

Willmore F. Holbrow III

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Shareholder

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Areas of Practice & Industry Specialties

Privacy and Data Security; Litigation; Intellectual Property Law;
Cannabis & Hemp Industry Law Group



Bill Holbrow is Chair of the Firm's Intellectual Property Litigation Group and for over 20 years has primarily focused his practice on patent, trademark, copyright and trade secret litigation. Mr. Holbrow works with clients in a variety of industries, including those involving medical devices, apparel, chemical compounds, computer software, furniture, internet-based applications, LED technology, locks, wheel designs and electronics. He is well versed in all aspects of alternative dispute resolution, including arbitrations, mediations, and focusing on unique strategies to resolve disputes and avoid costly litigation, when appropriate. In addition, Mr. Holbrow is a member of the patent bar, prosecutes trademark applications and counsels clients on a wide array of business and licensing issues.

Prior to his experience in private practice, Mr. Holbrow served as an engineer in the Air Force and a first-chair trial attorney in the Air Force Judge Advocate General's Corps handling numerous felony level cases.

In 2019, Mr. Holbrow was nominated by the *Los Angeles Business Journal* for the prestigious "Leader in Law" award.

Representative Matters

- Represented a fastener/rivet manufacturing company in the aerospace industry in a trade dress infringement action. Result: Court granted the client's motion for summary judgment. *Allfast Fastening Systems v. Briles Rivet Corp., et al.*, 16 F.Supp.2d 1154 (C.D. Cal. 1998).*
- Represented defendant publisher in a trademark infringement action involving the name of its yellow page publication. Result: Court granted the client's motion for summary judgment. The Ninth Circuit Court of Appeal affirmed the decision. *Filipino Yellow Pages, Inc. v. Asian Journal Publications, Inc.*, 198 F.3d 1143 (9th Cir. 1999).*
- Represented defendant beauty care product manufacturer in a trademark infringement and false advertising action. Result: Following six-day trial, jury ruled completely in client's favor. *Nexus Products v. Allou Manufacturing, Inc.* (State court in Santa Barbara, CA) (1999).*
- Represented a kayak manufacturer in a patent infringement action relating to the sale of multiple-person kayaks. The patents-in-suit focused on various internal structural components of the kayaks. Result: After obtaining an extremely favorable ruling from the Federal Circuit, the trial court granted the client's motion for summary judgment. *Old Town Canoe Co. v. Glenwa, Inc.*, 55 Fed. Appx. 918 (Fed. Cir. 2003).*
- Represented plaintiff, a medical device company, in a trademark and unfair competition action. The defendant was a former distributor who had developed a competing device and sold it under a similar trademark. Result: Following two-week trial, the jury ruled in client's favor. Client was awarded over \$5 million in damages and its attorneys' fees. *Electronic Waveform Lab., Inc. v. RJS Industries, Inc., et al.*, CV 00-9220-JSL (2005).*
- Represented defendant, a major toy company, in a patent infringement action involving the sale of rubber balls. The patents focused on the gelatinous composition of the balls and their unusual structural design. Result: The Court granted the client's motion for summary judgment. *JAKKS Pacific, Inc., et al. v. Imperial*

Toy Corp., et al., CV 05-3228 (2007).*

- Represented clothing company in opposition proceeding before the Trademark Trial and Appeal Board involving the attempted registration of a similar mark. Result: After the completion of the trial period, the Board sustained the client's opposition. *Michael Stars, Inc. v. Michael Starr*, Opposition No. 91164989 (2008).*
- Represented defendant, percussion manufacturer, in a patent infringement action involving a percussion-carrying device. Result: Federal Circuit overturned District Court's finding of infringement, which was based on flawed claim construction. On remand, District Court held that the product did not infringe and ordered Plaintiff to pay client's attorney's fees. *Randall May Inc. v. DEG Music Products, Inc.*, CV 0894 (2005); rev'd Fed Cir. 2009-1367.*
- Represented defendant in a design patent infringement action, in Minnesota, involving a collapsible hand-cart. Asserted a counterclaim alleging false-designation of origin regarding Plaintiff's competing product. Result: Case settled following favorable ruling on summary judgment highlighting serious inventorship issues and likelihood of success on counterclaim. *Safeco Products Co. v. Welcom Products, Inc. et al.*, CV 4918 (2008).*
- Represented defendant, a medical equipment manufacturer, in a patent infringement action involving a software/hardware product, designed to digitize and record medical images on a CD. Plaintiff asserted five patents and over 100 claims. Result: The Court granted the client's motion for summary judgment finding three of the patents not infringed and the other two patents invalid. *DatCard Systems, Inc. v. Pacsgear, Inc.* CV 1288-MRP (2010), aff'd, Fed. Cir. 2013-1445.*
- Represented defendant, publisher of an academic journal, in a copyright infringement action involving a third party article published in the journal. Result: Successfully negotiated resolution on terms the client found quite favorable. *Kumar v. Sage Publications, Inc.*, CV 12-6306 RSWL (2012).*
- Represented defendant, a wheel manufacturer, in a design patent infringement action involving the appearance of one-piece wheels. Result: The Court granted the client's motion for summary judgment finding the patent claim was primarily functional and invalid based on prior art. *All Star Tire v. Wheel Pros*, CV 0563 AHS (2008). The decision was affirmed on appeal by the Federal Circuit.*
- Represented defendant, a medical equipment manufacturer, in a patent infringement action in Minnesota involving a software/hardware product designed to digitize and record medical images on a CD. Plaintiff asserted four patents and over 100 claims. Prepared multiple IPRs (Inter-Partes Review) attacking the validity of the patents and reached a favorable settlement agreement. *Sorna Corp. v. Perceptive Software, LLC*, CV 2294 (2013).*
- Represented Plaintiff, a provider of ACH monetary transfer services in a trademark infringement case. Court granted client's motion for summary judgment and in 2016 enjoined any further use of the infringing mark. *Cachet Financial Services v. Cachet Financial Solutions*, CV 01564 (2013).*
- Represented Plaintiff, medical device manufacturer, in trademark infringement, trade libel and unfair competition case. Following extensive discovery, the client entered a very beneficial settlement agreement. *Electronic Waveform Lab Inc. v. Work Loss Data Institute*, CV 00794 (2015).*

*Represents experience from a previous law firm.

Publications

- If You Conduct Any Business with Entities (Including Affiliates) Outside of the U.S., Then Please Read, *Buchalter Client Alert*, May 1, 2018

Presentations

- Panelists, "Bill Holbrow and Kari Barnes, Panelists at the Additive Manufacturing Strategies Conference," Hynes Convention Center, Boston, MA, January 29, 2019

Education

Mr. Holbrow attended Loyola Law School and Suffolk University Law School, where he earned his JD, and graduated from the University of California, Los Angeles with a BS in Mechanical Engineering.

Bar Admissions

- California
- New York
- Massachusetts
- U.S. Patent and Trademark Office