

Marion P. Metelski

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Marion P. Metelski practices intellectual property law, with an emphasis on patent-related matters. His practice includes advising clients on all aspects of intellectual property law, including how to develop and enforce their patent portfolios, helping clients to develop and implement patent licensing programs, negotiating and drafting license agreements, rendering opinions as to the infringement and validity of patents, prosecuting patent applications, and patent litigation and arbitration.

Mr. Metelski has substantial experience in licensing patent portfolios in Asia, in particular Japan and Taiwan, involving technologies related to television receivers, CD discs and drives, and DVD discs and drives. His involvement in such licensing programs has included analyzing and evaluating potential assertions of patent infringement; preparing, evaluating, and revising documentation and presentations that demonstrate patent infringement; and taking a lead role during licensing negotiations.

In 2002, Mr. Metelski served as in-house patent counsel for Matsushita Electric Industrial Co., Ltd.'s Intellectual Property Rights Operations Company in Osaka, Japan. While there, he played an active role in advising Matsushita with respect to all facets of its patent-related activities, including analyses related to patent infringement and validity, claim construction, licensing in, licensing out, reverse engineering, and patent prosecution. He actively participated in numerous licensing negotiations.

Over the course of his practice, Mr. Metelski has dealt with a wide range of technologies including, television receivers, optical discs and drives, hard-disk drives, medical imaging systems, medical devices, switch-mode power supplies, motors, digital-to-analog converters, computer keyboards, three-dimensional virtual reality systems, semiconductors, phase-locked loops, analog and digital circuits, videocassette recorders, CMOS image sensors, DRAMs, power MOSFETs, cell-based integrated circuits, active matrix LCDs, digital still cameras, digital camcorders, cell phones, video production systems, nuclear fuel storage systems, computer file formats and file systems, video compression, financial services, and business methods.

Prior to joining Amster, Rothstein & Ebenstein LLP, Mr. Metelski was employed as a Patent Counsel with the GE/RCA Licensing Management Operation, Inc., a unit of the General Electric Co. While there he solicited invention disclosures from inventors, prepared and prosecuted U.S. and foreign patent applications, and was involved in patent licensing programs related to CD-ROM drives, color televisions, and color display monitors. In these licensing programs he was involved in searching for patents that could be asserted, interpreting claims, reading claims on infringing products, and reverse engineering products to confirm infringement, in addition to actively participating in the resulting licensing negotiations with prospective licensees.

Before turning his attention to the law, Mr. Metelski worked as an electrical engineer, first as a Project Engineer at Avionic Instruments, Inc. and then as a Member of the Technical Staff at the Astro-Space Division of General Electric Co. In both positions Mr. Metelski was involved in the design, testing, and manufacturing of power supply technology, such as static inverters and low-voltage dc-dc converters, for the aerospace industry.

Mr. Metelski received his Bachelor and Master of Engineering degrees in electrical engineering from Stevens Institute of Technology. He received his Juris Doctor degree, cum laude, from Syracuse University, and his Master of Laws degree in Trade Regulation from New York University.

EDUCATION

- New York University School of Law, New York, New York, 2001, LL.M. (Trade Regulation)
- Syracuse University College of Law, Syracuse, New York, 1994, J.D., *cum laude*, Dean's List; Managing Editor, Legislative Research Bureau (1993-1994); Legislative Research Bureau's Law and Public Policy Award; College of Law Certificate for Antitrust Law; Certificate of Specialization in Law and Economics
- Stevens Institute of Technology, Hoboken, New Jersey, 1990, Master of Engineering (Electrical)
- Stevens Institute of Technology, Hoboken, New Jersey, 1987, Bachelor of Engineering, Dean's List

PROFESSIONAL ASSOCIATIONS & MEMBERSHIPS

- American Intellectual Property Law Association; American Bar Association
- New York State Bar Association; Institute of Electrical and Electronic Engineers

BAR ADMISSIONS

- District of Columbia, 1997; New York, 2003
- Maryland, 1994
- New Jersey, 1994

BAR ADMISSIONS CONT.

- U.S. District Court for District of New Jersey, 1994
- U.S. Patent and Trademark Office, 1994

PROFESSIONAL EXPERIENCE

- General Electric Co., GE/RCA Licensing Management Operation, Inc., Patent Counsel, 1995-1999
- General Electric Co., Astro-Space Division, Member of Technical Staff, 1989- 1991
- Avionic Instruments, Inc., Project Engineer, 1987-1989

PUBLISHED WORKS

- **ARE Patent Litigation Alert: Federal Circuit—Applying Section 101 as a “Coarse Filter”— Confirms the Patent Eligibility of Some But Not All Claims In Classen Remand**
September 1, 2011
- **ARE Patent Litigation Alert: Federal Circuit Turns Its Attention to Natural Phenomena Under 35 U.S.C. § 101**
December 17, 2010
- **ARE Patent Law Alert: The Enlarged Board of Appeal of the European Patent Office Declines to Provide Further Guidance on the Patentability of Computer-Implemented Inventions**

PUBLISHED WORKS CONT.

- **Under the European Patent Convention**
May 18, 2010
- **ARE Patent Law Alert: Tafas v. Doll Round IV: Down For The Count**
October 8, 2009
- **ARE Patent Law Alert: Rehearing En Banc Granted in Tafas v. Doll**
July 8, 2009
- **ARE Patent Law Alert: Tafas v. Doll – Round II: One Down, Three to Go**
March 23, 2009
- **Tafas v. Doll – Round II: One Down, Three to Go**
- IP Law360, March 24, 2009
- **High Court Sets Patent Exhaustion Law Back On Track**
- IP Law360, July 10, 2008
- **The Boundaries of Patent-Eligible Processes in Bilski**
- IP Law360, May 09, 2008
- **New PTO Rules on Continuing Applications and Claim examination Practice: Learning to Count to 2 (+1 RCE) and 5/25**
- NYIPLA Bulletin, September/October, 2007