FIRM OVERVIEW

“A Knowledgeable Advocate”

That is how our clients see us. They also describe Bond as professional, thorough and accessible, “like an in-house counsel” and “a quarterback of resources.”

At Bond, Schoeneck & King, we are proud of our extensive body of work, our in-depth perspectives, and the education and experience that allow us to collaborate with our clients in developing high-quality, right-sized legal solutions.

We have cultivated a firmwide culture that encourages teamwork and continuity and offers our clients commitment, service and value. Bond is also committed to community and pro-bono work, and service to the Bar.

Why Choose Bond?

We’re responsive and easy to work with. When clients have a concern or a question, they want to connect with a knowledgeable, trusted advocate right away. At Bond, we understand the urgency.

> *“I’ve worked with other local and national law firms, and Bond’s client service outshines them all,” says Catherine Sawchuk, director of human resources at Glens Falls-based Genpak LLC, with operations in 12 states. “Bond is very attentive and personable; I feel as if I’m the firm’s only client. They always get back to me, regardless of time of day. I’m never waiting for a response or letter they’re preparing, and they ensure I always have the resources I need.”*

Our breadth of knowledge is powerful. Thanks to Bond’s size and our emphasis on teamwork and a “one-firm” approach to solving problems, we have the right professionals to provide targeted guidance on multiple dimensions of a client’s project.

> *“With Bond, I have real advocacy and competence in front of me,” says Robert Daino, Chief Operating Officer for Acreage Holdings, Inc. in Manlius, NY. “Whether I’ve worked with the attorneys for years or I’m meeting them for the first time, I feel the same level of comfort and trust.”*

Our depth of experience inspires confidence. Bond’s significant body of work allows us to bring perspective-rich, targeted approaches that address our clients’ challenges efficiently.

> *“Bond works with districts throughout the state,” says Janet Gilmor, assistant superintendent for HR with the William Floyd School District in Long Island, NY. “When they’re helping us, we know we’re getting the best legal advice there is.”*

We are engaged allies and advocates. At Bond, we invest in our clients and share their passion for their businesses. We listen carefully to understand their current needs, and we examine multiple angles to help identify emerging demands and offer innovative, strategic solutions.

> *“Bond is as good a firm as any we’ve dealt with,” says Howard Gutman, president of The Lutgert Cos. in Naples, FL. “Their expertise has given us the ability to analyze projects, businesses and situations and make prudent, timely decisions. This has been extremely helpful in rapidly changing conditions, particularly during the economic downturn.”*

About Bond, Schoeneck & King

Bond serves individuals, companies and public-sector entities in a broad range of areas.

With more than 300 lawyers and 15 offices, we represent clients in manufacturing; agribusiness; commercial lending and real estate and construction; energy; health care and long term care as well as municipalities, school districts, higher education and other exempt and nonprofit organizations. We maintain 11 offices across New York; and one each in Boston; Kansas City; Naples; and Newark.

Bond is committed to understanding our clients’ needs and providing comprehensive, practical, high-quality and responsive solutions. We strive to maintain the highest professional and ethical standards, and to provide leadership in community activities, pro bono work and service to the Bar.

For more information, visit bsk.com.

Our expanded reach meets your complex needs. As a member of the Employment Law Alliance, the world's largest network of labor and employment lawyers, Bond serves clients' needs throughout the United States and around the world. We are also a member of the selective Law Firm Alliance, a global network of more than 50 full-service law firms that collaborate to provide well-developed, cost-effective legal services in jurisdictions worldwide.

"When we first approached Bond for estate planning services, we felt an instant connection, thanks to the team's attention to detail, responsiveness and friendly attitude," says James Sydor, president and CEO of Sydor Optics in Rochester, New York. "Today we rely on Bond for real estate and business counsel, too, because we know we're in caring and capable hands."

We are affordable. Our clients want effective, high-quality services but also insist on value and a judicious use of their resources. Bond's unique cost structure, efficient staffing models and low staff turnover assist us in meeting clients' expectations of value while providing the representation and service they need.

Industries We Serve

Bond's clients are businesses of all sizes, non-profits and public-sector entities, and individuals, in the following industries:

- Agribusiness
- Commercial Lending
- Energy
- Exempt Organizations
- Health Care
- Higher Education
- Long Term Care

Keeping Our Clients Updated

At Bond, we strive to keep our clients informed, sharing relevant legal updates that may impact them and their businesses. We use an array of formats—seminars, webinars, blog postings, information memos, email blasts, and social media feeds. Recent educational offerings to clients have included:

Seminars and webinars. We offer clients free or reduced-price admission to events we sponsor or co-sponsor. Recent seminars and webinars have addressed:

- Labor, employment and human resources including National Labor Relations Board rule changes and activity
- Zoning and planning case law
- Medicaid and managed long term care
- Continuing legal education (CLE) seminars on ethics and arbitration
- Records retention and defensible deletion
- Financial planning for health care professionals
- Best practices for nonprofits

Blogs. Clients and prospective clients are invited to subscribe, free of charge, to the following frequently updated blogs and alerts:

- Higher Education Law Report
- New York Labor & Employment Law Report
- WebRulation Governmental Health Care Policy Determination Alert

Well-Regarded Among Our Peers

The quality and value that we bring to our clients and our contributions to the legal community are recognized in our lawyers frequent appearances on prestigious attorney lists. For example, *The Best Lawyers in America*® 2024 lists 91 Bond attorneys, and *New York Super Lawyers*® 2023 lists 80 Bond attorneys.

Looking for a trusted advocate who is as engaged in your success as you are?

Contact Bond today! bsk.com.

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TRADEMARK, COPYRIGHT AND BRAND PROTECTION

Securing Your Brand. Guarding Your Goodwill.

In a marketplace teeming with competition, the challenges of establishing and protecting your brand—your key to communicating the quality and uniqueness of your products and services—grow more intense every year. And, as technology evolves and as non-traditional branding applications proliferate, building the value of your goodwill and creating core equity become more important—and more difficult to achieve.

Thriving in this aggressive environment requires the skilled, vigilant involvement of an experienced intellectual property legal team with a regional, national, and global reach. Clients rely on Bond's experience in all phases of brand protection and IP law: trademarks and advertising, copyright, trade secrets, trade dress, privacy, and licensing and marketing arrangements.

Bond's Trademark, Copyright and Brand Protection team supports clients of all sizes and in all phases of development. Our clients are significant players in industries such as medical and mechanical devices, computer software and hardware, manufacturing, pharmaceuticals, telecommunications and e-commerce technologies.

As needed, we assist clients with IP matters that stem from mergers and acquisitions, financing and other transaction activity.

Trademark Service Areas

In trademark matters, Bond takes a comprehensive approach. Our attorneys follow the life of a mark—from selection, clearance, prosecution, and maintenance—to portfolio management, audits, licensing, watch services and litigation. We currently manage more than 2,000 active trademark files worldwide. In addition, we represent clients in matters involving trade dress, trade secrets and advertising.

Whether our client is a major multinational, an innovator with a national reach or a local startup, Bond offers trademark services including:

- Strategic brand counseling
- Trademark portfolio management
- Global trademark licensing
- Availability searches and opinions
- Oppositions and cancellations
- Protection proceedings before the U.S. Patent and Trademark Office, and before state authorities
- Coordination with our network of associates and the Patent Cooperation Treaty for trademark matters outside the United States
- State and common-law trademark protections
- Trademark audits
- Litigation and enforcement

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We also collaborate with the client's marketing team on strategies to maximize the trademark portfolio's value.

Copyright Service Areas

Likewise, Bond attorneys are skilled in handling copyright litigation, licensing, prosecution and counseling for clients across industries where protecting and leveraging intellectual property is imperative. Clients rely on our counsel and representation in copyright publishing, licensing, enforcement and fair-use matters.

We regularly handle U.S. Copyright Office registration procedures and deposit requirements, and matters involving the Digital Millennium Copyright Act (DMCA), which governs music and video distribution, website linking and enforcement.

Further, Bond's IP litigation team handles high-stakes matters such as copyright infringement class actions, disputes involving incorporating copyrighted standards into government statutes, and calculating damages for infringement violations.

Privacy Services

As part of our comprehensive commitment to our clients' long-term success, Bond emphasizes developing privacy policies and practices that avert disputes—thereby sidestepping business disruption and maintaining brand reputation. When such disputes prove unavoidable, however, Bond taps our considerable experience to resolve them as efficiently as possible.

Online Business and Social Media Matters

Bond assists clients in online business and social media matters including data security, e-commerce, direct email marketing and CAN-SPAM Act compliance issues, social media policies, social media handles and domain names, and legal issues involving search engine optimization and keyword advertising, copyright fair use, and trademark fair use.

We work with clients to develop website policies that limit liability around terms of service, user-generated content and privacy, and adhere to DMCA provisions.

Why Choose Bond

- **Refreshing Value Structure.** Bond's lean staffing models and low-cost office locations allow us to deliver partner-level attention and efficient support for less than our competitors charge. And, with our most experienced professionals directing and streamlining your case, Bond eases the demands on your time and the disruptions to your business.
- **Well-Regarded by Colleagues.** Best Lawyers®, Super Lawyers® and Martindale-Hubbell have recognized members of Bond's IP team.
- **Exceptional Pedigrees.** Not only do our lawyers regularly face off against the top firms, but many of us have built track records inside the country's biggest and best-known firms. Bond members have been members at Kirkland & Ellis, Proskauer Rose, Fulbright & Jaworski, and Nixon Peabody. Bond's team also includes the former chief Trademark Counsel from Eastman Kodak who managed its worldwide trademark portfolio.

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PATENT AND IP LITIGATION

Big Law Sophistication. National Reach. Uncommon Value.

Defending what's rightfully yours in the ultra-competitive world of high-tech innovation requires a legal team with experience, sophistication and depth in handling intellectual property. It also demands strategic creativity and efficiency.

The attorneys of Bond's Patent and IP Litigation Practice handle high-stakes technology cases nationwide involving patent, copyright, trademark, trade secret, trade dress and unfair competition matters. We've represented Fortune 100 companies, high-tech start-ups, service businesses, manufacturers, financial institutions, and major universities and research organizations.

By combining well-honed trial and appellate experience with experience in virtually every industry, Bond confidently handles the most complex cases.

Our deep bench includes a Litigation Practice of more than 40 attorneys, plus 13 registered patent attorneys with sophisticated technical backgrounds. Bond members hold degrees in aerospace, electrical and optical engineering, as well as physics, biology and chemistry. And we've amassed cutting-edge knowledge working inside research companies, engineering firms and large multinationals.

When a Cookie-Cutter Approach Won't Get It Done

In this volatile environment where ingenuity rules, why would you trust your precious innovations to formulaic legal representation? Bond evaluates each litigation matter with fresh eyes, customizing a strategy ideally suited to your circumstances .

And we bring our A team —the lawyers who've been to trial, who've litigated across the country, who've faced AmLaw 50 firms and won. With Bond, you get partner-level talent, not a first-year attorney training on your company's dime.

Leveling the Playing Field in the 'Sport of Kings'

Dealing with a patent or IP lawsuit is, let's face it, expensive; no wonder some call IP litigation the "sport of kings."

Unfortunately, hiring the most expensive law firm to defend your property doesn't guarantee a win. In fact, upon seeing the big name you've brought in, the other side may simply turn up the heat and run up the bill. Seeking to avoid costly litigation, many companies reluctantly settle.

At Bond, we position our clients to seize control of the patent and IP litigation process. Our emphasis on strategy and cost-efficiency helps us secure important wins for our clients—over patent trolls, yes, but over competitors as well.

Wary of spending time and money to protect or defend your company's IP? Look to Bond to help you take control of the IP litigation process—affordably, and with less disruption to your business.

About Bond, Schoeneck & King

Bond serves individuals, companies and public-sector entities in a broad range of areas.

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Why Choose Bond?

- **Trusted by Top Companies.** We've represented some of the most well-known brands and technology companies in the world. Also, Chambers USA 2020 has recognized Bond's IP litigation practice: "Well-regarded practice with a strong reputation in the litigation space. Excels in securities and IP disputes…".
- **National Reach.** Our attorneys have litigated IP cases in patent hot spots such as Texas, Delaware and the U.S. International Trade Commission, and California, Florida, Illinois, Minnesota and New York.
- **Deep Bench Strength.** Our trial-tested team of more than 50 professionals has the experience and credentials to meet the specific needs of each IP litigation matter. And our dedicated in-house litigation support staff provides robust e-discovery resources.
- **Exceptional Pedigrees.** Not only do our lawyers regularly face off against the top firms, but many of us built track records inside the country's biggest and best-known firms. Bond members have been members at Kirkland & Ellis, Proskauer Rose, Fulbright & Jaworski and Nixon Peabody.
- **Refreshing Value Structure.** Bond's lean staffing models and office locations in smaller markets allow us to deliver partner-level attention and efficient support—for less than our competitors. And, with our most experienced professionals directing and streamlining your case, Bond eases the demands on your time and the disruptions to your business.

Scoring Innovative Wins for Our Clients

Bond's clients have reaped the benefits of our unique approaches. Consider the following:

- **Prior-Art Discovery Yields Settlement in Patent Dispute.** Bond represented digital menu provider WAND Corp. and two of its customers—White Castle Management Co. and Cosí Inc.—in three lawsuits in Delaware over alleged infringement of digital menu board technology. Bond's IP team dug in and located key prior-art—which no other law firm involved in more than 30 related lawsuits had uncovered—showing that the asserted patents were invalid. Bond then negotiated a settlement in which the other party agreed never to sue WAND or its customers over the asserted patents.
- **Multi-Front Attack Achieves Major Victory Over Competitor.** Bond represented hardware and component manufacturer Nationwide Industries in defending a patent infringement suit filed in the Southern District of California. Bond obtained summary judgment of non-infringement at the district court, and that judgment was affirmed on appeal by the U.S. Court of Appeals for the Federal Circuit. In addition, Bond filed a re-examination of the asserted patent at the U.S. Patent and Trademark Office, resulting in significant claim amendments.
- **ITC Exclusion Order Obtained Against Foreign Manufacturers.** Bond represented electrical device manufacturer Pass & Seymour, a subsidiary of Legrand, in a patent infringement proceeding before the International Trade Commission. Six patents were asserted in various combinations against four primary China-based manufacturers, each of whom made different accused products. Because the four companies each made different products and because the same set of patents was asserted against each, Bond had to construct claims in a way that encompassed different products while also preserving the claims' validity. Our thoughtful, technical interpretation of the patents resulted in the ITC issuing an exclusion order against each of the Chinese manufacturers, preventing the importation of the accused products.

For more examples of Bond's experience in patent and IP litigation, see the attached list of representative cases.

Ready for a Game-Changing Approach to Protecting Your Company's IP?

Find out how Bond will bring refreshing, innovative strategies to your patent or IP case. Contact us today.

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PATENT POST-ISSUANCE PRACTICE

Patent practice before the U.S. Patent and Trademark Office (PTO) does not end at issuance of a patent. Post-issuance procedures are available for parties to challenge the validity of issued patents before the Patent Trial and Appeal Board (PTAB), as well as for patent owners to strengthen or correct the scope of an issued patent. These complex proceedings require an in-depth knowledge of patent office rules and procedures.

Alternative to Patent Litigation

Parties involved in high-value patent disputes are increasingly utilizing post-grant proceedings before the PTO, including *inter partes* review, post-grant review, and *ex parte* reexamination, to challenge the validity of issued patents. Such proceedings can avoid or defer district court litigation, and provide a strategic, cost-effective alternative. Various post-grant options provide a faster path for a validity challenge, utilize the technical patent knowledge of the judges at the PTAB and provide a lower burden of proof for invalidation than in federal court. While these procedures provide advantages to challenging validity of issued patents, patent owners must also be prepared to face such challenges when attempting to enforce their patent rights.

Identifying the Correct Path

Post-grant proceedings come in different flavors, including *inter partes* review, post grant review, and *ex parte* reexamination. Bond's IP attorneys have an in-depth understanding of the various procedures that can inform the client's decision with respect to whether to use post-grant proceedings, and which proceeding is appropriate.

Inter Partes Review (IPR)

IPRs are truncated trials challenging the validity of issued patents (except those available for post grant review) based on prior art patents and printed publications. An IPR petitioner need not have been sued on the patent or threatened with suit to file an IPR petition, however, there is a one year deadline after service of a patent infringement complaint to file a petition with the PTAB. An IPR trial is instituted when the PTAB determines that a petition demonstrates a "reasonable likelihood" of invalidating at least one claim. The patent owner has an opportunity to respond to the allegations, including optionally amending the patent's claims. The IPR trial, once instituted, must be concluded within one year.

Post-Grant Review *(PGR)*

PGRs apply only to patents issuing from applications filed on or after March 16, 2013, and can only be filed during the first nine months after issuance. While PGRs are procedurally similar to IPRs, the petitioner can advance a challenge on any basis of unpatentability and is not limited to prior art challenges. A PGR may be instituted upon a showing that it

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is “more likely than not” that at least one challenged claim is unpatentable. Similar to IPR, the patent owner has an opportunity to respond and may file a motion to amend the patent by substituting new claims, and the PTAB will issue a final determination within one year after it institutes trial.

Ex Parte Reexamination

Ex parte reexamination allows a third party to file a request for the PTO to reexamine an issued patent, based on printed prior art. The petition must raise a substantial new question of patentability for reexamination to be instituted. While the patent owner is allowed to participate in the reexamination, the third-party challenger has no further involvement after filing the initial request.

Benefits vs. Risks

While post-grant proceedings provide alternative options to litigation for parties involved in patent disputes, it is important to understand the risks involved as well. In particular, the use of certain post-grant proceedings to challenge validity can limit the petitioner’s ability to challenge validity in any subsequent litigation on certain grounds.

A Hybrid Approach

Post-grant proceedings incorporate aspects of traditional patent practice before the PTO, as well as features that are more akin to patent litigation. Success in the post-grant arena requires a mixture of sophisticated patent practice experience before the PTO, as well as litigation acumen.

Strengthening or Correcting Issued Patents

Reissue applications are valuable tools for correcting defects in issued patents and can be utilized prior to enforcement efforts to strengthen the patent asset and Bond attorneys have experience drafting and prosecuting these applications. The reissue application request must identify an error that causes the patent to be invalid. Reissue applications, for example, may be filed based on the claims being too narrow or too broad, although a broadening reissue must be filed within two years from the grant of the patent.

Why Choose Bond

The attorneys in Bond’s Patent and IP litigation practice have the experience and skills to develop post-grant strategies that strengthen their intellectual property position in each of these areas.

Bond’s IP attorneys possess a mixture of patent prosecution and litigation experience that provides clients with strategic advantages and guidance in developing post-issuance strategies. Our deep bench includes litigators and registered patent attorneys with sophisticated technical backgrounds. Bond IP attorneys hold degrees in aerospace, electrical and optical engineering, computer science, as well as physics, biology and chemistry making them well-equipped to provide post-grant results.

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Profile

Terria is a seasoned trademark and copyright intellectual property attorney who works closely with her clients to optimize, protect and leverage their brands and expand their impact in the market. At Bond, Terria chairs the firm's trademark and brand licensing practice.

Terria has an exceptional range and wealth of knowledge in trademark portfolio development, strategic brand management, brand counseling and brand licensing, having overseen a large multinational trademark and copyright portfolio for Kodak - an iconic global brand.

As chief trademark counsel and division counsel for Eastman Kodak she advised the company's consumer and commercial businesses on a wide range of domestic and international trademark, copyright, marketing and corporate matters. She has significant experience in:

- Global trademark portfolio management
- Global brand licensing
- Strategic brand counseling
- Trademark enforcement & protection
- Deal Negotiation
- Training and development
- Litigation management
- Claims review
- Advertising, marketing and copyright clearance and counseling
- Contract drafting and management
- IP due diligence/M&A support
- Mediation and dispute resolution

She also served as managing counsel and chief trademark counsel for Carestream Health, Inc., a medical imaging and equipment company, managing their sizeable trademark portfolio and directing the company's brand and marketing activities. Terria's in-house and private practice experience spans a range of businesses from start-ups and spin-out companies to mature businesses.

Prior to going in-house, Terria worked for the United States Patent and Trademark Office as a trademark examining attorney.

Honors & Affiliations

- *Rochester Business Journal,* Women of Excellence, 2023
- Western New York's Power Players, Power 20 List, Intellectual Property, *The Daily Record*, 2021, 2022, 2023

Education

- The Catholic University of America, Columbus School of Law (J.D. 1993)
- The American University (B.A. 1987)

Bar/Court Admissions

- New York
- Maryland
- District of Columbia

Practices

- Intellectual Property

- Certified Mediator, New York State Unified Court System
- International Trademark Association (INTA), Member
- Society of Product Licensors Committed to Excellence (SPLiCE), Member
- Judicial Clerkship: Law clerk to the Hon. Russell F. Canan (ret.), Superior Court of the District of Columbia
- Trial experience: Trial attorney, Maryland State Public Defender's office
- Leaders in Law Attorney of the Year, *The Daily Record,* 2014

Representative Publications

- Jenkins Brings Trademark Law Prowess to Bond, Schoeneck & King, *Rochester Business Journal*, July 20, 2021

Representative Presentations

- An Interview with Terria Jenkins, Trademarks, Legally Bond Podcast, February 27, 2023

Other Activities

- JustCause (formerly Volunteer Legal Services Project of Monroe County, Inc.), Board Member
- The Father's House, former Board Member
- Center for Dispute Settlement, Program Manager & Volunteer Mediator

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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 case. 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, 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, 2018-2025 (listed for more than 5 years)
  - *New York Super Lawyers®,* Intellectual Property Litigation, 2016-2024
  - *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 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
- 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

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

BOND SCHOENECK & KING ATTORNEYS

Mark L. Beloborodov

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(617) 865-9070

Profile

Mark is a seasoned intellectual property attorney with an extensive background in driving long-term IP strategy and supporting innovation in the healthcare, information technology, lighting, consumer goods and electronics sectors.

Mark is a strategic advisor to his clients, with comprehensive experience in managing global IP portfolios in alignment with business objectives and guiding business leaders, inventors and entrepreneurs on the strategies, tools and techniques for protecting the fruits of their innovation. As a registered U.S. patent attorney with more than 23 years of experience, both in-house and in private practice, he has drafted and/or prosecuted hundreds of patent and trademark applications and counseled his clients on establishing robust trade secret protection programs.

Mark regularly handles licensing, litigation and open source software matters, as well as negotiates and drafts confidentiality, joint development and strategic partnership agreements, and many other complex business contracts for technology companies. Skilled at assessing IP risks and opportunities, Mark's contributions have been especially noteworthy in merger and acquisition and equity investment transactions.

An effective communicator, both as a storyteller and listener, he is equally comfortable conversing with C-suite executives, fellow attorneys and research scientists. Mark is passionate about sharing knowledge and best practices and frequently speaks at conferences and symposia.

16+ Years of In-House Counsel Experience

While serving as the Deputy General Counsel, IP at Color Kinetics, the LED lighting pioneer, Mark accelerated patent filings and orchestrated the company's patent portfolio coverage mapping and validity assessment, increasing the valuation of the company for the imminent acquisition by Philips for ~$800 million.

Mark then spent almost 14 years in leadership roles at Philips Intellectual Property & Standards, supporting various clusters and units globally within the business and research organizations across Royal Philips, N.V. Highlights of his tenure at Philips IP&S include:

- Supporting the successful launch of the patent licensing program for Philips Lighting (now Signify), focused on accelerating LED lighting adoption worldwide;

Education

- Boston University School of Law (J.D., *cum laude,* 2000)
- National Technical University of Ukraine (B.S. in Materials Science and Engineering 1993)

Bar/Court Admissions

- Massachusetts
- U.S. Patent and Trademark Office

Foreign Languages

- Ukrainian
- Russian

Practices

- Intellectual Property
- Artificial Intelligence

- Leading the IP protection efforts prior to the commercial launch of several innovative product lines for Philips Consumer Lifestyle, including AirFryer oven, OneBlade shaver and Sonicare DiamondClean electric toothbrush;
- Spearheading the IP strategy development as part of digital transformation of consumer lifestyle and healthcare clusters;
- Serving as the IP business partner and mentor for Philips HealthWorks startup accelerator program, working with more than 70 early-stage companies worldwide over three years; and
- Leading IP due diligence review for the acquisition of or investment in more than a dozen companies by Philips.

Immediately prior to joining Bond, Mark was the head of IP and the assistant general counsel for a NASDAQ-listed public company, where he built the IP function from the ground up and led the IP strategy development.

Private Practice Experience

Prior to going in-house, Mark was an associate at two large general practice law firms in Boston, representing technology clients such as adidas, Boston Scientific, the Charles Stark Draper Laboratory, E-Ink Corporation, Massachusetts Institute of Technology and RSA Security in IP matters.

Honors & Affiliations

- Boston Intellectual Property Law Association
- Ukrainian-American Bar Association, Chairman of the IP Section
- Recognized as One of the World’s 300 Leading Intellectual Property Strategists, *IAM-Media*, 2018-2019
- “Massachusetts Rising Star” Attorneys Under 40, *Boston Magazine*, 2005-2008

Representative Publications

- "IP Attorney Joins Bond Schoeneck In Boston," *Law360*, October 11, 2022

BOND SCHOENECK & KING ATTORNEYS

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(315) 218-8100 fax

Profile

Blaine is an intellectual property and technology attorney whose practice focuses on patents, trademarks, copyrights and trade secrets. He is a registered patent attorney and has extensive experience prosecuting both patents and trademarks at the United States Patent and Trademark Office and registering copyrights with the United States Copyright Office.

Blaine works closely with inventors to prepare patent applications in the fields of biotechnology, biochemistry, genetics, immunology, molecular biology, chemistry and software applications, among others. His practice also includes preparing opinions of counsel relating to freedom to operate, patentability of inventions, patent validity and patent infringement. Blaine is also experienced in litigation involving all aspects of intellectual property in both administrative proceedings and in federal court.

As a frequent contributor to the Higher Education IP Law Report, Blaine examines and evaluates the latest developments in the field of intellectual property in order to assist universities and other institutions of higher education as they identify, procure and license their intellectual property.

Prior to joining Bond, Blaine obtained a Ph.D. from SUNY Upstate Medical University in Syracuse where his research was in the fields of biochemistry, genetics, cell biology and molecular biology. He served as a Research Assistant to Syracuse University Angela S. Cooney Professor of Law Lisa A. Dolak with whom he co-authored two articles relating to the portrayal of the United States Patent System in the media.

Blaine also has extensive experience regarding the many ethical, legal and social implications and issues associated with personal genomics. He is the author of *The Genetic Genealogist*, a leading blog in the area of direct-to-consumer genetic testing, and is a member of the Personal Genomes Project 1,000.

Representative Matters

Recently Issued Patents

- 8,118,880 Coloring composition containing L-DOPA and L-arginine
- 8,086,675 Generating a fingerprint of a bit sequence
- 8,084,140 Silver platelets comprising palladium

Education

- Syracuse University College of Law (J.D., *magna cum laude,* 2009)
- SUNY Upstate Medical University (Ph.D. in Biochemistry and Molecular Biology 2006)
- St. Lawrence University (B.S., *cum laude,* 1998)

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 Western District of New York
- U.S. Patent and Trademark Office

Practices

- Toxic Tort and Environmental Litigation
- Litigation
- Intellectual Property
- Business and Transactions
- Artificial Intelligence

- 8,060,820 Collaborative editing of a document
- 8,056,774 Fluid dispensing system
- 8,053,744 Location analysis using nucleic acid-labeled tags
- 8,032,523 Method and system for data migration

Honors & Affiliations

- Listed in:
  - *New York Super Lawyers*®, Upstate New York Rising Star, Intellectual Property, 2018 - 2020
- American Bar Association, Intellectual Property Law Section
- New York State Bar Association
- Northern District of New York Federal Court Bar Association
- Onondaga County Bar Association, Executive Committee, Board of Directors; Co-Chair, Continuing Legal Education Committee
- Justinian Honorary Law Society
- Order of the Coif, Syracuse University College of Law Chapter
- Editor, *Journal of Genetic Genealogy*, 2009-Present
- Notes and Comments Editor, *Syracuse Science & Technology Reporter*

Representative Presentations

- A Special Episode Celebrating LGBTQ History Month, Legally Bond Podcast, October 24, 2022
- An Interview with Blaine Bettinger, Investigative Genetic Genealogy, Legally Bond Podcast, June 21, 2021
- Inspirational Speaker and Law Roundtable Facilitator, Northern New York STEP and CSTEP 21st Annual Career Exploration Symposium, February 11, 2017
- Speaker and Panelist, Southern California Genealogy Society Jamboree, Burbank, CA, June 5-8, 2014
- Social Media: Implications for Intellectual Property Law, New York State Science & Technology Law Center, 2010

Representative Publications

- Co-Author, "Four Misconceptions About Investigative Genetic Genealogy," *Journal of Law and the Biosciences,* April 23, 2021
- Quoted in "Are DNA Testing Companies Selling My Genetic Information?," *SuperLawyers.com*, 2018
- Blaine T. Bettinger, George R. McGuire, "How the Supreme Court Got It Right in *Mayo v. Prometheus*," *The SciTech Lawyer*, Volume 10, Issue 1, Fall 2013
- Bettinger, Co-Author, "The United States Patent System in the Media Mirror," *Syracuse Law Review*, 2008, Vol. 58, No. 3. Selected for inclusion in the 2009 PATENT LAW REVIEW, an annual anthology published by Thomson Reuters (West)
- Bettinger, Co-Author, "eBay and the Blackberry®: A Media Coverage Case Study," *Akron Intellectual Property Law Journal*, 2008, Vol. 2, No. 1

- "Pencils, White-Out, and Loose Leaf Paper: Student Researchers' Need for Basic Intellectual Property Instruction," *New York State Science and Technology Center at Syracuse University College of Law Newsletter*, March 2008

Other Activities

- Board President, Directors of DNAngles
- Former Secretary, Board of Trustees, The Erie Canal Museum
- Board Member, The New York Genealogical & Biographical Society
- At Large Representative, The Association of Professional Genealogists

Jonathan L. Gray

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Profile

Jonathan is an intellectual property and registered patent attorney, with an emphasis on patent prosecution, patent litigation, and trademark portfolio management. Jonathan has represented clients of all sizes, from small privately-owned companies to multinational corporations, seeking to protect their inventions and their brands.

As a registered patent attorney, Jonathan has extensive experience drafting and prosecuting patent applications, with a particular focus on electrical and software technologies. He guides clients from idea to application, working closely with them to navigate the application process before the U.S. Patent & Trademark Office and internationally. He also advises clients on managing risk while bringing products to market, including preparing novelty, freedom-to-operate, and validity opinions.

As a litigator, Jonathan provides technical analysis and guidance through all phases of litigation from initial pleadings to claim construction and settlement.

Jonathan also has extensive experience advising clients seeking to protect their brand, including managing global trademark portfolios, preparing, filing and prosecuting domestic and international trademark applications, representing clients in opposition and cancellation proceedings before the Trademark Trial and Appeal Board, negotiating consent agreements, and overseeing international UDRP disputes.

Honors & Affiliations

- Listed in:
  - *The Best Lawyers in America®:* Ones to Watch, Corporate Law, 2025
- Justinian Honorary Law Society
- Computer Editor, *Syracuse Law Review*

Education

- Syracuse University College of Law (J.D., *magna cum laude,* 2014)
- Syracuse University (B.S. in Electrical Engineering 2010)

Bar/Court Admissions

- New York
- U.S. Patent and Trademark Office
- U.S. District Court for the Northern District of New York

Practices

- Intellectual Property
- Business and Transactions

Amanda Rosenfield Lippes

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Profile

Amanda is a member of the firm's intellectual property practice and a registered patent attorney. She focuses her practice on all facets of intellectual property counseling and portfolio development, domestic and foreign.

Intellectual Property Counseling: Amanda represents companies, from startups to multinational corporations, in securing, protecting, managing and enforcing patents, trademarks and copyrights in the United States. She assists clients with all matters before the U.S. Patent and Trademark Office and the U.S. Copyright Office. She also performs patentability and product clearance evaluations, validity/freedom-to-operate analyses, trademark and branding clearance searches, licensing and due diligence for corporate transactions involving intellectual property.

Technical Experience: Amanda has advised clients in a broad range of technologies including medical devices, mechanical devices, consumer products, automotive systems, telecommunications, e-commerce and internet-based systems, information technology, industrial equipment, manufacturing processes, artificial neural networks and software.

Honors & Affiliations

- Listed in:
  - *The Best Lawyers in America*®, Leisure and Hospitality Law, 2025
  - *New York Super Lawyers*® Rising Star, Intellectual Property, 2018-2023
- International Trademark Association (INTA)
- Erie County Bar Association, Intellectual Property, Computer and Entertainment Law Committee
- New York State Bar Association
- University at Buffalo Law Alumni Association
- Brandeis University Alumni Association Leadership Award, 2006

Representative Publications

- "Revisiting the Quid Pro Quo Bargain of the U.S. Patent System," Bond, Schoeneck & King IP Newsletter, Year Recap 2022, February 2023

Education

- University at Buffalo School of Law (J.D.)
- Brandeis University (B.A. in Biology)

Bar/Court Admissions

- New York
- Florida
- U.S. Patent and Trademark Office

Practices

- Intellectual Property
- Business and Transactions
- Hospitality and Tourism
- Artificial Intelligence
- Manufacturing

- Co-Editor, Bond, Schoeneck & King IP Newsletter, Winter 2021 Recap, April 2021
- Co-Editor, Bond, Schoeneck & King IP Newsletter, Summer/Fall 2020 Recap, December 2020
- Co-Editor, Bond, Schoeneck & King IP Newsletter, Winter 2020 Recap, May 2020
- “New Trademark Filing Rules: What You Need To Know,” Bond, Schoeneck & King IP Newsletter, Winter 2020 Recap, May 2020
- "U.S. Supreme Court Shaping IP Law," *Buffalo Law Journal*, April 3, 2017

Other Activities

- Friends of Reinstein Woods, Executive Board Member and Secretary, 2018 - present
- Legal Counsel, Buffalo Junior Chamber of Commerce, 2018-2019
- Attorney, Sub-Board I, Inc. Legal Assistance Office, University at Buffalo, 2016-2019

BOND SCHOENECK & KING ATTORNEYS

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Profile

George is a registered patent attorney and member 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
- 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*®, Litigation - Intellectual Property; Litigation - Patent; Patent Law, 2010-2025 (listed for more than 15 years)
  - *New York Super Lawyers*®, Intellectual Property, 2024 (listed for more than 10 years)
  - Western New York's Power Players, Power 20 List, Intellectual Property, *The Daily Record*, 2021
  - *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, Client Counseling in Trademark and Copyright, New York State Bar Association, July 16, 2024
- Intellectual Property Law 101, Bridging the Gap, New York State Bar Association, June 11, 2024
- Intellectual Property, Bridging the Gap, New York State Bar Association, April 26, 2022

- Intellectual Property 101 – What Non-IP Lawyers Need to Know about IP, Bridging the Gap, New York State Bar Association, December 10, 2020 and October 14, 2021
- Intellectual Property 101 – Key Skills in Issue Spotting - A General Practitioner's Guide to Advising Clients on the Basics of Intellectual Property, Copyright and Trademarks, New York State Bar Association CLE Program, July 16, 2020
- Intellectual Property Law 101, New York State Bar Association, 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

Representative Publications

- "Book it as Protectable: The Supreme Court Holds Booking.com is a Protectable and Registerable Trademark," *IP Litigator*, Volume 26, Issue 6, November/December 2020
- "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 (2016-2020)/Executive Committee, IP and Innovation American Inn of Court
- Member, International Trademark Association Right of Publicity Committee
- Adjunct Professor of Internet Law, Syracuse University College of Law
- Chairman of the Board, Milton J. Rubenstein Museum of Science and Technology (MOST) Foundation
- Board Member, Onondaga Historical Association
- Board Member & Treasurer, East Area Family YMCA of Greater Syracuse
- Board of Trustees, Everson Museum of Art, 2000-2006
- Advisory Board Member, Make-A-Wish Foundation of Central New York, Board Chair 2004-2006
- Past Board Member, March of Dimes/North CNY Chapter
- Past Advisory Board, New York State Science and Technology Law Center
- Past Editorial Advisory Board Member, Journal of the Association of University Technology Managers (AUTM)

BOND SCHOENECK & KING ATTORNEYS

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Profile

Dave specializes in U.S. patent law and helps university and corporate clients maximize the value of intellectual property with creative patenting and licensing strategies. He also regularly assists clients by crafting invention disclosure programs, providing employee training on intellectual property protection and business management best practices, and negotiating complex licensing deals.

Dave is a registered U.S. patent attorney who has prepared and prosecuted hundreds of patent applications worldwide, encompassing a variety of technologies including:

- electronic and pneumatic braking systems
- locomotive energy management systems
- small molecule pharmaceuticals
- shape memory polymers
- medical devices
- biomaterials

In addition to an extensive proficiency with the rules and procedures of the U.S. Patent and Trademark Office, Dave teaches an upper level course on patent prosecution at the Syracuse University College of Law. He also regularly shepherds Patent Cooperation Treaty (PCT) applications through patent offices in Australia, Brazil, Canada, China, Europe, India and South Africa and is well-versed in the nuances of international patent strategy.

As lead counsel in numerous patent, trademark, copyright and trade secret litigation matters, Dave has first chair trial experience in federal district court and before the U.S. International Trade Commission. His litigation matters have included:

- nationally-known consumer electronic goods
- medical devices
- computer software systems
- ground fault circuit interrupters
- yogurt
- roller coasters

Education

- Syracuse University College of Law (J.D., *summa cum laude,* 2000)
- Cornell University (B.S. in Biology 1991)

Bar/Court Admissions

- New York
- U.S. Court of Appeals for the Federal Circuit
- U.S. District Court for the Northern District of New York
- U.S. District Court for the Western District of New York

Practices

- Litigation
- Intellectual Property
- Business and Transactions
- Essential Resources for Business
- Semiconductor Industry

Dave has also lectured on intellectual property protection strategies for the Special American Business Internship Training (SABIT) Program of the U.S. Department of Commerce, local business and industry leaders, and undergraduate and graduate business classes and entrepreneurial programs.

Representative Matters

Recent Patents

- 9,851,528 Optical coating permitting cavity self-locking
- 9,821,822 Automatic parking brake for truck mounted brake cylinder
- 9,819,781 System for providing temporary speed restrictions to locomotives
- 9,789,889 Slack adjuster for narrow gauge railroad cars
- 9,758,808 Bioluminescence resonance energy transfer between bioluminescent proteins and semiconductive nanomaterials
- 9,752,180 Methods and compositions for amplification and detection of MicroRNAs
- 9,744,041 Shape-memory-actuated materials for accelerated healing of orthopedic injuries
- 9,737,587 Treatment of autism spectrum disorders with ciliary neurotrophic factor peptide mimetic
- 9,643,587 Sequence valve for a brake cylinder having an automatic parking brake
- 9,604,281 Method to control void formation in nanomaterials using core/alloy nanoparticles with stainless interfaces
- 9,603,905 Intranasal insulin administration for the minimization of anesthesia-induced memory loss
- 9,505,825 Methods and systems for zinc delivery using intrinsic factor or haptocorrin
- 9,450,572 Self-cascadable phase shifter
- 9,422,393 Water-triggered shape memory of PCL-PEG multiblock TPUs
- 9,340,578 Inhibitors targeting human ghrelin O-acyltransferase
- 9,249,203 Treatment of brain injury with a neurotrophic peptide

Recent IP Litigation

- General Mills, Inc. v. Chobani, LLC, 3:16-cv-58 (NDNY) – Assisted Fortune 500 company in obtaining a preliminary injunction against allegedly false advertising campaign launched by competitor
- Fage Dairy Industry v. General Mills, Inc. 11-cv-01174 (NDNY) – Represented trademark owner in appeal by plaintiff from adverse Trademark Trial and Appeal Board decision
- Conmed Corporation v. Cosmescu et al, 6:13-cv-01226 (NDNY) – Successfully defended publicly traded corporation from patent infringement claims brought by a competitor

Honors & Affiliations

- Listed in:
  - *The Best Lawyers in America*®, Patent Law; Trademark Law, 2022-2025
  - *New York Super Lawyers*®, Intellectual Property, 2018
  - *Martindale-Hubbell*®, AV Preeminent Rated
- New York State Bar Association
- Onondaga County Bar Association
- Justinian Honorary Law Society
- Form and Accuracy Editor, *Syracuse Law Review*
- Corpus Juris Secundum Recipient
- West Outstanding Achievement Award Recipient

BOND SCHOENECK & KING ATTORNEYS

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Profile

Joseph is an intellectual property and technology attorney who has more than 25 years of experience in patent infringement, patent validity, all aspects of patent application preparation and prosecution, and correction of errors in issued patents through reexamination and reissues.

He draws on both his in-house and private practice experience to counsel domestic and international corporations, university research institutions, start-ups and entrepreneurs.

Joseph is experienced in a wide variety of technologies relating to the chemical and mechanical arts, including energy, petroleum cracking catalysts, catalytic converters, internal combustion engines, biofuels, fuel cells, nanotechnology, semiconductor fabrication, medical devices, microelectromechanical systems (MEMS) including electrospray ionization and nanofabrication techniques including deep reactive-ion etching (DRIE), medical devices, optics, optical fibers and pharmaceuticals.

Honors & Affiliations

- New York Bar Association
- Virginia Bar Association
- Monroe County Bar Association
- American Chemical Society
- American Intellectual Property Law Association
- Rochester Intellectual Property Law Association

Representative Presentations

- Reasons to File a Patent on Your Research Discovery, F.I.R.E. (For Inventors, Researchers, and Entrepreneurs) Series LXVII, University of Rochester Medical Center, January 12, 2012
- Common Intellectual Property Pitfalls and How to Avoid Them, Growth Leadership Seminar Series, High Tech Rochester, December 1, 2011

Representative Publications

Education

- George Washington University (J.D.)
- State University of New York at Cortland (B.S. in Chemistry)

Bar/Court Admissions

- New York
- U.S. Court of Appeals for the Federal Circuit
- U.S. Court of Appeals for the Fourth Circuit
- U.S. District Court for the Eastern District of Virginia
- U.S. Patent and Trademark Office

Practices

- Intellectual Property

- "Bill Would ‘Harmonize’ Patent Process with World," *The Daily Record*, March 9, 2011. Joseph provided commentary throughout this feature story discussing a proposed Senate bill prior to the passage of the America Invents Act that includes significant changes to the U.S. patent system.

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(315) 218-8100 fax

Profile

Fred concentrates his practice on intellectual property law, including patents, trademarks, copyrights and trade secrets.

He is a registered patent attorney and has extensive experience prosecuting patents and trademarks at the United States Patent and Trademark Office (USPTO) and registering copyrights with the United States Copyright Office. Fred works closely with inventors to prepare patent applications and to prepare responses to Office Actions in the fields of nanotechnology, medical devices, fuel cells, alternative and renewable energy, mechanical devices, particle and gas filters, chemistry, entropic activity detection and monitoring systems and computer software systems, among others. He has also worked closely with inventors in reexamination proceedings at the USPTO.

Fred's transactional work includes the preparation of opinions of counsel including novelty (patentability), invalidity and right-to-use/non-infringement/freedom-to-operate opinions. He also drafts license agreements, assignment agreements, master service agreements, distribution agreements and sponsored research agreements, among others.

Fred's litigation work includes the preparation of cease and desist letters and responses to cease and desist letters. He represents or has represented clients in numerous patent, trademark and copyright litigation matters in federal district court and before the U.S. International Trade Commission (ITC) on matters involving computer software systems, ground fault circuit interrupters, Voice over Internet Protocol (VoIP) technology, food containers and fishing line products. Fred also represents clients in Uniform Domain-Name Dispute Resolution Policy (UDRP) proceedings, and in trademark opposition and cancellation proceedings.

Fred is a member of the firm's e-discovery and information management practice, which acts as a resource to the firm and to the firm's clients with all phases of the everchanging landscape of the e-discovery process. He is also a contributor to the firm's intellectual property and technology practice's newsletter.

Prior to joining Bond, Fred was an intellectual property associate with the New York City office of Fulbright & Jaworski LLP (Fulbright). While at Fulbright, he prosecuted patents related to cancer therapies and diagnostics, assisted with a patent interference relating to micro-electro-mechanical systems (MEMS), assisted with the defense of an international pharmaceutical company in a dispute over a cancer therapy drug and conducted due diligence and reviewed patents in response to

Education

- Syracuse University College of Law (J.D., *magna cum laude,* 2003)
- Le Moyne College (B.S. in Biology 1995)

Bar/Court Admissions

- New York
- U.S. Patent and Trademark Office
- 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 Western District of New York

Practices

- Toxic Tort and Environmental Litigation
- Litigation
- Intellectual Property
- Cybersecurity and Data Privacy
- Business and Transactions
- Manufacturing

proposed mergers.

Prior to attending law school, Fred worked at a research company in Boulder, Colorado, where he conducted research on the heterogeneous catalysis of a wide variety of environmental and industrial processes including exhaust gas purification. He also previously conducted chemical research on new consumer products.

Representative Matters

- CONMED; reg. no. 5467478; goods - Medical apparatus and instruments for use in endoscopic, laparoscopic, arthroscopic, gastroenterology, pulmonary and orthopedic procedures and/or surgery, general surgery, robotic surgery, open surgery, cardiac and critical care; medical imaging and visualization apparatus and medical imaging and visualization processors; insufflators for medical purposes; patient monitoring sensors and alarms; surgical smoke evacuation devices for capturing and filtering smoke during electrosurgical procedures; electrosurgical motors being part of surgical and medical apparatus and instruments for use in general surgery; biopsy instruments; medical apparatus for intravenous administration of fluids, namely, gravity flow control devices; and enteral feeding pumps and tubes; owner - ConMed Corporation
- HAMILTON; reg. no. 5435816; services - Educational services, namely, conducting higher education classes in the field of liberal arts and distribution of course material in connection therewith; owner - Trustees of Hamilton College
- DENTAL CLAIMS CLEANUP, LLC; reg. no. 5278272; services - Dental billing support and management services; accounts receivable billing support and management services; and consulting services in the field of dental practice
-

;

  reg. no. 4382658; services - Providing weight loss program services; owner - Medical Weight Loss of NY, PLLC
- MYWEB; reg. no. 4310306; goods - Computer application software for mobile phones, tablets, personal computers, and other electronic devices with the ability to connect to the Internet or other communication network, namely, software for enabling text messaging, web messaging, and instant messaging within the same social networking application or platform or across different social networking applications or platforms, and for facilitating communications between members of the same or different social networking applications or platforms through the use of personalized animated avatars; owner - My Web Software, LLC

Honors & Affiliations

- Listed in:
  - *New York Super Lawyers*® Intellectual Property, 2022

- Upstate New York Rising Star, Intellectual Property, 2014

- Justinian Honorary Law Society
- Order of the Coif
- New York State Bar Association
- Onondaga County Bar Association
- American Society of Heating, Refrigerating and Air-Conditioning Engineers (ASHRAE)
- Institute of Electrical and Electronics Engineers (IEEE)
- International Society of Automation (ISA)
- Executive Editor, *Syracuse Law Review*

Representative Presentations

- What Every Capital Region Business Needs to Know about Cybersecurity and GDPR, Albany Business Review Smart Series, April 16, 2019

Other Activities

- Board Member, Technology Alliance of Central New York
- Former Board Member, CNY Jazz Arts Foundation