

Edward A. Pennington

Partner | Washington, D.C.

Edward A. Pennington is a Partner in the Intellectual Property Practice of Smith, Gambrell & Russell, LLP.

Mr. Pennington is a registered patent attorney with an educational background in both physics and economics. He also taught statistics in college while attending graduate school on a Teaching Fellowship. His interest in litigation started early in his career, taking court-appointed indigent criminal defense cases to gain immediate courtroom experience. Almost immediately out of school, he tried to a verdict a successful Lanham Act defensive action in the Western District of Pennsylvania and followed that up with a continuous stream of patent, trademark, copyright, trade secret, and contract trials and settlements over the last 30 years. His litigation matters have spanned virtually every technical field, including vaccines, viral vectors and related bio-pharma technologies; computer hardware and software; location technology such as personal navigation, geo-fencing, telematics and VOIP-based 9-1-1 call routing; cellular wireless encoding schemes including CDMA, GSM, 3G, 4G, LTE, and 5G and corresponding standards; WIFI networks, power control and various standards; encryption and cryptography; nuclear reactors; materials science including alloys, ceramics and plastics; 3D printing; aircraft engines; diesel and gasoline engine design and components; electric power storage and generation, including solar arrays, wind turbines, and nuclear fusion and fission; coatings and substrates; sporting equipment including golf clubs, balls and gloves, martial arts protective equipment; water sports including sail boards, kayaks, foam flotation devices and powered craft; and medical devices including artificial joints and spinal implants, dental implants and surgical techniques, endoscopes, surgical clamps, catheters, surgical devices and valves; and satellite communications including DBS transmission and reception, antennas, transmitters, GPS, and other space based communication networks and systems such as IRIDIUM constellation satellites, receivers and transmitters.

Mr. Pennington has been admitted to and practiced in all major patent venues, and a good number of minor ones, including the U.S. District Court for the District of Delaware, the Eastern District of Texas, the Southern, Middle, and Northern Districts of Florida, the Eastern District



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Areas of Practice

Intellectual Property

Patent Prosecution

Inter Partes Review (IPR)

IP Litigation

Customs & International Trade

Bar Admissions

Virginia

District of Columbia

United States Patent Bar (Reg.
No. 32,588)

U.S. District Court for the
District of Maryland

U.S. District Court for the
Eastern District of Virginia

U.S. District Court for the
Western District of Virginia

of Virginia, the District of Maryland, the District of New Jersey, the Southern and Eastern Districts of New York, and all of the Districts Courts of California. He has also tried patent cases before the U.S. International Trade Commission and maintains an active docket there. His clients over the years have included major universities, U.S. government research laboratories, defense contractors, Fortune 50 companies, as well as independent inventors, research laboratories, and smaller, growth-oriented and technology-driven companies.

Mr. Pennington is a member of the American Bar Association, the American Intellectual Property Law Association, the Intellectual Property Law Section of the Virginia State Bar, and the Licensing Executives Society.

Before joining Smith, Gambrell & Russell, Mr. Pennington worked at Bingham McCutchen LLP, joining that firm when it combined with Swidler Berlin, where he was chairman of Swidler Berlin's IP practice group. Before that, he was the managing partner of Morgan & Finnegan's Washington, D.C., office. Mr. Pennington is a past Board Member of the Virginia State Bar, Intellectual Property Section.

Mr. Pennington received his B.S. and M.A. degrees from West Virginia University. In graduate school, he was a Teaching Fellow and taught Statistics. He received his J.D. from the George Mason University School of Law, where he was a member of the Jessup International Moot Court team. He is admitted to practice in the District of Columbia and Virginia and registered to practice before the United States Patent Trademark Office. He is also admitted to appear before the following Courts: U.S. Court of Appeals for the District of Columbia Circuit; U.S. Court of Appeals for the Federal Circuit; U.S. Court of Appeals for the Third Circuit; U.S. Court of Appeals for the Fourth Circuit; the U.S. District Court for the District of Columbia; the U.S. District Court for the Eastern District of Virginia; the U.S. District Court for the Western District of Virginia, the U.S. District Court for the District of Maryland; and the U.S. Supreme Court.

Representative experience

- *Cassidian v. microData GIS, et al., E.D.Tx., 2:2012-cv-162* lead trial counsel in a patent infringement case, securing jury verdict for the defendants, of invalidity on several grounds including inventorship, and non-infringement. Patent covered 9-1-1 call routing on a VOIP platform. Motions for Judgment as a Matter of Law, filed by plaintiff, denied by district court judge.

U.S. District Court for the District of Columbia
U.S. Court of Appeals for the Third Circuit
U.S. Court of Appeals for the Fourth Circuit
U.S. Court of Appeals for the Federal Circuit
U.S. Court of Appeals for the District of Columbia Circuit
U.S. Supreme Court

Memberships

District of Columbia Bar Association
Virginia State Bar, Intellectual Property Law Section
International Trade Commission Trial Lawyer's Association

Recognitions

Washington D.C. *Super Lawyers* (2014-2021)
Washington D.C. and National, IP Stars, *Managing Intellectual Property* (2018, 2019, 2021)
Washington D.C. Top Lawyers, *The Washington Post* (2019)

- *Children’s Hospital of Philadelphia v. Viagenetics, Inc., E.D.Pa.*, 2:18cv5551, represented defendants in a case having claims of trade secret misappropriation, breach of contract, and fraud; case dismissed with prejudice following extensive showing of no inappropriate activity resulting from collaborative research efforts between the parties.
- *Bote LLC v. bote-board.com* and *John Does 1-10*, 1:2021cv612 (E.D.Va.), obtained Temporary Restraining Order against unknown “Doe” using fake websites to phish for customer information.
- *Baggage Airline Guest Services, Inc. v. Roadie, Inc., D. Del.*, 1:2018cv707, represented defendant in a patent infringement case involving baggage delivery dispatch and delivery services. Won a summary determination of invalidity of the asserted patent, based on patent ineligibility, and won an affirmance at the U.S. Court of Appeals for the Federal Circuit.
- *California Fueling, LLC v. Best Energy, Inc. et al.*, California State Court, 18STCV8474 (Los Angeles), represented co-defendant Innospec, Inc. in an action asserting tortious interference, fraud, and unfair competition; case settled favorably to defendants near trial date.
- *ITC Investigation No.337-TA-1096*, In the Matter of Certain Microperforated Packaging Containing Fresh Produce, represented Complainant Windham Packaging LLC against seven respondents over patents covering produce packaging
- *ITC Investigation No. 337-TA-550*, In the Matter of Certain Modified Vaccinia Ankara (“MVA”) Viruses and Vaccines and Pharmaceutical Compositions Based Thereon, lead trial counsel for Complainant Bavarian Nordic A/S, on an ITC patent infringement action against vaccines sought to be imported by respondent Acambis PLC. Patents covered small pox vaccines and viral vectors supplied to the U.S. government as part of operation BioShiel. Trial and subsequent rehearing resulted in Acambis being pushed out of the market, and contract with HHS/NIH going to Bavarian Nordic.
- *Wavelinx LLC v. LivePerson, Inc., D. Del.*, 1:20cv1455-LPS, represented defendant software company in a patent infringement case involving video streaming, case withdrawn by plaintiff following presentation of non-infringement position.
- *Pureline Treatment Systems, LLC v. SMM Distributors LLC, C.D.Ca.*, 2:20cv04440 PSG, representing defendant in a patent infringement case involving chlorine dioxide cleaning systems.
- *Lerman Container v. Lids and Jars LLC, D. Md.*, 1:2019cv1414, representing defendant in a patent infringement case involving design patents for bottles.
- *Quikrete, Inc. v. Sakrete, Inc., N.D.Ga.*, 1:2016cv361, represented plaintiff in a trademark infringement action over the color red used in packaging quick setting pre-mixed concrete. Secured favorable settlement with defendant agreeing to cease using offending packaging.
- *Odorstar v. SMM Distributors, et al.*, S.D.Fla., 0:2013-cv-60136 won summary judgment of non-infringement for defendants on patent that covered chlorine dioxide cleaning solutions. Plaintiffs appealed to the Court of Appeals for the Federal Circuit, and in January 2015, the Federal Circuit affirmed the district court’s ruling of non-infringement.

- *OSS Holdings v. Thermal Defense, LLC, E.D.Tn.*, 2:2019cv137, represented defendant in a patent infringement case involving firearm suppressors, negotiated dismissal with prejudice following showing of non-infringement.
- *Delorme Publishing Co. v. Briar Tek, E.D.Va.*, 1:2013-cv-640 won summary judgment of invalidity for declaratory judgment plaintiff, on patents covering communication network using Iridium satellite constellation and GPS location techniques.
- *Straight Path LLC v. Telesphere, E.D.Va.*, 1:2013-cv-937 obtained favorable settlement for defendant in a case involving a non-practicing entity's patents that purported to cover VOIP communications.
- *Telecommunication Systems Inc. v. Porto, E.D.Va.*, 3:2014-cv-111 represented plaintiff in a Declaratory Judgment action seeking invalidation of patents that cover location technology, settled favorably with dismissal with prejudice.
- *Woosley v. Georgetown University, E.D.Va.*, 1:2000-cv-504 presented inventor of "Allegra" in dispute with University employer over distribution of proceeds received from research that led to the patented allergy medication, resulting in favorable settlement with University and third party graduate student who claimed to be a co-inventor.
- *Bavarian Nordic A/S v. Acambis, Inc.*, D. Del., 1:05-cv-614, Represented the owner of a patented viral strain in a suit for "conversion" of a sample of the viral strain. Companion patent infringement case was pending at the International Trade Commission (ITC). Case settled favorably after a global settlement with the competitor was negotiated.
- *Autocell Laboratories, Inc. v. Cisco Systems Inc.*, D. Del., 1:08-cv-760, Represented plaintiff in patent infringement case that involved dynamic power control for WIFI networks, dealing specifically with power control requirements under 802.11. Patent portfolio involved over 50 patents. Patent in suit found valid on summary judgment.
- *Callaway Golf Co. v. Acushnet Co.*, 576 F.3d 1331 (Fed. Cir. 2009), Represented appellant/defendant in obtaining a new trial, and reversing a jury trial verdict of validity and infringement. Patents related to the materials used in making golf balls.
- *PCT International Inc. v. John Mezzalingua Associates Inc.*, D. Del., 1:10-cv-00059, Represented defendant in a case involving "F-type" connectors used in the cable industry. Case settled favorably before trial.
- *Vehicle IP LLC v. AT&T Mobility LLC, et al.*, D. Del., 1:09-cv-1007, pending, Representing one of several defendants in a case involving location services used on cell phones and other devices.
- *Taser Int'l. Inc. v. Stinger Systems, Inc.*, D. Az., 2:07-cv-42, Represented defendant in a contempt proceeding; bench trial resulted in finding of no infringement by design-around product.
- *Smart Trike USA LLC v. Heinz Kettler GmbH, D.N.J.*, 2:10-cv-2063, Represented accused infringer in declaratory judgment action, case settled favorably to client after four days of trial.

- *Bavarian Nordic A/S v. Oxford Biomedica PLC*, S.D.Cal., 3:08-cv-1156, Represented patent holder in case involving patented cancer fighting biotechnology. Case settled after defendant failed to dismiss case under the “safe harbor” provisions of the Hatch Waxman Act.
- *Netropa Corp. v. Telecommunication Systems, Inc.*, C.D.Ca., 2:12-cv-4927, pending, Representing defendant in a copyright and breach of contract case involving a former software programmer.
- *National Black Chamber of Commerce, Inc. v. US Black Chamber*, D.D.C., 1:10-cv-1755, pending, Representing defendant in a trademark case between competing chambers of commerce.
- *Tendler Cellular of Texas, LLC v. MetroPCS Communications, Inc., et al.*, E.D.Tx., 6:11-cv-178, Represented defendant in a patent case involving navigation functionality of cellular telephones. Settled favorably before trial.
- *Levine v. Samsung Telecommunications America, LLC, et al.*, E.D.Tx., 2:09-cv-372, Represented one of several defendants in a suit involving navigation functionality of cellular telephones. Settled favorably before trial.
- *IP Venture, Inc. v. Cellco Partnership d/b/a Verizon Wireless, et al.*, N.D.Ca., cv 10-04755, Represented on of several defendants in a suit involving navigation functionality of cellular telephones. Settled favorably before trial.
- *Traffic Information, LLC v. Cricket Communications, Inc.*, E.D.Tx., 2:10-cv-226, Represented defendant in a patent case involving traffic identification on a cellular telephone. Settled favorably before trial.
- *Office of Strategic Services, Inc. v. Sedeghian et al.*, E.D.Tx., 1:11-cv-195, Represented defendants in a trademark, tortious interference, and breach of fiduciary duty claim arising from a hostile corporate break up. Case decided in favor of defendants on summary judgment.
- *Microsoft Corp. v. Computer Warehouse, Inc., et al.*, E.D.Va., 1:11-cv-491, Represented defendants in a copyright infringement case based on re-loading operating system software after computer refurbishing. Case settled favorably before trial.
- *QNX Software Systems GmbH v. Netrino LLC*, D.Md., 1:09-cv-2206, Represented defendant in a trademark case involving software. Case settled favorably before trial.
- *TracBeam, LLC v. AT&T Inc., et al.*, E.D.Tx., 6:11-cv-96, pending, Representing multiple defendants in patent case involving 911 services and location based services for cellular telephone.
- *Patent Licensing and Investment, LLC v. Green Jets, Inc.*, S.D.Fla., 9:11-cv-80689, Represented defendant in a patent case involving business methodology for operating a private jet company. Case dismissed in favor of defendant after discovery.

- *Verizon Services Corp. et al. v. Cox Fibernet Virginia LLC, E.D.Va.*, 1:08-cv-57, Assisted defense of case involving Voice over Internet Protocol (VOIP) patents, succeeded at trial in invalidating claims.
- *Google LLC v. Oracle America, Inc.*, 593 U.S. (2021) Represented one of several amicus parties supporting the position of Oracle on the issue of fair use of source code used in Android's Application Programming Interface (API) software.
- *Janssen Biotech, Inc. v. Abbott Laboratories, et al.*, No. 11-596, represented amici curiae Bavarian Nordic A/S, Novo Nordisk A/S and STC.UNM in a Petition for Certiorari on the issue of whether written description requirements of the Patent Statute have heightened reduction to practice standards for biotechnology.
- *Global Mail Limited v. U.S. Postal Service*, 142 F.3d 208 (4th Cir. 1998) represented plaintiff Global Mail in a trademark suit against the U.S. Postal Service. Case was dismissed at the trial court, Eastern District of Virginia, on grounds of sovereign immunity. Obtained a reversal and remand at the 4th Circuit, which led to a very favorable settlement before trial.