



SCOTT W. CUMMINGS

Partner

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BIOGRAPHY

Scott Cummings is a highly regarded lawyer focused on patent law and intellectual property litigation. Scott has compiled an impressive list of victories for both patent owners and patent challengers in United States Patent Office post-grant proceedings and previously led a global law firm's post-grant practice. IAM Patent describes Scott as "a PTAB expert and has an excellent track record in IPRs." He is also an avid speaker, writer, and thought leader on intellectual property and patent matters.

He works with clients from startups to multinational corporations across sectors including computer hardware and software technology, life sciences, clean and renewable energy, nanotechnology, metallurgy, polymer chemistry, inorganic chemistry, and automotive technologies.

As a former primary examiner for more than eight years at the United States Patent and Trademark Office (USPTO), Scott holds a strong track record achieving favorable results in representations for clients in *ex parte* and *inter partes* proceedings, and in federal district courts. His extensive knowledge of USPTO operations and procedure is relied upon by many companies as he is able to distill and develop complex concepts in inter partes reviews (IPRs), post grant reviews (PGRs), written and oral interagency appeals, petitions, as well as lead reexamination, reissue and interference proceedings. He also advises clients on issues involving freedom to operate, patent infringement, patent validity and design-around analyses. Scott's right mix of litigation and USPTO experience provides clients an integrated and comprehensive approach to parallel proceedings before district courts and in USPTO post-grant proceedings.

CIVIC INVOLVEMENT & HONORS

- *IAM Patent 1000: The World's Leading Patent Professionals, 2022-2023*
- Named an "IP Star" by *Managing IP's Guide, Euromoney Legal Guide, 2013-2022*

PROFESSIONAL AFFILIATIONS

- American Intellectual Property Law Association (AIPLA)

ADMISSIONS

- District of Columbia, 1998
- Virginia, 1995
- U.S. Patent & Trademark Office, 1997
- U.S. Court of Appeals, Federal Circuit

EDUCATION

- American University, J.D., 1995
- North Carolina State University, B.S., 1988

RELATED PRACTICE AREAS

- Intellectual Property and Technology

- Litigation & Dispute Resolution
- Regulation, Compliance & Advisory

EXPERIENCE

USPTO Proceedings

- Successful first-chair representation of the owner of two patents directed to recreational wave pool technologies, convincing the PTAB that the Petitioner failed to establish that it could successfully demonstrate unpatentability, thus obtaining a decision denying institution of trial in both cases – an outcome that is achieved in only 30% of such cases.
- Successful first-chair representation of Petitioner in two IPRs directed to patents involving remote monitoring and activation of traps for feral pigs. Successfully instituted two trials challenging the validity of all claims of the two patents at issue, resulting in a stay of the related district court proceeds. Responsible for all aspects of completed PTAB trial, including pre-filing strategy, petition drafting, discovery, briefing and oral argument. After fully trying both cases, the Patent Office issued its final decision, confirming that each and every challenged claim was invalid – thus achieving a complete victory for the client, with only a fraction of the legal fees that would have been incurred had the question of validity been litigated in district court.
- Successful first-chair representation of a patent owner in two IPRs before the Patent Trial and Appeal Board (PTAB) defending an important data storage and synchronization patent. The client had asserted its patent against various defendants in pending district court litigation. One of the defendants launched two attacks against the validity of the patent in highly specialized proceedings before the U.S. Patent & Trademark Office. We obtained a favorable early decision from the PTAB shielding several of the patent claims from further review. After fully trying both cases, the Patent Office issued its final decision in both cases, confirming the validity of every patent claim at issue in both trials – an elusive result historically attained in only 19% of such cases.
- Successful first-chair representation of Petitioner in an IPR of a medical device patent directed to safety needles. Scott had been leading the defense of the client in multiple litigation matters, including charges of patent infringement and other matters relating to the FDA. As part of a coordinated defense strategy, we prosecuted an IPR targeting one of the asserted patents. We successfully argued that the patent infringement litigation be stayed pending the outcome of the Patent Office proceedings, providing the client with substantial cost savings. Ultimately, the PTAB found that all of the claims asserted in the litigation were unpatentable.

- Successful first-chair representation in two concurrent IPRs at the PTAB on behalf of mobile device positioning systems developer as petitioner. Obtained rare grant of second IPR petition of same patent, and defeated standing challenges to both petitions based on real party-in-interest and privity arguments. Responsible for all aspects of completed PTAB trial, including pre-filing strategy, petition drafting, discovery, motions practice, briefing and oral argument. Related copending district court cases were successfully stayed. Completed trial resulting in total victory and binding final written decision in client's favor. Successful patent office representation resulting in settlement of all litigation, including copending district court proceedings.
- Successful first-chair representation of smart home device manufacturer as petitioner in Inter Partes Review. Using leverage created by the presentation of a strong case for unpatentability before the Patent Trial and Appeal Board, our client was able to negotiate settlement on very favorable terms compared to the original demands of the patent owner.
- Successful first-chair representation of smart home device manufacturer as petitioner in Inter Partes Review. Successfully moved for Joinder to existing IPR proceedings.
- Successfully instituted ex parte reexamination on behalf of mobile device positioning systems developer as third party requester.
- Defended a manufacturer of handheld electronics devices casings, as patent owner, in IPR of a patent directed to co-molded hard shell electronics casing technology.
- Defended a supplier of proprietary material handling products and systems in multiple inter partes and ex parte reexamination proceedings. These proceedings involved patents directed to bulk shipping container systems providing reduced residual content upon evacuation. Obtained rare termination of inter partes reexamination proceedings on behalf of patent owner in connection with favorable settlement of related district court litigation. Obtained issuance of favorable reexamination certificate in ex parte proceeding.
- Defended a website translation company in six inter partes reexamination proceedings involving patents directed to website translation technologies.
- Prosecuted, on behalf of a website translation company, an inter partes reexamination of a patent directed to a method of ordering a translation of an electronic communication.
- Represented an athletic shoe manufacturer in an interference proceeding. (*Litchfiled v. Rudy*, Patent Interference No. 104,510, United States Patent and Trademark Office Board of Appeals and Interferences)

District Court

- *Whitewater West Industries, Ltd. v. American Wave Machines, Inc.* (S.D. Calif.) – Representing American Wave Machines in a patent suit regarding air and water pressure systems used in watersports.
- *Jager Pro Incorporated v. W-W Manufacturing Co Inc.* (W.D.Okla.) Representing defendant W-W Manufacturing in this patent infringement matter regarding livestock and wildlife handling equipment..
- *R. Arena Products, Inc. v. Grayling Industries, Inc.* (N.D. Ohio) – Represented a plaintiff in an action for patent infringement related to bulk shipping containers. (, United States District Court for the Northern District of Ohio)
- *Akzenta Paneele + Profile GmbH and W. Classen GmbH & Co., KG v. Brown-West, L.L.C. d/b/a Carpet One Floor & Home, Shaw Industries Group, Inc. and Välinge Innovation AB [f/k/a Välinge Aluminium AB]* (E. D. Texas) – Represented a defendant in a patent infringement action concerning mechanical locking systems for floor panels. United States District Court for the Eastern District of Texas)
- *Välinge Innovation AB Pergo AG, Pergo AB, and Pergo LLC* (D. Ct. Del.) – Represented a plaintiff in a patent infringement action concerning mechanical locking systems for floor panels. ()
- *Napasol AG v. Cosmed Group, Inc.* (N.D. Iowa) – Represented counterclaim plaintiff and patentee Cosmed in a patent infringement case concerning steam pasteurization equipment and methods.
- *Ivoclar Vivadent, Inc. Shofu Inc. et al.* (W.D.N.Y.) – Represented dental company Ivoclar Vivadent in this patent infringement suit regarding silicate glass materials used in veneers and ceramic frameworks. The matter settled favorably.

RESOURCES

PUBLICATIONS

- Co-author, "[Winning An Unwinnable PTAB Rehearing](#)," *Law360*, January 8, 2020
- Co-author, "[Decisions From Administrative Law Judges Must Be Reviewable by Presidentially Appointed Principal Officers](#)" Dentons client alert, June 25, 2018
- Co-author, "[Federal Circuit finds no state sovereign immunity, expands reach of time bar for *inter partes* patent review](#)," June 19, 2019

- Co-author, "Dismissal of patent infringement complaint without prejudice does not reset inter partes review time bar," Dentons client alert, August 21, 2018
- Co-author, "Supreme Court rules inter partes reviews are constitutional and expands scope of their review," April 27, 2018
- Co-author, "Where PTAB Reform May Be Headed," *Law360*, March 26, 2018
- Co-author, "US Patent Office refuses to apply doctrine of tribal immunity as a defense in inter partes review proceedings," March 1, 2018
- Co-author, "Federal Circuit reverses course, ruling time-bar defense to inter partes review is appealable," Dentons client alert, January 9, 2018
- Co-author, "Patent Office to implement substantial fee increases for post-grant review proceedings," Dentons client alert, November 15, 2017
- Co-author, "Federal Circuit splits on deference to agency rules," October 9, 2017
- Co-author, "Supreme Court to consider constitutionality of inter partes reviews," June 12, 2017
- Co-author, "Supreme Court to review policy of partial institution of *inter partes* reviews," May 25, 2017
- Co-author, "Federal Circuit applies pre-AIA interpretation of on-sale bar to the America Invents Act," May 3, 2017
- Co Author, "Federal Circuit to review availability of appeal of Patent Trial and Appeal Board institution decisions," January 6, 2017
- Co-author, "The Third Wave of Changes Under the America Invents Act," *AIPLA Newsstand*, February 2013
- Author, "Having One's Cake and Eating It Too In Post-Grant Review," *IP Law360*, October 2012
- Co-author, "Challenges of the New Post-Grant Review Proceedings," *AIPLA Newsstand*, September 2012
- Co-author, "Now May Be the Best Time to File a Request for Patent Reexamination," *AIPLA Newsstand*, August 2012
- "The Role of Trade Secrets in Today's Nanotechnology Patent Environment," *Nanotechnology Law & Business*, January 2008
- "How Successful Startups Capitalize on IP," *Nanotechnology Magazine*, IEEE, December 2007

- "The Lack of Standards for Accurately Characterizing Nanomaterials and its Impact on the Patent System," *Intellectual Property Today*, September 2005

SPEAKING ENGAGEMENTS

- Moderator, "Patent Strategies at the Patent Trial and Appeal Board - One and Done: Latest Efforts to Reform Patent Challenges Before the PTAB," ABA Intellectual Property Law Section Annual Meeting, April 2019
- Presenter, "Multiple Parties and Proceedings at the PTAB," IPO Post-Grant Patent Office Practice Committee meeting, November 2017
- Presenter, "Trolls, the Supremes and the Pendulum Swing," Korea – US Cooperative Conference for Life Sciences, October 2016
- Presenter, "After Final Consideration Program 2.0," April 2015
- Instructor, "Application Drafting and Provisional Applications," AIPLA Practical Patent Prosecution Training for New Lawyers, 2007 – 2019
- Presenter, "The Life and Adventures of a Patent," September 2014
- Presenter, "Strategic Use of Modern U.S. Patent Office Post-Grant Review Procedures," May 2013
- Presenter, "USPTO Final Rules Implementing First-to-File and Other Provisions of the America Invents Act," March 2013
- Presenter, "Patent Application Drafting Techniques and International Application Filing Strategies," Office of Technology Development of the US National Institutes of Health—National Institute of Allergy and Infectious Diseases, Bethesda, MD, October 2010
- Presenter, "Global Patenting Strategies and Tactics," TechConnect Summit, June 2010
- Presenter, "Commercializing Cleantech," NTSI Nanotech Conference and Trade Show, June 2008
- Presenter, "How to Successfully Capitalize on Your Innovations: An Intellectual Property Workshop," Commercialization of NanoMaterials 2007 Conference, Pittsburgh, November 2007
- Presenter, "Nanotechnology Issues and Trends from a Patent Attorney's Perspective," November 2007
- Panelist, "The Role of the Legal Profession in the Responsible Development of Nanotechnology," American Bar Association Annual Meeting, San Francisco, August 2007

- Panelist, "Discussion of Intellectual Property Issues Affecting Nanotechnology," Commercialization of NanoMaterials 2006 Conference, Pittsburgh, September 2006
- Guest lecturer, "How Obviousness Determinations are Made," Patent Law and Regulation Course, American University Washington College of Law, 2004 – 2009

RELATED INSIGHTS

News

Dec 04, 2023

BCLP wins successful affirmance of patent rights for client American Wave Machines

News

Jul 14, 2023

Partner featured in multiple outlets on move to firm

News

Jun 28, 2023

BCLP Continues Expansion of IP Group with Additional Team of Four