

Daily Journal

APRIL 9, 2014

TOP INTELLECTUAL PROPERTY ATTORNEYS OF 2014

The most fascinating, and challenging, aspect of naming the intellectual property attorneys in California is the extraordinary variety of their achievements. While they share the same practice area, the lawyers — chosen from hundreds of nominations, along with a few staff selections — range from patent specialists who try cases before the U.S. International Trade Commission to Internet experts who fight the creators of malicious software “botnets.”

To qualify for the list, an attorney must be based in California, even if much of his or her work is done elsewhere, whether it’s the ITC in Washington, D.C., the patent office in Virginia, or district courts in Delaware, Texas and other states. Their focus must be intellectual property, as opposed to general litigators who often handle such work.

The attorneys chosen for the list have helped to advance technological innovation and change the law during the past year, handling work critical to the future of the entertainment, medical and technology industries.

It’s an increasingly difficult group to choose, but the impressive and diverse array of talent from across California is testimony to the state’s leadership in intellectual property law.

—The Editors

TOP LITIGATORS OF INTELLECTUAL PROPERTY

ADAM R. ALPER

FIRM:
KIRKLAND & ELLIS LLP

CITY
SAN FRANCISCO

SPECIALTY
PATENT

Alper, with co-counsel Michael De Vries, scored a major win last year related to standard essential patents and RAND licensing.

Owners of standard essential patents, which are key to industry standards, are generally required to license them based on reasonable and nondiscriminatory terms — commonly called RAND — when they participate in the standards development process.

Innovatio IP Ventures LLC had sued both large corporations and small businesses for allegedly infringing certain standard essential patents related to wireless technology. The company sought more than a billion dollars in damages.

“Innovatio sent thousands of demand letters out to users of Wi-Fi devices,” Alper said. “They were not the suppliers of computer chips or laptops, but the people who buy them and use them.”

In total, there were 23 patents asserted and dozens of defendants

throughout the country involved, including Cisco Systems Inc., Motorola Solutions Inc., and Netgear Inc. *In re Innovatio IP Ventures LLC Patent Litigation*, 13-09308 (N.D. Illinois, filed Oct. 3, 2013).

Early on, Alper and his team “felt that paying attention to the damages issues in a proactive manner would drive a resolution,” he said. Ultimately, the court agreed to put off considering the liability and infringement matters, among others, and proceeded to have two trials on damages issues.

The key to the case was determining the RAND royalty rate for the patents at issue.

Innovatio originally demanded \$2,300 per location using Wi-Fi.

But the court found that the plaintiff’s analysis supporting its demand lacked credible methodology, Alper said, and also suffered from a failure of proof.

Whittling down the sum demanded by Innovatio, the court held that the



maximum royalty rate was 9.56 cents per Wi-Fi chip.

“This order is unique in that it provides a specific, quantitative method for calculating a RAND royalty rate,” Alper said. “This is also the first court to look closely at the requirements for a claim to be subject to RAND obligations”

— Pat Broderick