



Gary J. Edwards

Partner

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PRACTICES Intellectual Property, Patent Prosecution and Counseling, Patents, International Trade Commission Section 337 Proceedings, Patent Office Trials, Technology Transactions, Precision Medicine and Digital Health, Autonomous Transportation

Dr. Gary J. Edwards has represented a wide range of clients from large, multi-national corporations, to start-up companies and independent inventors to develop, enforce, defend, and monetize their intellectual property rights. Dr. Edwards works with technology companies to protect their technology, build intellectual property portfolios, assert IP rights, monetize portfolios, and defend against the assertions of competitors. Whether it is in litigation (the International Trade Commission or in U.S. District Courts), in licensing or acquisition negotiations, in the analysis of IP portfolios, in the analysis of third party patents or in practice before the U.S. Patent and Trademark Office (including reexaminations, reissues, and *inter partes* review of patents) or international patent offices, Dr. Edwards' broad technical background and experience allows him to counsel clients to balance the often competing legal and business issues that surround the acquisition, defense, and assertion of patent rights.

Dr. Edwards has a strong technical background in physics and materials science and has broad experience in a diverse array of technologies. His experience includes technological areas such as optical devices and materials (including nonlinear optical materials LEDs, optical sensors, and other devices), semiconductor processing and processing equipment (including lithography, surface inspection, materials deposition, etching and other technologies), semiconductor devices, energy storage technologies (including solid-state batteries, flow-cell batteries, and other systems), clean energy systems (including solar, wind, tidal, and other systems), communications (including high-speed LAN, DSL, BLUETOOTH, and IEEE 802.11 wireless), RFID, nanotechnologies (e.g., MEMS, superconducting devices, and materials structures), electronic circuits, imaging technologies (e.g., NMR and OCT), video and sound compression and transmission technologies, remote sensing and sensing devices, automated systems (e.g., automated vehicles) and information technologies (e.g., software and networking). Dr. Edwards' broad technological background lends itself to complex technologies, novel materials structures, and cross-disciplinary technologies.

Dr. Edwards has represented clients in licensing negotiations involving various sized companies, has participated in litigation in district court as well as in the ITC, has prepared IPRs on patents involved in litigation, has handled disputes involving patent ownership and other issues, has developed patent portfolios for companies of sizes ranging from small startups to large multi-national companies, has analyzed portfolios for acquisition, and has advised clients on third-party IP issues. Dr. Edwards' experience as a University Professor and Research Physicist allows him to not only easily grasp the technology underlying a particular matter, but to also interact with both the business and technical people involved in order to evaluate and advise on actions that are most likely to reach the goals of the client.

Gary is involved in his community and is a founding member of Discover Angling, a non-profit organization whose mission is to organize with various youth groups to arrange on-the-water adventures for disadvantaged youth on San Francisco Bay and offshore. Gary is also involved in various boating and other similar activities to promote boating safety and participation.

Gary was recognized in *The Best Lawyers in America*, Woodward/White, Inc., for Litigation - Intellectual Property, 2018-2021.

QUALIFICATIONS

EDUCATION

- M.S., Physics, University of Connecticut, 1982
- Ph.D., Physics, University of Connecticut, 1989
- J.D., University of Pittsburgh School of Law, 1997, Order of the Coif; Lead Research Editor, *University of Pittsburgh Law Review*, 1996-1997; Vice-President, University of Pittsburgh Science and Technology Law Society, 1995-1997
- B.S., Physics, University of Vermont, 1981, *cum laude; with honors*

ADMISSIONS

- California
 - U.S. Patent and Trademark Office
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SELECTED CLIENT REPRESENTATIONS

- Developed the international patent portfolios for several companies ranging in size from small start-up companies to large multinational corporations.
- Handled multiple licensing negotiations and dispute settlement negotiations involving the enforcement of IP rights: Represented a telecommunications company in negotiations with a licensee involving breach of contract; Represented a semiconductor processing company in an IP ownership dispute under a joint development agreement; Represented multinational companies in licensing negotiations involving large patent portfolios.
- Participated on several litigation teams to defend or assert patent portfolios: Represented a multinational semiconductor company in settling a patent litigation filed in the Eastern District of Texas; Represented multinational semiconductor companies in a multijurisdictional litigation, including the ITC, involving large numbers of patents.