24, 2016
- Protecting Patents and Trademarks in Europe, Institute for Veterans and Military Families, March 18, 2016
- Structuring Trademark Clearance Opinions: Assessing Search Results to Identify Infringements, Overcoming Clearance Challenges, and Preparing Opinions to Reduce Legal Risks, Strafford Publications, Inc., March 15, 2016
- United States Patent Overview, IPO Association and IPP Association, Kunshan, China, November 3, 2015
- Intellectual Property 101 - Copyright, Trademarks, New York State Bar Association Bridging the Gap CLE Program, March 19, 2015
- The Invention Process and How IP Laws Impact the Process, TACNY John Edson Sweet Lecture, January, 13 2015
- Patent Law Update, NDNY Federal Court Bar Association CLE, Hot Topics in Intellectual Property, December 4, 2014
- Structuring Trademark Clearance Opinions, Strafford Publications Webinar, September 10, 2014
- Intellectual Property Considerations for the Pre-Award Office, National Council of University Research Administrators, August 13, 214
- Intellectual Property Challenges in Globally Sponsored Research, National Council of University Research Administrators, August 11, 2014
- Intellectual Property (IP): Patents, Trademarks and Copyrights, State University of New York College of Environmental Science and Forestry, ESF Outreach, May 12, 2014
- Intellectual Property Management and Negotiating Strategies for Research Administrators, National Council of University Research Administrators Spring Meeting, May 4, 2014
- Technology Transfer & Working with the Corporate Sector; University Spin-offs and Other Small Business, National Council of University Research Administrators Conference, March 18, 2014

## Representative Publications

- "What do you think PR and other communication professionals need to know about cybersecurity, and the threat of cyberattacks?, What Communicators Need to Know About Cyberattacks: A Legal Perspective," *International Association of Business Communicators Communication World*, February 3, 2016
- George R. McGuire, Blaine T. Bettinger, "How the Supreme Court Got It Right in *Mayo v. Prometheus*," *The SciTech Lawyer*, Volume 10, Issue 1, Fall 2013
- George R. McGuire, Nelson A. Blish, Stephen H. Shaw, "Reexamining Reexamination: An Alternative to Patent Litigation," *ACC Docket*, September 2009

## Other Activities

- President/Executive Committee, IP and Innovation American Inn of Court
- Board Member, Onondaga Historical Association
- Adjunct Professor of Internet Law, Syracuse University College of Law
- Board Member & Treasurer, East Area Family YMCA of Greater Syracuse
- Board of Trustees, Everson Museum of Art, 2000-2006
- Editorial Advisory Board, Journal of the Association of University Technology Managers (AUTM)
- Advisory Board Member, Make-A-Wish Foundation of Central New York, Board Chair 2004-2006
- Chairman of the Board, Milton J. Rubenstein Museum of Science and Technology (MOST)
- Board Member, March of Dimes/North CNY Chapter
- Advisory Board, New York State Science and Technology Law Center
- 2003 Class, 40 Top Business and Community Leaders in Central New York under the age of 40