BOND SCHOENECK & KING ATTORNEYS

Jeremy P. Oczek

Member
jpoczek@bsk.com
The Avant Building - Suite 900
200 Delaware Avenue
Buffalo, NY 14202-2107
(716) 416-7037
(716) 416-7001 fax

10 Post Office Square
8th Floor
Boston, MA 02109
(617) 878-2093

Profile

Jeremy is chair of the firm's intellectual property practice. He focuses his practice on complex intellectual property litigation, counseling, strategic advice and portfolio development.

Jeremy currently represents some of the most-recognized technology companies in the world, including a world leader in lighting, a global leader in health technology, a world-renowned audio pioneer, and a global leader in payment technologies, among others. He also represents cutting-edge start-ups and midsize companies driving innovation in advanced technologies.

Prior to joining Bond, Jeremy spent over a decade practicing law in Massachusetts and had been a Partner at the international law firm Proskauer Rose LLP in its Boston office.

Intellectual Property Litigation: Jeremy leads Bond's IP litigation practice and has an accomplished track record in litigating high-stakes IP disputes, including patent, trademark, copyright and trade secret cases. Over the course of his 25-year career, he has litigated over one hundred IP cases in federal courts throughout the country and has worked on trials and appeals. Jeremy currently is representing, or recently has represented, Bose, Philips, Signify, Verifone and Xerox as lead counsel in IP litigation matters.

Intellectual Property Counseling: A registered patent attorney, Jeremy has extensive experience in securing, protecting, and managing patents and trademarks in the United States and internationally. He assists clients with matters before the U.S. Patent & Trademark Office and also works with clients on patentability and product clearance studies, freedom to operate evaluations, trademark and branding clearance, licensing and corporate transactions involving intellectual property.

Technology Experience: Jeremy has advised clients in a broad range of technologies, including software, computers, networking, telecommunications, e-commerce and internet-based systems, industrial equipment, manufacturing processes, biotechnology, life sciences, medical devices and consumer products.

National Recognition: Jeremy has received an AV Preeminent Peer Review Rating from *Martindale-Hubbell*. He has also been recognized by *The Best Lawyers in America*® in Patent Litigation and as a Super Lawyer in IP Litigation by *Upstate New York Super Lawyers*. Jeremy has been frequently invited by national and international media to offer commentary on IP issues and has been quoted in publications such as The National Law Journal, Law360, The Metropolitan

Education

- Boston College Law School (J.D., *magna cum laude,* 2000)
- State University of New York at Geneseo (B.S. in Biology 1997)

Bar/Court Admissions

- New York
- Massachusetts
- U.S. Supreme Court
- U.S. Court of Appeals for the Federal Circuit
- U.S. Court of Appeals for the First Circuit
- U.S. Court of Appeals for the Second Circuit
- U.S. District Court for the District of Massachusetts
- U.S. District Court for the Eastern District of Texas
- U.S. District Court for the Eastern District of Wisconsin
- U.S. District Court for the Southern District of New York
- U.S. District Court for the Western District of New York
- U.S. District Court for the Northern District of New York
- U.S. Patent and Trademark Office

Practices

- Litigation
- Intellectual Property
- Business and Transactions

Corporate Counsel, Life Sciences IP Review and World IP Review.

Board Service and Community Involvement: Jeremy serves as the Chairperson and Board Member of Kleinhans Music Hall. He previously served on the Editorial Board for the American Intellectual Property Law Association (AIPLA) Quarterly Journal, and also served as an Executive Board Member and Secretary of InfoTech WNY and Board Member of Friends of Reinstein Woods.

Honors & Affiliations

- Listed in:
  - *The Best Lawyers in America*®, Litigation - Patent, 2018-2026 (listed for more than 5 years)
  - *New York Super Lawyers®,* Intellectual Property Litigation, 2016-2025
  - *Martindale-Hubbell*®, AV Preeminent Peer Review Rating
  - Western New York's Power Players, Power 20 List, Intellectual Property, *The Daily Record*, 2022
  - *Buffalo Business First,* Legal Elite of Western New York, *2018*
  - *New York Law Journal*, 2015 Rising Stars
- American Intellectual Property Law Association
- Erie Country Bar Association

Representative Matters

Representative Litigation Matters

Cases Handled for Signify

Represented **Signify** (formerly **Philips Lighting**), the world's largest lighting company, as lead counsel in numerous patent infringement actions around the country to protect Signify's pioneering LED lighting inventions. The cases were each successfully resolved:

- *Signify Holding B.V. v. Nanoleaf Canada Ltd.* (S.D.N.Y.)
- *Signify Holding B.V. et al v. EEMA Industries Inc.* (C.D. Cal.)
- *Signify North America Corporation et al v. Robe Lighting Inc et al. (S.D. Fla.)*
- *Signify North America Corporation et al v. All Star Lighting Supplies, Inc. (D.N.J.)*
- *Signify North America Corporation et al v. Kind LED Grow Lights LLC et al.* (N.D. Cal.)
- *Signify North America Corporation et al v. Vision X Offroad LLC et al.* (W.D. Wash.)
- *Signify North America Corporation et al v. Qingdao Yeelink Information Technology Co., Ltd.* (S.D.N.Y.)
- *Signify North America Corporation et al v. Reggiani Lighting USA, Inc. et al.* (S.D.N.Y.)
- *Signify North America Corporation et al v. Delta Light (USA) LLC et al.* (S.D.N.Y.)
- *Philips Lighting North America Corporation et al. v. Howard Industries, Inc.* (S.D. Miss.)

- *Philips Lighting North America Corporation et al. v. DECO Lighting, Inc.* (C.D. Cal.)
- *Philips Lighting North America Corporation et al. v. IKAN International, LLC* (D. Mass.)
- *Philips Lighting North America Corporation et al. v. GVA Lighting, Inc.* (D. Mass.)

Represented **Signify** as lead counsel in breach of contract cases in support of Signify's EnabLED Licensing Program. The cases were each successfully resolved. In two of the cases, judgments in the amounts of $1.4M (Fohse) and $500K (Mega) were entered:

- *Signify Holding B.V. v. Fohse Inc.* (S.D.N.Y)
- *Signify Holding B.V. v. Mega Systems Inc.* (S.D.N.Y)
- *Signify Holding B.V. v. TP-Link Research America Corporation* (S.D.N.Y)

Represented **Cooper Lighting** (a Signify company) as lead counsel in the defense of case involving LED luminaries. The plaintiff dismissed the action after the filing of a Motion to Dismiss by Cooper Lighting. *Ferruiz IP, LLC v. Cooper Lighting, LLC* (W.D. Tex.).

Represented **Signify** as lead counsel in the defense of a patent case involving tubular LED (TLED) lights. Following the filing of a petition for *Inter Partes* Review (IPR) by Signify, the case was successfully resolved. *Blackbird Tech LLC v. Signify North America Corporation* (D.N.J.)

Represented **Signify** as lead counsel in the defense of a patent case involving spread spectrum transmission technology. Our team dug in and found evidence showing that the former owner of the patent had not complied with Section 287, which was dispositive of plaintiff's claim given that the asserted patent had expired. Plaintiff then dismissed the case with prejudice and provided a covenant not to sue on all patents owned by the plaintiff, resulting in a victory for Signify. *Zyrcuits IP LLC v. Signify North America Corporation* (D. Del.)

Represented **Signify** as lead counsel in the defense of a patent case involving near field communication (NFC) commissioning of networked devices. After full briefing of a motion for summary judgment under 35 U.S.C. § 101, Plaintiff dismissed all claims in the action with prejudice. *TriDiNetworks Ltd. v. Signify North America Corporation et al.* (D. Del.)

Represented **Philips Lighting** as lead counsel in the defense of a patent case involving immersive image viewing systems. Our team dug in and located key prior art which was then cited extensively in Philips Lighting's' answer and counterclaim. The case was successfully resolved. *TBL Holdings LLC v. Philips Lighting Holding B.V.* (W.D. Tex.)

Represented **Philips Lighting** as lead counsel in the defense of a declaratory judgment patent action. After a hearing on Philips Lighting's motion to dismiss, the court dismissed the action and entered final judgment on behalf of Philips Lighting. *IKAN International Corporation v. Philips Lighting North America Corporation et al.* (S.D. Tex.)

Cases Handled for Bose

Represented **Bose**, world renowned for its pioneering audio technologies, as lead counsel in a patent case involving direct sequence spread spectrum technology. We achieved dismissal of plaintiff's claims for indirect infringement before the case was

successfully resolved. *Castlemorton Wireless, LLC v. Bose Corporation* (W.D. Tex.).

Represented **Bose** as lead counsel in the defense of a patent lawsuit directed to phased array sound systems. This action was filed in an improper venue by plaintiff, as Bose is not incorporated in Texas and has no offices, stores, factories, or facilities in the judicial district. Our team dug in and located key prior art showing that the asserted patent was invalid. After notifying the plaintiff that the case was filed in an improper venue and the asserted patent was invalid, plaintiff dismissed the case, resulting in a victory for Bose. *Patent Armory Inc. v. Bose Corporation* (E.D. Tex.)

Represented **Bose** as lead counsel in the defense of a patent lawsuit directed to audio level reduction methods. This action was filed in an improper venue by plaintiff, as Bose is not incorporated in Texas and has no offices, stores, factories, or facilities in the judicial district. The case was successfully resolved. *RecepTrexx LLC v. Bose Corporation* (E.D. Tex.)

Represented **Bose** as lead counsel in the defense of a patent lawsuit directed to voice assistant functionality. This action was filed in an improper venue by plaintiff, as Bose is not incorporated in Texas and has no offices, stores, factories, or facilities in the judicial district. The case was dismissed by the plaintiff. *Lab Technology LLC v. Bose Corporation* (E.D. Tex.)

Cases Handled for Philips

Represented **Philips**, a global leader in medical technology innovations, as lead counsel in a design patent action relating to electronic toothbrushs. The matter was successfully resolved. *Wenzhou Charmhome Electronic Tech. Co., Ltd. v. Koninklijke Philips N.V.* (S.D.N.Y.)

Represented **Philips** as lead counsel in the defense of a patent lawsuit directed to control and monitoring of multiple devices and inter-device connections. The case was successfully resolved. *Cloud Systems HoldCo IP, LLC v. Phillips North America, LLC* (W.D. Tex.)

Represented **Philips** as lead counsel in the defense of a patent lawsuit directed to wearable monitoring devices. The case was dismissed by the plaintiff. *SmartWatch MobileConcepts, LLC v. Philips North America LLC* (W.D. Tex.)

Represented **Philips** as lead counsel in the defense of a patent lawsuit directed to patient monitors. The case was successfully resolved. *VDPP, LLC v. Philips North America LLC* (W.D. Tex.)

Represented **Philips** as lead counsel in the defense of a patent lawsuit directed to digital health platforms. The case was successfully resolved. *Valjakka v. Philips North America LLC* (W.D. Tex.)

Cases Handled for Xerox

Represented **Xerox**, a global leader in workplace technology innovations, as lead counsel in a patent case involving authentication and access control technology. After the plaintiff was notified of numerous deficiencies in the complaint, the case was dismissed by plaintiff. *Patent Armory Inc. v. Xerox Corporation* (W.D.N.Y.)

Represented **Xerox** as lead counsel in the defense of a patent lawsuit involving multi-function printers. After the plaintiff was notified of numerous deficiencies both in the original and amended complaint, the case was dismissed by the plaintiff. *Cedar Lane Technologies Inc. v. Xerox Corporation* (W.D. Tex.)

Represented **Xerox** as lead counsel in the defense of a patent lawsuit involving authentication and access control technology. The case was successfully resolved. *Gallio IP LLC v. Xerox Corporation* (W.D. Tex.)

Cases Handled for Other Clients

Served as Counsel of Record for **Law Professors** Joshua D. Sarnoff, Sharon K. Sandeen and Ana Santos Rutschman in the filing of a merits stage amicus brief in support of Sanofi in the U.S. Supreme Court case *Amgen v. Sanofi*. In a unanimous opinion, the Supreme Court sided with Sanofi and affirmed the lower courts' decisions.

Represented **CNY Fertility**, one of the nation's most innovative fertility clinics, as lead counsel in the defense of a patent infringement action. The case was successfully resolved. *American Infertility of New York, P.C. et al v. CNY Fertility PLLC* (S.D.N.Y.)

Represented **The Buffalo News** in an appellate victory before the U.S. Court of Appeals for the Second Circuit in a copyright action. The case was originally filed in the District of Delaware and then transferred to the Western District of New York. The Second Circuit affirmed the judgment of the district court and found that an unconditional submission of a piece to a newspaper constituted authorization to publish, thus requiring dismissal of the copyright action. *Joseph v. The Buffalo News* (D. Del., W.D.N.Y., 2nd Cir.)

Represented **WAND Corporation** and two of its customers as lead counsel in three patent cases involving digital menu technology. Our team dug in and located key prior art—which no other law firm involved in more than thirty other lawsuits had uncovered—showing that the asserted patents were invalid. We then negotiated a settlement in which the plaintiff agreed never to sue WAND or its customers over the asserted patents. *WAND Corporation v. Activelight, Inc.* (D. Del.); *Activelight, Inc. v. Cosi, Inc.* (D. Del.); *Activelight, Inc. v. White Castle Management Co.* (D. Del.)

Represented **Breathe Yoga** as lead counsel in trademark actions asserting the company's BREATHE marks. The cases were successfully settled with consent orders and permanent injunctions entered against the defendants. *Breathe Yoga & Juice Bar, Inc. v. Bartolotta* (N.D.N.Y.); and *Breathe Yoga & Juice Bar, Inc. v. Perno* (W.D.N.Y.)

Represented **HealthNow New York** as lead counsel in trademark actions asserting the company's HEALTHNOW marks. The cases were successfully settled. *HealthNow New York Inc. v. CHSPSC, LLC* (W.D.N.Y.); *Healthnow New York, Inc. v. Healthnow Family Practice LLC et al.* (M.D. Fla.)

Represented **Ultralife Corporation** as lead counsel in a trademark action asserting the company's ULTRALIFE marks. The case was successfully settled. *Ultralife Corporation v. Targus Group International, Inc. et al.* (W.D.N.Y.)

Represented **Jaccard Corporation** as lead counsel in a trade dress action involving kitchen products. The case was successfully settled. *Jaccard Corporation v. WINCO Industries Company et al.* (W.D.N.Y.)

Represented **SIC Products** as lead counsel in a trade dress action involving drinkware products. The case was successfully settled. *Yeti Coolers, LLC v. SIC Products LLC* (W.D. Tex.)

At his prior firm, represented **Analog Devices** in the defense of a five-patent litigation relating to computer architecture and parallel processing. After jury selection, the plaintiff dropped its demand and agreed to settle the case for a token payment and to arbitrate one of the patents if it survived reexamination at the Patent Office. After the arbitration hearing, the arbitrator ruled in favor of Analog finding no infringement and awarded attorneys' fees to Analog. *BIAX Corp. v. Analog Devices, Inc.* (E.D. Tex.)

At his prior firm, represented **Analog Devices** in patent and copyright case involving digital isolators. After the close of discovery, obtained summary judgment against Silicon Labs' counterclaim of unfair competition (Mass. Chapter 93A). The case was successfully settled shortly before trial. *Analog Devices, Inc. v. Silicon Laboratories, Inc.* (D. Mass.)

At his prior firm, represented **Hypertherm** in a six-patent litigation relating to plasma torch technology against one of its competitors. Obtained summary judgment of infringement in Hypertherm's favor on numerous parts manufactured and sold by the defendant, summary judgment in Hypertherm's favor on several of defendant's alleged defenses, and disqualification and exclusion of defendant's technical expert witness. After obtaining these major court victories, along with other victories in the case, the case was successfully settled shortly before trial. *Hypertherm, Inc. v. American Torch Tip Co.* (D.N.H.)

At his prior firm, represented **Ivoclar** in obtaining summary judgment of non-infringement in a patent case relating to dental material systems in which the plaintiff was seeking tens of millions dollars in damages. This significant victory was affirmed by the U.S. Court of Appeals for the Federal Circuit. *PSN Illinois, Inc. v. Ivoclar Vivadent, Inc.* (N.D. Ill., Fed. Circ.)

At his prior firm, represented **MKS Instruments** in its assertion of five patents relating to plasma processing equipment for use in the semiconductor industry. After a four-day trial, the jury returned a verdict of infringement in favor of MKS on all patents asserted at trial. *MKS Instruments, Inc. v. Advanced Energy Corp.* (D. Del.)

At his prior firm, represented **Qwest**, **Global Crossing**, and **Level 3** in the defense of a patent infringement action relating to voice over IP (VoIP) switching technology. The case was successfully settled settled during trial. *C2 Communications Technologies, Inc. v. Qwest Communications Corp.*, *Global Crossing Telecommunications, Inc.*, and *Level 3 Communications, LLC* (E.D. Tex.)

At his prior firm, represented **Transamerica** in defending against three patents in three separate cases relating to the administration of insurance annuity products. Retained after an adverse jury verdict, assisted team in obtaining reversal of $13 million judgment on appeal at the U.S. Court of Appeals for the Federal Circuit. *Lincoln National Life Insurance Co. v. Transamerica Life Insurance Co. et al.* (N.D. Iowa, N.D. Ind., and Fed. Cir.)

At his prior firm, represented **ImClone** in a patent infringement action directed to technology allegedly used to produce Erbitux. The case was successfully settled shortly before hearings on motions for summary judgment. *Abbott Laboratories v. ImClone Systems, Inc.* (D. Mass.)

At his prior firm, represented **Facebook** as local counsel in a high-profile dispute associated with the founding of Facebook (which was later the subject of the movie *The Social Network*). *ConnectU LLC et al. v. Facebook, Inc. et al.* (D. Mass.)

At his prior firm, represented **Daniel Goodin**, a former reporter for the Industry Standard, in a pro bono case defending a defamation claim brought by John Fanning, uncle of Shawn Fanning, the founder of Napster. After Goodin won sanctions against the plaintiff, the case was dismissed by the plaintiff. *Fanning v. Goodin* (D. Mass.)

Representative Presentations

- IP Strategy Summit: Boston (Virtual), Minimizing the Risk of Costly Patent Litigation, October 15, 2020
- IP Strategy Summit: Boston (Virtual), COVID-19 & Beyond, June 23, 2020
- IP Strategy Summit: Boston, Portfolio Management Strategy, April 11, 2019
- IP Strategy Summit: Boston, Enforcing Patents in 2018: Risk & Opportunities, May 15, 2018
- IP Strategy Summit: Boston, Supreme Court Roundup, May 10, 2017
- IP Strategy Summit: New York, How the Changes to the Pleadings Standard Are Affecting Patent Litigation, October 27, 2016

Representative Publications

- Co-author, “A Reminder On Avoiding Improper Venues In Patent Cases,” *Law360*, March 11, 2025

Other Activities

- Board Member, Kleinhans Music Hall Management, Inc., 2017-present
  - Chair, 2020-present
  - Vice Chair / Chair-Elect, 2019
  - Secretary and Treasuer, 2017-2018
- Editorial Board, AIPLA Quarterly Journal, 2015-2018
- Board Member, InfoTech WNY, 2013-2019
  - Executive Board Member and Secretary, 2016-2019
- Board Member, Friends of Reinstein Woods, 2016-2018