



Edmund J. Walsh

Shareholder

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Ed Walsh has extensive experience representing both patent owners and petitioners before the Patent Trial and Appeal Board and in reexamination proceedings. He also works with electrical and computer-related clients in IP strategy development and execution. His areas of technical proficiency include semiconductor processing and high-speed circuit design, wireless communication and signal processing, networks, and connectors and interconnection technology.

Ed served over 14 years as in-house counsel for technology companies, including Chief Intellectual Property Counsel for Teradyne, a world leader in semiconductor processing equipment. Prior to entering law school, Ed worked as an electrical engineer, managing a team developing vehicle diagnostic equipment and as a researcher at the National Cancer Institute.

Education

Boston University, BS,
Electrical Engineering

Stanford University, MS,
Electrical Engineering

Suffolk University Law
School, JD

Practice Groups

Electrical & Computer
Technologies

Licensing & Transactions

Litigation

Post-Grant Proceedings

Client testimonial:

"Ed knows the business and knows the players, and that's invaluable."

Experience

- Lead counsel in first of its kind successful defense of a patent challenged in inter partes review accepting commercial success of the invention as proof of patentability.
- Defeated institution of inter partes review to five patents being asserted, setting up a jury verdict by a Wolf Greenfield litigation team.
- Won a decision in an inter partes reexamination, invalidating all claims to an internet ordering patent, ending a suit against our client.

- Invalidated in an inter partes reexamination all claims to a patent asserted against our client, turning the tables on the patent owner who was left facing a breach of contract claim.
- Persuaded examiners in an *ex parte* reexamination of patent underlying one of the largest patent verdicts ever to reverse course and confirm all claims as patentable, preserving a significant our damage award for our client.
- Represented a publicly traded client in IP diligence associated with acquisition of a competitor, in a transaction valued in ten figures.
- Lead counsel in sale by our client of software product line in a transaction valued in eight figures.
- Conducted due diligence in support of an investment in a company improving FLASH memories through application of signal processing techniques.
- Developed a position to prove a client was entitled to participate in a patent pool associated with a significant wireless communication standard.
- Designed licensing and patent portfolio program resulting in leading technology client's use of competitors to sell its product to gain market acceptance while retaining benefits of technology investment.
- Guided client in responding to demand for nine figure payment from patentee holding over 100 patents relating to wireless technology, evaluated whether portfolio represented threat or opportunity, and negotiated satisfactory resolution with patent holder.

Activities

- American Bar Association
- Boston Patent Law Association - Co-chair, Computer Law Committee
- Institute of Electrical and Electronics Engineers
- MIT \$100K - Mentor
- University of Massachusetts Amherst - Guest Lecturer at the Isenberg School of Management; Technology Innovation

Challenge, judge

- Intellectual Property Owners Association - Corporate IP Management Committee

Recognition

- Repeatedly included in *The Best Lawyers in America*© (IP Law)
- National Science Foundation Fellow
- Repeatedly named to Massachusetts Super Lawyers list

Interests

Ed was an Adjunct Professor and Lecturer in electrical engineering at Boston University. He has been active in local politics in the town of Northborough, is a member of the Sudbury Valley Trustees, is a trustee at First Parish Church, and is an avid lacrosse fan.