

Frederick S. Frei



**Senior Partner**

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Fred Frei is an experienced IP litigator and specializes in patent litigation. He has been litigating IP cases for more than 35 years, has tried many patent cases and has first chaired numerous others that resulted in either favorable settlements or summary judgment. Fred has litigated in state and federal courts, including bankruptcy court, throughout the country and at the International Trade Commission. Fred, a registered patent attorney, has been involved with the patent system for more than 40 years, including five years as a Patent Examiner with the U.S. Patent and Trademark Office.

His IP litigation experience spans patents, trademarks and copyrights and electrical, chemical and mechanical technologies. For example, Fred's representations have included pharmaceutical and nutritional supplements, cosmetics, medical devices, chemical sensors, optical sensors, food products, solar cells, coolant systems, packaging products, optical disc products and players, plastic products and plastic molding processes and apparatus, road-milling equipment, catalytic converters, electronic commerce, thin-screen monitors, equipment used to irradiate the U.S. mail, power converters, and ground fault circuit interrupters.

Fred was the lead patent trial counsel for the pioneer patent covering all modern-day optical discs (e.g., CDs and CD-ROMS). After a trial which confirmed its validity and where its claims were determined to cover the industry standard discs, the patent ultimately had 140 licensees, including the largest electronics and music companies in the world. Fred has been on trial teams composed solely of patent attorneys and trial teams where there was a mix of commercial litigators and patent attorneys.

His litigation experience began after completion of his clerkship for the Chief Judge of the U.S. Sixth Circuit Court of Appeals. In addition to IP cases, he has obtained favorable judgments in an assortment of petroleum price control cases for one of the world's largest oil companies and in contract, antitrust, franchise and fraud cases. For several years, he was responsible for the day-to-day activities, representing a major petroleum company, on the largest case ever filed—the FTC oil industry divestiture case filed against the world's eight largest oil companies. Fred has also represented individuals and companies in federal grand jury investigations involving mail and wire fraud, price fixing and bribery of state officials. Fred's first litigation victory still stands today as the only case where a federal appellate court invalidated a Department of Energy price control regulation on the grounds of lack of statutory authority.

Fred's practice also includes counseling relating to the creation, protection, management and exploitation of intellectual property assets, including acquisitions, sales and licensing. He has extensive experience in rendering patentability, validity, infringement

**PRACTICES**

Intellectual Property Litigation  
Intellectual Property Counseling and Litigation

**EDUCATION**

JD, 1973, Georgetown University Law Center, *Georgetown Law Journal*, Editor; First Prize in the Nathan Burkan Memorial Copyright Law Writing Competition  
BS, 1968, Chemical Engineering, Cornell University, Dean's List, scholarship recipient  
Law Clerk to the Honorable Harry Phillips, Chief Judge US Sixth Circuit Court of Appeals (September 1973-August 1974)

**ADMISSIONS**

Massachusetts 1989  
District of Columbia 1974  
US Patent and Trademark Office

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and enforceability opinions and in conducting product clearance studies.

REPRESENTATIVE EXPERIENCE

- *Cascades Computer Innovation, LLC v. Sony-Ericsson Mobile Communications (USA) Inc.* (N.D. Ill.). Representation of defendant in a patent infringement action involving cellular phones.
- *Frito-Lay North America, Inc. v. Innovia Films Limited* (E.D.Tx.). Representation of defendants in a case involving inventorship of US and foreign patent applications for bio-based packaging films.
- ITC Section 337 Investigation (Certain motion-sensitive sound effects devices and image display devices and components and products containing same, Inv. No.337-TA-2799)
- *WiAV Solutions LLC v. Motorola Mobility, Inc.* (E.D. Va). Representation of defendant in patent infringement case relating to sound encoding for cell phones.
- *Adrain v. NDI Technologies, Inc.* (M.D. Fla.). Representation of defendants in patent infringement case relating to license plate recognition system.
- *Technical Witts, Inc. v. Skynet Electronic Co., Ltd.* (Fed. Cir. 2010). Representation of defendant-appellee in appeal in patent infringement case involving power converters.
- *Wyers v. Master Lock Co.* (Fed. Cir. 2009). Representation of defendant-appellant in appeal in patent infringement case involving locks.
- *Orion IP, LLC v. Hyundai Motor America* (Fed. Cir. 2009). Representation of plaintiff-appellee in patent infringement case involving computer-assisted sales method.
- *ITEQ Corp. v. Isola USA Corp.* (D. Ariz.). Representation of plaintiff-counterclaim defendant in patent infringement case relating to resin compositions used to manufacture printed circuit boards.
- *McCormick & Co., Inc. v. Weatherchem Corp.* (D.Md.). Representation of the defendant in a trademark and unfair competition case relating to grinder bottles for pepper and other similar items.
- ITC Section 337 Investigation: (*Pass & Seymour, Inc. v. Shanghai Meihao Electric, Inc.*) (2007). Representation of the respondent in an investigation involving ground fault circuit interrupters.
- *Technical Witts, Inc. v. Skynet Electronic Co., Ltd., Skynet Electronic Corp.* (D.Ariz.). Representation of the defendant in this patent infringement action relating to power converters.
- *B-50.com, LLC v. Xformity, Inc.* (N.D.Texas). Lead counsel for the alleged infringer in a patent infringement case involving a point of sale reporting system using the Internet.
- *The SCO Group, Inc. v. International Business Machines Corporation* (D. Utah). Lead IP counsel for The SCO Group, Inc. in a case involving the UNIX and LINUX operating systems. The case involved three patent counterclaims filed by IBM and copyright infringement and contract claims against IBM arising out of IBM's source code contributions to LINUX.
- *Gateway Plastics, Inc. f/k/a Glendale Plastics, Inc. v. Weatherchem Corporation* (E.D. Wis.). Lead IP counsel for the alleged infringer/counterclaim-plaintiff in a case involving three patented closure devices.
- *Ion Beam Applications S A, et al. v. The Titan Corporation, et al.* (C.D. Calif.) (irradiation system for food, medical devices and mail)
- *Monster Cable Products, Inc. v. Lightning Audio, Inc.* (N.D. Cal.) (utility and design patents and trade dress)
- *Dr. Abulkalam M. Shamsuddin, et al. v. PharmWest, Inc.* (D. Md.) (nutritional supplements)
- *DiscoVision Associates v. Disc Manufacturing, Inc.*, 25 F. Supp.2d 301 (D. Del. 1998) (optical disc patents)
- *Disctronics Texas, Inc. v. Sony Corp.* (N. D. Tex.) (antitrust action relating to optical disc patents and licensing)
- *DiscoVision Associates v. Technicolor Videocassette, Inc.* (D. Del.) (optical disc patents)
- *Linear Dynamics, Inc. v. A. H. Harris & Sons and Koch Materials Company* (D. N. J.) (bridge joints)
- *A.T. Plastics v. Tyco International, Ltd.* (D. Mass.) (roofing materials)
- *Miratech, Inc. v. Johnson Matthey Inc.* (N.D. Okla.) (catalytic converters)
- *DiscoVision Associates v. Nimbus Records Limited* (W.D. Va.) (optical disc patents)

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- *Rovers, B.V. v. Wallach Surgical Devices, Inc.* (D. Conn.) (medical devices)

### PUBLICATIONS

- "Federal Circuit Affirms Pre-Therasense Finding of Inequitable Conduct," *IP and Technology Developments*, reprinted in *IP Frontline.com* (April 2012)
- *Therasense Inc. v. Becton, Dickinson and Company*—The Federal Circuit tightens the standards necessary to establish the inequitable conduct defense by requiring a "but-for" showing of materiality (May 27, 2011)
- *Hyatt v. Kappos: A New Standard for the Admissibility of Evidence in a Section 145 Action* *IP and Technology Developments - April 2011* (April 19, 2011)
- Federal Circuit Holds that Obviousness of Patent May Boil Down to Common Sense (January 4, 2011)
- "Bilski v. Kappos: Have We Come Full Circle?" (2010)
- "Revising Patent Strategies in Light of New Trends in Case Law," *Inside the Minds: The Impact of Recent Patent Law Cases and Developments* (2010)
- "Navigating the Complex World of Patent Law: Business, Legal and Academic Challenges" *Inside the Minds: Patent Litigation & Dispute Resolution* (2008)
- "Planning for Interoperability: A Standard Issue" *The Greater Washington Board of Trade News* (1996)
- "The Patentability of Computer-Related Inventions as Seen Through the Eyes of the Courts and the Patent and Trademark Office" *Computer Law Reporter* (1984)
- "The United States Court of Appeals for the Federal Circuit: A One-Year Review of Its Interaction with Other Federal Courts" *Selected Legal Papers, American Patent Law Association* (1983)
- "The New Court of Appeals for the Federal Circuit: Its Patent Law Legacy From the Court of Claims" *American Patent Law Association Quarterly Journal* (1982)
- "Collateral Estoppel – *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*" *Georgetown Law Journal* (1972)

### BRIEFINGS, SEMINARS & SPEECHES

#### Speaker

- "The America Invents Act," Practitioners Forum, Dresden University of Technology—International Studies in Intellectual Property Law, Dresden, Germany (May 18, 2012)
- "Intellectual Property Litigation," Advanced Civil Litigation (February 2008)
- "2007 IP Milestones and Landmark Cases," ReedLogic DVD (December 2007)
- "Licenses in the Courtroom," Modern Licensing Law Conference (November 2006)
- "Intellectual Property Rights Online: Recurring Antitrust Issues," Law Seminars, Inc. (July 2000)
- "Interaction of the United States Court of Appeals for the Federal Circuit with Other Federal Courts," American Intellectual Property Law Association - Plenary Session, Annual Meeting (1983)
- "Patent Law Developments," United States Court of Appeals for the Federal Circuit, Judicial Conference (100 F. R. D. 663) (1983)

#### Panel Member

- "Cutting-Edge Antitrust: Antitrust and the Protection of Intellectual Property Rights," Law Seminars, Inc. (February 2000)
- "Protection and Management of Technology," Greater Washington Board of Trade Seminar (September 1999)
- "Trial Skills Workshop," American Intellectual Property Law Association - Mid-Winter Meeting (1983)
- "How to Practice Before the New Court of Appeals for the Federal Circuit" Legal Times/Law & Business, Inc., Seminar (1982)

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**Guest Panelist** - "Information Technology Report: Intellectual Property," WMAL Radio (December 1999)

**TEACHING ACTIVITIES**

**Adjunct Faculty**

- Lecturer on U.S. Intellectual Property Law, Advanced Masters in Intellectual Property Law and Knowledge Management (LLM/MSC), University of Maastricht, Maastricht, the Netherlands (2011- present)
- Master's Degree Program in Intellectual Property, Swiss Federal Institute of Technology (Zurich, Switzerland), Teach two-day course in antitrust, patent misuse, and licensing (1997 to 2010)
- Master's Degree Program in Intellectual Property, Swiss Federal Institute of Technology (Zurich, Switzerland), Video-conference lectures on U.S. patent law (1999 to 2008)
- Master's Degree Program in Intellectual Property, Swiss Federal Institute of Technology (Zurich, Switzerland), Teach course on managing and extracting value from intellectual property (2000 to 2010)

**Instructor**

- Patent Resources Group, Inc., Patent Bar Review Course (1995-1998)
- Patent Resources Group, Inc., Advanced Application and Amendment Workshop (1993-1997)

**AFFILIATIONS**

- District of Columbia Bar
- State Bar of Massachusetts