



Zachary A. Higbee

Partner

+1 704 444 1133 | zack.higbee@alston.com

Charlotte | Vantage South End, 1120 South Tryon Street, Suite 300 | Charlotte, NC 28203

Related Services

Intellectual Property ■ Patent Prosecution, Counseling & Review ■ Mechanical Patents ■ Electrical, Software & Computer Science Patents ■ Technology ■ Intellectual Property Licensing Transactions ■ IP & Software Licensing ■ IP and IT Audits and Due Diligence ■ Artificial Intelligence (AI) ■ Payments & Fintech

Zack Higbee is a registered patent attorney practicing all aspects of U.S. and international patent prosecution, review, and IP counseling. Whether retooling and streamlining a mature portfolio or priming a client for rapid growth, Zack works with clients to identify, harvest, and protect valuable IP with forward-looking, cost-effective strategies. He also designs comprehensive IP portfolio and transactional strategies involving all aspects of IP, including patents, copyrights, open source, trade secrets, and licensing.

Zack helps clients protect their businesses and bring their products to market safely and efficiently by preemptively avoiding issues with competing IP and laying solid groundwork using patentability and freedom to operate analyses, opinions, and engineering design and strategic portfolio analysis and recommendations.

With a background in engineering and economics, and practical experience in software systems engineering, medical devices, and robotics, Zack handles high-stakes, interdisciplinary portfolios that integrate disparate technological fields and legal disciplines for the most technologically and legally holistic approach to IP protection for some of the largest companies in the world. A noted author on emerging patent legal issues, including AI-enabled inventions, Zack keeps clients' portfolios best positioned for long-term success.

Zack received his J.D., with honors, from The George Washington University, and dual B.S. in mechanical engineering and business economics and management from Caltech, where he was also a decathlete and captain of the track and field team.

Representative Experience

Patent Prosecution, Counseling, and Review

- Prosecuted client patent portfolios in the United States and in over 14 international jurisdictions resulting in clients receiving settlements worth nine figures.
- Represented a Fortune 500 financial services company strategically building its IP portfolio following an expansion into IoT, automotive, and mobile device software, including artificial intelligence-based solutions, via strategic IP harvesting, blue sky ideation, preparation and prosecution, transactional acquisitions of innovative technology companies.
- Counsel to an OMXS30 appliance manufacturer conducting patentability, freedom to operate searching, and opinion analysis.

- Represented a cancer electroporation and immunotherapy company during its early growth phase by identifying, harvesting, and protecting inventions in key business areas via design and utility patent applications to assist with ongoing fundraising and transactional efforts.
- Guided several clients through the preparation and prosecution of reissue applications to broaden their patent protection in view of changing business considerations.
- Counsel to a Fortune 100 global conglomerate regarding U.S. and international protection and enforcement strategies for industry-leading lines of fall protection equipment, sensors, robotic automation systems, and bar code scanning products.
- Represented a large eCommerce company in preparation and prosecution of patent applications related to graphical user interfaces and underlying software technology.
- Conducted strategic landscape searching, portfolio monitoring, and patent preparation and prosecution for the technology division of a national sports league.
- Represented a global product packaging company in preparation and prosecution of patent applications for computer vision solutions.
- Prepared and prosecuted patent applications related to acoustics, acoustic transducers, and associated signal processing on behalf of a large manufacturer of marine electronic products.

IP Transactions

- Counseled and drafted IP related agreements for new startup companies, including NDAs, license agreements, IP purchase agreements, and portions of employment agreements.
- Represented lenders and borrowers in IP due diligence and definitive agreement drafting as part of the acquisition financing for asset-based lending transactions.
- Represented a large telecommunications company in intellectual property matters associated with the acquisition of a carve-out division from an S&P 500 component global telecommunications technology company.
- Represented a private-equity-backed chip manufacturer in intellectual property matters related to its acquisition of a high-efficiency server processor business.

Publications & Presentations

Publications

- "Cross-Border Issues Following U.S. Artificial Intelligence Inventorship Decision," *Law360 Canada*, May 31, 2023.
- *USPTO Post-Grant Trials Handbook*, 3rd Edition, Wolters Kluwer, 2023.
- *USPTO Post-Grant Trials Handbook*, 2nd Edition, Wolters Kluwer, 2018.
- "Insight: Drug Delivery Devices in the FDA Orange Book After In re Lantus," *Bloomberg Law*, October 17, 2018.
- *USPTO Post-Grant Trials Handbook*, Wolters Kluwer, 2016.
- "After 'Alice': A Feedback Loop of Software Patent Invalidity," *Corporate Counsel*, September 3, 2015.
- "Go Ask 'Alice': Why Software Patents Are Still Valuable," *Corporate Counsel*, May 20, 2015.

Professional & Community Engagement

- Intellectual Property Owners Association, U.S. Patent Law Committee

Court Admissions

- U.S. Court of Appeals for the Federal Circuit

Accolades

- *Managing IP* – Rising Star (2021–2023)
- *The Best Lawyers in America*[®] - “Ones to Watch” (2021–2024)
- *Super Lawyers* - North Carolina Rising Stars (2023–2024)

Education

- The George Washington University (J.D., 2013)
- California Institute of Technology (B.S., 2009)

Admitted to Practice

- North Carolina
- U.S. Patent and Trademark Office