



## John B. Pegram

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## Overview

John B. Pegram concentrates his practice on intellectual property litigation, licensing, opinion, and counseling matters of all types in a wide range of technologies.

John has successfully litigated cases in state and U.S. District Courts and before the U.S. International Trade Commission. He also is registered to practice in patent matters before the U.S. Patent and Trademark Office. He has served as an advocate, arbitrator, or mediator in IP and business arbitrations and mediations, and as an expert witness on patent procedures.

Representative technical subject matter that John has handled include antibiotics, automobile components and systems, bar code reading and processing, batteries, cameras and lens systems, cathode ray tubes, centrifuges, coin and material testing, computer disk drives and controllers, computer logic, data compression, diagnostic kits, DNA polymerases, electronic displays and display systems, EMI shielding, enzyme production methods, fabric and fiber technologies, fermentation methods and systems, fiber optics, filtration systems, footwear, impact printers, inkjet printers, lighting devices, magnetic and optical recording, medical implants and instruments, microprocessor control systems, optical disc technology, orthopedic devices, packaging, photoconductive printers, photocopiers, pollution control systems, PTFE products, pumps, semiconductor devices and manufacturing, television broadcasting and receiving equipment, thyristors, and vending machines and systems.

John is a member of Fish & Richardson's Europe and Japan teams, helping U.S. clients with IP issues in those jurisdictions, and representing foreign clients in U.S. IP matters. For over 30 years, he has met regularly with officials of the European and Japanese patent offices and IP courts, as well as IP association leaders in those jurisdictions.

John is a frequent author and lecturer on patent, trademark, and federal court practice topics. He was a co-author of Fish's Patent Reform Updates, tracing the activity that led to the America Invents Act. Currently, he has written and periodically updates Fish's EU Unitary Patent & Unified Patent Court webpages and Fish's legal alerts on these subjects.

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## Experience

*Atari v. Commodore (joystick for computer games)* –Lead counsel for Commodore in defending against claims by Atari that Commodore's joystick design infringed various design patent, utility patent and trade dress rights of Atari. Case settled.

*Avrea v. Chrysler Corp. (automobile coolant recovery system)* –Lead counsel for Chrysler and its supplier, Mitsubishi Motors, in a patent infringement litigation. Avrea claimed that his patent covered the coolant recovery systems used in Mitsubishi automobiles sold by Chrysler in the United States. Case settled.

*Ballantine Laboratories Inc. v. LaFrance Precision Casting Co. (electronic instrument case design)* –Lead counsel in litigation by

Ballantine against a supplier who copied Ballantine's patented design for an electronics test instrument case. Case settled.

*Bourne v. Sankyo Seki Co., (musical copyrights)* – Lead defense of several foreign companies against charges that their music box movements, imported by others, infringed musical copyrights. Settled through mediation, by creating a new licensing program.

*Deering Milliken Co. v. Courtaulds North America, Inc. (fiber dyeing apparatus)* – Defended Courtaulds in a patent infringement litigation relating to apparatus used for dyeing fibers. Case settled.

*Drori v. Kenwood Corp. (automobile alarms)* – Lead counsel for Kenwood in defending against a patent infringement claim involving alarm systems for automobiles. Case settled during discovery.

*Fontijn v. Okamoto (complex extruded fiber)* – Successfully represented Akzona (Fontijn) in a patent interference and appeal. In one of the first cases of its type, the court granted priority to Akzona on the basis of a reissue application which was filed to obtain the priority of an earlier application.

*General Electric Co. v. ASEA (power semiconductor devices)* – Represented GE in patent infringement litigation against ASEA for infringement of GE patents on SCR semiconductor devices used in direct current power transmission systems. Case settled.

*General Electric Co. v. ECC Corporation, and General Electric Co. v. Hutson Industries, Inc. (semiconductor switching devices)* – Asserted GE patents relating to Triac-type semiconductor devices and Triac circuits used in electric light dimmers. Cases settled.

*Goodman v. PhilcoFord Corp. (cathode ray tube)* – Represented Philco successfully in a civil action by Goodman for review of a U.S. Patent Office patent interference decision awarding priority of invention to the Philco inventor.

*Highland Industries v. Toyobo Co., Ltd. (air bag fabric manufacturing)* – Led the defense of Toyobo in this patent dispute. After discussions between counsel, Highland voluntarily dismissed its complaint.

*Howes v. Mars, Inc. (promotional devices and methods)* – Lead counsel for Mars against claims that promotions of Mars' M&Ms and Kudos products each infringed a Howes patent. Case settled during discovery.

*Kaneka Corporation v. Mitsubishi Gas Chemical (MGC) (Coenzyme Q10 manufacturing)* – Led the Fish team defending MGC in a U.S. International Trade Commission (ITC) investigation and a parallel district court action. The ITC found that the MGC process did not infringe Kaneka's patent and that decision was not appealed. MGC settled the district court action on favorable terms while other defendants continued to litigate with Kaneka.

*Liu v. Kawase (compound semiconductor manufacturing)* – Lead counsel for Kawase (Sumitomo Electric Industrial Co., Ltd.) in a patent interference and related infringement dispute with American Xtal Corp. Successfully settled.

*Loral Fairchild Corp. v. Victor Co. of Japan et al. (charge coupled devices)* – Successfully defended one of the lead manufacturing defendants, Sanyo Electric Co., Ltd. and its U.S. subsidiaries, as their lead counsel. Loral Fairchild had asserted multimillion dollar claims for infringement of two patents on charge coupled devices, used in camcorders and facsimile machines against Sanyo, and other Japanese and Korean owned companies. Sanyo defendants obtained a dismissal of all claims against them.

*Mars, Inc. v. Coin Acceptors, Inc. (coin recognition and vending machine electronics)* – Lead counsel for Mars in a multi-patent, non-jury case. The district court's literal infringement and damages decisions were affirmed in separate appeals, and Mars collected over 27 million dollars damages and interest.

*Mars, Inc. v. Conlux U.S.A. Corp. (electronic coin recognition)* – Lead counsel for Mars in obtaining a jury infringement and damages verdict of 40% of Conlux's sales. Conlux was enjoined from further infringement of Mars' patent on comparing coin test data with values stored in a nonvolatile memory.

*Memtech LLC v. Kionix, Inc. (micromechanical accelerometers)* – Co-leader of Kionix's defense in a multidefendant, EDTX patent infringement case. Kionix settled on favorable terms at an early stage.

*Multimatic, Inc. v. Riken Kaki Co., Ltd. (auto components)*– Lead counsel for Riken in a pending litigation involving components for Honda automobiles. Case settled following discovery and claim interpretation by a Special Master.

*Nassau Tape Webbing Mills, Inc. v. Advance Thread (mattress edging tape)* –Lead counsel defending Advance Thread against Nassau's patent purporting to cover fire resistant tape used on most mattresses. Case settled favorably on the first day of trial.

*Pactiv LLC v. Mitsubishi Gas Chemical (MGC) (oxygen absorbers and food packaging)*– Co-leader of MGC's defense in a five patent litigation. MGC obtained a dismissal without prejudice while an unrelated defendant continued to litigate in the courts and obtained reexamination in the USPTO.

*Parker-Hannifin v. Zippertubing (Japan)*– (fire retardant gaskets to prevent electromagnetic interference) – Lead counsel for Zippertubing in a four patent case. After a favorable claim construction by the court, Zippertubing obtained a very satisfactory settlement.

*Quantum Corp. v. Tandon Corp. (disk drives)*– Lead counsel defending Tandon against Quantum's claims for infringement of two patents relating to signal processing and tracking in personal computer hard disk drives. This case involved complex issues of discovery and privilege, resulting in a leading Federal Circuit opinion on discovery relating to charges of willful infringement. Case settled following discovery.

*Stratagene v. Takara Holdings, Inc. (DNA polymerases)*– Lead counsel for Takara Bio in a civil action and a related patent interference involving inventorship, ownership, infringement, and validity issues. Settled by cross-licenses.

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## Recognitions & awards

Best Lawyers in America

*Best Lawyers* 1995-2024

AV Preeminent Lawyer

*Martindale-Hubbell* 2013-2022

Lifetime Achievement Award

*New York Intellectual Property Law Association* 2019

IP Star

*Managing IP* 2016-2018

President's Outstanding Service Award

*American Intellectual Property Law Association (AIPLA)* 2011

Guides to the World's Leading Patent & Trade Mark Law Experts

*Euromoney*

Listed

*Who's Who in America*

Listed

*Who's Who in American Law*

Listed

*Who's Who in the East*

Listed

*Who's Who Legal*

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## Professional associations

American Bar Association, Antitrust Law Section (past chair of the Patent, Trademark and Know-How Committee and past member of the Federal Litigation Committee) and Intellectual Property Law Section (past chair of several committees and past division chair).

American Intellectual Property Law Association (AIPLA) – past member of the Board of Directors; past chair of many committees, including International and Patent Litigation; current active member of the IP Practice in Europe and IP Practice in Japan Committees.

Intellectual Property Owners (IPO) – current active member of the European Practice Committee.

International Association for the Protection of Intellectual Property (AIPPI) – current member of the Committee on the Unified Patent Court.

New York Intellectual Property Law Association (NYIPLA) – past President, Secretary and member of the Board of Directors.

US Bar – EPO Liaison Council – past Chair and past Delegate of AIPLA, current member as a past Chair.

US Bar – JPO Liaison Council – current Delegate of NYIPLA

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## Insights

Blog | November 1, 2023

Legal Alert: EPO Enlarged Board of Appeal Raises Bar for Challenging Priority Claims at the EPO

Article | June 28, 2023

How to Minimise Preliminary Injunction Risk in the UPC

Blog | May 15, 2023

Legal Alert: Minimizing Patent TRO and PI Risk in Europe

Webinar | February 28, 2023

A Deeper Dive Into the EU Unified Patent Court

Webinar | February 21, 2023

Introducing the EU Unified Patent Court and Unitary Patent

Blog | February 17, 2023

Legal Alert: Germany Ratifies UPC Agreement; UP & UPC to Begin 1 June

Blog | December 6, 2022

Registration as a Unitary Patent

Blog | December 6, 2022

Start of Unified Patent Court Sunrise Period Postponed to 1 March 2023

Blog | December 6, 2022

UP & UPC Chronology

Blog | October 11, 2022

Legal Alert: Unitary Patent and UPC Start Date Target Is Now 1 April 2023

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## News

News | August 15, 2024

101 Fish Attorneys Included in the 2025 Edition of *The Best Lawyers in America*

News | August 17, 2023

101 Fish Attorneys Included in the 2024 Edition of *The Best Lawyers in America*

News | August 22, 2022

96 Fish Attorneys Included in the 2023 Edition of *The Best Lawyers in America*

News | August 19, 2021

Fish Attorneys Recognized in 2022 Edition of *The Best Lawyers in America*

News | May 15, 2019

Fish & Richardson's John B. Pegram Receives Lifetime Achievement Award from New York IPLA

News | August 15, 2018

47 Fish Attorneys Named to The Best Lawyers in America 2019 List

Media Coverage | May 29, 2018

Mixed Fortunes for the Appeals Boards

*World Intellectual Property Review*

News | May 21, 2018

Fish & Richardson Announces 39 Attorneys Named "IP Stars" by *Managing Intellectual Property* Magazine

News | June 23, 2017

Fish & Richardson Announces 36 Attorneys Named "IP Stars" by *Managing Intellectual Property* Magazine

Media Coverage | March 30, 2017

UK Has Uncertain Post-Brexit Role In Unified Patent Court

*Law360*

Media Coverage | January 24, 2017

Trump Removes US From TPP Deal

*World Intellectual Property Review*

Media Coverage | July 15, 2016

Brexit imperils European Unified Patent Court - Experts

*Reuters Legal*

Media Coverage | June 23, 2016

IP and 'Brexit': Too Much Uncertainty and the Devil You Know

*World Intellectual Property Review*

News | September 9, 2014

IPO Honors Winners of Committee of the Year Award

Media Coverage | August 14, 2014

From the U.S., Progress Towards Creating Europe's New Unified Patent System is Looking Good

*IAM Magazine*

News | September 5, 2012

Thirty Fish & Richardson Attorneys Selected for the 2013 Best Lawyers in America®

News | October 21, 2011

Fish & Richardson Senior Principal John B. Pegram Receives 2011 Outstanding Service Award from AIPLA

News | May 7, 2009

Coinco Pays Mars Over \$27 Million in 20-Year Old Patent Dispute

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## Events

April 4, 2024

31st Annual Fordham Intellectual Property Law & Policy Conference

April 13, 2023

30th Annual Fordham Intellectual Property Law & Policy Conference

December 7, 2022

American Intellectual Property Law Association (AIPLA) CPM Webinar | The EU Unified Patent Court is Opening: To Be In or To Opt-Out?

April 26, 2022

New York Intellectual Property Law Association (NYIPLA) Webinar | What You Need to Know About the EU Unitary Patent and Unified Patent Court

April 22, 2022  
29th Annual Fordham Intellectual Property Law & Policy Conference

February 3, 2022  
AIPLA Mid-Winter Institute 2022

April 8, 2021  
28th Annual Fordham IP Conference

June 3, 2019  
AIPLA Seminar with Chartered Institute of Patent Attorneys (CIPA)

May 14, 2019  
New York Intellectual Property Law Association (NYIPLA) Annual Meeting

April 25, 2019  
2019 Fordham IP Conference

May 3, 2018  
Intellectual Property Owners Association's European Practice Committee Conference

November 14, 2017  
IPO Education Foundation EPO Day

June 12, 2017  
John Pegram to Speak at AIPLA IP Practice in Europe Committee Meetings

May 18, 2017  
John Pegram to Speak at IPO's European Practice Committee Conference

April 20, 2017  
25th Annual Fordham Intellectual Property Law & Policy Conference

January 27, 2017  
JETRO: An Overview of US and World IP Developments in 2016-2017

November 25, 2016  
Strategies to Win IP Litigation in the U.S. (JIPA)

October 25, 2016  
AIPLA IP Practice in Japan Pre-Meeting

October 24, 2016  
16th Annual Sedona Conference on Patent Litigation

May 7, 2014  
Intellectual Property Owners Association (IPO) "The New Reality in Patent Invalidation Procedures: Developments in Post-Grant Review"

April 24, 2014  
Fordham IP Conference

October 25, 2013  
USA: Courts with patent rules v. a true patent court

October 23, 2013  
Giles Rich and Pauline Newman Inns of Court Meeting

May 27, 2013  
A Harmonized Patent World - Are We Getting There?

May 21, 2013  
Comparing Patent Enforcement Across Multiple Foreign Jurisdictions

April 8, 2013  
AIPLA - IP Practice in Japan committee meeting

April 4, 2013  
21st Annual Fordham Intellectual Property Law and Policy Conference

March 11, 2013  
Interplay Between Litigation and the AIA

February 8, 2013  
U.S. Patent Law Developments 2009

January 10, 2013

WEBINAR: European Unitary Patent: An Update

November 12, 2012

Recent Developments in U.S. Patent Law 2012

August 23, 2012

Osaka Seminars

October 24, 2011

U.S. Patent Law Developments 2011

April 28, 2011

Fordham International IP Conference

April 7, 2011

Tokyo (AIPPI) Seminar 2009

April 7, 2011

American Bar Association, 26th Annual Intellectual Property Law Conference

March 9, 2011

US and European Patent Law Conference 2008

February 16, 2011

Boston Breakfast Series: Patent Law Reform-What may happen in 2011

November 9, 2010

U.S. Patent Law Developments 2010

November 9, 2010

U.S. Patent Law Developments

October 19, 2010

AIPLA Annual Meeting, Japan Practice Committee Meeting

April 20, 2010

Open Seminar of the Japan Patent Attorneys Association

April 19, 2010

AIPLA IP Practice in Japan Committee, Delegation Trip 2010

April 8, 2010

Fordham IP Conference

May 19, 2009

Patent Litigation in the United States: What Japanese Companies Need to Know to Protect their Most Important Assets

April 20, 2009

AIPLA IP Practice in Japan Committee, Delegation Trip 2009

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## Additional insights

### Publications

- [“What Brexit Means for Non-EU IP Owners,”](#) *Managing Intellectual Property*(March 2019)
- [“Service of Process on Foreign Defendants,”](#) *Fish Litigation Blog*(January 2017)
- [“Greener pastures for US patents,”](#) *World Intellectual Property Review*(November 2016)
- [“Update on EU Unitary Patent and Unified Patent Court Developments,”](#) *Fish & Richardson Patent Blog, January 2016.*
- [“From the US, progress towards creating Europe’s new unified patent system is looking good,”](#) *IAM Blog* (August 2014)
- [“Limiting Choice of Venue in Patent Litigation,”](#) *IP Law360*(July 2014)
- [“The future of attorneys’ fee awards in patent cases,”](#) *Fish Litigation Blog & AIPLA Newsstand (Lexology)*(July 2014)
- [“An equivalent to amendments during IPR proceedings,”](#) *Fish Litigation Blog & AIPLA Newsstand (Lexology)*(May 2014)
- [“The question of specificity in patent pleadings heats up,”](#) *Fish Litigation Blog & AIPLA Newsstand (Lexology)*(March 2014)

## Speaking engagements

- “[What You Need to Know About the EU Unitary Patent and Unified Patent Court](#),” *New York Intellectual Property Law Association (NYIPLA) Webinar* (April 26, 2022) (with Moritz Ammelberg & Herbert Kunz)
- “PTAB” session moderator, *29th Annual Fordham Intellectual Property Law & Policy Conference* (April 22, 2022)
- “Deep Dive: Everything You Need to Know about the Unified Patent Court in Europe,” *AIPLA Mid-Winter Meeting* (February 3, 2022)
- “Unified Patent Court and Unitary Patent in the European Union,” organizer and moderator, *AIPLA Mid-Winter Meeting*, January 2022.
- “Let’s Seek a Better § 101—Patent Eligibility in the United States,” *Fordham IP Law Conference*, April 2021.
- “EU Unified Patent Court & Unitary Patent,” *CIPA-IPO Webinar — Brexit and the UPC*, July 16, 2020
- “Current PTAB Practice in the United States,” *AIPLA IP Practice in Japan Committee meeting with Japan Trademark Association*, June 2019.
- “Update on U.S. IP Policy under Director Iancu,” *AIPLA IP Practice in Japan Committee meeting*, June 2019.
- “Claim Amendments in the United States & Europe—Why Amendments Are Rarely Permitted in U.S. PTAB Proceedings,” September 2018 (with John Conroy).
- “Current Legislative and Juridical Trends in the U.S.,” *Intellectual Property Owners European Seminar*, Amsterdam, May 2018
- “Inter Partes Review Survival Rates Based on Decision Statistics—A Preliminary Report,” and panelist on PTAB panel, *Fordham IP Conference*, April 2018.
- “European Patent Developments,” moderator, *Fordham IP Conference*, April 2018.
- “Clarity Workshop,” moderator & co-author of materials, *Intellectual Property Owners Education Foundation—EPO Day*, November 2017
- “Overview of IP Developments in 2016-2017 in the United States and the World,” *Japan External Trade Organization Seminar*, New York January 2017 (with John Johnson)
- “Patent Litigation in the United States,” *Japan Intellectual Property Association Seminar*, Tokyo, November 2016.
- “The EU Unified Patent Court—Background, Structure and Procedures” (paper) and “Unified Patent Court Procedure” (presentation), *The Sedona Conference, Patent Litigation Conference*, Washington, DC, October 2016.
- “U.S. Supreme Court Patent Decisions,” *S. Bar-EPO Liaison Council*, New York, September 2016.
- “Brexit and Intellectual Property Issues” and moderator, *Intellectual Property Organization Annual Meeting*, New York, September 2016.
- “Update on PTAB Litigation,” *AIPLA Committee meeting with foreign patent organization in Japan*, June 2016.
- “Issue Preclusion and Estoppel: Trademark and Patent Perspectives” and “The U.S. Supreme Court’s B&B Decision,” *AIPLA Japan Committee & the Japan Trademark Association*, Japan, October 2015 (with George Lewis).
- “The New Reality in Patent Invalidation Procedures – Developments in Post-Grant Review,” *Intellectual Property Owners European Seminar*, Brussels, May 2014.
- “Comparison of the New Inter Partes Review at the USPTO and Oppositions at the EPO,” panelist *Fordham IP Conference*, April 2014
- “Evolving Standards for Disclosing and Claiming Inventions or What Can a Patentee Claim and What Does a Claim Mean?” (paper & presentation), *Fordham IP Conference*, April 2014.
- “Update on Inter Partes Disputes and the PTAB,” *AIPLA Japan Committee seminar for Japan Patent Attorney Association*, Tokyo & Osaka, April 2014.
- “Mock Program—PTAB Inter Partes Proceeding Including a Hearing,” author & participant, *AIPLA Japan Committee seminar for Japan Patent Attorney Association*, Tokyo & Osaka, April 2014. .
- “Current trends/effects of AIA on US patent practice,” *AIPLA Europe Committee meeting with Compagnie Nationale Conseils Propriété Industrielle*, Paris, March 2014 (with another speaker).
- “Counseling Clients re New USPTO Post Grant Proceedings and Interplay with Litigation,” *AIPLA Europe Committee meetings*



with *Chartered Inst. of Patent Attorneys*, London, *German Patent Attorneys Ass'n*, Munich, and *European Patent Institute*, Munich, March 2014.

- “Unitary Patent and Unified Patent Court,” *Japan Patent Attorney Association seminars*, Osaka and Tokyo, Japan, November 2013, (with Dr. Margot Fröhlinger (EPO) and Jan-Malte Schley)
  - “Patent Courts – The US System: What Can Be Done to Address Litigation Inefficiencies?” *AIPPLA Annual Meeting*, October 2013,
  - “EU Unified Patent Court,” Joint meeting of the Giles Rich and Pauline Newman Inns of Court, Washington, DC, October 2013,
  - “Report on US law – Written description requirements,” *US Bar – EPO Liaison Council*, Munich, Germany, October 2013,
  - “Global Harmonization in Patent Law,” *IPO European Practice Committee Conference*, Brussels, Belgium, May 2013,
  - “Comparing Patent Enforcement Across Multiple Foreign Jurisdictions,” *NYIPLA Annual Meeting workshop*, May 2013,
  - “Recent Developments in U.S. Patent Law” and “Administrative & Substantive Patent Office Harmonization,” *Fordham International IP Conference*, New York, New York, April 2013,
  - “Interplay between Litigation and the AIA,” *AIPPLA Europe Committee* meetings with the Chartered Institute of Patent Attorneys (London), IP Lawyers Association (London), and the European Patent Institute (Munich), March 2013,
  - “European Unitary Patent and Unified Patent Court,” *West LegalEdcenter Webinar*, February 2013,
  - “European Unitary Patent: An Update,” *IPO Chat Channel Webinar*, January 2013, (with Dr. Margot Fröhlinger (EPO) and Paul Coletti)
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## Services

Litigation

Patent Litigation

Post-Grant

*Inter Partes* Review

Patent

Strategic Patent Counseling & Opinions

Unitary Patent & Unified Patent Court

## Industries

Electrical & Computer Technology

Hardware

Semiconductors

Optics

Life Sciences

Biotech & Diagnostics

Medical Devices

## Admissions

U.S. Patent and Trademark Office (1969)

New York (1965)

Supreme Court of the United States

U.S. Court of Appeals for the Federal Circuit

## Education

LL.B., New York University School of Law (1965)

B.A., Physics, Columbia University (1960)

