



## Jeffrey S. Ginsberg

Partner

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Jeffrey Ginsberg has over twenty-five years of experience litigating patent infringement disputes and other intellectual property matters including false advertising, unfair competition, trademark infringement and trade secret misappropriation. Mr. Ginsberg has represented clients before numerous federal district courts, the International Trade Commission and the Patent Trial and Appeal Board (PTAB). He has had lead roles in bench and jury trials, and appellate proceedings. His technical experience covers an array of technologies including automotive parts, mechanical systems, manufacturing processes, electronics, telecommunications, medical devices, endodontic products, networked exercise equipment, agrochemicals, pharmaceuticals, mass spectrometers, and polymeric materials. Additionally, he has substantial experience in patent prosecution, client counseling, opinion work, due diligence and licensing.

Mr. Ginsberg has served as an editor for the *Intellectual Property Strategist* for more than a decade reviewing and reporting on intellectual property decisions of significance. He has also been recognized as a 2020 “Client Service All-Star” by BTI. This award recognizes attorneys who “stand above all the others in delivering the absolute best in client service.” In recognition of his work in a landmark trade secrets suit, Mr. Ginsberg was featured in *The American Lawyer’s* ‘Litigators of the Week’ (May 13, 2022). *Benchmark Litigation* also recognized Mr. Ginsberg as a “Litigation Star” in 2024.

### Representative Experience

- Represented a global enterprise software company in an action for trade secret misappropriation against a major competitor. Following a seven-week trial, the jury found that the defendant misappropriated our client’s trade secrets, and awarded our client over \$2 billion in damages. (Va. Fairfax Cir.). The jury also found that the defendant violated the Virginia Computer Crimes Act.
- Represented leading medical device manufacturer in assertion of a patent directed to an ultrasonic device. (S.D. Ohio). Following a favorable claim construction ruling, the Court granted client’s motion for summary judgment of infringement and lack of available non-infringing alternatives. Case settled favorably on the eve of trial with a nine figure payment to our client.
- Defended networked exercise equipment provider against allegations of patent infringement of several patents. (E.D. Tex./PTAB). Case settled favorably after the PTAB granted client’s petitions for *inter partes* (IPR) of all claims of the challenged patents.
- Defended leading medical device manufacturer against allegations of infringement of numerous patents directed to advanced bipolar electrosurgical devices. (D. Mass.). Obtained stipulations of dismissal of several of the patents prior to trial. Court found all asserted claims of remaining patents not infringed after a two week trial resulting in significant victory for our client.

- Defended endodontic equipment manufacturer against allegations of infringement of patents directed to methods of making nickel-titanium endodontic instruments. (E.D. Tenn./PTAB/Fed.Cir.). In separate IPR and post grant review (PGR) proceedings initiated after the district court action was filed, the PTAB found all challenged claims unpatentable on multiple grounds. The Federal Circuit affirmed the IPR unpatentability decision. The Patent Owner withdrew its appeal of the PGR decision, resulting in a final judgment that all challenged claims of the second patent were also unpatentable. The district court action was then dismissed with prejudice resulting in a complete victory for our client in this “bet the company” litigation.
- Defended several dental supply companies against allegations of trade secret misappropriation in Tennessee state court. Obtained dismissal of all claims.
- Represented industry leader in the design and manufacture of screening equipment used in the mining, and oil and gas drilling industries with enforcement of patents on vibratory screening machines and replaceable screens that are used with the machines. Obtained highly favorable settlement after claim construction hearing. (W.D. La.).
- Represented a leading global engineering and electronics company in connection with enforcement of patents covering braking systems. (E.D. Mich.). Obtained highly favorable settlement.
- Represented a leading global engineering and electronics company in connection with enforcement of patents covering automotive parts against numerous parties in various district courts. Obtained jury verdict finding patents valid and infringed by one defendant, which was affirmed on appeal. (D. Del./Fed. Cir.). Obtained favorable settlements from numerous other defendants in more than 15 subsequent actions.
- Defended a home shopping network against allegations of infringement of patent directed to reverse auction in district court action and related Covered Business Method (CBM) review proceeding. Following hearing before the PTAB, all 39 claims of patent were found to be invalid. (E.D. Tenn./PTAB).
- Represented a broadband technology developer in connection with enforcement of patent concerning communications systems and methods for dynamically allocating data signaling channels. Obtained a multimillion dollar settlement on eve of trial. (E.D. Tex.).
- Defended an endodontic equipment manufacturer against allegations of infringement of patents related to root canal files in district court and ITC. (W.D. Pa./ITC). Case ended after favorable manufacturing/supply agreement was entered. In subsequent breach of contract action, jury awarded client \$44 million in damages. (D.N.M.).
- Defended pharmaceutical company against allegations of infringement of patents covering prenatal vitamins. Case settled favorably on eve of trial. (D. Del.).
- Represented a leading global medical technology company in a false advertising case concerning X-ray contrast agents. District court found in favor of client after trial on its false advertising counterclaim. (DNJ).
- Defended leading engineered materials company against allegations of infringement of patent on a measurement system for type of plywood. Obtained summary judgment of non-infringement. (W.D. La.).
- Represented a leading global engineering and electronics company in a patent infringement case before the ITC related to windshield wipers, which settled favorably after final hearing began. (ITC).
- Represented a major manufacturer of analytical instruments in connection with enforcement of patent related to triple quadrupole mass spectrometers. Obtained jury verdict of \$47.5 million, the fourth-largest jury verdict in an intellectual property case that year. Verdict affirmed on appeal. (D. Del./Fed. Cir.).
- Represented manufacturer of dental products in declaratory judgement action concerning allegations of infringement of patent directed to making custom dental impression trays. Obtained summary judgment of non-infringement, which was affirmed on appeal. (E.D.N.Y./Fed. Cir.).
- Represented multinational consumer products company in connection with enforcement of patent directed to nicotine patches; case settled favorably on eve of trial. (S.D. Fla.).

## **Admissions**

- U.S. Supreme Court
- U.S. Patent and Trademark Office

- U.S. Court of Appeals, Federal Circuit
- U.S. District Court, Southern and Eastern Districts of New York; District of Colorado; District of New Jersey; Eastern District of Pennsylvania; Eastern District of Texas
- New York
- New Jersey
- Pennsylvania

## Professional Activities

MEMBERSHIPS: American Bar Association; American Intellectual Property Law Association; New York Intellectual Property Law Association; Gibbons Institute Advisory Board

## Publications

- Co-Author, "Federal Circuit Affirms Precedential Opinion Panel Decision Limiting the Circumstances In Which the Board Should Raise *Sua Sponte* Patentability Issues Against Proposed Substitute Claims," *The Intellectual Property Strategist* (May 2022)
- Co-Author, "Federal Circuit: Applicant Admitted Prior Art Cannot Provide a "Basis" for a Ground of Unpatentability In an IPR, But Can be Cited for Other Purposes" *The Intellectual Property Strategist*, (March 2022)
- Co-Author, "Pair of Federal Circuit Decisions Address Standing to Appeal Adverse IPR Decision" *The Intellectual Property Strategist*, (January 2022)
- Co-Author, "Federal Circuit Clarifies Pleading Requirements for Patent Cases and Affirms Grant of Summary Judgement of Invalidity Under 35 U.S.C. §101" *The Intellectual Property Strategist*, (September 2021)
- Co-Author, "Federal Circuit: The Doctrine of Equivalent is Not a Binary Choice" *The Intellectual Property Strategist*, (May 2021)
- Co-Author, "Federal Circuit: Texas Court Abused Its Discretion By Delaying On Venue Transfer Motion While Proceeding With the Merits of the Case" *Law Journal Newsletters, The Intellectual Property Strategist*, (March 2021)
- Co-Author, "Federal Circuit: Post-Employment Assignment Clause Void Under California Law" *Law Journal Newsletters, The Intellectual Property Strategist*, (January 2021)
- Co-Author, "Federal Circuit: HP Not Estopped from Challenging Claims Deemed Unchallengeable in IPR That It Had Joined" *Law Journal Newsletters, The Intellectual Property Strategist*, (November 2020)
- Co-Author, "Federal Circuit: ITC Did Not Err in Denying Non-Respondent's Petition to Rescind Exclusion Order Based on Invalidity Grounds" *Law Journal Newsletters, The Intellectual Property Strategist*, (September 2020)
- Co-Author, "Federal Circuit Holds PTAB Judges Unconstitutional, Constructs a Fix—But Not All Judges Agree on What Happens Next," *Law Journal Newsletters*, (January 2020)

## Education

- Seton Hall University School of Law (J.D., 1993)
- Lafayette College (B.S., 1990)
  - Metallurgical Engineering
  - Dean's List

# Publications

March 2024

**Federal Circuit: ITC Did Not Err In Finding Violation Of Section 337**

*The Intellectual Property Strategist*

May 3, 2022

**Federal Circuit Affirms Precedential Opinion Panel Decision Limiting the Circumstances In Which the Board Should Raise *Sua Sponte* Patentability Issues Against Proposed Substitute Claims**

*The Intellectual Property Strategist*

March 4, 2022

**Federal Circuit: Applicant Admitted Prior Art Cannot Provide a “Basis” for a Ground of Unpatentability In an IPR, But Can be Cited for Other Purposes**

*The Intellectual Property Strategist*

January 10, 2022

**Pair of Federal Circuit Decisions Address Standing to Appeal Adverse IPR Decision**

*The Intellectual Property Strategist*

September 9, 2021

**Federal Circuit Clarifies Pleading Requirements for Patent Cases and Affirms Grant of Summary Judgement of Invalidity Under 35 U.S.C. §101**

*The Intellectual Property Strategist*

May 3, 2021

**Federal Circuit: The Doctrine of Equivalents is Not a Binary Choice**

*The Intellectual Property Strategist*

March 4, 2021

**Federal Circuit: Texas Court Abused Its Discretion By Delaying On Venue Transfer Motion While Proceeding With the Merits of the Case (March 2021)**

*The Intellectual Property Strategist*

January 6, 2021

**Federal Circuit: Post-Employment Assignment Clause Void Under California Law (January 2021)**

*The Intellectual Property Strategist*

November 17, 2020

**Federal Circuit: HP Not Estopped from Challenging Claims Deemed Unchallengeable in IPR That It Had Joined (November 2020)**

*The Intellectual Property Strategist*

September 14, 2020

**Federal Circuit: ITC Did Not Err in Denying Non-Respondent's Petition to Rescind Exclusion Order Based on Invalidity Grounds (September 2020)**

*The Intellectual Property Strategist*

January 2, 2020

**Federal Circuit Holds PTAB Judges Unconstitutional, Constructs a Fix—But Not All Judges Agree on What Happens Next (January 2020)**

*Law Journal Newsletters*