

# Daily Journal

APRIL 6, 2011

## Intellectual Property

### TOP 75 CALIFORNIA IP LITIGATORS



**Terrence P. McMahon**  
McDermott Will & Emery LLP  
Silicon Valley  
Patent

With both an undergraduate degree and a law degree from Santa Clara University, McMahon thinks of himself as “indigenous”

to Silicon Valley.

For more than three decades, he has practiced intellectual property law while the region blossomed into a start-up hotbed. It wasn't just a boom time for companies, he says, but for law firms, too.

“Every law firm on the planet moved into Silicon Valley to open an office,” he said. In 1995, one of those firms, Orrick brought on McMahon to help seed the firm's intellectual property group.

“When I got there, the IP department was, like, one,” he said. “It was me.”

He drew other intellectual property lawyers to the fledgling practice group, and it grew. By the time he left for McDermott Will & Emery LLP in 2001, McMahon says the IP group at

Orrick topped 80 lawyers.

But while his roots have long been planted in the soil of Silicon Valley, his practice branches nationwide. Cases regularly sweep him across the country, bouncing him from one airport to another before bringing him back to his Menlo Park office.

Last year, McMahon successfully defended software maker Sybase Inc. in the U.S. District Court for the Eastern District of Virginia. TeleCommunication Systems Inc. alleged that Sybase had infringed on patents surrounding two-way messaging protocols. He also filed a patent case on Sybase's behalf against TeleCommunication Systems on multiple patents. *TeleCommunication Systems Inc. v. Sybase 365 Inc.*, CV09-00387 (E.D. Va.) and *Sybase 365 LLC v. Telecommunication Systems Inc.*, CV09-00493 (E.D. Va.)

In 2009, he won a favorable settlement for plaintiff Research Corporation Technologies Inc. in a 10-year battle against Microsoft Corp. over a process to optimize images on computer screens. Fifteen minutes before the jury was to hear opening arguments, says McMahon, the two companies entered a settlement approved by the judge. *Research Corp. v. Microsoft Corp.*, CV01-00658 (D. Ariz.)

— Ben Adlin



**Yar Chaikovsky**  
McDermott Will & Emery LLP  
Silicon Valley  
Patent

Chaikovsky successfully fought to halt a patent infringement lawsuit against client Zumbox Inc., a digital postal system that was sued by Pitney Bowes Inc., which

manufactures postage meters and other software, hardware and services for packaging and shipping. Pitney Bowes accused Zumbox of infringing on three patents related to converting traditional paper mail into paperless mail that gets delivered and sorted in an email inbox.

In addition to defending the case in court, Chaikovsky also went to the U.S. Patent and Trademark Office — which is tasked with determining whether a patent is valid and “patentable” — to argue that the three patents in question were invalid.

Although the trademark office found two of the three patents were in fact valid, a judge in the Central District of California still stayed the case (*Pitney Bowes Inc. et al v. Zumbox, Inc.*, CV09-07373 (C.D. Cal., filed Oct. 13, 2009).

“We thought all three were going to be found invalid, and two out of the three were confirmed,” said Chaikovsky. “But she still stayed the case, with no precedential support for that position. I'm not aware of any other case where one or more patents had claims confirmed by the patent office and the judge still stayed the case.”

The decision was huge for Zumbox, a small company that could have been devastated by expensive, drawn-out litigation.

“I staved them off from spending massive amounts of litigation fees,” he said. “The whole point there was to save them money.”

Other recent matters Chaikovsky has been involved with:

- Lead counsel for Yahoo Inc., a defendant in a patent infringement case brought by Bedrock Computer Technologies LLC, which is accusing several Internet companies of infringing on its patent, a component of the Linux operating system that allows websites to store Internet Protocol addresses.

- Lead counsel for Amazon.com, Adobe Systems Inc. and 32 other companies in a patent infringement lawsuit brought by Side Update Solutions LLC relating to search engine optimization technology.

— Catherine Ho

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### TOP 25 CALIFORNIA PORTFOLIO MANAGERS, PROSECUTORS AND LICENSE SPECIALISTS



**Mark Itri**

McDermott Will & Emery LLP  
Irvine

Patent and trademark

With patent trolls stalking and competitors looming, it doesn't hurt to have a little leverage. So says Itri, who has seen his reexamination practice heating up. The way he sees it, asking the patent office to take another look at a patent can level the playing field, and it is significantly cheaper than litigation.

"No one wants to see their patent invalidated," Itri said. "Some courts will halt all proceedings if a reexamination is in place. But it has to be done very strategically. It's an under utilized tool."

Itri also is noticing another shift taking place in the IP world — the emergence of software as the technology star, overshadowing the hardware.

"Now, they give away the hardware and charge for the software," he said. "It's causing us to increase the number of attorneys we're hiring to service more work."

Alternative energy also is keeping Itri and his firm McDermott Will busy these days, from dealing with new inventions to matters related to wind, water and nuclear power. Nanotech, he added, is especially taking off.

"We're getting a lot more work," Itri said. "There are so many applications for this kind of technology."

With a roster of clients that include Google Inc., QUALCOMM, Lockheed Martin Corp. and Toshiba Corp., Itri is responsible for managing and overseeing several thousand issued and pending patent and trademark files for his U.S. and foreign-based clients.

Itri also heads up the firm's IP prosecution, transactions and strategy practice group, which includes about 90 registered patent lawyers and agents.

Not all of Itri's work involves deal-making. Sometimes, he gets to be a crime fighter, working on cyber security and privacy issues.

"It's being able to protect trademarks, copyrights and information on our clients' websites that are being take by others out there," he said. "It's a crime, and we've used Scotland Yard, the FBI and local police to bring these people to justice. Across the board, it's another growing area."

— Pat Broderick



**Jorge Arciniega**

McDermott Will & Emery LLP  
Los Angeles

Trademark and copyright counseling;  
prosecution and commercial exploitation

Arciniega noticed the past few years that companies increasingly are taking heed of what they've got in their intellectual property portfolios, with a view toward mining the commercial possibilities.

"In a downturn in the economy, you get creative thinking of other ways to make money," he said.

For Arciniega, he can't think of a time when the legal industry has been hit as hard as it's been.

But he's managed to keep busy for his many clients that include Jenny Craig Inc., Hollywood Tans Brands LLC and Univision Communications Inc., billed as the largest Spanish language media company in the United States, and the operator of the country's fifth largest television network.

In 2010, he advised Univision on several matters related to the expansion of the company's traditional television and radio content into digital platforms — work, he said, that included sophisticated analysis of intellectual property rights.

Arciniega also advised the company on a new global trademark protection strategy.

"I've seen a modernized system at the trademark office, and, for the most part, I am pleased at the advancement," he said. "Things seem to be moving more smoothly."

He's also seeing new opportunities with the rise in new platforms, over which intellectual property content can be distributed.

"With every new platform or technology, we always have to question the rights our clients have to this particular content and how it extends to new apps."

For example, he said, say a book retailer is offering, along with the digital edition of a book, technology that allows customers to listen to the book through speakers.

"The question is, do the rights of the retailers to sell the book give them the right to also offer buyers the audio version of that same book?" Arciniega said.

Since technology tends to move faster than legislators can pump out laws, his practice is always a challenge.

"More often than not, you are able to address these gaps by going back and taking another look at what the principles were that the law was originally designed to protect," he said. "You can then extrapolate on how the law should treat this new medium."

— Pat Broderick