Author Biographies

Chapter 1: Introduction
Kenneth L. Dorsney

Kenneth L. Dorsney is a partner and Chair of the Intellectual Property Practice in the Wilmington, Delaware office of Morris James LLP. He is a registered United States patent attorney and former judicial clerk to the Honorable Chief Magistrate Judge Mary Pat Thynge, U.S. District Court for the District of Delaware, and to the Honorable District Court Judge Kent A. Jordan, U.S. District Court for the District of Delaware (now on the U.S. Court of Appeals for the Third Circuit). Ken has assisted outside counsel and clients as Delaware counsel or co-counsel on over four hundred patent cases involving a broad range of technologies, including numerous pharmaceutical cases brought under the Hatch-Waxman Act. In addition to Evidence in Patent Cases, Ken is Editor-in-Chief and co-author of two other books: ANDA Litigation: Strategies and Tactics for Pharmaceutical Patent Litigators, and Pre-ANDA Litigation: Strategies and Tactics for Developing a Drug Product and Patent Portfolio. His Juris Doctor is from the University of Pittsburgh School of Law, and he earned degrees in Mechanical Engineering and Criminal Justice from the University of Delaware.

Part I: Evidentiary Issues in Patent Litigation

Chapter 2: Preliminary Evidentiary Issues
David S. Bloch and Lowell D. Jacobson

David S. Bloch is a partner in the San Francisco and Menlo Park offices of Winston & Strawn LLP. He holds a B.A. from Reed College, where he was a member of Phi Beta Kappa, and obtained his Juris Doctor (with honors) and Master of Public Health degrees from the George Washington University. In 1997, Mr. Bloch was a Fellow in International Trade Law with the University Institute of European Studies in Turin, Italy. The author or co-author of IP and Technology in Government Contracts and more than 50 articles and book chapters, Mr. Bloch has served as a lecturer at the University of California–Boalt Hall School of Law and is a frequent speaker worldwide on a wide range of intellectual property
topics. Mr. Bloch is a member of the Bar of the State of California and the District of Columbia.

Lowell D. Jacobson is an associate at the Chicago office of Winston and Strawn LLP, where his practice focuses on complex intellectual property litigation in the high-tech space. He is registered to practice before the U.S. Patent and Trademark Office and is a member of New York and Illinois bars. He earned a Bachelor of Science in Electrical Engineering, cum laude, from Columbia University, and a Bachelor of Arts in Physics and History from Williams College. He obtained his law degree from George Mason University School of Law (now Antonin Scalia Law School), where he completed the patent law specialty track. Following law school, Mr. Jacobson was a judicial clerk for the Hon. Lawrence J. Block on the United States Court of Federal Claims.

Chapter 3: Evidentiary Issues in Preliminary and Permanent Injunction Hearings

Ross R. Barton and David L. Gann

Ross R. Barton is a partner in Alston & Bird’s Intellectual Property Litigation Group. He is a trial lawyer focusing his practice on the litigation of complex patent disputes before district courts and the U.S. International Trade Commission (ITC). With a background in physics and a deep understanding of mobile technologies, semiconductors, and software and hardware programming languages, Ross has spent the last decade taking high-stakes cases in the high-tech sector to trial. Ross was selected to the Super Lawyers “Rising Star” list for IP Litigation in 2007 in Virginia and 2012 in North Carolina, and he was recognized in The Best Lawyers in America© in 2018. He previously taught patent litigation courses as an Adjunct Professor at the University of Virginia School of Law and at the Catholic University of America’s Columbus School of Law. He has previously served as the vice chair of the Intellectual Property Owners Association’s ITC and Damages & Injunctions Committees. He earned his A.B. from Bowdoin College and his J.D. from Washington & Lee University. Ross is admitted to practice in North Carolina, Virginia and before the U.S. Patent and Trademark Office.

David L. Gann is a senior associate in Alston & Bird’s Intellectual Property Litigation Group. David focuses his practice primarily on actions for patent infringement, with a particular emphasis on high-stakes, complex litigation. He has represented both plaintiffs and defendants in actions involving a broad range of technologies and products, including wireless and wired communications, control systems, hardware and logic, microprocessors, computer software, mobile applications, and various consumer electronics. David has litigated in district courts throughout the country, in Section 337 investigations at the International Trade Commission, and in arbitration proceedings before the ICC International Court of Arbitration. David has been recognized as a Georgia Super Lawyers “Rising Star” in Intellectual Property Litigation each year from 2015 to 2018. David graduated cum laude from Georgia State University.
College of Law, where he served as a member of the Moot Court Board and Intellectual Property Law Society. He earned his B.S. in electrical engineering from the Georgia Institute of Technology and is a registered professional engineer in the state of Georgia. His former professional experience includes several years working as a control systems engineer, where he designed and implemented automation solutions for several large companies. David is admitted to practice in Georgia and before the U.S. Patent and Trademark Office.

Chapter 4: Evidentiary Issues During Discovery

Neil A. Benchell

Neil A. Benchell is an attorney with the Devlin Law Firm, practicing in Chicago, Illinois. His practice focuses on all aspects of intellectual property with an emphasis on patent and trademark litigation, including Hatch-Waxman pharmaceutical litigation, counseling, and licensing. His litigation experience spans a broad array of technologies and industries including pharmaceutical, signal processing, data storage, telecommunications, automotive, petroleum manufacturing and chemical before the Federal Courts and the International Trade Commission. Mr. Benchell received his Bachelor of Arts degree in Computer Science from Indiana University and after an 18 year career in the industry, received his law degree from Loyola University of Chicago. Mr. Benchell is now an adjunct professor at Loyola teaching patent litigation, and coaches Loyola’s undergraduate Mock Trial team. He is also the Chair of the Intellectual Property section of the DuPage County Bar Association. Mr. Benchell lectures on intellectual property, and has published on the Digital Millennium Copyright Act. He is the editor of the chapter Clinical Trials and Regulatory Considerations in the book PRE-ANDA LITIGATION: STRATEGIES AND TACTICS FOR DEVELOPING A DRUG PRODUCT AND PATENT PORTFOLIO.

Chapter 5: Specific Types of Patent Evidence

Eric H. Weisblatt and Anu Sharma

Eric H. Weisblatt has over 30 years’ experience as a patent litigator, the last 20 years as the first chair. He has litigated numerous cases before various district courts and at the Federal Circuit in all fields, from diapers to nuclear fuel rods to progressive eyeglass lenses to cases in the chemical, life science, and pharmaceutical arenas, with extensive experience in ANDA litigation. After 28 years at the legendary firm of Burns, Doane, Swercher & Mathis, he spent seven years at Wiley Rein, before joining Hunton Andrews Kurth LLP for two years. He now consults with clients at the Law Office of Eric H. Weisblatt. Registered to practice before the U.S. Patent and Trademark Office, Eric is also admitted to practice before the United States Supreme Court, the U.S. Courts of Appeal for the Federal Circuit and the Fourth Circuit, and the U.S. District Courts for the Eastern District of Virginia and Eastern District of Wisconsin.
Anu Sharma is a patent attorney in the Washington, D.C. office of Hunton Andrews Kurth LLP. Mr. Sharma devotes his time to counseling clients on patent prosecution, patent litigation, and post-grant matters on a wide range of subject matter areas, including telecommunications, microprocessors, and business methods. Mr. Sharma graduated from Purdue University (B.S. in Electrical Engineering), Franklin Pierce Law Center (Master’s in Intellectual Property Law), and Suffolk University Law School (J.D.). Prior to law school, Mr. Sharma served as a trademark litigation clerk, and also worked at two major university technology transfer offices and in a software start-up company. During law school, Mr. Sharma served as a patent examiner extern at the United States Patent and Trademark Office, where he focused on examination of patent applications, including computer architecture software and information security, before becoming a patent agent at a mid-size firm in Boston. Registered to practice before the U.S. Patent and Trademark Office, Mr. Sharma is also admitted to practice in the Commonwealth of Massachusetts and in the District of Columbia.

Chapter 6: Pretrial Issues: Claim Construction and Summary Judgment

Eric Joseph Klein, Mario Aurel Apreotesi, and Jeffrey R. Swigart

Eric Joseph Klein is a partner with Vinson & Elkins LLP in Dallas, Texas. He is a trial lawyer who focuses on intellectual property matters with a particular emphasis on patent litigation and inter partes review proceedings. He has a broad background in engineering, and extensive experience building cases in highly technical subject-matter areas. His practice encompasses all aspects of case preparation, discovery, expert preparation, claim construction, trial preparation and trial. Eric graduated from the Texas Tech University School of Law and holds a B.S.C.E. from Texas A&M University and a M.E.E. (Electrical and Computer Engineering) from Purdue University.

Mario Aurel Apreotesi is an attorney with Vinson & Elkins LLP in Austin, Texas. His practice focuses on patent litigation and inter partes review proceedings. Mario graduated from Harvard Law School and, after law school, Mario clerked for Justice Daniel Winfree of the Alaska State Supreme Court. He earned his Bachelor of Science and Master of Science degrees in Mechanical Engineering from Oregon State University, where he graduated Summa Cum Laude.

Jeffrey R. Swigart is an attorney with Vinson & Elkins LLP in Dallas, Texas. His practice primarily focuses on patent litigation. He also provides advice related to intellectual property portfolio management with regard to growth opportunities and mergers and acquisitions. Jeffrey graduated with distinction from the University of Oklahoma, College of Law, and is a member of the Order of the Barristers. While in law school, Jeffrey was a judicial extern for the Honorable Judge Robert E. Bacharach on the United States Court of Appeals for the Tenth Circuit. Jeffrey earned his Bachelor of Science in Electrical Engineering from Oklahoma State University where he graduated Magna Cum Laude. Prior to law school,
Jeffrey was a staff engineer at Southwest Research Institute in San Antonio, Texas.

Chapter 7: Trial
Gregory S. Gewirtz, Jonathan A. David, and Alexander Solo

Gregory S. Gewirtz is a partner at the intellectual property law firm of Lerner, David, Littenberg, Krumholz and Mentlik, LLP. Greg has practiced in many aspects of patent and trademark law since 1991, with extensive experience in patent litigation, post-grant proceedings before the United States Patent and Trademark Office, licensing, studies and prosecution involving electrical engineering technologies, mechanical products and medical devices. He has been the lead counsel in numerous district court actions throughout the United States, as well as in appellate actions before the Court of Appeals for the Federal Circuit. Greg has lectured and authored on various aspects of patent litigation and prosecution, and is a former Master in the John C. Lifland American Inn of Court. He holds a Bachelor of Science degree in electrical engineering from Rutgers University College of Engineering, is a registered patent attorney, and worked as an electrical engineer for RCA and General Electric in their aerospace divisions.

Jonathan A. David is a partner at the intellectual property law firm of Lerner, David, Littenberg, Krumholz and Mentlik, LLP. Jon has handled all aspects of patent litigation and patent prosecution since 1992, and has litigated patent and trademark cases in numerous federal jurisdictions across the United States. Jon's litigation experience has been predominantly in technology areas such as consumer electronics, telecommunications, and computers. Jon also authors and lectures on the patentability of business and software-related patents, and is a registered patent attorney. He holds a Bachelor of Science degree in electrical engineering from Cornell University.

Alexander Solo is an attorney at the intellectual property law firm of Lerner, David, Littenberg, Krumholz and Mentlik, LLP. For over 10 years his practice has focused on litigation and resolution of contentious intellectual property matters in venues throughout the United States. His cases have spanned diverse technological fields including medical devices, software, nanomaterials, interactive entertainment, and others. Alex also advises clients on strategies for intellectual property procurement and licensing. He is a registered patent attorney and has a bachelor's degree in computer science.

Chapter 8: Evidentiary Issues in Claims of Willful Infringement
Elizabeth H. Rader

Elizabeth H. Rader began her legal career clerking for the Honorable Alvin A. Schall of the Federal Circuit and the Honorable Leonie M. Brinkema of the Eastern District of Virginia. As counsel at Alston & Bird, LLP, she specializes in Federal Circuit appeals and
mission-critical motions in intellectual property cases in the U.S. district courts. She strives to make highly technical subject matter understandable to present her clients’ positions in a way that is compelling.

Chapter 9: Evidence Issues Regarding Inequitable Conduct
Jeffrey D. (Jeff) Dyess, Benn C. Wilson, Jacob W. (Jake) Neu, and Dennis Núñez

Jeffrey D. (Jeff) Dyess is a litigation partner in the Birmingham office of Bradley Arant Boult Cummings. An experienced IP and commercial litigator and registered patent attorney, Jeff devotes a significant amount of his practice to patent, intellectual property and trade secret litigation matters. Jeff has litigated patent disputes in federal district courts in Alabama, California, Delaware, Maryland, Texas, and Utah. He also has patent litigation experience before the International Trade Commission and the Patent Trial and Appeal Board of the U.S. Patent and Trademark Office. Jeff is admitted to practice in all federal District Courts in Alabama as well as in the United States Courts of Appeal for the Eleventh Circuit and the Federal Circuit. In 2002, he was admitted to practice before the U.S. Patent and Trademark Office.

Benn C. Wilson is an associate in the Birmingham, Alabama, office of Bradley Arant Boult Cummings LLP. Mr. Wilson’s practice focuses on complex civil litigation, principally in the areas of patent and IP litigation. Benn has represented clients in complex patent and other IP disputes before federal district courts in Alabama, Delaware, Maryland, Minnesota, Mississippi, Texas and Utah, as well as the United States International Trade Commission and the Trademark Trial and Appeal Board. Before entering private practice, Mr. Wilson was a clerk for Judge Lanier Anderson of the 11th Circuit Court of Appeals, and for Chief Judge Ashley Royal of the United States District Court for the Middle District of Georgia. Mr. Wilson is a graduate of the University of Georgia School of Law, and received a BS and MS in Chemical Engineering from Georgia Tech.

Jacob W. (Jake) Neu is an associate in the Intellectual Property group in the Nashville office of Bradley Arant Boult Cummings. His clients range from tech entrepreneurs to large consumer goods manufacturers. His practice includes all aspects of intellectual property, including patent and trademark prosecution, technology licensing, software licensing, and related matters. Jake also has experience in patent litigation before district courts, the International Trade Commission, and the Patent Trial and Appeal Board, and in trademark inter partes disputes before the Trademark Trial and Appeal Board.

Dennis H. Núñez is a senior attorney at Bradley, Arant, Boult, Cummings, LLP in Huntsville, Alabama. His practice focuses on patent prosecution and he has drafted more than 200 U.S. utility patent applications with an emphasis on integrated circuits (IC), semiconductor fabrication, and 802.11 technology. He also manages patent prosecution of foreign patent applications in China and Europe. Prior to graduating from law school, Dennis earned a B.S. in Electrical Engineering from
the University of Alabama, and has several years of industry experience in Huntsville. He is an honors graduate of Chicago/Kent College of Law.

Chapter 10: Evidence Issues in AIA Trials
Mark J. Feldstein, Ph.D., Rachel L. Emsley, and Cara Regan Lasswell

Mark J. Feldstein, Ph.D., is a partner in the Washington, DC office of Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, where he focuses on U.S. district court patent and trade secret litigation, post-grant trial proceedings at the USPTO, including IPRs and PGRs, and appeals to the U.S. Court of Appeals for the Federal Circuit. Dr. Feldstein also maintains an active patent prosecution practice and teaches patent strategy as an Adjunct Professor at Georgetown University. His practice encompasses a wide range of technologies, including pharmaceuticals, biochemistry, chemistry, chemical engineering, polymers, nanotechnology, optics, and medical and diagnostic devices. Dr. Feldstein holds a J.D. from Georgetown University and a Ph.D. in chemistry from the University of Pennsylvania.

Rachel L. Emsley, is an associate in the Boston office of Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, where she focuses on PTAB trials and appeals from PTAB decisions to the U.S. Court of Appeals for the Federal Circuit, as well as district court litigation. Rachel has been a key team member on both the petitioner and patent owner sides in PTAB trials. She has successfully argued motions before the Board, and has developed winning 35 U.S.C. §§101, 102, 103 and 112 positions in PTAB proceedings. Ms. Emsley has been a guest lecturer for Suffolk University’s PTAB practice course, and co-chairs the Boston Patent Law Association’s Contested Matters Committee, which focuses on adversarial proceedings at the USPTO. Ms. Emsley’s litigation and USPTO practice spans a wide range of technologies, including software, communication networks, telecommunications devices, data storage devices and networks, signal processing, computer graphics, and semiconductors. Before joining Finnegan, Ms. Emsley spent several years working in semiconductor product development for a Boston-area company, designing hardware and software solutions to showcase analog-to-digital converter technologies and working with customers to define new integrated circuit (IC) products. Ms. Emsley holds a J.D. with highest honors from Suffolk University Law School, and a B.S. in Electrical Engineering from Boston University.

Cara Regan Lasswell is a former associate at Finnegan, Henderson, Farabow, Garrett & Dunner, LLP. She received a B.S. in physics-engineering, cum laude, and a B.A. in history, cum laude, from Washington and Lee University. Ms. Lasswell also received her J.D., summa cum laude, from Washington and Lee University. While at Finnegan, Ms. Lasswell worked on an array of IP matters involving consumer products, medical devices, industrial manufacturing, and vehicular technologies. Ms. Lasswell’s practice focused on trial litigation and contentious proceedings at the USPTO, as well as patent prosecution, and strategic client counseling. She handled inter partes review (IPR) proceedings before the Patent Trial and Appeal Board, where she represented both patent owners and
petitioners, and district court litigations. She also participated in appeals to the U.S. Court of Appeals for the Federal Circuit. Ms. Lasswell maintained a client counseling practice and assisted clients in evaluating infringement risks and negotiating license agreements.

Chapter 11: Evidence Issues in Investigations at the United States International Trade Commission
Jonathan Tuminaro, Ph.D. and Dallin G. Glenn

Jonathan Tuminaro, Ph.D., is a director in Sterne Kessler’s Trial & Appellate and Electronics Practice Groups. He focuses his practice on patent litigation at the International Trade Commission, the U.S. district courts, and the Patent Trial and Appeal Board (PTAB). Jonathan is an experienced litigator who has examined witnesses at trial, argued motions before judges, drafted briefs before the Federal Circuit, and tried dozens of cases before the PTAB. He regularly represents clients in the electrical, software, medical, mechanical, and chemical arts. He has been named a 2015, 2016, 2017, and 2018 DC Super Lawyers “Rising Star” in IP litigation. Jonathan regularly publishes and speaks regarding issues at the PTAB and the International Trade Commission. Before becoming a practicing attorney, Jonathan received his Bachelor’s degree in physics and mathematics from Canisius College, and was a member of the ’95–’96 Men’s Basketball team that won the Metro Atlantic Athletic Conference Tournament and earned an automatic bid to the NCAA Division I Men’s Basketball Tournament. He then went on to earn a Master’s degree and a Ph.D. in physics from the University of Maryland. He received his J.D. from George Mason University.

Dallin G. Glenn is an associate in Sterne Kessler’s Trial & Appellate Practice Group. Dallin has worked in many aspects of intellectual property law, including litigation at the U.S. International Trade Commission (ITC) and in district courts, post-grant patent challenges at the USPTO, drafting patent applications and pursuing global prosecution strategies, and providing opinions on intellectual property matters. Dallin has represented clients in more than ten high-stakes disputes at the ITC, and his strategic input and procedural expertise make him a valued member of the firm’s ITC practice. While attending George Mason University School of Law, Dallin interned for the Honorable Chief Administrative Law Judge Paul J. Luckern of the ITC, assisting the Chief Judge with an extensive docket of Section 337 investigations.

Chapter 12: Hatch-Waxman Cases
Stephen R. Auten, Jaimin Shah, and Courtney A. Carapella

Stephen R. Auten is head of the Pharmaceutical & Life Sciences Litigation practice area at Taft Stettinius & Hollister LLP. He is widely recognized as a seasoned attorney in Hatch-Waxman and biosimilar matters, including related patent litigation, and is followed by key leaders in pharmaceutical industries (brand and generic alike), law firms, analysts, educators and others on his LinkedIn blog, Hatch-Waxman ANDA Litigation
Forum or HALF, which has over 8,500 members worldwide. He currently advises clients primarily on Paragraph IV design strategies, Hatch-Waxman litigation, and biosimilar market opportunities. Prior to Taft, he led the IP division for Sandoz for several years. Steve is recognized by Chambers USA as a top Intellectual Property attorney in Illinois, as well as by his peers in The Best Lawyers in America for IP Litigation, as an Illinois Leading Lawyer, an Illinois Super Lawyer in IP Litigation, and as a “World’s Leading Patent Practitioner” by Intellectual Asset Management magazine.

Jaimin Shah is an associate in the Chicago office of Taft Stettinius & Hollister LLP, where he focuses on patent litigation and counseling related to pharmaceuticals and biosimilars. Jaimin has represented world-class pharmaceutical companies in various phases of litigation. Prior to attending law school, Jaimin worked at a large India-based generic pharmaceuticals company as a manager in the company's Intellectual Property Cell. He received a B.Sc. in biochemistry from St. Xavier's College, Ahmedabad and an M.Sc. in biotechnology from the Indian Institute of Technology–Bombay. His J.D. is from The John Marshall Law School, cum laude, where he received the CALI award in Professional Responsibility and International Law. Jaimin was a judicial extern for the Hon. James F. Holderman and the Hon. Virginia M. Kendall in the U.S. District Court for the Northern District of Illinois.

Courtney A. Carapella was an associate at Taft, Stettinius & Hollister during the summers of 2017 and 2018. She is a second-year student at Northwestern University Pritzker School of Law where she is a member of the Northwestern Journal of Technology and Intellectual Property. Ms. Carapella is also a member of the Intellectual Property Law Association of Chicago and American Intellectual Property Law Association. Outside her legal studies, she volunteers with the Street Law program educating Chicago-area high school students on various areas of the law, and works, pro bono, at the Cook County Domestic Violence Legal Clinic. Ms. Carapella graduated from Northwestern University with a B.A. with concentrations in chemistry and psychology (neuroscience). As a member of the Van Duyne Research Group at Northwestern University, Ms. Carapella conducted solvent annealing studies to improve the stability of patterned silver nanoparticles against femtosecond laser exposure in nanoscale optical biosensors by optimizing synthetic and clinical sample parameters for improved detection of biomarkers for Alzheimer’s disease.

Chapter 13: Evidentiary Issues in the Federal Circuit Court of Appeals: Preservation and Avoiding Waiver
Michael J. Schaengold, Patrick J. (P.J.) McCarthy, and Myomi T. Coad

Michael J. Schaengold is a shareholder in the Washington, D.C. office of Greenberg Traurig, LLP, where he focuses his practice on litigation in the U.S. Court of Appeals for the Federal Circuit and its trial tribunals. Mike regularly represents clients in patent/government contracts litigation in the U.S. Court of Federal Claims and in patent and government contracts appeals to the Federal Circuit. He has represented clients in
some of the largest Federal Circuit appeals, including several valued at more than $500 million. He has been appointed by four Federal Circuit Chief Judges to that Court’s Advisory Council and/or Rules Advisory Committee, and has been appointed by two Court of Federal Claims Chief Judges to that Court’s Advisory Council. He currently serves on both Councils and, from 2004–2010, was Co-Chair of the Federal Circuit Advisory Council. He served as a law clerk to Federal Circuit Judge H. Robert Mayer. He has been selected as a Washington, D.C. Super Lawyer (2007, 2013–18); listed in Who’s Who Legal, Government Contracts (2015–18); and listed in Washingtonian Magazine as a Washington, D.C. Best Lawyer (2017).

Patrick J. (P.J.) McCarthy is a partner in the IP Litigation practice of Goodwin Procter LLP. Mr. McCarthy is a first chair patent litigator who litigates complex patent disputes from start to finish across a broad range of complex technologies, especially in the computer, electronic, and mechanical arts. Mr. McCarthy is particularly experienced in handling Section 337 Investigations at the International Trade Commission, having now handled nearly thirty investigations. In addition to ITC matters, he handles a steady flow of District Court matters across the country and has argued at the Federal Circuit.

Mr. McCarthy’s practice also spans a wide-range of experience with start-ups in non-litigation capacities, such as IP procurement, IP valuation, company valuation, and overall IP and non-IP corporate strategy for clients. Prior to joining Goodwin in 2018, Mr. McCarthy was a partner at Greenberg Traurig.

Myomi T. Coad is an attorney in the patent litigation group in the Washington, D.C. office of Goodwin Procter LLP. Her practice focuses on patent litigation in U.S. district courts, Section 337 investigations in the U.S. International Trade Commission, and review proceedings before the Patent Trial & Appeal Board. Myomi graduated from the University of New Hampshire School of Law (formerly the Franklin Pierce Law Center) and holds a B.S. in Chemistry from Southern Methodist University. While in law school, Myomi was a judicial intern with the Honorable Ron Clark in the U.S. District Court for the Eastern District of Texas, served as chair of the Student Intellectual Property Law Association, and was a competitor in the International Trademark Association’s Saul Leffowitz Moot Court Competition. Before entering private practice, Myomi served as a Special Assistant U.S. Attorney at the U.S. Attorney’s Office for the District of Columbia. Myomi is also active in pro bono matters, and represents clients in removal proceedings in immigration court.

PART II: FEDERAL RULES OF EVIDENCE IN PATENT LITIGATION

Chapter 14: General Provisions
Anthony F. Lo Cicero and Mark Berkowitz

Anthony F. Lo Cicero is an engineer by training, and has been a practicing attorney for more than four decades. As a partner at Amster,
Rothstein & Ebenstein LLP, Mr. Lo Cicero has represented companies in litigation involving product areas ranging from e-commerce platforms, angular rate sensors, HDMI connectivity and flat panel displays. He conducts due diligence of IP portfolios and provides strategic intellectual property counseling to companies in a wide variety of industries. In the public sector, Mr. Lo Cicero is a Past President of the New York Intellectual Property Association. He has been active in advocating responsible patent reform, and was involved in shaping the Trademark Anti-Counterfeiting Act of 1984. He served on the board of the International Anti-Counterfeiting Coalition during seminal efforts to strengthen the protection of federal and state laws.

**Mark Berkowitz**’s practice focuses on all aspects of intellectual property, with an emphasis on patent litigation. Mark has litigated patents covering a wide variety of technologies, including consumer electronics, semiconductors, e-commerce, power distribution and medical devices. He has assisted in all phases of patent cases, from pre-suit investigations through appeal, including discovery, Markman briefing and dispositive motions. Prior to attending law school, Mark worked as an electrical engineer in the defense industry. Mark uses his technical and legal background to support patent disputes both in traditional litigation and before the Patent Trial and Appeal Board.

**Chapter 15: Rule 201. Judicial Notice**

*John P. Bovich, Christine M. Morgan, and Christopher J. Pulido*

**John P. Bovich** is a partner with Reed Smith LLP in San Francisco. John is a commercial and technology trial lawyer, specializing in patent infringement litigation. John has served as lead counsel in numerous patent infringement lawsuits involving software, hardware, graphical user interfaces, 3-D graphics, networking, cloud storage and medical imaging technology, among others. He has been named by the *Daily Journal* as one of California’s Top Intellectual Property Litigators, and that journal called his defense verdict at trial for NETGEAR, in the Fujitsu v. NETGEAR litigation, one of the Top Defense Verdicts of 2012. John received his A.B. from the University of Michigan and his J.D. from the University of Wisconsin. John also serves as a member of Reed Smith’s Executive Committee, the firm’s global governing board.

**Christine M. Morgan** is counsel with Reed Smith LLP in San Francisco. Chris is an intellectual property litigator and has tried patent cases across the country, including in the Northern District of California, the Eastern District of Texas, and the International Trade Commission. Her patent litigation experience includes representing both plaintiffs and defendants in cases involving both design and utility patents. Her patent cases have involved a wide range of technologies and products. Examples include semiconductors, semiconductor packaging, software, wireless technology, Power over Ethernet technology, LED technology, promotion programs, and printer cartridges. Chris also has had recent success invalidating patents as “abstract” and ineligible for patent protection under the Supreme Court’s landmark decision, *Alice Corp. Pty. Ltd.*
Evidence in Patent Cases

v. CLS Bank Int'l, 134 S. Ct. 2347 (2014). Chris received her B.S. from the University of California, Davis and her J.D. from Santa Clara University.

Christopher J. Pulido is an associate with Reed Smith LLP in San Francisco and is a member of the firm’s IP, Tech & Data Group. His practice focuses primarily on intellectual property litigation, specifically in the areas of patent, trademark, trade secret and copyright. He also has experience representing clients in complex commercial litigation matters in both state and federal courts. Chris received his B.S. from the University of Oregon, Lundquist College of Business and his J.D. from Santa Clara University.

Chapter 16: Rule 301. Presumptions in Civil Cases Generally

Derek A. Newman and Sergio D. Becerra

Derek A. Newman is the managing partner of Newman Du Wors LLP, a firm he founded in 1998 with offices in Seattle, Los Angeles, and San Francisco. He has represented both plaintiffs and defendants in patent cases involving computer technology, mechanical devices and industrial systems. Derek has helped defendants invalidate patents and plaintiffs recover millions of dollars in judgments, settlements, and royalties. He has litigated hundreds of cases in United States district courts across the country and has argued appeals before the United States Court of Appeals for the Federal Circuit and several regional federal appeals courts. Derek graduated from Pepperdine University School of Law.

Sergio D. Becerra graduated from Pepperdine University School of Law in 2018. As a patent agent, Sergio has prosecuted patents covering a wide variety of technologies, including the mechanical and digital arts, with a special focus on software patents. While in law school, he provided independent counsel to a French firm regarding U.S. patent filings, served as the Note and Comment Editor for the Journal of Business, Entrepreneurship and the Law, completed pro bono work at the Union Rescue Mission in Los Angeles, and wrote a published article addressing the impact that changing technology and artificial intelligence are having on the practice of law. Sergio holds a B.S. in Chemistry and is fluent in Spanish.

Chapter 17: Rule 401. Test for Relevant Evidence

Sri K. Sankaran and Devan V. Padmanabhan

Sri K. Sankaran is a shareholder of Winthrop & Weinstine, in Minneapolis. He represents clients in patent infringement cases in a variety of fields, including software, communication networks, pharmaceuticals and nutritional supplements. He has also litigated copyright, trademark, trade secret and unfair competition matters. He works closely with clients to understand their businesses, their technology, what exactly is at stake, and to develop a client’s strategy based on each individual case. He earned his J.D., cum laude, from the University of Michigan Law School, and his B.A., with honors, from the University of Chicago. He has been recognized for his legal skills by Best Lawyers in America and
as an “IP Star” by Euromony/MIP. He is a regular author on intellectual property and patent topics.

**Devan V. Padmanabhan** is a shareholder of Winthrop & Weinstine, in Minneapolis. He is chair of the Patent group at the firm, and serves on the Board of Directors for the firm. For more than 20 years, Devan has helped clients litigate and manage patent portfolios with national and international needs. His experience includes patent litigation cases covering a wide range of technologies and industries, and across all intellectual property areas, including patent, copyright, unfair competition, trademark, and technology-based cases. With his background as an electrical engineer, he deftly combines his technical, engineering, legal, and business skills to his client’s advantage. He has represented clients in a wide range of industries, including medical and chemical technologies and devices, pharmaceuticals, food and nutritional formulations, manufacturing and machinery, data and communications networks, computer software, agricultural products and processes, business systems, optical sensors, and others. Devan earned his J.D. cum laude, from Northwestern University Pritzker School of Law, and his B.S. in Electrical Engineering from Northwestern University. He has been recognized by a number of organizations for his legal skills, including Chambers USA, *Best Lawyers in America* and Euromoney/MIP.

**Chapter 18: Rule 501. Privilege in General**

**Andrew M. (Jake) Grove**

Andrew M. (Jake) Grove is a member of Howard & Howard Attorneys PLLC in its Royal Oak, Michigan, office. Jake has been recognized as one of the leading intellectual property litigators by Super Lawyers®, Best Lawyers in America® (including as its Lawyer of the Year honor in 2018), and others. Jake specializes in intellectual property litigation. He also works as an adjunct professor at the University of Detroit Mercy Law School teaching Trademarks and Unfair Competition Law. Jake received a B.A. in English with High Honors from the University of Michigan, and a B.S. in Engineering cum laude, also from the University of Michigan. Additionally, he earned an M.A. in English Literature from the University of Chicago. His J.D. is from Wayne State University Law School. Jake co-authored *Cases and Materials on Patent Law, 6th Edition*. He has also written widely on intellectual property topics, and has appeared as a lecturer, panelist, and panel discussion leader at numerous conferences.

**Chapter 19: Witnesses**

**Patricia A. Carson and Thomas F. Fleming**

Pat Carson is an intellectual property partner in the New York office of Kirkland & Ellis LLP. She has established a reputation as a top litigator in the life sciences field. While she focuses her practice on patent litigation including jury and bench trials, Pat also has extensive experience counseling clients on patenting strategy, patenting evaluation and IP due diligence relating to transactions, including licensing, joint
ventures and acquisitions. She has represented clients in the pharmaceutical, biotechnology, chemical, medical device, consumer health care, consumer electronics and semiconductor fields. Pat recently led the trial team in *Regeneron v. Merus*, prevailing on behalf of her client Merus on all issues including non-infringement, invalidity and unenforceability due to inequitable conduct. That victory was upheld on appeal by the Federal Circuit.

Pat has been recognized in *The National Law Journal*’s “Defense Hot List” feature and by *Intellectual Asset Management (IAM) Life Sciences 250—The World’s Leading Life Sciences Lawyers*. She was also honored in *Managing Intellectual Property’s IP Stars—Top 250 Women in IP*, and was also selected as a “Life Science Star” by *LMG Life Sciences*.

**Thomas F. Fleming** is an intellectual property partner in the New York office of Kirkland & Ellis LLP. He is a veteran trial lawyer with extensive experience in complex commercial litigation, intellectual property litigation and patent litigation. He has co-chaired numerous jury patent trials in the areas of biotechnology, pharmaceuticals and wireless technology, and has been lead counsel in patent and trade secret litigation matters in the areas of chemical products, devices and genetically modified crops. He has argued numerous appeals, including before the Federal Circuit. Thomas advises Fortune 100 companies on intellectual property aspects of international merger and acquisition matters, licensing and deal related matters. Thomas has been recognized by *The Legal 500 U.S.* He is also listed in *The Best Lawyers in America* and *The Best Lawyers in New York*.

**Chapter 20: Opinions and Expert Testimony**

**Mark J. Feldstein, Ph.D., Shana K. Cyr, Ph.D., and Kelly S. Horn**

**Mark J. Feldstein, Ph.D.,** is a partner in the Washington, DC office of Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, where he focuses on U.S. district court patent and trade secret litigation, post-grant trial proceedings at the USPTO, including Inter Partes Reviews (IPRs) and Post-Grant Reviews (PGRs), and appeals to the U.S. Court of Appeals for the Federal Circuit. Dr. Feldstein also maintains an active patent prosecution practice and teaches patent strategy as an Adjunct Professor at Georgetown University. His practice encompasses a wide range of technologies, including pharmaceuticals, biochemistry, chemistry, chemical engineering, polymers, nanotechnology, optics, and medical and diagnostic devices. Dr. Feldstein holds a J.D. from Georgetown University and a Ph.D. in chemistry from the University of Pennsylvania.

**Shana K. Cyr, Ph.D.,** is a partner in the Reston, Virginia, office of Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, where she focuses on complex patent disputes related to pharmaceuticals, biologics, combination products, and diagnostics. Her experience includes traditional patent litigation, Hatch-Waxman litigation related to abbreviated new drug applications, and 505(b)(2) applications, proceedings before the International Trade Commission, inter partes reviews, inter partes
reexaminations, interferences, and appeals to the U.S. Court of Appeals for the Federal Circuit. Dr. Cyr also counsels clients on issues at the intersection of patent and U.S. Food and Drug Administration law, and specializes in working with inventors and experts in the chemical and pharmaceutical arts. Her pro bono work includes representing disabled veterans and disadvantaged children. She previously served as a judicial law clerk to the Honorable Kimberly A. Moore at the U.S. Court of Appeals for the Federal Circuit, and as a legal intern for the Honorable Noel L. Hillman at the U.S. District Court for the District of New Jersey. Dr. Cyr holds a J.D. with high honors from Rutgers University, a Ph.D. in chemistry from the University of Virginia, and a B.S. in chemistry from the University of Richmond.

**Kelly S. Horn** is an associate in the Washington, D.C. office of Finnegan, Henderson, Farabow, Garrett & Dunner, LLP. She is a registered patent attorney who regularly appears before the U.S. Patent and Trademark Office on behalf of clients to obtain and defend utility and design patents. Kelly draws on her experience before the USPTO to help clients assert and defend patent infringement claims before the International Trade Commission and in U.S. district courts. Her technical experience spans a broad range of technologies, including medical imaging, biosurgical products, welding systems, control systems, automotive systems, power production systems, blockchain technology, and communications systems. Kelly also represents clients on a pro bono basis before the U.S. Court of Appeals for Veterans Claims and the Social Security Administration. She has drafted successful appellate briefs on behalf of military veterans and represented disabled Americans in proceedings before the SSA. Kelly earned her J.D. with honors from Georgetown University Law Center, her M.S. in bioengineering from Rice University, a B.S. in biomedical engineering with honors from Rutgers University, and a B.A. in political science with high honors from Rutgers University.

**Chapter 21: Article VIII. Rule 801. Hearsay**

**Anil Patel, Ph.D., Peter Giunta, and Kenneth C. Liao**

**Anil Patel, Ph.D.** is a partner in the Houston and New York offices of K&L Gates LLP. He earned a Ph.D. in physical chemistry from the University of Florida and his J.D. from Emory University School of Law, where he served as managing editor of the Emory International Law Review. He focuses his practice on intellectual property litigation in the pharmaceutical and chemical industries. Dr. Patel has served as lead counsel in numerous Hatch-Waxman litigation cases. He has experience in all phases of patent litigation, including *Markman* hearings, *Daubert* motions, direct and cross-examination of fact and expert witnesses, fact and expert discovery and depositions, motion practice, and pre-trial and post-trial briefing. Dr. Patel’s scientific background, together with his breadth of expertise in legal issues relevant to the pharmaceutical industry, allow him to provide his clients with sophisticated advice, leading to a competitive advantage. Dr. Patel also focuses a significant portion
of his practice on advising clients on patent licensing agreements and settlement agreements, including specific experience in negotiating settlements of Hatch-Waxman litigations. Relatedly, he frequently advises clients on FDA regulatory matters, with a focus on matters relating to regulatory exclusivities. Additionally, Dr. Patel’s practice involves advising clients on IP due diligence matters relating to potential acquisitions of target products and companies. In this context, his expertise includes advising clients not only on the IP related matters, but also in providing an overall assessment of the impact of IP, regulatory and other legal issues on the business potential of the target acquisition. Dr. Patel’s experience includes counseling clients on non-infringement and invalidity opinions, drafting Paragraph IV notice letters and detailed statements; advising clients on products for portfolio selection, including evaluation of potential launch dates, as well as legal and regulatory hurdles.

Peter Giunta is a partner in the New York office of K&L Gates LLP. He focuses on technology disputes, including patent, unfair competition, and commercial litigation. Mr. Giunta practices in federal district courts, the U.S. Court of Appeals for the Federal Circuit, the International Trade Commission, and the U.S. Patent & Trademark Office Patent Trial and Appeal Board. He advises clients in a wide array of industries, including pharmaceuticals, biotechnology, medical devices, and electronics. He has extensive experience in Hatch-Waxman pharmaceutical patent litigation and related patent opinion, prosecution, and licensing strategies, navigating the interface between the patent and FDA laws. Mr. Giunta graduated from Benjamin N. Cardozo School of Law, where he was Production Editor of the Cardozo Law Review. He also earned a B.S. in Chemistry from Seton Hall University. Before entering private practice, he served as a judicial clerk to the Honorable Lawrence M. McKenna, U.S. District Court Judge in the Southern District of New York, whose docket included patent, trademark, contract, securities, and criminal cases.

Kenneth C. Liao is a patent attorney in the New York City office of K&L Gates LLP, whose practice focuses on advising clients on their patent and intellectual property strategies, including patent procurement, intellectual property licensing, and intellectual property disputes. Mr. Liao studied biology and chemistry at New York University, with a focus on bioinformatics. He earned his J.D. from the Evening Division at the Fordham University School of Law. Prior to entering private practice, Mr. Liao was a researcher at Memorial Sloan-Kettering Cancer, working in cancer genetics, and a software engineer with Credit Suisse, working on a variety of aspects of securities trading technology.

Chapter 22: Authentication and Identification
Louis E. Fogel and Susan A. O’Brien

Louis E. Fogel is a partner in Jenner & Block LLP’s Chicago office, where he is the co-chair of the Life Sciences subgroup of the firm’s Patent Litigation and Counseling Practice. Mr. Fogel received both his Ph.D. in chemistry and his J.D. from the University of Chicago, and he is a
Registered Patent Attorney admitted to practice before the United States Patent and Trademark Office. His practice focuses on complex commercial and intellectual property litigation, including patent and trade secrets. He also provides patent-related client counseling and advises clients with IP-related transactions. In addition, Mr. Fogel is a frequent speaker and author on intellectual property issues. His litigation experience spans a wide array of technologies and industries, including pharmaceuticals, biological drugs, medical devices, chemicals, consumer electronics and telecommunications. Mr. Fogel also has an active and diverse pro bono practice, representing parents in administrative hearings who are involved in the child welfare system, engaging in district court litigation involving civil rights statutes, and, as a member of the Northern District of Illinois Trial Bar, being appointed counsel in pending district court civil litigation matters.

Susan A. O’Brien is an associate in Jenner & Block LLP’s Chicago office, where she focuses on patent litigation in both the firm’s Litigation Department and Patent Litigation and Counseling Practice. Ms. O’Brien received her B.S. in biology from the University of Miami, and an M.S. in chemistry and biochemistry from the University of California, Santa Cruz, where she investigated techniques that could increase the bio-availability of pharmaceuticals. Sue received her J.D. from the University of Chicago as a Rubenstein Scholar, where she participated in the Institute for Justice Clinic on Entrepreneurship and the LAF Housing Clinic. Ms. O’Brien is admitted to practice before the United States Patent and Trademark Office. As a member of the Federal Circuit Bar Association, Ms. O’Brien is a monthly contributor to the FCBA Case Digest and has worked on a number of IP-related issues involving biological pharmaceuticals and high-profile technologies.

Chapter 23: Contents of Writings, Recordings and Photographs
Eric A. Buresh, Jason R. Mudd, and Carrie A. Bader

Eric A. Buresh is a Shareholder and founder of Erise IP in the Kansas City office. Over the last fifteen years, Eric has litigated over 135 patent infringement matters in district courts across the nation. He has also led teams in multiple appeals at the Federal Circuit and handled several cases through trial at the International Trade Commission. Eric currently represents clients in multiple technology areas, including GPS technology, consumer electronics, digital rights management, video games and systems, e-commerce, and multiple aspects of data network technology and testing. Eric obtained a degree in engineering with honors and graduated law school summa cum laude. Following law school, Eric clerked for a federal judge, focusing on patent infringement cases. Eric is licensed in numerous federal courts around the country, the Federal Circuit, and also is licensed to practice before the United States Patent and Trademark Office. Eric has been recognized as a “Super Lawyer” in each of 2013–2017 as well as an “IP Star” by Managing Intellectual Property and an “IP Trailblazer” by The National Law Journal.
Jason R. Mudd is a Shareholder in the Kansas City office of Erise IP. His practice focuses on patent litigation before federal district courts across the country, the U.S. International Trade Commission, the U.S. Court of Appeals for the Federal Circuit, and in post-grant proceedings before the U.S. Patent and Trademark Office. Mr. Mudd successfully represented the petitioner in the very first *inter partes* review proceeding under the America Invents Act of 2011. His experience involves representing a wide array of clients from startups to large multi-nationals in a wide array of technologies, including software, microelectronics, automotive, textiles, medical devices, avionics, telecommunications, and many others. Mr. Mudd received a B.S. *magna cum laude* in Chemical Engineering and a J.D. with honors from the University of Missouri, where he was a member of Order of the Coif and an editor of the Missouri Law Review. He has been named to a select list of national “IP MVPs” by *IP Law360*, and has been recognized as an “IP Trailblazer & Pioneer” by the *National Law Journal*, an “IP Star” by *Managing Intellectual Property*, and a “Super Lawyer” by *Super Lawyers*.

Carrie A. Bader is a Shareholder in the Kansas City office of Erise IP. She focuses her practice on litigation of patent, trademark, copyright, and trade secrets cases, and has clients in a wide range of industries including video games, consumer electronics, toys, wearable technology, and telecommunications. Ms. Bader also counsels clients on IP-related issues, including software development and licensing agreements. Prior to joining Erise, Ms. Bader clerked for Justice Beier on the Kansas Supreme Court and continues her involvement in the Kansas legal community through leadership roles in the Kansas Women Attorneys’ Association. Ms. Bader received her B.A. from the University of Southern California in Cinema–Television and her J.D. from the University of Kansas, where she was the Editor-in-Chief of the *Kansas Journal of Law & Public Policy*. She was also named a 2017 “Rising Star” in Intellectual Property Litigation by *Super Lawyers*.

*Chapter 24: Article XI. Miscellaneous Rules*

Travis W. Bliss, Ph.D.

Travis W. Bliss, Ph.D. is an intellectual property attorney in the Wilmington, Delaware office of Buchanan Ingersoll & Rooney PC. Travis is the Chair of the firm’s IP Biotechnology Practice Group, and also heads the firm’s plant IP practice within that group. As that suggests, from a technology standpoint, Travis’s practice falls largely within the life sciences field, including novel plant varieties (e.g., in the ornamental, fruit, and cannabis industries), transgenic plants, diagnostic testing methods/apparatus, pharmaceuticals and biologics, and treatment methods. Within the cannabis industry, Travis is a thought leader in the area of IP protections for cannabis-based inventions, including novel cannabis varieties and products. Travis counsels clients in nearly all major aspects of intellectual property law, from procurement of IP assets, to monetizing those assets, to enforcement of IP rights for those assets. From a
litigation standpoint, Travis's practice includes actions brought in state and federal courts, as well as actions brought before the USPTO's Patent Trial and Appeal Board, including Inter Partes Review actions and interference proceedings. Prior to entering the legal profession, Travis earned both a Bachelor of Science and a Ph.D. in Animal Science from the Department of Agriculture at the University of Delaware, with course work and research that focused on animal and plant genetics, molecular immunology, biotechnology, and bioinformatics.