



## Susan G. L. Glovsky

PRINCIPAL

### Boston Office

155 Seaport Blvd., Boston, MA 02210

617.607.5995

Susan.Glovsky@hbsr.com



### PRACTICE AREAS

- IP Litigation
- Patents
- Trademarks
- Trademark Opposition and Cancellation Proceedings
- Trade Secrets
- Post-Grant Proceedings
- Design Patents
- Copyrights
- Counseling
- Agreements
- Licensing
- Open Source Software Counseling
- IP Intelligence and Audits
- IP Diligence

### TECHNOLOGY AREAS

- Chemistry
- Chemical Engineering
- Medical Devices
- Materials Science
- Biotechnology and Life Sciences
- Biologics and Immunotherapies
- Medical Imaging
- Pharmaceuticals
- Semiconductors
- Robotics
- Computer Software
- Clean Technology
- Blockchain
- Business Methods
- Energy Storage

Susan, a patent attorney, represents science and technology companies in all facets of invention enforcement and protection from the courtroom to the Patent Office.

Susan uses analysis, communication, and advocacy to achieve clients' goals in patent, trademark, copyright, trade dress, and trade secret matters. Her experience covers a broad spectrum of technologies and industries, including biotechnology, chemistry, electrical, mechanical, green technology, ecommerce, medical devices, and consumer products.

Susan has wide-ranging experience representing national and international clients enforcing patents and defending against patent infringement actions through means tailored to the particular business and circumstances. Susan handles patent disputes in courts throughout the country and before the United States Patent and Trademark Office. Her experience handling contested matters before the Patent Office as a Registered Patent Attorney for more than three decades enables her to develop and carry out effective strategies in interrelated courtroom and Patent Office proceedings. Susan is equally adept at pursuing and defending against enforcement actions and contested matters in the trademark realm.

Susan represents and counsels clients on protecting valuable company information as trade secrets through the use of agreements and best practices. She also advises clients on the availability of new resources for protection and enforcement as a result of the enactment of the Defend Trade Secrets Act. When necessary, Susan pursues clients' trade secret rights against those that improperly use clients' trade secret information.

In addition to litigation, Susan's practice focus includes patent and trademark prosecution in the United States and internationally, working with global and local business clients to develop strategies to attain multi-faceted protection of intellectual property.

Recognized by the Boston intellectual property law community, Susan was selected to serve on and chair the Merit Selection Panel constituted in 2009 by the U.S. District Court for the District of Massachusetts in Boston to review and recommend candidates for the Magistrate Judge position. She was recently selected to serve on the Local Rule 16.6 Revision Committee tasked by the Massachusetts District Court to revise the local patent rules.

# Susan G. L. Glovsky

PRINCIPAL



## EDUCATION

- Newton (North) High School, 1973
- University of Vermont, B.S. in Chemistry, 1977
- Boston University School of Law, J.D., 1980

## PROFESSIONAL ASSOCIATIONS

- American Arbitration Association - National Roster of Neutrals
- American Bar Association - Litigation Section
- Boston Intellectual Property Law Association - Past President; Former Co-chair Antitrust and Contested Matters Committees; Founder, Member and prior Co-Chair Litigation Committee
- International Trademark Association
- German-American Business Council of Boston - Former Board Member
- Federal Bar Association of Massachusetts – IP Section

Susan's involvement in the intellectual property legal profession is local and international. Susan is past-president of the Boston Intellectual Property Law Association (BIPLA), founder and past co-chair of the BIPLA's Litigation Committee, a founder and past co-chair of its Committee on Contested Matters, and past co-chair of the Antitrust Committee. As a member of the International Trademark Association (INTA), Susan is on the Enforcement Committee and its Task Force on Pretext Investigations and previously served as co-chair of the Sustainable Labels Subcommittee of the Emerging Issues Committee.

Susan has tried cases to juries, judges, and arbitrators, and she is a member of the American Arbitration Association's National Roster of Neutrals. Susan served as a lead attorney on a litigation team whose victory was named among the "State's Ten Most Important Opinions of 2006" by Massachusetts Lawyers Weekly (Gather Inc. v. Gatheroo, LLC et al.).

Susan is a Martindale-Hubbell featured AV Peer Review rated lawyer. She has received distinction in The Best Lawyers in America® in three categories for her expertise in Trademark Law since 2017, IP Litigation since 2022, and Patent Law since 2023. For 16 years, she has been a "Super Lawyer," a rating of outstanding lawyers who have attained a high-degree of peer recognition and professional achievement. For the past seven years, Susan has been individually honored in the Silver category by World Trademark Review 1000 for enforcement and litigation, and was named among "The Top 250 Women in IP" 2016, 2017, 2018, and 2019 by Managing Intellectual Property. In 2022, Susan was individually recognized by Managing IP as an IP Patent STAR both nationally and in Massachusetts. She was recognized by Managing IP as an IP Star in Massachusetts for patent litigation in 2020. Since 2021, Susan has been individually recognized by IAM Patent 1000 for her patent prosecution expertise.

Susan is a recognized speaker and moderator for various organizations on a variety of intellectual property topics including litigation strategy, patent ownership, and trademark enforcement goals, to name a few.

## BAR ADMISSIONS

- U.S. Court of Appeals for the Federal Circuit
- U.S. District Court, District of Massachusetts
- U.S. Patent and Trademark Office
- U.S. Supreme Court
- Massachusetts
- New York
- Various federal trial and appellate courts around the country

## REPRESENTATIVE EXPERIENCE

- Achieved preliminary injunction against continued infringement of client's patents, and succeeded in having defendant found in contempt, with an award of attorneys' fees, even though the injunction was dissolved based on newly discovered prior art.
- Stopped infringement of client's trademark rights by obtaining injunction shortly after the filing of the complaint. The injunction, issued by The Honorable Joseph Tauro after a Hearing, resulted in settlement of the matter with the entry of a permanent injunction and payment of our client's attorneys' fees.
- Convinced company that had threatened patent enforcement not to pursue matter by demonstrating prior art and literature that questioned the validity of the patent.
- Defended against a complex portfolio of interrelated patents directed to bioreactors and mixers for use by the biotech industry resulting in resolution shortly after deposition of patentee's prosecuting attorney.
- Defended against patent infringement action involving LED backlight technology and light enhancing films in the U.S. District Court for the District of Delaware. A defense strategy was formulated including discovery, mediation, and depositions to achieve a very favorable settlement for our client within ten months of service of the complaint, on the eve of our taking the inventor's deposition.
- Enforced multiple patents involving sampling devices and related mechanical device in multiple courts, resulting in a mediated and negotiated resolution with competitor.
- Achieved dismissal of a patent infringement action for lack of personal jurisdiction.
- Achieved goal of Markman and summary judgment Hearing in the initial phase of litigation in representing an academic institution in a patent case against a major technology corporation involving technology related to speech analysis, compression and transmission. .
- Achieved cessation of infringement of patents on pool cue couplers by pursuing multiple competitors in a succession of actions and obtaining consent judgments in favor of our client.
- Stopped false advertising and trademark infringement by client's competitor by bringing a complaint and motion for preliminary injunction, resulting in consent judgment.
- Achieved immediate concession of priority in interference on diagnostic involving a nucleic acid.

## REPRESENTATIVE EXPERIENCE (CONTINUED)

- Negotiated early dismissal of client from multi-party lawsuit alleging infringement of patents directed to molecular cloning and expression of protein coupled receptors.
- Achieved voluntary dismissal of complaint alleging Lanham Act and other claims against our client and obtained payment by client's insurance company of all attorneys' fees for representing client.
- Counseled a start-up biomedical and diagnostic company in negotiating a license to platform technology.
- Prepared combined software-hardware use license with service agreements for a corporate maker of chemical and bio-tech manufacturing process equipment and components.
- Counseled a start-up biomedical and diagnostic company in negotiating a license to platform technology.
- Prepared combined software-hardware use license with service agreements for a corporate maker of chemical and bio-tech manufacturing process equipment and components.

## ARTICLES

- Dos and don'ts for employees handling third-party patents, co-authored with Lawrence Cogswell, Managing IP, April 2023
- Trade Secrets: Gearing Up To Enhance Protection, Intellectual Property Magazine, May 2018
- Lessons From The 1st Inter Partes Review Ruling, Law360, December 5, 2013
- It's Never Too Late To Arbitrate a Patent Case, New England In-House, July 2006

## IP NEWS ALERTS

- Trade Dress Revival Could Lead to Exclusion Order Under Section 337, November 6, 2018
- Supreme Court Includes Lost Foreign Profits In Patentee's Recovery, June 26, 2018
- Online Re-registration of DMCA Agents Required by the United States Copyright Office by December 31, 2017., December 8, 2017
- Impact of the Brexit Vote on Your IP, Hamilton Brook Smith Reynolds Alert, June 27, 2016
- Disparagement Provision in Lanham Act Found Unconstitutional, Hamilton Brook Smith Reynolds Alert, December 23, 2015
- Lessons Learned from the First IPR Decision by the Federal Circuit - Patent Office Successfully Takes Over Garmin's Attack on Cuozzo's Patent, Hamilton Brook Smith Reynolds Alert, February 11, 2015
- Supreme Court Determines Trademark Tacking is Jury Issue - Reconfirms Markman Claim Construction is for the Judge, Hamilton Brook Smith Reynolds Alert, January 29, 2015
- Supreme Court Orders Deference to Factual Findings for Claim Construction, Hamilton Brook Smith Reynolds Alert, January 28, 2015

### IP NEWS ALERTS (CONTINUED)

- A Decision in the First Inter Partes Review - Lessons from *Garmin v. Cuozzo* for IPRs and Litigation, Hamilton Brook Smith Reynolds Alert, November 25, 2013
- It's Time For a Reliable System to Determine Who Owns a U.S. Patent, Hamilton Brook Smith Reynolds Alert, March 2012
- Post-Recession Planning for Your IP: Rescuing Your Company's IP Value from the Budget Hatchet, Hamilton Brook Smith Reynolds Alert, May 2009
- Federal Circuit Changes Law on Willfulness, Hamilton Brook Smith Reynolds Alert, August 2007
- Supreme Court Removes Barriers To Attack On Licensed Patent, Hamilton Brook Smith Reynolds Alert, January 2007

### SPEAKING ENGAGEMENTS

- "Issues and Practice Tips Relating to Third Party Discovery and Subpoenas, Both Foreign and Domestic," The Massachusetts Chapter of the Federal Bar Association, October 19, 2023
- "Injunctions and Exclusion Orders in IP Cases: Preliminary Injunctions in Federal Court and a Primer on ITC Exclusion Orders," The Massachusetts Chapter of the Federal Bar Association, May 10, 2023
- "IP DUE DILIGENCE 101: Managing the IP Due Diligence Process from Soup to Nuts," ACI's 5th Annual Summit on Life Sciences IP Due Diligence Conference, November 14, 2022
- "Tug of War: Strategies for Dealing with Confidential Client Information and Intellectual Property in a Very Public Forum," The Massachusetts Chapter of the Federal Bar Association, October 18, 2022
- "Erecting and Tearing Down Patent Barriers to Market Access," Advancing Gene Therapy Conference, Woburn, MA, March 29, 2022
- "Entrepreneur Success Through Involvement in Local and International Organizations," MIT Enterprise Forum Podcast, August 6, 2020
- "Solutions for Manufacturing Your Electronic Ideas," MIT Enterprise Forum Podcast, June 5, 2020
- "Going Green and Organic? The How To's of Protecting Sustainable Marks and Labels," 2018 INTA Annual Meeting, Seattle, WA, May 23, 2018
- "IP in the Courts: Three Steps Forward, Two (or Four?) Steps Back: A Trial Lawyer's Synopsis of the Latest in IP Litigation," Massachusetts Continuing Legal Education (MCLE), Boston, MA, June 20, 2017
- "Going Green and Organic? How to Protect Sustainable Marks and Labels," 2017 INTA Annual Meeting Table Topic, Barcelona, Spain, May 24, 2017
- "Intellectual Property Protection Strategies," Hamilton Brook Smith Reynolds / German-American Business Council of Boston Lecture, Newton, MA, April 6, 2016
- "Protecting Innovation - Best Practices," Hamilton Brook Smith Reynolds / Ogletree, Deakins, Nash, Smoak & Stewart Lecture, Waltham, MA, November 5, 2015
- "Search Strategies and Tools for Post Grant Proceedings at the PTAB," Boston Patent Law Association, Boston, Massachusetts, October 29, 2014

## SPEAKING ENGAGEMENTS (CONTINUED)

- “September 2014 Meeting of the BPLA IP Case Law Club,” Boston Patent Law Association, Boston, Massachusetts, September 12, 2014
- “Think Your Company’s Trademark Will Be Difficult to Protect?” Hamilton Brook Smith Reynolds Webcast, June 24, 2014
- “Cross-Pollinating Litigation and Prosecution Intelligence,” Association of Intellectual Property Firms Webcast, April 9, 2014
- “Design Patents: Modernizing an Old Property Interest,” Suffolk University Law School, Boston, Massachusetts, November 22, 2013
- “September 2013 Intellectual Property Roundtable - Hot Topics from the Summer,” American Bar Association, Boston, Massachusetts, September 26, 2013
- “Moving the Battleground to the Patent Office by Taking Advantage of Post-Grant Proceedings,” Hamilton Brook Smith Reynolds Webcast, September 19, 2013
- “Fighting It Out in the Patent Office - Early Experiences and Observations about IPRs,” Boston Patent Law Association Lecture, Waltham, Massachusetts, June 19, 2013
- “Wrestling the eDiscovery Beast - The Role of In-House Counsel,” Hamilton Brook Smith Reynolds Lecture, Boston, Massachusetts, March 19, 2013
- “United States Intellectual Property in a Global Economy,” Boston University School of Management, Boston, Massachusetts, February 28, 2012
- “Considerations in Corporate Structuring to Maximize Potential Recovery in Patent Cases,” Waltham, Massachusetts, June 9, 2011
- “Selecting, Protecting, and Enforcing Trademark Rights,” Association of Corporate Counsel, Northeast Chapter, December 2, 2009
- “Effectively Managing and Protecting Your Company’s Intellectual Property,” New England Corporate Counsel Association, June 3, 2009
- “What Does Not Kill Us Makes Us Stronger: Smart IP Decisions to Maximize Post Recession Strengths,” Association of Corporate Counsel, Northeast Chapter, Waltham, Massachusetts, May 28, 2009
- “Tools and Tactics for Managing Trade Secrets and Other Corporate Treasures,” Association of Corporate Counsel, Northeast Chapter, Waltham, Massachusetts, June 12, 2008