

DANA M. HERBERHOLZ

Shareholder

BIOGRAPHY

With particular emphasis on patent litigation, Dana maintains a national practice and regularly serves as lead counsel in patent disputes in various courts across the United States, including the Federal Circuit Court of Appeals and the Patent Trial and Appeal Board. His patent litigation practice spans diverse technology areas including consumer electronics and hardware, computer software, image processing, wireless communication devices, laboratory equipment, medical devices, and internet technologies, among others. Dana also has extensive experience assisting clients in international patent disputes, including proceedings in Canada and in Europe.

Active in numerous bar associations and committees, Dana has served as the President of the Idaho Chapter of the Federal Bar Association and as the chair of the Intellectual Property Law Section of the Idaho State Bar.

ACCOMPLISHMENTS

Academic

Gonzaga University School of Law, Spokane, Washington (J.D., 2006)

University of Washington, Seattle, WA

Cellular and Molecular Biology (B.S., 2002)

Law Societies and Justice (B.A., 2002)

Professional

Recognized in *Best Lawyers in America* 2021 for Litigation - Patent

Listed as a "Rising Star" in the category of Intellectual Property Litigation - Mountain States Super Lawyers & Rising Stars (2009-present)

Martindale-Hubbell AV-rated

ASSOCIATIONS

Professional

President, Federal Bar Association, Idaho Chapter (2018-2019)

Local Civil Rules Committee – U.S. District Court District of Idaho (2016-present)

Executive Committee, Idaho Technology Council (2017-2020)



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PRACTICE AREAS

Intellectual Property Litigation

Litigation, Trials & Appeals

Intellectual Property

Patent Litigation

Federal Circuit Appeals

Copyright Litigation

Trademark & Trade Dress Litigation

Trade Secret Litigation

COVID-19 Response Team

LICENSED/ADMITTED

U.S. Dist. Court, Dist. of Idaho

U.S. Dist. Court, Eastern Dist. of Texas

U.S. Patent & Trademark Office

U.S. Court of Appeals, Federal Circuit

U.S. Court of Appeals, 9th Circuit

Idaho

Washington

Board Member, Federal Bar Association, Idaho Chapter (2016-present)
 Chair, Idaho State Bar Intellectual Property Law Section (2010-2011, 2013-2014)
 Member, Idaho State Bar Litigation Section (2006-present)
 Member, American Bar Association, Intellectual Property Section (2007-present)
 Member, Federal Circuit Bar Association (2011-present)

PRESENTATIONS

Opening Statement Demonstration and Trial Advocacy Mentor, Idaho Trial Skills Academy sponsored by Idaho State Bar (March 8-9, 2019)
 "Winning and Losing Strategies for Arguing an IP Case in Federal Court," Federal Bar Association Tri-State Conference, Park City, Utah (September 21, 2018)
 "Introduction to Intellectual Property Law for Business Lawyers," Idaho State Bar Business & Corporate Law Section (September 12, 2017)
 "Intellectual Property: Football, Music, and Texas – Recent Developments in IP Litigation," Federal Bar Association, Sun Valley, Idaho (October 14, 2016)
 "NPE Patent Litigation: Latest Developments," Webinar (January 27, 2016)
 "US Patent Law Updates & Avoiding Patent Infringement," American Society of Mechanical Engineers, National Webinar (February 22, 2014)
 "Are Your Genes Patentable? Overview and Potential Implications of *AMP v. Myriad Genetics*," Idaho State Bar Intellectual Property Law Section (May 15, 2013)
 "Intellectual Property Law 101," Boise State University Department of Engineering (February 08, 2013)
 "Leveraging the AIA's Joinder Provision, Recent Decisions, and New Court Procedures in Defending Infringement Disputes," Strafford Publications, National Webinar (January 09, 2013)
 "Non-Practicing Entities in Patent Litigation: Latest Developments," (co-presenter with R. David Donoghue, Holland & Knight) Strafford Publications, National Webinar (January 17, 2012)
 "Changing Technology and the Attorney-Client Privilege," National Business Institute, Boise, Idaho (December 19, 2011)
 "Patent Damages – Recent Trends and Practice Pointers Concerning the Recovery of a Reasonable Royalty," Idaho State Bar (December 08, 2010)
 "Ten Things Every Lawyer Should Know About Patents," Gonzaga University School of Law, Business and Licensing Continuing Legal Education (December 2009)

PUBLICATIONS

"Why Tech Startups Need Intellectual-Property Plans," Idaho Statesman (November 25, 2016)
 "New Federal Trade Secret Law Will Protect Idaho Employers," Idaho Business Review (May 17, 2016)
 "Veterans Legal Clinics: Protecting the Rights of Idaho's Service Members," *The Advocate* (March/April 2016)
 "Inventors, Take Note: Race to the Patent Office Starts Soon," *Idaho Statesman Business Insider*, p. 8 (Sept. 2011)
 "America Invents Act: How Landmark Patent Reform Legislation Will Impact Idaho Inventors and Companies," *The Advocate* (June/July 2011)
 "Curing Confusion: An Overview of the Regulatory Complexities of Obtaining Pharmaceutical Trademarks and a Prescription for Reform," *8 Minn. J.L. Sci. & Tech.* 97 (2007)
 Founder and editor of the Northwest Patent Litigation Blog (nwpatentlitigation.com), which provided updates and commentary on patent litigation matters in the Pacific Northwest (2011-2013)

REPRESENTATIVE MATTERS

Patent Litigation

- Won a jury verdict, enhanced damages, attorneys' fees, and a permanent injunction as lead trial counsel for railroad technology company in a case against a direct competitor. A Texas federal jury found that the competitor willfully infringed the company's patent for machine vision railroad track inspection technology.
- Lead counsel representing railroad technology company on appeal before the U.S. Court of Appeals for the Federal Circuit. Secured affirmance of jury verdict, enhanced damages, attorneys' fees, and a permanent injunction in favor of client.
- Represented manufacturer of optical systems in separate appeals before the U.S. Court of Appeals for the Federal Circuit. Secured affirmance of USPTO decisions invalidating asserted patents directed to microscope slide staining technology.
- Represented consumer electronics retailer in the Northern District of California in patent infringement case involving 802.11 wireless encryption technology. Obtained judgment of non-infringement and successfully defended judgment on appeal before the U.S. Court of Appeals for the Federal Circuit.
- Represented retail grocery chain in the Eastern District of Texas in patent infringement case involving digital image processing for surveillance systems.
- Represented manufacturers of infrared thermometers on appeal before U.S. Court of Appeals for the Federal Circuit. Successfully reversed \$2.5 million verdict against client and invalidated one of three asserted patents on appeal.
- Defended laboratory equipment manufacturer in the Southern District of California in patent infringement case involving fluorescent optical imaging technology. Successfully defeated all claims on summary judgment and recovered costs for client.
- Defended online retailers in the Eastern District of Texas in patent infringement case involving webcam technology. Obtained complete dismissal of all claims against client with prejudice shortly before trial.
- Represented one of the world's largest consumer electronics companies in the Northern District of Illinois in patent infringement case involving noise reduction, signal transmission, and motion-adaptive deinterlacing technology. Case settled favorably shortly before trial.
- Represented networking services company in patent infringement case in Eastern District of Texas involving WiFi technology. Case settled favorably during claim construction.
- Represented one of the world's largest consumer electronics companies in the Eastern District of Texas in patent infringement case involving LCD backlight technology.
- Represented online retailers in the Northern District of Georgia in patent infringement case involving personalized web content technology. Obtained complete dismissal of all claims against client with prejudice.
- Represented retail grocery chain in the Eastern District of Texas in patent infringement case involving web-based purchasing platform and "shopping cart" technology.
- Defended medical device company in District of Massachusetts in patent infringement case involving non-contact infrared thermometers.
- Represented medical device company in Southern District of Florida in in case involving design patents for infrared thermometers.
- Represented online retailers in the Eastern District of Texas in patent infringement case involving computerized sales force automation technology.
- Defended online retailers in Southern District of Florida in patent infringement case involving power supply technology.
- Defended consumer electronics company in the Eastern District of Texas in patent infringement case involving parental control and signal encryption technology.
- Represented consumer electronics retailer in the Northern District of Georgia in patent infringement case involving LCD and DLP projector technology.

- Defended dairy equipment company in the District of Idaho in patent infringement case involving technology used to prevent mastitis in cattle.
- Represented firearm technology company in the District of Idaho in patent infringement case involving interchangeable firearm components.
- Represented manufacturing company in the District of Utah in patent infringement case involving elastomeric gel technology.
- As co-counsel, represented five automobile manufacturers in District of Idaho in patent infringement case matter involving electronic vehicle braking technology.

Copyright & Trademark Litigation

- Defended fuel distributor against allegations of copyright infringement. Defeated plaintiff's motion for preliminary injunction and secured dismissal of all claims against client with prejudice.
- Defended vocational school in the District of Utah against claims of copyright infringement seeking more than \$35 million in damages. Case settled favorably after court dismissed majority of plaintiff's claims on summary judgment.
- Represented a national testing company asserting copyright infringement claims in an action filed in the Western District of Washington.
- Defended a packaging systems equipment manufacturer sued in the District of Idaho for misappropriation of trade secrets and trade dress infringement.