



## 2021 TOP INTELLECTUAL PROPERTY LAWYERS

### James L. Davis Jr.

Davis focuses on high stakes intellectual property litigation at the U.S. Court of Appeals for the Federal Circuit, in district court and at PTAB proceedings. His background in electrical and computer engineering at the University of Illinois comes in handy, he said. He also graduated from law school there.

"The science was my introduction to an evolving field," he said of studying engineering in the early 2000s. "I do think back to those classes often."

His clients have included Emerson Electric Co., Samsung Electronics Co. Ltd., SAP SE, Activision Blizzard Inc., Electronic Arts Inc., NXP Semiconductors N.V., SkyKick Inc., Spansion Inc., and RR Donnelley & Sons Co.

As lead, co-lead and second chair across dozens of proceedings for Emerson Electric, Davis and his team have won every case and appeal that have reached a final decision in its long-running dispute with SIPCO LLC over Emerson's Smart Wireless products.

"This is a non-practicing entity that's been asserting a portfolio of patents against the wireless industry for a while," Davis said of his litigation foe.

The wins Davis has obtained span venues across the U.S. and Europe, including at the International Trade Commission and the U.S. Supreme Court.

The most recent development in the Emerson-SIPCO conflict addressed an issue of first impression. The U.S. Court of Appeals for the

Federal Circuit affirmed a win for Emerson after Davis argued for his client in January.

The PTAB had agreed with Emerson that certificates of correction issued after inter partes review is complete cannot have a retroactive effect — rejecting SIPCO's argument to the contrary.

The circuit affirmed two days after oral argument. *SIPCO LLC v. Emerson Electric Co.*, 18-1364 (Fed. Circ., filed Jan. 21, 2021).

And in a precedent-setting decision last year, the Federal Circuit agreed with Davis' argument that the court is not permitted to review whether a patent is a covered business method patent when it has been found unpatentable in a CBM proceeding.

Originally, the panel accepted SIPCO's argument that it could reach this issue and remanded the case for a further PTAB decision.

"That was a rare win for SIPCO, and we had to take it up," Davis said.

The U.S. Supreme Court granted Emerson's petition for certiorari, vacated the Federal Circuit's decision, and remanded.

Then, in November 2020, the Federal Circuit held that it had no jurisdiction to decide whether a patent was a covered business method patent subject to CBM review. *SIPCO LLC v. Emerson Electric Co.*, 18-1635 (Fed. Circ., filed Nov. 17, 2020).

Davis once worked at Emerson.

"I did web development as a summer job in 2000," he said. "That work has long been superseded, but my legal work goes on. It's a



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pleasure now to help out a company that gave me my first real job."

— John Roemer