

John C. Alemanni

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Services

Adversarial Patent ProsecutionSM

Asset Creation - Prosecution &

Counseling

Biologics & Pharmaceutical Patent

Litigation

Intellectual Property

Licensing, Transactions &

Monetization

Market Protection - Opinions &

Dispute Avoidance

Patent Litigation

Patents

Post-Grant Proceedings

Industries

Energy

Financial Services

Health & Life Sciences

Retail & Consumer Goods

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 60 trials before the PTAB. He also helps manage the portfolios of both established and emerging companies, including a company consistently ranked at the top of its category in the IEEE Power Spectrum Patent Power scorecard and having generated licensing revenues of more than \$250 million dollars. 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 2019 and the six years immediately preceding by Managing Intellectual Property magazine. He was recognized by The Best Lawyers in America® in 2018, 2019 and 2020 for Patent Law. Mr. Alemanni was recommended by Legal 500 US in 2017 in the area of Patent Prosecution. He was named a top patent practitioner in 2019 by IAM Patent 1000 – The World's Leading Patent Practitioners.

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. Supreme Court

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 Texas

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

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Record-Breaking Recognition for Kilpatrick Townsend in *The Best Lawyers in America*® 2020

August 15, 2019

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August 14, 2019

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PTAB Trials Insights and Strategies – Leveraging Recent Developments at the PTAB

August 6, 2019

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Kilpatrick Townsend Receives High Rankings in 2019 IAM Patent 1000

July 11, 2019

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Kilpatrick Townsend Attorneys Named 2019 Managing Intellectual Property IP Stars

June 17, 2019

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Competitor Standing Requires Present or Non-Speculative Interest



May 14, 2019

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PTAB - The Discretionary Standard for Denying Institution

May 8, 2019

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Trends and Recent Changes to PTAB Practice

March 4, 2019

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Patent Challenges at the U.S. Patent Trial & Appeal Board: An Overview

February 20, 2019

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Patent Challenges at the U.S. Patent Trial & Appeal Board: An Overview

February 19, 2019

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PTAB Applies AIA On-Sale Bar, Nixes Aircraft Potty Patent

October 26, 2018

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6 Key Takeaways | Post Grant Proceedings: Recent Developments & Precedential Proceedings

August 22, 2018

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Record-Breaking Recognition for Kilpatrick Townsend in The Best Lawyers in America® 2019

August 20, 2018

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The One-Year Bar Applies Even After a Voluntary Dismissal without Prejudice

August 16, 2018

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Post Grant Proceedings – Recent Developments and Precedential Decisions
August 7, 2018

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Tribal Immunity Cannot Shield Patents from IPR
July 23, 2018

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Consider Estoppel Before Proceeding on Newly-Instituted Grounds Post-SAS
July 16, 2018

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Kilpatrick Townsend Attorneys Named 2018 Managing Intellectual Property IP Stars
June 19, 2018

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Are PTAB Non-Institution Decisions Based on Indefiniteness Defensible post-SAS?
May 10, 2018

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Exercising Care in Selecting Grounds is Even More Crucial Post-SAS
April 30, 2018

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Oil States and SAS
April 24, 2018

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A Cautionary Tale Regarding Forum Selection
March 28, 2018

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Aqua Products: Petitioner Bears Burden of Proving Unpatentability of Amended Claims in Inter Partes Review
October 5, 2017



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Kilpatrick Townsend Recognized by Prestigious 2017 Legal 500 US

October 2, 2017

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The Federal Circuit Expresses Concern about IPR Joinder and Expanded Panels

August 28, 2017

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3 Key Takeaways: Navigating the Post-Grant Landscape

August 25, 2017

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

August 15, 2017

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Is the Pendulum About to Swing Back?

August 10, 2017

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Kilpatrick Townsend Attorneys Named 2017 Managing Intellectual Property IP Stars

June 27, 2017

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Tips For A Successful Inter Partes Review Petition

February 6, 2017

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Jury Hands Doctor \$20.3M Verdict In Medtronic Patent Suit

November 14, 2016

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KT is...Trending, November 5-11, 2016

November 11, 2016



Events

Patent Practice: Using Recent IPR and Court Decisions to Better Defend or Defeat Patents and Maximize Your Portfolio Strength

November 10, 2016

In The News

Kilpatrick Townsend's Media Report, October 22 - November 4, 2016

November 7, 2016

Publications

Tips For A Successful Inter Partes Review Petition

November 4, 2016

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Publications Must Be Accessible to Persons of Ordinary Skill

October 5, 2016

In The News

Kilpatrick Townsend's Media Report September 2-8, 2016

September 9, 2016

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A Second Chance for a Motion to Amend

August 31, 2016

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Supreme Court Upholds Broadest Reasonable Interpretation at the PTAB

June 21, 2016

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The PTAB Applies Enfish

June 2, 2016

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Thirty-Two Kilpatrick Townsend Attorneys Named 2016 Managing Intellectual Property IP Stars

May 26, 2016



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Kilpatrick Townsend's Media Report May 13-19, 2016

May 20, 2016

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A Non-illusory Opportunity to Amend

April 28, 2016

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Kilpatrick Townsend's Media Report March 18-24, 2016

March 25, 2016

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Federal Circuit Reverses the PTAB's Reliance on Evidence Presented Solely During Oral Argument and Its Claim Construction

March 22, 2016

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Impact of the New Federal Rules of Civil Procedure & Procedural Case Law on Patent Litigation

February 24, 2016

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Federal Circuit Scrutinizing PTAB Claim Constructions, Emphasizing "Reasonable" in The Broadest Reasonable Interpretation Standard

January 13, 2016

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Federal Circuit Remands IPRs to PTAB for Reference Consideration

December 4, 2015

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PTAB Relaxes Rules Related to Motion to Amend in IPR

October 30, 2015

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Kilpatrick Townsend's Media Report September 4-10, 2015



September 11, 2015

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Kilpatrick Townsend's Media Report July 23-30, 2015

July 31, 2015

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Twenty-Nine Kilpatrick Townsend Attorneys Named 2015 Managing Intellectual Property IP Stars

May 6, 2015

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Kilpatrick Townsend's Media Report February 6-12, 2015

February 13, 2015