



David L. Cavanaugh

PARTNER

Chair, Post-Grant Proceedings Group

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David Cavanaugh has broad legal experience in industry and private practice and provides clients with strategic, business-focused counseling in the procurement, management and exploitation of their intellectual property. He has extensive experience in all aspects of intellectual property practice, including IP litigation, patent procurement, technology transfer and licensing, and due diligence for corporate transactions. Mr. Cavanaugh has developed and implemented intellectual property strategies suited for companies at all stages, from early startup phase to established business phase.

Since the implementation of the America Invents Act, Mr. Cavanaugh has been active in post-grant proceedings at the US Patent Office and was recently named by Patexia as one of the most active attorneys in *inter partes* review (IPR). He has filed petitions and represented patent owners in a variety of technologies and has been lead counsel or counsel of record on roughly 400 IPR proceedings. As lead counsel he has presented at dozens of oral hearings at the Patent Trial and Appeal Board (PTAB). He has also developed strategies for using IPRs as a vehicle toward settlement of related district court cases as well as developed strategies for joinder of parties. Mr. Cavanaugh has also represented patent owners in IPR proceedings and developed successful IPR strategies for patent owners.

Along with IPRs, Mr. Cavanaugh routinely develops strategies for other post-grant proceedings such as *ex parte* reexaminations and reissues. He has extensive experience in *inter partes* reexamination and interferences. These procedures can be used to develop comprehensive strategies using all the procedures the US Patent Office provides.

Prior to joining the firm, Mr. Cavanaugh was a senior patent counsel in the legal department of Boston Scientific Corporation, responsible for the intellectual property matters in the radiology, neurology, urology and endoscopy divisions. Prior to his work with Boston Scientific, Mr. Cavanaugh was associated with Wolf, Greenfield and Sacks in Boston, where he provided patent support to a variety of medical device clients. Mr. Cavanaugh also has been a patent examiner at the Patent Office, where he examined patent applications in a variety of

technologies.

Professional Activities

Mr. Cavanaugh is a sought-after speaker on post-grant proceedings, specifically IPRs. He developed the post-grant class and curriculum for the American University Washington College of Law, where he has taught classes on patent litigation and post-grant proceedings since 2014. He has also frequently lectured on patent law–related topics at the New England College of Law.

Mr. Cavanaugh served on the Board of Directors of the Massachusetts Medical Device Industry Council for six years, and he was also a board member of the New England Business and Technology Association. He has been selected by the Massachusetts Life Sciences Center to serve as a peer reviewer for its Small Business Matching Grant Program, which promotes the life sciences within the Commonwealth of Massachusetts.

Solutions

Post-Grant Proceedings

Litigation

Intellectual Property
Counseling and Prosecution
Life Sciences

Intellectual Property Litigation

Experience

PTAB PROCEEDINGS

- Lead counsel for two IPRs before the PTAB for Permobil, a company that designs and manufactures wheelchairs. The PTAB issued Final Written Decisions declaring unpatentable all challenged claims of US Patent No. 8,408,343 (the '343 patent) and US Pat. No. 8,408,598 (the '598 patent).
- Lead counsel for a patent owner in a series of IPR filed against US Patent number 6,331,415, (the Cabilly '415 patent). The Cabilly '415 patent issued in 2001 and was filed in 1983, and has been through extended prosecution, an interference, two reexamination proceedings (which were merged) and extensive litigation. The patented technology relates to the production of monoclonal antibodies.
- Lead counsel in an IPR victory for Unified Patents, Inc. when the PTAB held that a SportBrain Holdings LLC patent for fitness tracker technology was obvious, invalidating a patent that dozens of companies have been accused of infringing. The patent has been asserted in more than 140 cases, and more than a dozen of those were pending at the time of the board's decision.
- Lead counsel for a patent owner in a series of IPRs filed against US Patent Nos. 6,866,866 ('866 patent) and 6,790,459 ('459 patent) alleging the patents were invalid. The IPRs on the '459 patent were denied at institution, and the '866 patent survived in the Final Written Decision was held not-cancelled. The patented technology relates to timed release of medication.
- Lead counsel and co-counsel for a patent owner in a series of IPRs filed against US Patent Nos. 7,429,572; 7,964,580; 8,334,270; 8,735,372; 8,633,309; 9,284,342; 9,393,256 and 8,889,159 where each IPR petition was denied institution.
- Lead counsel for a Fortune 500 technology company when the Federal Circuit held that three patent claims that the WilmerHale team had challenged in an IPR adverse to an acoustics company were unpatentable. The patents related to speaker designs that the acoustics company accused our client of infringing.
- Lead counsel for a patent owner in a series of IPRs on Patent Nos. 7,731,379 and 6,627,196 which were held not-cancelled in a Final Written Decision.

PATENT PORTFOLIO DEVELOPMENT

- Selected to develop patent portfolio by TransMedics—a Massachusetts-based medical device company created to address the need for more effective organ transplant technologies—since 2004, when the company sought corporate, litigation and IP advice. The company has developed the first commercial, portable warm blood perfusion system, or Organ Care System, which allows surgeons to reanimate hearts from people who have recently died. The portfolio includes both US and worldwide patent applications.
- Selected to develop a patent portfolio by SevenOaks Biosystems and Massachusetts General Hospital (MGH) in the field of tissue grafting. The portfolio includes applications licensed to SevenOaks by MGH and technology developed by SevenOaks.
- Selected to be on the Patent Advisory Council for Lavit, a company which develops beverage dispensers for residential use. The Advisory Council aligns existing product development and the developing US and worldwide patent

portfolio.

Recognition



Leading Practitioner in Patent Law

IAM Patent 1000

2014-2023



Recommended for Intellectual Property: Patents and Healthcare: Life Sciences

The Legal 500 United States

2016-2019



Top Lawyer for Intellectual Property

Chambers USA

2018-2022

- Selected as a 2022-2023 IP Star by *Managing IP*, a guidebook that identifies leading IP lawyers in the United States.
- Named a Leading Lawyer in the 2016–2019 editions of *The Legal 500 United States* for intellectual property: patents: prosecution and is recommended for healthcare: life sciences.
- Named a 2014–2023 leading practitioner for Post-Grant Proceedings (National) and Prosecution and Transactions (DC Metro Area) by *IAM Patent 1000: The World's Leading Patent Practitioners*, which also recognizes his "technical and presentation abilities in a slew of PTAB oral hearings."
- Selected as a 2015–2020 IP Star and named to *Managing IP's* 2015–2018 shortlist as the US PTAB Practitioner of the Year.
- Regularly recognized by *Chambers USA Guide* in Washington DC for intellectual property litigation and intellectual property patent prosecution.
- Selected to the 2013–2023 Washington DC *Super Lawyers* list for his intellectual property practice.
- Recognized as the 2018 Intellectual Property Lawyer of the Year by *Finance Monthly*.
- Selected by peers for inclusion in *Best Lawyers in America* for his patent law practice in 2021–2024 and for his patent litigation practice in 2023–2024.

Credentials

EDUCATION

JCL, Catholic University of
America, 2016

JD, George Washington
University Law School, 1994

*selected to study at Max Plank
Institute for Comparative Patent
Law in Munich*

MA, Washington Theological
Union, 1989

BME, Villanova University,
1986

*member, Pi Tau Sigma National
Mechanical Engineering Honor
Society*

ADMISSIONS

District of Columbia

Maryland

Massachusetts

US Patent and Trademark Office