




John B. Pegram

Of Counsel

 New York, NY
 212-641-2230
 pegram@fr.com

Overview

About John

John B. Pegram is of counsel in the New York office of Fish & Richardson P.C. He specializes in intellectual property litigation, licensing, opinion and counseling matters of all types. John has successfully litigated cases in state and U.S. district courts, and before the U.S. International Trade Commission in Washington, D.C. He also is registered to practice in patent matters before the U.S. Patent and Trademark Office.

John is a member of Fish's Europe and Japan teams, helping U.S. clients with IP issues in those jurisdictions, and representing foreign clients in U.S. IP matters. For over 20 years, he has met regularly with officials of the European and Japanese patent offices and IP courts, as well as IP association leaders in those jurisdictions.

Representative technical subjects of matters that John has handled include: antibiotics; automobile components and systems; bar code reading and processing; cameras and lens systems; cathode ray tubes; centrifuges; coin and material testing; computer disk drives and controllers; computer logic; data compression; diagnostic kits; DNA polymerases; electronic displays and display systems; enzymes; fabric and fiber technologies; fiber optics; filtration systems; footwear; impact printers; inkjet printers; lighting devices; magnetic and optical recording; medical implants and instruments; microprocessor control systems; optical disc technology; orthopedic devices; packaging; photoconductive printers; photocopiers; pollution control systems; PTFE products; pumps; semiconductor devices and manufacturing; television broadcasting & receiving equipment; thyristors; and vending machines and systems.

Focus Areas

Services

- Copyright
- Litigation
- Trademark
- Trademark Counseling and Prosecution
- TTAB Oppositions and Cancellations
- Unitary Patent and Unified Patent Court
- Digital Millennium Copyright Act
- Transactions and Agreements
- ITC Litigation
- Patent Litigation
- Trademark, Copyright, and Media Litigation

Industries

- Consumer Products
- Electrical and Computer Technology
- Life Sciences
- Manufacturing
- Medical Devices
- Optics
- Semiconductors
- Telecommunications
- Transportation

Education

LL.B., New York University School of Law (1965)

B.A., Physics, Columbia University (1960)

Experience

Atari v. Commodore (joystick for computer games) – Lead counsel for Commodore in defending against claims by Atari that Commodore’s joystick design infringed various design patent, utility patent and trade dress rights of Atari. Case settled.

Avrea v. Chrysler Corp. (automobile coolant recovery system) – Lead counsel for Chrysler and its supplier, Mitsubishi Motors, in a patent infringement litigation. Avera claimed that his patent covered the coolant recovery systems used in Mitsubishi automobiles sold by Chrysler in the United States. Case settled.

Ballantine Laboratories Inc. v. LaFrance Precision Casting Co. (electronic instrument case design) – Lead counsel in litigation by Ballantine against a supplier who copied Ballantine’s patented design for an electronics test instrument case. Case settled.

Bourne v. Sankyo Seki Co., (musical copyrights) – Lead defense of several foreign companies against charges that their music box movements, imported by others, infringed musical copyrights. Settled through mediation, by creating a new licensing program.

Deering Milliken Co. v. Courtaulds North America, Inc. (fiber dyeing apparatus) – Defended Courtaulds in a patent infringement litigation relating to apparatus used for dyeing fibers. Case settled.

Drori v. Kenwood Corp. (automobile alarms) – Lead counsel for Kenwood in defending against a patent infringement claim involving alarm systems for automobiles. Case settled during discovery.

Fontijn v. Okamoto (complex extruded fiber) – Successfully represented Akzona (Fontijn) in a patent interference and appeal. In one of the first cases of its type, the court granted priority to Akzona on the basis of a reissue application which was filed to obtain the priority of an earlier application.

General Electric Co. v. ASEA (power semiconductor devices) – Represented GE in patent infringement litigation against ASEA for infringement of GE patents on SCR semiconductor devices used in direct current power transmission systems. Case settled.

General Electric Co. v. ECC Corporation, and General Electric Co. v. Hutson Industries, Inc. (semiconductor switching devices) – Asserted GE patents relating to Triac-type semiconductor devices and Triac circuits used in electric light dimmers. Cases settled.

Goodman v. PhilcoFord Corp. (cathode ray tube) – Represented Philco successfully in a civil action by Goodman for review of a U.S. Patent Office patent interference decision awarding priority of invention to the Philco inventor.

Highland Industries v. Toyobo Co., Ltd. (air bag fabric manufacturing) – Led the defense of Toyobo in this patent dispute. After discussions between counsel, Highland voluntarily dismissed its complaint.

Howes v. Mars, Inc. (promotional devices and methods) – Lead counsel for Mars against claims that promotions of Mars' M&Ms and Kudos products each infringed a Howes patent. Case settled during discovery.

Kaneka Corporation v. Mitsubishi Gas Chemical (MGC) (Coenzyme Q10 manufacturing) – Led the Fish team defending MGC in a U.S. International Trade Commission (ITC) investigation and a parallel district court action. The ITC found that the MGC process did not infringe Kaneka's patent and that decision was not appealed. MGC settled the district court action on favorable terms while other defendants continued to litigate with Kaneka.

Liu v. Kawase (compound semiconductor manufacturing) – Lead counsel for Kawase (Sumitomo Electric Industrial Co., Ltd.) in a patent interference and related infringement dispute with American Xtal Corp. Successfully settled.

Loral Fairchild Corp. v. Victor Co. of Japan et al. (charge coupled devices) – Successfully defended one of the lead manufacturing defendants, Sanyo Electric Co., Ltd. and its U.S. subsidiaries, as their lead counsel. Loral Fairchild had asserted multimillion dollar claims for infringement of two patents on charge coupled devices, used in camcorders and facsimile machines against Sanyo, and other Japanese and Korean owned companies. Sanyo defendants obtained a dismissal of all claims against them.

Mars, Inc. v. Coin Acceptors, Inc. (coin recognition and vending machine electronics) – Lead counsel for Mars in a multi-patent, non-jury case. The district court's literal infringement and damages decisions were affirmed in separate appeals, and Mars collected over 27 million dollars damages and interest.

Mars, Inc. v. Conlux U.S.A. Corp. (electronic coin recognition) – Lead counsel for Mars in obtaining a jury infringement and damages verdict of 40% of Conlux's sales. Conlux was enjoined from further infringement of Mars' patent on comparing coin test data with values stored in a nonvolatile memory.

Memtech LLC v. Kionix, Inc. (micromechanical accelerometers) – Co-leader of Kionix's defense in a multidefendant, EDTX patent infringement case. Kionix settled on favorable terms at an early stage.

Multimatic, Inc. v. Riken Kaki Co., Ltd. (auto components) – Lead counsel for Riken in a pending litigation involving components for Honda automobiles. Case settled following discovery and claim interpretation by a Special Master.

Nassau Tape Webbing Mills, Inc. v. Advance Thread (mattress edging tape) – Lead counsel defending Advance Thread against Nassau's patent purporting to cover fire resistant tape used on

most mattresses. Case settled favorably on the first day of trial.

Pactiv LLC v. Mitsubishi Gas Chemical (MGC) (oxygen absorbers and food packaging) – Co-leader of MGC’s defense in a five patent litigation. MGC obtained a dismissal without prejudice while an unrelated defendant continued to litigate in the courts and obtained reexamination in the USPTO.

Parker-Hannifin v. Zippertubing (Japan) – (fire retardant gaskets to prevent electromagnetic interference) – Lead counsel for Zippertubing in a four patent case. After a favorable claim construction by the court, Zippertubing obtained a very satisfactory settlement.

Quantum Corp. v. Tandon Corp. (disk drives) – Lead counsel defending Tandon against Quantum’s claims for infringement of two patents relating to signal processing and tracking in personal computer hard disk drives. This case involved complex issues of discovery and privilege, resulting in a leading Federal Circuit opinion on discovery relating to charges of willful infringement. Case settled following discovery.

Stratagene v. Takara Holdings, Inc. (DNA polymerases) – Lead counsel for Takara Bio in a civil action and a related patent interference involving inventorship, ownership, infringement, and validity issues. Settled by cross-licenses.

Insights

Publications

John is a frequent author and lecturer on patent, trademark, and federal court practice topics. He was a co-author of Fish’s [Patent Reform Updates](#), tracing the activity that led to the America Invents Act (AIA). Currently, he has written and periodically updates Fish’s [EU Unitary Patent & Unified Patent Court webpages](#).

- “German Constitutional Court Rejects Requests for Interim Injunctions against Ratification of UPC Agreement,” *Fish Legal Alert* (July 14, 2021)
- “What Brexit Means for Non-EU IP Owners,” *Managing Intellectual Property* (March 2019)
- “Service of Process on Foreign Defendants,” *Fish Litigation Blog* (January 2017)
- “Greener pastures for US patents,” *World Intellectual Property Review* (November 2016)
- “Patent owners should not fear the Unified Patent Court,” *World Intellectual Property Review* (January 2016)
- “U.S. Bar – JPO Liaison Council Meets with JPO,” *NYIPLA Bulletin* (August-September 2014)
- “From the US, progress towards creating Europe’s new unified patent system is looking good,” *IAM Blog* (August 2014)

- “Limiting Choice of Venue in Patent Litigation,” *IP Law360* (July 2014)
- “The future of attorneys’ fee awards in patent cases,” *Fish Litigation Blog & AIPLA Newsstand (Lexology)* (July 2014)
- “An equivalent to amendments during IPR proceedings,” *Fish Litigation Blog & AIPLA Newsstand (Lexology)* (May 2014)
- “The question of specificity in patent pleadings heats up,” *Fish Litigation Blog & AIPLA Newsstand (Lexology)* (March 2014)
- “Adjusting the life of a US patent due to Patent Office delay,” *Industrial Biotechnology* 6(1): 18-21 (February 2010)

Speaking Engagements

- “Patent Litigation in the United States,” *Japan Intellectual Property Association Seminar*, Tokyo, Japan (November 2016)
- “U.S. Supreme Court Patent Decisions,” *U.S. Bar-EPO Liaison Council*, New York, New York (September 2016)
- “Brexit and Intellectual Property Issues,” *IPO European Practice Committee, IPO Annual Meeting*, New York, New York (September 2016)
- “The New Reality in Patent Invalidation Procedures – Developments in Post-Grant Review,” *IPO European Practice Committee Conference*, Brussels, Belgium (May 2014)
- “Comparison of the New Inter Partes Review at the USPTO and Oppositions at the EPO,” *Fordham International IP Conference* (April 2014)
- “Evolving Standards for Disclosing and Claiming Inventions or What Can a Patentee Claim and What Does a Claim Mean?” *Fordham International IP Conference* (April 2014)
- “Update on Inter Partes Disputes and the PTAB,” *AIPLA Japan Committee seminar for Japan Patent Attorney Association*, Tokyo, Japan (April 8, 2014); Osaka, Japan (April 10, 2014)
- “Mock Program – PTAB Inter Partes Proceeding Including a Hearing,” *AIPLA Japan Committee seminar for Japan Patent Attorney Association*, Tokyo, Japan (April 8, 2014); Osaka, Japan (April 10, 2014)
- “Current trends/effects of AIA on US patent practice,” *AIPLA Europe Committee meeting with CNCPI (Compagnie Nationale Conseils Propriété Industrielle)* Paris, France (March 2014)
- “Counseling Clients re New USPTO Post Grant Proceedings and Interplay with Litigation,” *AIPLA Europe Committee meetings with Chartered Inst. of Patent Attorneys* London, United Kingdom (March 2014); German Patent Attorneys Association, Munich, Germany (March 2014) and with European Patent Institute, Munich, Germany (March 2014)
- “Unitary Patent and Unified Patent Court,” *Japan Patent Attorney Association seminars*, Osaka and Tokyo, Japan (November 2013)
- “Patent Courts – The US System: What Can Be Done to Address Litigation Inefficiencies?” *AIPLA Annual Meeting* (October 2013)
- “EU Unified Patent Court,” Joint meeting of the Giles Rich and Pauline Newman Inns of Court, Washington, DC (October 2013)

- “Report on US law – Written description requirements,” *US Bar – EPO Liaison Council*, Munich, Germany (October 2013)
- “Global Harmonization in Patent Law,” *IPO European Practice Committee Conference*, Brussels, Belgium (May 2013)
- “Comparing Patent Enforcement Across Multiple Foreign Jurisdictions,” *NYIPLA Annual Meeting workshop* (May 2013)
- “Recent Developments in U.S. Patent Law” and “Administrative & Substantive Patent Office Harmonization,” *Fordham International IP Conference*, New York, New York (April 2013)
- “Interplay between Litigation and the AIA,” *AIPLA Europe Committee* meetings with the Chartered Institute of Patent Attorneys (London), IP Lawyers Association (London), and the European Patent Institute (Munich) (March 2013)
- “European Unitary Patent and Unified Patent Court,” *West LegalEdcenter Webinar* (February 2013)
- “European Unitary Patent: An Update,” *IPO Chat Channel Webinar* (January 2013)

Recognition

- Named to *The Best Lawyers in America* (2022)
- Listed as “Best Lawyer in Litigation – Patent, Litigation – Intellectual Property, and Patent Law” by the *Best Lawyers in America* (1995-present)
- Received Lifetime Achievement Award from the New York Intellectual Property Law Association (2019)
- Recognized as a 2013 Top Rated – AV® Preeminent™ Lawyers in Intellectual Property Law and an “IP Star” by *Managing Intellectual Property* (2013-2018)
- Recipient of the President’s Outstanding Service Award from the American Intellectual Property Law Association (2011)
- Listed in *Euromoney Guides to Leading Patent & Trademark Experts*; *Marquis Who’s Who in America*; *Who’s Who in American Law*; *Who’s Who in the East*; and *Who’sWhoLegal: The International Who’s Who of Business Lawyers*

Memberships & Affiliations

John is active as a bar association leader, including Past President of the New York IP Law Association (NYIPLA), a past Director of the American Intellectual Property Law Association (AIPLA), and former Editor-in-Chief of The Trademark Reporter. He is currently AIPLA delegate to the US Bar - EPO Liaison Council and NYIPLA delegate to the US Bar - JPO Liaison Council, and has served as an advocate, arbitrator, or mediator in intellectual property and business arbitrations and mediations,

and as an expert witness on patent procedures.