

PARTNER

## John D. Vandenberg

john.vandenberg@klarquist.com



### EDUCATION

- J.D., Order of the Coif, New York University School of Law, 1983
- B.S.E., *cum laude* in Mechanical and Aerospace Engineering, Princeton University, 1979

### BAR ADMISSIONS

- Oregon, 1989
- Washington, 2006
- U.S. Patent and Trademark Office (Reg. No. 31,312)

### COURT ADMISSIONS

- U.S. Supreme Court
- U.S. Court of Appeals for the Federal, Second, Fifth, Ninth, and Eleventh Circuits
- U.S. Court of Federal Claims
- U.S. District Court for the Eastern District of Michigan
- U.S. District Court for the District of Oregon
- U.S. District Court for the Eastern District of Texas
- U.S. District Court for the Western District Washington

### YEAR JOINED FIRM

1989

### PRACTICE AREAS

Litigation  
Post-Grant USPTO Proceedings

### TECHNOLOGIES

Software & Internet Technology

### PRACTICE AREA OVERVIEW

For 33 years, Mr. Vandenberg has been litigating patents around the country for technology clients including Microsoft, SAP, eBay, Nautilus, and Mentor Graphics.

Supreme Court and Courts of Appeals: Mr. Vandenberg has argued a dozen appeals before the Court of Appeals for the Federal Circuit. He successfully argued before the Supreme Court of the United States in *Nautilus, Inc. v. Biosig Instruments, Inc.*, No. 13-369, for rejection of the Federal Circuit's "insolubly ambiguous" and "amenable to construction" test for enforcing the Patent Act's mandate that patent claims "particularly point[] out and distinctly claim[]" the patent's invention.

Court Trials: Mr. Vandenberg has first-chair tried patent infringement suits, copyright infringement suits, trademark infringement suits, and product-configuration trade dress suits. Most recently, he and a team at Klarquist obtained an \$8.42 Million jury verdict in a false advertising action.

PTAB Trials: Mr. Vandenberg has been lead counsel in Patent Office trial proceedings.

Patent-Law Training and Advocacy: Since 2004, Mr. Vandenberg has been the primary editor of an extensive summary of substantive defenses and related strategies in patent infringement suits, posted at [www.patentdefenses.com](http://www.patentdefenses.com). He speaks throughout the nation on patent law, district-court patent litigation, PTAB patent trials, and patent appellate practice. He emphasizes untraditional approaches to successfully defending against a patent infringement suit while improving the law and patent system in the process. To the same end, he has authored many *Amici* briefs in the U.S. Supreme Court and the Federal Circuit on behalf of scores of technology companies and associations.

### PRIOR PROFESSIONAL EXPERIENCE

Engineer at Pratt & Whitney Aircraft, jet engine development.

### PROFESSIONAL ACTIVITIES

- Vice Chair, Federal Circuit Bar Association, PTAB-TTAB Committee
- Former Vice Chair, Federal Circuit Bar Association, Patent and Trademark Office Committee
- Board of Directors (President), Seattle Intellectual Property American Inn of Court

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### HONORS AND AWARDS

- 2008-2018 *The Best Lawyers in America*®, Portland, OR, IP Litigation and Patent Litigation
- 2012, 2013, and 2016 *The Best Lawyers in America*®, Portland, OR, Patent Litigation Lawyer of the Year
- 2011, 2012, and 2015 *The Best Lawyers in America*®, Portland, OR, IP Litigation Lawyer of the Year
- 2006-2017 *Oregon Super Lawyers*®
- 2010-2017 Ranked in *Chambers USA*, Oregon, Intellectual Property
- 2014-2017 *IAM Patent 1000: The World's Leading Patent Professionals*
- 2014-2016 *IP Stars, Managing IP Magazine*
- 2014 *BTI Client Service All-Star*

### PRESENTATIONS AND PUBLICATIONS

- "The Constitutionality of IPRs: The Supreme Court Set to Rule" (panel discussion), Center for Advanced Study & Research on Innovation Policy 2017 Patent and Intellectual Property Law Summer Institute, University of Washington
- "Functional Claiming: New Traps for Prosecutors / Opportunities for Litigators, Under *Williamson* and *Nautilus*," Center for Advanced Study & Research on Innovation Policy 2017 Patent and Intellectual Property Law Summer Institute, University of Washington School of Law, 7/19/17
- "7 Things to Think About After TC Heartland," *Law360*, Co-author (3/31/17)
- "Patent Litigation 2017: The Courts and Patent Trial and Appeal Board," Panelist on Appellate Practice, Santa Clara University School of Law, 2/17/2017
- "Patent Defenses: Getting More Out of the Specification, Prior Art & Markman" Cleveland Intellectual Property Law Association CLE, Cleveland, OH, 10/27/2016
- Section 101 Preemption: Amici Brief filed in U.S. Court of Appeals for the Federal Circuit in *McRO, Inc. v. Bandai Namco Games America*, 10/26/2016 (John D. Vandenberg, Salumeh R. Loesch)
- "We Need Another Phillips to Explain 'Plain Meaning,'" *Law360* (8/3/2016)
- "The Supreme Court Review 2016" (Federal Circuit Bar Association's 2016 Bench and Bar Conference, Nashville, TN, 6/24/2016)
- "Panel with Chief Judge Mosman: Patent Litigation in 2016" (The Novice to the Pro, Portland, Oregon, 2/23/2016)
- "Advanced Tips for Patent Prosecution and Litigation" (San Jose technology companies' offices, 2/10/2016)
- "The PTAB Matures: Precedential Impact of Decisions, Procedural Aspects of CAFC Reversals, and The Public Role in Key Decisions" (Federal Circuit Bar Association, Washington, DC, 1/15/2016)
- "Tips for Patent Prosecution and Litigation Based on Recent Decisions" (Washington State Patent Law Association, Seattle, WA, 11/18/2015)
- "Patents and Patent Litigation: Develop, Strengthen, and Protect Your Intellectual Property" (Electronic Design Automation Consortium, San Jose, CA, 10/29/2015)

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- “Tips for Patent Prosecution and Litigation Based on Recent Decisions” (Oregon Patent Law Association and Oregon State Bar IP Section, Portland, OR, 10/1/2015)
- “Particularly Pointing Out And Distinctly Claiming”: What’s Next For The Patent Act’s “Clarity And Precision Demand” Post *Nautilus* and *Williamson*? (2015 American Bar Association Annual Meeting, Chicago, IL, 7/31/2015)
- “Using Patents to Curtail Climate Change: A Proposal” (Law360, 2/23/2015)
- “*Nautilus*: Watershed or Non-event?” (Oregon State Bar IP Section Annual Meeting, Portland, OR, 10/8/2014)
- Panelist at the Supreme Court IP Review regarding “*Nautilus v. Biosig Instruments*: Patent indefiniteness” (Illinois Institute of Technology Chicago-Kent College of Law, 9/12/2014)
- Panelist at United States Patent and Trademark Office’s “Software Partnership Meeting: Functional Claiming and Clarity of the Record,” (Alexandria, VA, 7/22/2014)
- “PTAB Roundtable Panel Discussion” (Patent Trial and Appeal Board, Seattle, WA, 5/01/2014) “A Discussion on *Nautilus v. Biosig*” (Federal Circuit Bar Association, The Patent and Trademark Office Committee, 4/29/2014)
- “Patent Strategies after the America Invents Act (AIA)” (Law Seminars International, Portland, OR, 1/30/2012)
- “Immediate and Near-Term Practical Impacts of the America Invents Act” (Oregon State Bar Intellectual Property Law Section, Oregon State Bar Computer and Internet Law Section, and Oregon Patent Law Association, Portland, OR, 12/7/2011)
- Panel with Judge William C. Bryson (Lewis & Clark Law School, 10/6/2011)
- “Immediate Impacts of Patent Reform, What You Need to Know Now About the America Invents Act” (Law Seminars International, Portland, OR, 10/6/2011)
- “Will Courts Follow the Supreme Court or the Federal Circuit?” (TexasBarCLE’s 7<sup>th</sup> Annual Advanced Patent Litigation Course, San Antonio, Texas, 7/15/2011)
- “Is Research Corp. Tech. v. Microsoft an Outlier or the Future of Patent Law Sec. 101?” (OSB Computer & Internet Law Section, Portland, OR, 2/22/2011)
- “Patent Law New Developments and Year in Review: Cases, Trends and Revelations” (Oregon State Bar’s Intellectual Property Review - Updates and Changes from 2010 Seminar, Tigard, OR, 1/21/2011)
- “In re Bilski: What Can You Patent Now?” (Joint Meeting of Oregon Patent Law Association & OSB Computer & Internet Law Section, Portland, OR, 12/11/08)
- “Patent Claim Construction Strategies for Defendants” (Patent Claim Construction Workshop, Law Seminars International, Seattle, WA, 7/10/07 & Supp., 7/16/08)
- “When Does a U.S. Patent Cover ‘Infringement’ Occurring Abroad?,” *The Licensing Journal*, Vol. 27, No. 8, Pgs. 13-20, September 2007 (John D. Vandenberg, Scott E. Davis)
- “Microsoft v. AT&T: The Foreign Reach of U.S. Patents” (Complex Intellectual Property Licensing Conference, Law Seminars International, Philadelphia, PA, 6/21/07)