



## → James V. Fazio

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James Fazio is special counsel in the Intellectual Property Practice Group in the firm's San Diego (Del Mar) office.

### Areas of Practice

James focuses on intellectual property, data privacy and security, and business litigation. He represents public and private companies as well as start-ups in a wide variety of disputes, including those involving cybersecurity threats and incidents, data breaches, patent and trademark infringement, theft of trade secrets, fraud, breach of contract, unfair competition, false advertising and various business tort claims. James has been practicing law since 1995 and was selected by his peers among the top ten intellectual property litigators in San Diego in 2010, 2011 and 2014 by *The San Diego Daily Transcript*.

James represents clients in a wide variety of technologies and industries, including food services and restaurants, telecommunications, computer hardware and software, database management, semiconductors and chip design, medical devices, biometrics, business methods, e-commerce and wireless technologies, among others. He also has experience defending major companies against large class action lawsuits, including those involving data breaches, securities fraud and false advertising, stockholder derivative suits and investigations by the U.S. Securities and Exchange Commission.

James is a former Assistant U.S. Attorney for the Southern District of California. While serving as a federal prosecutor, he tried nearly a dozen federal jury cases to verdict and argued numerous appeals before the Ninth Circuit Court of Appeals.

James regularly lectures and writes extensively on various legal topics. He previously authored and co-authored more than a dozen legal articles in various publications, including *IP Today*, *The Recorder*, *The FBA Newsletter*, *The Federal Lawyer*, *California Lawyer*, *The San Diego Daily Transcript*, and *The National Law Journal*.

### Honors

Recognized as one of the Top 10 Intellectual Property Litigators in San Diego by *The Daily Transcript*, 2010, 2011 and 2014

## Experience

### Representative Matters

- Settled a complex case involving claims for quantum meruit and conversion and cross-claims for misappropriation of trade secrets and related claims, as well as a parallel federal action for correction of inventorship, on behalf of a San Diego technology start-up company, resulting in a highly-favorable settlement and transfer of all intellectual property at issue to our clients.
- Recovered millions of dollars for a public wireless company in multiple complex breach of contract matters, obtaining monetary recoveries nearly 20 times the attorney fees expended
- Successfully represented a document camera company in the enforcement of multiple patents against several competitors in an ITC investigation and parallel district court cases, obtaining a consent order against one respondent, a default against a second respondent and a lucrative settlement with running royalties against a third respondent
- Obtained a seven-figure settlement for an entertainment company client in a complex case involving computer hacking and related claims on the eve of trial
- Obtained numerous lucrative settlements for a public company client in several multi-patent infringement actions involving multi-modal biometric technology
- Obtained a lucrative settlement for an e-commerce and risk management client in a complex case involving theft of computer code and unfair competition after taking over the case from prior counsel
- Won monetary sanctions against opposing counsel in a four-patent infringement case involving copy prevention technology, prompting an immediate and highly favorable settlement for our client
- Successfully negotiated the dismissal of a breach-of-contract case for a global internet security company client shortly after filing a motion for sanctions against the plaintiff
- Successfully defended an international shoe and apparel company in a trademark infringement action and reached a settlement that did not require payment of any monies to the plaintiff
- Successfully defended an international solar tubing business in a bet-the-company lawsuit, obtaining a dismissal of the case less than four months after filing
- Won a motion to sever and transfer a patent case for a global travel, real estate and hospitality company, resulting in a prompt and highly favorable settlement
- Successfully defended several public computer companies in securities fraud class action lawsuits and parallel investigations by the Securities and Exchange Commission (SEC), obtaining dismissals of the district court cases and no-action letters from the SEC

## Articles

- Eye on Privacy 2021 Year in Review  
01.11.2022
- The Status of a Cannabusiness' Ability to Seek Relief in the Courts – the 'Illegality' Issue  
*Cannabis Business Executive*, 06.10.2020
- "Leon Stambler Stumbles But Has Not Given Up: An Overview of Leon Stambler's Patent Enforcement Battles,  
" *IP Today*, January 2009

- "Beware Foreign Defendants: You May Be Liable for Patent Infringement Even Without Conducting Any Business in the United States," *IP New Matter*, Vol. 32, No. 4, 2007
- "Choosing Your Turf: An Overview of Venue in Patent Cases," *IP Today*, October 2006
- "Be Careful Patent Holders: The Presumption of Market Power in Patent-Tying Cases," *IP Newsletter*, 2005
- "Changing the Game," *The Recorder*, June 8, 2005
- "The PROTECT Act: A Brief Overview of its Effect on the Federal Sentencing Guidelines," *FBA Newsletter*, Spring 2004
- "When Mandatory Arbitration Isn't Mandatory," *California Lawyer*, November 2003
- "The Motive and Opportunity Test for Pleading Scierter Under the Federal Securities Laws: Where Is It Now?" *The Federal Lawyer*, May 2003
- "Safe Harbor for Securities Fraud Defendants," *California Lawyer*, October 2000
- "In re Silicon Graphics Makes It Tough for Securities Class Action Plaintiffs," *California Lawyer*, December 1999
- "Raising the Bar," *The San Diego Daily Transcript*, August 3, 1999
- "Whistleblowers Given More Time," *The National Law Journal*, November 4, 1996

## Eye on Privacy Blog Posts

- "What's the Big Deal About Dark Patterns?," May 25, 2022
- "Booking.com Fined By Dutch DPA For Breach Notice Delay," April 29, 2021
- "What Is FTC's Course Under Biden?," March 25, 2021
- "Insurance Cybersecurity Certifications: A State Roundup," February 18, 2021
- "Successful Dismissal of PayPal Class Action Over Breach Disclosures Serves as Risks Reminder," February 2, 2021
- "New York and Others Settle with CafePress Over 2019 Data Breach," January 12, 2021
- "Travel Giant Sabre Reaches Deal with State Attorneys General Over Data Breach," January 4, 2021

## Game Counsel: Esports and Games Law Blog

- "Top Esports Deals and Investments in 2020 and 2021," May 28, 2021
- "Esports: What We Should Expect in 2021," January 15, 2021

## Intellectual Property Law Blog

- "The PTAB's Ground-Breaking Decision in *Apple v. Fintiv* Promises to Make IPR Institutions More Challenging," June 9, 2020

## Trade Secrets Law Blog

- "Ninth Circuit Denies Sherman Act Challenge To No-Poach Provision," September 15, 2021
- "Is Lawful Possession of a Trade Secret Enough for Standing to Sue for Misappropriation?" June 29, 2021
- "California Labor Code Section 925 and How Employers Can Avoid It," March 29, 2021
- "Diminution in Value As A Measure of Damages for Trade Secret Misappropriation," March 16, 2021

## Lex Arbitri: International Arbitration Law Blog

- "Insisting on Live, In-person Arbitration Hearings During The Pandemic," March 8, 2021

## Books

Trade Secret Litigation and Protection: A Practice Guide to the DTSA and the CUTSA  
04.2022

## Speaking Engagements

"Becoming an IP Lawyer," Whittier Law School, March 2006

## Practices

Intellectual Property

False Advertising, Lanham Act and Unfair Competition

Patent Litigation

Trade Secrets

Trademarks and Trade Dress

Litigation

Privacy and Cybersecurity

## Industries

Esports & Games

Healthcare

## Education

J.D., Syracuse University, 1995, *cum laude*, editor, *Syracuse Law Review*

M.A.S., University of California, San Diego, 2010

B.A., Colgate University, 1991

## Clerkships

Extern, Chief Bankruptcy Judge Stephen D. Gerling of the U.S. Bankruptcy Court for the Northern District of New York, 1994

## Admissions

California

U.S. District Court for the Southern District of California

U.S. District Court for the Northern District of California

U.S. District Court for the Eastern District of California

U.S. District Court for the Central District of California

U.S. Court of Appeals for the Ninth Circuit

U.S. Court of Appeals for the Federal Circuit