




Thad C. Kodish

Principal

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“He’s trustworthy and knowledgeable. We know we are getting the best advice possible when we reach out. He is a team lawyer with us.”

– *Client testimonial, Chambers and Partners 2019*

Overview

About Thad

Thad Kodish is the managing principal of the Atlanta office of Fish & Richardson P.C. In addition, Mr. Kodish is a patent trial lawyer and leads cases in venues across the U.S. An experienced courtroom lawyer, Mr. Kodish has first-chaired for some of the firm’s largest clients, including at *Markman* hearings and at the Federal Circuit.

Recently, Mr. Kodish and his fellow Fish partner, Christopher Green, tried and won the first patent jury verdict in the Middle District of Georgia since 2001. *YKK Corporation et al v. Velcro Companies USA Inc.* (M.D. Ga., November 17, 2017). The Fish trial team won on all counts for their clients, the Velcro Companies, fending off the plaintiffs’ accusations levied against VELCRO® brand hook and loop fasteners for the transportation industry. Read more about this competitor case win in the news.

Mr. Kodish’s successful argument at the Federal Circuit in *Shaw Industries Group Inc. v. Automated Creel Systems Inc.*, has been hailed by *Law 360* as one of the “Top AIA-Related Decisions of 2016” and the “Top Patent Cases of 2016.” The holding in *Shaw* that limits the scope of estoppel stemming from IPR proceedings, has been widely cited by the Federal Circuit and numerous U.S. district courts.

Mr. Kodish argued successfully as first chair for Samsung Electronics in *Synchrome LLC v. Samsung Electronics America, Inc. et al.*, which led to the plaintiff's later stipulation of non-infringement and favorable settlement. His hands-on approach includes a deep understanding of his clients' business, and business objectives, allowing him to quickly provide clients with targeted guidance on vital issues and opportunities that arise during the course of litigation.

His cases span a wide range of electrical, computer software, chemical and mechanical technologies, microprocessors, Ethernet and wireless network communications, operating system software, product activation software, telecommunications systems, computer storage devices, point-of-sale software and hardware, computer-aided design, wearable software and hardware, as well as textile and laminate flooring technologies.

As a result of his many long-standing client relationships, Mr. Kodish routinely provides counsel and guidance at all stages of a legal dispute. Thus, clients frequently consult with him before a lawsuit is filed to work on sensitive and highly confidential pre-suit matters, including offensive and defensive strategies for litigation avoidance.

Since the 2011 enactment of the Leahy-Smith America Invents Act (AIA), Mr. Kodish has broadened his practice to integrate strategies that incorporate post-grant proceedings, including *inter partes* review (IPR). He has successfully litigated IPRs for both the patent owner and the patent challenger, in diverse fields ranging from computer software to manufacturing.

In addition to his patent litigation practice, Mr. Kodish has extensive involvement at the Emory School of Law. Mr. Kodish was the adjunct professor of law teaching the course on patent litigation in the 2016 spring semester. Mr. Kodish has also been a member of the law school alumni board for nearly ten years, including his two-year term as alumni board and alumni association president (2013-2015).

Mr. Kodish has been actively involved in numerous pro bono causes. Mr. Kodish obtained oral argument and argued before the Georgia Supreme Court in a long-running *habeas corpus* petition, trial, and appeal. Mr. Kodish has also obtained temporary protective orders for women subject to domestic abuse for the Safe Families Project at Atlanta Volunteer Lawyers Foundation.

Prior to joining Fish, he was a chemical engineer at Pratt & Whitney Aircraft and responsible for chemical technologies for jet engines.

Focus Areas

Services

- IP Licensing, Transactions, and Agreements
- Litigation
- Post-Grant
- ITC Litigation
- Patent Litigation
- Trade Secret Litigation
- Trademark, Copyright, and Media Litigation

Industries

- Chemicals
- Digital Health
- Electrical and Computer Technology
- Internet
- Manufacturing

Education

J.D., Emory University School of Law (2000) Member, *Emory Law Journal*

B.S. *cum laude*, Chemical Engineering, University of Michigan (1996)

Experience

UPL NA, Inc. v. Tide International (USA) Inc. (C.D. Cal. 2019-21) (Lew, J.): Lead trial counsel for Tide in a patent dispute concerning agrochemical pesticide formulations. Obtained a stay of case proceedings following successful institution of *inter partes* review proceedings at the USPTO.

In the Matter of Certain Video Processing Devices, Components thereof, and Digital Smart Televisions Containing the Same, Inv. No. 337-TA-1222 (ITC 2020-21): Counsel for Respondent *Samsung Electronics Co., Ltd.* in ITC investigation defending against allegations concerning patents describing video processing technologies.

Berall v. Verathon, Inc., 2:21-cv-00944 (W.D. Wash. 2020-2021): Took over defense of longstanding

case for Verathon concerning laryngoscope technologies. Obtained an order granting Verathon's opposed motion to transfer from SDNY to W.D. Wash.

SIPCO, LLC v. Inovonics, Inc., 1:20-cv-1867 (D. Colo. 2020-21): Lead counsel for Inovonics defending against patent infringement allegations concerning wireless networking technologies.

Yamaha Golf-Car Company v. Club Car, LLC, (Federal Circuit 2019): Lead counsel for Yamaha in appeal of PTAB decisions concerning GPS monitoring and control of golf carts.

Club Car, LLC v. Yamaha Golf-Car Company, (S.D. Ga. 2017) (Hall, J.): Lead trial counsel for Yamaha in patent infringement suit concerning GPS monitoring and control of golf carts.

SAS Institute Inc. v. World Programming Limited, et al., (E.D. Tex. 2018) (Gilstrap, J.): Lead trial counsel for Shaw Industries Group, Inc. in software copyright infringement suit concerning business metrics monitoring software.

Adv. Qualcomm Inc. (S.D. Cal. 2017-2019) (Bencivengo, J.): Counsel for large electronics manufacturer in a patent dispute involving mobile devices and touchscreen technologies.

YKK Corporation et al v. Velcro Companies USA Inc. (M.D. Ga. 2013-2017) (Abrams, J.): Counsel for Velcro Companies in patent dispute regarding VELCRO® Brand fasteners and hooks for the transportation market in which Fish obtained a complete non-infringement jury verdict. Read more about this case in the news.

Automated Creel Systems, Inc. v. Shaw Industries Group, Inc. (N.D. Ga. 2018) (Ray, II, J.): Lead trial counsel for Shaw Industries in a patent dispute involving creeling equipment.

Big Baboon Inc. v. Intel Corp. et al. (C.D. Cal. 2010-17) (Wilson, J.) Lead counsel for Intel in patent dispute regarding computer software and database technologies; Obtained a dismissal with prejudice following successful reexaminations cancelling all asserted patent claims.

SAS Institute Inc. v. World Programming Limited et al. (E.D. Tex. 2018) (Gilstrap, J.): Lead counsel for defendant, Shaw Industries Group, Inc. in a copyright and patent dispute concerning business analytics software.

Certain Digital Cable and Satellite Products, Set-Top Boxes, Gateways, and Components Thereof (ITC 2017) (McNamara, ALJ): Counsel for Respondent, ARRIS, in ITC investigation involving set-top box and network gateway devices.

TiVo, Inc. v. Samsung Electronics America, Inc. et al (E.D. Tex. 2015-17) (Gilstrap, J.): Counsel for Samsung in patent dispute regarding set-top box technologies.

Uniloc USA Inc., et al. v. McKesson Corp., et al. (E.D. Tex. 2016) (Schroeder, J.): Lead counsel for

McKesson in patent dispute regarding computer software technologies.

Freeny, et al. v. Fitbit, Inc. (E.D. Tex. 2016) (Judge Gilstrap) Lead counsel for Fitbit in patent dispute regarding wireless technology aspects of wearables.

Fujinomaki v. Google Inc., et al. (N.D. Cal. 2015-16) Counsel for Samsung in case concerning wearable technologies. Following the successful invalidation of the plaintiff's patent in IPR proceeding, obtained dismissal with prejudice and cost award.

Shaw Industries Group Inc. v. Automated Creel Systems Inc. (Fed. Cir. 2016) Counsel for Shaw Industries arguing successfully on several issues regarding invalidity and PTAB procedure.

Olivistar, LLC v. Samsung Electronics America, Inc. (E.D. Tex. 2014) (Judge Gilstrap) Counsel for Samsung in patent dispute regarding computer networking technologies.

Prescriber, LLC v. McKesson Corporation (E.D. Tex. 2014) (Judge Mitchell) Lead counsel for McKesson in patent dispute regarding electronic prescribing technologies.

Ingeniador, LLC v. McKesson Corporation (E.D. Tex. 2013) (Judge Gilstrap) Lead counsel for McKesson in patent dispute regarding digital health technology.

Clark Equipment Company v. Corriher (N.D. Ga. 2012-13) (Story, J.): Counsel for Clark Equipment Co. in trademark dispute alleging improper use of Clark's BOBCAT trademarks.

Automated Creel Systems, Inc. v. Shaw Industries Group, Inc. (N.D. Ga. 2012) (Story, J.) Counsel for Shaw Industries in a patent dispute involving creeling equipment. Obtained dismissal without prejudice for Shaw based on Plaintiff's lack of standing.

U.S. Ethernet Innovations, LLC v. Acer, Inc., et al. (N.D. Cal. 2011-14) Counsel for Intel Corp.; Team obtained Summary Judgment rulings of non-infringement and invalidity, affirmed on appeal, and costs awarded.

Synchrome Technology, Inc. v. Samsung Electronics America, et al. (N.D. Ga. 2009-2014)(Jones, J.): Counsel for Samsung in patent infringement action concerning disk drive technology.

HTTP Hypothermia Therapy, LTD. v. Kimberly-Clark Corporation, et al. (Fulton County Superior Court) (2012-2013) Testifying expert for Kimberly-Clark on patent law issues.

SIPCO, LLC v. Control4 Corp., et. al. (N.D. Ga. 2010-2012) (Chief Judge Carnes) Represented Digi International, Inc. in dispute involving wireless networking technologies.

Lutron Electronics Co. Inc. v. Pass and Seymour Inc., et al. (C.D. Cal. 2011-12) Represented Pass & Seymour in patent infringement case regarding electrical dimmer switch technology.

Greenlight Technologies LLC v. Anigmo LLC (dba Anigmo), et al. (2010-2011) Represented Pass & Seymour in patent infringement matter concerning electrical dimmer switch circuitry.

Akzenta Profile et al. v. Shaw Industries Group, Inc., et al. (E.D. Tex. 2010-2012) (Ward, J.): Represented Shaw Industries in dispute involving laminate flooring technologies.

SIPCO, LLC, v. Johnson Controls, Inc., et al. (E.D. Tex. 2009-2011) (Davis, J.): Represented Johnson Controls, Inc. in dispute involving wireless networking technologies.

Mesh Comm LLC v. Landis+Gyr, Inc. and Oncor Electric Delivery Company LLC (E.D. Tex. 2009-2010) (Ward, J.): Represented defendants Landis+Gyr and Oncor in dispute involving networking technologies.

Shaw Industries Group, Inc. v. Interface, Inc. (N.D. Ga. 2005-2009) (Murphy, J.): Represented Shaw Industries in action for declaratory judgment of non-infringement and invalidity of carpet tile patent.

Shaw Industries Group, Inc. v. Interface, Inc. (N.D. Ga. 2007-2009) Represented Shaw Industries in action for false patent marking.

Toni & Guy, USA v. Nature Lab's (N.D. Tex. 2008-2009) Represented Toni & Guy in action for trademark and trade dress infringement.

IP CO, LLC and SIPCO, LLC v. Cellnet Technology, Inc. and Hunt Technologies, et al. (N.D. Ga. 2007-2009) Represented Cellnet and Hunt in contract dispute and patent infringement matter concerning wireless mesh networking technology.

American Valve v. Asia Factory Direct, et al. (D. Nev. 2008) Obtained temporary restraining order and preliminary injunction in trademark dispute for American Valve.

Fulks v. Chaparral Boats, Inc., et al. (E.D. Tex. 2002-2004) and *Fulks v. Crownline Boats* (E.D. Tex. 2006-2007) Represented Chaparral and Crownline in patent infringement matters involving structural designs for power boats. Obtained complete win for client in obtaining a ruling unwinding the bankruptcy sale of the asserted patent to the plaintiff.

Milliken & Co. v. Shaw Industries Group, Inc., et al. (D.S.C. 2000-2002) Represented Shaw Industries in patent infringement action involving construction of carpet backing.

SuperGuide Corp. v. DIRECTV Enterprises, Inc., EchoStar Technologies, Inc., Thomson Consumer Electronics, Inc. v. Gemstar Development Corp. (W.D N.C. 2001) Represented EchoStar in complex patent infringement litigation involving three patents owned by SuperGuide, licensed to Gemstar in

certain fields of use, and directed to various aspects of interactive program guides (IPG) software and systems used in Satellite television services.

Insights

Publications

Mr. Kodish has also been featured in several issues of *Emory Lawyer Magazine* as the Law School Alumni Board President. (Fall 2013 p. 26-27, Summer 2014 p. 18, Winter 2015 p. 25)

Speaking Engagements

- “Willful Patent Infringement,” *Georgia Chapter of the Association of Corporate Counsel* (October 2019)
- “IP Chat Channel webinar on IPR Estoppel in District Courts,” *Intellectual Property Owners Association* (“IPO”) (March 2017)
- International Patent Law and Policy, *Emory School of Law* (March 2017)
- Panelist on the importance of diversity at law firms at *The Georgia Asian Pacific American Bar Association* (April 2016)
- “Making Sense of *Inter Partes* Review Proceedings,” *Cantor Fitzgerald’s Inaugural Healthcare Conference* (July 2015)
- *Columbia Insurance Company 4th Annual IP Conference* (June 2015)
- “Post-Grant Patent Practice and Legislative Developments,” *Korean Intellectual Property Protection Association Lecture* (March 2014)
- “Patent Litigation and Legislative Developments,” *Seoul National University Law School Lecture* (March 2014)
- “Joint Infringement – Recent Updates and Practical Impact,” *Association of Corporate Patent Counsel 2014 Winter Meeting* (January 2014)
- “Hot Topics in Intellectual Property,” *Daily Report’s In-House Counsel CLE Seminar* (July 2013)
- “Claim Construction Re-Set,” *24th Annual All Hands Meeting* (December 2012)
- “Indirect and Divided Infringement in the Wake of CAFC’s *Akami* and *McKesson* Rulings,” *Emory Law Alumni Intellectual Property Society* (November 2012)
- “Understanding New Proceeding for Patent Review,” *Litigation Patent Disputes Conference* (November 2012)
- “Valuation of Intellectual Property from an Enforcement Perspective,” *What Israel Companies Really Need to Know About IP Protection and Enforcement in the U.S.* (January 2011)

Recognition

- Named to *The Best Lawyers in America* (2022)
- Named a “Leading Patent Professional” by *IAM Patent 1000* (2020-2021)
- Named to *Best Lawyers* Litigation – Intellectual Property (2018-2021)
- Received 2017 Distinguished Leaders Award by *ALM’s Daily Report* (2017)
- Recognized as an “IP Star” by *Managing Intellectual Property* (2013-2020)
- Received the Emory Law Young Alumni Award (2015)
- Selected by his peers to the *Super Lawyers* list for IP Litigation (2014-2020)
- Recognized as a Georgia Top 40 under 40 attorney “On the Rise” by *The Daily Report* (2013)
- Selected by his peers as a *Super Lawyers* “Rising Star” for IP litigation (2007-2013)
- Named a leader in IP law by *Chambers USA: Georgia* (2011-present)

Memberships & Affiliations

Adjunct Professor, Emory School of Law, teaching Patent Litigation (2016)

President, Emory Law Alumni Association (2013-2015)

Member, Emory Law Alumni Board (2006-2016)