



Robert S. Gerber

Partner

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PRACTICE AREAS

- Intellectual Property
- Litigation
- Entertainment, Media and Technology

INDUSTRIES

- Advertising
- Entertainment, Media and Technology
- Sports
- Video Game

OVERVIEW

Robert S. Gerber is a partner of Sheppard Mullin located in the Del Mar Heights (Northern San Diego) office. He is a member of the firm's Diversity & Inclusion Committee. He is the former Chair of the firm's Pro Bono Committee (2001-2010).

Areas of Practice

Mr. Gerber has been practicing trial law in San Diego since 1988, with a focus in Intellectual Property, Entertainment Litigation, and Professional Liability Litigation. He regularly handles a variety of IP matters in the entertainment and many other industries, including patent, trademark, copyright, false advertising, and trade secret lawsuits. He also advises companies and individuals on protection and prosecution of their intellectual property rights.

Mr. Gerber's practice also focuses on the defense of lawyers, accountants, directors, officers, brokers, insurers, and others in professional liability claims and related insurance issues. He has significant experience defending against class action and representative plaintiff claims as well.

Mr. Gerber also has significant experience in general commercial litigation, including securities law, real estate, products liability, contracts, banking law, partnership disputes, arbitrations, and administrative proceedings.

EDUCATION

- J.D., Harvard Law School, 1988, *cum laude*
- M.P.P., University of Michigan, 1985
- B.A., University of Michigan, 1984, *high honors and high distinction*

CLERKSHIPS

- Law clerk for the Hon. Rudi M. Brewster, U.S. District Court for the Southern District of California, from 1988-1989

ADMISSIONS

- California

EXPERIENCE

Intellectual Property

- Represented a sales training company in a copyright and trademark infringement action against it; prevailed in a ten day arbitration hearing and successfully defended against a motion to vacate in federal district court.
- Represented a publicly traded retailer of women's apparel and accessories in a copyright infringement action (and related appeal of a prior case) involving four different copyrighted jewelry/sculptural designs. Case settled favorably.
- Represented a San Diego children's magazine publisher in multi-million dollar dispute with a local author concerning ownership and use rights in and to numerous copyrighted works, trademarks, and the publication's trade dress. Negotiated and drafted thirteen different license, distribution, consulting, and other contracts (copyright and trademark related) in favorable settlement of the disputes.
- Represented a publicly traded San Diego herbal supplement manufacturer in its trade secret/contract dispute with a nationally recognized New Jersey pharmaceutical company competitor (a Fortune 500 company) and former licensee in New Jersey and California state courts; obtained a six-figure settlement for our client, the defendant.
- Represented an internationally renowned golf equipment manufacturer in San Diego in a multi-million dollar dispute with a Fortune 500 competitor concerning patent infringement, trade dress infringement, false advertising, and unfair competition allegations relating to golf ball manufacture, packaging and advertising. The complaint was voluntarily dismissed by the opposing party without payment of any kind on the eve of the trial setting conference.
- Represented a nationally recognized Illinois manufacturer of pregnancy test kits in patent infringement/validity action against a California competitor, as local counsel; case went to trial the morning of 9/11/01; prevailed in the Federal Circuit on appeal, and judgment as a matter of law was granted to our client. Case settled favorably thereafter.
- Represented a San Diego music distribution company in a trademark infringement lawsuit against a publicly held, nationally recognized Internet software and content provider in the Bay Area. Obtained a seven-figure settlement payment after only 21 days of litigation.
- Represented a prominent Southern California ski resort in a copyright infringement case involving the client's alleged unauthorized use in a radio advertisement of lyrics from a famous rock & roll song by a Hollywood-based "big hair band" from the 1980's; case settled favorably on eve of trial.
- Repeatedly represented a world-renowned San Diego bicycle parts manufacturer in its disputes with various international and domestic competitors concerning patent, copyright and trademark infringement claims; cases settled favorably; continuing to provide ongoing advise to company on its overall IP strategy.
- Represented world-renowned San Diego golf company in defense of a private attorney-general/unfair competition claim arising from its advertising. Case settled very favorably with minimal changes to its already planned advertising, and successfully defeated plaintiff's fee motion (plaintiff was awarded nothing).
- Represented world-renowned San Diego golf company in its misappropriation of trade secrets and unfair competition claims against a Fortune 500 competitor involving theft of patented golf technology and other trade secrets; case settled confidentially and very favorably.
- Represented a San Diego water purification company in its declaratory relief trademark lawsuit against an Illinois Fortune 500 competitor; case settled with a payment by PLAINTIFF to our client, the alleged infringer.

Professional Liability

- Represented a San Diego lawyer and his law firm in a legal malpractice cross complaint arising out of a complicated real estate development partnership dissolution. Settled case favorably.
- Represented a San Diego business litigation lawyer in a legal malpractice case arising out of a complicated divorce involving the alleged under-valuation of a closely held corporation. Tried the case and obtained judgment of nonsuit in favor of our client.
- Represented a Los Angeles law firm and its partners in a legal malpractice action arising from an underlying failed premises liability case involving a rape in an apartment complex, which the clients lost; obtained summary judgment on behalf of the clients.
- Represented a San Diego law firm and a number of its lawyers in a legal malpractice/breach of fiduciary duty case arising out of the alleged use of confidential information against the firm's prior clients. Obtained summary judgment for our clients against the key plaintiffs; remainder of case settled without any payment to plaintiffs.
- Represented a San Diego law firm and one of its partners in a lawsuit for alleged fraud brought by a former adverse party. Obtained judgment of dismissal on grounds of the litigation privilege.
- Represented a Washington law firm and various partners in a lawsuit for alleged malicious prosecution of an underlying patent lawsuit. Settled case favorably.
- Represented a San Diego law firm and one of its partners in a legal malpractice lawsuit arising out of a failed real estate development scheme. Settled case favorably.
- Represented a Washington, D.C. law firm and one of its partners in a legal malpractice case arising out of the firm's employment of a patent expert who committed fraud with respect to his credentials. Settled case favorably.
- Represented a Los Angeles insurance broker and his firm in a broker malpractice claim brought by a public company for alleged failure to secure proper coverage. Settled case favorably.
- Represented an accountant in a claim of alleged malpractice arising out of an alleged tax reporting error. Settled case favorably.

Entertainment

Properties as to which Mr. Gerber has handled disputes or agreements include:

- "Babylon A.D." (motion picture) (bond/financing dispute)
- "Barnyard" (motion picture) (equipment sale dispute)
- "Best Friends Forever" (motion picture) (domain name dispute)
- "Black Water Transit" (motion picture) (financing dispute)
- "Brigham City" (motion picture) (distribution contract negotiation)
- "Charly" (motion picture) (production contract dispute)
- "Deceit" (a.k.a. "The American Standard") (motion picture) (participation dispute)
- "Dreamgirls" (motion picture) (copyright and trademark infringement dispute)
- "God's Army" (motion picture) (distribution dispute)
- "The Good Shepherd" (motion picture) (foreign distribution dispute)
- "The Ground Truth" (motion picture) (trademark infringement/ unfair competition)
- "Hustle and Flow" (motion picture) (domain name dispute)
- "Little Children" (motion picture) (domain name dispute)

- "Lucky Number Slevin" (motion picture) (financing dispute)
- "The Other Side of Heaven" (motion picture) (distribution contract negotiation)
- "Sister Christian," Night Ranger (sound recording/composition) (copyright infringement dispute)
- "The Transformers" (motion picture) (domain name dispute)
- "Unknown" (motion picture) (distribution dispute)
- "World Poker Tour" (cable television program) (copyright, trademark, and contract disputes)
- Representative entertainment and media companies/organizations include:

ABS CBN, Inc.
Barnyard the Movie, Inc.
Broken Nose Productions, LLC
Eleven Eleven Films, LLC
Excel Entertainment, Inc.
First Look Studios, Inc.
Focus Features, Inc.
Motion Picture Association of America
Paramount Pictures Corp.
Sony Online Entertainment, Inc.
Studio Canal, S.A.
WPT Enterprises, Inc.

Pro Bono

- Mr. Gerber has donated thousands of hours of free legal services to the indigent since becoming a lawyer, including the representation of a Mexican teenager in a precedent-setting immigration case entitled *Hernandez-Montiel v. INS*, 225 F.3d 1084 (9th Cir. 2000).
- Mr. Gerber was named the "Pro Bono Attorney of the Year" and "Pro Bono Attorney of the Decade" by Sheppard Mullin in 2010.

HONORS

- Best Lawyers in America, 2012, in Intellectual Property Litigation and Patent Litigation
- Top Attorneys 2008, IP Litigation, *San Diego Daily Transcript*; Top Attorneys 2009, IP Litigation and Commercial Litigation, *San Diego Daily Transcript*; Top Attorneys 2011, IP Litigation, *San Diego Daily Transcript*.
- Rated AV® by Martindale-Hubbell (the highest peer rating available for legal ability and ethics)
- San Diego Super Lawyer, 2007 - 2011

MEMBERSHIPS

- Mr. Gerber is well-respected in the San Diego legal community and throughout California by both bench and bar. He has been appointed or elected to leadership positions in bench/bar activities at the local, state and national levels, including, among others:
- Ninth Circuit Trustee, American Inns of Court Foundation
- President, Former Vice-President, Treasurer, and Master, J. Clifford Wallace American Inn of Court
- Master, Louis M. Welsh Inn of Court

- Appointed Lawyer Representative, Southern District of California
- Co-Chair, Trade Secrets Subcommittee of the ABA Litigation Section's Intellectual Property Litigation Committee
- Former Chair, Litigation Section of the State Bar of California
- Current Advisor and Former Chair, Legal Ethics Committee, San Diego County Bar Association
- Former Member, California State Bar Commission on Judicial Nominees Evaluation
- Former Co-Editor, ABA Section of Litigation, Professional Liability Litigation Committee's Newsletter

ARTICLES

- Top Attorneys 2011, *San Diego Daily Transcript*, July 20, 2011
- Top Attorneys 2010, *San Diego Daily Transcript*, July 21, 2010
- Top Attorneys 2009, *San Diego Daily Transcript*, July 8, 2009
- Mentors: Robert Gerber, July 20, 2009
- Leadership Liability: Protecting Directors, Officers From Exposure to Patent Infringement Damages, *San Diego Daily Transcript*, January 31, 2008
- The Top 10 Ways Copyright Law Can Ruin Your Transaction, February 28, 2007
- Pulling Rank, September 14, 2006
- Mixing It up on the Web: Legal Issues Arising from Internet "Mashups," August 24, 2006
- Who's to Blame? 'Baird' Clears Way for an Answer, June 13, 2006
- Fluidity of Test Factors Makes Trademark Cases Hard to Pin, February 15, 2006
- The Top Five Excuses for Not Doing Pro Bono Work, and Why They're All Bad, May 4, 2005
- Internet Litigation And The Battle To Protect Intellectual Property Rights, August 19, 2004

Intellectual Property Law Blog Articles

- "Questions Unanswered: The Application of California's New Trade Secret Jury Instructions," December 8, 2008
- "I Can Copy, Right? Oh No, Copyright!," April 17, 2006
- "'Surviving' Summary Judgment In Trademark Infringement Actions," March 10, 2006

SPEECHES

- Moderator: "Not Just for Hackers Anymore? Use of The Computer Fraud and Abuse Act to Respond to Theft of Confidential Information by Employees," American Bar Association Roundtable (March 2009)
- "Truth in Advocacy," San Diego County Bar Association (February 2008)
- Ethical Issues in the Modern Law Office," San Diego County Bar Association (January 2008)
- Recent Developments in E-Discovery," Mortgage Bankers Association (November 2007)
- "What Poker Can Teach Us About Negotiation," California Western School of Law, Negotiations Class (May 2006 and 2007)
- "The Ethical Edge," San Diego County Bar Association program (January, 2005)

- "Arbitration and Mediation of Trademark Disputes," State Bar of California Intellectual Property Section program (November 2004)
- "Advertising Claims under Bus. & Prof. Code Section 17200," Co-Panelist with Robert Beall, Esq. and the Hon. J. Richard Haden, American Corporate Counsel-San Diego program (April 2004)
- "Digging Up Digital Dirt: Electronic Discovery in 2003," San Diego County Bar Association (November 2003)
- "Are You Practicing Illegally in California? Recent Developments in Multijurisdictional Practice Law," Co-Presenter with Andrew Guilford, Esq., American Corporate Counsel Association breakfast program (June 2003)
- "Multijurisdictional and Multi-Disciplinary Practice," PLUS Convention, New York, NY (May 2002)
- "Ethics after Enron," American Corporate Counsel Association luncheon program (April 2002)
- "Ethical Issues in ADR," Program Moderator and Participant, Legal Ethics Committee of the San Diego County Bar Association (January 2002)
- "State Court v. Federal Court: On Which Side of Broadway is the Grass Greener?," San Diego Federal Bar Association program moderator (September 2001)
- "Recent Developments in Immigration Law," State Bar Annual Meeting (September 2001)
- "Ethical Issues in Multi-Disciplinary and Multi-Jurisdictional Practice," Legal Ethics Committee of the San Diego County Bar Association (January 2001)
- "Ethical Jeopardy," Litigation Section of the State Bar of California, Section Education Institute (January 2001)
- "Advanced Intellectual Property Litigation," Continuing Education of the Bar (October 1999)
- "Obtaining TROs and Preliminary Injunctions in Federal Court," San Diego Chapter of the Federal Bar Association (May 1999)
- "After the Crash: Protecting Yourself From Y2K Litigation," University of California-San Diego's "Connect" Program Conference (May 1999)
- "Being Effective in Expert Testimony," National Association of Certified Valuation Analysts' Conference (Aug. 1997 and Sept. 2000)
- Interviewed on KCEO (AM 1000) and KPRZ (AM 1210) radio stations regarding legal issues arising out of doing business on the Internet (Fall 1997).
- "Uniform Possibilities in Local Rules," California State Bar Annual Meeting, San Diego, California (October 1993).
- Frequent speaker to many clients' in-house attorneys on issues of ethics, intellectual property law, and other legal developments.