



Kassim M. Ferris

Partner

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"I strive for a deep understanding of our clients' businesses and the industries in which they operate, which helps me deliver practical and insightful solution-oriented advice on complex legal matters."

Kassim Ferris applies his technological knowledge to deliver business-centric solutions to complex legal and regulatory challenges. His practice spans a broad spectrum of intellectual property matters, including domestic and international patent procurement, patent opinions, technology licensing, technology development and collaboration agreements, patent enforcement, and intellectual property dispute resolution. Kassim also advises on trademark and copyright matters, and IP aspects of corporate transactions and government contracts. He also represents clients on national security and international trade matters.

Kassim has experience procuring patents on a wide range of mechanical, electromechanical, optics, and computer-related technologies, notably including atomic layer deposition, electrical connectors, sporting optics, ballistics, gun safety equipment, precision motion and positioning systems, image processing, food packaging, electronic image display technologies, building products, fenestration systems, apparel, and footwear. He is also versed in materials science, metallurgy, plastics molding, progressive die stamping, and semiconductor integrated circuit fabrication. He finds joy in collaborating with engineers and technologists, and takes pride in obtaining defensible patents that provide clients with a real business advantage for sophisticated inventions, whether complex or elegant.

Kassim also leverages his technical and IP expertise in guiding clients through national security reviews by the Committee on Foreign Investment in the United States (CFIUS), and advising on compliance with U.S. export controls, sanctions, and embargoes. He has provided national security diligence and advice on more than 250 transactions involving foreign investments in U.S. software and technology companies, infrastructure, and energy projects, and has filed numerous notices and declarations with CFIUS. He also advises on compliance with export regulations and economic sanctions.

Education

J.D., Willamette University
College of Law, 1996

B.S.M.E. with mathematics
minor, Colorado State
University, 1990

- Tau Beta Pi

Bar Admissions

Oregon
Washington
District of Columbia
U.S. Patent and Trademark
Office

Court Admissions

U.S. Court of Appeals,
Federal Circuit

U.S. District Court, District
of Oregon

Professional Activities

- Optica (f.k.a. Optical Society of America), Columbia Section
- Oregon Patent Law Association
- Outdoor Industry Association, Former Member
- American Intellectual Property Law Association, Former Member
- Intellectual Property Owners Association, Former Patent Search Committee Member

Civic Activities

- Saturday Academy, Board Member, 2019-present
- Lewis & Clark Small Business Legal Clinic, Former Pro Bono Attorney
- Legal Aid Services of Oregon, Former Pro Bono Attorney

Representative Experience

Patent Procurement and IP Portfolio Management

- Successfully prosecuted patents on a scramjet engine with variable fuel injection for hypersonic thrust over a large mach number range, for use in next-generation space launch vehicles.*
- Successfully prosecuted patents on a phonetic markup system and text encoding method for teaching reading skills, overcoming difficult examiner's rejections on subject matter eligibility grounds under 35 U.S.C. § 101.*
- Served as primary outside IP counsel to a global manufacturing company with over \$4 billion in annual revenue, including managing its portfolio of nearly 1000 active patent and trademark matters, patent preparation and prosecution, design protection strategy, IP licensing, patent dispute resolution, IP aspects of corporate acquisitions, and patent clearance for new products.*
- Represented a private company in a multimillion-dollar acquisition of well-known brand assets and patents from a public company.*
- Represented a public company in a \$3.5 million divestiture of certain patent assets and associated technology to a multinational public company.*
- Represented electronic display technology company, Planar Systems, Inc., in connection with its divestiture of the CoolSign digital signage business, in two separate transactions: the sale of a joint interest and exclusive IP rights in the field of gaming to a leading gaming and entertainment technology company, and the subsequent sale of the remaining joint interest and exclusive IP license rights outside the field of gaming to a second buyer in the digital signage and advertising software business.*

Intellectual Property Dispute Resolution

- Represented a sports optics manufacturer in complex patent enforcement litigation against a competitor through summary judgment on eight patents covering five distinct technologies. The litigation was ultimately resolved on mutually agreeable terms via a license agreement.*
- Advised an educational software company on legal and business issues arising from gaps in a complex chain of title to patent and copyright assets, and successfully leveraged strategic legal action to secure title ownership.*
- Represented one of the world's largest door and window manufacturers in a contentious renegotiation of a long-term patent license from a provider of equipment and technology for making insulated glazing units, resulting in significant financial savings.*
- Represented a manufacturer of emergency rescue and medical training equipment, in successful enforcement of a patent on bleeding simulation systems for training field medics, including handling briefing and oral argument on patent claim construction and on a motion for summary judgment, preparing discovery responses, facilitating expert reports, and assisting with briefing on a successful appeal to the U.S. Court of Appeals for the Federal Circuit.*

National Security and International Trade Compliance

- Represented Inpria Corporation, a pioneer of inorganic photoresists for extreme ultraviolet lithography used in advanced semiconductor manufacturing, in five simultaneous mandatory declarations to CFIUS in connection with a \$31 million Series C round of investment by strategic investors from Korea, Japan, France, and Taiwan.*
- Represented HydrantID, a provider of managed public key infrastructure (PKI) and digital certificate authentication services, through CFIUS review in connection with sale of the company to HID Global, a subsidiary of Swedish lock and security company ASSA ABLOY.*
- Represented a global engineering consulting firm in an investigation by the Department of State, Directorate of Defense Trade Controls (DDTC), Office of Defense Trade Controls Compliance (DTCC), regarding compliance with the International Traffic in Arms Regulations (ITAR) under the Arms Export Control Act (AECA).*
- Represented a semiconductor process technology company in five simultaneous mandatory declarations to CFIUS in connection with a Series C round of investment by investors from Korea, Japan, France, and Taiwan.*
- Represented an Idaho cobalt mine owner, US Cobalt Inc., through CFIUS review in connection with its sale to Canadian company First Cobalt Corp.*
- Represented a Chinese-owned company in connection with its acquisition of a U.S. designer of optical motion capture camera systems and software, including on intellectual property diligence, export classification, and a joint voluntary notice to CFIUS.*

Government Contracting

- Represented SunPower Corporation in drafting and negotiating subcontracts under a \$6.65 million grant from the U.S. Department of Energy for collaborative research and development of a solar and storage-powered microgrid community, including preparing three subaward agreements, a multi-party intellectual property management plan, and a cybersecurity and data protection agreement.*
- Represented a provider of data center facilities and services on compliance with federal government contracting requirements under Section 889 of the John S. McCain National Defense Authorization Act (NDAA).*

*Prior to joining Miller Nash

Publications

- “The Committee on Foreign Investment in the United States: Its Purpose, Powers, and Procedures,” Oregon State Bar, Business Law Section, *Oregon Business Lawyer* (Sept. 2023)
- “Business Law Practice, Part 5: Intellectual Property Considerations,” *Washington Lawyers Practice Manual*, Editor (2006-2008)

Presentations

- “2024 CFIUS Update and Proposed Outbound Investment Regulations,” Oregon State Bar, Business Law Section (Aug. 2024)
- “Intellectual Property Protection in the Defense Industry,” Pacific Northwest Defense Coalition, NW Trade Compliance Conference (July 2024)
- “What Every Business Lawyer Needs to Know About CFIUS,” Oregon State Bar, Business Law & International Law Sections (Apr. 2023)
- “Avoiding Patent Pitfalls: Protecting Your Company’s Crown Jewels,” Outdoor Industry Association, Outdoor University (Apr. 2013)

Recognition & Honors

- Recognized as a “Leader in Their Field” by *Chambers USA* in Intellectual Property, 2009-present
- Selected for inclusion in *Best Lawyers in America*® (Portland, OR)
 - Patent Law, 2013-present
- Selected for inclusion in IAM Patent 1000—The World’s Leading Patent Professionals, 2020-present
- Rated AV® Preeminent™ by Martindale-Hubbell®

Personal Activities

Kassim enjoys time in the mountains—hiking, backpacking, and alpine skiing. He also loves music, travel, and spending quality time with family.