

JOHN D. VANDENBERG

PARTNER

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OVERVIEW

For 35 years, John has been litigating patents around the country for technology clients including Microsoft, SAP, ETAP, Nautilus, and Mentor Graphics.

Supreme Court and Courts of Appeals: John has argued more than 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: John 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: John has been lead counsel in Patent Office trial proceedings.

Patent-Law Training and Advocacy: Since 2004, John has been the primary editor of an extensive summary of substantive defenses and related strategies in patent infringement suits, posted at 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.

John joined Klarquist in 1989 as an associate and became partner in 1991.

PROFESSIONAL EXPERIENCE

► Pratt & Whitney Aircraft | Engineer, jet engine development | East Hartford, CT

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

ADMISSIONS

Oregon, 1989

Washington, 2006

U.S. Patent and
Trademark Office, 1984
(Reg. No. 31,312)

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

Klarquist

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PROFESSIONAL ACTIVITIES

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

HONORS & AWARDS

- ▶ 2008 – 2022 The Best Lawyers in America®, Portland, OR, IP Litigation and Patent Litigation
- ▶ 2010 – 2020 Chambers USA, Oregon, Intellectual Property
- ▶ 2014 – 2021 IAM Patent 1000: The World’s Leading Patent Professionals
- ▶ 2006 – 2017, 2020 Oregon Super Lawyers®
- ▶ 2012, 2013, 2016, 2018 The Best Lawyers in America®, Portland, OR, Patent Litigation Lawyer of the Year
- ▶ 2011, 2012, 2015 The Best Lawyers in America®, Portland, OR, IP Litigation Lawyer of the Year
- ▶ 2014 – 2015 IP Stars, Managing IP Magazine
- ▶ 2014 BTI Client Service All-Star

REPRESENTATIVE CASES

- ▶ *Power Analytics Corporation v. Operation Technology, Inc.*, Case Nos. 18-1428 (Fed. Cir.), 16-cv-01955 (C.D. Cal.), 16-cv-00177 (D. Del.): Won summary affirmance at the U.S. Court of Appeals for the Federal Circuit of the invalidation of 138 claims in four patents in the field of modeling electrical systems. The Court in the Central District of California found all claims invalid under the abstractness exclusion to patent eligibility under § 101 of the Patent Act.
- ▶ *E-System Design, Inc. v. Mentor Graphics Corp.*, Case No. 17-cv-682 (E.D. Tex.): Represented EDA company in which the Court in the Eastern District of Texas invalidated all claims against the client based on the more stringent “reasonable certainty” test for claim indefiniteness. This stricter standard was established by the Supreme Court in *Nautilus Inc. v. Biosig Instruments Inc.*, where Klarquist had successfully represented Nautilus.
- ▶ *Biosig Instruments, Inc. v. Nautilus, Inc.* No. 13-369 (S. Ct.): Argued before the United States Supreme Court to reject the Federal Circuit’s lenient standard for definiteness. The Supreme Court unanimously held that the standard for definiteness applied by the Federal Circuit was too liberal. And it articulated that patent claims are indefinite if “read in light of the

PRACTICE AREAS

Litigation
Post-Grant USPTO
Proceedings

TECHNOLOGY AREAS

Software & Internet
Technology

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specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” The asserted patent involved heart rate monitor technology.

▶ *Synopsys, Inc. v. Mentor Graphics, Inc.*, Case No. 12-cv-06467 (N.D. Cal.): Represented EDA company in competitor multi-patent litigation. Argued and won partial summary judgment of patent invalidity under Section 101.

▶ *Metasearch Systems, LLC v. Priceline.com, Travelocity.com, Expedia, Orbitz, & American Express*, Case Nos. 12-cv-01188, 12-cv-01189, 12-cv-1190, 12-cv-01191, 12-cv-01223, 12-cv-01225 (D. Del.): Defended group of on-line travel companies against seven patents related to metasearching. Successfully argued Covered Business Method patent review trials instituted by the Patent Trial & Appeal Board, which found all claims unpatentable, resulting in dismissal of the lawsuit.

▶ *A Pty LTD v. eBay, et al.*, Case No. 15-cv-00155 (W.D. Tex.): Represented eBay on case involving email communication systems. The complaint was dismissed on a Rule 12 motion, as the Court found the asserted patent invalid as claiming unpatentable subject matter, under Section 101.

▶ *Grupo Bimbo S.A.B. de C.V., et al. v. Snak King Corp., et al.*, Case No. 13-cv-02147 (C.D. Cal.): Defended Snak King against large Mexican corporation asserting trademarks, trade dress, and patents related to rolled tortilla chips. After Snak King won claim construction on key patent claim terms and after Court held hearing on certain trademark issues, parties reached favorable settlement.

▶ *Realtime Data LLC d/b/a IXO v. SAP America, Inc., Sybase, Hewlett-Packard, & Dell*, Case No. 15-cv-00469 (E.D. Tex.): Defending SAP and Hewlett-Packard in multi-patent case involving data compression.

▶ *Big Baboon Inc. v. Hewlett-Packard, et al.*, Case No. 09-cv-01198 (C.D. Cal.): Representing Hewlett-Packard in multi-defendant multi-patent case involving database systems for end-to-end B2B commerce. Litigation was stayed after Klarquist filed reexaminations on both patents.

▶ *Research Corporation Technologies v. Microsoft Corp.*, Case No. 01-cv-0658 (D. Ariz.): Defended Microsoft against six asserted patents regarding halftoning technology, including at trial.

▶ *Anascape Ltd. v. Microsoft Corp., et al.*, Case No. 06-cv-00158 (E.D. Tex.): Represented Microsoft in multi-patent litigation involving Xbox® game controllers, winning partial stay pending reexams and partial summary judgment of non-infringement and no willful infringement (see 2008 WL 7182476).

▶ *Sklar v. Microsoft Corp.*, Case No. 06-cv-00007 (E.D. Tex.): Defended Microsoft in case relating to Windows® operating system user interface features.

▶ *Network Commerce v. Microsoft Corp.*, Case Nos. 01-cv-01991 (W.D. Wash.), 04-1445 (Fed. Cir.): Led defense team for Microsoft and won summary judgment of non-infringement regarding patents relating to online media distribution. Successfully defended the summary judgment win on appeal. See 422 F.3d 1353 (Fed. Cir. 2005).