

Daily Journal

APRIL 22, 2015

The Leading Intellectual Property Attorneys in California 2015

The most compelling aspect of choosing the list of leading intellectual property attorneys in California is recognizing the diversity of their achievements, and their ability to stay on the cutting edge of new developments in patent, copyright and trademark law.

While based in the state, leading litigators travel the nation to try cases, whether it's in the Eastern District of Texas, the U.S. International Trade Commission, or a new U.S. Patent and Trademark Office proceeding to determine whether a patent is valid. A few litigators successfully argued or defended cases before the U.S. Supreme Court. Copyright attorneys were in the midst of battles between technology and content providers. Trademark lawyers fought to protect their clients.

The patent prosecutors and portfolio managers on the list represent medical device makers and technology companies, drafting and defending new patents, protecting trademarks and copyrights, while often handling IP aspects of major acquisitions.

The lawyers chosen for this year's list helped to advance technological innovation or transform the law while representing a range of clients that includes Hollywood studios, technology giants, aggressive startups, and the daughter of a screenwriter. The list demonstrates the impressive and diverse work done by California attorneys whose work advances the state's leadership in intellectual property law.

—The Editors

TOP LITIGATORS OF INTELLECTUAL PROPERTY

Carlo F. Van den Bosch

FIRM:

Sheppard, Mullin, Richter & Hampton LLP

CITY

Costa Mesa

SPECIALTY

Trademark



Van den Bosch recently took a trademark case as high as it could go: the U.S. Supreme Court. And in January, he won.

It involved two companies that each

had the same word in their title: Hana Financial Inc. and Hana Bank.

The former accused his client, Hana Bank — one of Korea's biggest financial institutions — of improperly using its mark in the U.S. *Hana Financial Inc. v. Hana Bank*, 07-CV1534 (C.D. Cal., filed March 15, 2007).

This became a rare question before the U.S. Supreme Court about “tacking,” which deals with whether one company can make changes in its mark but still have the priority date of the earlier mark.

By the time the case reached the Supreme Court, Van den Bosch said there was “very little” that could be done to deny his client victory.

“We had to spend eight years in litigation. [On the federal level,] we won on summary judgment and we won at the trial,” he said. “Then we won at 9th

Circuit and won at the Supreme Court.”

Among its victories, Hana Bank prevailed in the Central District because Van den Bosch and his team showed it had been advertising in the U.S. since 1994. They also won on a theory of “unclean hands,” he said.

“Hana Financial effectively built its brand based upon my client’s,” he said.

By the time it reached the U.S. Supreme Court, the question had become whether the decision maker in such cases should be a judge or jury. But, by that time, Hana Bank had won before a judge and in a jury trial.

“I think it was very helpful I was the bank’s counsel throughout the case,” Van Den Bosch noted. “Our client continuously stuck with our team, giving us thorough, in-depth knowledge of all of the facts.”

— Saul Sugarman