



Senior Counsel - Kansas City  
913.777.5614  
jason.mudd@eriseIP.com

## EDUCATION

J.D., University of Missouri  
School of Law (*Order of the Coif*)

- Lead Articles Editor, *Missouri Law Review*
- Member, National Moot Court Team

B.S., University of Missouri,  
Chemical Engineering  
(*magna cum laude*)

## MEMBERSHIPS

Litigation Committee Member  
& Past International Trade  
Commission Committee

Member, Intellectual Property  
Owners Association (IPO)

## AWARDS

"IP Star" by Managing IP  
(2014-2020)

IP Trailblazer & Pioneer by  
The National Law  
Journal (2014)

"Super Lawyer" by Missouri/  
Kansas Super Lawyers  
(2016-2020)

## JASON R. MUDD

Jason's practice focuses on the litigation of complex intellectual property disputes, with an emphasis on patent litigation. He represents clients in federal district courts across the country, before the U.S. International Trade Commission, and in post-grant proceedings at the United States Patent and Trademark Office. Jason represented and successfully argued on behalf of the petitioner in the first-ever inter partes review (IPR) conducted at the USPTO under the America Invents Act. The National Law Journal recognized Jason for this accomplishment by naming him to its list of "2014 IP Trailblazers and Pioneers." IP Law360 named Jason to a list of nine attorneys nationwide recognized on its list of "2015 IP MVPs." Jason is a frequent invited speaker and panelist on topics relating to PTAB post-grant proceedings and patent litigation.

Jason's experience spans a wide range of technologies, including software, microprocessors, navigation and GPS technology, automotive technologies, vehicle interfaces, electro-mechanical systems, telecommunications, liquid crystal displays, avionics, medical devices and diagnostics, consumer products and textiles, networking and internet technologies, health care information systems, medical informatics, console and online video games, and pharmaceuticals. He has significant experience in all phases of litigating patent cases, including managing discovery, taking and defending fact and expert witness depositions, Markman procedure and hearings, motion practice and hearings, pre-trial proceedings, bench and jury trials, and appeals, including appeals to the U.S. Court of Appeals for the Federal Circuit. Jason also has experience in matters involving trademarks, copyrights, design patents, trade secrets, Hatch-Waxman and ANDA litigation, unfair competition, tortious interference, antitrust and cyber law issues. Jason's practice is international in scope, having been involved in deposition practice in numerous countries and continents around the world.

### Some representative matters in which Jason has been involved include the following:

- Represented Garmin in first-ever inter partes review (IPR) before the Patent Trial and Appeal Board, which resulted in a favorable claim construction ruling and all claims under review being held invalid.
- Represented Garmin in a Section 337 investigation before the ITC and parallel district court proceeding involving multiple patents relating to navigation technology, in which ITC found no violation
- Represented Ford Motor Company and Mazda Motor of America Inc. in a patent infringement action relating to RFID fuel dispensing technology, which resulted in a decisive victory during claim construction in which the court invalidated certain claims and construed others in a manner that required the patentee to stipulate to noninfringement.

## LICENSES

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Missouri

Kansas

U.S. Court of Appeals for the  
Federal Circuit

U.S. District Courts for the  
District of Kansas

Western District of Missouri

Eastern District of Texas

Eastern District of Michigan

Eastern District of Missouri

Northern District of Texas

Other various federal district  
courts around the country

Admitted to practice before  
the United States Patent and  
Trademark Office.

## REPRESENTATIONS CONTINUED

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- Represented Sprint in series of complex multi-patent infringement actions asserting Sprint's voice-over-packet technology patent portfolio, resulting in the largest jury verdict in Kansas history at the time (\$69.5 million), a post-Seagate finding of willfulness, and a subsequent settlement for \$80 million
- Represented Cerner Corporation in a declaratory judgment patent and trade secret case relating to healthcare information systems for remote monitoring of intensive care units, which, after a three-week trial, resulted in a jury finding the asserted patents not infringed and invalid, including a patent that had been reexamined twice by the U.S. Patent and Trademark Office
- Represented Abbott Point of Care in multiple patent infringement actions relating handheld point of care blood analyzer technology
- Represented Sony Computer Entertainment America in patent infringement actions relating to online video gaming and voice-over-data technology
- Represented Garmin in multiple patent infringement actions relating to GPS and navigation technology against its chief competitor, TomTom
- Represented Ford Motor Company in patent case in the District of Delaware and related instituted IPRs involving torque sensors for four-wheel drive and all-wheel drive systems, which resulted in judgment of noninfringement, award of Rule 11 sanctions, and "exceptional case" attorney fee award for Ford under 35 U.S.C. 285
- Represented Ford Motor Company in patent case accusing MyFord Touch instrument clusters and touch panels, in which Ford was granted summary judgment of invalidity of all asserted claims on the eve of trial
- Represented Sony Online Entertainment, Blizzard Entertainment, and Hasbro subsidiary Backflip Studios in multiple IPR proceedings relating to online gaming technology
- Represented Ford Motor Company in patent cases in the Eastern District of Texas relating to hybrid vehicle battery charging systems and Ford's MyKey system, which resulted in successful settlement
- Represented Ford Motor Company in seven-patent case in the District of Delaware and related IPR proceedings involving liquid crystal display technology and light guide technology for vehicle tail lights, which resulted in complete dismissal by plaintiff
- Represented multiple avionics system and instrumentation suppliers in multiple patent litigations in the Northern District and Eastern District of Texas, which resulted in successful settlement for clients
- Represented Garmin in a Section 337 investigation before the ITC involving patented microprocessor clocking technology in which the ALJ and full Commission awarded Garmin a final determination of noninfringement
- Represented Ford Motor Company in four-patent case in the Eastern District of Texas and related CBM proceedings relating to online marketing technology

## SPEECHES

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"USPTO PTAB Stadium Tour," Invited panelist on "An Outside Perspective on Patent and Trademark Office Challenges" (March 1, 2016)

"101 Post-Alice: How the USPTO & Practitioners are Reacting," USPTO Invited Speaker (July 23, 2015)

"Conducting Inter Partes Reviews: Reflections on IPR #1," LAKC's Sixth Annual IP CLE (January 22, 2014)

Invited Panelist, IPO's Chat Channel, "Inter Partes Review: A 6-Month Check-up" (April 4, 2013)

Guest Lecturer, University of Missouri School of Law, "Patent Claim Construction" (April 1, 2013)

Invited Speaker, Missouri Law Review Symposium 2011, Evolving The Court of Appeals for the Federal Circuit and its Patent Law Jurisprudence (February 25, 2011)

"Acts By Many, Infringement By None: A Discussion of Joint Infringement" CLE (March 22, 2011)

"What Every Business Lawyer Needs To Know About Intellectual Property" CLE (June 26, 2008)

"State Sovereign Immunity From Patent Infringement" CLE (January 25, 2007)

As a registered patent attorney before the U.S. Patent and Trademark Office, Jason has prepared and prosecuted domestic and international patent applications in the areas of computer software and telecommunications, as well as in the chemical, pharmaceutical, medical, and metallurgical arts. Jason also has counseled clients on infringement, validity, and licensing issues.

Before practicing law, Jason worked as an engineer for Kimberly-Clark Corporation where he was involved in the design and manufacture of consumer products.

## PUBLICATIONS

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Jason R. Mudd, *To Construe or Not to Construe: At the Interface Between Claim Construction and Infringement in Patent Cases*, 76 Mo. L. Rev. 709 (2011) (invited)

Jason R. Mudd, *The Federal Circuit Makes a "Leap in Logic": The Dangerous Upstream Use of Related Patents' Prosecution History to Interpret Claims in Already Issued Patents*, 70 Mo. L. Rev. 291 (2005)

Jason R. Mudd, *Liberalizing the Mansfield Rule in Missouri: Making Sense of the Extraneous Evidence Exception after Travis v. Stone*, 69 Mo. L. Rev. 779 (2004)