

## Kevin K. McNish

### Associate

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A registered patent attorney, Kevin K. McNish represents clients in *inter partes* reviews, covered business method reviews, and other post-grant proceedings before the United States Patent and Trademark Office. His first-chair experience spans more than 60 Patent Trial and Appeal Board proceedings and includes drafting petitions and responsive briefs; taking and defending expert cross-examinations; and arguing at oral hearings before the Board. In 2018, the analytics firm Patexia recognized him as one of the **top 10 most effective attorneys** practicing before the Patent Trial and Appeal Board.

Mr. McNish led the defense of IBM's patents at the Patent Trial and Appeal Board against a series of *inter partes* reviews and covered business method reviews filed by Priceline and its related companies. His team obtained complete denials of institution on six petitions, scoring a clean sweep against Priceline's challenges to three of IBM's patents. One of those decisions denying institution later received a rare designation of "informative" from the Patent Trial and Appeal Board. *Kayak Software Corp. v. Int'l Bus. Machs. Corp.*, Case CBM2016-00075, Paper 16 (PTAB Dec. 15, 2016) (designated informative).

He was also part of the team that successfully defended an Orange Book-listed patent on Pharmacyclics' mantle cell lymphoma treatment *Imbruvica*® against a hedge fund's petition for *inter partes* review. Persuaded by the preliminary response the firm filed for Pharmacyclics, the Board completely denied institution on the hedge fund's petition.

In addition to his practice representing patent owners, Mr. McNish also represents companies seeking to challenge patents at the United States Patent and Trademark Office, including Cisco, IBM, and Nokia. His work on behalf of patent challengers has contributed to instituted proceedings, litigation stays, and favorable settlements.

Outside of his work at Desmarais LLP, Mr. McNish is an active member of the PTAB Bar Association, where he serves as the District Court Desk Editor for the biweekly PTAB Roundup newsletter. He has also given presentations on practice before the Patent Trial and Appeal Board at national conferences

#### EDUCATION

University of Virginia School of Law, J.D., 2011, ABA-BNA Award for Excellence in the Study of Intellectual Property Law, Managing Editor for the Virginia Journal of Law and Technology

Vanderbilt University, B.A., Physics, Mathematics, and High Honors in Art History, 2008, *magna cum laude*, Harold Stirling Vanderbilt Scholar

#### ADMISSIONS

2014, New York

2011, California

2009, United States Patent and Trademark Office

and seminars.

Before joining Desmarais LLP, Mr. McNish was an associate in the Orange County, California office of Knobbe Martens Olson & Bear LLP. During law school, he spent two semesters as a patent and licensing intern with the University of Virginia Patent Foundation, now the UVA Licensing and Ventures Group. He also served as the managing editor of the Virginia Journal of Law and Technology, a law journal that publishes about intellectual property law, Internet law, privacy law, and other issues at the intersection of law and technology.

## Prior Experience

- Associate, Knobbe Martens Olson & Bear LLP, Orange County, California, 2011-2013
- Intern, University of Virginia Patent Foundation, 2010-2011

## Courts

- United States Court of Appeals for the Federal Circuit
- United States District Court for the Southern District of New York
- United States District Court for the Northern District of California
- United States District Court for the Northern District of Indiana
- United States District Court for the Eastern District of Michigan

## Memberships & Affiliations

- PTAB Bar Association – PTAB Roundup, District Court Desk Editor; Communications Committee
- Federal Circuit Bar Association

## Other Distinctions

- Docket Navigator, Top Attorneys in the PTAB (2015)

## Representative Matters

- As lead counsel, represented petitioner IBM in *inter partes* reviews against an e-commerce patent that Groupon asserted against IBM. Trial was instituted on every claim that Groupon asserted against IBM; the matter settled favorably after the oral hearing.
- As lead counsel, represented patent owner IBM to defend patents related to network-based services against petitions for *inter partes* review and covered business method review filed by Priceline and its affiliates. Obtained complete denials of institution on six of Priceline's petitions, ultimately leading to a favorable settlement for IBM.
- As lead counsel, represented patent owner Bonutti Skeletal Innovations to defend patents related to spinal implants and surgical techniques against petitions for *inter partes* review filed by Globus Medical Inc. After obtaining complete denials of institution for key patents, achieved a favorable settlement.
- Represented patent owner Pharmacyclics to defend one of its Orange Book-listed patents on the mantle cell lymphoma treatment *Imbruvica*® against a hedge fund's petition for *inter partes* review.

Obtained a complete denial of institution.

- Represented Kinetic Concepts, Inc. against Wake Forest University Health Sciences in a patent infringement and breach of contract action involving negative pressure wound therapy. Overcame multiple motions for summary judgment filed by Wake Forest, contributing to a favorable settlement.

## Publications

- “Desmarais LLP Ranked as Top PTAB Firm by Patexia” – *Firm News*, December 5, 2018 – Kevin K. McNish is ranked by analytics firm Patexia as the industry’s No. 9 most effective PTAB attorney overall (Performance Rate of 78.3%) and as the No. 12 most effective PTAB attorney for patent owners (Performance Rate of 87.1%).
- “Desmarais LLP Secures \$82.5M Patent Win for IBM Over Groupon at Trial” – *Firm News*, July 27, 2018 – Kevin K. McNish was part of the Desmarais LLP team that won an \$82.5 million jury verdict for IBM in a patent infringement trial in Delaware.
- *IBM Corp. v. The Priceline Group Inc. et al.* – *Firm News*, December 2017 – Kevin K. McNish was part of the Desmarais LLP team that represented IBM in litigation against Priceline involving patents related to network-based services, which resulted in a favorable settlement for IBM.
- “PTAB Follows Strict Application of CBM Statute Following *Unwired Planet*” – *Patent Docs*, December 27, 2016 – Kevin K. McNish was lead counsel for the Desmarais LLP team that successfully represented IBM before the Patent Trial and Appeal Board in a covered business method review filed by Priceline and its related companies. The firm obtained a denial of institution on Priceline’s petition.
- “PTAB Nixes Priceline’s Bid To Review IBM Patent” – *Law360*, July 29, 2016 – Kevin K. McNish led the Desmarais LLP team that successfully represented IBM before the Patent Trial and Appeal Board in an *inter partes* review filed by Priceline and its related companies. The firm obtained a denial of institution on Priceline’s petition.

## Events

- Panelist, “Leveraging the PTAB Journey: Concurrent District Court Trial Strategies,” at PLI USPTO Post-Grant Patent Trials 2018: Change & Recalibration (September 2018).
- Roundtable Moderator, “PTAB Boot Camp,” at PTAB Bar Association Inaugural Conference (March 2017).
- Presenter, “Post-Grant Practice,” at Desmarais LLP (February 2017).