



## A. James Isbester

PARTNER

Two Embarcadero Center, Suite 1900  
San Francisco, CA, 94111  
USA  
t +1 415.273.4335  
f +1 415.576.0300

Suite 400, 12730 High Bluff Drive  
San Diego, CA, 92130  
USA  
t +1 858.350.6254

Jisbester@kilpatricktownsend.com

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### Services

Litigation; Patent Litigation; Intellectual Property; Trademark & Trade Dress Litigation; Transactional Intellectual Property; Trade Secret; Alternative Dispute Resolution; Intellectual Property Litigation; Mergers & Acquisitions

James Isbester has been advising and representing clients in intellectual property and technology-related matters since 1987. Although his clients span the business world, most of his work is on behalf of high technology and medical device companies.

Mr. Isbester has represented both plaintiffs and defendants in jury trials, bench trials, various state and federal courts of appeal, and arbitrations. As a member of the Northern District of California's panel of court-appointed mediators, Mr. Isbester has conducted mediations in more than three dozen patent, trademark, copyright and trade secret disputes. In addition to his work in the courts, Mr. Isbester is active in advising clients in mergers, acquisitions, new product introductions, and initial public offerings. Mr. Isbester frequently assists his clients to avoid litigation through effective licensing efforts on behalf of both the IP owner and the licensee.

Mr. Isbester was listed in *The Best Lawyers in America*<sup>®</sup> in 2017 for Intellectual Property Litigation. Mr. Isbester has been recognized as a Northern California "Super Lawyer" in the areas of Intellectual Property and Intellectual Property Litigation each year since 2006 by *Super Lawyers* magazine and he is AV<sup>®</sup> rated by Martindale-Hubbell.\*

\*CV, BV, and AV are registered certification marks of Reed Elsevier Properties Inc., used in accordance with the Martindale-Hubbell certification procedure's standards and policies.

### Experience Highlights

#### *Fujifilm Corporation v. Motorola Mobility LLC*

Defended Motorola against Fujifilm's assertion of five patents relating to digital cameras and the transmission of files through a cell phone. After summary judgment and a two week jury trial in San Francisco, Motorola prevailed on four of the five patents (proving two of the patents invalid and not infringed, one patent not infringed, and one patent invalid), limited damages on the fifth patent to less than 1/25th of plaintiff's request, and excluded injunctive relief. The case is currently in post-trial motions.

*Fujifilm Corporation v. Motorola Mobility LLC*, No. 3:12-cv-3587 (N.D. Cal. filed July 10, 2012).

#### *Medtronic v. Edwards Lifesciences*

Led an eight lawyer team defending Edwards Lifesciences in a four patent case Medtronic brought involving Edwards' flagship prosthetic surgical heart valves. Also led the countersuit asserting Edwards patents infringed by Medtronic's valve reconstruction products. The Kilpatrick Townsend team successfully challenged the validity of three of the four Medtronic patents-in-suit and two other threatened patents in proceedings before the U.S. Patent and Trademark office, winning cancellations of virtually all pertinent claims. The case settled as part of a global settlement of multiple cases with an exchange of cross-licenses and license payments by Medtronic of over \$1 billion. Mr. Isbester has also successfully represented Edwards in patent trials relating to cardiovascular applications of lasers and equipment for performing heart bypass during open heart surgery.

*Medtronic, Inc. et al. v. Edwards Lifesciences Corp, et al.*, No. 11-cv-01650 (D. Minn. filed June 24, 2011).

#### *Open Text v. Alfresco*

The firm served as lead counsel on behalf of Alfresco Software in a lawsuit involving allegations of patent infringement related to content management systems. The lawsuit involved nine patents from two distinct families of patents, each covering different subject matter. After successfully transferring the case from the Eastern District of Virginia to the Northern District of California,

Alfresco invalidated two of the asserted patents at the 12(b)(6) stage under the Supreme Court's *Alice* standard for patentable subject matter under 35 U.S.C. 101. The remainder of the case was settled shortly thereafter on confidential terms.

*Open Text SA v. Alfresco Software Ltd., et al.*, 13-cv-04843 JD (N. D. Cal., filed October 18, 2013).

#### Comarco and ACCO

Led a team defending ACCO Brands USA and its subsidiary Kensington Microwave against allegations that its universal laptop power supplies infringed Comarco's patents. An aggressive strategy that used both a declaratory relief complaint and inter partes review, coupled with successful claim construction and summary judgment motions substantially reduced the value of Comarco's claims. ACCO was then able to obtain releases and licenses with a payment of only \$200,000.

*ACCO Brands USA, LLC v. Comarco Wireless Technologies, Inc.* Case No. C-11-03478 RS (N. D. Cal., filed September 1, 2011).

#### Abbott Medical Optics (fka Advanced Medical Optics) v. Alcon \*

Represented Abbott Medical Optics (AMO, fka Advanced Medical Optics), a supplier of advanced refractive technologies, as plaintiff in one action and as defendant in three other related actions and in reexamination of patents involving ophthalmic surgical products. Case settled with payment to AMO of \$121 million and cross-licenses after AMO obtained jury verdict of infringement and judgment of \$235 million and invalidated two of Alcon's patents in reexamination..

*Advanced Medical Optics, Inc. v. Alcon Inc.*, No. CIV.A. 03-1095-KAJ (D. Del., filed December 3, 2003).

#### Contract litigation for Taiwanese computer/NB manufacturer

Represented a Taiwanese computer/NB manufacturer in a contract related action before a U.S. District Court in California.

#### In re Maxim Integrated Products Inc. MDL

Defended Union Bank, N.A. and Wells Fargo involving numerous patents relating to the security and encryption asserted against mobile banking apps. The cases, along with many others, were consolidated in multi-district litigation in the Western District of Pennsylvania. Obtained early settlements for both clients at less than cost of defense.

*Maxim Integrated Prod. Inc. v. Union Bank N.A.*, No. 12-882 (W.D. Pa. filed June 27, 2012); *Maxim Integrated Prod. Inc. v. Wells Fargo & Co.*, Case 4:12-cv-00623-RAS (E.D. Tx, filed October 1, 2012).

#### Auto-Kaps LLC v. Clorox Co., No. 2:15-cv-01737 (E.D.N.Y. 2015).

Represent Clorox in a patent infringement claim alleging that the spray bottle in which Clorox sells almost all its liquid cleaning products infringes Auto-Kaps' patent. At our request at the initial status conference, the judge stayed discovery and entertained an early motion for summary judgment of non-infringement, ultimately granting that motion. The matter is currently on appeal.

#### Video Enhancement Solutions v. Epson America

Represented Epson America Inc. as defendant in a patent infringement case related to the reduction of blocking artifacts in video displays. Succeeded in transferring case from the Eastern District of Texas to the Central District of California. The case settled soon after the transfer.

*Video Enhancement Solutions, LLC. v. Denon Electronics (USA), LLC. et al.*, 2:10-cv-04370 (C.D. Cal. filed June 14, 2010).

#### TecSec Inc. v. Oracle Corporation, et al.

Representing Oracle in a matter filed in the Eastern District of Virginia. Summary judgment of non-infringement was entered in favor of defendants. The matter is now on appeal to the Federal Circuit Court of Appeals.

*TecSec, Inc. v. IBM Corp., et al.*, No. 1:10-cv-115 (E.D. Va, filed Feb. 5, 2010).

#### Resonate Inc. v. Nortel Networks Corporation

Lead counsel for Alteon Web Systems, which was acquired by Nortel Networks, in patent infringement action relating to switching in large Internet server sites. Won summary judgment of non-infringement. On appeal, certain claim terms were redefined and the matter remanded. Won a second motion for summary judgment, affirmed on appeal.

*Resonate Inc. v. Alteon Web Systems, et al*, 4:00-cv-03307-CW (N. D. Cal., filed September 12, 2000).

#### Surety v. Entrust

Co-counsel for defendant Canadian data security company accused of infringing patent relating to encryption techniques used in creating verifiable time stamps. Conducted the liability-related examinations at trial. Won jury verdict of patent invalidity.

*Surety Technologies Inc. v. Entrust Technologies Inc.*, 1:99-cv-00203-TSE (E.D. Va, filed February 2, 1999).

### **Molecular Probes v. Texas Fluorescence Laboratories**

Lead counsel for plaintiff in patent infringement case involving fluorinated xanthene fluorophores. After district court accepted our client's position on all disputed claim terms, the defendant took a license and the parties settled.

*Molecular Probes, Inc. v. Texas Fluorescence Laboratories, Inc.*, 3:02-cv-00461-SI (N. D. Cal., filed January 25, 2002)

### **Lochner Technologies LLC v. Lenovo (United States) Inc., Hitachi America Ltd et al.**

Represented Hitachi America Ltd. in a patent infringement action on a patent related to modular computer systems. We were successful in settling the case on behalf of Hitachi America Ltd., very early in the case, with no financial recovery for the plaintiff.

*Lochner Technologies, LLC v. Lenovo (United States) Inc., et al.*, No. 10-00430 (E.D. Tex. filed October 12, 2010).

\*Experience gained by attorney prior to joining Kilpatrick Townsend

## **Publications, Articles and Speaking Engagements**

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**Diligence in IP: Yahoo as a Case Study, A Practical Overview**  
2016 Patent Law Forum, October 28, 2016

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**Diligence in IP: Yahoo as a Case Study, A Practical Overview**  
Intellectual Property Law Seminar, October 25, 2016

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**Defending Against NPEs: Updates to Case Law and Strategies**  
Silicon Valley Association of General counsel Annual All Hands Meeting, December 05, 2013

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**Defending Against NPEs: Updates to Case Law and Strategies**  
Silicon Valley Association of General counsel Annual All Hands Meeting, December 05, 2013

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**Defending Against the NPE**  
Kilpatrick Townsend Intellectual Property Seminars, August 01, 2011  
Easily half of the patent infringement lawsuits brought in the United States are initiated by non-practicing entities ("trolls") against operating companies. Anyone who makes something and sells it in the United States should understand the dynamics of troll litigation, the most recent trends, and the latest defense tactics. This seminar presents the lessons learned from Kilpatrick Townsend's experience in this area.

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**Congress Is Considering Big Patent System Change**  
San Francisco Business Times, April 01, 2011

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**Updates on Patent Reform 2011**  
Corporate Counsel IP Forum, March 25, 2011

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**Selecting A Forum From Among The District Courts and The International Trade Commission**  
Practicing Law Institute, Patent Litigation 2010, November 01, 2010

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**Exploring the Changing Patent Litigation Landscape**  
AdvaMed Conference, October 20, 2010

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**Early Case Evaluation and Pre-Litigation Counseling**  
Townsend Intellectual Property Seminars (TIPS), August 04, 2010

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**A Patently Good Idea**  
MX: Medtech Executive, August 01, 2010

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**What Bilski Means for E-Commerce Patents**  
American Corporate Counsel Association Bay Area Chapter, July 20, 2010

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**Trade Secrets: Cost Effective Protection for Valuable Business Information**  
Panelist, American Corporate Counsel Association Bay Area Chapter, June 03, 2009

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**The Ethics of IP Litigation**  
Speaker, 24th Annual Intellectual Property Law Conference, ABA Section of Intellectual Property, April 03, 2009

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Preventatives and Alternatives in IP Disputes — A View of IP Litigation from an Expert Witness and Neutral Speaker, 20th Annual All Hands Meeting, Silicon Valley Association of General Counsel, December 04, 2008

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**National Standards for Patentability**

Guest Speaker, Intellectual Property, Lecture Course, Osgoode Hall Law School, York University, October 11, 2007

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**As the Supreme Shake Up The Patent World, New Strategies Emerge**

Proceedings of the Litigation Counsel of America Summer Conference, July 01, 2007

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**Issues in International IP Management**

Guest Speaker, Advanced Issues in Patent Law, Seminar Course, Osgoode Hall Law School, York University, April 03, 2007

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**The Uncomfortable Role of the Advocate in Claim Construction**

Proceedings in Claim Construction, LSI, January 26, 2007

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**Negotiating Licenses Under The Threat Of Litigation**

Address to the Licensing Executive Society of Northern California, December 01, 2006

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**Professional & Community Activities**

American Bar Association, Member

Litigation Counsel of America, Member

Editorial Advisory Board, MX Update, Member

Advisory Council, IP Osgoode, Member

**Education**

Osgoode Hall Law School, LL.B. (1987)

University of California, Davis School of Law (1987)

Princeton University, B.S.E., Chemical Engineering (1983)

**Bar Admissions**

California

District of Columbia

Washington

**Admissions**

U.S. Patent and Trademark Office

U.S. Court of Appeals for the Ninth Circuit

U.S. Court of Appeals for the Federal Circuit

U.S. District Court for the Eastern District of Texas

U.S. District Court for the Western District of Michigan

U.S. District Courts for all Districts of California