



Monica Grewal

PARTNER

Co-Chair, Post-Grant Proceedings Group

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Monica Grewal focuses on intellectual property litigation, patent prosecution, counseling and post-grant proceedings, including *inter partes* review (IPR) and *ex parte* review. Major corporations and universities rely on her to build and protect strategic patent portfolios for biomedical, electrical, chemical, mechanical and business method patents involving a diverse array of technologies. She also litigates patents in the International Trade Commission (ITC) and in the federal courts, where she has represented clients in cases involving computer software and hardware, medical devices, renewable energy, electronic devices and wireless communications technology, GPS technology, signal processing, and digital camera technology. She has also represented clients in more than 50 proceedings before the Patent Trial and Appeal Board (PTAB).

Clients in a range of industries depend on Ms. Grewal for patent advice and prosecution strategy. She has written patent applications in a wide range of technologies, including medical devices and procedures, imaging technologies for surgical and diagnostic applications, spectroscopic applications, semi-conductor fabrication, gas turbine engine applications, optics, control systems, computer networking, signal processing, business methods, and other software and telecommunications technologies.

Prior to joining the firm, Ms. Grewal was a partner and co-founder of the intellectual property group at a local general practice firm. She also worked at two intellectual property boutique firms and served as an in-house intellectual property attorney at Pratt & Whitney Aircraft. She also has significant technical experience: Ms. Grewal worked on a variety of US space programs as a former engineer in the Hamilton Standard Division of United Technologies Corporation, where she aided in the advanced testing of the NASA spacesuit and shuttle environmental control systems. She received multiple awards for this work, including for her role in the 1994 Hubble Telescope Repair Mission.

Professional Activities

Ms. Grewal is currently the President of the PTAB Bar Association, and previously served as the secretary and founding director of the PTAB Bar Association and as past president of the Board of Governors of the Boston Patent Law Association. She is a member of the American Bar Association, the Boston Bar Association, the Intellectual Property Owners Association and the American Intellectual Property Law Association and is a fellow of the American Bar Foundation. She is also an active member of the Engineering Advisory Committee at Trinity College.

Solutions

Asia	Emerging Company and Venture Capital	Intellectual Property Counseling and Prosecution
Intellectual Property Litigation	Patent Prosecution	Post-Grant Proceedings
Trade Secrets	Trials	

Experience

- Prevailed at the ITC, the US district court, and twice before the Federal Circuit on behalf of Intel, Apple and Hewlett-Packard after X2Y Attenuators LLC claimed that Intel's microprocessors, and the Apple and HP computers containing them, infringed multiple X2Y patents.
- Represented Medtronic and its subsidiary, Covidien, against a two-patent lawsuit in the District of Delaware, reaching a favorable settlement for a fraction of the exposed revenue.
- Defending Dropbox in multiple infringement cases in the Western District of Texas and in multiple post-grant proceedings.
- Defending a bank accused of allegedly infringing patents covering mobile check deposit technology in the Eastern District of Texas.
- Representing a leading research university in scores of patent prosecutions involving a wide range of technologies, from medical devices to robotics to nanoparticles.
- Successfully represented a major software company as a patent owner in an IPR petition and defended the company a patent infringement action.
- Successfully defended a multinational financial services group against infringement claims involving a patent related to a system for authenticating public encryption keys using certificates issued by trusted third parties, among others.
- Obtained a summary judgment of non-infringement on behalf of an international financial services group in an action brought by an application hosting and online accounting company in the US District Court for the Southern District of New York. The Federal Circuit affirmed in our client's favor.
- Achieved a series of victories for a multinational financial services group against the largest patent assertion entity in the nation. The victories culminated in four

successful CBM proceedings before the Patent Office. The PTAB invalidated 83 of the patent assertion entity's claims across four patents—in particular, finding that a patent for authenticating a web page was a CBM patent.

- Successfully handled foreign litigations brought by a multinational telecommunications company against our client and helped identify noninfringement and invalidity positions for the challenged patents. We coordinated with US and foreign law firms to make sure our client's positions were represented consistently across jurisdictions.
- Successfully represented a major auto and truck parts manufacturer in its patent suit against a competitor, claiming the defendant violated three patents for electronically monitoring tires. The jury ultimately ruled that the asserted patents, while valid, were not infringed by the defendant.
- Successfully represented a multinational conglomerate company against a major automotive manufacturer. Our client brought an action in the ITC alleging that the respondent's wind turbines infringed on three patents. The case was appealed, and the Federal Circuit awarded a victory to our client.
- Successfully represented insurance company clients in appeal against Intellectual Ventures. The Federal Circuit affirmed the district court's findings that two Intellectual Ventures patents are invalid under 35 U.S.C. 101, and that Intellectual Ventures did not own a third patent.
- Obtained dismissal of a seven-patent infringement complaint because all claimed patent ineligible subject matter under 35 U.S.C. § 101.
- Successfully represented a multinational software company in a patent infringement case against a non-practicing entity and frequent litigator in the Eastern District of Texas on the ground that the asserted claim was unpatentable under 35 U.S.C. § 101.
- Successfully represented three multinational technology companies in a Section 337 proceeding brought by a company that develops passive component solutions for the electronics industry. The ITC issued a final determination terminating the investigation with a finding of no violation.
- Successfully represented a semiconductor manufacturer of analog circuitry in a patent infringement case against a competing semiconductor manufacturer in the District of Massachusetts.
- Successfully represented a digital camera technology company in an action filed against two cellular handset manufacturers resulting in a finding of a violation based on infringement of two patents in a Section 337 proceeding before the ITC. A corresponding patent infringement action was withdrawn prior to the final hearing in Dusseldorf, Germany.
- Successfully represented a manufacturer of GPS chips in an action against a competing GPS chip company resulting in a finding of a violation based on infringement of six patents in a Section 337 proceeding before the ITC.

Recognition

- Named to *Boston Magazine's* Top Lawyers list in 2022 in the area of Intellectual Property Rights.
- Selected as a 2022 and 2023 IP Star by Managing IP, a guidebook that identifies leading IP lawyers in the United States.
- Selected by peers for inclusion in *Best Lawyers in America®* for intellectual property litigation (2014–2024), patent litigation (2014–2024) and patent law (2021–2024) and in 2021 named Lawyer of the Year for patent law in Boston.
- Recognized as a 2014–2023 *Massachusetts Super Lawyer* for her intellectual property practice and named among the "Top Women Attorneys in Massachusetts" in 2016 and 2017.
- Named a 2019 Top Woman in Law by *Massachusetts Lawyers Weekly* for her accomplishments in pro bono, social justice, advocacy and business.
- Named among the Top 50 Women in PTAB Trials in 2019 and 2021 by the PTAB Bar Association, which recognized female practitioners who have appeared in the highest number of PTAB trial proceedings since 2012.
- Featured by *INDIA New England News* in its 2019 Women of the Year series, which profiled South Asian women in New England who have achieved phenomenal success in both the business and social arenas.
- Honored during the International Institute of New England's 2019 annual International Women's Day Luncheon, which celebrates "immigrant women and daughters of immigrants who have made a profound difference in New England and the world."
- Included in *BTI Consulting's Client Service All-Stars* 2020 list for combining "exceptional legal expertise with practical advice, business savvy and innovative, effective solutions."
- Recommended in the 2016–2018 editions of *The Legal 500 United States* for intellectual property: patents: prosecution (including re-examination and post-grant proceedings).
- Named to the Lawdragon 500 Leading Litigators in America list.

Credentials

EDUCATION

JD, University of Connecticut,
1997

MS, Electrical Engineering,
Rensselaer Polytechnic
Institute, 1988

BS, Engineering, Trinity College,
1987

Phi Beta Kappa

ADMISSIONS

Massachusetts

Connecticut

District of Columbia

Illinois

US Patent and Trademark Office

LANGUAGES

Hindi

Punjabi