



DON F. LIVORNESE

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Practices:

Intellectual Property Litigation including Patents, Trademarks, Copyrights and related Unfair Competition; Trade Secret Litigation; International Trade Commission – Section 337 Litigation; Post-Grant Proceedings (*Inter Partes* Review, Post-Grant Review and Covered Business Method Review) before the Patent Trial and Appeal Board and *Ex Parte* Reexamination before the Patent and Trademark Office.

State Bar:

California
U.S. Patent and Trademark Office

Court Admissions:

U.S. Court of Appeals for the Federal Circuit
U.S. Court of Appeals for the Ninth Circuit
U.S. District Court for the Central District of California
U.S. District Court for the Northern District of California
U.S. District Court for the Southern District of California
U.S. District Court for the Eastern District of California
U.S. District Court for the Eastern District of Texas

Education:

The George Washington University Law School, JD, *with honors*
University of Colorado at Boulder, BS Mechanical Engineering

Mr. Livornese is a partner in Southern California, splitting time with the firm's San Francisco office. He was formerly a Los Angeles intellectual property partner at Howrey LLP where he spent many years working with Sunny Cherman.

Mr. Livornese's practice includes representing plaintiffs and defendants in patent, trademark, copyright, trade secret and related unfair competition disputes. He has handled infringement actions in district courts nationwide, including jury trials to verdict and appeals before the Court of Appeals for the Federal Circuit. He has extensive experience representing clients in Section 337 actions

before the International Trade Commission, including hearings before an ALJ and appeals to the Court of Appeals for the Federal Circuit. He also represents clients in Post-Grant Proceedings (*Inter Partes* Review, Post-Grant Review and Covered Business Method Review) before the Patent Trial and Appeal Board and *Ex Parte* Reexamination before the Patent and Trademark Office. Mr. Livornese has been registered to practice before the PTO since law school (originally admitted as patent agent).

Mr. Livornese has handled infringement actions in a variety of technologies, including wireless communications and hardware, network transmission and hardware, digital signal encryption, digital storage devices including flash memory, radio frequency identification (RFID) technology, semiconductors and semiconductor manufacturing equipment, 3D printing and stereolithography, MEMS technology, biotechnology and medical equipment.

Representative Cases

Google v. BT Americas, Inc., et al. Represented Ipanema Technologies Corporation in patent infringement action involving networking Quality of Service technology filed by Google in the Central District of California. This was a countersuit to British Telecom's earlier suit against Google seeking damages on sales of Android devices.

Kyocera Wireless et al. v. ITC. Lead trial and appellate counsel for Kyocera Wireless in the landmark CAFC case holding that the ITC lacks jurisdiction to issue limited exclusion orders against nonrespondents. This reversed a longstanding Commission practice of permitting Complainants to exclude, under a limited exclusion order, products imported by downstream manufacturers that had not been named as respondents in the complaint. In the ITC investigation (*In re Certain Baseband Processors*) against respondent QUALCOMM, Broadcom sought a limited exclusion order covering 3G cellular handsets imported by a large number of manufacturers and carriers that Broadcom failed to name as respondents. A number of manufacturers (including Kyocera Wireless) and carriers intervened, and with QUALCOMM they convinced the ALJ not to issue a downstream exclusion order. The Commission nevertheless issued a sweeping limited exclusion order against the entire 3G handset industry. The CAFC struck down the limited exclusion order, holding "...Section 337 permits exclusion of the imports of non-respondents only via a general exclusion order, and then too, only by satisfying the heightened requirements of 1337(d)(2)(A) or (B). The statute permits LEOs to exclude only the violating products of named respondents..."

Antor Media Corp. v. Nokia, Inc. et al. (Antor II). Lead counsel representing defendant Kyocera Wireless Corp. in patent litigation in the Eastern District of Texas relating to downloading media content. Filed one of the initial four successful reexamination requests. Subsequently filed successful fifth reexamination request attacking 80 additional claims added by plaintiff during reexamination. The case was stayed pending reexamination, which found all claims unpatentable. The PTO Board and CAFC affirmed.

Saxon Innovations/Norman IP Holdings v. Casio, et al. Lead counsel for Kyocera defendants in E.D.

Texas and Kyocera DJ plaintiffs in S.D. California patent infringement actions relating to signal encryption, low power consumption and inter-processor communication.

ITC Investigation No. 337 TA 665. Co-counsel for respondents Kyocera, Sprint Spectrum, MetroPCS, Virgin Mobile and TracFone in ITC action brought by SPH America, Inc.

SPH America, Inc. v. 3COM, et al. Lead counsel representing cellular data card/module supplier Option Wireless and Option Wireless USA in patent infringement action in the Eastern District of Virginia and the Southern District of California.

Allflex USA, Inc. v. Avid Identification Systems. Represented Allflex USA, Inc. a patent infringement case against Avid Identification Systems, Inc. in the Central District of California relating to implantable radio frequency ID chips used to track livestock and pets.

Trilogy Software v. Selectica Inc. Represented defendant in patent infringement suit brought by Trilogy Software in the Eastern District of Texas relating to computer configuration software.

Lucent Technologies, Inc. v. Foundry Networks, Inc. Represented defendant Foundry Networks in a patent infringement dispute with Lucent in the Eastern District of Texas relating to VoIP technology.

Alcatel v. Foundry Networks, Inc. Represented defendant Foundry Networks in a patent infringement dispute with Alcatel in the District of Delaware relating to VoIP technology.

Bausch & Lomb v. Oasis Medical. Represented defendant Oasis Medical against claims of patent infringement brought by Bausch & Lomb in the Central District of California relating to microkeratome technology.

Sanyo Energy (USA) Corporation, et al., v. BYD Co. Ltd. Represented defendant BYD in patent infringement suit brought by Sanyo in the Southern District of California relating to lithium ion battery technology. Substituted in as trial counsel six weeks before trial; the case settled on eve of trial after adverse jury instructions were obtained and evidence was excluded for spoliation.

Affymetrix Inc. v. Incyte Genomics, Inc. et al. Represented defendant Incyte Genomics, Inc. and Stanford University in long-running district court actions and interference proceedings before the PTO relating to DNA microarray ("gene chip") technology.

Varian Technologies v. Applied Materials. Represented Applied Materials in interference proceedings in the PTO regarding inventorship of certain semiconductor manufacturing technology.

Medcam / Optimems v. MCNC. Represented MCNC in arbitration regarding development and ownership of MEMS (Micro Electro-Mechanical Systems) technology.