



Brian Berliner

Of Counsel

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Brian Berliner is a seasoned intellectual property litigator focused on representing technology companies in patent litigation, particularly involving electronics, computer hardware, software, communications, and Internet technology. In addition to litigating patent matters in U.S. District Courts across the country and before the U.S. International Trade Commission (USITC), Brian has an active practice representing clients in inter partes and other post-grant review proceedings in the U.S. Patent & Trademark Office. Brian is also Chair of O'Melveny's patent and trademark prosecution sub-practice.

Chambers USA has repeatedly ranked Brian among the top Intellectual Property lawyers in the country, noting his ability "to explain the byzantine patents process in layman's terms, which helps [clients] make informed and tactical decisions," and describing him as an "exceptionally responsive" lawyer with "great business sense" and "fine legal knowledge." The *Daily Journal* has recognized Brian among the leading portfolio managers, patent prosecutors, and intellectual property litigators in California. And Brian has been recognized as a Southern California "Super Lawyer" in a survey conducted by *Law & Politics Media Inc.* that is published in *Los Angeles* magazine.

In addition to his technical patent work, Brian represents and counsels clients in trademark matters, including trademark litigation, clearance, and registration, and advises clients on transactional intellectual property matters, including licensing and technology transfer agreements and due diligence.

Prior to practicing law, Brian served as a Captain in the US Air Force, responsible for the acquisition and testing of defense

Admissions

Bar Admissions

California

District of Columbia

New York

Court Admissions

US Court of Appeals, Ninth, District of Columbia, and Federal Circuits

US District Court, Central, Eastern, and Northern Districts of California, Southern District of New York

Registered to Practice

US Patent & Trademark Office

Education

Loyola Law School, J.D., 1991: chief articles editor, *Loyola of Los Angeles International and Comparative Law Journal*

University of Southern California, M.S., Systems Management, 1984

Northeastern University, B.S., Electrical Engineering, 1981

satellite systems and subsystems. In that capacity, he had hands-on payload integration responsibilities involving a number of Atlas expendable launch vehicle missions.

Experience

- Prevailing at trial and securing a rare Eastern District of Texas jury verdict in favor of the defense for an international consumer electronics company against patent infringement claims asserted by a competitor involving digital television products; the jury found all patents non-infringed and two patents invalid in a decision affirmed on appeal to the Federal Circuit
- Securing summary judgment of invalidity for an international consumer electronics company six weeks before trial in defense of a Southern District of Florida patent infringement case against a major University involving video-image scaling used in computer monitors and digital televisions; affirmed on appeal to the Federal Circuit Currently defending one of the largest electronics companies in the world in a contentious patent infringement against a competitor relating to graphics processing technology (E.D. Tex.)
- Currently defending an international consumer electronics company against patent infringement claims asserted by a competitor involving digital television and monitor products (E.D. Tex.)
- Currently representing a privately held e-commerce company in asserting patent infringement claims against an e-commerce and cloud computing giant in a seven-patent case involving e-commerce technology; currently on appeal to the Federal Circuit (W.D. Wash.)
- Defending an international consumer electronics company in two parallel USITC proceedings involving LCD panels used in digital televisions, monitors, laptops, cellular phones, and computer displays, with related actions in the Northern District of California and the District of Delaware; all matters resolved in a favorable global settlement
- Representing a major retail grocery chain in enforcing trademark rights against a copycat retailer; currently on appeal to the Ninth Circuit
- Prevailing at trial for an international semiconductor company in the defense of a USITC Section 337 investigation against a competitor involving multilayer ceramic capacitors found in nearly every electronics product in the country; the Commission found no violation on all asserted patents and, on one, found no domestic industry
- Prevailing at trial for an international consumer electronics company in the defense of a USITC Section 337 investigation against a competitor involving digital television technology; after a full trial on the merits the Commission confirmed the invalidity of one of the patents-in-suit, and the Federal Circuit reversed a finding of patent infringement with respect to the second patent, resulting in a complete victory for the client
- Representing an international consumer electronics company in a series of patent infringement cases, both offensive and defensive, against a competitor involving LCD panels and display modules, including a USITC Section 337 investigation and district court cases in Delaware and the Northern District of California; the parties reached a global settlement just before trial in the USITC case
- Representing a leading global entertainment content company in a confidential commercial arbitration involving patent, copyright, and licensing rights one of most popular music videogames of all time; case settled favorably for the client

- Representing a major retail grocery chain in seeking a preliminary injunction in a trademark infringement matter against a would-be competitor; matter resolved with a consent decree that halted all of defendant's infringing activities (E.D. Penn.)
- Successfully defended a major aerospace company against patent infringement claims involving attitude control systems for space satellites; invalidated the patent-in-suit in reexamination proceedings resulting in the subsequent dismissal of the District Court case on summary judgment (C.D. Cal.)

Professional Activities

President

- Los Angeles Intellectual Property Law Association (2005)

Member

- American Bar Association, Intellectual Property Section
- Los Angeles Intellectual Property Law Association (Board member, 2002-2006)
- American Intellectual Property Law Association
- Research Committee for Children's Hospital Los Angeles (2005 to present)

Author

- "Revised USPTO Trial Practice Guide Leans Pro-Patent Owners," *Law360* (November 12, 2019)
- "Fee Shifting in Patent Litigation," (co-author Mark Liang), *Virginia Journal of Law & Technology*, Vol. 18, No. 01 (Fall 2013)
- "Supreme Court Holds Business Methods May Be Patentable," *ipFrontline* (June 29, 2010)
- "Courting Patent Reform," *Law 360* (April 27, 2009)
- "Patently Unfair?," *The Recorder* (December 2006)
- "Preparing Patent Infringement And Freedom-To-Operate Opinions," *Practising Law Institute* (2005)
- "Preparing Patent Infringement and Freedom-to-Operate Opinions," *The Computer & Internet Lawyer* (November 2004)
- "Preparing Patentability Opinions," *Preparing Patent Legal Opinions* (Intellectual Property Course Handbook Series), Practising Law Institute (2001)
- "Making Intellectual Property Pirates Walk the Plank: Using 'Special 301' to Protect United States' Rights," *Loyola of Los Angeles International and Comparative Law Journal*, Volume 12
- "Security Interests in Intellectual Property," *Structuring Secured Commercial Loan Documents* (1992)

Speaker

- "Conflicts of Interest When Representing Multiple Clients," Loyola Law School Special IP Focus Series (December 2007)
- "Patents and the Real World: How Recent Supreme Court Cases and Proposed Legislation Will Impact You and Your Business," CLE Presentation, Newport Beach and San Francisco (September 2007)
- "Patent Opinion Letters and Willful Infringement," Silicon Valley Intellectual Property Law Association (May 2006)

- “Drafting Non-infringement Opinions,” Orange County Patent Law Association (April 2006)
- “Avoiding Conflict and Reducing the Risk of Claims in Patent and Intellectual Property Practice,” Los Angeles Intellectual Property Law Association “Washington and the West” Conference (January 2006)
- “Preparing Patent Legal Opinions 2005,” Practising Law Institute (October 2005)
- “Patent Infringement and Freedom to Operate Opinions,” Practising Law Institute (October 2004)
- “Preserving U.S. Patent Rights,” Eighth Annual Intellectual Property Law Conference for Paralegals (June 2004)
- “Preparing Patent Legal Opinions 2003,” Practising Law Institute (September 2003); “Preparing Patentability Opinions,” Practising Law Institute (October 2002)
- “Preparing Patentability Opinions,” Practising Law Institute (September 2001); “Washington & The West Patent Symposium,” Los Angeles Intellectual Property Law Association (January 2001)

Chair

- “A Comprehensive Review of Trademark Registration Practice,” Los Angeles Intellectual Property Law Association (January 2000)
- “Patent Protection for Software Companies,” Software Council of Southern California (November 1999)

Editorial Board

- *American Intellectual Property Law Association (AIPLA) Quarterly Journal*

Honors & Awards

- Recognized by *The Legal 500 US* for Trademarks: Litigation (2020)
- Named by *Managing Intellectual Property* as among “IP Stars” for 2019
- Recognized in *Chambers USA*, Intellectual Property, Patent (California)
- Listed by *Los Angeles* and *San Francisco Daily Journals* as among “Leading Portfolio Managers, Patent Prosecutors and Litigators”
- Recognized as a Southern California “Super Lawyer” in a survey conducted by *Law & Politics Media Inc.* and published in *Los Angeles* magazine and the Southern California edition of *Super Lawyers*