

Víctor M. P.



# Practice Areas Health & Insurance Law Intellectual Property Copyrights Internet & E-Commerce Law IP Licensing IP Litigation Patents Portfolio Management Trade Secrets

# Education

Trademarks

ESADE Law School, LL.M., 2010 University of Puerto Rico Law School, J.D., 2007

University of Barcelona Law School, L.L.L., 2007

University of Puerto Rico, B.S.in Chemistry, 2003

# **Bar Admissions**

Commonwealth of Puerto Rico U.S. District Court for the District of Puerto Rico

U.S. District Court for the Eastern District of Texas

United States Patent and Trademark Office

Puerto Rico Notary Bar

# Víctor M. Rodríguez-Reyes

Senior Member

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Víctor M. Rodríguez-Reyes is a Senior Member with our Intellectual Property and Health Law & Insurance practice groups. He counsels clients in all areas of intellectual property, is a Registered Patent Attorney before the United States Patent and Trademark Office, and does patent litigation and patent drafting and prosecution.

Victor represents clients, plaintiffs and defendants, in patent infringement cases in several United States District Courts. He focuses on the technical aspects of patent infringement, invalidity, and claim construction. He also represents clients before the Patent Trial and Appeal Board in trial proceedings including Inter Partes Reexaminations. He litigated one of the first cases brought under the Puerto Rico Trade Secret Act, obtaining a preliminary injunction, which was confirmed by the Puerto Rico Court of Appeals.

Prior to joining Ferraiuoli, Victor worked as a legal intern in the Intellectual Property Litigation Department of Clifford Chance in Barcelona, Spain. He participated in the preparation of oral arguments for patent infringement and unfair competition hearings and performed infringement analysis of pharmaceutical patents. Before entering the Intellectual Property field, Victor worked in the health and insurance industries as In–house Counsel for Medical Card System, Inc. and as Compliance Officer at the Puerto Rico branch of the Office of Public Health Preparedness and Response. His experience included litigation of administrative proceedings before the Commissioner of Insurance, the Puerto Rico Health Insurance Administration, and the Centers for Medicare and Medicaid Services. He has actively participated in high-profile negotiations involving hospitals, software companies, and government entities, and the bidding processes for public health plan contracts.

Victor is also a Chemist and performed undergraduate research at Argonne National Laboratory and at the University of Puerto Rico, Río Piedras Campus in the fields of atmospheric chemistry and physical chemistry.

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# **Representative Cases or Transactions**

- Quality Water Service and Distribution Corp. v. Caribbean Water Coolers, Inc., et al., Puerto Rico Appellate Court (August 28, 2012) PKLCE201200503, 2012 PR App. LEXIS 2852.
- Master Lock Company LLC, v. Toledo & Co., Inc., United States District Court, D. Puerto Rico. October 17, 2014
   No. 3:13-CV-01658-PAD. 2014 WL 7670530.
- Toledo & Co., Inc., v. Master Lock Company LLC, Case IPR2014-01542 (Patent Tr. & App. Bd.).
- Toledo & Co., Inc., v. Master Lock Company LLC, Case IPR2014-01540 (Patent Tr. & App. Bd.).
- Canatelo LLC v. Trendnet, Inc., 3:13-cv-01093-PAD (D.Puerto Rico).

### **Publications**

- How I Learned to Stop Worrying and Love the Bomb: a Personal Look at the IPR's Strangelove, Pulse blog, May 2015.
- Drink it Up: Rums of Puerto Rico's New Marketing Campaign, Marca Sur International, January 28, 2015.
- Appeals Court discusses nature of franchise agreements, World Trademark Review, October 20, 2014.
- A Trade Dress Does Not a Designation of Origin Make, Marca Sur International, August 10, 2014.
- Court of Appeals issues decision on certification marks; World Trademark Review, June 19, 2014.
- The Theory of Immoral Infringement, Marca Sur International, April 30, 2014.
- Patents and the Search for Economic Growth, Marca Sur International, November 6, 2013.
- Protecting Your Secrets from the Free Riders, Marca Sur International, April 24, 2013.
- All IP is Not Created Equal: Protection v. Enforcement of IP Rights, Marca Sur International, March 9, 2012.
- The New Order in Authors' Rights, Marca Sur International, January 1, 2012.
- Copyrights and Syncretism: Trouble in Mixed Jurisdictions, Marca Sur International, November 21, 2011.
- Co-author: The Income and Consumption Tax Reform in the United States, Journal of Social Economics and Business, Cooperative Institute for Public Economics and Financial Law, Barcelona, Spain, February 3, 2006, pp. 49-60.

### **Speaking Engagements**

- *Protection and Commercialization of Inventions*, Continuing Education Course, PRChem 2013, Río Grande, PR, July 2013.
- *Processes and Costs of Patenting Products and Services*, Seventh Forum for Inventors and Entrepreneurs, San Juan, PR, October 2012.
- *Patenting Procedures and Policy*, Professional Development Program of External Resources: Complying with Scientific Research, San Juan, PR, May, 2012.
- Co-speaker, Effects of the America Invents Act on Academia, Ninth Educational Congress Sistema Universitario Ana G. Mendez, San Juan, PR, November, 2011.

## Affiliations (Bar Association, Professional Organizations)

- American Intellectual Property Law Association (AIPLA)
- American Bar Association Intellectual Property, Litigation, Health Law and Tort, Trial and Insurance Sections