



DAVID MAGEE

PARTNER

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With nearly 20 years of experience, David Magee represents technology and other industry clients in patent litigation and licensing, as well as counseling on intellectual property matters and commercial disputes. He has successfully litigated patent, trademark, copyright, trade secret and other intellectual property and commercial cases before the International Trade Commission (ITC), Patent Trial and Appeal Board (PTAB) and U.S. District Courts, as well as numerous mediation and arbitration panels. His background as an engineer at a top engineering firm lends to his ability to quickly distill complex technical information, and drives his successful representation of clients in complex, multimillion-dollar disputes.

Licensed to practice before the U.S. Patent and Trademark Office, his counsel is instrumental at all phases of IP planning, from procurement and monetization to enforcement and defense. David works with business clients in evaluating IP scope, quality and total addressable market (TAM) for IP acquisitions and negotiates and prepares commercial agreements including licenses, confidentiality and nondisclosure agreements, development and distribution agreements, releases, product sale, software and service agreements.

His strategic counsel regarding critical technologies and assets extends to a number of complementary practice areas including those related to information control, cloud migration, privacy and data security, and related regulations and compliance including International Traffic in Arms Regulations (ITAR), Export Administration Regulations (EAR), California Consumer Privacy Act (CCPA) and the General Data Protection Regulation (GDPR).

In addition to his intellectual property practice, David has guided clients through matters involving accidents, major losses, False Claims Act and other government investigations (Department of Justice, U.S. Coast Guard, Occupational Safety and Health Administration (OSHA) and Minerals Management Service (MMS)), and claims in the energy, manufacturing and construction industries.

BACKGROUND

Prior to joining Armstrong Teasdale, David was in private practice at another Boston-area law firm. He has experience at both small firms and Am Law 25 international firms, and prior to becoming a lawyer, he worked as an engineer for a top 25 global engineering and construction firm, as ranked by the Engineering News-Record.

SERVICES AND INDUSTRIES

Intellectual Property
Intellectual Property Litigation
Patent
Copyright
Trademark
Noncompete and Trade Secrets
Post Grant Proceedings
Data Innovation, Security and Privacy
Technology Transactions
White-Collar Criminal Defense and Government Investigations
Energy and Utilities
Manufacturing and Innovation Technology

ADMISSIONS

Massachusetts
Texas
U.S. Patent and Trademark Office
U.S. District Court, District of Massachusetts
U.S. Court of Appeals, First Circuit
U.S. Court of Appeals, Federal Circuit

EDUCATION

- Northeastern University School of Law (J.D., 2001)
- Northeastern University College of Engineering (B.S., 1997)

PROFESSIONAL ACTIVITIES

- American Bar Association (Member; Young Lawyers Division Antitrust Committee Chair, 2008-2009)
- Massachusetts Bar Association
- Boston Bar Association
- Boston Patent Law Association
- American Society of Civil Engineers

CHARITABLE AND CIVIC INVOLVEMENT

- Father Bill's & MainSpring, Volunteer (2016-present)
- Middlesex County District Attorney, Pro Bono Attorney (2014-present)
- Cardinal Cushing Centers, Inc., Human Rights Committee (Member, 2017-2019)

ACCOLADES

- *Massachusetts Super Lawyers*®, Rising Star (2005-2006, 2010-2011)
- Who's Who in American Law (2008)
- Who's Who of Emerging Leaders (2007)

EXPERIENCE

Defense of Multinational Tech Company in Patent Infringement Claims

Represented multinational technology company specializing in internet-related services and products (online advertising technologies, search engine, cloud computing, mobile software and hardware) in several matters ranging from alleged infringement of patent covering software methods used in generating differential update packages for mobile device operating systems to patent claims related to the non-cellular signal use in determining a cell phone's location.

Successful Verdict in Four-Week Trial for Disease/Genetics Testing Corporation

Represented plaintiff health sciences corporation in a patent infringement action relating to its automated tissue processing systems used in the diagnosis of a variety of diseases. The four-week jury trial resulted in a verdict finding infringement on all asserted claims, which was upheld on appeal before the Federal Circuit.

Trade Secret, Cybersecurity Protection for Real Estate Technology Industry Client

Represented leading commercial real estate industry platform and cloud service provider in transactions and disputes including the protection of trade secrets and cybersecurity breaches.

Substantial ITC Settlement for Semiconductor Client in Section 337 Investigation

Represented semiconductor industry client in International Trade Commission (ITC) Section 337 investigation directed at the importation of mobile processors incorporating client's patented integrated circuit features. Three-week trial resulted in substantial settlement to client.

General Exclusion Order (GEO) for Client in ITC Section 337 Investigation

Represented manufacturer of LED light arrays used in photography and video studios in Section 337 investigation directed at the importation of camera- and tripod-mounted LED arrays sourced from a variety of respondents. Trial resulted in the rare issuance of a general exclusion order (GEO). Worked with U.S. Customs officials to enforce GEO and seize infringing articles at ports of entry.

Favorable ITC Settlement for Designer, Manufacturer in Section 337 Investigation

Represented designer and manufacturer of digital microphone and noise-reduction products used in voice-driven applications including in ITC Section 337 investigation directed at the importation of devices incorporating directional microphone arrays and associated software. Resolved matter on the eve of trial with favorable settlement to client.

Representation of Largest Publicly Traded Private Equity Firm in the U.S. in IP Portfolio Evaluation

Represented the largest U.S. publicly traded private equity firm and other investors in evaluating and securing intellectual property portfolios for acquisitions and investments in companies operating in the energy and technology industries.

Evaluations of Large Tech, Patent Portfolios for Valuation and Market Potential

Evaluated large technology and patent portfolios consisting of thousands of assets, for valuation and total addressable market (TAM) potential to identify assets for investment, license and/or sale. Identified market participants and developed licensing programs to maximize client ROI. Negotiated resulting agreements and licenses.

Numerous Representations Before PTAB and in IPR, Reexamination Proceedings

Represented numerous clients in actions before the Patent Trial and Appeal Board (PTAB) in challenging and defending patent claims through post-grant proceedings including *inter partes* review (IPR) and reexamination proceedings. Notable success in obtaining denial of institution at preliminary response stage.

Representation of Joint Venture Partners in Deepwater Horizon Spill

Served as the technical lead attorney representing the Macondo well leasehold joint venture partners in defense of claims and numerous government investigations stemming from the accident onboard the Deepwater Horizon and resulting hydrocarbon release into the Gulf of Mexico.

Representation of Joint Venture Management Consultant in Claims, Investigations Surrounding Boston's "Big Dig"

Represented the joint venture management consultant in defense of claims and government investigations arising from the design and construction of Boston's \$24.3 billion Central Artery/Tunnel Project (the "Big Dig").

Representation of Subcontractor in Boston Interstate Tunnel Collapse

Represented key subcontractor in defense of claims and government investigations related to the ceiling collapse of the D Street portal of Interstate 90 connector tunnel in

Boston.

Representation of Design Joint Venture in \$4 Billion LaGuardia Redevelopment

Represented the design joint venture in defense of claims from the \$4 billion redevelopment of LaGuardia Airport Central Terminal B in New York City, the largest public-private partnership (P3) undertaken in the United States.

Representation of Manufacturer in Claims, Investigation Related to Facility Explosion

Represented industrial manufacturer in defense of claims and government investigations related to an explosion of cylinders containing borane-tetrahydrofuran at a chemical manufacturing facility.

Successful Representation of Subcontractor in DOJ Investigation

Represented mega project materials subcontractor in defense of False Claims Act investigations by the Department of Justice, resulting in the government closing its investigation without action.

Representation of Energy Industry Owner and Operator in Breach of Contract Case

Represented gas-turbine power generation owner and operator in claims against general contractor for breach of contract for failure to meet gas supply obligations, plant efficiency and output requirements.