



Neil A. Smith

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PRACTICE AREAS

- Intellectual Property
- Entertainment, Media and Technology
- Litigation
- International Business

INDUSTRIES

- Entertainment, Media and Technology
- Fashion, Apparel and Beauty
- Life Sciences
- Video Game

OVERVIEW

Neil Smith is a partner in the Intellectual Property Practice Group in the firm's San Francisco and Silicon Valley offices.

Areas of Practice

Mr. Smith's practice includes litigation and counseling in trademark, patent, copyright and unfair competition matters. Mr. Smith has represented a broad range of high-technology, corporate, software, and traditional brick-and-mortar businesses in publishing, multi-media, video game and consumer product businesses, and is a frequent speaker and author on Internet and intellectual property subjects. In addition to traditional IP issues, he has specialized in Internet, gray market and anti-counterfeiting subjects, including ex parte restraining orders and asset freezes.

Prior to joining Sheppard Mullin, Mr. Smith was a partner for more than 25 years at an intellectual property boutique firm, where he specialized in the full range of intellectual property matters in trademark, patent, unfair competition and copyright law. Prior to moving to California, he served as a law clerk to Judge Giles S. Rich, Associate Judge, United States Court of Customs and Patent Appeals in Washington, D.C., 1972-1974 (Predecessor to the Court of Appeals for the Federal Circuit). From 1969-1972 he was a Patent Attorney for the United States Atomic Energy Commission in Washington, D.C.

EDUCATION

- L.L.M., Patent and Trade Regulation Law, George Washington Law School, 1973
- J.D., Columbia Law School, 1969
- B.S., Mechanical Engineering, Columbia University, 1966
- B.A., Physical Sciences, Columbia University, 1965

ADMISSIONS

- U.S. Patent and Trademark Office

HONORS

- Top Intellectual Property: Trademark, Copyright & Trade Secrets Lawyers, Chambers & Partners', 2009

- Who's Who Legal: California, 2008, 2009
- The Best of the U.S. 2008
- The International Who's Who of Internet and e-Commerce Lawyers, *Who's Who Legal*, 2008
- The International Who's Who of Business Lawyers, *Who's Who Legal*, 2008
- Leading attorney in media and information technology (Technology, Media and Communications), Legal Media Group's The U.S. Best of the Best, 2006
- Top leading lawyer, Chambers & Partners', 2006 and 2008
- "Litigator of the Year", Managing Intellectual Property, 1999
- First recipient of the Joseph Rossman Award from the Patent and Trademark Office Society
- Best Lawyers in America
- Guide to the World's Leading Experts in Trademark Law
- Guide to World's Leading Experts in Patent Law
- Who's Who of Internet and Electronic Commerce Lawyers

MEMBERSHIPS

- Panel of Neutrals, International Trademark Association
- Treasurer, State Bar of California International Law Section Executive Committee
- President, San Francisco Patent and Trademark Law Association
- Member, Board of Directors American Intellectual Property Law Association, Trademark and Trade Name Committee Chairman, Licensing Committee Chairman
- Member, American Bar Association, PTC Section, Chairman Trademark and Trade Name, and Trade Secret Committee and, Trademark Office Affairs Committees, PTC Section delegate to RICO Committee 1986-90, Chair of Div. II (Trademarks) and currently Chair of Div. IV (IP Related Legal Issues)
- Member, Advisory Board of the Patent, Trademark and Copyright Journal of the Bureau of National Affairs
- Executive Committee Member, State Bar of California, Patent and Trademark Section
- Delegate, California State Bar Convention
- Former member, U.S. Dept. of Commerce Public Advisory Committee on Trademark Office Affairs
- Trustee, United States Copyright Society
- Board and Treasurer, National Council of Intellectual Property Law Association

ARTICLES

- Ninth Circuit Report: Raymond Edwards II v. Arthur Andersen LLP, April 6, 2009
- Ninth Circuit Report: ESS Entertainment 2000, Inc. d/b/a Playpen v. Rock Star Video, Inc. et al., November 5, 2008
- Ninth Circuit Report: Omega S.A., v. Costco Wholesale Corporation, September 3, 2008
- Ninth Circuit Report: Krinsky v. Doe 6, February 6, 2008
- Ninth Circuit Report: Leadsinger, Inc. v. BMG Music Publishing, ET AL., *New Matter*, Volume 33, Number 1, 2008, 2008
- Ninth Circuit Report: K and N Engineering, Inc. v. Bulat, December 18, 2007

- Assessing Personal Jurisdiction in Patent Litigation Actions, November 1, 2007
- When Copyright and Trademark Infringement Goes Online, *New York Law Journal*, October 29, 2007
- The Supreme Court Opens the Door to More Patent Challenges, July 2, 2007
- Fox v. Dastar Redux, November 28, 2006
- Ninth Circuit Report: Altera Corp. v. Clear Logic, Inc., November 28, 2006
- Ninth Circuit Report: Au-Tomotive Gold, Inc. v. Volkswagen of America, Inc., November 28, 2006
- Supreme Court Report: e-Bay v. MercExchange, November 28, 2006
- Supreme Court Report: Metro-Goldwyn-Mayer Studios Inc. et al. v. Grokster, Ltd., et al. 125 S. Ct. 2764 (2005), March 3, 2006

Mr. Smith is the author of numerous articles on trademark, patent and copyright law, Internet law and domain name issues, anti-counterfeiting remedies and gray market subjects, including

- Split Decision for eBay Refines Internet Trademark Infringement Standards: Perfumebay.com, Inc. v. eBay, Inc. _ Fed 3D _ (9th Cir. Nov. 5, 2007), New Matter, Volume 32, No. 4, p. 18.
- The Supreme Court Opens the Door to More Patent Challenges: MedImmune, Inc. v. Genentech, Inc., 127 S. Ct. 764, 166 L. Ed.2d 604 (2007), New Matter, Volume 32, No. 1, p. 22, co-authored with Darren M. Franklin.
- What Needs to be Shown to Establish *Laches* in a Trademark Case: Reno Air Racing Association, Inc. v. Jerry McCord, 452 F.3d 1126 (9th Cir. 2006), New Matter, Volume 32, No. 1, p. 36.
- A Rare Summary Judgment on Laches in a Trademark Case: Tillamook County Smoker, Inc. v. Tillamook County Creamery Association, 452 Fed.3d 1126 (9th Cir. 2006), New Matter, Volume 32, No. 1, p. 37.
- Obtaining Early and Effective Relief Against Trademark Counterfeiting, 10 COMM/ENT, HASTINGS COLLEGE OF THE LAW, No. 4, p. 1049, Summer 1988;
- The Collateral Estoppel Effect of a Prior Judgment of Patent Invalidity: Blonder-Tongue Revisited, 55 JOURNAL OF THE PATENT OFFICE SOCIETY 285, 363, 436, 1973;
- Fraud Upon the Patent Office as a Violation of the Sherman Antitrust Law, 53 JOURNAL OF THE PATENT OFFICE SOCIETY 337, 423;
- Intellectual Property Counseling and Litigation, Chapter 71, DISCOVERY IN TRADEMARK CASES IN THE COURTS AND TRADEMARK TRIAL AND APPEAL BOARD;
- Trademarks, Creation Protection and Valuation, Chapter 10, THE TRADEMARK LAW OF THE UNITED STATES;
- Ninth Circuit Report.
- Also published in (Quarterly Column) NEW MATTER, PUBLICATION OF THE STATE BAR OF CALIFORNIA INTELLECTUAL PROPERTY SECTION, and NINTH CIRCUIT COLUMN IN ABA NEWSLETTERS IP COMMITTEE OF LIT. SECT. NEWSLETTERS.

Intellectual Property Law Blog Articles

- "Effective Immediately, Trademark Owners Need To Protect Their Trademarks From Registration As Usernames On Facebook", June 11, 2009
- "Ninth Circuit Report: Raymond Edwards II v. Arthur Andersen LLP", May 13, 2009

- "Not So Fast on Granting Summary Judgment for Defendant in Trademark/Copyright Case", December 14, 2007

SPEECHES

- "International Issues in Intellectual Property Enforcement: Enforcement of Patents, Trademarks and copyrights Abroad, State Bar of California's 2008 Section Education Institute series of Continuing Legal Education Program, San Diego, January 2008
- Mr. Smith is a frequent speaker on intellectual property law to both bar associations and technology meetings, including the San Francisco Patent, Trademark and Copyright Law Association, the San Francisco Barristers Club, the Engineering and Product Liability Section of the San Francisco Bar, the California, Colorado, Washington, Ohio, D.C., Oregon and Utah State Bar and Silicon Valley PTC Law Associations; Intellectual Property Associations in Los Angeles, San Diego; the American Patent Institute Patent Bar Review Course; Practising Law Institute (PLI), American Bar Association IP, Business, Science & Technology, and Litigation Sections, American Intellectual Property Law Association, International Trademark Association, Computer Law Association, Stanford Law School, Hastings Law School, Santa Clara Law School; Mr. Smith testified on the Report of the United States Working Group on Intellectual Property Rights of the National Information Infrastructure Task Force, and the World Intellectual Property Organization on Internet subjects; was the U.S. Reporter for ALAI on the subject of technical devices for the protection of copyrights in digital works; speaker on Digital Technology and The Internet Conferences, American Conference Institute, Internet World; panelist for internet domain name disputes for the World Intellectual Property Organization.

EVENTS

- Trying A Copyright Fair Use Case