



## Scott A. Felder

Partner



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Scott helps clients identify, protect, manage, and enforce their intellectual property rights. His practice focuses on the complex intellectual property issues confronted by government contractors, including patent rights and rights in technical data and computer software, with emphasis on the aerospace, defense, and intelligence sectors. Scott routinely represents clients in intellectual property disputes and negotiations with the government.

As the head of the firm's Patent Prosecution practice, Scott also represents clients before the United States Patent and Trademark Office, including the Patent Trial and Appeal Board.

A frequent speaker and author on intellectual property issues, Scott is the co-instructor of the Federal Publications Seminars Government Contract Intellectual Property Workshop. He currently serves as a vice-chair of the Intellectual Property and Technology Committee of the American Bar Association's (ABA) Section of Public Contract Law.

### Representative Matters



#### Patent and Data Rights Counseling and Disputes

- Served as counsel for The Boeing Company in a successful appeal to the Federal Circuit regarding a contractor's ability to apply restrictive markings directed to third parties to their technical data deliverables.
- Won summary judgment at the Armed Services Board of Contract Appeals that software development costs charged to a technology investment agreement constitute "private expense" permitting a contractor to assert that the resultant

### Practice Areas



Government Contracts  
Intellectual Property

### Credentials



#### Education

J.D., University of Virginia School of Law;  
Order of the Coif  
M.A., United States Army War College  
B.E., *summa cum laude*, Vanderbilt  
University

#### Law Journals

Executive Editor, *Virginia Sports and  
Entertainment Law Journal*

#### Bar and Court Memberships

District of Columbia Bar  
Missouri Bar  
Supreme Court of the United States  
U.S. Court of Appeals for the Third, Fourth,  
and Federal Circuits  
U.S. Court of Appeals for Veterans Claims  
U.S. District Court for the District of  
Columbia  
U.S. Court of Federal Claims  
U.S. Patent and Trademark Office

software is subject to restricted rights.

- Represents a leading manufacturer of unmanned aircraft systems in a patent infringement action related to its participation in NASA's Mars Exploration Program.
- Represents a Fortune 100 government contractor in a patent infringement action at the U.S. Court of Federal Claims related to video surveillance.
- Represented a Fortune 100 defense contractor in a patent infringement action at the Court of Federal Claims related to uncrewed aerial systems. Successfully argued the authorization and consent aspects of a motion to stay a parallel district court infringement proceeding.
- Won dismissal with prejudice of a patent infringement suit against BAE Systems, Inc., in federal district court on the basis that the alleged infringement was subject to 28 U.S.C. § 1498(a). The Federal Circuit affirmed the dismissal, and the district court awarded BAE Systems attorneys' fees under 35 U.S.C. § 285.
- Lead counsel for the patentee in a patent infringement action against the United States related to military training and simulation technology, resulting in a \$2.1 million judgment against the United States.
- Advises nontraditional defense contractors in connection with their public sector businesses.
- Represents contractors in administrative claims for patent and copyright infringement submitted to the U.S. Department of Defense as well as in patent and copyright infringement litigation at the Court of Federal Claims.
- Represents contractors in pre-challenge requests for information to validate their data rights assertions, formal challenges under the Federal Acquisition Regulation and the Defense Federal Acquisition Regulation Supplement, and in appeals of contracting officer final decisions.
- Advises government contractors in connection with licensing their commercial and non-commercial intellectual property to the government under contracts, grants, cooperative agreements, Other Transaction Agreements (OTAs), cooperative research and development agreements (CRADAs), and technology investment agreements (TIAs).
- Provides advice related to the government's rights in inventions and patents under the Bayh-Dole Act and its implementing regulations.
- Provides patent and data rights training to government contractors.

### **Patent Prosecution and Related Counseling**

- Prosecutes key patent applications and provides related strategic counseling to a Fortune 150 medical device manufacturer.
- Prepares and prosecutes patent applications in several fields, including fluid systems, aerospace and automotive technologies, computer hardware and software, wireless communications, data security, data privacy, and data analytics.

- Represents clients in *inter partes* review proceedings before the Patent Trial and Appeal Board, including filing dozens of petitions to advance litigation-related goals.
- Performs validity, non-infringement, and freedom-to-operate analyses.
- Conducts intellectual property due diligence studies, including in connection with the acquisition and sale of government contractors.
- Assists clients with intellectual property licensing and other transactions.

## Professional Experience

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- U.S. Army Judge Advocate General's (JAG) Corps (2002-Present)
- Chief, Business Operations Law Division, Army Reserve Innovation Command, Houston, TX.
- Group Judge Advocate, 648th Regional Support Group, St. Louis, MO (2018-2020). Served as general counsel to a geographically-dispersed, 1,200-person unit within the Military Intelligence Readiness Command.
- Assistant Executive Officer, Office of the Judge Advocate General, The Pentagon (2016-2018). Assisted the Executive Officer, the Judge Advocate General, and the Deputy Judge Advocate General in managing a Department of the Army Headquarters staff agency providing legal support to the Army Staff and Secretariat.
- Professor (2006-2010, 2013-2016) and Vice Chair (2013-2016), Contract and Fiscal Law Department, The Judge Advocate General's Legal Center and School, Charlottesville, VA. Instructed in Fiscal Law and Government Contract Law, including courses on Intellectual Property in Government Contracts.
- Associate General Counsel/Brigade Judge Advocate, Uniformed Services University of the Health Sciences, Bethesda, MD (2010-2013)
- Assistant Counsel, Office of Chief Counsel, Headquarters, U.S. Army Corps of Engineers, Washington, DC (2002-2005). Advised the Chief Counsel and command senior leadership in all aspects of intellectual property acquisition, management, and enforcement.

## Affiliations

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- American Bar Association (ABA)
  - Vice-Chair (2011-2015, 2019-Present), Co-Chair (2016-2018), Intellectual Property Committee, Section of Public Contract Law
  - Section of Intellectual Property Law
- American Intellectual Property Law Association (AIPLA)
- American Society of Mechanical Engineers (ASME)

- Federal Circuit Bar Association
- Court of Federal Claims Bar Association
- Society of American Military Engineers (SAME)

## Recognitions

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- Named one of DC's "Super Lawyers" for Intellectual Property by *Super Lawyers* magazine (2013, 2015-2020)