



# Mark DeBoy

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#### Overview

Mark DeBoy joined Edell, Shapiro & Finnan in 2012, and has been practicing intellectual property law since 2009. With a degree in physics, Mark focuses his practice on United States Patent and Trademark Office post-grant proceedings, appeals before the Court of Appeals for the Federal Circuit, drafting and negotiating patent licensing and litigation settlement agreements, patent drafting and prosecution, patent portfolio development, portfolio management, counseling, freedom-to-operate, invalidity, and infringement analysis and opinions, and related matters.

Mark's advocacy before the Patent Trial and Appeal Board has resulted in over fifty successful outcomes in *inter partes* review, post grant review and reexamination proceedings. Representative matters include:

- Post Grant Review PGR2020-00051
- Inter Partes Review IPR2019-00952
- Inter Partes Review IPR2018-01456
- Inter Partes Review IPR2018-00556
- Inter Partes Review IPR2017-01490
- Inter Partes Review IPR2017-01236
- Inter Partes Review IPR2016-01526
- Inter Partes Review IPR2014-00008
- Voestalpine Stahl GmbH v. ArcelorMittal, Appeal No. 2016-1407 (Fed. Cir. 2016)

Mark's practice specializes in a wide variety of technologies, including:

- optics
- lithography
- semiconductor devices
- metallurgy
- mobile communications systems
- computer hardware and software
- electronic circuitry
- wireline and optical networking
- semiconductor fabrication
- encryption
- medical devices
- e-commerce
- financial services

Prior to joining Edell, Shapiro & Finnan, Mark practiced at a large patent boutique and spent time in-house at an academic institution. Mark's prior experience included managing a sizeable patent prosecution docket, patent litigation including discovery matters, infringement and invalidity contentions, and USPTO post-grant proceedings.

Before embarking on a career in patent law, Mark worked as a consultant for a top technology consulting firm. Mark also spent time teaching high school math, science and computer science.

In his free time, Mark enjoys running, reading and enjoying time with his family.

### **Professional Affiliations**

- American Bar Association
- American Intellectual Property Bar Association

## Education

- J.D., from the University of Maryland School of Law, Cum Laude
- B.S. in Physics from the University of Notre Dame, Cum Laude

## Admissions

- Maryland
- United States Patent and Trademark Office
- United States Court of Appeals for the Federal Circuit

#### **Practice Areas**

- Patent Prosecution
- Post Issuance Proceedings
- IP Litigation
- Counseling & Transactions
- Industrial Design

## Industries

- Communications and Network Architecture
- Computer and Software Engineering
- Consumer Products
- Electrical Engineering
- Mechanical Engineering
- Nanotechnology
- Physics