

Kari Barnes

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Senior Counsel

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Kari Barnes is Senior Counsel in the Firm's Intellectual Property Practice Group and focuses her practice on Intellectual Property prosecution and associated transactional endeavors. Ms. Barnes is proficient in domestic and international patent prosecution for a wide variety of technologies, including medical devices, electronic devices, computer hardware and software, networking systems and protocols, green technologies, and mechanical devices. She also has experience with intellectual property strategic planning, intellectual property-related due diligence for mergers and acquisitions, freedom to operate opinions, and patent infringement and validity opinions.

Ms. Barnes currently advises a large international medical device company on its intellectual property strategy, including creating and maintaining a foreign and domestic patent portfolio; offensive and defensive opinions regarding infringement, freedom to operate, and patentability; as well as assessing the intellectual property assets of potential acquisitions. She has prosecuted a large number of patents protecting stents, catheters, catheter placement systems, needle safety devices, ultrasound devices, urological slings, and other implants and delivery systems.

She has also counseled small businesses and start-ups on intellectual property strategy and portfolio planning to protect an emerging market share or to retain and maximize intellectual property rights in view of joint venture research and development, and government grants. She has prosecuted a number of patents for these companies covering various technologies, such as storage area networks, remote access security and devices, beverage dispensers and holders, clean energy wood burning furnaces, pyrolysis systems, ratcheting pulleys, laser testing devices, and mirrors.

Representative Matters

IP Prosecution

- Prosecuting domestic portfolio of international medical device division focused on surgical and interventional devices for peripheral vascular patency
- Prosecuted domestic and international portfolios of different divisions of an international medical device company focused on surgical and interventional devices for peripheral vascular patency, vascular access devices, and urological disorders
- Prosecuted the domestic portfolio covering software and hardware applications of international smart phone company
- Prosecuted the domestic and international portfolios of a NASDAQ traded company covering smart networking and communications solutions for machine-to-machine applications
- Prosecuted the domestic portfolio of national hardware and software company focused on network connectivity, monitoring and management that supports enterprise, cloud, government and telecommunications
- Prosecuting the domestic and international portfolios of a middle sized aerospace company recognized for light weight space inflatables
- Prosecuting the domestic and international portfolios for middle sized company specializing in the design and development of advanced photonics systems for military and commercial customers
- Prosecuting the domestic and international portfolios of start-up companies in the medical device and diagnostic, software, clean energy and recycling, and mobile industries

IP Diligence:

- Assisted different divisions of an international medical device company in the IP diligence associated with its acquisitions of a number of technologies and products including ultrasound devices and applications, ECG signal processing, incontinence devices, catheter access systems, balloon catheters and associated manufacturing methods, and stent placement devices
- Performed Freedom to Operate analysis on new technologies and potential product lines of an international medical device company including in vivo device location methods and systems, ultrasound products and accessories, ECG applications, stents, balloon catheters, and ports
- Performed Freedom to Operate analysis on technologies of start-up companies including medical device imaging systems, medical diagnostic systems and methods, locker systems, beverage dispensers, clean energy processes, recycling processes including pyrolysis, and software applications
- Counsel small businesses and start-ups on IP concerns and best practices to prepare for diligence associated with the desired exit strategy

IP Litigation

- Counselling oil and gas sensor company on monetizing and enforcing patent portfolio against competitors
- Represented global leader in providing access control and secure identity solutions including smart cards, readers, printers, RFID tags and software in patent litigation both as plaintiff and defendant
- Counselling software and technology companies in defense of patent suits
- Represented international toy maker in patent defense
- Represented DVD technology company, and associated DVD consortium, in defense of patent infringement suit

Recent Publications

- "What to Know After the Latest Patent Ruling by the U.S. Supreme Court," *Computerworld*, July 28, 2014
- "Alice is Unanimous—The Latest on Software and Business Methods Patents from the U.S. Supreme Court," Buchalter Nemer *Client Alert*, June 2014
- "A Word To The Wise - You Don't Own It Just By Inventing It," *Investors Digest* (May 2013)
- "American Invents Act - Now What?" *OC Lawyer* (March 2013)

Recent Presentations

- "Patents and Intellectual Property," University of California Irvine Institute for Clinical & Translational Science (June 25, 2014)
- "Legal Issues With SBIR's and Protecting IP," University of California Irvine (April 16, 2014)
- "Legal Do's and Don'ts for Small Businesses," The Small Business Development Center, Costa Mesa, CA (October 30, 2013)
- "Practical Aspects of University Technology Licensing," for the SBIR/STTR Grant Development Series, OCTANe and UCI's Henry Samueli School of Engineering, Irvine, CA (June 27, 2013)
- "Intellectual Property Strategies: Managing the Risks and Seizing the Opportunities," Wyndam Hotel, Costa Mesa (April 2013)
- "Legal Issues for SBIR/STTR: Intellectual Property, Contracts, and Licensing," for the SBIR/STTR Grant Development Series, OCTANe and UCI's Henry Samueli School of Engineering, Irvine, CA (April 10, 2013)



Before coming to Buchalter Nemer, Ms. Barnes was an Associate at Rutan & Tucker, LLP and Morrison Foerster litigating and prosecuting patents for large companies involving toys, storage area networks, medical devices, dvd technologies, cell phones, and computer hardware interfaces including touch screens. Prior to law school, Ms. Barnes instructed at the Colorado School of Mines' Physics Department. As an adjunct professor, she taught undergraduate physics courses in mechanics and electromagnetism. She was also a researcher at the National Institute of Standards and Technology in the opto-electronics department.

Graduating first in her class, Ms. Barnes received her law degree from Loyola Law School in 2007, magna cum laude. She was awarded the J. Rex Dibble Honor Award for Academic Achievement and the ALI-ABA Scholarship & Leadership Award, and is a member of the Order of the Coif. Ms. Barnes graduated with high scholastic honors in 2001 from Colorado School of Mines. She achieved her B.S. degree in Engineering Physics, and earned minors in Computer Science, and Mechanical Engineering.

Areas of Practice

Intellectual Property
Aviation
Aerospace
Cybersecurity
Life Science
Solar and Renewable Energy
Technology
Transportation

Bar Admissions

California
U.S. Patent and Trademark Office



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