

Mehrnaz Boroumand Smith

Partner

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Services

Intellectual Property
ITC Section 337
Patent Litigation
Trade Secrets

Industries

Consumer Goods
Electronics & Computer
Technology
Energy
Financial Institutions
Financial Services
Oil & Gas
Retail & Consumer Goods
Technology

Mehrnaz Boroumand Smith focuses her practice on intellectual property and complex commercial litigation matters. She has successfully represented clients, including well known high technology companies, in litigation regarding claims of utility and design patent, copyright, and trademark infringement, as well as breach of contract, breach of warranty, fraud, unfair competition and misappropriation of trade secrets. She also has successfully defended clients in class action cases. Ms. Boroumand Smith has represented clients in a variety of fields and industries covering technology and disputes relating to software, hardware, semiconductors, digital cameras, lasers, video gaming, information technology installations and licenses, arts and crafts, toys and manufacturing conveyors. She has appeared in federal courts (at both the district and appellate levels), California state courts and is also experienced in arbitration matters.

Ms. Boroumand Smith also regularly advises clients regarding their intellectual property enforcement strategies, including online enforcement, social media monitoring and right of publicity issues. She has also worked with clients in assessing cybersecurity breaches.

Ms. Boroumand Smith serves on the firm's Executive Committee and previously served on the firm's Diversity Council and was Managing Partner of the San Francisco office from March 2014 through January 2017. She



also was an adjunct professor at the University of San Francisco School of Law, where she taught copyright, trademark and privacy issues in the Internet and Intellectual Property Justice Clinic from 2008 to 2016.

Ms. Boroumand Smith has been consistently recognized as a Northern California "Super Lawyer" in the area of Intellectual Property by *Super Lawyers* magazine (2013-2019) and prior to 2013, she was recognized by *Super Lawyers* as a "Rising Star" from 2009 to 2012. She was recommended by *Legal 500 US* in 2015 for Trade Secrets Litigation. Ms. Boroumand Smith was named a "Future Litigation Star" among California attorneys in the 2016 edition of *Benchmark Litigation*.

Experience

Copyright and Trademark

Oracle Corporation and Oracle International Corporation v. Oracle Healthcare Advisors, Inc. Currently representing Oracle in asserting trademark infringement, trademark dilution, cybersquatting and unfair competition claims against Oracle Healthcare Advisors in the Northern District of California for defendants use of the Oracle Healthcare trademark.

GoPro, Inc. v. 360Heros, Inc. Currently representing GoPro in lawsuit filed in the Northern District of California against 360Heros asserting claims of copyright and trademark infringement and seeking declaratory judgment rulings of non-infringement and invalidity of 360Heros' patent. Successfully obtained summary judgment of copyright infringement against 360Heros and ruling that 360Heros lacked standing to assert its patent against GoPro at time litigation was instituted.

Sound Around Inc. v. GoPro, Inc. Represented GoPro in lawsuit filed in the Southern District of New York that sought declaratory relief of no trademark or patent infringement and successfully obtained dismissal of the suit.

Actuate Corporation v. Aon Corporation et al. Represented plaintiff Actuate Corporation in U.S. District Court for the Northern District of California in a breach of contract, copyright infringement and unfair competition action against defendants AON Corporation and TWG Warranty Group based on their use of Actuate's software. Matter settled on the eve of trial.

The Prudential Insurance Company of America v. Actuate Corporation. Represented defendant Actuate Corporation in U.S. District Court for the District of New Jersey in response to a request for declaratory relief filed by The Prudential Insurance Company of America for breach of contract and violation of the New Jersey Computer Fraud Act and with regard to counterclaims by Actuate for breach of contract and copyright infringement. The matter settled confidentially.

MB Technologies v. Oracle Corporation. Represented Oracle in fraud and copyright infringement case filed by



MB Technologies, a Georgia-based software company accusing Oracle of unlawfully using MB's technology for the creation of user interfaces for Fusion Applications. The matter settled confidentially.

Apple Inc. v. Psystar Corporation. Obtained summary judgment and a permanent injunction against a computer company utilizing Apple's copyrighted operating system software on non-Apple hardware based upon copyright infringement and violation of the Digital Millennium Copyright Act. The ruling resulted in a published opinion which affirmed liability for distributing copies of operating software and circumvention technology. The Ninth Circuit affirmed the permanent injunction and inapplicability of copyright misuse. *Apple Computer Inc. v. Psystar Corporation*, 673 F.Supp.2d 943 (N.D. Cal. 2009), 673 F.Supp.2d 931 (N.D. Cal. 2009), 586 F.Supp. 2d 1190 (N.D. Cal. 2008), 658 F.3d 1150 (9th Cir. Sept. 28, 2011).

Ellison Educational Equipment Inc. v. QuicKutz. Represented plaintiff in patent inventorship, copyright and trademark matter in the Central District of California. The matter settled confidentially. *Ellison Educ. Equip., Inc. v. Jing Chen, et al.*, No. 02-01184 (C.D. Cal. filed Dec. 20, 2002).

Sony Computer Entertainment America Inc. v. Bleem LLC. Represented plaintiff in action involving use of copyrighted screen shots in comparative advertising and misappropriation of trade secrets. *Sony Computer Entm't America Inc. v. Bleem LLC et al.*, No. 99-01590 (N.D. Cal. filed Apr. 2, 1999).

Sony Computer Entertainment Inc. v. Connectix Corporation. Represented plaintiff in copyright infringement action dealing with issues of fair use in the context of reverse engineering and intermediate copying. The case also included misappropriation of trade secrets claims. *Sony Computer Entm't, et al. v. Connectix Corp.*, No. 99-cv-00390 (N.D. Cal. filed Jan. 27, 1999).

Oracle Corporation v. Light Reading, Inc. Represented plaintiff in trademark infringement case. Case settled after preliminary injunction was granted.

Patents

360Heros v. GoPro, Inc. Currently defending GoPro in patent infringement lawsuit in the District of Delaware filed by 360Heros on mechanical rigs designed to hold cameras in place to film 360 degree footage.

TNA Australia Pty Limited and TNA North America Inc. v. PPM Technologies, LLC. Currently representing TNA entities in patent infringement claim against competitor for infringement of patent covering conveyor system.

C&A Marketing, Inc. v. GoPro, Inc. Defended GoPro in a design patent infringement lawsuit filed in November 2015 by C&A Marketing, a New Jersey company that licenses the Polaroid brand and that has developed the Polaroid Cube camera and affirmatively asserted copyright infringement, false advertising and unfair



competition claims against C&A Marketing. The matter settled confidentially. *D.N.J. Civil Action #1:15-cv-07854-RMB-JS*

GoPro, Inc. v. C&A Marketing, Inc. et al. Filed a patent infringement suit on behalf of GoPro on June 27, 2016 asserting infringement by defendants C&A Marketing, Inc., C&A Licensing, LLC, and PLR IP Holdings, LLC of two of GoPro's utility patents (U.S. Patent Nos. 9,025,896 and 9,282,226). The matter settled confidentially. *N.D. Cal., Civil Action #: 5:16-cv-03590-NC*

Thought, Inc. v. Oracle Corporation. Successfully defended patent infringement case in the Northern District of California for client Oracle against Thought, Inc. involving seven patents for object-to-relational mapping technology. Over a three-year period, we defeated a claim for \$130 million dollars in damages by (1) invalidating three patents in IPR proceedings; (2) obtaining voluntarily dismissals of three more patents; and (3) obtaining summary judgment of non-infringement of the final patent. Case upheld on appeal before the Federal Circuit.

iMTX Strategic LLC v. Rhapsody International Inc. Represented Rhapsody International, a leading provider of streaming music services, against claims of patent infringement involving a single patent related to the transfer of digital media files over the Internet. Successfully transferred case to the Northern District of California and then obtained dismissal with prejudice after claims of asserted patent were invalidated in proceedings before the Patent Trial and Appeal Board.

TecSec v. IBM et al. Representing Oracle in patent infringement matter covering encryption technology and software and hardware products before the Eastern District of Virginia.

B.I. Systems LLC v. Actuate Corporation et al. Represented Actuate Corporation, a leading developer of business intelligence and enterprise performance software, as defendant in a patent infringement action related to a patent for a method and system for computer-based visual data evaluation. The matter settled confidentially.

B.I. Systems LLC v. Actuate Corporation et al., No. 01472 (M.D. Fla. filed Sep. 6, 2011).

Global Cash Access v. Game Financial Corporation. Represented plaintiff in a patent infringement action concerning cash access services for casino patrons in the District of Nevada. The matter settled confidentially.

In the Matter of Certain Rubber Antidegradants II. Prevailed in obtaining summary determination of matter and dismissal of complainants complaint before the International Trade Commission on behalf of large Korean chemical manufacturer.

Technology Properties Limited v. Fujitsu et al. Represented a manufacturer of microprocessors in the Eastern District of Texas. The matter settled confidentially.

In the Matter of Certain Electronic Educational Devices and Components Thereof. Represented respondent, a

distributor of educational toys in obtaining a settlement within several months of the filing of the complaint in the International Trade Commission.

International Rectifier v. IXYS Corporation, Central District of California. Represented defendant in a patent infringement action concerning design and fabrication of power MOSFET semiconductor devices. The matter settled confidentially.

Complex Commercial Litigation

James Thomas Long d/b/a James Thomas Long Photography v. YP Western Directory LLC et al. Served as counsel for YP in a class action in federal district court in San Francisco (Northern District of California) defending against plaintiff and putative class action alleging consumer fraud claims based relating to the marketing of an advertising services program and seeking the certification of a nationwide class. Successfully removed case to federal court under the Class Action Fairness Act and, soon after removal, moved for early summary judgment which was granted on the grounds that plaintiff had sued the wrong entity. On appeal, the Ninth Circuit affirmed the grant of summary judgment, but remanded the case so that the plaintiff could amend his complaint to name the proper party-defendants. On remand, YP entities were named as defendants, but the district court again granted summary judgment dismissing plaintiff's claims for false advertising (Cal. Bus. & Prof. Code § 17500) and unfair and deceptive business practices (Cal. Bus. & Prof. Code § 17200). Plaintiff appealed second summary judgment decision and once again the Ninth Circuit affirmed.

TenCate Advanced Composites v. Ehsan Barjasteh. Filed lawsuit in Santa Clara Superior Court for misappropriation of trade secrets, violation of Computer Fraud and Abuse Act, breach of contract, and breach of duty of loyalty against former employee for absconding plaintiff's confidential and trade secret information. Successfully obtain injunctive relief and judgment against defendant.

Smith v. EyeWonder Inc. Represented defendant in U.S. District Court for the Northern District of California with regard to a motion to stay pending arbitration in Georgia. Court granted motion to stay.

McGee v. Ross Stores Inc. Represented defendant in class action lawsuit involving the Fair and Accurate Credit Transaction Act and resolved matter through agreed upon settlement which was approved by court in the Northern District of California.

Wall Street Rarities Inc. v. Oracle Corporation. Represented Oracle in case brought by an Internet distributor of rare coins that had licensed Oracle software. The complaint alleged fraud, negligence, negligent misrepresentation, breach of contract and breach of express and implied warranties of merchantability and unjust enrichment. Case reached confidential settlement.

CGI-AMS v. Fireman's Fund Insurance Company. Represented plaintiff in breach of contract, fraud and unfair

competition arbitration matter resulting from non-payment of fees in an IT outsourcing dispute. The case concluded with a confidential settlement.

Accord Human Resources v. Oracle Corporation. Represented Oracle in case involving claims of breach of contract, rescission, fraud, fraudulent misrepresentation and breach of warranty. Settled the case after successful transfer to the U.S. District Court in the Northern District of California.

Electronic Data Systems Corporation v. Aspect. Represented client in breach of contract, fraud and unfair competition dispute over an IT outsourcing project. Took direct and cross examinations of several witnesses at arbitration.

Oracle Corporation v. Smithfield Foods. Represented plaintiff in breach of contract dispute. Case settled in confidential settlement.

Tri-Valley Growers v. Oracle Corporation. Represented plaintiff in a software performance dispute. Case was settled confidentially after filing of summary judgment motions against defendant.

Education

George Washington University Law School, J.D. (1998) *Public Contracts Law Journal*, Moot Court Board
University of California, Berkeley, B.A., *Political Economies of Industrialized Societies* (1993)

Admissions

California (1998)

Court Admissions

U.S. Court of Appeals for the Federal Circuit (2003)

U.S. District Court for the Central District of California (2003)

U.S. District Court for the District of Colorado (2003)

U.S. Court of Appeals for the Ninth Circuit (1998)

U.S. District Court for the Northern District of California (1998)

Professional & Community Activities

American Bar Association, Member (1998-present)

American Intellectual Property Law Association, Member (1995-present)

Bar Association of San Francisco, VLSP Board (2010-2013)



Insights

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Kilpatrick Townsend Achieves Strong Rankings in Benchmark Litigation 2020
January 6, 2020

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Kilpatrick Townsend Attorneys Named 2019 Northern California Super Lawyers
July 16, 2019

[Events](#)

Mediation of Intellectual Property Disputes
March 4, 2019

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Three Kilpatrick Townsend Attorneys Named 2019 Client Choice Award Winners
February 19, 2019

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Seven Kilpatrick Townsend Attorneys Recognized in Benchmark Litigation 2018
September 24, 2018

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California Powerhouse: Kilpatrick Townsend & Stockton
August 29, 2018

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Twenty-Six Kilpatrick Townsend Attorneys Named 2018 Northern California Super Lawyers & Rising Stars
July 23, 2018

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Twenty-Four Kilpatrick Townsend Attorneys Named 2017 Northern California Super Lawyers & Rising Stars
August 9, 2017

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Collaboration, Clients, and Coffee Fuel Kilpatrick's New Office Design in San Francisco



January 17, 2017

[In The News](#)

Record Rents Drive Design Changes for San Francisco Firms

October 31, 2016

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Eight Kilpatrick Townsend Attorneys Named to 2016 Benchmark Litigation

August 9, 2016

[In The News](#)

Kilpatrick Townsend's Media Report June 24-30, 2016

July 1, 2016

[In The News](#)

Kilpatrick Townsend's Media Report June 10-16, 2016

June 17, 2016

[In The News](#)

Kilpatrick Townsend's Media Report January 22-28, 2016

January 29, 2016

[News Releases](#)

Kilpatrick Townsend Attorneys Named 2015 Northern California Super Lawyers

July 21, 2015

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Kilpatrick Townsend Recognized by Prestigious 2015 Legal 500 US

July 15, 2015

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The Seventh Circuit Weighs in on Personal Jurisdiction and the Internet

October 13, 2010

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Ninth Circuit Finds Autodesk Software Licensed, Not Sold
September 28, 2010