



GARDELLA GRACE

Greg H. Gardella



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Post-Grant Proceedings | Patent and Trade Secret Litigation | Patent Procurement

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As noted by one of the most highly regarded international rankings of IP professionals, “Greg H. Gardella is ‘a great counselor and patent attorney’ whose procurement, litigation and post-grant work is ‘amazing.’ He is able to synthesize legal solutions for his clients from all angles — anyone who knows Greg knows he is wicked smart.” Elsewhere, they noted that he “‘has real pedigree and an incredible depth of knowledge’” and he is “‘wonderfully savvy.’”

Mr. Gardella has been honored as one of the Best Lawyers in America for multiple consecutive years and has likewise received various awards and recognition from U.S. News & World Report, Chambers & Partners, Managing IP Magazine, Intellectual Asset Management (IAM), Super Lawyers and Who’s Who Legal. He has been repeatedly named as one of the nation’s top post-grant practitioners by IAM, which previously reported that “the ‘phenomenal’ Greg H. Gardella is ‘extremely experienced in the post-grant space and a dynamic all-round patent consultant’” and noted that his “‘former big-ticket patent litigation experience has served him well in contested reexamination proceedings, of which he is regarded a master.’” Mr. Gardella is one of only a handful of U.S. patent attorneys to have earned spots on both *IAM Patent 1000 Global Leaders* and *IAM Strategy 300 Global Leaders*.

Mr. Gardella successfully defended the famous TiVo DVR patent, which thereafter generated well over \$1 billion in licensing revenue. Mr. Gardella also successfully defended before the Patent Trial and Appeal Board four patents covering aseptic packaging technologies that are used to process about 2 billion bottles per year. On the challenger side, Mr. Gardella prevailed for St. Jude Medical in nine post-grant proceedings targeting numerous Medtronic patents that purportedly covered the billion-dollar denervation industry. In those cases, every challenged claim was finally adjudicated to be invalid on multiple grounds.

Mr. Gardella was also the editor of a treatise on post-grant practice entitled “Post-Grant Proceedings Before the Patent Trial and Appeal Board,” published by Practising Law Institute. He has frequently lectured on post-grant proceedings and strategies for effective execution of concurrent litigation, post-grant proceedings and patent prosecution.

Mr. Gardella has broad technical aptitude arising from his dual degrees in electrical and mechanical engineering and from years of representations involving DNA detection and sequencing, genetic diagnosis and screening, organic chemistry, immunochemistry, pharmaceutical and other biotechnology innovations. Mr. Gardella has deep familiarity with the technologies underlying most medical devices, polymerization processes, genetic sequencing techniques, semiconductor fabrication and device structure, computer architecture, wireless telecommunications, network data communication, software ranging from microcode to application layer, signal processing, VLSI design, micro-structured films, and industrial equipment.

Education

- The University of Michigan Law School (J.D., cum laude)
- University of Minnesota (M.S., 3.9/4.0 GPA)
Electrical Engineering
- University of Michigan (B.S., magna cum laude)

Mechanical Engineering

Admissions

- Admitted in DC, IL, MN and USPTO only; practice is limited to matters and proceedings before federal courts and agencies
- District of Columbia
- Minnesota
- Illinois
- U.S. Patent and Trademark Office
- U.S. Supreme Court
- U.S. Court of Appeals, Federal Circuit
- U.S. District Court, Western District of Wisconsin
- U.S. District Court, Northern District of Illinois

Accolades

- Chambers and Partners, ranked in a top band for qualities most valued by clients
- Best Lawyers in America, named to its list of top intellectual property lawyers (multiple consecutive years)
- IAM Patent 1000: The World's Leading Patent Practitioners, selected as one of the top practitioners in the United States for post-grant proceedings (multiple consecutive years); named to Intellectual Asset Management Magazine's list of the top 1000 patent attorneys in the world (multiple consecutive years)
- The Legal 500, recognized for his expertise in patent reexamination
- Managing IP Magazine, recognized as an "IP Star" (multiple consecutive years)
- Who's Who Legal Life Sciences 2014, listed as one of the top 100 lawyers in the U.S. for life sciences contested proceedings
- Super Lawyers, named to its list of leading patent attorneys (multiple consecutive years)

Representative Presentations and Publications:

- "Resurgence of Ex Parte Reexamination," PTAB Masters 2022 (January 25, 2022).
- Association of Corporate Patent Counsel Winter Meeting (January 23-26, 2022).
- Practising Law Institute semi-annual conference, USPTO Post-Grant Patent Trials 2018 (includes live webcast) (September 21, 2018).
- Evolving PTAB Trial Practice: Navigating Complex Procedural Rules (November 8, 2016).
- PTAB 2015 Year in Review; CAFC & Beyond On-Demand (November 3, 2016).
- Practising Law Institute semi-annual conference, USPTO Post-Grant Patent Trials 2016 (includes live webcast) (March 31, 2016).
- USPTO Post-Grant Patent Trials 2016 (includes live webcast) (March 31, 2016).
- USPTO Post-Grant Patent Trials 2015 (March 26, 2015).
- Leveraging Post-Grant Patent Proceedings Before the PTAB (June 12, 2014).
- 12th Annual Rocky Mountain Intellectual Property & Technology Institute (May 29, 2014).
- USPTO Post-Grant Patent Trials 2014
- AIPLA Annual Meeting 2013, "The First Year of AIA Post-Grant Challenges: Lessons Learned," presenter and panelist (October 24, 2013).
- AIPLA Spring Meeting 2013, "PTAB Review Proceedings – Lessons Learned and Other Observations from Both Sides of the Bench in the New Review Proceedings" (May 2013).
- Editor, single volume treatise entitled "Post Grant Proceedings Before the Patent Trial and Appeal Board," published by Practising Law Institute in late 2012.
- "Post Grant Proceedings Before the Patent Trial and Appeal Board," Strafford CLE Webinar (August 2012).
- Intellectual Property Owners Association (IPO) Inter Partes Proceedings Committee, "Inter Partes Review and Post-Grant Review: New Regime and New Strategies" (April 2012).
- Patent Law Institute (6th Annual), hosted by Practising Law Institute, "Post Grant Review and Reexamination" (March 2012).
- 2012 National CLE Conference–Intellectual Property, "Strategies for Reexamination and the New Post Grant Proceedings" (January 2012).
- "The New Patent Law," speaker and panelist on the new first-to-file system (October 2011).
- "Ex Parte and Inter Partes Reexamination Tactics," Intellectual Property Owners Association (June 2011).
- United States Patent and Trademark Office Roundtable Concerning Streamlining Patent Reexamination, Panelist (June 2011).
- "Patent Reexamination: Effective Strategy for Litigating Infringement Claims," Strafford CLE Webinar (May 2011).
- "Managing Concurrent Patent Litigation and Reexamination," USC IP Institute (March 2011).
- "Ex Parte and Inter Partes Reexamination Tactics," AIPLA's 2011 Mid-Winter Institute (February 2011).
- "Patent Reexamination," California MCLE (2010).
- "Patent Reexamination A New Shield," The Recorder (December 2010).
- "Patent Reexamination: Strategic Considerations In Patent Litigation," The Intellectual Property Strategist (October 2010).
- "Patent Reexamination: Best Practices for Pursuing and Defending Parallel Reexamination and Litigation," Strafford CLE Webinar (May 2010).
- "Advanced Patent Prosecution: Hot Topics in 2010: Latest Developments in Inter Partes Reexam Practice and Case Law Update," Midwest IP Institute (2010).
- "Patent Reexamination: The New Strategy for Litigating Infringement Claims," National CLE (October 2009).
- "Inter Partes Reexamination," Panel Discussion, Midwest IP Institute (2009).
- "Reexamination: Tactical Considerations and Trends," Law Education Institute, Inc. (2009).
- "Inter Partes and Ex Parte Reexamination: Recent Trends and Tactics," Minnesota CLE (2009).

- “Patent Reexamination: Trends and Tactics,” PLI’s Third Annual Patent Law Institute (March 2009).
- “Recent Developments in the Law of Inequitable Conduct: The Duty to Cite Co-Pending Applications,” California CLE (2009).
- “Inter Partes Reexamination: Tactics and Recent Trends,” Law Education Institute’s National CLE Conference (2009).
- “United States Reexamination Procedures: Recent Trends, Strategies and Impact on Patent Practice,” John Marshall Law Review (Vol. 8, Issue 3, Spring 2009).
- “Post-KSR Drafting Tips,” Minnesota CLE (2008).
- “The New Framework of Patent Exhaustion: The Supreme Court’s Holding in Quanta Computer v. LG Electronics,” Minnesota CLE (2008).
- “Best Practices for Managing High Volume Patent Portfolios: Lessons Learned from the Battlefield,” California CLE (2008).
- “Post-KSR Decisions on Obviousness: Practical Implications for Patent Prosecution, Opinion and Enforcement Practice,” Minnesota CLE (2008).
- “In re Seagate: Implications for Opinion Practice and Freedom to Operate Analyses,” Minnesota CLE (2007).
- “USPTO Final Rule Changes for Continuations and Claims,” Minnesota CLE (2007).
- “The Newly Proposed Amendments to the Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals,” Minnesota CLE (2007).
- “MIPLA Comments on the Proposed Appeals Rules and a Recap of the New Rules on Continuation Practice and Examination of Claims,” Minnesota CLE (2007).
- “Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims,” Minnesota CLE (2007).
- “The Patent Reform Act of 2007 and Update on the New Patent Rules Packages,” Minnesota CLE (2007).
- “The New Patent Office Rule Package on Continuation Practice,” Minnesota CLE, moderator (2007).
- “CEO’s Guide to Patents,” Twin Cities Business Journal Seminar, moderator (2007).
- “The Supreme Court’s Decision in Medimmune v. Genentech: Declaratory Judgment Actions by Licensees,” Minnesota CLE (2007).
- “For Whom the Bell Tolls,” Minnesota Lawyer Newspaper, In House Counsel section (2006).
- “DSU Medical v. JMS Co. en banc: The New Standard for Inducement,” Minnesota CLE (2006).
- Author, Official Comments of the Minnesota Intellectual Property Law Association on the Proposed USPTO Rules on Information Disclosure Statements (September 2006).
- “The USPTO’s Proposed Rules on Information Disclosure Statements,” Minnesota CLE, moderator (2006).
- “Top Ten IP Mistakes Made by Start-Up Companies,” Upsize Magazine (June 2006).
- “Patent Peer Review Pilot and other Proposed Changes at the USPTO,” Minnesota CLE (2006).
- “Claim Construction in a Post-Phillips World,” Minnesota CLE (2006).
- “The USPTO’s Proposed Rules on Continuations and Examination,” Minnesota CLE (2006).
- “Proposed Amendments to the District of Minnesota’s Local Rules for Patent Cases,” Minnesota CLE (2005).
- “Symbol Technologies v. Lemelson: the Re-Birth of Prosecution Laches,” Minnesota CLE (2005).
- “Recent Amendments to Rules of Practice Governing Interferences,” Minnesota CLE (2005).
- “Patent Reform Proposals and Legislative Update,” Minnesota CLE (2005).
- “Cooperative Research and Technology Enhancement (CREATE) Act of 2004,” Minnesota CLE (2005).
- “Prosecution of Business Method Patent Applications: Rules, Procedures and Tactics,” Minnesota CLE (2005).
- “Keeping Your IP Options Open,” IEEE Spectrum (2003), an article on patent prosecution strategies designed to maximize intellectual property protection while minimizing expense.
- “How Not to Get Squeezed – Lessons to Learn from the Ongoing Patent Battle Over the Blackberry E-mail System,” IEEE Spectrum (2003), an investigative article discussing patent prosecution and litigation tactics in the context of the NTP v. Research in Motion lawsuit.
- “Patent Pitfalls for Programmable Devices,” Patent Strategy & Management (2000), an analysis of an alternate theory of patent infringement for computer controlled, programmable devices.

Publications

- September 2012 – [“Post-Grant Proceedings Before the Patent Trial and Appeal Board”](#)
- April 2012 – [“Cancellation of Patent Claims in an Interference After Those Claims Have Been Held Not Invalid in an Infringement Action”](#)