

Partner

Thomas F. Lebens

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## Profile

“Intellectual property development is about connection, not collection. Planning for these connections starts at the point of idea conception, and is developed throughout the protection process, through the transaction and monetization.”

Thomas F. Lebens is an experienced attorney-at-law and patent attorney who has served clients since 1991 in preparing and prosecuting patent and trademark applications, including appeals, post-grant review, and interferences. In addition to his law practice, Tom currently manages West Coast operations for Fitch Even’s San Diego, Los Angeles, and San Luis Obispo offices.

Tom has handled sophisticated, high-stakes patents across a wide spectrum of technologies and industries, including these:

- Analog and digital electronics
- Optics
- Control systems
- Communications, including cellular telephony and satellite communications and design
- Semiconductor fabrication
- Circuit design
- Physics
- Medical devices, implants and imaging
- Consumer electronics, including television technologies and optical video technologies
- Materials and contraband detection and imagery
- Weaponry, both lethal and nonlethal
- Complex computer software technologies, including data compression and encryption, database design, computer security, intruder detection, software design tools, and Internet technologies
- Business methods, such as software and business processes

In addition, Tom is highly experienced in counseling clients in intellectual property and business strategy; licensing issues; infringement and validity analysis; patentability, infringement, and validity opinions; and copyright matters, both for artistic works and computer software.

Tom has an integrated approach to a business’s intellectual property that spans the lifetime of its assets. Clients value Tom’s involvement from the concept stage all the way to leveraging the asset through sale, licensing, pooling, partnering, and product/service delivery and market management.

He helps clients focus on IP-rich technology segments, developing an intellectual property portfolio aligned with those technology segments and targeted to strategic profit opportunities.

Thanks to Tom’s approach, clients better understand their competition, positioning their intellectual property portfolio accordingly, both as potential business partners and as adversaries. And, when it comes time to create and close a deal, his experience, creativity, and competitive spirit come into play.

### Education

J.D., University of San Diego School of Law, 1993, *cum laude*

B.S., Electrical Engineering, California Polytechnic State University, 1989

### Bar Admissions

California

U.S. Patent and Trademark Office

California Supreme Court

U.S. Court of Appeals for the Federal Circuit

U.S. Court of Appeals for the Ninth Circuit

Numerous U.S. District Courts

U.S. Supreme Court

### Services

Copyrights

Entertainment + Media

International IP Protection

Internet + Domain Names

IP Portfolio Management

IP Strategy Development

IP Transactions

Patent Preparation + Prosecution

Product Clearance + Legal Opinions

PTAB Trial Practice

Reissue + Reexamination Proceedings

Trade Secrets

Trademark + Brand Protection

### Industries

Artificial Intelligence

Computer Software + Hardware

Consumer Products + Packaging

Electronics

Energy + Clean Technology

Environmental Engineering

As a part of his integrated approach, Tom regularly assists clients in developing policies and drafting agreements related to their intellectual property and information, including drafting non-disclosure agreements, license agreements, customer terms and conditions, intellectual property notices, office and data access policies, joint development agreements, employee and independent contractor agreements, website disclaimers, privacy policies, and notices, website policies and notices, and privacy law compliance policies and practices.

Food + Agricultural Sciences  
Internet + E-Commerce  
Material Science  
Mechanical Engineering + Manufacturing  
Medical Devices + Diagnostics  
Transportation

## Representative Matters

- Successfully represented patent owner in several *inter partes* review and covered business method review proceedings, resulting in all claims surviving validity challenges.
- Represents innovation-driven client in creation and development of patent portfolio, and sale of portfolio to industry leader in smartphone technology.
- Represents global consumer electronics and telecommunications company in creation and development of top-10 U.S. and international patent portfolio.
- Developed patent portfolio for media post-production company in execution of licensing and product protection strategy.
- Leads team in offensive and defensive post-grant review proceedings for various weapon systems in executing business and patent strategies leading to successful outcomes, including mergers/purchases, licensing, and enforcement.
- Experienced in patent pre-appeals, appeals, and advanced tactics for a Fortune 500 company in difficult patent prosecution cases in the consumer electronics, telecommunications, and software industries to maximize protection and business value of patent application assets.
- Conducts due diligence in connection with purchase of patent assets covering media technologies, leading to improved negotiating conditions, and understanding of limitations and encumbrances.
- Prepares and prosecutes hundreds of patent applications and trademark applications ranging in technologies from complex physics, telecommunications, and electronics to software algorithms, user interfaces, and data processing.
- Negotiates and drafts numerous licensing, sale, joint development, and business agreements with Fortune 500 companies and non-practicing entities on behalf of small and mid-cap clients.

## Presentations + Publications

### Presentations

- "Terrifying Tales of the USPTO's DOCX Filing System," Fitch Even Webinar, with Giles N. Turner, May 23, 2023.
- "Discretionary Denials Revisited: The New Politics of *Fintiv*," Moderator, American Intellectual Property Law Association, July 20, 2021.
- "Redefining the Problem: Thomas Lebens," March 3, 2021, in *That One Case* podcast, produced by Lower Street, [lowerstreet.co](http://lowerstreet.co)
- "Latest Developments in the Patentability of AI- and Software-Based Inventions," Fitch Even Webinar, with Zachary Van Engen, September 24, 2020.
- "Can You Patent Your AI-Based Invention?," 2020 Embedded Vision Summit, September 17, 2020.
- "Effective Trade Secret Practices: What You and Your Employees Need to Know," Fitch Even Webinar, with Donald Bunton, September 26, 2019.
- "Avoiding Prosecution Churn: When *Ex Parte* PTAB Appeals Make Dollars and Sense," Fitch Even Webinar, Co-Presenter, March 21, 2018.

- “How to Strategically Incorporate *Ex Parte* Appeals into Your Practice,” Co-presenter, American Intellectual Property Law Association Corporate Practice Committee webinar, January 16, 2018.
- “Your Devices Are Listening,” San Luis Obispo Chamber of Commerce monthly program, San Luis Obispo, Calif., February 23, 2017.
- “Practical Tips for Trade Secret Protection in the Ever-Evolving Digital Age,” Panel Moderator, American Intellectual Property Law Association Annual Meeting, Washington, D.C., October 28, 2016.
- “The Defend Trade Secrets Act: A Federal Remedy at Last,” Fitch Even Webinar, May 25, 2016.
- “Legal Issues in Cybersecurity,” American Intellectual Property Law Association Annual Meeting, Washington, D.C., October 22, 2015.
- “Cybersecurity: What Your Small Business Can’t Afford Not to Know,” San Luis Obispo Chamber of Commerce Legislative Lunch, San Luis Obispo, Calif., September 22, 2015.
- “Emerging Standards and Legal Developments in Cybersecurity,” American Intellectual Property Law Association Trade Secret Law Summit, Santa Clara, Calif., December 5, 2014.
- “Trade Secret Implications of the America Invents Act: Can the Coca-Cola® Formula Now Be Patented?” Fitch Even Webinar, March 20, 2014.

## Memberships

- American Intellectual Property Law Association
  - Trade Secret Law Committee
  - Patent Committee
  - PTAB Trial Committee
  - IP Transactions Committee
- American Youth Soccer Organization
  - Past Member, National Board of Directors
  - Past Area Director & Regional Commissioner
  - Member and Past Chair, National Legal Commission
- Boy Scout Troop 413, Arroyo Grande
  - Past Scoutmaster
  - Past Assistant Scoutmaster
- Cal Poly Alumni Association, San Luis Obispo
  - Past President
  - Past Member, Board of Directors
- California State University Alumni Council
  - Past Member, Board of Directors
- Cal Poly Center for Innovation & Entrepreneurship
- Cal Poly College of Engineering
  - Member and Past Chair, Dean’s Advisory Council
- Cal Poly Corporation
  - Past Member, Board of Directors

- Cal Poly Student Affairs Advisory Council
- Central Coast Natural History Association
  - Past President, Board of Directors
- French Hospital Medical Center Foundation
  - Member and Past Chair, Board of Directors
- French Hospital Medical Center Community Board
  - Past Member, Community Board
- SESLOC Federal Credit Union
  - Chair, Board of Directors
  - Past Member, Supervisory Committee
- Institute of Electrical and Electronics Engineers
  - Senior Member
- Prado Day Center
  - Past Member, Board of Directors
- San Luis Obispo Chamber of Commerce
  - Past Member, Issues Evaluation Committee
  - Member, Audit Committee
  - Past Chair, Board of Directors
  - Past Chair, Technology Advocacy Committee
- San Luis Obispo County Bar Association
  - Past Member and Past Chair, Intellectual Property Section
- Scouts USA
  - District Commissioner
- Silicon Valley Intellectual Property Law Association
- Softec, Central Coast Software and Technology Association
  - Director Emeritus
  - Past Chair, High Technology Companies Symposium
- San Luis Obispo Literacy Council
  - Past Member, Board of Directors
- San Luis Obispo Court Appointed Special Advocates (CASA)
  - Member, Board of Directors