

## John C. Alemanni

### Partner

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### Services

Asset Creation - Prosecution &

Counseling

Intellectual Property

Litigation

Patent Disputes

Post-Grant Proceedings

### Industries

Energy

Technology

John C. Alemanni focuses his practice on trials before the Patent Trial and Appeal Board and related appeals to the U.S. Court of Appeals for the Federal Circuit. His practice also includes client counseling, patent litigation and strategic patent prosecution. He provides creative, cost-effective solutions for his clients. He is the co-chair of Kilpatrick Townsend's Patent Office Litigation team and has served as lead or back-up counsel on over 50 trials before the PTAB. He also manages the portfolios of both established and emerging companies. He focuses on hardware and software technologies, including mobile devices, bioinformatics and laboratory information management, as well as mechanical and electro mechanical devices, including aerospace components, medical devices and medical device simulations.

Before joining the firm, he owned and managed a computer consulting firm and web hosting company. He was an experienced programmer, database administrator, and systems integrator, having developed dozens of applications, including both client-server and web-enabled applications. He is also an avid amateur race car driver.

Mr. Alemanni has been recognized as an "IP Star" in 2017 and the four years immediately preceding by *Managing Intellectual Property* magazine. He was recognized by *The Best Lawyers in America*® in 2018 for Patent Law.

### Experience

Represented Patent Owner in Inter Partes Review. Dispute favorably settled and dismissed prior to deadline to



file a Preliminary Response. *Sumitomo Chemical Company, Ltd. v. Celgard, LLC*, No. 3:12-cv-00122 (W.D.N.C., filed Feb. 22, 2013).

Kilpatrick Townsend successfully instituted an *inter partes* review of U.S. Patent No. 8,590,838, titled "Aircraft Interior Lavatory," against B/E Aerospace. We obtained a final holding of invalidity of 29 of 33 challenged claims. United States Patent and Trademark Office Patent Trial and Appeal Board, Case Number IPR2014-00727.

Served as lead counsel and prevailed on behalf of Petitioner Google Inc. in two *inter partes* reviews challenging the validity of patents related to processing and transmitting digital content. The PTAB ruled in favor of Google, finding all challenged claims in both proceedings unpatentable. PTAB Case Numbers IPR2015-00806 and IPR2015-00807.

Representing Celgard LLC in an *inter partes* review related to separators for high energy rechargeable lithium batteries.

The firm served as lead counsel in the representation of Epic Systems Corporation, a leading Wisconsin-based health care software company, against claims of patent infringement in a suit involving Internet-based doctor-patient communications software. The district court held that Epic and its health care provider customers did not and could not infringe the patent. The case settled while on appeal. *McKesson Info. Solutions v. Epic Sys. Corp.*, No. 06-2965 (N.D. Ga. filed Dec. 6, 2006), No. 2010-1291 (Fed. Cir. Apr. 12, 2011).

The firm served as lead counsel on behalf of broadband communications technology developer in a patent infringement suit involving broadcast delivery of data filed against it by Broadcast Innovation LLC, an Acacia subsidiary. A favorable settlement was reached, after a motion to dismiss was filed.

The firm served as lead counsel on behalf of Red Hat, an open-source software company, in a patent infringement suit brought by Firestar related to database technology—in particular, object-relational mapping. This suit is believed to be the first patent infringement suit involving open-source software. Red Hat recently settled this suit and another recently-filed suit with the same plaintiff. The settlement was structured to be compatible with all versions of the GPL (General Public License), the open-source license under which many Red Hat products are developed and distributed, and provides licenses to the patents for all of Red Hat's products. In addition, the license extends not only to Red Hat and its customers, but also to members of the open-source community who contribute to the development of Red Hat's products. *Firestar Software, Inc. v. Red Hat, et al.*, No. 06-00258 (E.D. Tex. filed June 26, 2006). (Judge Ward).

As lead trial counsel to the inventor and patent owner, obtained a verdict of willful infringement and an award of \$20.3 for past damages after a seven day jury trial in the Eastern District of Texas. The Court increased the



award to \$23.6 million after ruling on post-trial motions. The two related *inter partes* review hearings resulted in an exceedingly rare final determination upholding the patentability of all challenged claims.

Represented Dr. Mark A. Barry in a series of *inter partes* reviews relating to Dr. Barry's patents directed to a unique surgical instrument and related techniques for use in scoliosis surgeries filed by Medtronic, Inc., two of which were instituted. The PTAB issued two final written decisions upholding the validity of the two patents and resulted in a total victory for our client. PTAB Case Numbers IPR-00780 and IPR2015-00783.

Served as lead counsel representing Motorola in IPR trials before the United States Patent and Trademark Office for two related patents that are the subject of litigation in Delaware (*SoftView LLC v. Motorola Mobility LLC* before Judge Stark). We filed a successful motion to join two corresponding IPR trials that had been filed by Kyocera and subsequently instituted. We represented Motorola in oral argument before the board on January 7, 2014, and received a decision finding all challenged claims unpatentable. Judge Stark (D.Del.), who previously denied a motion for stay in the case, granted a stay in view of our IPR trials. The Federal Circuit affirmed the PTAB's finding that all claims were invalid. Case numbers IPR2013-00256, IPR2013-00257; related case numbers IPR2013-00004, IPR2013-00007.

Counsel for patentee Racing Optics in four *inter partes* review petitions filed by competitor Aevoe challenging validity of Racing Optics' patents related to touch screen protectors, with related action in D. Nevada. U.S. Patent & Trademark Office, Patent Trial and Appeal Board, Case Numbers IPR2016-01164, IPR2016-01165, IPR2016-01166, and IPR2016-01745.

Provides patent procurement and counseling services to Adobe Systems Incorporated, one of the largest and most diversified software companies in the world. The company offers creative, business and mobile software and services used by creative professionals, knowledge workers, consumers, original equipment manufacturer (OEM) partners and computer programmers. Much of the firm's work has focused on the software and services used to create, manage, deliver and engage with compelling content and experiences across multiple operating systems, devices and media. The firm works closely with the key technical and business personnel to identify and protect innovations with patent protection to achieve the company's strategic corporate goals. The firm also counsels the company with respect to patent strategy.

The firm served as lead counsel on behalf of Red Hat, an open-source software company, in a patent infringement suit brought by Datatarn related to database technology. Specifically, the patent at issue involved methods for interfacing software with relational databases. *Datatarn, Inc. v. United Air Lines Inc. et al.*, No. 09-53 (E.D. Tex. filed Feb. 17, 2009). (Judge Folsom).



We represented AT&T against allegations that AT&T infringed patents related to Internet-based security, fire and emergency identification and communication system. After claim construction briefing, ComCam accepted a settlement that was very favourable to AT&T. *ComCam International, Inc. v. AT&T Corp.*, No. 2:13-cv-00795 (E.D. Tex. filed Oct. 7, 2013). PTAB Case Number IPR2015-00086.

The firm served as lead counsel on behalf of a major North American bank and an international airline in a patent infringement suit in the Eastern District of Texas filed by an intellectual property technology company. The patent at issue involved methods for interfacing software with relational databases. The plaintiff sued more than 20 defendants – including many leading companies in the travel and financial industries – and the firm played an integral role in the joint defense group on behalf of its two clients. Our two clients in this matter split our fees for common tasks, such as claim construction and invalidity, and we billed each client separately for work related to that client. Case settled.

### **Education**

Wake Forest University School of Law, J.D. (1996)

University of North Carolina at Greensboro, B.S., Management Information Systems (1990) *magna cum laude*

### **Admissions**

North Carolina (1996)

District of Columbia (2017)

### **Court Admissions**

U.S. Patent and Trademark Office (2000)

U.S. Patent and Trademark Office (2000)

U.S. Court of Appeals for the Federal Circuit (2014)

U.S. Court of Appeals for the Federal Circuit (2014)

U.S. District Court for the Eastern District of North Carolina

U.S. District Court for the Eastern District of North Carolina

U.S. District Court for the Eastern District of Texas

U.S. District Court for the Eastern District of Texas

U.S. District Court for the District of Colorado

U.S. District Court for the District of Colorado

### **Professional & Community Activities**

Intellectual Property Owners Association, Post-Grant Committee, Member



PTAB Bar Association, Member

North Carolina Bar Association, Intellectual Property Section, Member, Past Chair of the Software and Electrical Engineering Committee and Past Chair of the Continuing Legal Education Committee

Piedmont Opera Company, Winston-Salem, North Carolina, Former Board Member

Eastern Music Festival, Greensboro, North Carolina, Former Board Member

## Insights

### Publications

A Cautionary Tale Regarding Forum Selection

March 28, 2018

### Publications

Aqua Products: Petitioner Bears Burden of Proving Unpatentability of Amended Claims in Inter Partes Review

October 5, 2017

### News Releases

Kilpatrick Townsend Recognized by Prestigious 2017 Legal 500 US

October 2, 2017

### Alerts

The Federal Circuit Expresses Concern about IPR Joinder and Expanded Panels

August 28, 2017

### Alerts

3 Key Takeaways: Navigating the Post-Grant Landscape

August 25, 2017

### News Releases

Record-Breaking Recognition for Kilpatrick Townsend in The Best Lawyers in America® 2018

August 15, 2017