

Frederick S. Frei



Partner

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PRACTICE AREAS

Intellectual Property
Litigation
Intellectual Property
Antitrust

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
United States Sixth
Circuit Court of Appeals
(September 1973 -
August 1974)

ADMITTED

Massachusetts 1989
Texas 1985 (inactive)
District of Columbia
1974
US Patent and
Trademark Office

Fred has been involved with the patent system for more than 35 years, including five years as a Patent Examiner with the US Patent and Trademark Office. His practice 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, and enforceability opinions and conducting due diligence and product clearance studies and intellectual property audits.

A primary focus of Fred's practice is intellectual property litigation, with particular emphasis on patents and related antitrust and trade regulation issues. He has been lead counsel in numerous litigations. He was lead patent trial counsel for US Patent No. 4,893,297, the basic patent for all modern-day optical discs, obtaining a favorable verdict on validity and infringement, including a finding that the patent claims covered the industry standard for all audio and CD-ROM compact discs. The patent had more than 140 licensees.

His representations have included diverse areas of chemical, electrical, and mechanical technology, including pharmaceutical, nutritional supplements, medical devices, chemical sensors, food products, solar cells, coolant systems, packaging products, optical disc products and players, plastics and plastic molding processes and apparatus, road-milling equipment, catalytic converters, electronic commerce, and thin-screen monitors.

REPRESENTATIVE EXPERIENCE

- McCormick & Co., Inc., v. Weatherchem Corp., No. 07-1100 (D.Md. filed Apr. 30, 2007). 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., No. 04-2025 (D.Ariz. filed Sept. 27, 2004). Representation of the defendant in this patent infringement action relating to power converters.
- B-50.com, LLC v. Xformity, Inc., Case No. 3:04-CV-0542-D (N.D.Texas) (Lead counsel for the alleged infringer in a patent infringement case involving a point of sale reporting system using the Internet.)

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- The SCO Group, Inc. v. International Business Machines Corporation, Case No. 2:03-CV-0294 DAK (D. Utah) (Lead IP counsel for The SCO Group, Inc. in a case involving the UNIX and LINUX operating systems. The case involves 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, Case No. 02-C-0870 (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., Case No. 00CV 1994J (BEN) (C.D. Calif.) (irradiation system for food, medical devices, and mail)
- Monster Cable Products, Inc. v. Lightning Audio, Inc., Case No. C 99-05416 SBA (MED) (N.D. Cal.) (utility and design patents and trade dress)
- Dr. Abulkalam M. Shamsuddin, et al. v. PharmWest, Inc., Case No. JFM 99-CV-3857(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., Case No. 4-95CV-300Y (N. D. Tex.) (antitrust action relating to optical disc patents and licensing)
- DiscoVision Associates v. Technicolor Videocassette, Inc., Case No. 94-592-LON(D. Del.) (optical disc patents)
- Linear Dynamics, Inc. v. A. H. Harris & Sons and Koch Materials Company, Case No. 94-3779 JWB (D. N. J.) (bridge joints)
- A.T. Plastics v. Tyco International, Ltd., Case No. 94-11435 RGS (D. Mass.) (roofing materials)
- Miratech, Inc. v. Johnson Matthey Inc., Case No. 93-C-0240-E (N.D. Okla.) (catalytic converters)
- DiscoVision Associates v. Nimbus Records Limited, Case No. 92-CV-008 (W.D. Va.) (optical disc patents)
- Rovers, B.V. v. Wallach Surgical Devices, Inc., Case No. N-90-290 TFGD (D. Conn.) (medical devices)

ARTICLES/PUBLICATIONS

- "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

- "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)

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- "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)

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

TEACHING ACTIVITIES

Adjunct Faculty

- Post-Graduate Degree Program in Intellectual Property, Swiss Federal Institute of Technology (Zurich, Switzerland), (teach two-day course in antitrust, patent misuse, and licensing) (1997 to present)
- Post-Graduate Degree Program in Intellectual Property, Swiss Federal Institute of Technology (Zurich, Switzerland) (video-conference lectures on U.S. patent law) (1999 to present)
- Post-Graduate Degree Program in Intellectual Property, Swiss Federal Institute of Technology (Zurich, Switzerland) (teach course on managing and extracting value from intellectual property for the Swiss Federal Institute of Technology and also for an International Senior Entrepreneurship Program in conjunction with St. Gallens University and the Massachusetts Institute of Technology) (2000 to present)

Instructor

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

PROFESSIONAL/CIVIC AFFILIATIONS

Member

- District of Columbia Bar
- State Bar of Massachusetts