

# ROGER W. PARKHURST

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## ***Education***

Purdue University, B.S.Ch.E., 1965  
National Honoraries: Tau Beta Pi (Engineering); Omega Chi Epsilon (Chem. Eng.);  
The George Washington University, J.D., 1968  
Harvard Law School, Program on Negotiation, Certified in Mediating Disputes, 2017

## ***Bar Admissions***

New York 1969  
District of Columbia 1970  
Virginia 1974  
U.S. Supreme Court 1978  
U.S. Courts of Appeals  
Federal Circuit 1982  
Third Circuit 1982  
Fourth Circuit 1975  
U.S. District Courts  
District of Columbia  
E.D. Virginia  
W.D. Virginia  
W.D. New York  
Admitted *pro hac vice* in more than 30 other U.S. Courts of Appeals and District Courts  
U.S. Patent and Trademark Office 1968

## ***Professional Affiliations***

American Intellectual Property Law Association, President 2001-2002  
Federal Circuit Bar Association  
The District of Columbia Bar  
Virginia State Bar

## ***Employment***

Steptoe & Johnson, LLP, Washington, DC, partner April 2005-2018  
Parkhurst & Wendel, LLP, Alexandria, Virginia, partner 1990-2005  
Arnold, White & Durkee, Arlington, Virginia, partner/shareholder 1989-1990  
Parkhurst & Oliff, Alexandria, Virginia, partner 1983-1988  
Stevens, Davis, Miller & Mosher, Arlington, Virginia 1971-1982, partner 1975-1982  
Xerox Corporation, Patent Department, Rochester, New York, 1968-1971

## ***Communications, Opinion Writing, and Leadership Responsibilities***

This resume and the attachment thereto show that throughout my career I have argued numerous motions and issues before numerous U.S. District Courts and appeals before U.S. Courts of Appeals, *ex parte* appeals before the BPAI, now PTAB, and have litigated numerous *inter partes* interferences and IPRs before that Board.

I am an effective, experienced patent law counselor and advocate. I succinctly organize and prioritize facts, legal concepts and precedents, to clearly explain them and thereby effectively counsel clients and advocate positions. These habits and skills have been demonstrated throughout my career in both verbal articulation and clear writing. I have consulted and advised hundreds of clients, prosecuted hundreds of patent applications and litigated scores of patent cases involving a wide variety of technologies. In those matters (and others), I have led and supervised teams of IP attorneys and other professionals, And, I have authored more than 300 formal written patentability/infringement opinions.

### *Selected Cases*

See attached list of selected litigation cases, which includes notes on the subjects matter of many of those cases. In the large majority of those post-1980 cases, I have been the lead counsel for the party(ies) I represented.

### *Dispute Resolution Experience*

My interest in the dispute resolution process in cases involving technology is longstanding. In addition to many years of litigating, and negotiating settlements of, patent cases, for at least the past ten years I have acted as a judge, studying the case materials and sitting for oral arguments, for The George Washington Law School's Patent Moot Court Competition (now called Rothwell IP Moot Court Competition), and in 2018 and 2019 I judged the quarterfinals of the national Giles S. Rich Patent Moot Court Competition at the U.S. Court of Appeals for the Federal Circuit. During the 2003 AIPLA Mid-Winter Institute I judged a patent appellate demonstration argument on a panel comprising Federal Circuit Judge Newman, U.S. District Judge Matthew F. Kennelly, and myself. During the 2004 AIPLA Mid-Winter Institute I was a panelist along with Donald R. Dunner, Ninth Circuit Judge Richard C. Tallman, and U.S. District Judge Dee Benson, in a program entitled "How to Do An Appeal in the Digital Age." And in private practice I have sat on a number of panels hearing and critiquing other attorneys' practice arguments for presentation in Federal Circuit appeals. I was once asked by a U.S. District Judge to act as a Special Master in a pharmaceutical patent case. And I am certified in mediating disputes by the Harvard Law School, Program on Negotiations.

### *Author [A] and Speaker [S]-- Selected Items*

"U.S. Supreme Court Decisions Renew Need for Opinions on Competitor's Patents," AIPLA Newstand, August 4, 2017 [A]

"Likely U.S. District Court Estoppels After PTAB Final Written Decisions," a Steptoe webcast, November 16, 2016 [A/S]

"21st Century Section 101," a Steptoe webcast, October 13, 2016 [A/S]

"AIA Post-Grant Proceedings: Federal Circuit & PTAB Expand Roles of Collateral Prior Art in Post-Grant Proceedings," AIPLA Newstand, February 11, 2016 [A]

"Best Practices for Monitoring Competitors and Litigious Parties," AIPLA, Wilmington, DE, June 7, 2013 [A/S]

"After Ariad v. Lilly: Implications and Best Practices," a Steptoe teleconference event, April 27, 2010 [A/S]

- "U.S. Supreme Court Revisits Non-Obviousness in KSR, Ultimate Test of Patentability," Steptoe webcast events, September 28, 2006 and June 5, 2007 [A/S]
- "Demonstration of Cross-Examination of a Technical Expert Contending for Obviousness," before U.S. District Judge William C. Conner, PLI, New York, NY, 2002 and 2005 [S]
- Markman Mock Hearings, PLI, New York, NY, October 2001, 2003 and 2004 [S]
- "Closing Arguments in Patent Validity/Infringement Cases," PLI, New York, NY, October 2000 [S]
- "The 1993 Amendments to the U.S. Federal Rules of Civil Procedure," Institute of Intellectual Property, Tokyo, Japan, June 1993; Tokyo University, June 1993; and Alexandria, Virginia Bar Assn., January 1994 [A/S]
- "Preliminary Injunctions in Patent Cases," ABA-PTC, Chicago, IL, 1990 [A/S]
- "U.S. Patents--Their Scope and Enforcement," Am. Ceramics Soc., 1989 and 1990 [A/S]
- "Current USITC Law and Practice After the Omnibus Trade Act of 1988," Houston Law Assn., 1989 [A/S]
- "U.S. ITC Proceedings-Enforcing U.S. Patents Against Importers," European Study Group, Versailles, France, 1980 [A/S]
- "U.S. Supreme Court Unanimously Approves Duration Unlimited Licensing of Unpatentable Technology," Jour. Japanese Group AIPPI, 1979 [A]
- "Nonobviousness--Patentability Under 35 USC 103," Exchanges ASPI, Revue L'Assn. Francaise des Specialistes En Propriete Industrielle, December 1978 [A]

***Other Noteworthy Mentions***

Euromoney's Expert Guide to the World's Leading Patent Law Practitioners, 2010-2017

Ranked, IAM Patent 1000, Luminary: DC Metro Area, 2014-2016

Who's Who Legal, Patents, 2005-2016

The International Who's Who of Patent Lawyers, 2005-2013; recognized in 2007 as an "authority" on patent litigation, and a "very knowledgeable and prominent member of the intellectual property bar."

ROGER W. PARKHURST  
SELECTED LITIGATION CASES

Raytheon Company v. Sony Corp. et al., Appeal No. 17-1554 (Fed. Cir. 2018) from PTAB; assisted in appellate briefing and preparation for oral argument for Raytheon.  
[microelectric chips having removable substrate and etch-stop layers]

International Spirit Brands Ltd. v. Kalaris, U.S. TM Opposition No. 91/231,927 (TTAB 2016) as lead counsel for opposer, settled favorably for opposer.

Hyundai Mobis Co. Ltd. et al v. Autoliv ASP, Inc., IPR 2014-01005; Fed. Cir. Appeal No. 2016-1896, lead counsel for petitioner/appellant Hyundai Mobis; primary author of appellate brief. (\*)  
[automotive airbag technology]

Hyundai Mobis Co. Ltd. et al v. Autoliv ASP, Inc., IPR 2014-01006; won final written decision by PTAB holding all challenged claims unpatentable/invalid.  
[automotive airbag technology]

Roger Cleveland Golf Co., Inc. et al v. Callaway Golf Co., Civil Action No. 8:13-cv-1642 AG (RNBx), (C.D. Cal. 2013) as lead counsel for plaintiffs in trademark infringement/unfair competition case; defeated motion to dismiss; settled.

SRI Sports Ltd. and Roger Cleveland Golf Co., Inc. v. Golf Network et al., Case No. SA 12-cv-294 DOC-RNB, (C.D. Cal 2012) as lead counsel for plaintiffs in 15 USC 1125(a) (Section 43(a)) unfair competition/trademark case; settled with stipulated injunction against all defendants.

Production Automation, Inc. v. FKI Logistex, Inc., Civil Action No. 2:07-CV-480(RBS), E.D.Va. (Norfolk), settled as lead counsel for defendant.  
[multiple container conveyor apparatus]

Teva Pharmaceuticals USA, Inc. et al. v. Abbott Labs., Fournier Industrie et Santé, and Laboratories Fournier S.A., Civil Action No. 02-1512 (SLR) D. Del. and In re Tricor Direct Purchaser Antitrust Litigation, Civil Action No. 05-340 (SLR) D. Del., Consolidated with related antitrust actions; of counsel for patent owner Fournier defending patent-antitrust claims.  
[pharmaceutical patents]

StarTrak Systems, LLC v. Hester; Satamatics Ltd. et al.,  
Civil Action No. 07-9203(DRD), (D.N.J. 2007); defeated  
plaintiff's motion for preliminary injunction in trade  
secret case, as co-counsel for defendants.  
[satellite monitoring of trucks/trains]

Quate (Affymetrix Inc.) v. Cerina (Wisconsin Alumni Res. Found  
(WARF), Interference No. 105,446 (BPAI 206) as lead counsel for  
WARF litigated case to judgment against Quate's patent.  
[direct write optical photolithography without masks]

Henry-Griffitts, Inc. v. Roger Cleveland Golf Company, Inc.  
et al., Civil Action No. 04 CV 2182 (S.D. Cal. 2005); lead  
counsel for defendants in patent infringement/invalidity  
litigation; won stipulated consent judgment after successful  
Markman hearing; argued and won Appeal No. 2006-1278 at  
Federal Circuit. (\*\*)  
[golf club testing system]

SMC Corp. v. Tanhay Corp. et al, Civil Action No. CV04-9466 (RJK-  
AJWx) (C.D.Cal. 2004) as lead counsel for  
plaintiff/patentee, settled favorably for plaintiff.  
[pneumatic/hydraulic apparatus]

Semitool Inc. v. Oblon et al. (ex rel. Semitool Inc. v. Tokyo  
Electron America, Inc.), Misc. Civil Action No. 03-CV-24  
(E.D.Va. 2003); local counsel for Tokyo Electron in  
discovery dispute.  
[semiconductor wafer production]

Takata Corp. v. Delphi Automotive Systems Corp. and General  
Motors Corp., Civil Action No. 01-746-KAJ, (D.Del. 2001);  
as lead counsel for Takata successfully settled patent  
infringement action against Delphi/GM.  
[automotive airbag igniter/inflator technology]

Adang et al. (Mycogen Corp./Dow Chemical Co.) v. Fischhoff et al.  
(Monsanto Co.), Patent Interference No. 103,324 (BOPI 2001);  
Appeal No. 01-1169; 286 F3d 1346(Fed. Cir.2002); as lead  
counsel for Monsanto won interference; briefed and argued  
appeal; on appeal count (claim) construction only modified  
by Federal Circuit; all other findings affirmed. (\*\*)  
[genetically transformed insecticidal tomato plants]

Karsten Mfg. Co. v. Cleveland Golf, Civil Action No. CIV95-2239, (D.Ariz. 1995); lead counsel for Cleveland Golf defended allegations of infringement of five patents, won five summary judgments; briefed and argued Appeal No. 99-1234; 242 F2d 1376 (Fed. Cir. 2001); all aff'd except two claims of one patent held non-obvious; case then settled. (\*\*)  
[golf club technology]

Bedmate International Corp. v. Med-Pat, Inc., Civil Action No. 98-3488, (D.N.J. 1999); as lead counsel for Bedmate won summary judgment of patent infringement via doctrine of equivalents, after which case settled favorably to patentee.  
[hospital telephone systems]

Pioneer Hi-Bred International, Inc. v. The Lubrizol Corp., Civil Action No. 4-92-70198 (S.D.Iowa 1999); represented attorneys who prosecuted biotechnology patent against charges of inequitable conduct, through discovery depositions and preparation for trial testimony; judgment for patentee dismissing inequitable conduct claim.

Loesch-Fries et al. (Agrigenetics Corp.) v. Beachy et al., (Monsanto Co.), Patent Interference No. 103,645 (BPAI 1995); Appeal No. 96-1186 (Fed. Cir. 1996); as lead counsel for Monsanto, briefed and argued appeal of Board decision arbitrarily declaring second interference on part of original interfering subject matter without any stated evidentiary basis for decision; affirmed. (\*\*)  
[genetically engineered plants]

Takeda Chemical Co., Ltd. v. Astra-Zeneca Pharmaceutical Corp., Civil Action No. 1:1993CV04171, (S.D.N.Y. 1994); defended attorneys for Takeda against allegations of inequitable conduct through depositions until settlement.  
[pharmaceutical patents]

Ramos v. Biomet, Inc., Civil Action No. 90-0417-CIV, (S.D.Fla. 1993); as lead patent counsel for Ramos, after full bench trial patent held valid and infringed, and awarded treble damages for willful infringement; briefed and argued Federal Circuit Appeal No. 94-1004; infringement via doctrine of equivalents aff'd (\*\*)  
[hip prosthesis technology]

J&P Coats, Ltd. v. Dixie Yarns, Inc., Civil Action No. 95-CV-444 (W.D.N.C. 1995) as lead counsel for Dixie defended patent infringement action to settlement.  
[textile equipment]

Knowledgenet Inc. v. Boone, Civil Action 1-94-CV-7195 (N.D.Ill. 1994) defended defendant in internet domain name/unfair competition case to settlement.

In re Baysdon et al., Appeal No. 93-1168 (Fed. Cir. 1993); as lead counsel for Monsanto won appeal against USPTO wherein Monsanto had sought declaration of interference with a third party application; PTO solicitor conceded after my opening oral argument to the Federal Circuit; interference declared and prosecuted to dismissal. (\*\*)  
[chemical reaction process and herbicide product]

Westinghouse Air Brake Co. v. Knorr Brake Holding Corp., Civil Action No. 92-0262 (W.D.Pa. 1992) expert witness for WABCO until settlement.  
[railroad braking technology]

Teledyne Industries Inc. v. Air-A-Plane Corp., Civil Action No. 9:91cv822 (E.D.Va. 1992) as lead patent counsel for defendant, defended patent infringement suit through entire discovery; settled just before trial.  
[apparatus and method for air-conditioning aircraft]

National Draeger, Inc. v. Industrial Scientific Corp., Civil Action No. 89-1291, (W.D.Pa. 1990); patent law and practice expert for Industrial Scientific until case settled.  
[noxious vapor detection equipment/method]

Eagle Comtronics, Inc. v. Northeast Filter Co., Inc., Civil Action No. 90-CV-573; 22 USPQ2d 1134 (N.D.N.Y. 1991), as lead counsel for Eagle won summary judgment of patent infringement.  
[cable television transmission security technology]

Bulk-Store Structures Ltd. v. Campcore, Inc., Civil Action No. 88-CV-883, (N.D.N.Y. 1988); as lead counsel won for plaintiff preliminary injunction enjoining patentee from threatening to enforce patent against devices at issue in prior suit; 16 USPQ2d 2029 (N.D.N.Y. 1990); won summary judgment of res judicata for plaintiff; briefed and argued Appeal No. 91-1002 (Fed. Cir. 1991); cross-appeal of denial of civil contempt and award of attorneys fees, affirmed in

unpublished opinion.  
[salt dome structure patents]

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Metretek, Inc. v. Metscan, Inc., Civil Action No. \_\_\_\_\_, (W.D.N.Y. 1987); as lead counsel defended patent infringement action through discovery to settlement.  
[automated remote data collection/communication system for monitoring household meters via RF transmission]

Hollowick, Inc. v. Standex International Corp., Civil Action No. CTV-86-0281T (W.D.N.Y. 1896) as lead counsel for plaintiff in trade dress infringement action, won preliminary injunction and then favorable settlement for plaintiff.

Spindelfabrik Suessen-Schurr Stahlecker & Grill GmbH, Hans Stahlecker, and Fritz Stahlecker v. Schubert & Salzer Maschinenfabrik AG, Civil Action No. 83-2421-3, (D.S.Car. 1985); testified as patent law and practice expert for defendant; aff'd., 829 F2d 1075 (Fed. Cir. 1987).  
[open-end textile yarn spinning apparatus patent]

Indium Corporation of America v. Semi-Alloys, Inc., Civil Action No. 82-CV-482, 566 F. Supp. 1384; 591 F. Supp. 608; 611 F. Supp. 379 (N.D.N.Y. 1984), as lead counsel for Indium, briefed and argued appeal, aff'd., 781 F2d 879 (Fed. Cir. 1985); in patent declaratory judgment/antitrust case dismissed for alleged lack of case or controversy. (\*\*)  
[semiconductor package sealing system]

Teibow Company, Inc. v. Tokyo Boshi K.K., Civil Action No. 82-0744, (D.D.C. 1982); as lead counsel defended patent infringement action, including two weeks of depositions in Tokyo, Japan, to settlement advantageous for defendant.  
[extruded polymer pen nib technology]

Akzo Plastics B.V. v. E.I. DuPont de Nemours & Co., Civil Action No. 80-359, 519 F. Supp. 356 (D.Del. 1981), drafted portions of appeal brief; appeal withdrawn (3<sup>rd</sup> Cir. 1982); declaratory judgment action against DuPont patents dismissed for alleged lack of case or controversy. (\*)  
[aramid fiber production technology]

In re Certain High Voltage Circuit Interrupters and Components Thereof, Investigation No. 337-TA-64 (USITC 1979); lead counsel for respondent Merlin Gerin S.A. through dismissal.  
[high voltage circuit breaker technology]



E-Systems Inc. v. The Arbitron Co., Civil Action No. 79-1067-A, (E.D.Va 1980); co-counsel for plaintiff in jury trial alleging misappropriation of trade secrets; verdict for defendant.

[wireless system for home television channel setting detection/polling]

SCM Corp. v. Xerox Corp., Civil Action No. 15,807, (D.Conn. 1978); expert for Xerox on certain patent studies on electrophotographic/xerographic imaging methods and apparatus in jury trial of antitrust/patent declaratory judgment case won by Xerox.

Hughes Aircraft Co. v. Centre Electronique Horloger S.A., Civil Action No. CV 78967-F(TX), (C.D.Cal. 1978); lead counsel for patentee CEH in declaratory judgment suit litigated to favorable settlement for patentee.

[frequency divider circuits for electronic timepieces]

Bridgestone Tire Co. of America, Inc. v. Petzetakis, Civil Action No. 1054-73 (D.D.C. 1975) successfully settled for declaratory judgment plaintiff.

[co-extruded plastic coil reinforced plastic tubing technology]

Milliken Research Corp. v. Beaunit Corp., Civil Action No. 75-1648, 382 F. Supp. 403 (W.D.N.C. 1974), aff'd, 538 F2d 1022 (4<sup>th</sup> Cir. 1975), won bench trial judgment of patent infringement; briefed appeal, reversed by 4<sup>th</sup> Cir. as obvious; wrote cert. petition, cert. denied, 426 U.S. 936. [commercial warp knit elastic fabric and method] (\*)

Maclaren et al. v. B-I-W Group, Inc., Civil Action No. 70 Civ. 5348, 401 F.Supp. 283 (S.D.N.Y. 1975), reversed, 535 F2d 1367 (2d Cir. 1976), cert. denied, 429 U.S. 1001 (1976); won bench trial judgment of patent infringement for Maclaren; drafted portion of brief to 2d Cir.; reversed by 2d Cir. as obvious; drafted portion of petition for cert.; petition denied. (\*)

[collapsible 3-D stroller structure]

Milliken Research Corp. v. Dan River, Inc., Civil Action No. 70-C-13-D (W.D.Va. 1982); aff'd, 739 F2d 587 (Fed. Cir. 1984); won three recommended judgments for patentee by Special Master; reversed by District Court Judge; briefed Federal Circuit appeal; aff'd on appeal 2-1. (\*)

[commercial warp knit pile fabric and manufacturing method]

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- (\*)           appellate briefing
- (\*\*)          appellate briefing and oral argument