



## Andrew (A.J.) Tibbetts

### Shareholder

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### Education

Rensselaer Polytechnic Institute, BS, Computer Science and Computer and Systems Engineering, *magna cum laude*

Suffolk University Law School, JD, *cum laude*

### Practice Groups

Electrical & Computer Technologies

Licensing & Transactions

Post-Grant Proceedings

A.J. Tibbetts is a leader in protecting intellectual property for software and business methods. He brings his deep technical expertise to representing clients in industries ranging from financial services and mobile applications to speech recognition, machine learning, operating systems, networking and telecommunications (including 3G and 4G cellular standard technologies, and wireless LAN technologies), big data analytics, and more. He counsels clients on IP best practices, navigating acquisitions, transactions including licensing, patent litigation, and challenging validity of patents at the Patent Office through post-grant proceedings. While he works with multiple international and publicly-traded companies, he devotes part of his practice to counseling small and growing companies on IP strategies that will help them achieve their own unique business goals. He has been named multiple times to the Massachusetts list of "Rising Star" attorneys in the field of intellectual property.

A.J. closely studies the current development of the law surrounding patentability of software and best practices for software inventions, which allows him to help his clients protect their inventions in this difficult and rapidly-changing area. He frequently presents on this topic to entrepreneurs, student groups, and other attorneys. A.J. has also assisted with drafting amicus briefs on the patentability of software, which have been cited by the Supreme Court and U.S. Court of Appeals for the Federal Circuit.

Prior to joining Wolf Greenfield, A.J. was a programmer for IBM/Lotus where he worked on development of Lotus Notes. A.J. also worked as a programmer for the retailer Christmas Tree Shops, where his focus was developing a client/server application to analyze sales and inventory data for planning purposes. At Christmas Tree Shops, he was the lead developer and oversaw the whole development cycle for the project, from planning through coding, documentation, testing, and

roll-out. A.J. leverages that experience with enterprise-level software development and customer interaction in developing protection strategies that account for the business context of his clients' work and products.

**Client testimonial:**

"I really appreciate your technical depth—as a software developer myself with an entirely C.S. background, it's been difficult in the past to relay new software concepts when even the foundations are a struggle to communicate. But with you bringing to the table an already in-depth background and experience with software development, it's clear that we were able to discuss just what was new, and you were able to flesh out all of the supporting details—new and old—that we didn't even have to discuss. I greatly appreciate that!"

## Experience

- Manage team of 22 professionals in prosecuting patent portfolio for publicly-traded company with nearly \$2 billion in revenue. Direct team's efforts in both US and international prosecution. Assist client in review of large portfolio and surfacing items to aid evolving business needs.
- Analyze ongoing litigation between industry-dominant supplier of cell-standard-compliant chipsets, competitors, and trade regulators in various jurisdictions. Handicap potential outcomes of the three-continent litigation and potential government responses. Analyze patents identified as standards-essential for various cellular communication standards.
- Lead technical attorney on six-patent district court litigation and related post-grant proceedings at USPTO, in dispute between industry competitors. Led team in identifying patents to assert from client's patent portfolio. Identified strategies that led to multiple wins at USPTO and immediate subsequent settlement of litigation on terms favorable to client. Led settlement negotiations and drafted terms of settlement. Following an end of the litigation, client asked A.J. to take over responsibility for prosecution of its US patent portfolio.
- Lead technical attorney representing defendant in an International Trade Commission (ITC) patent investigation. Key in building successful strategy for dismissing the action under an ineligibility theory—the first time the ITC's fast-track "100 day" program had been used to dismiss an action under ineligibility.

Lead attorney in related USPTO post-grant review that found all pending claims invalid as obvious. Took lead in developing arguments for the petition, preparing declaration with expert to support our client's petition, deposing patent owner's expert, and preparing our client's response to the patent owner's arguments.

- Analyzed software companies' product portfolios to identify key elements that would be most valuable to protect in view of business plan, including exit strategy. Prepared patent applications targeted at those elements.
- Developed IP strategy for a startup company that included preparation of patent applications in stages, as the company progressed through related phases of its business plan. Prepared filings first for a mobile app and subsequently for specialty hardware to operate with that mobile app.
- Developed IP strategy for a biotechnology company releasing a software utility to perform fast genomic analysis.
- Counseled client throughout its life cycle, including in developing original IP strategy for the startup, preparing patent applications as the company grew from the startup to a medium-sized company, defended the company during due diligence, and assisted post-acquisition with educating acquirer on the value of IP.
- Drafted IP provisions for a software development agreement for a US company outsourcing development of a software product to a Southeast Asian company.
- Conducted IP due diligence on the part of the startups being acquired, as well as for multinational looking to acquire startups and to acquire patent portfolios, to assist clients in achieving the best valuation.
- Counseled a client interested in acquiring a large patent portfolio on validity and current value of the portfolio.
- Defended software startup against a "non-practicing entity" accusing the startup of patent infringement. After raising significant questions of non-infringement and invalidity, the startup was able to settle the suit for much less than the accuser originally requested.

- Counseled biotech company on protectability, including patent-eligibility, of a software tool for quickly screening proteins like antibodies to see whether they possess a particular characteristic qualifying them for further clinical evaluation.
- Defended software company against allegations of patent infringement by preparing and filing at the US Patent and Trademark Office repeated challenges to validity of patent our client was accused of infringing. This tactic successfully delayed litigation for years and kept our client's costs low while forcing the accuser to spend time and resources defending their patent.
- Defended large multinational against patent infringement charges from a “patent assertion entity” at the US International Trade Commission (ITC), which included a detailed workup of patent validity and non-infringement positions with a team of technical experts, as well as a parallel effort challenging the validity of the patents at the patent office.
- Counseled undergraduate students commercializing a veterinary medical device that emerged from a class project with applying for patent protection for their projects. Assisted them in negotiating sale of their technology.
- Conducted "freedom to operate" searches for startups planning to expand into new business area to determine risk of infringement accusations.

## Activities

- Boston Patent Law Association
- 2017 Chair of the Boston Patent Law Association's Computer Law Committee
- Institute of Electrical and Electronics Engineers

## Recognition

- Eta Kappa Nu
- Tau Beta Pi
- Upsilon Pi Epsilon
- Repeatedly named to the list of Massachusetts Rising Stars by

## Super Lawyers

### Interests

A.J. served as Editor-in-Chief, Managing Editor, and News Editor of *The Rensselaer Polytechnic*, the student-run weekly newspaper at Rensselaer Polytechnic Institute. He was also an Eagle Scout.