

## Garfield B. Simms

Attorney  
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Garfield litigates a range of matters related to patent, trademark and trade secret infringement. He brings more than 20 years of litigation experience to Banner Witcoff and has successfully litigated numerous matters involving complex technologies, including light-emitting diodes, digital imaging, digital televisions, digital cameras, 3G and 4G digital communications, electronic sensors, electronic commerce, data caching, bar code readers and power management systems in electronic devices.

His IP experience involves both offensive and defensive matters in district court and before the International Trade Commission (ITC). His experience includes performing extensive case research, drafting legal memoranda, preparing letter motions, briefs, claim contentions, as well as conducting all aspects of discovery, interfacing with various testifying and consulting experts, and conducting depositions. His experience spans initial investigations determining infringement, through motions practice, Markman hearings and trial. He also has first chair trial experience before the ITC.

Additionally, Garfield has drafted patent specifications for various internet applications, semiconductor devices, optical instruments and imaging systems, prepared foreign and U.S. office responses, and performed miscellaneous patent prosecution, counseled clients and provided litigation support. He also has drafted electrical and mechanical patent applications, prepared foreign and U.S. office responses, performed miscellaneous patent prosecution duties, counseled clients and provided litigation support.

Garfield has provided pro bono services for many years to a range of clients and received special recognition for his work. He also has been a member of the board of directors of the Lawyers Committee for Civil Rights Under Law since 2009.

In addition to his legal background, Garfield has extensive teaching experience, serving as assistant professor teaching calculus and pre-calculus to business and pure science majors and conducting research on novel semiconductor devices at Hampton University in Hampton, Va.; teaching PASCAL to high school students in a NSF-funded summer program at the University of Massachusetts, in Amherst, Mass.; and as a teaching assistant at the University of Delaware, in Newark, Del., where he monitored student progress in basic semiconductor physics and electricity and magnetism.

### Education

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Delaware State College  
1985, B.S., Physics & Mathematics

University of Delaware  
1989, M.S., Electrical Engineering  
1992, PhD, Electrical Engineering

Northeastern University School of Law  
1997, J.D.

## Admissions

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### Bar Admissions

1998, Massachusetts  
2010, District of Columbia

### Court Admissions

U.S. Patent and Trademark Office  
U.S. District Court for the District of Massachusetts

## Practices

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Litigation  
PTAB Litigation  
Section 337/ITC Litigation

## Industries

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Electrical + Computer Technologies

## Representative Matters

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### Litigation Experience

- Sharpe Innovation, Inc. v. U.S. Mobile, LLC, Civil Action No. 1:19-cv-06436 (S.D.N.Y.): Lead counsel for USMobile defending against patent infringement claims involving SIM card suppliers. Parties reached a negotiated settlement on favorable terms for client.
- Strike 3 Holdings, LLC v. John Doe Subscriber ; Civil Action No. 6:19-cv-006239-EAW (W.D.N.Y.): Lead counsel for defendant against Plaintiff's allegations of copyright infringement using bit torrent file distribution network. Parties reached a negotiated settlement.
- Malibu Media, LLC v. John Doe Subscriber, (S.D.N.Y.): Lead counsel for defendant against Plaintiff's allegations of copyright infringement using bit torrent file distribution network. Parties reached a negotiated settlement.
- Honeywell International Inc. v. Cree, Inc., Civil Action No. 2:14-cv-02004 (D.N.J.): Cree defended claims of infringement based on Honeywell patents directed to white LEDs. Represented Cree, Inc. against patent infringement claims brought by Honeywell Inc. in New Jersey concerning two patents directed to white LEDs, one of which had been re-issued by the USPTO in light of Cree's products.
- In the Matter of Certain Digital Televisions and Certain Products Containing Same and

Methods of Using Same: Represented Vizio, Inc. against Funai, Inc. in an ITC Section 337 investigation involving digital transmission of data to televisions (Inv. No. 337-TA-617). After 5-day trial, the lawsuit was successfully settled.

- **SuperSpeed LLC v. International Business Machines Corporation** (E. D. Tex.): Represented defendant IBM in a patent infringement case relating to management of data caching on computer networks. IBM counter sued Superspeed's SuperVolume and Super Cache products related to server and application performance solutions used to optimize hardware utilization. The lawsuit was successfully settled before trial.
- **Certain Laminated Floor Panels**: Represented respondents Vöhringer Wood Product Co., Ltd., Shengda Flooring Corporation and Power Dékor Group Co., Ltd., in a patent infringement action before the International Trade Commission (Inv. No. 335-TA-545).
- **Eastman Kodak Co. v. Sony Corp.**, (W.D.N.Y.): Represented Eastman Kodak Company in concurrent patent infringement cases. Primary responsibilities involved developing Kodak's offensive positions regarding its digital camera patent portfolio (27 patents) relating to digital image processing, compression and storage, and CCD structure and operation in digital cameras.
- **Motorola, Inc. and Freescale Semiconductor, Inc. v. Analog Devices, Inc.** (E.D. Tex.): Represented Motorola and Freescale in a patent infringement lawsuit involving 11 semiconductor product, packaging and process patents covering microchip fabrication and circuitry technology. The case settled on favorable terms shortly before trial.
- **Symbol Technologies, Inc. v. Hand Held Products, Inc.** (D. Del.): Represented defendant Hand Held Products in an infringement action on 12 patents and declaratory judgment on 36 other patents for barcode scanners and imaging. A settlement was reached after successfully dismissing patents out of Delaware and defeating a motion to transfer from Virginia.
- **In Re Elonex Phase II Power Management Litigation** (D. Del): Represented Elonex, the patentee and a leading UK computer manufacturer, in patent litigation relating to power management for PCs and computer monitors. Phase II defendants (22 total) include Apple Computer, ADI Systems, Compaq, Compal, Daewoo Electronics, Delta Electronics, Envision Peripherals, and Gateway. Phase I defendants included Dell, Gateway, Hewlett-Packard, MAG technology, Micron Technology, Mitsubishi, NEC, Philips, Princeton Graphics and Sony.
- **Novozymes A/S v. Enzyme Bio-Systems** (D. Del): Represented EBS, a manufacturer of, inter alia, the product ULTRA-pHLo, an alpha amylase enzyme used commercially to assist in breaking down starches into sugars. Novozymes sought a preliminary injunction to enjoin EBS from making, using and selling ULTRA- pHLo.
- **Micron Technology v. Rambus** (D. Del.): Represented Rambus. Rambus asserted eight patents relating to DDR-SDRAMs. In a declaratory judgment action, Micron alleged, inter alia, that Rambus breached an agreement to them as members of a standard setting organization called JEDEC. The litigation was stayed awaiting an appeal of a related case in Virginia.

## **Pro Bono Experience**

- **Lawyers Committee for Civil Rights Under Law.** Member of the Board of Directors since 2009 to present. December 2016 Received Special Recognition Award for work related to preparing materials providing guidance to peaceful protestors in various U.S. cities.
- **Buck v. Davis**, 580 U.S. \_\_\_ (2017) (Roberts, J.). Member of an Amicus team in a death penalty case in which the state of Texas secured a death sentence based upon Buck's race. Defense counsel introduced expert testimony that Buck's race was a risk factor that made "future dangerousness" more likely. In a six to two decision, the United States Supreme Court reversed and remanded the decision below, holding that Buck's death sentence was the unjust result of racial discrimination.
- **Henson Valley Montessori School Bankruptcy Counseling.** Henson Valley Montessori School, Inc. ("HVMS"), a nonprofit organization located in Upper Marlboro, Maryland, is considering filing bankruptcy under Chapter 11 or Chapter 7. With the assistance of two bankruptcy attorneys, providing HVMS with corporate restructuring advice.
- **Office of the Montgomery County Public Defender.** Represented a client charged with Assault in the

Second Degree (Count one), Failure to Register (Count two), and Reckless Endangerment (Count three). The maximum sentence the court could impose was 18 years and \$12,500 in fines. The court could also revoke the client's probation meaning that Client C would have to serve nearly five (5) years of the remaining sentence from a prior conviction. The State ultimately filed a nolle prosequi – conceding that it lacked sufficient evidence to proceed to trial on all counts. Also, worked with the Montgomery Board of Probation and Client's parole officer to reinstate probation and to obtain Client's immediate release from imprisonment.

- **Children's Law Center.** Assisted a Grandmother in obtaining permanent custody of her grandchildren who had been living with her since birth. The Client sought custody to prevent eviction, to register children for school and obtain minimal state aid for their care. Both birth parents were incarcerated. The birth mother was also battling drug addiction. The parents consented to the placement.
- **American Association of People with Disabilities.** Represented AAPD on a trademark infringement matter. Prepared cease and desist letters and assisted AAPD in reaching a negotiated settlement.

\*Garfield handled some of these matters prior to joining Banner Witcoff.

### **Affiliations/Memberships**

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Member, American Bar Association

Member, American Intellectual Property Law Association

Member, Lawyers Committee for Civil Rights Under Law Board of Directors

Member, D.C. Bar

Member, International Trade Commission Trial Lawyers Association

Member, Massachusetts Bar Association

Member, National Bar Association