

Intellectual Property Practice Overview

Protecting the World's Leading Technology & Brands



King & Spalding offers clients a full-service intellectual property practice that combines proven first-chair trial and business lawyers with true scientific specialists. The firm's Intellectual Property practice group consists of more than 50 IP professionals located in our Atlanta, Austin, Charlotte, Houston, New York, San Francisco, Silicon Valley and Washington, D.C. offices. Nearly 80% of the IP team's lawyers, agents and technical advisors hold technical degrees, including many who have previously worked in the field as engineers and scientists, as in-house counsel, as judicial clerks, and as examiners in the U.S. Patent and Trademark Office. (USPTO).

“Sophisticated, full-service IP practice.”

– *Chambers USA*

We provide our clients with services across the spectrum of IP work, including:

- Patent litigation before the district courts across the country, appellate courts, and ITC
- *Inter partes* review and post-grant review proceedings before the PTAB
- Trademark and false advertising litigation
- Copyright, trade secret, non-compete, and domain names
- Media and entertainment law, including both traditional and new media space
- Patent prosecution and strategic counseling in a wide range of technologies and subject matter
- Trademark prosecution and strategic counseling worldwide
- IP government relations with Congress and the Executive Branch

Recognized as one of the best IP practices in the U.S. in *Managing Intellectual Property's* “2016 Managing IP Handbook.”

Recognitions

- Ranked by *Chambers USA* 2016 among the top firms for intellectual property, patent, trademark, and copyright law.
- Ranked by *Chambers USA* 2016 among the top firms for media and entertainment law.
- Ranked by *Legal 500* nationwide for copyright law and trade secrets (litigation and non-contentious matters).
- Recognized by *IP Law & Business* magazine as one of the top patent litigation firms in the country.
- Trademark lawyers named by WTR 1000 2016 as among the top in the field.
- Women in Intellectual Property Shortlisted for Women in Law Awards “Most Innovative Networking Group.”
- Ranked Tier 1 by *U.S. News & World Report* for IP litigation, patent litigation, patent law, trademark law, and copyright law.
- IP lawyers recognized as NLJ IP trailblazers, IAM Patent 1000 and IP Strategists, *Best Lawyers in America*, *Law 360* Rising Stars, *Benchmark Litigation* Hot List, and as leading lawyers by *Chambers*, *Legal 500* and *BestLawyers*.



“King & Spalding has a deep, experienced bench strength in intellectual property litigation, and is a go-to firm for major IP litigation.”

– *U.S. News & World Report*

Representative Clients

- Alcatel-Lucent
- Atlanta Gas Light Company
- BASF Corporation
- Baxter Healthcare Corporation
- Boehringer Ingelheim Pharmaceuticals
- The Coca-Cola Company
- Chevron
- Daiichi Sankyo Co., Ltd.
- Daimler AG
- DRI Capital Inc.
- Eaton Corporation
- Federal Reserve Bank System
- Google Inc.
- Herbalife
- The Home Depot
- IBM
- Kemira Chemical
- Landis + Gyr.
- Microsoft Corporation
- Nokia Inc.
- Nokia Solutions and Networks
- Pandora Media Inc.
- Spanx, Inc.
- Varel International
- Verizon Communications
- ZTE Corporation

Representative Matters

- We successfully represented **Pandora Media Inc.** in a significant licensing dispute with the American Society of Composers, Authors and Publishers (ASCAP). We obtained partial summary judgment in favor of Pandora persuading the U.S. District Court to reject ASCAP’s proposed rate structure in favor of one advanced by Pandora.
- We intervened on behalf **Nokia Solutions and Networks USA (NSN)** in a patent infringement action filed by a Luxembourg-based patent assertion firm against T-Mobile USA Inc. NSN, along with T-Mobile and intervenor Ericsson, filed motions for partial summary judgment based on patent exhaustion and licensing defenses. The Court granted the motions in their entirety and the parties subsequently stipulated to resolution of all remaining claims. We currently represent NSN in the appeal to the Federal Circuit.
- We defended **Spanx, Inc.** against claims of design and utility patent infringement involving its best-selling shaping tops. Our IP team successfully invalidated two of the design patents in dispute and obtained a favorable claim construction ruling for Spanx, which eliminated the relevance of four design patents, before reaching a mutual agreement to dismiss the cases.
- We defended **Atlanta Gas Light Company (AGLC)** in a patent infringement action, and the court dismissed AGLC from the case for lack of personal jurisdiction. AGLC subsequently retained us to submit a petition for *inter partes* review of the asserted patent before the Patent Trial & Appeal Board, which is currently evaluating the validity of such patent.

Representative IP Appellate Matters

- On behalf of **McKesson Technologies, Inc.**, we persuaded the Federal Circuit to grant en banc review and to overturn its precedents concerning the standard for joint or divided infringement.
- On behalf of **Avon Products, Inc.**, we succeeded in reversing an eight-figure verdict of patent infringement.
- We successfully represented **Anvik Corp.**, securing reversal of summary judgment and restoring the validity of three patents related to LCD panels in a case where Anvik sought over \$100 million in damages.
- We advised **Google Inc.** on legal issues in advance of trial in this high-stakes case brought by a patent assertion entity to enforce an Internet-related patent that had been the subject of a \$520 million jury verdict in a previous case. Following a jury verdict of invalidity, the group successfully represented Google and its co-defendants Amazon.com, Inc., and J.C. Penney Corp. in defending the verdict on appeal.



“Extremely talented and creative [appellate] lawyers” with “exceptional brief-writing and oral advocacy skills.”

– *Legal 500*

Patent Litigation

King & Spalding believes in combining proven first-chair trial lawyers who are dedicated to patent work with a deep bench of technical specialists. Our patent litigators routinely appear in district courts across the country, including the most popular jurisdictions such as the Eastern District of Texas, the District of Delaware, and the Central and Northern Districts of California. Our group has represented, and continues to represent, some of the largest companies in the world. The majority of our patent professionals have technical degrees in a wide range of disciplines, from high-tech to life sciences to oil and gas, consumer products and many others.

Patent Prosecution, Strategic Counseling and Due Diligence

With expertise in assisting clients from large multinational corporations to startup companies, King & Spalding’s patent prosecution, counseling and due diligence practices focus on creating value in our clients’ patent portfolios. These practices encompass a wide range of technologies and subject matter, including life sciences, computer science, electrical and mechanical engineering, oil and gas, and financial services. Our team has obtained or assisted in the procurement and management of hundreds of U.S. and foreign patents, with particular expertise in managing complex patent portfolios. We also routinely negotiate technology transactions and license agreements, conduct due diligence concerning intellectual property assets in mergers and acquisitions, and provide opinions on intellectual property matters.

Patent Post-Grant Proceedings

King & Spalding’s attorneys have extensive experience in post-grant proceedings. By combining its litigation and U.S. Patent and Trademark Office expertise, our attorneys guide clients through post grant procedures, whether challenging or defending patent validity or strengthening a patent prior to assertion in litigation. We have been involved in various aspects of reexaminations, *inter partes* review and post grant review proceedings, including filing, strategizing and evaluating likely outcomes of IPRs filed in patents involved in various King & Spalding diligence matters. In addition, our experience in all of these types of challenges to patent validity in the USPTO, along with managing foreign oppositions of patents outside the United States, allows our attorneys to coordinate world-wide patent strategies.

Trademarks, Copyrights and Trade Secrets

From counseling to litigation, lawyers in King & Spalding’s intellectual property group have experience in all aspects of trademark, copyright and trade secret law. Our team has been involved in numerous trials and preliminary injunction hearings; has practiced in the federal courts, the USPTO, Trademark Trial and Appeal Board and the International Trade Commission; and has participated in ICANN domain name arbitrations. In addition to litigation and contested matters, we routinely handle registering and maintaining trademarks, copyright and domain names; providing guidance on Internet and social media policies; licensing and counseling; and conducting due diligence in mergers and acquisitions. Also, our trade secrets and noncompete litigation practice is uniquely composed of a cross-functional group of lawyers with expertise in trade secrets, unfair competition, noncompete agreements, intellectual property and e-discovery laws throughout the United States.



Media and Entertainment

King & Spalding's media and entertainment practice is at the leading edge of the marriage of digital media and traditional media. Our team has particular experience in litigating copyright infringement and antitrust/rate-setting claims in cases involving the distribution of audio and audiovisual content. Often, these engagements involve the construction and application of provisions of the Digital Millennium Copyright Act (including statutory license and safe harbors thereunder), and federal court/copyright tribunal proceedings in the United States and abroad establishing structures and rates for the exploitation of musical works in both traditional (e.g., cable, satellite and broadcast) and new media distribution environments.

Ranked by *Chambers USA* 2016 among the top firms for media and entertainment law.

Women in IP shortlisted for *Chambers Women in Law Awards*: "Most Innovative Networking Group."

Women in IP

More than 30% of King & Spalding's intellectual property partners are women. Less than half of the Am Law 50 can say the same, reflecting in part the broader challenge of attracting women to science, technology, engineering and math (STEM)—areas in which men continue to outnumber women. Our women IP partners represent clients across a broad spectrum of work including in litigation, prosecution and strategic counseling, due diligence, licensing and other transactions involving intellectual property. King & Spalding's women IP partners are part of the growing STEM movement and actively support programs that encourage girls and young women to pursue scientific and technical educations.

ITC Litigation

King & Spalding is unique in that we have leading practices in the multiple disciplines necessary to litigate Section 337 investigations at the International Trade Commission: broad-based patent litigation experience and technical expertise, extensive hearing experience at the ITC, expertise in international trade and the ITC's procedures, intellectual property appellate expertise and top-tier governmental relations expertise. Our ITC patent litigation team is particularly deep in electrical, computer and mechanical patent expertise, the areas that comprise the majority of ITC investigations under Section 337.

IP Appellate Practice

King & Spalding has established an excellent reputation for successfully representing clients in major appeals in virtually every litigation forum, including before the U.S. Supreme Court, federal and state trial and appellate courts, government agencies, and national and international arbitration panels. In recent years, our IP practice, as a result of concerted efforts done by our appellate practice to build its team, has established a reputation as a go-to firm for IP appellate work. We represent clients in appeals for cases that we originally tried—often seeking to retain the favorable results garnered by our trial counsel—as well as stepping in as appellate counsel for matters originally tried by other firms. Clients frequently retain our appellate team to handle high-stakes and cutting-edge IP matters before the Court of Appeals for the Federal Circuit and U.S. Supreme Court.

The group has received numerous accolades. Recently, *Legal 500* named King & Spalding firm of the year for Supreme Court and Appellate. In 2014, King & Spalding's appellate practice was selected as "Appellate Practice Group of the Year" by *Law360*.

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