

## Melvin C. Garner

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### PARTNER

Melvin Garner is a partner in the Patent Practice and Litigation Practice Groups at Leason Ellis, where he heads the firm's Japan Practice Group. Mel works with individuals and companies in the US to obtain patents and to manage their patent portfolios. He provides opinions on patentability and patent infringement. Further, Mel represents clients in patent and trade secret litigations. Mel also helps Japanese and Chinese companies obtain patents in the US and defends them in US patent litigation. Mel's domestic and foreign clients operate in a wide range of industries including ultrasonic testing, lighting, medical devices, automotive, machine tool, chemical and university research. Mel is interested in learning about clients' problems and fashioning efficient solutions to those problems.

Mel has been an expert witness in over 20 cases. He is the author of numerous articles and is a frequent lecturer at the Practising Law Institute. Mel is a Past President of both the New York Intellectual Property Law Association and the American Intellectual Property Law Association. He is currently a member of the Executive Committee of the Hon. William C. Conner Inn of Court. He also serves on the Magistrate Judge Merit Selection Panel for the Southern District of New York. Mel received the AIPLA's 2024 Excellence Award and the NYIPLA's 2024 Lifetime Achievement Award. He is also listed in Euromoney's Guide to the World's Leading Patent Law Experts, Who's Who Legal – Patents, WIPR Leaders and New York Super Lawyers. Mel has a J.D. from Brooklyn Law School, where he was an editor of the Law Review. He received a B.S.E.E. from Drexel University and an M.S.E.E. from New York University.

### Selected Articles

- "Designing, Creating, and Managing an IP Portfolio," IP Issues in Business Transactions, Practising Law Institute, 2005- 2024
- "IPRs are a Constitutional Exercise of Congressional Authority," New York Intellectual Property Bulletin, 2017
- "Evaluating and Enriching Your Company's Invention Inventory," Inside Counsel, 2015
- "Checklist of Trade Secret Causes of Action and Defenses, Including Sample Pleading," Intellectual Property Counseling and Litigation, Ch. 58, 2009
- "Intellectual Property Protection of E-Commerce," Intellectual Property Counseling and Litigation, Ch. 13, 2009



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### Education

- Brooklyn Law School, J.D., 1973
- New York University, M.S.E.E., Electrical Engineering, 1967
- Drexel University, B.S.E.E., Electrical Engineering, 1964

### Bar Admissions

- New York
- Registered Patent Attorney: U.S. Patent and Trademark Office

### Court Admissions

- U.S. District Court for the Southern District of New York
- U.S. District Court for the Eastern District of New York
- U.S. Second Circuit Court of Appeals
- U.S. Federal Circuit Court of Appeals
- U.S. Supreme Court

### **Selected Articles (continued)**

- “Advanced Claim Drafting and Amendment Writing Workshop for Electronics and Computer-Related Subject Matter,” 11th Annual Patent Prosecution Workshop, Practising Law Institute, 2004
- “Inevitable Disclosure of Trade Secrets by the Departing Employee,” Selected Legal Papers, American Intellectual Property Law Association, 1995
- “Discovery and Related Motion Practice,” Anatomy of Patent Litigation, Practising Law Institute, 1994

### **Selected Speaking Engagements**

- Practising Law Institute, “Advanced Licensing Agreements,” 2007-present
- Practising Law Institute, “Handling Intellectual Property Issues in Business Transactions,” 2007-present
- Practising Law Institute, “Patent Prosecution Basics Course,” 1992-2004
- Practising Law Institute, “Advanced Patent Prosecution Workshop,” 1992-2004
- AIPLA, “Advanced Patent Litigation Seminar,” 2001

### **Selected Cases & Matters**

- ScentSational Technologies v. Pepsi Co, 773 Fed. Appx. 607 (Fed. Cir. 2019)
- Lazare Kaplan v. GIA & Photocscribe, Civ. Action 06-CV-4005 (S.D.N.Y. 2008)
- Patent Infringement Jury Trial
- Concept Innovation v. CFM Corp., Civ. Action No. 04C 3345 (N. D. Ill 2004)
- Patent infringement case settled with a recovery by client
- V.P. Intellectual Properties LLC v. Nobel Biocare et al., Civil Action No. 99-3136 (D.N.J. 2004)
- Patent infringement settled with multi-million dollar recovery by client
- OP Solutions, Inc. v. Intellectual Property Network, Ltd., 52 U.S.P.Q.2d 1818 (S.D.N.Y. 1999)
- Judgment for client in computer software copyright case
- Pitney Bowes, Inc. v. Bell & Howell Mail Processing Systems, Civ. Action No. 99 263 GMS (D. Del. 1999)
- Patent Infringement settled with client receiving millions of dollars
- Universal Gym Equip., Inc. v. ERWA Exercise Equip. Ltd., 229 U.S.P.Q. 335 (D Md. 1985), 827 F.2d 1542 (Fed. Cir. 1987)
- Judgment for client in trade secret case

### **Experience**

- Darby & Darby PC, Partner, 1982-2010
- Brumbaugh, Graves, Donohue & Raymond, Associate, 1973-1981
- Bell Telephone Laboratories, Patent Agent, 1971-1973

### **Memberships**

- American Intellectual Property Law Association (AIPLA)
  - President, 2005-2006
- Association of the Bar of the City of New York
- Hon. William C. Conner Inn of Court
  - Executive Committee, Member
- Intellectual Property Owners Association (IPO)
  - Member of the Trade Secrets Committee
- International Federation of Industrial Property Attorneys (FICPI)
- Metropolitan Black Bar Association
- New York Intellectual Property Law Association (NYIPLA)
  - President, 2002-2003
  - Amicus Committee
  - Patent Trial and Appeal Board (PTAB), Committee
- Magistrate Judge Selection Panel, SDNY