



## Hidetada James Abe

Partner

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### Related Services

Intellectual Property ■ Intellectual Property Litigation ■ Patent Litigation ■ Litigation ■ Japan Business Team ■ Intellectual Property - Japan Business Team ■ Patent Prosecution, Counseling & Review ■ Post Grant Proceedings ■ Post Grant Review Proceedings ■ International ■ Biotechnology, Pharmaceutical & Life Sciences Patent Litigation ■ Corporate & Business Transactions ■ Blockchain & Digital Assets

James Abe is a partner in Alston & Bird's Intellectual Property Group and a member of the Biotechnology, Pharmaceutical & Life Sciences Patent Litigation Team and Japan Business Team. James counsels a wide range of companies on all aspects of intellectual property law, with a focus on advising on patent, trade secret, trademark, copyright, and privacy and data security disputes and procuring patent and trademark rights.

James is fluent in Japanese and counsels many Japanese companies on their U.S. legal needs, including intellectual property and technology matters, commercial and business disputes, and cross-border transactions. He also regularly represents Japanese companies in court and before the U.S. Patent and Trademark Office.

James earned his J.D., cum laude, from the University of San Diego School of Law, where he served as a member of the *San Diego Law Review* and received the CALI award in Patent Law. He earned his B.S. in chemistry from the University of California, Irvine. Before law school, James worked at Terumo Cardiovascular Systems Corp. for seven years, where he worked on various patient monitoring systems.

### Representative Experience

#### Litigation

- Defending a major Japanese electronics company in a patent infringement litigation in the Eastern District of Texas.
- Representing a Japanese optical device company in a patent enforcement action in the Northern District of Texas.
- Representing the patent owner in a series of inter partes reviews involving patents related to remote control devices. *Roku Inc. v. Universal Electronics Inc.*, Nos. IPR2019-01595, IPR2019-01608, IPR2019-01612, IPR2019-01613, IPR2019-01614, IPR2019-01615, IPR2019-01619, IPR2019-01620, IPR2019-01621.
- Representing an engineering company in a declaratory judgment action involving a patent directed to retaining wall systems. *SRK Engineering Inc., et al. v. John Babcock, et al.*, No. 2:19-cv-09987 (C.D. Cal.).
- Represented a hearing-aid company in a declaratory judgment action involving a patent directed to remotely controlled hearing aids. *Sivantos GMBH, et al. v. Manchester*, No. 2:19-cv-06874 (C.D. Cal.).
- Represented a social networking service company in a patent infringement action involving data security. *Transaction Secure LLC v. DeviantArt Inc.*, No. 2:19-cv-05836 (C.D. Cal.).
- Represented a hearing-aid company in litigation involving claims of trade secret misappropriation. *Manchester v. Sivantos GmbH, et al.*, No. 2:17-cv-05309 (C.D. Cal.).

- Representing a footwear company in trademark infringement litigation. *Skechers U.S.A. Inc., et al. v. Easy Spirit LLC, et al.*, No. 2:19-cv-02141 (C.D. Cal.).
- Representing a beverage company in trademark infringement litigation. *Real Coco USA LLC v. Clark Foods Inc.*, No. 2:19-cv-00038 (C.D. Cal.).
- Represented a manufacturer of communication devices in a patent infringement action involving communication technology. *TQ Delta LLC v. ZyXEL Communications Inc., et al.*, No. 1:13-cv-02013 (D. Del.).
- Representing a developer of payment technology in a patent infringement action against a smartphone manufacturer. *International Technologies and Systems Corp. v. Samsung Electronics Co. Ltd., et al.*, No. 8:17-cv-01748 (C.D. Cal.); *International Technologies and Systems Corp. v. Samsung Electronics Co. Ltd., et al.*, No. 20-1077 (Fed. Cir.).
- Represented the defendants in a copyright infringement case. *Elohim EPF USA Inc. v. PONDANET Inc., et al.*, No. 8:19-cv-00349 (C.D. Cal.).
- Represented an apparel company in a design patent infringement action involving shoe designs. *TBL Licensing LLC v. Koton Trading Inc.*, No. 2:18-cv-03950 (C.D. Cal.).
- Represented pharmaceutical companies in several inter partes review proceedings. Nos. IPR2017-01034, IPR2017-01035, IPR2017-00643, IPR2017-00644, IPR2017-00645, IPR2016-01163, IPR2016-00626, IPR2015-00902, IPR2015-00903.
- Represented the respondents in an ITC patent infringement action involving ATM devices. *Certain Automated Teller Machines, ATM Modules, Components Thereof, and Products Containing the Same*, Inv. No. 337-TA-989 (ITC).
- Represented pharmaceutical companies in several patent infringement actions. *Bausch & Lomb Inc., et al. v. Micro Labs USA Inc., et al.*, No. 1:15-cv-03113 (D.N.J.); *Senju Pharmaceutical Co. Ltd., et al. v. Innopharma Licensing Inc., et al.*, No. 1:14-cv-06893 (D.N.J.).
- Represented a Japanese company in a design patent infringement action involving game controllers. *Performance Designed Products LLC v. Hori USA Inc., et al.*, No. 3:16-cv-00630 (S.D. Cal.).
- Represented a Japanese company in a patent infringement action involving customized proposal systems. *Clear With Computers LLC v. Yanmar America Corp.*, No. 6:13-cv-00168 (E.D. Tex.).
- Represented a Japanese beverage company in a class action lawsuit.
- Represented the defendant in a products liability lawsuit involving baby-powder products.
- Represented an Internet service company in a patent infringement action involving network security systems. *Elia Data of Texas LLC v. Amazon.com Inc.*, No. 2:13-cv-00517 (E.D. Tex.).
- Represented a declaratory judgment plaintiff in a patent infringement action involving communication technology. *Mellanox Technologies Inc. v. Infinite Data LLC*, No. 1:13-cv-00913 (D. Del.).
- Represented a mobile phone manufacturer in a patent infringement action involving 3G/4G wireless technology. *Certain Wireless Devices with 3G and/or 4G Capabilities and Components Thereof*, Inv. No. 337-TA-868 (ITC).

## **Counseling and Transactions**

- Counsel to a Japanese medical device company on several corporate acquisitions.
- Counsel to a major Japanese company on licensing issues involving standard essential patents.
- Counsel to a Japanese medical equipment manufacturer on intellectual property matters.

- Counsel to a Japanese battery manufacturer on intellectually property matters.
- Counsel to a Japanese toy company on intellectual property matters.
- Counsel to a Japanese construction company on intellectual property matters.
- Counsel to a Japanese computer security company on intellectual property matters.
- Counsel to a Japanese medical device company on intellectual property matters.
- Counsel to a Japanese restaurant business on corporate transactions and intellectual property matters.
- Counsel to a Japanese payment service company on corporate matters.
- Counsel to several Japanese clients on employment, immigration, and general corporate matters.

## **Publications & Presentations**

### **Publications**

- *USPTO Post-Grant Trials Handbook*, 3rd Edition, Wolters Kluwer, 2023.
- “Summary of Countermeasures for Counterfeit Products in the US,” JETRO New York Office (Intellectual Property Division), March 2022.
- “‘Pulp Fiction’ NFT Lawsuit Presents New IP Battleground,” *Law360*, December 20, 2021.
- “Google LLC v. Oracle America, Inc.: Fair Use under US Copyright Law,” *A.I.P.P.I. Japan*, Vol. 66 No. 11, November, 2021.
- “The Impact of the SAS Decision That the USPTO’s Handling of Inter Partes Reviews Was Improper,” *Intellectual Property Management*, Vol. 69, No. 3, March 2019 (Japanese).
- *USPTO Post-Grant Trials Handbook, Second Edition*, editorial committee, Wolters Kluwer, 2019.
- *USPTO Post-Grant Trials Handbook*, 2nd Edition, Wolters Kluwer, 2018.
- “Challenges to U.S. Patents: What You Need to Know About *Inter Partes* Review Practice in the United States Patent Trial and Appeal Board,” *Journal of Towa Institute of Intellectual Property*, Vol. 9, No. 2, 2017.
- *USPTO Post-Grant Trials Handbook*, editorial committee, Wolters Kluwer, 2016.
- *USPTO Post-Grant Trials Handbook*, Wolters Kluwer, 2016.
- “Why Intent Is Important Under U.S. Patent Law: The Strategic Position of Intent in U.S. Patent Litigation and Discussions on Privilege,” *Journal of the Japanese Group of the International Association for the Protection of Intellectual Property*, March 2016 (Japanese).
- “Pretrial Dismissals and Judgments in Post-Alice Courts,” *Law360*, April 23, 2015.
- “Effect of USTR’s Recent Ruling on Litigation Strategy in the ITC for Standard Essential Patents,” *The Lawyers*, February 2014 (Japanese).
- “Effect of USTR’s Recent Ruling on Litigation Strategy In the ITC for Standard Essential Patents,” *The Lawyers*, February 2014.

### **Presentations**

- “Biotech IP Protection in the US,” webinar, April 14, 2022.
- “Intellectual Property Developments,” CHIZAI Toastmasters, November 13, 2020.

- Joint Meeting between the Japan Patent Attorney Association, AIPPI Japan, and AIPLA IP Practice in Japan Committee: Japanese and US Perspectives on Trade Secrets, webinar, November 9, 2020.
- “Subject Matter Eligibility: *American Axle & Manufacturing, Inc. v. Neapco Holdings LLC* (Fed. Cir. 2020),” Japan External Trade Organization (JETRO) IPG Seminar
- “Leveraging the Right Venues for Successful Patent Litigation,” LAIPLA Spring Seminar 2019, Rancho Palos Verdes, CA, April 26–28, 2019.

## ***Professional & Community Engagement***

- USC IP Institute, Planning Committee
- Japan Business Association of Southern California, Planning & P.R. Committee
- Asian Americans Advancing Justice – LA, Executive Advisory Council
- Japan America Society of Southern California
- Japanese American Bar Association

## ***Education***

- University of San Diego (J.D., 2009)
- University of California, Irvine (B.S., 2000)

## ***Languages***

- Japanese

## ***Admitted to Practice***

- California
- U.S. Patent and Trademark Office