

Robert O. Groover III

Registered Patent Attorney

Admitted: U.S. Supreme Court; Texas; Federal Circuit; D.C. Circuit;
Fifth Circuit; Northern, Eastern, Southern, and Western Districts of Texas.

Professional Experience

Private Practice Dallas TX 1992 to date: Patent and trade secret matters, including applications, prosecution, reexams, licensing, litigation, appeals, and opinions in a very wide range of technologies.

Worsham Forsythe Dallas TX 1988-1992: Started patent department and became partner in established general firm (since merged into Hunton & Williams). Wide range of patent and trade secret matters.

Saidman Sterne Washington DC 1987-1988: Patent application and prosecution work in numerous technologies (mostly electronics and software).

Texas Instruments Dallas TX 1981-1987: Managed patent acquisition for Corporate Research. Wrote hundreds of original applications; prosecuted many more in US and overseas. Supervised in-house and outside counsel.

Education

B.A. Yale College. Started in accelerated math/physics program graduated with double major (and graduate coursework) in Greek and Latin.

J.D. University of Texas Law School: Best Brief prize; Board of Advocates; Texas International Law Journal; published one law review article.

The University of Texas Business School. 24 graduate hours of finance and accounting **in addition to** law school coursework during 1977-1979.

U.T. Dallas: 6 hours graduate coursework toward MSEE.

Representative Engagements

Google Inc. v. Grandeye Ltd., IPR2013-00546, IPR2013-00547, and IPR2013-00548: Lead counsel for Inter Partes Review proceedings.

US 2008-0315112: Winning Pre-Appeal Nov.2012.

Tewari De-Ox Systems v. Mountain States/Rosen 637 F.3d 604 (5th Cir. 2011)
Briefed and argued successful appeal in widely discussed trade secret case.

Ideal Power, Inc. – patent matters from 2007 on. The client had 18 issued patents

by the time of its IPO in 2013 (NASDAQ:IPWR).

Grandeye Ltd. v. Immervision (W.D.Tx. 1:2011-cv-00251) (co-counsel)

Grandeye Ltd. v. Sentry 360 Security (N.D.Ill. 1:2011-cv-02188) (co-counsel)

Third-party-initiated reexamination **90/010783** – after in-person interview, all claims were confirmed patentable without amendment.

Inter partes reexamination **95/001161** - analyzed adverse filing; assembled information and experts, and filed response and evidence and additional claims under great time pressure; got prompt allowance of numerous claims.

Uniloc v. BCL Technologies et al. (E.D.Tx. 6:2010-cv-00018) – achieved rapid settlement for patent co-defendant QuadriSpace Corporation.

Liu v. Jackson (N.D.Tx. 4:2009-cv-00415) appealed sub nom. **Liu v. Moorman** (5th Cir. 2010 10-10202) (Pro bono – racial discrimination plaintiff). We lost the appeal, but saved the plaintiff's professional career meanwhile.

Tewari De-Ox Systems v. Mountain States Rosen (W.D.Tx. 5:2008-cv-00190) – Worked with expert inventor and technological publications to clarify trade secret definitions and reorient pleadings.

Ex Parte Baldwin (Board of Patent Appeals and Interferences 2005-1995 decided 2006) – briefed and argued appeal. All rejections reversed. Issued 7,215,344.

Ex Parte Kent (Board of Patent Appeals and Interferences 2006-1687 decided 2006) – briefed and argued appeal. All rejections reversed; issued 7,187,383.

IPIX v. Grandeye Ltd. (E.D.Va. 2:2005-cv-00134)(patents) – Opinion work; rpatent analysis; licensing negotiations.

Phase Dynamics v. Kvaerner Process Systems (contracts) (Dallas 2005) – Helped hire and manage litigation counsel; worked on damage model; helped with technology issues.

Grandeye Ltd. v. IPIX (N.D. Cal. 5:2004-cv-05081) (unfair competition) – complaint included non-patent causes to invoke 9th Circuit rather than CAFC appellate jurisdiction.

Paulssen Geophysical Services Inc. v. Input/Output (Ft. Bend county 2004) – worked on trade secret definitions.

Ex Parte Gontowski (Board of Patent Appeals and Interferences 2002) – appeal decided on briefs. Rejections reversed. Issued 6,504,328.

Halliburton Energy Services v. Smith International (E.D.Tx. 4:2002-cv-00269) (co-counsel for patentee).

Adverse to Texas Commission on Environmental Quality (2001) – dissected and refuted agency's technical evidence resulting in abandonment of enforcement

action.

- Ex Parte Crandall** (Board of Patent Appeals and Interferences 2001) – appeal decided on briefs. Rejections reversed issued as 6,413,165.
- Ex Parte Padoan** (Board of Patent Appeals and Interferences 2001) – briefed and argued appeal. Rejections reversed issued as 6,392,469.
- Ex Parte Baldi** (Board of Patent Appeals and Interferences 2001) – appeal decided on briefs. Rejections reversed issued as 6,350,676.
- Ex Parte Murphy** (Board of Patent Appeals and Interferences 2001) – briefed and argued appeal. Rejections reversed issued as 6,348,919.
- Ex Parte Ricotti** (Board of Patent Appeals and Interferences 2001) – appeal decided on briefs. Rejections reversed issued as 6,307,426.
- Ex Parte Cini** (Board of Patent Appeals and Interferences 2000) – appeal decided on briefs. Rejections reversed issued as 6,222,414.
- Ex Parte Le Van Suu** (Board of Patent Appeals and Interferences 2000) – appeal decided on briefs. Rejections reversed issued as 6,212,658.
- Ex Parte Pignon** (Board of Patent Appeals and Interferences 1999) – appeal decided on briefs. Rejections reversed issued as 6,158,016.
- Ex Parte Cameron** (Board of Patent Appeals and Interferences 1999) – appeal decided on briefs. Rejections reversed in part issued as 6,094,026.
- Ex Parte Ferrario** (Board of Patent Appeals and Interferences 1999) – appeal decided on briefs. Rejections reversed issued as 6,040,730.
- Ex Parte Poletto** (Board of Patent Appeals and Interferences 1999) – appeal decided on briefs. Rejections reversed issued as 6,037,826.
- Ex Parte Casati** (Board of Patent Appeals and Interferences 1999) – appeal decided on briefs. Rejections reversed issued as 6,002,173.
- Ex Parte Bond** (Board of Patent Appeals and Interferences 1999) – appeal decided on briefs. Rejections reversed issued as 5,991,156.
- Ex Parte Wei** (Board of Patent Appeals and Interferences 1998) – appeal decided on briefs. Rejections reversed issued as 5,894,158.
- Ex Parte Monti** (Board of Patent Appeals and Interferences 1997) – appeal decided on briefs. Rejections reversed in part issued as 6,104,235.
- Ex Parte Gloton** (Board of Patent Appeals and Interferences 1997) – appeal decided on briefs. Rejections reversed issued as RE36,356.
- Evans & Sutherland v. 3Dlabs** (C.D.Ca. 2:1996-cv-00698) (patents) (co-counsel for alleged infringer).

Ex Parte Nicolai (Board of Patent Appeals and Interferences 1996) – briefed and argued appeal. Rejections reversed in part issued as 5,751,940.

Samsung Electronics v. Texas Instruments (N.D.Tx. 3:1996-cv-00001) and **Samsung Electronics v. Texas Instruments** (E.D.Tx. 2:1996-cv-00148) (co-counsel for patentee).

ST Microelectronics adverse to IBM (1995 patent licensing negotiations) – Formulated claim interpretation argument on very short notice.

Phase Dynamics v. Agar Systems (E.D.Tx. 4:1994-cv-00040-PNB) – Secondary counsel focusing on claim interpretation and noninfringement.

International Rectifier v. SGS-Thomson (C.D.Ca. 2:1992-cv-06779) (patents) (worked with expert witnesses and validity issues).

Texas Instruments v. Micron Semiconductor (E.D.Tx. 3:1992-cv-01803) (patents) (secondary counsel not of record).

SGS-Thomson v. International Rectifier (N.D.Tx. 4:1991-cv-00408) (patents) (worked with expert witnesses and claim charts).

SGS-Thompson Microelectronics v. Dallas Semiconductor (N.D.Tx. 3:1990-cv-00359) (patents) (co-counsel for Defendant).

Dallas Semiconductor adverse to IBM (1989 patent licensing negotiations) - Studied adverse patents; formulated questions to adversary; responded to correspondence until adversary lost interest.

Dallas Semiconductor adverse to Motorola (1988 patent licensing negotiations) - Studied adverse patents; scheduled and managed negotiations leading to favorable result.

Texas Utilities (TXU) – various patent and software licensing matters.

Professional Associations

AIPLA (American Intellectual Property Law Association)

Intellectual Property section of State Bar of Texas

Bar Association of the Fifth Federal Circuit

Federal Circuit Bar Association

SVIPLA (Silicon Valley Intellectual Property Law Association)

HIPLA (Houston Intellectual Property Law Association)

IEEE (Senior Member since 1988)

Sample Publications and Presentations

"Intellectual Property and IP Rights" - invited presentation to CIE, Plano TX, 2009.

"IP Management for Outsourced Design Work" - invited presentation at Wuxi International Industrial Design Expo, November 2008.

"Patent Systems and Growing Companies" - Nanjing Technical University, October 2008.

"Optimal Patent Management" - Shanghai Jiao Tong University, October 2008.

"Maximizing Value in Patent Prep and Pros" - invited presentation to Dallas Paralegal Institute January 2008.

Three presentations to ACP Plano Texas 2007 regarding patent and cash flow issues in startups.

"U.S. Patent Enforcement" - Shanghai IP Association, May 2006.

"Patenting Electronics Inventions" - presented to Hong Kong IP Law Society May 2006.

"Patent Communication Tools: For Showing Patent Processes and Decisions" - AIPLA Annual Meeting, 2005.

"US Prosecution for Maximum Value" - presented to Shanghai IP Law Society September 2005.

"Seeking Safe Harbor: Practical Approaches and Risks in IDS Practice" - AIPLA Annual Meeting, 2003.

"Managing Patent Quality" - IP and Technology Law Journal, May 2003.

"Maximizing Patent Productivity" - IP and Technology Law Journal, Dec. 2002.

"The Process of Building a Patent Application" - AIPLA Spring Meeting, Chicago, 2001.

"Patent Law Changes in the AIPA" - AIPLA Spring Meeting, Pittsburgh, 2000.

"The Patent Profession Practices with Provisionals" - presented at Compaq, 1999.

"Managing Patent Quality" - Offshore Technology Conference, May 1999.

"Learning from Unpredictable-Arts Practice" - AIPLA Spring Mtg, San Francisco 1999.

Coordinated panel on provisional application practice at AIPLA Spring Meeting 1999.

"Ways to Talk about Patent Quality" - IP Law section, Dallas Bar Association, March 1999.

"The Concept of Municipal Sovereignty in Supreme Court Jurisprudence" - 3 Urban Law J. 1 (1978). This article received very favorable comments from Profs. Owen Fiss and Charles Alan Wright.

Miscellaneous

Reading knowledge of French; German; and Italian.

Avocations: Parenting; Woodturning; Tennis; Genealogy.

Sample Issued Patents

Following are a few of the thousands of patents I have written and/or prosecuted:

Graphics/Image/Video Processing: 8427538; 8405732; 8264524; 8243135; 8238695; 8223157; 8212837; 8145007; 8145007; 8139896; 8131826; 8077176; 7990422; 7894531; 7893985; 7710425; 7616200; 7587520; 7529424; 7528881; 7518616; 7505036; 7466319; 7450165; 7366359; 7301540; 7227556; 7215344; 7154502; 7106323; 7061500; 7050061; 6977649; 6819332; 6798421; 6744438; 6731288; 6683615; 6677952; 6650333; 6587113; 6377266; 6366327; 6348919; 6366327; 6248991; 6025853.

Mechanical/Petroleum: 8453762; 7599803; 7544641; 7516793; 7499846; 7431094; 7431088; 7416565; 7380596; 7357197; 7350576; 7350574; 7325607; 7073611; 7044242; 6942045; 6883412; 6872958; 6845828;

6817425; 6802380; 6769500; 6752223; 6725947; 6722450; 6712160; 6695073; 6691802; 6681633; 6648082; 6634441; 6631772; 6630833; 6593753; 6568490; 6564884; 6536192; 6474424; 6469278; 6424595; 6412577; 6401839; 6390209; 6357540; 6302224; 6279671.

Power Electronics: 8531858; 8514601; 8471408; 8461718; 8451637; 8446745; 8446043; 8446042; 8406025; 8400800; 8395910; 8391033; 8345452; 8300426; 8295069; 7778045; 7599196; 7557394; 7368831; 6969970; 6538279; 6504328; 6331794; 6323609; 6259971; 6137268; 6040684; 6020722.

Telecom/DSP: 7805759; 7706276; 7551933; 7515597; 7471787; 7461155; 7155526; 6980605; 6944406; 6480559; 6980605; 6879648; 6226315.

Computers/Software/Internet: 8131826; 7793221; 7187383; 6934772; 6826715; 6826627; 6791559; 6647415; 6609204; 6502203; 6463495; 6363449; 6360326; 6359994; 6349385; 6330674; 6363449; 6360326; 6330674; 6349385; 6202070.

Optics etc.: 8384048; 8242457; 7780085; 7608830; 7504672; 7459730; 7450624; 7015336; 6963597; 6853666; 6760359; 6661825; 6647048; 6636547; 6600765; 6600765; 6285636.

Processors and Memory: 8144156; 7385608; 7317641; 6847370; 6788303; 6700581; 6628540; 6433787; 6201757.

Chemical Engineering: 7927875; 7775085; 7680617; 7660648; 7648836; 7636614; 7620481; 7606636; 7587290; 7574325; 7567856; 7561943; 7523647; 7457714; 7433762; 7415364; 7407625; 7392113; 7354768; 7334450; 7150184; 7143638.

Semiconductor Devices/Processes and Materials Science: 8575688; 8567658; 8564057; 8546893; 8546878; 8466025; 8420483; 8354711; 8344451; 8330214; 8330213; 8330186; 8319278; 8310007; 8310006; 8310001; 8304329; 8076719; 8203180; 8058682; 7989293; 7964913; 7960783; 7923804; 7911021; 7910439; methods;; 7843004; 7705397; methods;; 7704842; 7473966; 7411249; 6958515; 6350676; 6120842; 6069072; 6017818; 6236101; 6218732; 6137144; 6211034; 6130126.

Analog/RF/Sensors: 6867599; 6836189; 6392469; 6288663; 6222471; 6297990.

Designs and Other: D690,575; 6413165 (Intermittently Wetted Sliding Amusement Ride); 6359994 (Speaker system); 6304434 (Speaker system); 6026946 (Coin Discrimination).
