



Walter M. Egbert III

Partner

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Areas of Concentration

- Patent Counseling including due diligence studies and opinions such as non-infringement, freedom-to-operate, and invalidity.
- Patent Litigation relating to medical devices technology, semiconductor manufacturing, telecommunications.
- Patent Procurement including reexaminations and reissue in various technological areas including medical devices, mechanical and electrical engineering technology, and software.
- Intellectual Property Transactions including licensing and development agreements and advice regarding intellectual property aspects of corporate acquisitions.

Court Admissions

- Federal District of New Jersey
- Southern District of New York
- Eastern District of New York
- United States Patent & Trademark Office

Professional Activities

- Guest Lecturer, Patent Law, Brooklyn Law School, 2005.

Highlighted Matters

Selected Patent Litigations

- Represented Plaintiff in patent infringement lawsuit involving

Practice Groups and Other Information

Intellectual Property
Litigation
Patents

Education Information

Princeton University, B.S.E. Mechanical and Aerospace Engineering, 1989
elected 1989,
Sigma Xi Scientific Research Society
Donald Janssen Dike Award for
Excellence in Undergraduate
Research, Honorable Mention,
1989
Fordham University School of Law, J.D.,
1994

11 patents in semiconductor, 802.11 wireless transmission, laser, and data storage technologies. Supervised team of eight associates. (E.D. Texas 2006-9).

- Represented Defendant in multi-defendant patent infringement lawsuit involving caller ID, call waiting technology. (E.D. Texas 2005-7).
- Represented Defendant in patent infringement lawsuit involving image technology for CAT scan equipment. (S.D. Texas 2005).
- Represented Defendant in patent infringement lawsuit involving safety mechanism for pharmaceutical syringes. (S.D. Cal. 2003-4).
- Represented Plaintiff in patent infringement lawsuit involving four patents in plasma-enhanced chemical vapor deposition technology. (E.D.N.Y. 2003-4)

Selected Transactional Matters

- Due diligence with regard to intellectual property assets, agreements and issues; Drafted intellectual property provisions of share purchase agreement in connection with Liberty Media Corporation's \$145 million indirect acquisition of a majority interest in FUN Technologies PLC.
- Due diligence with regard to intellectual property assets, agreements and issues; Negotiated intellectual property provisions of stock purchase agreement in connection with Liberty Media Corporation's \$185 million acquisition of a controlling interest in OpenTV Corporation.
- Due diligence with regard to intellectual property assets, agreements and issues; Negotiated intellectual property provisions of asset purchase agreement in connection with Emerson Electric Company's \$725 million asset acquisition of Ericsson Energy Systems.

Selected Patent Counseling & Prosecution Matters

- Performed freedom-to-operate /product clearance investigations for various pipeline medical device products for Fortune 100 healthcare company.
- Provided strategic counseling relating to patent portfolio development
- Represented Patent Owner in 23 reexamination proceedings.
- Prepared and prosecuted patent applications (U.S. and foreign) relating to various technologies including medical

devices (continuous glucose monitoring, minimally invasive surgical instrumentation, orthopedic devices, coronary artery bypass devices), software and computer system intrusion detection (detection of malware, anomaly detection), medical imaging, digital circuits (high speed pipeline processing).

Highlighted Publications

- "The Peer Review Pilot Program at the United States Patent & Trademark Office," Patent Strategy & Management, September 2009.
- "Use of License to Avoid Application of the First Sale Doctrine: L.G. Electronics v. Bizcom, 79 U.S.P.Q.2d 1443 (Fed. Cir. 2006)," Joint Patent Practice Continuing Legal Education, Inc., New York, May 2007.
- "Claim Construction after Phillips v. AWH," Novo Nordisk Patent Attorney Summit, 2006.