

Karim Z. Oussayef

Partner

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Karim Oussayef is a trial lawyer who has represented clients in a wide variety of offensive and defensive technology litigation. He has litigated patent, trade secret, and contract cases relating to networking devices, VOIP telephony, cable television, e-commerce platforms, web and mobile applications, encryption and compression technologies, antibody therapies, skin graft medical devices, and vehicle insurance.

Mr. Oussayef has significant trial experience. He recently second-chaired IBM's first trial as a patentee in decades, helping secure an \$82.5 million jury verdict on behalf of IBM. Leading up to trial, Mr. Oussayef successfully argued dispositive issues involving claim construction, patent eligibility, and infringement. At trial, Mr. Oussayef examined IBM's technical expert and cross-examined three of Groupon's witnesses, including Groupon's technical expert. The two-week trial resulted in a finding of willful infringement on all four patents-in-suit.

Mr. Oussayef has extensive experience managing all aspects of technology cases. He represented LifeCell Corporation against TELA Bio, Inc. in a trade secret and unfair competition case involving surgical mesh products, where he defended and deposed dozens of witnesses across the country before the case settled. He also defended Cisco, ARRIS, Time Warner Cable, and several other technology companies in patent infringement actions involving 29 patents asserted by a non-practicing entity, Rockstar, created by Apple, Microsoft, Ericsson, Sony, and Blackberry. In that case, Mr. Oussayef managed a team of attorneys from several law firms engaged in simultaneous district court actions and patent office proceedings.

Mr. Oussayef is active in the firm's pro bono and attorney development efforts. Mr. Oussayef has helped expand Desmarais LLP's pro bono practice and has served as pro bono counsel in matters involving political asylum and not-for-profit intellectual property licenses. Mr. Oussayef co-directs the firm's trial training program, where Desmarais LLP associates have the opportunity to run a multi-day mock trial, with partners acting as judges, actors acting as witnesses, and volunteers acting as jurors.

Mr. Oussayef earned his law degree from Boston University and studied computer science as an undergraduate at the University of Rochester, where

EDUCATION

Boston University School of Law, J.D., 2008, magna cum laude, Executive Editor of the Journal of Science & Technology Law

University of Rochester, B.S., 2004, cum laude, Computer Science with High Departmental Distinction

ADMISSIONS

2009, New York

2008, Massachusetts

he focused on artificial intelligence. He was president of the debate team, where he was an Academic All-American and competed against schools from across the country. His decision to pursue technology litigation arose from combining those interests.

Before joining Desmarais LLP, Mr. Oussayef was an associate in the Intellectual Property Group at Ropes & Gray LLP.

Courts

- United States District Court for the Eastern District of New York
- United States District Court for the Southern District of New York
- United States Court of Appeals for the Federal Circuit

Memberships & Affiliations

- Massachusetts State Bar
- New York State Bar

Other Distinctions

- New York Metro Rising Star (2018)
- New York Metro Rising Star (2017)
- New York Metro Rising Star (2016)
- New York Metro Rising Star (2015)

Representative Matters

- Represented IBM in patent litigation against Groupon resulting in an \$82.5 million jury verdict finding that all four e-commerce patents at issue were valid and willfully infringed. Successfully argued and defeated patent-eligibility challenges at hearing on the pleadings. Successfully argued claim construction at *Markman* hearing. Successfully argued and defeated Groupon's motion for summary judgment of non-infringement at summary judgment hearing. Examined IBM's technical expert witness and cross examined three Groupon witnesses, including Groupon's technical expert witness at trial.
- Represented IBM in patent litigation against Priceline, OpenTable, and Kayak concerning e-commerce patents. Overcame repeated challenges to IBM's patents in district court and before the patent office, and ultimately secured a favorable settlement shortly before trial.
- Represented LifeCell Corporation against TELA Bio, Inc. in a trade secret and unfair competition case involving surgical mesh products. Defended and deposed dozens of witnesses across the country before the case settled.
- Defended Cisco, ARRIS, Time Warner Cable, and several other entities in patent infringement actions involving 29 patents asserted by a non-practicing entity, Rockstar, created by Apple, Microsoft, Ericsson, Sony, and Blackberry. Managed team of attorneys from several law firms engaged in simultaneous district court actions and patent office proceedings.
- Represented GSK in a patent litigation against Genentech concerning

technology for manufacturing and purifying monoclonal antibody biologics. Defended and deposed several witnesses before the case settled.

- Defended IBM in a patent litigation brought by IP Venture concerning server load-balancing technologies. Deposed the inventors of the patents-in-suit and developed non-infringement and validity arguments that helped lead to a favorable settlement for IBM during summary judgment briefing.
- Defended Cisco in a patent infringement action involving encryption technology filed by VirnetX, a non-practicing entity. VirnetX asserted six patents against virtually all of Cisco's product line, including switches, routers, voice-over-IP phone systems, and VPN products. VirnetX had previously won jury trial verdicts of \$368 million against Apple, and \$108 million against Microsoft. Prepared witnesses and developed claim construction, non-infringement, and invalidity positions as part of the team that secured a jury verdict rejecting VirnetX's \$258 million damages claim against Cisco.
- Represented Realtime Data in a patent litigation case against a variety of network device manufacturers in a patent litigation involving compression technologies before the case settled on the eve of trial.

Publications

- Speaker at the Berkeley School of Law - Modern Jury Trials: Persuasive Techniques for Complex Technology Cases (2018).
- ["Desmarais LLP Secures \\$82.5M Patent Win for IBM Over Groupon at Trial"](#)
- Panelist at the District of Delaware - Bench & Bar Conference - Young Attorney Focus: Advancing Your Career and the Value of Mentors (2018).
- ["Desmarais LLP Finalizes Favorable Settlement for IBM to End Lawsuit Against Priceline"](#)
- Speaker at the Berkeley School of Law - Patent Jury Trials and How to Win Them (2017).
- Sasha Rao & Karim Oussayef, Structurally Similar, But Effectively Different?, *Pharma Magazine* November/December 2010, at 68.
- Karim Oussayef, Selective Privacy: Facilitating Market-Based Solutions to Data Breaches by Standardizing Internet Privacy Policies, 14 *B.U. J. Sci. & Tech. L.* 104 (2008).