

Derrick W. Toddy

derrick.toddy@klarquist.com



EDUCATION

- Post-Baccalaureate coursework in Computer Science, Oregon State University, 2015
- J.D., James Kent Scholar, Harlan Fiske Scholar, Columbia University, 2004
- B.S., Philosophy and Literature, Engineering Sequence in Information Systems Engineering, Dean's List, United States Military Academy (West Point), 1995

BAR ADMISSIONS

- Oregon, 2007
- California, 2004
- U.S. Patent and Trademark Office (Reg. No. 74,591)

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 Northern and Central Districts of California
- U.S. District Court for the District of Oregon
- U.S. District Court for the Eastern District of Texas

YEAR JOINED FIRM

2006

PRACTICE AREAS

Intellectual Property Counseling
Litigation
Patents: Utility
Post-Grant USPTO Proceedings

TECHNOLOGIES

Mechanical
Medical Devices & Diagnostics
Software & Internet Technologies

PRACTICE AREA OVERVIEW

Since joining Klarquist in 2006, Mr. Toddy has focused his practice on all aspects of Intellectual Property disputes, from pre-litigation and "alternatives to litigation" such as *inter partes* reviews, reexaminations, and other post-grant proceedings, through discovery, motion practice and summary judgment, to preparation for trial, as well as related settlement and licensing work.

Mr. Toddy has particular experience both prosecuting and litigating patents involving computer software, computer hardware, video game technology and e-commerce applications, as well as medical devices and treatments. He has represented technology clients such as Microsoft, Samsung, SAP, eBay, Adobe, LinkedIn, Netflix, Twitter, Hewlett-Packard, Nokia, and Amazon.com, as well as retail clients such as Office Depot, Staples, J.C. Penney, Burlington Coat Factory, Dillard's and Costco in intellectual property disputes nationwide, including in California, Delaware, Florida, Idaho, Massachusetts, Nevada, Puerto Rico, Tennessee, Texas and Washington.

Mr. Toddy also has experience in advising clients regarding freedom-to-operate issues, crafting settlement agreements, and intellectual property licensing, and has prepared a number of opinions regarding both non-infringement and invalidity. Finally, Mr. Toddy has extensive experience working on various post-grant proceedings in the USPTO, including first-chair trial and appeal experience in *inter partes* reviews and reexaminations defending appeals to the Patent Trial and Appeal Board (formerly BPAI). Mr. Toddy's work on these reexams and appeals often resulted in cancellation of patent claims asserted in litigation for which Klarquist's clients had obtained a stay pending the outcome of *ex parte* or *inter partes* reexams, in many cases avoiding entirely or greatly reducing the cost of having to litigate these claims in district court.

TECHNICAL EXPERTISE

Mr. Toddy's practice emphasizes both computer- and mechanical-related fields, and in particular the field of Web commerce and medical devices.

PRIOR PROFESSIONAL EXPERIENCE

Morgan Miller Blair
Associate | 2005 - 2006

Quinn Emanuel Urquhart Oliver & Hedges, LLP
Associate | 2004 - 2005

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JUDICIAL CLERKSHIP

Judicial Extern to the Honorable Jack Weinstein, Eastern District of New York | 2003

PRESENTATIONS AND PUBLICATIONS

- "Ask the Legal Professional," *Portland Business Journal*, December 2012, June 2015
- "Navigating Your Business Through the Rising Tide of Patent False Marking Suits", *Portland (OR) Business Journal*, September 2010
- "False Marking Suits: Rising Tide or Blip on the Radar?", *Oregon State Bar Intellectual Property Section*, August 2010

REPRESENTATIVE CASES

Over the past decade, Mr. Toddy has been involved in all aspects of a large number of patent and trademark cases, including the following representative litigation cases (represented parties underlined), as well as, in many cases, related PTO and/or PTAB proceedings:

- *ADC v. Microsoft Corporation* (W.D. Wash.): Patent infringement litigation and related PTO reexaminations involving online distribution of videos and software.
- *Anascape v. Microsoft Corporation* (E.D. Tex.): 12-patent litigation and related PTO reexaminations involving various technical aspects of Xbox® game controllers.
- *Big Baboon v. Hewlett-Packard* (C.D. Cal.): Multi-defendant patent litigation case and related PTO reexaminations involving database systems for end-to-end B2B commerce.
- *Canatelo v. Avigilon* (P.R.): Patent infringement suit related to video surveillance technology.
- *Meynard Designs v. Earth Products, Inc.* (Mass.): Trademark infringement suit related to use of the mark "earth" on clothing.
- *Hawk Technology v. Avigilon, Costco, Burlington Coat Factory, NBC Universal et al.* (S.D. Fla., M.D. Fla.): Series of patent cases relating to video surveillance technology.
- *Interval Licensing v. eBay, Netflix, Office Depot, Staples et al.* (W.D. Wash.): Patent infringement litigation and related PTO reexaminations involving recommendation functionality on web commerce sites.
- *Microsoft Corporation v. WebXchange* (D. Del., N.D. Cal.): Declaratory judgment actions and related reexaminations related to patents on facilitating online network transactions.
- *Optimize v. Dillard's, Drugstore.com, J.C. Penney, Staples et al.* (E.D. Tex.): Patent infringement litigation related to recommendation technology on web commerce sites.
- *Reiffin v. Microsoft Corporation* (N.D. Cal.): Patent infringement litigation and Federal Circuit appeal concerning multithreading operating system technology.

OF COUNSEL

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- *RMail Limited v. Amazon.com, PayPal* (E.D. Tex.): Multi-defendant patent infringement suit and related PTO reexaminations related to online transmission of secure messages.
- *SAP v. Wellogix*, (S.D. Tex.): Patent infringement litigation and related PTO reexaminations involving project management software.
- *Taylor Brands v. Columbia River Knife and Tool* (E.D. Ten.): Patent infringement suit and Federal Circuit appeal related to assisted opening knives.
- *TQP v. Adobe, British Airways, Costco, Intuit, LinkedIn, Travelocity.com, Twitter, Yelp, and Zones* (E.D. Tex.): Series of patent infringement cases involving encryption patent that Plaintiff asserted against the ubiquitous use of RC4 with SSL/TLS with various secure websites.
- *VStream v. Nokia et al.* (E.D. Tex.): Patent infringement suit related to compression and decompression of images on "smart" devices.