

**NEWARK, NEW JERSEY**

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PRACTICE AREAS:

[Intellectual Property Litigation](#)

[Intellectual Property](#)

STATE 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:

J.D., Seton Hall University School of Law, magna cum laude, Order of the Coif, 2007; Comments Editor – Seton Hall Law Review

B.S., Life Science, The Pennsylvania State University, 2001

Theodore Y. McDonough

MEMBER

Ted McDonough is a seasoned IP counselor who has advised clients in a wide range of industries including pharmaceuticals, nutraceuticals, diagnostic testing and laboratory equipment, medical products, consumer electronic products, entertainment, and financial services, among others.

Ted brings extensive knowledge and experience to representing clients in every phase of infringement cases, from pre-suit investigations to trial and appeal. He has litigated parallel U.S. Patent and Trademark Office and district court proceedings, successfully argued dispositive motions, and has appeared in a number of federal trials. Putting his stellar communication and analytical skills to work, Ted enjoys crafting persuasive briefs, and particularly enjoys appellate advocacy. Although comfortable in adversarial settings, Ted also understands the value presented by amicable resolution of disputes, and has successfully mediated and negotiated positive settlements for his clients both before and after commencement of litigation.

Ted also 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. At his prior firm Ted enjoyed serving as a member of the Ethics Committee.

REPRESENTATIVE MATTERS

- 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.

PROFESSIONAL AFFILIATIONS

- Federal Bar Association

AWARDS AND RECOGNITION

- Selected for inclusion in *New York Super Lawyers – Rising Stars*