

TOP INTELLECTUAL PROPERTY ATTORNEYS in California for 2016

When we're listening to pre-1972 music on rotation in our smartphones or reaching for a ketchup bottle at lunch, intellectual property doesn't come to mind. But these are just a few examples of the work behind the California attorneys we chose on our list for their efforts protecting the intellectual property belonging to companies of all sizes across the country and around the world.

As technology makes vast improvements year after year across the industry spectrum, intellectual property attorneys — litigators and patent prosecutors — are rolling up their sleeves to stay ahead of the game. In California, established Silicon Valley and booming Silicon Beach have created global hubs for such innovation to take place in on-demand services, social media, health care, consumer technology and other various fields. But the fight to protect patents, copyrights and trademarks can start on a local court level and move to the appellate courts, while also heading to the U.S. Patent and Trademark Office, the U.S. International Trade Commission and the U.S. Supreme Court.

Intellectual property attorneys face many hurdles as they try to protect the branding of companies for consumers and a range of venues for those who want to protect their innovations. The attorneys in this issue took those challenges head-on and pushed technological progress forward.

—The Editors

William R. Overend

FIRM

Reed Smith LLP

CITY

San Francisco

SPECIALTY

IP litigation



Overend counts several technology and entertainment companies as clients in his intellectual property litigation practice at Reed Smith. But his most recent victory had nothing to do with either.

It dealt with how savvy shoppers retain their coupons at Safeway Inc.

In 2012, Kroy IP Holdings challenged Safeway on patent infringement of the grocery giant's "Just for U" personalized coupon plan. The allegations hinged on the computer program used to deliver the coupons. *Kroy IP Holdings LLC v. Safeway Inc.*, 12-CV00800 (E.D. Texas, filed Dec. 17, 2012)

The U.S. Supreme Court handed down a ruling that broadened patent protection under an abstract idea, such as using a computer program as delivery mechanism. *Alice v. CLS Bank International*, 134 U.S. 2347 (2014)

"The *Alice* decision certainly bolstered our case," Overend said.

Overend and his team won summary judgment in the Eastern District of Texas in May 2015 when Senior Circuit Judge William C. Bryson, sitting by designation, found Kroy's patent ineligible for protection and that Safeway's use of such technology should be anticipated and obvious because of its role in the industry.

Kroy appealed and lost in April.

"The case was a great example of how today's patent laws and resulting litigation

are being rapidly re-shaped by recent Supreme Court decisions, and how as a litigator you need the dexterity to focus your strategies accordingly," he said.

Parallel to his patent practice, Overend has been working on litigation involving trademarks and trade secrets.

He currently represents Koninklijke Philips N.V. in a case alleging that a former employee of Lumileds Holding B.V., a subsidiary of the Dutch electronics giant, downloaded thousands of trade secrets dealing with high-powered LED "epitaxy" technology and took them to Chinese competitor Elec-Tech International Co.

The former employee fled to China with the alleged downloads, but the case is targeting ETI and several individuals as plaintiffs. *Koninklijke Philips N.V., et al v. Elec-Tech International Co.*, 15-CV-02737 (N.D. Cal., filed March 20, 2015)

"I love this area of practice," Overend said. "I have fascinating clients with amazing technology, and with every case you become a mini-expert on an issue you knew nothing about before."

— Banks Albach