

TOP INTELLECTUAL PROPERTY ATTORNEYS in California for 2016

When we're listening to pre-1972 music on rotation in our smartphones or reaching for a ketchup bottle at lunch, intellectual property doesn't come to mind. But these are just a few examples of the work behind the California attorneys we chose on our list for their efforts protecting the intellectual property belonging to companies of all sizes across the country and around the world.

As technology makes vast improvements year after year across the industry spectrum, intellectual property attorneys — litigators and patent prosecutors — are rolling up their sleeves to stay ahead of the game. In California, established Silicon Valley and booming Silicon Beach have created global hubs for such innovation to take place in on-demand services, social media, health care, consumer technology and other various fields. But the fight to protect patents, copyrights and trademarks can start on a local court level and move to the appellate courts, while also heading to the U.S. Patent and Trademark Office, the U.S. International Trade Commission and the U.S. Supreme Court.

Intellectual property attorneys face many hurdles as they try to protect the branding of companies for consumers and a range of venues for those who want to protect their innovations. The attorneys in this issue took those challenges head-on and pushed technological progress forward.

—The Editors

Robert M. Galvin

FIRM

Wilmer Cutler Pickering Hale and Dorr LLP

CITY

Palo Alto

SPECIALTY

IP litigation



Galvin won a precedent-setting case for website domain company GoDaddy Inc. against the Academy of Motion Picture Arts and Sciences in a cybersquatting dispute over the Academy's trademarked names "Oscar" and "Academy Awards."

"The Academy complained that some of

our domains contained strings of names like 'Oscar' and 'Academy,'" Galvin said. "Instead of going after the people who owned the domains, they went after us."

Galvin argued that GoDaddy had a strong takedown policy. "The case dragged on for four or five years. We were brought in shortly before trial. We showed that we took down cybersquatters quickly, and that some of the challenged names were legitimate," he said.

"One witness was a comedian named Oscar Sagastume, whose name was understandably oscarsagastume.com," Galvin added. "We showed that our client registers a domain every second — and we showed that the steps we took to protect against cybersquatting were reasonable."

The Academy demanded \$29.3 million under the Anticybersquatting Consumer Protection Act, claiming that GoDaddy had made \$90 million in revenue from placement of ads on 293 web domains containing "Oscar" or "Academy." But U.S. District Judge Andre Birotte Jr. found last September the Academy failed to prove GoDaddy acted with a bad faith intent to profit.

Birotte also found the defense had established an affirmative defense that it acted with a good faith belief that the challenged domain names fell under the fair use doctrine or were otherwise lawful. *Academy of Motion Picture Arts and Sciences v. GoDaddy.com Inc.*, 10-CV03738 (C.D. Cal., filed May 18, 2010)

"I was incredibly impressed by Judge Birotte," who had been U.S. attorney in the Central District. "The day before closing arguments, he posed a series of questions that let the parties know what he was thinking. I was impressed with the detail and care he took at a very deep level."

Galvin said the outcome represented a successful partnership with GoDaddy's original counsel at Ring Bender McKown & Castillo LLLP. "We were able to leverage their knowledge from living the case into a successful collaboration," he said.

Galvin didn't expect the entertainment crossover. "I never thought any of my IP cases would be in the Hollywood Reporter."

— John Roemer