



James H. Morris

Shareholder

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Education

Queens College of The
City University of New
York, BA, Physics

City College of The City
University of New York,
BE, Electrical
Engineering

Suffolk University Law
School, JD, *cum laude*

Practice Groups

Electrical & Computer
Technologies

Mechanical Technologies

Post-Grant Proceedings

James Morris brings three decades of experience in patent prosecution, opinion, and counseling work in the electrical, electromechanical, computer, software, and optical arts to his practice. He works with companies and research institutions in the biomedical, medical device, and bioinformatics fields. He has experience in semiconductors, quantum computing and quantum information technologies, and telecommunications. He works in particular with technologies that lie at the intersection of life sciences and software, such as the application of big data analysis to disease diagnosis and treatment, algorithms for compound identification, and software for analysis and modeling of biological processes. He represents a full spectrum of business entities including multinational companies, medium-size companies, non-profits and research institutions, and individual inventors.

James regularly evaluates other competitors' technologies and patent portfolios and advises clients on potential risks and opportunities. James also counsels clients with respect to strategic portfolio development and different types of intellectual property protection strategies. He has particular experience in semiconductors, memory, semiconductor manufacturing, MEMS, analog and digital circuits, optical switches, software, electromechanical systems and devices, and computer related inventions.

James has successfully argued a number of cases before the Board of Patent Appeals and Interferences and has also represented clients in mediations and negotiations.

Prior to joining the firm, James worked as an electrical engineer. He held positions as an audio/visual systems designer, hardware design engineer, and research and development engineer. During his engineering career, he designed memory systems and associated

control circuits, control systems for presentation facilities, audio and video systems, motor control circuits, and remote digital controllers.

James also worked on image processing and prepress systems and did research on human visual perception in connection with development of electronic color prepress image processing and editing systems.

Client testimonial:

"James Morris impressed the investigators with his understanding of a very abstract concept."

Client testimonial:

"James has a great understanding of our business goals."

Client testimonial:

"We had a technical consultant not able to attend an important meeting, and James just stepped in and explained the technology. He did a bang-up job."

Experience

- For a major semiconductor client facing incessant infringement accusations, was able to find, in each case, unknown prior art to invalidate accusers' patents and eliminate threats of litigation.
- For client introducing new microprocessor product, resolved multiple inventorship and ownership issues to develop patent filing program that eventually consisted of 20 patent applications, creating strong protection for technology.
- A client was approached for a license by an aggressive competitor known to commence litigation if license requests not granted. During extended negotiations, discovered new prior art that resulted in initial agreement by both sides not to litigate the other. When the agreement was ignored by competitor's employee who filed multiple reexaminations, our client was able to use this to its advantage during final negotiations.
- While defending an inter partes reexamination for a client with a patent on image sensor technology, unearthed prior art that nullified competitor's patent, resulting in settlement on terms favorable to our client.

- A major research institution client with an important medical device on the market was being threatened by a competitor who filed a reexamination of our client's patent in an attempt to invalidate it. Defended the reexam and was able to keep all of client's claims intact, resulting in the competitor's inability to enter the market.

Activities

- American Bar Association
- Boston Patent Law Association
- Institute of Electrical and Electronics Engineers
- Massachusetts Bar Association

Interests

James was previously a member of the firm's Executive Committee. He was also the firm's first technology specialist in 1988.