

Daily Journal

OCTOBER 6, 2021



WILLIAM R. OVEREND

A perfect storm is building for businesses using trade secrets to protect their important intellectual property, Overend says.

“Companies are increasingly using trade secrets law to protect key IP assets, and yet at the same time, those assets are becoming more susceptible to theft... from hackers, from competitors, from departing employees, even from state actors,” he said.

While Overend handles patent and other types of intellectual property cases, over the past five or 10 years, trade secrets matters have become a growing share of his practice. As hacking technologies have become more sophisticated, an increasing part of that work, he said, is helping his clients identify and track their trade secrets and strengthen programs to protect them.

He also is experiencing the perfect storm in a pair of litigations on behalf of client Philips Medical Systems and its highly specialized proprietary software used to diagnose and service advanced medical imaging equipment such as diagnostic X-ray, ultrasound, MRI and CT systems. The software is built into the company’s machines, protected there by multiple levels of security protocols.

“What’s happened is across the country a number of the companies that service this equipment other than Philips have obtained ways to hack through Philips’ security,” Overend said. “That allows them to access all of the different levels of service

software... that Philip’s spent years and millions developing but without paying a penny.”

He sued one such competitor in Florida two years ago. The lawsuit settled confidentially this past June, just a month before trial was to begin. *Philips North America LLC v. 626 Holdings Inc.*, 19-cv-81263, (S.D. Fla., filed Sept. 12, 2019)

A second case, pending in North Carolina, alleges that Transtate Equipment Co. hired former Philips engineers, wrongfully obtained trade secret information and then used it to create software that unlocks unauthorized access to Philips’ servicing software and materials. Trial is set for December, Overend said. *Philips Medical Systems Nederland B.V. v. TEC Holdings Inc.*, 3:20-v-00021 (W.D. N.C., filed Jan. 10, 2020)

Overend has also taken on pro bono work to help refugees immigrate to the United States. He obtained special immigrant juvenile status, which provides a path to citizenship, for a teenage client from Guatemala. That case continues in Alameda Superior Court.

A few years ago, he also obtained political asylum for two people from Nigeria and their families. The daughter of one family has now graduated from college, he said. “That’s been really rewarding,” he said of the pro bono work.

FIRM

REED SMITH LLP

CITY

SAN FRANCISCO

PRACTICE TYPE

INTELLECTUAL
PROPERTY LITIGATION

— John Roemer