

BRADLEY K. GROFF
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Brad Groff's practice is primarily devoted to the procurement and enforcement of intellectual property rights, counseling clients to avoid IP problems, defending clients when intellectual property disputes do arise, and intellectual property law alternative dispute resolution (ADR).

Mr. Groff has been recognized as one of the top attorneys in his practice area, repeatedly selected as a Georgia "Super Lawyer" in intellectual property law, named to Georgia Trend's "Legal Elite," and receiving Martindale-Hubbell's highest "AV" peer-evaluated certification. He is a frequent speaker on intellectual property matters and serves in a variety of leadership roles in bar organizations on the local, state and international level.

Prior to his legal career, Brad was a mechanical engineer in the nuclear weapons field. He is also a named inventor on two patents and a number of additional patent applications, and a published author.

Brad is active in a number of civic organizations and devotes considerable time and resources in service to his community. His *pro bono* efforts have included the legal representation of a faith-based youth leadership organization, trademark work for churches and church programs, and legal work for a clean drinking water initiative in Haiti.

SELECTED EXPERIENCE:

Patent preparation and prosecution in the U.S. Patent and Trademark Office. Representative technologies include medical devices, contact lenses, manufacturing systems and methods, exercise equipment, packaging, materials handling equipment, jet engines, heavy equipment, optical and photographic equipment, tools, heavy equipment, lighting equipment, textiles, poultry growing and processing, sporting goods, protective equipment, business methods and e-commerce.

Examples of patents include:

- U.S. Patent Number 8,267,950 (Medical Lancing Device)
- U.S. Patent Number 8,037,863 (Rotary Engine)
- U.S. Patent Number 8,034,150 (Nickel-Cadmium Recycling Process)
- U.S. Patent Number 7,963,272 (Vegetable Oil Fueled Diesel Engine)
- U.S. Patent Number 7,866,843 (Lighting Fixture)
- U.S. Patent Number 7,685,000 (Medical Disease Management Method)
- U.S. Patent Number 7,243,456 (Firearm Scope Mount)
- U.S. Patent Number 7,234,824 (Surgical Microscope Glare Elimination System)
- U.S. Patent Number 7,194,366 (Electronic Component Testing)
- U.S. Patent Number 7,150,755 (Blood Sampling Device)
- U.S. Patent Number 7,044,679 (Optical Illusion Speed Bump)
- U.S. Patent Number 7,004,043 (Elevated Surveillance Camera Support with Automatic Electrical Connection)

- U.S. Patent Number 6,979,298 (Olfaction Aerodynamics Analysis)
- U.S. Patent Number 6,934,600 (Nanotube Fiber Reinforced Composite Material)
- U.S. Patent Number 6,929,233 (Ophthalmic Lens Casting Mold)
- U.S. Patent Number 6,855,137 (Catheter with Co-Extruded Shaft Stiffeners)
- U.S. Patent Number 6,846,545 (Non-Woven Material for Ballistic Projectile Impact Absorption)
- U.S. Patent Number 6,811,046 (Carpet Sample Display Rack)
- U.S. Patent Number 6,796,533 (Airfoil Boundary Layer Reattachment by Piezoelectric Synthetic Jet Actuators)
- U.S. Patent Number 6,788,071 (Nano-scale Photovoltaic Biomembranes)
- U.S. Patent Number 6,753,004 (Fishing Lure)
- U.S. Patent Number 6,735,382 (Pressurized Surveillance Camera Housing)
- U.S. Patent Number 6,679,795 (Baseball Pitching Target)
- U.S. Patent Number 6,599,265 (Catheter steering device)
- U.S. Patent Number 6,393,905 (Adhesion Test Device)
- U.S. Patent Number 6,283,982 (Medical Lancing Device)
- U.S. Patent Number 6,267,377 (Educational Card Game)
- U.S. Patent Number 6,213,974 (Spinal Catheter)
- U.S. Patent Number 5,996,336 (Jet Engine)

Trademark preparation and prosecution in the U.S. Patent and Trademark Office for goods and services in various business areas, including:

- Medical devices
- Healthcare services
- Consumer goods
- Wine and liquor
- Energy drinks
- Firearms
- Designer eyewear
- Restaurants and bakeries
- Law firm services

Litigation and Enforcement of intellectual property controversies:

Legal services in general, and especially in the intellectual property litigation area, have become terrifically expensive. For example, the latest surveys show that litigating a trademark infringement action through trial costs in excess of \$600,000 on average, and the average patent infringement action costs over \$2,000,000. Add to these fees the disruption of your market activities and the delays inherent in the litigation process, and it can be fatal to a business.

Mr. Groff works hard to streamline the dispute resolution process, contain costs and provide his clients with the highest value for their dollar, generally obtaining very favorable results faster and for far less cost than the above averages. In fact, Brad considers his best legal work to be that which keeps his clients out of the courtroom and avoids the cost and distraction of litigation altogether. But when the need arises, Mr. Groff is well-versed in the focused, strategic use of the judicial process to quickly meet the business objectives of clients in a cost-effective manner.

This strategic approach to litigation has led to numerous successful outcomes for our clients, often against larger opponents with far greater resources and opposite some of the nation's largest and most prestigious law firms. Example prior engagements include:

- Trade dress litigation in federal district court employing aggressive motion practice and discovery, compelling a competitor to alter its product design and drop all counterclaims against our client.
- Successfully negotiate resolution of trademark infringement charges against our client for a mark used in connection with trade shows, avoiding litigation and avoiding interruption to our client's ongoing business.
- Initiate re-examination in the Patent Office of a competitor's patent in response to an infringement suit, resulting in patent being invalidated and revoked.
- Initiation of a declaratory judgment action in federal court for invalidity and non-infringement of a patent for manufacturing equipment, driving resolution of dispute on commercially agreeable terms and without interruption of client's manufacturing activities.
- Lead counsel on appeal and oral argument before U.S. Patent and Trademark Office Board of Appeals and Interferences. Examiner's rejections overturned and all claims allowed without amendment.
- Identify invalidating prior art against client's former business partner who misappropriated patent rights in automotive accessory design and asserted patent against client. All accusations were dropped, with no interruption of client's business.
- Deposition testimony in federal patent infringement lawsuit in support of prior opinion of invalidity and non-infringement, leading to settlement on terms favorable to client.
- Initiate declaratory judgment lawsuit in federal district court to invalidate patent of client's former supplier, which client's firearms accessory was accused of infringing. Resolved with full release and dismissal of all claims against our client, no payment to opposing party, and no interruption of client's sales.

- Resolved copyright claims against our client for carpet pattern design by uncovering ancient public domain source of design, avoiding litigation and with no liability for our client.
- Lead counsel for two corporate officers sued in federal court for infringement of seven patents related to spinal catheters. Transferred action to arbitration where case was quickly and efficiently resolved, with a finding that four of the patents were invalid and no liability for infringement of remaining patents by either officer.
- Trial counsel in federal court representing party accused of infringing competitor's patent for manufacturing equipment. Competitor's patent found invalid on appeal and costs awarded in favor of client.
- Secured temporary restraining order and preliminary injunction to prevent infringement of client's copyright and patent rights for commercial sewing equipment at trade show. Emergency relief forced competitor to immediately remove copied materials from their booth and eventually leave trade show before its close.
- Successfully negotiated relief from unduly burdensome terms of preliminary injunction that had been entered against client before our representation began in a trademark infringement lawsuit.

Alternate Dispute Resolution (ADR): Brad is a registered neutral with the Georgia Office of Dispute Resolution for mediation and arbitration. His practice as a mediator and arbitrator is limited to resolution of intellectual property matters exclusively.

Counseling and advising clients by providing opinions of patentability of inventions, opinions of trademark availability and registrability, opinions of infringement or non-infringement of intellectual property rights, opinions of validity or invalidity of intellectual property rights, intellectual property audits, and education of employees to recognize and harvest corporate intellectual property opportunities and maximize their value to company.

Transactions including assignment and licensing of intellectual property interests, and due diligence related to transfer of intellectual property assets. Assist businesses in identifying and valuing IP assets in corporate acquisitions and mergers.

1989 - 1992 Westinghouse Savannah River Site, Aiken, South Carolina

Engineer: Project design and implementation, supervised construction and startup of mechanical and electrical systems and equipment in a nuclear-chemical processing facility.

Shift Supervisor: Supervised production employees in the operation of a nuclear-chemical processing facility.

12/86 - 9/87 Denlinger, Inc., Paradise, Pennsylvania

Engineer: Design and computer-simulated analysis of structural floor and roof truss systems, production scheduling and estimating.

7/86 - 12/86 MarkLine Industries, Inc., Ephrata, Pennsylvania

Draftsman and Project Manager: Design and oversee construction of commercial and industrial pre-fabricated buildings, including production scheduling, purchasing, managing inventory, and overseeing assembly line construction.

1984 - 1986 Amos M. Stoltzfus, Inc., Limeville, Pennsylvania

Carpenter: Crew leader, carpenter and dump truck driver in residential construction field, including framing, concrete work, roofing, finish carpentry, ditch digging, and cabinet installation, with Amish construction crew.

1980 - 1989

Service Industry: Thankless work busing tables, washing dishes, janitoring, waiting tables and tending bar.

1973 - 1981

Farm Hand: Hard, dirty, smelly manual labor for little or no pay on two family dairy farms.

EDUCATION:**University of Georgia School of Law, Athens, Georgia**

Juris Doctor, 1994, (*Cum Laude*)

- Order of the Coif
- Georgia Law Review, Editorial and Managerial Boards
- AmJur and C.J.S. Book Awards in Property Law

Lehigh University, Bethlehem, Pennsylvania

Bachelor of Science in Mechanical Engineering, 1988

Georgia State University, Atlanta, Georgia

Graduate studies in Chemistry: Organic, Biochemistry, Physical Chemistry

University of South Carolina, Columbia, South Carolina

Graduate studies in Business Administration

PROFESSIONAL MEMBERSHIPS AND RECOGNITION:

- Registered Patent Attorney, U.S. Patent & Trademark Office.
- Member in good standing, State Bar of Georgia.

- Admitted to state and federal courts in Georgia, and U.S. Court of Appeals for Federal Circuit.
- Georgia Bar Association Intellectual Property Law Section: Trademark Committee Chair 2005-06 and 2006-07, IP Litigation Committee Chair 2007-08, Patent Committee Chair 2008-09 and 2009-10, Treasurer 2010-11, Secretary 2011-12, Chair 2014-15.
- Rotary International: Multiple Paul Harris Fellow and Major Donor, Will Watt Fellow, David Stahl Fellow, multiple years as club Treasurer, Sergeant-at-Arms, Rotary Club President 2010-11, Georgia Rotary Student Program host 2012-13, Rotary Youth Exchange host family 2018-19, Youth Exchange Officer, Foundation Chair.
- “*Georgia Super Lawyer*,” Atlanta Magazine, 2007 - 2019.
- Atlanta Bar Association, IP Section, Founding Member, Board of Directors, Secretary-Treasurer 2008-09, Vice Chair and SpringPosium Coordinator 2009-10, Chair 2010-11.
- Cobb Chamber of Commerce, 2006-07 CEO Roundtable.
- Palestine Masonic Lodge #486, Junior Warden 2010, Senior Warden 2011, Master 2012.
- International Trademark Association (INTA), Non-Traditional Marks Committee 2008-11, Non-Profit Organizations Committee 2012-13.
- Martindale-Hubbell “AV” Rated.
- Emory University and Georgia Tech TI:GER Program Patent Claim Drafting Clinic Group Leader.
- Georgia State Bar Commission on Professionalism, Group Leader for University of Georgia Law School Orientations on Professionalism.
- Georgia Bar Transition into Law Practice Program, Mentor to multiple new attorneys.
- Atlanta Intellectual Property Inn of Court – Master.

PUBLICATIONS & PRESENTATIONS:

- Indirect and Joint Patent Infringement after Akamai and McKesson, North American Entertainment, Sports and Intellectual Property Law Conference, Cancun Mexico, Nov. 2012).
- Willful Patent Infringement Post-Seagate, Intellectual Property Institute, Dominican Republic (Nov. 2009).
- “Avoiding the Potholes: A Roadmap for Intellectual Property Due Diligence in Business Transactions,” Georgia Bar Journal (December 2008).
- “Patent Opinion Practice after *Seagate*,” Intellectual Property Law SpringPosium®, Young Harris, GA (May 2008).
- “Intellectual Property Law SpringPosium®,” Program Kick-Off and Introduction, Young Harris, GA (May 2008).

- “Steering Clear of Inequitable Conduct: Ethics and the Duty of Disclosure in Patent Prosecution,” Atlanta, GA (January 2007).
- “Intellectual Property Law Basics for Accountants,” Sandy Springs, GA (August 2007).
- “Due Diligence for Intellectual Property in Angel Investment Transactions,” Georgia Centers of Innovation and Lanier Technical College Manufacturing Development Center, Gainesville, GA (December 2007).
- “Trademark Law Update”, Georgia State Bar IP Institute, Cancun, Mexico (November 2006).
- “Intellectual Property Basics for Law Students”, John Marshall School of Law (November 2006).
- “Intellectual Property Asset Management: Best Practices for In-House Counsel”, 2006 Georgia IP SpringPosium®, Young Harris, GA (April 2006).
- “*Best Practices in Patent Opinion Drafting*,” State Bar of Georgia Intellectual Property Law Section, Atlanta, GA (March 2006).
- “*Intellectual Property & You: A Crash Course for the Business World*,” Emory University Graduate School of Business, Atlanta, GA (March 2006).
- “*Trademark Law Basics*,” Georgia State Mid-Year Meeting, Atlanta, GA (January 2006).
- “*Trademark Law Case Update*,” IP Institute, Georgia State Bar IP and Entertainment Law Sections, San Juan, Puerto Rico (November 2005).
- “*Developments in Patent Opinion Practice and Litigation Tactics in View of Knorr-Bremse v. Dana Corp.*,” SpringPosium 2005, Chateau Elan, Braselton, GA (April 2005).
- “*Trademark Law for Business*,” Trademark Law Committee of Georgia State Bar Intellectual Property Section, Atlanta, GA (April 2004).
- U.S. Patent No. 7,044,679, Inventor (November 2002).
- “*Intellectual Property Basics for Business*,” Connect Cobb, insert to Atlanta Journal-Constitution (September 2001).
- U.S. Patent No. 6,129,265, Co-Inventor with D. Perryman (October 2000).
- “*Patent Protection for Business Methods*,” Georgia Bar Journal (February 2000).
- “*Appeal of an Adverse Markman Hearing*,” 15 A.I.P.L.A. Selected Legal Papers 193 (October 1996).
- “*Bare Fisted Competition or Palming Off? Protection of Product Design as Trade Dress Under the Lanham Act*,” 23 A.I.P.L.A. Q.J. 65 (Winter 1995).
- “*Burned if We Do-Burned if We Don’t: Treatment of Municipal Incinerator Ash Under RCRA’s Household Waste Exclusion*,” 27 Georgia Law Review 555 (Spring 1993).