

Zachary A. Higbee

Senior Associate

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Zack Higbee focuses his practice on all aspects of ex parte U.S. and international patent prosecution, review, and IP counseling, as well as advising on IP licensing and transactional matters, copyright, open source, and trade secret issues where appropriate for his clients' business goals. He works with client principals and team members to identify, harvest, and protect valuable IP. Zack also regularly conducts patentability, freedom to operate analyses, prepares opinions, and provides engineering design recommendations that help preemptively avoid costs and expenses associated with competing IP.

With an academic background in mechanical engineering and economics, and practical experience in medical device research, robot design, and software systems engineering, Zack often handles interdisciplinary cases that integrate disparate technological fields and legal disciplines for the most technologically holistic approach to IP protection.

Leveraging his background in business, Zack also understands his clients' products and business goals, and helps structure and optimize the value of their portfolios, including identifying and acquiring IP to fill holes in client portfolios.

Zack received his J.D., with honors, from The George Washington University, where he was a member of the *AIPLA Quarterly Journal*. Before pursuing a career in law, Zack earned a dual B.S. both in mechanical engineering and in 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

- Represented a large 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, and internal employee, open source, and trade secret policy management.
- Represented a major appliance manufacturer conducting patentability, freedom to operate searching, and opinion analysis.
- Represented a cancer electroporation and immunotherapy company during its early growth phase to assist with ongoing fundraising and transactional efforts by identifying, harvesting, and protecting inventions in key business areas via design and utility patent applications.
- Prosecuted client patent portfolios in over 14 international jurisdictions and assisted client principals with evaluating and identifying key foreign footprint needs based on business and practical legal considerations.
- Counsel to an industry-leading medical testing equipment manufacturer crafting robust and overlapping layers of patent and design protection for new high value products.

- Counsel to a global conglomerate regarding U.S. and international protection and enforcement strategies for industry-leading lines of fall protection equipment 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 and Post Grant Proceedings

- Counseled and drafted IP related agreements for new startup companies, including NDAs, license agreements, IP purchase agreements, and portions of employment agreements.
- Represented lenders in IP due diligence and definitive agreement drafting as part of the acquisition financing for asset-based lending transactions.
- Guided several clients through the preparation and prosecution of reissue applications to broaden their patent protection in view of changing business considerations.
- Represented a large telecommunications company in intellectual property matters associated with the acquisition of a carve-out division from a 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.
- Represented the patent owner in inter partes review proceedings related to expandable downhole drilling tools, securing a dismissal of all challenges to two patents related to expandable downhole tools.

Publications & Presentations

Publications

- *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.
- “How the Proposed Patent Fee Schedule Diminishes the Benefits of the AIA, and a Possible Solution,” *The Federal Lawyer*, September 2012.

Presentations

- “IP Due Diligence and Audits,” Carolina’s Patent, Trademark & Copyright Law Association - Fall Meeting, Kiawah, SC, September 23, 2016.

Professional & Community Engagement

- Intellectual Property Owners Association, Patent Office Practice Committee

Court Admissions

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

Accolades

- *Managing IP* – Rising Star (2020)
- *The Best Lawyers in America*® - “Ones to Watch” (2021-2022)

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

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