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Profile

Honors & Affiliations

- Listed in:
 - *The Best Lawyers in America*®, Litigation - Patent, 2018-2024 (listed for more than 5 years)
 - *New York Super Lawyers*®, Intellectual Property Litigation, 2023
 - *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

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 the U.S. Supreme Court case *Amgen v. Sanofi*.

Represented **Bose**, world renowned for its innovative audio solutions, 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** in the defense of a patent lawsuit involving a computerized method for controlling electronic devices. Our team dug in and located key prior art showing that the asserted patent was invalid. Plaintiff then dismissed the case, resulting in a victory for Bose. *Cedar Lane Technologies Inc. v. Bose Corporation* (W.D. Tex.)

Represented **Xerox**, a global leader in workplace innovations, as lead counsel in a patent case involving authentication and access control technology. The case was successfully resolved. *Gallio IP LLC v. Xerox Corporation* (W.D. Tex.)

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. Patent and Trademark Office

Practices

- Litigation
- Intellectual Property
- Business and Transactions

Represented **Signify** (formerly **Philips Lighting**), the world leader in lighting, as lead counsel in numerous patent infringement actions around the country to protect Signify's pioneering LED lighting inventions:

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

Represented **Signify** as lead counsel in a breach of contract case related to Signify's EnabLED Licensing Program. The case was successfully resolved. *Signify Holding B.V. v. TP-Link Research America Corporation* (S.D.N.Y.)

Represented **Signify** as lead counsel in the defense of a patent case involving tubular LED (TLED) lights. After 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 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 **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 complete victory for Signify. *Zyrcuits IP LLC v. Signify North America Corporation* (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.)

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. *Joel 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 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
- Business of Technology, InfoTech WNY Learning Series, March 22, 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
- Distinguished Biology Alumni Panel, State University of New York College at Geneseo, October 17, 2014
- Annual Meeting of the Association of Towns of the State of New York, Intellectual Property Issues for Municipalities, February 17, 2014
- Bond, Schoeneck & King's In-House Counsel CLE Series: The Top 10 Things Every Company Should Do to Protect Its IP, October 16, 2013
- The Knowledge Congress, Defending Yourself Against Online Patent Trolls, Webinar, June 28, 2013

Representative Publications

- Quoted in "BLJ: IP lawyers sharpen focus on data privacy," *Buffalo Business First*, March 26, 2018
- Quoted in "Ownership and control of websites vary," *Buffalo Business First*, March 4, 2016
- Quoted in "'Disparaging' trademarks take new direction," *Buffalo Law Journal*, January 25, 2016
- Quoted in "Business-friendly automatic assignment provisions challenged," *Buffalo Law Journal*, January 25, 2016
- Quoted in "Photonics could bring IP work to area," *The Daily Record*, November 2, 2015
- Quoted in "PTAB changes: levelling the playing field," *World Intellectual Property Review*, October 1, 2015
- Quoted in "Facebook and Google demand review of Apple v Samsung ruling," *World Intellectual Property Review*, July 21, 2015
- Quoted in "Patent trolls mushroom, squashing them proves tough," *Rochester Business Journal*, June 12, 2015
- Quoted in "Lawyer drops defamation claim against EFF patent blog," *World Intellectual Property Review*, June 8, 2015
- Author, "Common Law vs. Federal Trademark Registration," *Bond IP & Technology Newsletter*, Fall 2014
- Quoted in "Software patents called into question," *Buffalo Law Journal*, August 12, 2014
- Quoted in "What's what in intellectual property," *Buffalo Law Journal*, August 11, 2014

- Author, "Strategies to Battle NPEs: Lessons from the Front Lines," *Bond IP & Technology Newsletter*, Spring 2014
- Quoted in "Social Media After Death," *13WHAM ABC Rochester*, February 23, 2014
- Quoted in "Man Fighting to Access Late Wife's Facebook," *13WHAM ABC Rochester*, February 24, 2014
- Quoted in "FDA approval adds new life to Copaxone," *Life Sciences Intellectual Property Review*, January 29, 2014
- Quoted in "'Arrest threat' for US patent company in China," *World Intellectual Property Review*, December 18, 2013
- Quoted in "Teva to lose grip on Copaxone next year," *Life Sciences Intellectual Property Review*, November 20, 2013
- Quoted in "Samsung under fire over alleged Apple secrets leak," *World IP Review*, October 7, 2013
- Author, "Patent Exhaustion: Bowman v. Monsanto (Supreme Court 2013)," *Bond IP & Technology Newsletter*, Summer 2013
- Quoted in "Samsung says Ericsson unfairly seeks 'billions more' in licensing fees," *World IP Review*, August 29, 2013
- Quoted in "US court rules Teva patent invalid," *Life Sciences IP Review*, July 30, 2013
- Quoted in "Wi-Lan loses patent suit in under an hour," *World IP Review*, July 18, 2013
- Quoted in "UCB challenges Teva generic drug application," *Life Sciences IP Review*, July 3, 2013
- Quoted in "AbbVie triumphs in Humira case," *Life Sciences IP Review*, July 2, 2013
- Quoted in "Lawyers Weigh In On Obama 'Patent Troll' Initiatives," *Law360*, June 6, 2013
- Author, "Patent Filing Strategies Under the AIA," *Bond IP & Technology Newsletter*, Spring 2013
- Author, "Rethinking Defense in 'Patent Troll' Cases," *Corporate Counsel*, March 27, 2013
- Author, "Supreme Court shaping IP law," *Buffalo Law Journal*, March 11, 2013
- Author, "Q4, discussing upcoming U.S. patent law changes," *Rochester Business Journal*, March 8, 2013
- Author, "Supreme Court Decisions Will Have Major IP Impact in 2013," *Bond IP & Technology Newsletter*, Winter 2013
- Author, "The Supreme Court's *Mayo v. Prometheus* Decision and the Future of Diagnostic Patents," *Bond IP & Technology Newsletter*, Spring 2012
- Co-author, "Best Practices to Implement in View of the America Invents Act," *Bond IP & Technology Newsletter*, Winter 2012
- Author, "Companies clue in to patent law reform," *Buffalo Law Journal*, March 12, 2012
- Quoted in "High Court Says Willful Blindness Is Evidence of Knowledge in Induced Patent Infringement, BNA's Patent," *Trademark & Copyright Journal*, 82

PTCJ 137, June 3, 2011

- Quoted in "Actual Knowledge Necessary For Inducement: High Court," *Law360*, March 31, 2011
- Interviewed in "Patent Law Reform: Adjusting to a New World of First-To-File and More," *The Metropolitan Corporate Counsel*, April 3, 2011
- Quoted in "In High Court Patent Fight, Tech and Auto Companies Lobbied White House to Stay Out of Case," *The National Law Journal*, March 1, 2011
- Quoted in "False Marking Constitutionality Debate to Rage On," *Law360*, February 24, 2011
- Quoted in "Supreme Court Weighs Induced Infringement Test," *Law360*, February 23, 2011

Other Activities

- Board Member, Kleinhans Music Hall Management, Inc., 2017-present
 - Chair, 2020-present
 - Vice Chair / Chair-Elect, 2019
 - Secretary and Treasurer, 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