

CONLEY ROSE

INTELLECTUAL PROPERTY LAW

Representative Intellectual Property Civil Cases and USPTO PTAB / TTAB Proceedings Decided/Published 1995- 2022

PlasmaCAM, Inc. v. CNC Electronics, LLC, 24 F. 4th 1378, 1380. Fed. Cir. 2022. Obtained reversal of district court in favor of our client in patent infringement case involving plasma cutting controller technology.

Luckenbach Texas, Inc. v. Stewart Skloss et al., No. 1:21-cv-00871. W.D. Tex. 2022. Obtained ruling denying preliminary injunction in favor of our client in trademark infringement case involving craft whiskey.

ASHH Inc. v. Various Defendants, Nos. 3:21-cv-02779, 02820, 02831, 02832, 02833, 02835, 02836, N. D. Tex. 2022. Obtained judgment in favor of our client in several cases involving trademark counterfeiting of consumer products in vaping industry.

GustoMSC Resources B.V., Adrian Richie, FA2107001954382, ADR Forum 2021. Represented Dutch marine construction company in protecting its domain name in UDRP proceeding against email impersonator.

Local Yocal LLC v. Mastronardi Produce Ltd., No. 92078023, TTAB 2021. Represented trademark applicant in successfully cancelling registered mark in field of produce groceries.

EOG Resources, Inc. v. Angela Enya, FA2112001977235, ADR Forum 2021. Represented plaintiff in defending Internet domain name in typo squatting UDRP proceedings.

NovaLash, Inc. v. Sugar Lash Inc., No. 91251448, TTAB 2021. Represented manufacturer of artificial eyelashes in successful opposition of application to register competing trademark.

Social Positioning Input Systems, LLC v. Coretex, LLC, No. 3:20-cv-1083-H-JLB, N.D. Cal. 2020. Represented accused infringer in successfully convincing non-practicing entity (NPE) patent owner to dismiss lawsuit early on due to non-infringement.

GEO-Tag, LLC. v. Guala Closures SPA et al., No. 1:19-cv-00395, S.D. Ohio 2020. Represented Italian closure manufacturer in favorable resolution of patent infringement case involving smart bottle caps and closures with RFID devices.

TXS Industrial Design, Inc. v. National Hospitality Supply Corp., No. 3:20-cv-00427, N. D. Tex. 2020. Obtained an injunction in favor of our client in trade dress infringement case involving alarm clocks.

TXS Industrial Design, Inc. v. Various Defendants, Amazon IPR Take-Down 2020. Defended our client with registered trade dress in Amazon IPR take-down actions against knock-off alarm clocks.

Coreology, Inc. v. Lagree Techs., Inc., Trademark Oppositions, TTAB 2019. Represented our client in opposing trademark registration of common exercise names before TTAB in field of Pilates exercises.

RFC Capital Holdings, Inc. v. Gordon*Howard Associates, Inc. d/b/a PassTime USA, No. 1:18-cv-02972, D. Colo. 2018. Obtained favorable resolution for our client, the defendant after filing Motion for Summary Judgment that the four asserted patents were unenforceable due to the plaintiff's inequitable conduct in improperly filing Petitions to Revive expired patents.

KRYPTTEK Outdoor Group, LLC. v. Salt Armor, Inc., No. 1:15-cv-00348, E.D. Tex. 2017. Represented a designer of camouflage patterns for outdoor clothing in copyright infringement case involving infringing imports.

Lunareye, Inc. v. Gordon*Howard Associates, Inc., CAFC Appeal Nos. 16-1413, -1837. Affirmed cancellation of asserted patent claims for Appellee Gordon*Howard in Federal Circuit appeals of two Petitions for Inter Partes Review challenging claims in patent asserted against Gordon*Howard in parallel district court litigation in the Eastern District of Texas.

- IPR2014-00712, Paper 43, Final Written Decision, PTAB Sep. 28, 2015. Finding unpatentable all challenged patent claims asserted in parallel district court litigation, U.S. Patent No. 6,484,035 – Apparatus and method for triggerable location reporting. Affirmed on appeal at the Federal Circuit Court of Appeals.
- IPR2014-01213, Paper 37, Final Written Decision, PTAB Feb. 02, 2016. Finding unpatentable all challenged patent claims asserted in parallel district court litigation, U.S. Patent No. 6,484,035 – Apparatus and method for triggerable location reporting. Affirmed on appeal at the Federal Circuit Court of Appeals.

Zimmer Biomet Holdings, Inc. v. Four Mile Bay, LLC, IPR2016-00012, Paper No. 34, Final Written Decision, PTAB Mar. 10, 2017. Represented patent owner in defense of Petition for Inter Partes Review of patent claims covering hip implant technology.

Ericsson, Inc. v. Intellectual Ventures. Represented petitioner in filing six Petitions for Inter Partes Review challenging claims in four patents being asserted against its customers in parallel district court litigation).

- IPR2014-00921 (Paper 43) & -01149 (Paper 68), Final Written Decision PTAB Dec. 9, 2015. Finding unpatentable all patent claims asserted in parallel district court litigation, U.S. Patent No. 6,023,783 – turbo code data encoder/decoder for error detection/correction in wireless communication.
- IPR2014-01330, Paper 29, Final Written Decision, PTAB Feb. 19, 2016. Finding unpatentable all patent claims asserted in parallel district court litigation, U.S. Patent No. 8,310,993 – wireless network transmission of TCP data including allocation of network resources.

Motorola Solutions, Inc. v. Mobile Scanning Techs., LLC, IPR2013-00093, Paper No. 61, Final Written Decision, PTAB April 24, 2014. Represented patent owner in defense of Petition for Inter Partes Review of patent claims covering bar code scanner feature of the Palm III PDA's infrared port.

UltimatePointer, L.L.C. v. Nintendo Co., 816 F.3d 816, Fed. Cir. Mar. 1, 2016. Obtained judgement affirming noninfringement and reversed a judgment of invalidity for indefiniteness for a patent covering handheld pointing device used to control the cursor on a projected computer screen.

Van Steenburg v. Hageman, No. SA:14-976, 2015 U.S. Dist. LEXIS 41318, 2015 WL 1509940, W.D. Tex. Mar. 31, 2015. Obtained order denying plaintiff's motion to remand, confirming federal question jurisdiction for removal of case from state court based on copyright infringement counterclaim, in favor of our client, the defendant.

eDekka LLC v. 3balls.com, Inc., No. 2:15-541, 2015 U.S. Dist. LEXIS 125990, 2015 WL 5579840, E.D. Tex. Sep. 21, 2015. Obtained order granting summary judgment of invalidity for software patent under Section 101 as directed to unpatentable subject matter, in favor of our client the defendant.

eDekka LLC v. 3balls.com, Inc., No. 2:15-541, 2015 U.S. Dist. LEXIS 168610, E.D. Tex. Dec. 17, 2015. Obtained order finding patent infringement case "exceptional" under 35 U.S.C. § 285, in favor of our client, the defendant, which led to award of attorney's fees assessed against the non-practicing entity plaintiff.

PrinterOn Inc. v. BreezyPrint Corp., 93 F. Supp. 3d 658, S.D. Tex. 2015. Obtained order granting summary judgment of no infringement in favor of our client (defendant) in patent infringement case over computer technology for printing on remote devices.

In re Nintendo Co., Ltd., Misc. Docket No. 15-1544, Fed. Appx. 934, 2013 U.S. App. LEXIS 19606, 2013 WL 5345899, Fed. Cir. 2013. Granted petition for writ of mandamus regarding severance and transfer issues in multi-defendant patent infringement case.

Pennell dba “Triton Digital Plus” v. Triton Media, LLC, No. A-12-706, 2013 U.S. Dist. LEXIS 195702, W.D. Tex. Jan. 10, 2013. Obtained order granting in part, and denying in part, motion to dismiss trademark infringement and misappropriation claims, in favor of our client the defendant.

Baker Hughes, Inc. v. Homa, No. H-11-3757, 2011 U.S. Dist. LEXIS 148118, S.D. Tex. Dec. 23, 2011. Obtained order granting in part, and denying in part, preliminary injunction in trade secrets case over fiber-optic sensors and cable for use in downhole oil and gas applications. This action was later dismissed against alien defendants for lack of personal jurisdiction – 2013 U.S. Dist. LEXIS 153385, 2013 WL 5775636, S.D. Tex. Oct. 25, 2013.

Duhn Oil Tool, Inc. v. Cameron Int’l Corp., No. 05-1411, E.D. California, Fresno Division, 2012 WL 604138. District court and jury invalidated all asserted patent claims as anticipated and/or obvious in light of prior art, in patent case over wellhead equipment used for fracking gas wells, ruling in favor of our client, the defendant.

- 2012 WL 4210104, E.D. Cal. 2012. Obtained order taxing costs in the amount of \$162,932.34 in favor of our client, the defendant.
- Appellate court opinions include: 367 Fed. Appx. 148, Fed. Cir. 2010. Reversal of district court’s preliminary injunction order, ruling in favor of our client.
- District court opinions include: 474 F.Supp.2d 1148, E.D. Cal. 2007; Markman claim construction ruling, 2007 WL 3335008 (2007); 609 F.Supp.2d 1090, (E.D. Cal. 2009), 2009 WL 910769, 1639576, 3381055, 3381052, 5202463 (2009); 757 F.Supp.2d 1006 (E.D. Cal. 2010), 2010 WL 596312, 716306, 2354411, 3744820 (2010); 818 F.Supp.2d 1193, 842 F.Supp.2d 1242 (E.D. Cal. 2011), 2011 WL 121547, 202188 (2011); 2012 WL 3585405 (2012); and 2013 WL 3936889 (2013).

Vantage Trailers, Inc. v. Beall Corp., 567 F.3d 745, 90 U.S.P.Q.2d 1855, 5th Cir. 2009. Affirmed district court’s dismissal of declaratory judgment action in favor of our client, the defendant, in trademark infringement case over the distinctive “Beall Bullet” aluminum bottom dump trailer design. District court opinions include: 2008 WL 304747, 4093691, 4746288 S.D. Tex. 2008 ; 2009 WL 1562179 (2009).

Safoco, Inc. v. Cameron Int’l Corp., 2009 WL 2424108, S.D. Tex. July 31, 2009. Obtained order granting summary judgment of no willful infringement in favor of our client, the defendant in patent case over actuators used with wellhead equipment.

Cummins-Allison Corp. v. SBM Co., Ltd., 584 F.Supp.2d 916, E.D. Tex. 2008. Obtained order providing for submission of question to jury on future royalty rate, in patent case regarding currency denomination and counterfeit detection technology. District court opinions include: 669 F.Supp.2d 774, E.D. Tex. 2009 - post-verdict damages based on reasonable royalty); 2009 WL 763926, 806753, 4017135, 4017160 (2009).

Emtel, Inc. v. Lipidlabs, Inc., 583 F.Supp.2d 811, S.D. Tex. 2008. Obtained order granting summary judgment of no infringement in favor of our client, the defendants in patent infringement case over telemedicine technology involving medical care providers' use of videoconferencing for diagnosis and treatment of patients.

High Island Health, LLC v. Libertybelle Marketing Ltd., 2007 WL 1173631, S.D. Tex. April 18, 2007. Obtained order granting motion to dismiss for insufficiency of service of process in favor of our client, the defendant. The court confirmed our client's contentions that the plaintiff's alleged service of process on one of defendant's customers in the United Kingdom was insufficient under the Hague Convention on the Service Abroad of Judicial and Extrajudicial Documents (the "Hague Convention").

Case cited by legal treatises including LITIGATION OF INTERNATIONAL DISPUTES IN US COURTS, § 2:4, The Terms of the Hague Service Convention (2011); and WRIGHT & MILLER: FEDERAL PRAC. & PROC. § 1062, Service of Process Other than as Explicitly Prescribed in Rule 4 (2011); WRIGHT & MILLER: FEDERAL PRAC. & PROC. § 1391, Waiver of Certain Defenses-Rule 12(h)(1) (2011).

American Registry of Radiologic Technologists v. Garza, 512 F.Supp.2d 902, S.D. Tex. 2007. Obtained order resolving motion to amend judgment in certification trademark case in which judgment for false designation of origin granted in favor of our client, the plaintiff.

Autobytel, Inc. v. Dealix Corp., 455 F.Supp.2d 569, E.D. Tex. 2006. Obtained order resolving attorney-client privilege and work product doctrine in patent case involving technology for Internet car-buying service.

JJK Industries, L.P. v. KPlus, Inc., 447 F.Supp.2d 713, S.D. Tex. 2006. Obtained ruling declaring "interference-in-fact" and resolving "interference count" in favor of our client the plaintiff in an "interfering patents" case under 35 U.S.C. § 291 due to the U.S. Patent Office improperly issuing two patents covering the same invention. 2004 WL 5499508, 5499509, and 5499510 (2004) - orders denying motions to exclude plaintiff's experts.

Test Masters Educational Services v. Singh, 46 Fed. Appx. 227, 5th Cir. 2002. Obtained order invalidating "TESTMASTERS" trademark registration for test preparation services in favor of declaratory judgment our client, the plaintiff.

Watson & Chalin Mfg., Inc. v. The Boler Co., 229 F.Supp.2d 630, E.D. Tex. 2002. Obtained a Markman claim construction ruling in favor of our client the plaintiff in patent case involving trucking industry suspension systems.

Cudd Pressure Control, Inc. v. Westbury Service Co., 2002 WL 34455512, S.D. Tex., July 10, 2002. Obtained a Markman claim construction ruling, construing patent

claims in favor of declaratory judgment for our client, the plaintiff in patent case involving coil tubing injection head assemblies.

Kothmann & Kothmann, Inc. v. Trinity Industries, Inc., 287 F.Supp.2d 699, S.D. Tex. 2002. Obtained order denying motion for preliminary injunction in patent case involving roadside safety products; 287 F.Supp.2d 673 (2003) Markman ruling construing patent claims; 394 F.Supp.2d 923 (2005) summary judgment rulings on validity and infringement; 455 F.Supp.2d 608 (2006) Bench trial rulings resolving equitable defenses of inequitable conduct and prosecution laches in favor of our client, the plaintiff.

Trinity Industries, Inc. v. Road Systems, Inc., 121 F. Supp.2d 1028, E.D. Tex. 2000. Obtained a Markman Ruling providing detailed interpretation of patent claims in favor of our client, the defendants in a patent case involving roadside safety products. The court later granted a summary judgment of no infringement in favor of the defendants based upon this Markman Ruling. *Trinity Industries, Inc. v. Road Systems, Inc.*, 235 F. Supp.2d 542, E.D. Tex. 2002.

- District court opinions also include: 235 F.Supp.2d 547, E.D. Tex. 2002 - obtained an order denying motion for reconsideration as to aspects of Markman claim construction ruling; 235 F.Supp.2d 536, E.D. Tex. 2002 – obtained order finding no inequitable conduct for patentee’s failure to disclose federal funding for patented technology.

Frank’s Casing Crew & Rental Tools, Inc. v. PMR Technologies, Ltd., 292 F.3d 1363, Fed. Cir. 2002. Obtained affirmation of district court judgment in favor of declaratory judgment for our clients, the plaintiffs in a patent infringement case involving torque-turn monitoring for oilfield tubing premium connections, in which the plaintiffs obtained a judgment that the patent asserted against them was unenforceable due to inequitable conduct committed by the patentee in failing to name the true inventor that should have been named on the patent.

American Imaging Services, Inc. v. Intergraph Corp., No. 99-1485, 250 F.3d 757 (Table), 2000 WL 772725, Fed. Cir. June 12, 2000 (nonprecedential). Obtained an order for our client, the plaintiff vacating the district court’s grant of summary judgment of invalidity as to four specific claims of the asserted patent, and remanding the action for trial in the district court against the defendant on these four patent claims covering software which enables manually generated engineering drawings to be converted to computer-readable form for use in computer-aided design (CAD) systems.

Hazmatpac, Inc. v. U.S. Can Co., No. 99-1479, 230 F.3d 1380 (Table), 2000 WL 178149, Fed. Cir. Jan. 28, 2000 (nonprecedential). Obtained a dismissal of the defendant’s appeal of the district court’s grant of a patent infringement preliminary injunction in favor of the our client the plaintiff in a patent case involving hazardous materials packaging.

Datapoint Corp. v. PictureTel Corp., Nos. 98-1341, 98-1367, 98-1368, 215 F.3d 1344 (Table), 1999 WL 507141, Fed. Cir. Jul. 15, 1999 (nonprecedential). Obtained an order affirming the district court’s judgment in favor of the defendant in a patent infringement case involving videoconferencing technology.

Frassanito v. Datapoint Corp., No. 97-1022, 129 F.3d 133 (Table), 1997 WL 632793, Fed. Cir. Sep. 16, 1997 (nonprecedential). Obtained a reversal of the district court’s grant of summary judgment and remanding for proceedings to correct the inventorship of the patents at issue in favor of our client, the plaintiffs in a patent ownership dispute involving videoconferencing technology.

Minnesota Mining & Mfg. Co. v. International Biophysics Corp., No. 96-1371, 106 F.3d 426 (Table), 1997 WL 12124, Fed. Cir. Jan 15, 1997 (nonprecedential). Obtained an order affirming the district court’s denial of the plaintiff’s motion for a preliminary injunction and approving the district court’s interpretation of patent claims in favor of our client, the defendant in a patent case involving blood-gas monitors used by perfusionists operating heart-lung machines during cardiac surgery). The district court later granted a summary judgment of no infringement in favor of our client.

Carbide Blast Joints, Inc. v. Rickert Precision Industries, Inc., Nos. 95-1040, 95-1059, 73 F.3d 379 (Table), 1995 WL 710871, Fed. Cir. Dec. 4, 1995 (nonprecedential). Obtained an order reversing the district court’s judgment in favor of our client, the defendant in a patent infringement action involving carbide blast joints used in oil and gas drilling and production.

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