A. James Isbester

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Services

Intellectual Property

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Industries

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Financial Services

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Food, Restaurant & Beverage

Health & Life Sciences

Medical & Surgical Devices

Retail & Consumer Goods

Technology

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 post-grant proceedings, 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*® in 2023 and the six years immediately preceding for Intellectual Property Litigation. He 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. Mr.

Isbester was named a top patent practitioner in 2019, 2020 and 2021 by *IAM Patent 1000 – The World's Leading Patent Practitioners* and he is AV® rated by Martindale-Hubbell.*

Experience

We 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), and excluded willful infringement for injunctive relief. Through ex parte reexamination proceedings, we invalidated the fifth patent. The district court denied Fujifilm's attempt to undo the jury's verdict, and the case settled on appeal. *Fujifilm Corporation v. Motorola Mobility LLC*, No. 3:12-cv-3587 (N.D. Cal. filed July 10, 2012).

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).

Lead counsel for food products company accused of infringing U.S. patent relating to enzymes used in cheese manufacture. Won summary judgment of non-infringement.

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).

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).

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).

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).

Led an eight lawyer team defending Edwards Lifesciences in a four patent case Medtronics brought involving Edwards' flagship prosthetic surgical heart valves. Also led the countersuit asserting Edwards patents infringed by Medtronics' 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).

Led a team defending ACCO Brands USA and its subsidiary Kensington Microware 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).

Represented Tzero Technologies in patent infringement actions relating to ultra wideband communications technologies. The case settled following discovery.

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).

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).

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).

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.

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

Education

Osgoode Hall Law School LL.B. (1987)

University of California, Davis School of Law (1987) Visiting Student

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

Admissions

California

District of Columbia

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 Eastern District of Texas

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

U.S. District Courts for all Districts of California

U.S. Patent and Trademark Office

Professional & Community Activities

American Bar Association, Member

Litigation Counsel of America, Member

Editorial Advisory Board, MX Update, Member

Advisory Council, IP Osgoode, Member

Insights

News Releases

37 Kilpatrick Attorneys Named to the 2024 Lexology Index
November 25, 2024

News Releases

Kilpatrick Townsend Earns Top Recognitions in 2023 Edition of The Best Lawyers in America®
August 18, 2022

News Releases

Kilpatrick Townsend Once Again Achieves Impressive Rankings in Annual IAM Patent 1000

July 14, 2022

News Releases

Kilpatrick Townsend Attorneys Honored in the 2022 Edition of The Best Lawyers in America

August 19, 2021

News Releases

Kilpatrick Townsend Attorneys Recognized in 2021 IAM Patent 1000

July 28, 2021