



contact

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My clients realize that I always give their issues very careful consideration and am thoughtful and deliberate in my analysis and advice, while working efficiently. They appreciate that I present them with all relevant information and potential options, guiding them through the logical result of adopting one trajectory over another. Together we work toward the best decision possible for their objectives and businesses.

In his intellectual property practice, Ted McDonough counsels clients on a wide range of issues in patent cases that arise in many industries, including pharmaceuticals, nutraceuticals, diagnostic testing, medical products, consumer electronic products, entertainment, and financial services, among others. As well as litigating in patent court, Ted advises organizations and individuals from across the country in the federal patent and trademark laws and also counsels inventors from many countries around the globe.

Ted brings extensive knowledge and experience to representing clients in every phase of infringement cases, from pre-suit investigations to fact and expert discoveries, parallel U.S. Patent and Trademark Office inter partes proceedings, summary judgment motions, trials, appeals, and settlements. Recently he has been helping clients navigate the fallout and unsettled nature of the legal landscape in the aftermath of a Supreme Court decision that increased the difficulty of patenting software-based inventions. Ted closely monitors judicial

decisions and regulatory moves and alerts clients of possible changes that might affect them – often looking at issues on the horizon before changes have been made.

Putting his stellar communication and analytical skills to work, Ted crafts briefs and writes persuasive arguments in IP appellate advocacy. He enjoys the intellectually stimulating and often challenging nature of this work and likes that it requires him to stay on his toes and get creative while remaining vigilant and thorough. Ted also finds it gratifying that his efforts in the appeals courts often result in him helping to shape the law in ways that make sense to him and favor his clients.

Ted is involved with rendering validity and infringement opinions, counsels clients on trademark issues and license and technology agreements, and frequently handles electronic discovery issues. With an educational background in life science, Ted draws on his scientific knowledge and training and uses this broad understanding of and familiarity with technologies, concepts, and scientific writings to benefit his clients and their patent cases. He also serves as a member of the firm's Ethics Committee.

Experience

- Representing Japanese producer of chemical products in parallel infringement proceedings in California and Texas U.S. District Courts, and in appeal to United States Court of Appeals for the Federal Circuit.
- Conduct infringement investigation on behalf of owner of the patent for web-based electrical circuit design tool.
- Advise New York Not for Profit corporation in connection with management, governance and intellectual property issues.
- Advising New York based financial services company on Foreign Corrupt Practice Act issues, including review and revision of company's FCPA policies and assisting company with responses to subpoena from SEC.
- Advise intermodal equipment provider on antitrust issues concerning proposed equipment leasing arrangement.
- Advise thoroughbred horseracing industry group in connection with antitrust issues.
- Representing hedge fund manager in dispute over transaction involving the purchase of environmental commodities.
- Represented one of Manhattan's largest landowners in drafting and negotiation of construction contracts for commercial properties and in dispute arising from construction accident involving client's building.
- Represent natural gas pipeline company in connection with pipeline expansion project.
- Advise state government entity in connection with proposal to construct and operate nuclear waste repository at Yucca Mountain, Nevada.
- Represent municipal electric provider in litigation concerning siting of new electric generating facility.
- Represented Empire State Development Corp. in litigation relating to Columbia University campus expansion project (*Kaur v. New York State Urban Dev. Corp.*, 15 N.Y.3d 235 (2010)).
- Represented the City of New York in connection with the Hudson Yards Rezoning and Development – No. 7 Subway Extension Project including litigation of claims for compensation.
- Represented the Port Authority of New York and New Jersey in its planning for possible condemnation in connection with its Access to the Region's Core project, which involved novel issues relating to acquisition of interests within existing buildings to create subway entrances and imposition of negative easements to limit construction above the proposed tunnel structures.
- Represented New York City Economic Development Corporation in connection with the Willets Point Redevelopment Plan.

Outside the Office

I'm a father and I coach youth sports including softball, baseball, and football. I like to read, primarily historical fiction, as well as other genres. I'm an avid skier, work out frequently, and also have my open water diver certification.

Practices

Litigation and Disputes

Intellectual Property
Condemnation
Cannabis, Hemp & CBD Industry Group
First Amendment and Media Law

Admissions

Bar Admissions

New Jersey
New York

Court Admissions

U.S. District Court for the Eastern District of New York
U.S. District Court for the Southern District of New York
U.S. Patent and Trademark Office

Education

Seton Hall University School of Law (JD, *magna cum laude*, Order of the Coif, 2007)

- Comments Editor – *Seton Hall Law Review*

The Pennsylvania State University (BS in Life Science, , 2001)

Awards/Honors

Super Lawyers® - "Rising Star," 2016-2018