

Partner

Jon A. Birmingham

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Profile

Jon A. Birmingham is a patent attorney and litigator who is particularly skilled at coordinating the prosecution of complex patent families on a global scale. Jon's practice has a strong focus on mechanical opinion and prosecution matters, including the creation of strategies to protect high-value products and advising on patent protection strategies for inventions utilizing artificial intelligence (AI).

A wide range of clients rely on Jon's counsel. For over two decades, he has represented Fortune 500 companies as well as small and mid-sized companies in intellectual property litigation, opinion matters, and patent prosecution matters (including protecting designs).

Jon has handled complex litigation involving a broad range of technologies. These include standard-essential patents (SEPs) for wireless communication technology, semiconductor memory, electronic medical devices, fluid systems, printing presses, optical recognition software, network management software, and injection-molded automotive components.

Jon maintains an active patent prosecution and client counseling practice in a variety of technologies and emerging fields such as artificial intelligence, and particularly those involving the mechanical arts, such as high-speed automated equipment, consumer food product packaging, irrigation devices, automotive timing and transmission systems, household organizational products, and commercial printing equipment. He has participated in a number of intellectual property due diligence studies, product clearance studies, and IP value assessments.

Jon is a member of Fitch Even's Recruiting and Employment Committee.

Representative Matters

- *Lone Star Silicon Innovations LLC v. Nanya Technology Corporation* (N.D. Cal. 2016–20). Represented plaintiff in patent infringement actions

Education

J.D., University of Illinois
College of Law, 2000, *cum laude*

B.S., Mechanical Engineering,
Northwestern University,
1997

Bar Admissions

California

Illinois

U.S. Patent and Trademark
Office

U.S. Supreme Court

U.S. Court of Appeals for the
Seventh and Federal Circuits

U.S. District Court for the
Central, Southern, Northern,
and Eastern Districts of
California

U.S. District Court for the
Northern District of Illinois

U.S. District Court for the
Eastern District of Texas

Trial Bar of the U.S. District
Court for the Northern
District of Illinois

Services

International IP Protection

IP Litigation

Appellate Practice

against Nanya Technology Corporation under multiple patents related to DRAM and NAND Flash memory and other large-scale integrated semiconductor devices. Actions against Micron, Toshiba, United Microelectronics Corporation, Renesas Electronics, Semiconductor Manufacturing International Corporation, and STMicroelectronics were resolved.

- *Limestone Memory Systems LLC v. Micron Technology, Inc.* (C.D. Cal. 2015–20). Represented plaintiff in patent infringement actions against Micron, Dell, Hewlett-Packard, and Kingston relating to memory chips that incorporate DRAM technology. Stay of case was lifted following *inter partes* review proceedings and jury trial is scheduled for spring 2020. Actions against Acer and Lenovo were resolved.
- *Belava, LLC v. Dion Nails Supply, Inc.* (C.D. Cal. 2017). Represented plaintiff in design patent litigation related to spa products. Court entered consent judgment and permanent injunction.
- *Belava, LLC v. TNG Worldwide, Inc.* (C.D. Cal. 2015). Represented plaintiff in design patent and trade dress litigation relating to spa products, including with filing of motion for preliminary injunction. Case settled.
- *Belava, LLC v. Fuji Nails, Inc., et al.* (C.D. Cal. 2015). Represented plaintiff in design patent and trade dress litigation related to spa products. Court entered consent judgment and permanent injunction.
- *Taran Tactical Innovations, LLC v. Adrian Cobb* (C.D. Cal. 2015). Represented defendant in patent litigation relating to base pads for firearm magazines. Case settled.
- *SOTA Semiconductor LLC v. NVIDIA, Inc., et al.* (C.D. Cal. 2014). Represented plaintiff in patent infringement action against NVIDIA, Acer, ASUS, Hewlett-Packard, Lenovo, and Microsoft relating to microprocessors integrated in mobile phones.
- *SOTA Semiconductor LLC v. Marvell Semiconductor, Inc., et al.* (C.D. Cal. 2014). Represented plaintiff in patent infringement action against Marvell, Belkin, Dell, Hewlett-Packard, Hisense USA, Konica Minolta, Lenovo, Netgear, Samsung, Seagate, and Western Digital, relating to microprocessors.
- *Alexsam, Inc. v. UnitedHealth Group Incorporated* (E.D. Tex. 2007-11). Represented patentee in claims of infringement under patents relating to systems for conducting transactions for managing medical savings account cards. Obtained settlement on the eve of jury selection.
- *Taye, Inc. v. Drum Workshop, Inc.* (C.D. Cal. 2007). A patent infringement case in which Jon personally handled the Markman briefing and oral

Brand Enforcement
Commercial + Technology Disputes
Copyright Disputes
IP Professional Responsibility + Malpractice
ITC Section 337 Disputes
Northern District of Illinois Local Counsel Services
Patent Litigation
Standard Essential Patents
Trade Secret Litigation

IP Portfolio Management
IP Strategy Development
IP Transactions
Patent Preparation + Prosecution
Product Clearance + Legal Opinions
PTAB Trial Practice
Reissue + Reexamination Proceedings

Industries

Artificial Intelligence
Computer Software + Hardware
Consumer Products + Packaging
Mechanical Engineering + Manufacturing
Medical Devices + Diagnostics
Transportation

argument. The case settled after a favorable Markman ruling.

- *Liquid Dynamics Corp. v. Vaughan Co. Inc.* (N.D. Ill. 2001-07; Fed. Cir. 2003, 2006). Patent litigation, two successful Federal Circuit appeals; jury verdict in Fall 2004 at 45% royalty, treble damages, and attorneys' fees; bench trial for contempt proceeding.
- *Rain Bird Corporation v. Hit Products Corporation* (C.D. Cal. 2004). A patent/trade dress case in which Jon helped Rain Bird to obtain a preliminary injunction based on a contested motion filed over 16 months after the complaint.

Presentations + Publications

Presentations

- "Navigating the Changes to the Test for Obviousness in Design Patents After *LKQ Corp. v. GM Global*," Fitch Even Webinar, October 29, 2024.
- "Means-Plus-Function Claim Construction in Patent Prosecution and Litigation," Fitch Even Webinar, January 27, 2021.
- "Design Patent Enforcement: Recent U.S. Court and PTAB Decisions," Fitch Even Webinar, August 2, 2018.
- "Updates on Design Patent Law: The Hague Agreement and U.S. Design Patent Enforcement," Fitch Even Webinar, with Conor S. Hunt, September 30, 2015.
- "Protection by Design: A Comparison of U.S. and European Design Protection," Fitch Even Webinar, June 29, 2011.