



# Samuel J. Sussman

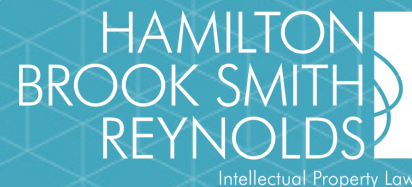
PRINCIPAL

## Boston Office

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## PRACTICE AREAS

- Patents
- IP Litigation
- Design Patents
- Trademark Opposition and Cancellation Proceedings
- IP Intelligence and Audits

## TECHNOLOGIES

- Mechanical Engineering
- Optics and Photonics
- Electrical Engineering
- Biotechnology and Life Sciences
- Medical Devices
- Semiconductors
- Computer Software
- Materials Science
- Mobile

## EDUCATION

- University of Virginia, B.S. in Physics B.A. in Foreign Affairs, concentration in the Middle East
- Cornell Law School, J.D.

## BAR ADMISSIONS

- U.S. Court of Appeals for the Federal Circuit
- U.S. District Court, District of Massachusetts
- U.S. Patent and Trademark Office
- Massachusetts

Sam strategically develops patent assets for clients, advises clients on licensing and commercializing their IP portfolios, and has experience in portfolio management and review, infringement analysis, and drafting and negotiating agreements.

Once a patent issues, Sam protects clients' patents against post grant proceedings. He also works with clients to bring post grant proceedings to remove patent obstacles owned by third parties.

Sam has extensive experience as a litigator protecting and asserting clients' rights in patent, trademark, trade secret, and copyright cases before United States District Courts in a number of jurisdictions in the U.S. Sam has experience obtaining favorable outcomes for clients in mediation sessions before Federal Judges. In addition to U.S. matters, Sam has handled intellectual property disputes in Europe and Asia, including cases ranging from website takedown proceedings to patent and trademark infringement matters. In patent matters, Sam has experience in preparing inter partes review and post-grant review petitions that have succeeded in the institution of trials by the PTAB of the USPTO. He has also assisted clients threatened by infringement allegations by preparing and litigating declaratory judgment actions, including against non-practicing entities.

Sam has identified trademark counterfeiters in Asia and prevented them from selling, exporting, and importing infringing goods internationally. He has successfully requested and received preliminary and permanent injunctions resulting in the cessation of sale and distribution of infringing products.

Sam has worked with clients that include individual inventors, large educational institutions, small corporations, and multi-national corporations to provide patent prosecution services, both in the U.S. and internationally, tailored to clients' particular needs. He utilizes his experience in contested and licensing matters to draft and obtain patent claims that provide robust protection and maximize commercial value.

Example technology areas:

- Electrical Engineering
- Medical Devices
- Mechanical Engineering
- Optics
- Telecommunications
- Machine Learning
- Process Control
- Computer Architecture
- Digital Storage
- Material Science
- X-ray imaging
- Computer Modeling

Before he began his career as a patent attorney, Sam assisted in research on large self-assembling proteins and other molecules that were analyzed using dynamic light scattering to predict the best conditions for crystallization and to examine behavior under different external stimuli.

Sam is a board member of the Massachusetts Chapter of the Federal Bar Association and is co-chair of the IP Section of the Massachusetts Chapter. In addition, Sam was recognized as one of the 2024 Massachusetts Rising Stars by Super Lawyers.

### REPRESENTATIVE CONTESTED MATTERS

- Sam has been involved in the preparation and filing of multiple post grant proceeding petitions that have been instituted by the USPTO and led to favorable resolutions for his clients. One example, in the blockchain technology space, is PGR2022-00058. Post grant proceedings are a growing practice area that can provide a quicker and less expensive means of challenging the validity of patents than traditional litigation.
- Sam has appeared before the Federal Circuit to prepare and assist with the arguments for an appeal of an inter partes review decision by the USPTO.
- Sam has successfully obtained preliminary injunctions, for example in Civil Action No. 21-cv-11254 in the District of Massachusetts, ordering defendants to cease infringement of a client's trademark and tradename rights.
- Sam, utilizing the Uniform Domain-Name Dispute-Resolution Policy, has been able to obtain ownership for a client of multiple domain names, including those hosted outside the United States. These domain names were being used by anonymous and/or unidentifiable individuals to divert internet traffic away from the client's actual domains or online presence.

### 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 NEWS ALERTS

- Online Re-registration of DMCA Agents Required by the United States Copyright Office by December 31, 2017., December 8, 2017
- In re: Micron Technology, Inc.: Uncertainty Remains in Objections to Patent Venue, November 29, 2017
- The Federal Circuit Confirms a Return to Restrictive Patent Venue Requirements , September 29, 2017

### PROFESSIONAL ASSOCIATIONS

- Boston Intellectual Property Law Association
- Federal Bar Association of Massachusetts
  - Board Member
  - IP Section Committee