

David W. Long

Kelley Drye & Warren LLP



(blog) <http://www.essentialpatentblog.com>



Overview

Mr. Long is a registered patent attorney and former Federal Circuit law clerk with twenty years of experience dealing with complex patent issues in the telecommunications industry ranging from simple matters to bet-the-company litigation. He has experience in federal district and appellate courts as well as in the U.S. Patent & Trademark Office (“Patent Office”). His experience includes balancing parallel proceedings in court and in the Patent Office to challenge or defend issued patents in high-tech arts. He counsels clients on licensing patents, product redesigns, trade secrets and other high-tech matters in industries such as telecommunications, VoIP, electronic circuits, microchips and software.

Before entering the legal profession, Mr. Long earned a master’s degree in electrical engineering. He has over five years technical industry experience working in telecommunications, software/hardware design, control systems and rocket science.

Education

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| University of Alabama School of Law, Juris Doctorate (<i>magna cum laude</i>) | 1995 |
| <ul style="list-style-type: none">• Alabama Law Review | |
| Auburn University, Masters of Science in Electrical Engineering | 1990 |
| <ul style="list-style-type: none">• Federal Bureau of Investigation Honors Intern• Graduate Teaching Assistant (Microprocessor, Communications & Controls Labs)• Thesis: <i>Speech Prosthesis from Secondary Myoelectric Signals</i> | |
| Auburn University, Bachelors of Electrical Engineering (with Honor) | 1987 |
| <ul style="list-style-type: none">• Engineering Honor Societies: <i>Eta Kappa Nu</i> (Electrical Engineering), <i>Sigma Pi Sigma</i> (Physics) and <i>Tau Beta Pi</i> (Engineering)• Cooperative Education Engineering Student Program (Universal Data Systems) | |

Legal Experience

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|---|-------------------------------|
| Kelley Drye & Warren LLP (Washington, DC) | Oct. 2013 to Present |
| Partner. Mr. Long is a patent attorney focusing on high-technology industries. His practice includes representing clients in patent litigation (in courts and the Patent Office), patent counseling (standard essential patents, licensing negotiations, product clearance review, and design around) and other areas of law involving high-tech (trade secrets). | |
| Dow Lohnes PLLC (Washington, DC) | Apr. 2011 to Sep. 2013 |
| Partner. Mr. Long led the firm’s patent practice group where he represented clients in patent litigation, Patent Office proceedings and patent counseling matters. | |
| Howrey LLP (Washington, DC) | 2001 to 2011 |
| Partner (2004 to 2011) and Of Counsel (2001 to 2004). Mr. Long’s practice focused on complex, high stakes patent litigation and parallel Patent Office proceedings. | |

- Pillsbury Madison & Sutro** (Washington, DC) **1996 to 2001**
 Sr. Associate (1999 to 2001) and Associate (1996 to 1999). Mr. Long initially prosecuted patents in the high-tech arts and later focused on patent litigation in appellate and district courts involving a range of technologies from medical devices to complex wireless devices.
- Cushman Darby & Cushman** (Washington, DC) **1996**
 Associate. Mr. Long started his law firm career doing patent prosecution in the electrical arts in this well-respected patent boutique that later merged with the Pillsbury law firm.
- U.S. Court of Appeals for the Federal Circuit** (Washington, DC) **1995 to 1996**
 Judicial Law Clerk to Hon. Edward S. Smith.
- Lanier, Ford, Shaver & Payne** (Huntsville, AL) **Summers 1993, 1994**
 Summer Associate. Legal research and writing for various commercial litigation matters.

Court and Other Admissions

State Bars: Alabama (1995, inactive), District of Columbia (2000) and Virginia (2001)
U.S. Appellate Courts: Federal Circuit (1996) and Supreme Court (1998)
U.S. District Courts: D.D.C. (2000), E.D. Va. (2003), D. Md. (2008) and W.D. Wis. (2014)
Other: U.S. Patent & Trademark Office (1998) and U.S. Court of Federal Claims

Professional Activities

Intellectual Property Owners Association

- Vice-Chair of Litigation Committee (2010 to present)

American Intellectual Property Law Association

- Chair of Standards and Open Source Committee (2014 to present)
- Chair of Programs for Standards and Open Source Committee (2012 to 2014)

Sedona Conference

- Co-Leader of WG 9, Standard Essential Patent/FRAND Brainstorming Team (2015)

Bar Association of the District of Columbia

- Board Member (2006 to 2009 and 2011 to present)
- Chair or Officer of Patent, Trademark and Copyright Section (2002 to 2006)

Technical Experience

- Dynetics, Inc.** (Huntsville, AL) **1990 to 1992**
 Rocket Scientist. Engineering work studying communications hardware, simulating missile guidance systems and analyzing data communication signals.
- Auburn University School of Electrical Engineering** (Auburn, AL) **1988 to 1990**
 Graduate Teaching Assistant. Instructor for various engineering labs teaching hands-on experience with microprocessors, communications and control systems.
- EPOS, Inc.** (Auburn, AL) **1987 to 1988**
 Research Engineer. Engineering work developing software and analyzing laser radar data and other communication signals.
- Universal Data Systems** (Huntsville, AL) **1983 to 1985, 1988**
 Summer Engineer (1988) and Cooperative Education Engineering Student (alternating quarters 1983 to 1985). Engineering work designing data communications hardware, such as modems, during alternating quarters while pursuing engineering degree.

Other Experience

University of Alabama Student Housing (Tuscaloosa, AL) Hall Director.	1992 to 1994
Auburn University Student Housing (Auburn, AL) Hall Director.	1990 to 1992
Federal Bureau of Investigation (Washington, DC) Honors Intern.	Summer 1989

Pro Bono

Amicus Briefs (Washington, DC)	—
Prepare briefs and represent amicus on a pro bono basis for various intellectual property law bar organizations on important patent law issues, including the Intellectual Property Owners Association and the Bar Association of the District of Columbia.	
Asylum (Washington, DC)	2008
Successfully petitioned for and obtained asylum for an Iraqi attorney, his wife, new born daughter and brother. The attorney and his brother had been kidnapped and tortured by insurgents for helping American troops in occupied Iraq.	
Huntsville Emergency Medical Services, Inc. (Huntsville, AL)	1990 to 1992
Volunteer First Responder Emergency Medical Technician. Responsible to be first on scene for medical emergencies such as a car accident, gunshot or heart attack.	
Crisis Center (Auburn, AL)	1987 to 1992
Volunteer Trainer and Listener. Responsible for training volunteers (“listeners”) to deal with callers to the local suicide hotline.	

Publications

- Essential Patent Blog (www.essentialpatentblog.com) (Founder, Owner, Editor)
- *Black's Law Dictionary* (Panel of Practicing Contributors)
- *The Winning Brief* by Brian Garner (Contributing Practitioner)
- *Fujitsu v. Tellabs: Jury Finds that Patent Holder Breached RAND Obligation and Must Show Cause Why Patent Should Not Be Held Unenforceable*, IP Litigator (Sep./Oct. 2014)
- *Apple Defeats IPrCom's Patent Infringement Claim: A Look Inside the Tech Giant's Mannheim Regional Court Victory*, Bloomberg BNA (Mar. 2014)
- *The So-Called "Patent Troll" Problem: Dealing With Non-Innovating, Non-Practicing Patent Monetization Entities*, The Metropolitan Corporate Counsel (Feb. 2014)
- *Proposed Cost-Shifting in Patent Infringement Cases*, InsideCounsel (Oct. 17, 2013)
- *Protecting "End Users" from Patent Infringement Actions*, InsideCounsel (Sep. 18, 2013)
- *Establishing Federal Rules of Patent Procedure*, InsideCounsel (Aug. 20, 2013)
- *Design Patents May Be Next Troll Target*, Today's General Counsel (June/July 2013)
- *The Implications of Patent Rulings with Limited Remedies*, Wall Street Journal's All Things Digital (Jan. 30, 2013)
- *Navigating the Sea of Change in US Patent Law*, New Legal Review (Apr. 4, 2012)
- Federal Circuit Bar Journal (Editorial Board 2005)
- *Safeguarding Advice From Lawyers*, The National Law Journal (Oct. 2004)

Speaking Engagements

- *Smartphones and the Patent Battleground: Is Peace at Hand?*, American Bar Association (Intellectual Property Law Section) (Mar. 25, 2015)
- *The Future of Standards: What's Next After the IEEE Shift*, Intellectual Property Law Association (Mar. 18, 2015)
- *Complying with FRAND Obligations: Guidance from Recent Cases for Setting FRAND Terms*, Law Seminars International (Oct. 30, 2014)
- *Practical Considerations in Litigating Standard Essential Patents*, American Intellectual Property Law Association (Oct. 23, 2014)
- *Understanding Patent Assertion Entities: Defense Strategies and Solutions for Your Company*, Commercial Law WebAdvisor (May 8, 2014)
- *Voluntary Standards in the Patent World: Opening the Door to Antitrust Litigation*, PECIS 2014 Spring Meeting (April 3, 2014)
- *Lessons Learned From Litigated Royalty Rates on Standard Essential Patents*, Kelley Drye Webinar (Oct. 17, 2013)
- *Practical Considerations & Industry Perspectives in Applying Recent FRAND Rulings*, American Intellectual Property Law Association (Aug. 7, 2013)
- *Standard Essential Patents at the ITC: Samsung and Apple*, Intellectual Property Owners Association (July 11, 2013)
- *Standard Essential Patents: Implications of the FTC-Google Consent Decree*, Intellectual Property Owners (Mar. 5, 2013)
- *America Invents Act: A Brief Introduction to Post-Grant and Inter Partes Review*, National Institutes of Health (June 27, 2012)
- *Cardiac Pacemakers and Section 271(f) Infringement*, Women's Bar Association and Bar Association of the District of Columbia (Oct. 30, 2009)
- *Patent Law Update: Can You Patent That, Who Cares What My Attorney Thinks and Did We Really Agree To That?*, Washington Metropolitan Area Corporate Counsel Association (Dec. 4, 2008)
- *What's New in Patent, Trademark and Insurance Coverage Law*, Washington Metropolitan Area Corporate Counsel Association (Apr. 17, 2008)
- *Pre-Suit Investigation Reasonable Inquiry*, American Intellectual Property Law Association (2007)
- *Reexaminations and Permanent Injunctions*, Practising Law Institute (Aug. 3, 2007)
- *eBay and Its Aftermath on Patent Injunctions*, Virginia State Bar Intellectual Property Section (2006)
- *Enforcing IP Rights: Where are the borders?*, International Law Association, Toronto, Canada (2006)
- *Global Reach of US Patent Law*, Intellectual Property Institute of Canada (2006)
- *The Supreme Court's Review of Obviousness in KSR Int'l v. Teleflex*, American Intellectual Property Law Association and George Washington University Student IP Law Association (2006)
- *Patent Office's Proposed Rule Changes to Improve Patent Prosecution*, Bar Association of the District of Columbia (Patent, Trademark & Copyright Section) (2006)
- *Illinois Tool Works and Tying: Impact and Implications*, American Bar Association (2006)
- *A Practitioner's Guide to eBay and Its Aftermath*, American Intellectual Property Law Association (2006)

- *Avoiding Patent Pitfalls in Doing Business in the US*, Canadian Information Technology Law Spring Training Program, Toronto, Canada (2005)
- *The Effect of the Federal Circuit's Recent Decision in Knorr-Bremse v. Dana Corp. on Opinions of Counsel and a Discussion of the Positions Argued by Amicus Curie in the En Banc Rehearing of Phillips v. AWH Corp.*, Bar Association of the District of Columbia (Patent, Trademark & Copyright Section) (2004)
- Intellectual Property Symposium Hot Topics in Copyrights & Patents, Duke University (2003)

Media

- *Google to License Wireless Technology Amid Industry Row on Rates*, Bloomberg News (Apr. 9, 2015)
- *9th Circ. Could Shape FRAND Patent Law in Motorola Case*, IP Law360 (Apr. 6, 2015)
- *New HEVC Patent Pool: What Are the Implications*, Streaming Media Magazine (Apr. 1, 2015)
- *Court to Tally Samsung's Costs for Using Apple iPhone Features*, Bloomberg News (Mar. 3, 2015)
- *Patent Owners Take Hit With Standard-Setting Body's Rules*, IP Law360 (Feb. 9, 2015)
- *Court Steps Into Patent Debate That Split Technology Companies*, Bloomberg News (Dec. 5, 2014)
- *Patent System Benefits From Supreme Court Guidance In Alice v. CLS Bank*, Metropolitan Corporate Counsel (Oct. 17, 2014)
- *Akamai Case May Be 1st Step Toward Joint Infringement Rule*, IP Law360 (Sep. 10, 2014)
- *Lawyers Weigh In On High Court's Software Patent Ruling*, IP Law360 (June 19, 2014)
- *Lawyers Weigh In On High Court's Induced Infringement Ruling*, IP Law360 (June 2, 2014)
- *Lawyers Weigh In On High Court's Patent Ruling On Attorneys' Fees*, IP Law360 (Apr. 29, 2014)
- *Teva Gets Supreme Court Hearing on Generic Copaxone Delay*, Bloomberg News (Mar. 31, 2014)
- *Apple's Loss On Samsung Ban Shows Bar May Be Too High*, IP Law360 (Mar. 6, 2014)
- *Patent Attacks Expand With Industry's Reliance On Technology*, Multichannel News (Nov. 4, 2013)
- *Who Loses in the White House Patent Decision?*, Bloomberg TV (Aug. 6, 2013)
- *iPhone Reprieve Seen Aiding Apple Sales, Hurting Samsung*, Bloomberg News (Aug. 5, 2013)
- *How Important is ITC Apple-Samsung Ruling*, Bloomberg TV (May 31, 2013)
- *After Court Ruling, US Still In Disarray On Software Patents*, Intellectual Property Watch (May 30, 2013)
- *Vt's Historic Fight On Patent Trolls May Fall Flat*, IP Law360 (May 29, 2013)
- *After Court Ruling, US Still in Disarray On Software Patents*, Intellectual Property Watch (May 20, 2013)
- *Patent Court Torn On Whether Software Deserve Patents*, Bloomberg News (May 10, 2013)
- *Dow Lohnes' Long: Motorola Has Decades Of Patents*, Bloomberg TV (Apr. 29, 2013)

- *Google emerges from FTC antitrust probe largely unscathed*, Inside Counsel (Mar. 26, 2013)
- *ITC Clears Microsoft's Xbox in Patent Case*, Wall Street Journal (Mar. 22, 2013)
- *Google antitrust settlement reshapes patent disputes*, IT World (Jan. 4, 2013)
- *Apple, Samsung Inch Toward End of Smartphone Patent Fight*, Bloomberg News (Dec. 18, 2012)
- *Samsung Mocking Apple in Ads Looks to Win Cheech and Chong Test*, Bloomberg News (Oct. 22, 2012)
- *Samsung and Apple Patent War*, Bloomberg TV (Sep. 14, 2013)
- *Apple Counts on iPhone Being Too Cool for US Import Ban*, Bloomberg News (Aug. 24, 2012)
- *Lawyers at \$1,200 an Hour Booming as Apple Confronts Foes*, Bloomberg News (Aug. 23, 2012)
- *A Pivotal Fight Over 'Essential Patents'*, Wall Street Journal (May 7, 2012)
- *Implications of Quanta Patent Exhaustion*, MyTechLawyer Radio (July 17, 2008)
- *Patent Litigation: Lessons from a RIM patent vet*, The Globe & Mail (June 14, 2006)
- *NTP Filing Accuses U.S. Patent Office of Bias in Reexam*, Dow Jones (June 9, 2006)
- *In Patent Disputes, A Scramble to Prove Ideas Are Old Hat*, Wall Street Journal (Jan. 25, 2006)

Representative Litigation Experience

- *WAG Acquisition v. Coolvision Ltd, et al.* (D.N.J.), Defend Coolvision in patent infringement case involving streaming video over the Internet.
- *Bright Response v. Infosys Ltd.* (E.D. Tex.), Defend Infosys in patent infringement case concerning contextual interpretation of email.
- *Epic Systems v. Tata Consultancy Services, et al.* (W.D. Wis.), Defend against charge of misappropriation of software trade secrets.
- *Bright Response v. Infosys* (E.D. Tex.), Defend Infosys in patent infringement case involving automatic review and response to emails.
- Patent Monetization Entity Licensing Negotiations. Represent high-technology companies in negotiations with various patent monetization entities such as Rockstar, Innovatio, Digimedia and Helferich.
- *Cambrian Science v. Cox Communications, Inc., et al.* (C.D. Cal), Defend CCI in patent infringement case involving photonic integrated circuits.
- *Digimedia v. Cox Radio, et al.* (D. Del.), Defend Cox Radio in patent infringement case involving digital music broadcast systems.
- *Teles AG v. Cisco Systems* (D.D.C./D. Del.), Represent patent owner in a patent infringement case involving VoIP technology.
- *Teles AG v. Quintum Technologies* (D. Del.), Represent patent owner in a patent infringement case involving VoIP technology.
- *Technologies Patents LLC v. Motorola, et al.* (D. Md.), Defend Motorola in patent infringement case involving international text messaging.
- *Broadcom v. Qualcomm* (ITC/S.D. Cal.), Defend Qualcomm in patent infringement case involving power management and multiplexing in wireless phone system.
- *Rasterex Holdings v. Research In Motion* (Ga. Sup. Ct.), Defend Research In Motion in a trade secrets case involving software for converting and displaying files on wireless device.

- *Matsushita Electric v. Samsung Electronics* (Fed. Cir.), Defend Samsung Electronics in a patent infringement case involving memory chip design.
- *Toshiba v. Samsung Electronics* (ITC/D.N.J.), Defend Samsung Electronics in patent infringement case involving memory circuit design and manufacture.
- *NTP v. Research In Motion* (E.D. Va./Fed. Cir.), Replace trial counsel after unfavorable verdict and defend Research In Motion in a patent infringement case involving wireless mobile email system.
- *On Demand Machine Corp. v. Ingram Industries* (Fed. Cir.), Defend Ingram Industries in a patent infringement case involving on-demand book publishing systems.
- *ePlus v. Ariba* (E.D. Va.), Defend Ariba in patent infringement case involving electronic database systems.
- *Linear Tech. v. Impala Linear Corp.* (Fed. Cir.) Defend Linear Tech. in a patent infringement case involving switching voltage regulators.
- *Verizon California v. Ronald Katz Tech.* (N.D. Cal.) Defend Verizon California in a patent infringement case involving interactive telephone call processing systems.
- *Applied Medical Resources v. U.S. Surgical* (C.D. Cal./Fed. Cir.) Represent patent owner Applied Medical Resources in a patent infringement case involving trocar floating seals for minimally invasive surgery
- *Applied Medical Resources v. Core Dynamics* (C.D. Cal.) Represent patent owner in a patent infringement case involving trocar floating seals for minimally invasive surgery.
- *Symbol Techs. v. Lemelson Medical, Education & Research Foundation* (Fed. Cir.) Represent amicus National Retail Federation in a patent infringement case involving bar code readers, which amicus brief was credited for Federal Circuit granting interlocutory appeal on prosecution laches defense.
- *Applied Medical Resources v. U.S. Surgical* (E.D. Va./Fed. Cir.) Represent patent owner in a patent infringement case involving trocar floating seals for minimally invasive surgery.
- *Motorola v. Qualcomm* (S.D. Cal.) Represent patent owner and defendant Qualcomm in a patent infringement case involving mobile phone circuit design and wireless protocols.
- *Steelcase v. Haworth* (D. Mich.) Defend Haworth in a patent infringement case involving office furniture.
- *Wytttenbach v. Atoma Int'l and Toyota Motor Corp.* (Fed. Cir.) Defend Atoma Int'l in a patent infringement case involving child car seats.
