

David W. Long



ESSENTIAL PATENT LLC

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Overview

David has over twenty years of experience litigating complex patent issues in the telecommunications industry ranging from simple matters to high-stakes litigation. He was a judicial law clerk at the U.S. Court of Appeals for the Federal Circuit and has substantial experience leading litigation in federal courts and in the U.S. Patent & Trademark Office (“PTO”). His experience includes balancing parallel proceedings in multiple courts and the PTO. He counsels domestic and international clients on patent licensing, product redesigns, trade secrets and other legal issues in telecommunications, electronic circuits, microchips, computer and other high-tech industries.

David is a thought leader in the patent community. He has been appointed leadership responsibilities in international and national professional intellectual property organizations. The media frequently seeks his views and he often is invited to speak on significant patent law developments. Congress and the White House have sought his views on patent policy issues. He is globally recognized as a thought leader on standard essential patents. He founded the Essential Patent Blog, which is followed by decision makers in industry, the judiciary and competition authorities throughout the world.

Before entering the legal profession, David earned a master’s degree in electrical engineering and has several years of technical industry experience working in telecommunications, software/hardware design, control systems and rocket science.

Education

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| University of Alabama School of Law, Juris Doctorate (<i>magna cum laude</i>) | 1995 |
| <ul style="list-style-type: none">Alabama Law Review | |
| Auburn University, Masters of Science in Electrical Engineering | 1990 |
| <ul style="list-style-type: none">Federal Bureau of Investigation Honors InternGraduate Teaching Assistant (Microprocessor, Communications & Controls Labs)Thesis: <i>Speech Prosthesis from Secondary Myoelectric Signals</i> | |
| Auburn University, Bachelors of Electrical Engineering (with Honor) | 1987 |
| <ul style="list-style-type: none">Eta Kappa Nu Electrical Engineering Honor SocietySigma Pi Sigma Physics Honor SocietyTau Beta Pi Engineering Honor SocietyCooperative Education Engineering Student Program (Universal Data Systems) | |



Court and Other Admissions

State Bars: Virginia, District of Columbia, Alabama (inactive)

U.S. Appellate Courts: Supreme Court and Federal Circuit

U.S. District Courts: D.D.C., E.D. Va., D. Md. and W.D. Wis.

Other: U.S. Patent & Trademark Office and U.S. Court of Federal Claims

Professional Activities

Sedona Conference

- Co-Leader WG 9, Standard Essential Patent/FRAND Working Group (2015 to present)

American Intellectual Property Law Association

- Amicus Committee (2017 to present)
- Chair of Standards and Open Source Committee (2014 to 2017)
(2016 Committee of the Year as Committee Chair)
- Chair of Programs for Standards and Open Source Committee (2012 to 2014)

Intellectual Property Owners Association

- Vice-Chair of Standards Setting Committee (2018 to present)
- Vice-Chair of Litigation Committee (2010 to 2017)
(2013, 2015 Committee of the Year as Vice-Chair of Committee)

Bar Association of the District of Columbia

- Board Member (2006 to 2009 and 2011 to 2017)
- Chair or Officer of Patent, Trademark and Copyright Section (2002 to 2006)
(2005/2006 Outstanding Bar Section Award as Section Chair)

Technical Experience

Dynetics, Inc. (Huntsville, AL) **1990 to 1992**

Rocket Scientist. Engineering work studying foreign hardware and developing software to simulate missile guidance systems and analyze data communication signals.

Auburn University School of Electrical Engineering (Auburn, AL) **1988 to 1990**

Graduate Teaching Assistant. Instructor for various engineering labs dealing with microprocessors, communications and control systems.

EPOS, Inc. (Auburn, AL) **1987 to 1988**

Research Engineer. Engineering work developing software and analyzing radar data and other communication signals.

Universal Data Systems (Huntsville, AL) **1983 to 1985, 1988**

Summer Engineer (1988) and Cooperative Education Engineering Student (1983 to 1985). Designed data communications hardware and software, such as modems, during alternating quarters while pursuing engineering degree.

Other Experience

Federal Bureau of Investigation (Washington, DC) **Summer 1989**

Honors Intern. Accepted into competitive program for prospective special agent candidates. Worked on state of the art surveillance equipment.

University of Alabama Student Housing (Tuscaloosa, AL) **1992 to 1994**

Hall Director. Responsible for managing student dormitory.

Auburn University Student Housing (Auburn, AL)

1987 to 1990

Hall Director. Responsible for managing Auburn's first coed student dormitory.

Pro Bono

Amicus Briefs (Washington, DC) —

Represented amicus on a pro bono basis for intellectual property law bar organizations on important patent issues, including the American Intellectual Property Law Association, Intellectual Property Owners Association and the Bar Association of the District of Columbia.

Asylum (Washington, DC) **2008**

Successfully obtained asylum for an Iraqi attorney, his wife, new born daughter and brother. Iraqi insurgents had kidnapped and tortured the attorney and his brother because they were helping American troops in Iraq.

Huntsville Emergency Medical Services, Inc. (Huntsville, AL) **1990 to 1992**

Volunteer First Responder Emergency Medical Technician. First on scene for medical emergencies such as a car accident, gunshot or heart attack.

Crisis Center (Auburn, AL) **1987 to 1990**

Volunteer Trainer and Listener. Trained volunteers ("listeners") to deal with callers to the local suicide hotline in a college town.

Publications

- Essential Patent Blog (www.essentialpatentblog.com) (Founder/Editor)
- *Framework for Analysis of Standard-Essential Patent (SEP) and Fair, Reasonable, and Non-Discriminatory (FRAND) Licensing and Royalty Issues (Stage One)*, The Sedona Conference (Feb. 2018) (Chapter Editor)
- *Litigating Standard Essential Patents at the U.S. International Trade Commission*, The Sedona Conference Journal (Nov. 2016)
- *Litigating Standard Essential Patents in the U.S. International Trade Commission*, American Intellectual Property Association (Jan. 2016)
- *Federal Circuit Provides Guidance on Royalty Determination for Standard Essential Patents*, The Licensing Journal (Jan. 2016)
- *Case Management Issues Involving Standard Essential Patents: U.S. International Trade Commission*, Sedona Conference (Oct. 2015)
- *Black's Law Dictionary* 9th Ed. (Panel of Practicing Contributors)
- *The Winning Brief* 2d Ed. by Brian Garner (Contributing Practitioner at 327, 329)
- *Fujitsu v. Tellabs: Jury Finds that Patent Holder Breached RAND Obligation and Must Show Cause Why Patent Should Not Be Held Unenforceable*, IP Litigator (Sep./Oct. 2014)
- *Apple Defeats ICom's Patent Infringement Claim: A Look Inside the Tech Giant's Mannheim Regional Court Victory*, Bloomberg BNA (Mar. 2014)
- *The So-Called "Patent Troll" Problem: Dealing With Non-Innovating, Non-Practicing Patent Monetization Entities*, The Metropolitan Corporate Counsel (Feb. 2014)
- *Proposed Cost-Shifting in Patent Infringement Cases*, InsideCounsel (Oct. 17, 2013)
- *Protecting "End Users" from Patent Infringement Actions*, InsideCounsel (Sep. 18, 2013)
- *Establishing Federal Rules of Patent Procedure*, InsideCounsel (Aug. 20, 2013)
- *Design Patents May Be Next Troll Target*, Today's General Counsel (June/July 2013)
- *The Implications of Patent Rulings with Limited Remedies*, Wall Street Journal's All Things Digital (Jan. 30, 2013)



- *Navigating the Sea of Change in US Patent Law*, New Legal Review (Apr. 4, 2012)
- Federal Circuit Bar Journal (Editorial Board 2005)
- *Safeguarding Advice From Lawyers*, The National Law Journal (Oct. 11, 2004)

Public Speaking

- *What does U.S. case law tell us about standard essential patent licensing?*, Licensing Executives Society (Mar. 21, 2018)
- *Valuing and Enforcing SEPs Globally: Is There An International Consensus As To What “FRAND” Is?*, The Sedona Conference on International Patent Litigation: Aspirations Toward Attaining Effective Global IP Protection (Feb. 26, 2018)
- *Update on Standard Essential Patent Litigation*, Intellectual Property Owners Association Litigation Committee (Dec. 21, 2017).
- *Patent Damages in SEP Cases and Court Adjudication*, Jindal Initiative on Research in IP and Competition (Nov. 5, 2017)
- *Mediating IP Matters: Winning Without Winning Everything*, American Intellectual Property Law Association Annual Meeting (Oct. 19, 2017)
- *A Patent By Any Other Name: A Framework To Analyze Standard Essential Patents*, Chinese National Federation of Industries (Aug. 23, 2017)
- *Licensing Standard Essential Patents after Microsoft v. Motorola*, DRI Intellectual Property Litigation Seminar (May 11, 2017)
- *FRAND and SEP – Effective Case Management To Focus The Issues and Advance the Litigation*, The Sedona Conference WG9 and WG10 Joint Annual Meeting 2017 (Feb. 27, 2017)
- *IP/Antitrust Issues: Thoughts about SEPs and Non-SEPs*, American Intellectual Property Law Association Mid-Winter Institute (Feb. 2, 2017)
- *FRAND/SEP Litigation – Policy Struggles. Sorting out today’s problems*, Naples Round Table (Jan. 16, 2017)
- *The Role of Comity & Cooperation in Global Antitrust*, University of Southern California Gould School of Law Global Antitrust Symposium (Jan. 13, 2017)
- *Partnering in Standards & Open Source*, American Intellectual Property Association (Oct. 25, 2016)
- *Standards Setting and IPR: United States and China*, University of California, Berkeley (Mar. 28, 2016)
- *Update on e-Discovery and Local Court Rules on Discovery*, American Intellectual Property Law Association (Feb. 23, 2016)
- *Case Management in Standard Essential Patent Litigation*, Sedona Conference (Feb. 11, 2016)
- *FRAND Obligations and Standard Essential Patents at the ITC*, American Intellectual Property Law Association (Jan. 28, 2016)
- *Antitrust/Standards & Open Source Committee Program on International Issues Concerning Standard Essential Patents*, American Intellectual Property Law Association (Oct. 22, 2015)
- *Partnering in Standards and Open Source Software*, American Intellectual Property Law Association (Oct. 21, 2015)
- *Administering Justice – Practical Case Management Considerations in Litigating Standard Essential Patents*, The Sedona Conference (Oct. 20, 2015)

- *The 15th Annual Sedona Conference on Patent Litigation: Improving the Efficiency of Handling Patent Litigation*, The Sedona Conference, Co-Chair for Conference (Oct. 19-20, 2015)
- *Standards and FRAND: Important Developments in U.S. and Europe*, Intellectual Property Owners Association (Oct. 13, 2015)
- *Best Practices In Patent Litigation: What Practitioners Need To Know Given Recent Procedural Changes*, Intellectual Property Owners Association (Sep. 28, 2015)
- *How Investors Assess Startups*, Congressional Inventions Caucus Meeting (July 9, 2015)
- *FRAND/SEP: Defining the Issues In Controversy and Proposing The Scope For A Productive Sedona Commentary on the Subject*, Sedona Conference (May 19, 2015)
- *H.R. __, Targeting Rogue and Opaque Letters (TROL) Act*, U.S. House of Representatives Committee on Energy & Commerce, Subcommittee on Commerce, Manufacturing, and Trade (Apr. 16, 2015)
- *Smartphones and the Patent Battleground: Is Peace at Hand?*, American Bar Association (Intellectual Property Law Section) (Mar. 25, 2015)
- *The Future of Standards: What's Next After the IEEE Shift*, Intellectual Property Law Association (Mar. 18, 2015)
- *Complying with FRAND Obligations: Guidance from Recent Cases for Setting FRAND Terms*, Law Seminars International (Oct. 30, 2014)
- *Practical Considerations in Litigating Standard Essential Patents*, American Intellectual Property Law Association (Oct. 23, 2014)
- *Understanding Patent Assertion Entities: Defense Strategies and Solutions for Your Company*, Commercial Law WebAdvisor (May 8, 2014)
- *Voluntary Standards in the Patent World: Opening the Door to Antitrust Litigation*, PECIS 2014 Spring Meeting (April 3, 2014)
- *Lessons Learned From Litigated Royalty Rates on Standard Essential Patents*, Kelley Drye Webinar (Oct. 17, 2013)
- *Practical Considerations & Industry Perspectives in Applying Recent FRAND Rulings*, American Intellectual Property Law Association (Aug. 7, 2013)
- *Standard Essential Patents at the ITC: Samsung and Apple*, Intellectual Property Owners Association (July 11, 2013)
- *Standard Essential Patents: Implications of the FTC-Google Consent Decree*, Intellectual Property Owners (Mar. 5, 2013)
- *The FRANDly Fall of 2012*, American Intellectual Property Law Association (Dec. 10, 2012)
- *America Invents Act: A Brief Introduction to Post-Grant and Inter Partes Review*, National Institutes of Health (June 27, 2012)
- *Cardiac Pacemakers and Section 271(f) Infringement*, Women's Bar Association and Bar Association of the District of Columbia (Oct. 30, 2009)
- *Patent Law Update: Can You Patent That, Who Cares What My Attorney Thinks and Did We Really Agree To That?*, Washington Metropolitan Area Corporate Counsel Association (Dec. 4, 2008)
- *What's New in Patent, Trademark and Insurance Coverage Law*, Washington Metropolitan Area Corporate Counsel Association (Apr. 17, 2008)
- *Reexaminations and Permanent Injunctions*, Practising Law Institute (Aug. 3, 2007)
- *Pre-Suit Investigation Reasonable Inquiry*, American Intellectual Property Law Association (Jan. 25, 2007)
- *eBay and Its Aftermath on Patent Injunctions*, Virginia State Bar Intellectual Property Section (Sep. 9, 2006)

- *The Supreme Court's Review of Obviousness in KSR Int'l v. Teleflex*, American Intellectual Property Law Association and George Washington University Student IP Law Association (Oct. 5, 2006)
- *Global Reach of US Patent Law*, Intellectual Property Institute of Canada (Sep. 27, 2006)
- *Enforcing IP Rights: Where are the borders?*, International Law Association, Toronto, Canada (June 7, 2006)
- *Patent Office's Proposed Rule Changes to Improve Patent Prosecution*, Bar Association of the District of Columbia (Patent, Trademark & Copyright Section) (2006)
- *Illinois Tool Works and Tying: Impact and Implications*, American Bar Association (May 19, 2006)
- *A Practitioner's Guide to eBay and Its Aftermath*, American Intellectual Property Law Association (Oct. 22, 2006)
- *Avoiding Patent Pitfalls in Doing Business in the US*, Canadian Information Technology Law Spring Training Program, Toronto, Canada (May 11, 2005)
- *The Effect of the Federal Circuit's Recent Decision in Knorr-Bremse v. Dana Corp. on Opinions of Counsel and a Discussion of the Positions Argued by Amicus Curie in the En Banc Rehearing of Phillips v. AWH Corp.*, Bar Association of the District of Columbia (Patent, Trademark & Copyright Section) (2004)
- *Intellectual Property Symposium Hot Topics in Copyrights & Patents*, Duke University (Mar. 21, 2003)

News/Media

- *4 Things To Know About The Latest FRAND Rate-Setting Case*, IP Law360 (Jan. 4, 2018)
- *What the Nokia-Apple Lawsuit Means for the Streaming Industry*, streamingmedia.com (Dec. 30, 2016)
- *Procter & Gamble Sues Edgewell for Patent Infringement*, Wall Street Journal (Aug. 23, 2016)
- *US FRAND litigation more focused on damages than injunctions -- analysis*, PaRR (Aug. 23, 2016)
- *7 Popular Patent Law Writers to Follow Right Now*, JD Supra Business Advisor (Oct. 29, 2015)
- *Patent Wars Cooling? Microsoft, Google End 5-Year Dispute*, Bloomberg TV (Oct. 1, 2015)
- *3 Takeaways From 9th Circ.'s Motorola FRAND Decision*, IP Law360 (July 30, 2015)
- *Recent Rulings Shed Light On Fed. Circ's Approach To Teva*, IP Law360 (June 29, 2015)
- *Attys React To High Court's Induced Infringement Ruling*, IP Law360 (May 27, 2015)
- *Fed. Circ. Makes Joint Patent Infringement Tough To Prove*, IP Law360 (May 13, 2015)
- *ITC judge spells out finding of Nokia's 'reverse hold-up' against InterDigital*, mlex (May 12, 2015)
- *Google to License Wireless Technology Amid Industry Row on Rates*, Bloomberg News (Apr. 9, 2015)
- *9th Circ. Could Shape FRAND Patent Law in Motorola Case*, IP Law360 (Apr. 6, 2015)
- *New HEVC Patent Pool: What Are the Implications*, Streaming Media Magazine (Apr. 1, 2015)
- *Court to Tally Samsung's Costs for Using Apple iPhone Features*, Bloomberg News (Mar. 3, 2015)
- *Patent Owners Take Hit With Standard-Setting Body's Rules*, IP Law360 (Feb. 9, 2015)
- *Court Steps Into Patent Debate That Split Technology Companies*, Bloomberg News (Dec. 5, 2014)

- *Patent System Benefits From Supreme Court Guidance In Alice v. CLS Bank*, Metropolitan Corporate Counsel (Nov. 2014)
- *Akamai Case May Be 1st Step Toward Joint Infringement Rule*, IP Law360 (Sep. 10, 2014)
- *Lawyers Weigh In On High Court's Software Patent Ruling*, IP Law360 (June 19, 2014)
- *Lawyers Weigh In On High Court's Induced Infringement Ruling*, IP Law360 (June 2, 2014)
- *Lawyers Weigh In On High Court's Patent Ruling On Attorneys' Fees*, IP Law360 (Apr. 29, 2014)
- *Teva Gets Supreme Court Hearing on Generic Copaxone Delay*, Bloomberg News (Mar. 31, 2014)
- *Apple's Loss On Samsung Ban Shows Bar May Be Too High*, IP Law360 (Mar. 6, 2014)
- *Patent Attacks Expand With Industry's Reliance On Technology*, Multichannel News (Nov. 4, 2013)
- *Who Loses in the White House Patent Decision?*, Bloomberg TV (Aug. 6, 2013)
- *iPhone Reprieve Seen Aiding Apple Sales, Hurting Samsung*, Bloomberg News (Aug. 5, 2013)
- *How Important is ITC Apple-Samsung Ruling*, Bloomberg TV (May 31, 2013)
- *Vt's Historic Fight On Patent Trolls May Fall Flat*, IP Law360 (May 29, 2013)
- *After Court Ruling, US Still in Disarray On Software Patents*, Intellectual Property Watch (May 20, 2013)
- *Patent Court Torn On Whether Software Deserve Patents*, Bloomberg News (May 10, 2013)
- *Dow Lohnes' Long: Motorola Has Decades Of Patents*, Bloomberg TV (Apr. 29, 2013)
- *Google emerges from FTC antitrust probe largely unscathed*, Inside Counsel (Mar. 26, 2013)
- *ITC Clears Microsoft's Xbox in Patent Case*, Wall Street Journal (Mar. 22, 2013)
- *Google antitrust settlement reshapes patent disputes*, IT World (Jan. 4, 2013)
- *Apple, Samsung Inch Toward End of Smartphone Patent Fight*, Bloomberg News (Dec. 18, 2012)
- *Samsung Mocking Apple in Ads Looks to Win Cheech and Chong Test*, Bloomberg News (Oct. 22, 2012)
- *Samsung and Apple Patent War*, Bloomberg TV (Sep. 14, 2013)
- *Apple Counts on iPhone Being Too Cool for US Import Ban*, Bloomberg News (Aug. 24, 2012)
- *Lawyers at \$1,200 an Hour Booming as Apple Confronts Foes*, Bloomberg News (Aug. 23, 2012)
- *Google's \$12 Billion Apple Defense Tested by Patent Cases*, Bloomberg News (Apr. 20, 2012)
- *A Pivotal Fight Over 'Essential Patents'*, Wall Street Journal (May 7, 2012)
- *Implications of Quanta Patent Exhaustion*, MyTechLawyer Radio (July 17, 2008)
- *Impact of Microsoft v. AT&T Golden Master Case*, MyTechLawyer Radio (Aug. 2, 2007)
- *Patent Litigation: Lessons from a RIM patent vet*, The Globe & Mail (June 14, 2006)
- *NTP Filing Accuses U.S. Patent Office of Bias in Reexam*, Dow Jones (June 9, 2006)
- *In Patent Disputes, A Scramble to Prove Ideas Are Old Hat*, Wall Street Journal (Jan. 25, 2006)

Representative Litigation

- Patent Monetization Entities. Represent high-technology companies in negotiations with various patent monetization entities including Rockstar, Innovatio, Digimedia, LaserDynamics, Helferich and numerous others.

- *LaserDynamics USA, LLC v. Advanced Duplication Services, LLC* (S.D.N.Y.), Defend ADS in patent infringement case involving DVD formats.
- *WAG Acquisition v. Coolvision Ltd, et al.* (D.N.J.), Defend Coolvision in patent infringement case involving streaming video over the Internet.
- *Bright Response v. Infosys Ltd.* (E.D. Tex.), Defend Infosys in patent infringement case concerning computer automated contextual interpretation of email.
- *Cambrian Science v. Cox Communications, Inc., et al.* (C.D. Cal), Defend CCI in patent infringement case involving photonic integrated circuits.
- *Digimedia v. Cox Radio, et al.* (D. Del.), Defend Cox Radio in patent infringement case involving digital music broadcast systems, including parallel reexamination challenges to the patents in the PTO.
- *Teles AG v. Cisco Systems* (D.D.C./D. Del.), Represent patent owner in a patent infringement case involving VoIP technology.
- *Teles AG v. Quintum Technologies* (D. Del.), Represent patent owner in a patent infringement case involving VoIP technology.
- *Technologies Patents LLC v. Motorola, et al.* (D. Md.), Defend Motorola in patent infringement case involving international text messaging.
- *Broadcom v. Qualcomm* (ITC/S.D. Cal.), Defend Qualcomm in patent infringement case involving power management and multiplexing in wireless phone system, including parallel reexamination challenges to the patents in the PTO.
- *Rasterex Holdings v. Research In Motion* (Ga. Sup. Ct.), Defend Research In Motion in a trade secrets case involving software for converting and displaying files on wireless device.
- *Matsushita Electric v. Samsung Electronics* (Fed. Cir.), Defend Samsung Electronics in a patent infringement case involving memory chip design.
- *Toshiba v. Samsung Electronics* (ITC/D.N.J.), Defend Samsung Electronics in patent infringement case involving memory circuit design and manufacture.
- *NTP v. Research In Motion* (E.D. Va./Fed. Cir.), Replace trial counsel after unfavorable verdict and defend Research In Motion in a patent infringement case involving wireless mobile email system, including parallel reexamination challenges in the U.S. Patent & Trademark Office.
- *On Demand Machine Corp. v. Ingram Industries* (Fed. Cir.), Defend Ingram Industries in a patent infringement case involving on-demand book publishing systems, including filing parallel reexamination challenge in the PTO.
- *ePlus v. Ariba* (E.D. Va.), Defend Ariba in patent infringement case involving electronic database systems.
- *Linear Tech. v. Impala Linear Corp.* (Fed. Cir.) Defend Linear Tech. in a patent infringement case involving switching voltage regulators.
- *Verizon California v. Ronald Katz Tech.* (N.D. Cal.) Defend Verizon California in a patent infringement case involving interactive telephone call processing systems.
- *Applied Medical Resources v. U.S. Surgical* (C.D. Cal./Fed. Cir.) Represent patent owner Applied Medical Resources in a patent infringement case involving trocar floating seals for minimally invasive surgery
- *Applied Medical Resources v. Core Dynamics* (C.D. Cal.) Represent patent owner in a patent infringement case involving trocar floating seals for minimally invasive surgery.
- *Symbol Techs. v. Lemelson Medical, Education & Research Foundation* (Fed. Cir.) Represent amicus National Retail Federation in a patent infringement case involving bar code readers, which amicus brief was credited for Federal Circuit granting interlocutory appeal on prosecution laches defense.

- *Applied Medical Resources v. U.S. Surgical* (E.D. Va./Fed. Cir.) Represent patent owner in a patent infringement case involving trocar floating seals for minimally invasive surgery.
- *Motorola v. Qualcomm* (S.D. Cal.) Represent patent owner and defendant Qualcomm in a patent infringement case involving mobile phone circuit design and wireless protocols.
- *Steelcase v. Haworth* (D. Mich.) Defend Haworth in a patent infringement case involving office furniture.
- *Wytttenbach v. Atoma Int'l and Toyota Motor Corp.* (Fed. Cir.) Defend Atoma Int'l in a patent infringement case involving child car seats.
