



→ Eric K. Gill

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Eric Gill is an associate in the Intellectual Property Practice Group in the firm's San Diego (Del Mar) office.

Areas of Practice

Eric's IP practice draws heavily on his industry experience and education in electrical engineering and encompasses patent litigation and post-grant proceedings as well as strategic IP portfolio development and counseling.

Eric's patent litigation and post-grant practice focuses on Standard Essential Patents (SEPs) and related Fair, Reasonable and Non-Discriminatory (FRAND) licensing issues in the wireless and cellular technology spaces. In this connection he litigates patents across a broad spectrum of technologies in the 2G GSM/GPRS/EDGE, 3G UMTS/WCDMA/HSPA and 4G LTE/LTE-A cellular standards, including speech coding, random access, adaptive modulation and coding, resource allocation, ACK/NACK, hybrid automatic repeat request and error correction coding, power control and power status reporting, channel estimation, discontinuous transmission, multiple antenna transmission (MIMO), carrier aggregation, multimedia broadcast multicast service, frequency and time division duplexing, orthogonal frequency-division multiplexing and code division multiple access. Additionally, Eric litigates patents directed to a range of other technologies, including social media, GPS and location services, control programs for wireless devices, power management and power control circuitry, image sensors and graphics processors, audio/video codecs, receiver architecture and circuitry, spinal surgery tools and online mortgage exchanges. He also handles soft IP and other IP related litigation.

Eric is a registered patent attorney and represents clients before the United States Patent and Trademark Office, drafting and prosecuting patent applications relating to such technologies as wireless communications, analog and RF circuits and systems, Bluetooth, semiconductors, micro-electromechanical systems, augmented and virtual reality, machine learning and mechanical and medical devices.

Before joining the firm, Eric landscaped patent portfolios in the telecom radio frequency/analog space while working in the IP strategy group of one of the world's leading semiconductor and wireless technology companies. Before entering the legal sector, Eric worked in industry as a microwave and radio frequency design engineer at Northrop Grumman, where he designed microwave integrated circuits and radio frequency systems for aircraft and satellite communications and for counter-improvised-explosive-device-warfare technologies. He also worked as a radio frequency chip designer at NextWave Wireless, a San Diego semiconductor company that developed chip sets and wireless technology for WiMAX and 4G LTE.

Honors

Ones to Watch – Intellectual Property Law, *Best Lawyers*, 2021, 2022

Experience

Representative Patent Litigation Matters:

- *Continental Automotive Systems, Inc. v. Nokia Corp. et al.*, No. 2021-0066-JRS (Del. Ch.). Represents Continental in a lawsuit seeking declaratory relief for determination and imposition of FRAND licensing terms for Nokia's 2G, 3G, and 4G SEPs.
- *10Tales, Inc. v. TikTok Inc. et al.*, No. 3:21-cv-03868 (ND Cal). Represents TikTok and ByteDance in a lawsuit involving a patent asserted to cover the backend system and recommendation engine for the TikTok mobile app. We got the case transferred from the Western District of Texas before Judge Albright to the Northern District of California.
- *Continental Automotive Systems, Inc. v. Avanci, LLC et al.*, No. 3:19-cv-2933 (ND Tex). Represents Continental in a lawsuit seeking declaratory relief for determination and imposition of FRAND licensing terms for the 2G, 3G, and 4G SEPs managed by the Avanci patent licensing platform.
- *Certain LTE- and 3G-Compliant Cellular Communications Devices*, Inv. No. 337-TA-1138 (USITC). Represents HTC in an investigation involving five alleged SEPs asserted to cover the 3G UMTS and 4G LTE/LTE-A standards. The Commission affirmed Judge McNamara's determination of no violation based on non-infringement.
- *INVT SPE LLC v. HTC Corp. et al.*, No. 2:17-cv-3740 (DNJ). Represents HTC in an eight-patent infringement action relating to alleged SEPs asserted to cover the 2G EGPRS, 3G UMTS/WCDMA/HSPA and 4G LTE/LTE-A standards. HTC has counter claimed for breach of FRAND and filed numerous IPRs against the asserted patents.
- *TCL Commc'n Tech. Holdings, Ltd. et al. v. Telefonaktiebolaget LM Ericsson et al.*, No. 8:14-cv-341 (CD Cal). Represents TCL in a breach-of-contract and declaratory judgment action relating to ETSI's IPR Policy and Ericsson's obligation to license its 2G GSM/GPRS/EDGE, 3G UMTS and 4G LTE/LTE-A SEPs under FRAND terms.
- *Sun Patent Trust v. HTC Corp.*, No. 2:20-cv-286 (ED Tex). Represented HTC in a six-patent lawsuit involving alleged Standard Essential Patents (SEPs) asserted to cover the LTE and LTE-Advanced cellular standards.
- *Evolved Wireless, LLC v. HTC Corp. et al.*, No. 1:15-cv-543 (D Del). Represented HTC in a five-patent infringement lawsuit relating to alleged SEPs asserted to cover the 4G LTE standard. HTC counter claimed for breach of contract, alleging that Evolved Wireless failed to license its patents on FRAND terms, and filed IPRs against all the asserted patents. Evolved dropped three of the patents and the PTAB invalidated a fourth. As for the remaining patent, the court granted HTC's motion for summary judgment based on its license and patent exhaustion defense stemming from an agreement between HTC's chip supplier Qualcomm and the original patent owner LG Electronics. The Federal Circuit affirmed in part and the case was dismissed.
- *Pixmarx IP LLC v. Snap Inc.*, No. 3:20-cv-1157 (ND Tex). Represented Snap in a lawsuit involving four patents related to embedding an overlay in a digital photograph and asserted to cover the Snapchat mobile app. The matter settled quickly after we filed six IPR petitions challenging the asserted patents.
- *u-blox AG et al. v. Sisvel Int'l S.A. et al.*, No. 3:20-cv-494 (SD Cal). Represented u-blox in a breach of FRAND and antitrust action relating to Sisvel's portfolio of 2G, 3G, and 4G alleged SEPs.

- *u-blox AG et al. v. InterDigital, Inc. et al.*, No. 3:19-cv-1 (SD Cal). Represented u-blox in a breach of contract and antitrust lawsuit arising from InterDigital's obligation to license its SEPs on FRAND terms. Defended u-blox against InterDigital's counterclaims of infringement of two patents directed to resource allocation and carrier aggregation.
- *Prestige Flag Mfg. Co., Inc. v. Golf Solutions I, LLC*, No. 3:18-cv-98 (WD Wis). Represented Prestige in a case for design patent infringement and federal and common law unfair competition.
- *McCree's Multi Services, LLC v. Poway Weapons & Gear, Inc. et al.*, No. 3:17-cv-1749 (SD Cal). Represented Poway Weapons & Gear as local counsel in a two-patent case involving firearm technology.
- *Hitachi Maxell, Ltd. v. ZTE Corp. et al.*, No. 5:16-cv-179 (ED Tex). Represented ZTE in an eight-patent infringement lawsuit relating to patents alleged to cover aspects of cellular phone technology such as power management circuitry, image sensors and graphics processors, transmit power control circuitry and multi-format, multiplexed audio/video decoding receiver circuitry.
- *Ericsson Inc. et al. v. TCL Commc'n Tech. Holdings, Ltd. et al.*, No. 2:15-cv-11 (ED Tex). Represented TCL in a five-patent infringement action relating to patents Ericsson alleged cover aspects of cellular phone hardware and the Android OS, including multimode direct conversion receiver circuitry, A-GPS and control programs for wireless communications. TCL counter sued on two patents relating to LTE cellular network infrastructure and base stations. TCL obtained a stay of the trial after it filed 17 IPRs against Ericsson's asserted patents and the PTAB instituted all 17. The PTAB invalidated four of the five patents and the Federal Circuit invalidated the fifth patent.
- *Ericsson Inc. et al. v. TCL Commc'n Tech. Holdings, Ltd. et al.*, No. 2:14-cv-667 (ED Tex). Represented TCL in a two-patent infringement action relating to speech coding and modulation patents Ericsson alleged cover the 2G, 3G and 4G standards. TCL counter sued on two patents related to LTE cellular networks and communications. TCL got the case transferred to CD Cal, consolidated with the FRAND case and stayed pending the outcome of that case.
- *Prestige Flag Mfg. Co., Inc. v. Par Aide Products Co.*, No. 14-cv-2711 (SD Cal). Represented Prestige in an action for design patent and trade dress infringement, and state and federal unfair competition.
- *Prestige Flag Mfg. Co., Inc. v. Standard Golf Co. et al.*, No. 14-cv-1574 (SD Cal). Represented Prestige in an action for design patent infringement.
- *Abdou v. Alphatec Spine, Inc.*, No. 3:12-cv-1804 (SD Cal). Represented Alphatec Spine in a patent infringement action.
- *LendingTree, LLC v. Zillow, Inc. et al.*, No. 3:10-cv-439 (WD NC). Represented LendingTree in a six-week jury trial over antitrust and patent infringement claims.
- Represented numerous clients in connection with third party subpoenas served in patent cases involving such technologies as semiconductors, telecommunications, video game hardware, gene sequence enrichment, spinal surgery tools and wearables.

Representative *Inter Partes* Review Matters:

- *TikTok Inc. v. 10Tales Inc.*, IPR2021-00476. Represents Petitioner TikTok in a challenge to a patent relating to creating user specific digital media content.
- *Apple Inc. et al. v. INVT SPE LLC*, IPR2019-01574. Represented Petitioner HTC in a challenge to INVT's alleged SEP relating to a hybrid automatic repeat request system. INVT disclaimed the challenged claims.

- *HTC Corp. et al. v. INVT SPE LLC*, IPR2018-01555, IPR2018-01581. Represents Petitioner HTC in its challenge to INVT's alleged SEP relating to adaptive modulation and coding. Trial instituted.
- *Apple Inc. et al. v. INVT SPE LLC*, IPR2018-01476. Represented Petitioner HTC in a challenge to INVT's alleged SEP relating to multiple antenna transmission. The PTAB invalidated the challenged claims and the Federal Circuit affirmed.
- *Snap Inc. v. Pixmarx IP LLC*, IPR2021-00140, IPR2021-00141, IPR2021-00142, IPR2021-00143, IPR2021-00232, IPR2021-00233. Represented Petitioner Snap in six IPRs filed against Pixmarx's patents relating to embedding an overlay in a digital photograph and asserted to cover the Snapchat mobile app. Settled before the patent owner preliminary responses were filed.
- *Apple Inc. et al. v. INVT SPE LLC*, IPR2018-01475. Represented Petitioner HTC in a challenge to INVT's alleged SEP relating to modulation. The PTAB invalidated the challenged claims.
- *Apple Inc. et al. v. INVT SPE LLC*, IPR2018-01473. Represented Petitioner HTC in a challenge to INVT's alleged SEP relating to transmission power and rate control. Trial instituted.
- *Apple Inc. et al. v. INVT SPE LLC*, IPR2018-01472. Represented Petitioner HTC in a challenge to INVT's alleged SEP relating to discontinuous transmission. The PTAB invalidated the challenged claims.
- *Prime Focus Creative Servs. Can. Inc. v. Legend3D, Inc.*, IPR2016-01243. Represented patent owner Legend3D in opposing a challenge to a Legend3D patent related to image processing. The PTAB found Prime failed to demonstrate that several claims are unpatentable.
- *TCL Corp. et al. v. Telefonaktiebolaget LM Ericsson*, Nos. IPR2015-1584, IPR2015-1600. Represented petitioner TCL in its challenge to an Ericsson patent directed to multimode direct conversion receiver circuitry. The PTAB invalidated all the challenged claims and denied Ericsson's request for rehearing. The Federal Circuit affirmed.
- *TCL Corp. et al. v. Ericsson Inc.*, No. IPR2015-1583. Represented TCL in its challenge to an Ericsson patent directed to control programs for wireless communication devices. The PTAB invalidated all challenged claims.
- *TCL Corp. et al. v. Telefonaktiebolaget LM Ericsson*, Nos. IPR2015-1650, IPR2015-1772, IPR2015-1878. Represented TCL in its challenge to an Ericsson patent directed to using QoS parameters in A-GPS for mobile terminals. The PTAB invalidated all challenged claims.
- Represented petitioners and patent owners in IPR proceedings regarding patents related to chemical compounds for pharmaceutical and industrial/commercial applications.

Representative IP and Other Litigation Matters:

- *Citizens Equity First Credit Union v. San Diego County Credit Union*, No. 92066165 (TTAB). Represents SDCCU in a trademark cancellation proceeding brought by CEFCU.
- *Prestige Flag Mfg. Co., Inc. v. Golf Solutions I, LLC et al.*, No. 3:14-cv-2945 (SD Cal). Represented Prestige in an action for breach of contract.
- *Golf Solutions I, LLC v. Prestige Flag Mfg. Co., Inc. et al.*, No. 14-cv-869 (WD Wis). Represented Prestige in an action for breach of contract.
- *Konstantino v. AngioScore, Inc.*, No. 9681-CB (Del Ch). Represented AngioScore in an action for advancement of legal fees related to AngioScore's claims for patent infringement, breach of fiduciary duty and unfair competition.

- *RamSoft, Inc. v. Imaging Advantage, LLC et al.*, No. 14-cv-335 (CD Cal). Represented RamSoft in an action for breach of contract, copyright infringement, copyright management information removal/alteration, trade secret misappropriation and intentional interference with contract.
- *Cobra Systems, Inc. v. Accuform Manufacturing, Inc.*, No. 13-cv-5932 (CD Cal). Represented Cobra in an action for copyright infringement, copyright management information removal/alteration, trademark infringement, state and federal unfair competition and breach of contract.

Patent Drafting and Prosecution Matters:

- Representative clients include Dexcom, Disney, JayBird, MasterCard, Toyota and Western Digital.

Representative IP Counseling Matters:

- Provides strategic counseling to major handset manufacturers and automotive suppliers regarding cellular SEPs and FRAND issues in connection with licensing negotiations and pre-litigation.
- Provided strategic counseling to automotive supplier regarding IP issues relating to the AUTOSAR automotive standard setting organization.
- Provided strategic counseling regarding the scope and validity of patents related to thin-film transistor and pixel display circuit technologies for LED TVs.

Articles

- Inter partes review a decade into the America Invents Act
Daily Journal, 09.28.2021
- "Establishing the Weight of Evidence After *Sciele*," *Law360*, August 13, 2012

Intellectual Property Law Blog Post

- "Breach of FRAND Implications on ITC Exclusion Orders In View of the Public's Interest," May 7, 2020
- "AIPLA's Updated Model Patent Jury Instructions Address "Clear and Convincing" Standard of Proof & Streamline Case Citations," April 7, 2020
- "Conan Doyle Estate's Quixotic Attempt to Protect Sherlock Holmes," July 15, 2014

Events

Protecting Intellectual Property
Third Thursday Emerging Company Webinar
via WebEx, 03.15.2018

Memberships

Co-Chair of the Model Patent Jury Instructions Subcommittee, American Intellectual Property Law Association (AIPLA)

Barrister, J. Clifford Wallace American Inn of Court

Practices

Intellectual Property

Copyrights

IP Licensing, Technology and Commercial Transactions

Patent Litigation

Patent Prosecution and Counseling

Post-Grant Proceedings

Trademarks and Trade Dress

Industries

Aerospace & Defense

Telecom

Transportation

Education

J.D., Brigham Young University, J. Reuben Clark Law School, 2013, *cum laude*; Senior Editor, *Brigham Young University Law Review*

B.S., Electrical Engineering, University of California, Santa Barbara, 2007

Admissions

California

U.S. Patent and Trademark Office