



Jerome R. SMITH

Foreign Attorney / US Patent Agent /
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Patent Preparation and Prosecution, US and globally, for high technology including Computer technologies such as Cybersecurity, AdTech, Fintech, Augmented and Virtual Reality, Artificial Intelligence (AI), Telecommunications, Semiconductors, Gaming, Internet of Things (IoT), Robotics, Medical Devices, Food, and Chemistry/Biology, litigation support, agreements, patent portfolio creation, strategy and management, for clients ranging from start-ups to multinational corporations (NVIDIA, Marvell, Johnson & Johnson Surgical, Unity (IronSource), Checkpoint Software Systems), and Global Patent Portfolio creation, management and strategizing

Expert on US Patent and Trademark Office and Examination Practice, for patent prosecution, appeals, reexaminations and post grant proceedings

- Legal consultant in a US Patent Litigation in US Federal District Court, which resulted in the client being awarded a 12-million-dollar jury verdict (2022) for patent infringement (2017~Present)
- Claims drafted and prosecuted for the patent in suit were upheld for the patentee by a US Federal District Court in a Markman Hearing on all six challenged points of law
- Successfully prosecuted a key corporate patent through Supplemental Examination and Reexamination (declared by the US Patent Office resulting from the Supplemental Examination) - All existing claims were unchanged and additional dependent claims were added
- Succeeded in an Oral Proceeding in the European Patent Office (Munich) before a three examiner panel, and obtaining a 3-0 decision to grant the client's patent
- Drafted the patent portfolio for an Israeli startup which exited to Samsung
- Drafted and managed Adknowledge's patent portfolio from patents 1 through 46, which were the major assets in a 100 Million Dollar plus investment round
- Led prior art searching for a joint defense team and uncovered knock-out (invalidating) prior art resulting in an extremely favorable settlement for Adknowledge brought by a non-practicing entity (NPE)
- Handled numerous Due Diligences for Patent Portfolios for Acquisitions, Investments, Sales and Exits

- Evaluator of US Patents from Israeli Patentees to determine whether patents are suitable for US Litigation, for two US Patent Litigation Firms (2016~2023)
- Assisted numerous Israeli patentees to obtain funding for US Patent monetization

Practice Area

- Internet
- Software
- Computers
- Cyber-Security
- Artificial Intelligence (AI)
- Augmented/Virtual Reality
- Robotics
- Medical Devices

Experience

- Lee International IP & Law (2023~Present)
- Senior Counsel, Kligler & Associates, Tel Aviv (2021~2023)
- Dr. Mark Friedman Ltd., Tel Aviv (2013~2020, Partner 2014~2020)
- Chief IP Counsel, Adknowledge, Inc., Kansas City (2011~2012)
- Elman Technology Law, PC (2010)
- Lathrop & Gage, Kansas City (2005~2009)
- Private Practice in USA, AmLaw 250 Firms and Major Boutique IP Firms (1990~2005)
- Former US Patent Examiner – Surgery and Medical Devices

Education

- Thomas Jefferson University (Completed the coursework for M.S. in Microbiology, 2011)
- The University of San Francisco School of Law (J.D., 1990)
- Northwestern University (B.S., Materials Science and Engineering, 1985)

Qualifications

- Admitted to the bar, Kansas (2009); Minnesota (1992); Illinois (1990)
- Registered to practice before the US Patent and Trademark Office (1992)

Membership

- AIPLA (American Intellectual Property Law Association)
- AIPPI (Association of Israel Intellectual Property Attorneys)

Publications / Presentations

< Publications >

- Author, Hidden Gems: US Intellectual Property (IP) Protection For Jewelry, Gold News (Turkey), pages 162-165 (July 2015)
- Co-author, In *Bilski v. Kappos*, the Supreme Court Hits the Reset Button, Then Tosses the Baton back to the CAFC, Elman Technology Law Briefing (June 30, 2010)
- Co-author, Going Into the Lab, Take *Ariad v. Eli Lilly* With You, Elman Technology Law Briefing (June 23, 2010)
- Author, Eyeing Foreign Filing Licenses, Export Regulations, IP Law 360 (December 8, 2008)
- Author, Patent Claims: Judicial Interpretation And Analysis, Chapter 5, pages 103-119, The Icfai University Press, First Edition (2008)
- Author, A Patent Drafter's Sweet 16 On The Road To A Champion Patent, Atlanta IP Law (May 2007)
- Author, Exploit the Down Market: Bring Up Your Patent Portfolio, Blue Tech Magazine; Summer (2001)
- Co-author, Pursuing the Bandits With Infringement Claims: Damages for Patent and Copyright Infringement, Minnesota Institute of Legal Education (1992)
- Co-author, Protecting and Profiting From Your Ideas: An Overview of Patents, Trademarks and Copyrights, Minnesota Institute of Legal Education (1992)

< Presentations >

- Seminar Instructor, Patent Application Amendment Practice and Claim Drafting-Presented at Numerous locations in Israel (2000, 2006, 2008, 2013-2023)
- US Computer Related Patent Examination and Practice – Presented at Ukraine Industrial Property Office, Kyiv (2019, 2020)
- Starting Your Start Up With Patents, Numerous Locations Throughout Israel, Poland, Malta, and Italy (2014~Present)
- Biotechnology Patents, Jenkins Law Library, Philadelphia, PA (October 6, 2010)
- Top 10 Federal Circuit Decisions (*Bilski* and *Egyptian Goddess*), Kansas City Metropolitan Bar Association (April 2009)
- New Guidelines For Patent Drafting And Prosecution In View Of *KSR*, Kansas City Metropolitan Bar Association (September 2007)
- Working With Your Patent Drafter, Kansas City Metropolitan Bar Association (September 2006)
- Drafting Patent Applications In View of *Festo*, Dan Hotel, Tel Aviv, Israel (April 2006)
- An Israeli Perspective on Intellectual Property Law, Kansas City Metropolitan Bar Association (May 2005)

- Speaker and Author, International Patent Protection, Institute of Continuing Legal Education in Georgia, 13th Annual Caribbean Seminar, Cabo San Lucas, Mexico (February 2003)
- International Patent Protection Strategies, Right From The Start, ABA Young Lawyers Division, Midyear Meeting, Philadelphia, PA (February 2002)

Awards & Recognition

- Missouri & Kansas Super Lawyers for Intellectual Property (2005)

Etc

- Languages : English, German

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