



6345 Balboa Boulevard  
Suite 312, Building I  
Encino, California 91316

**Edward F. O'Connor**

**t:** 949.291.2894

**f:** 818.332.4205

**e:** [efo@avynolaw.com](mailto:efo@avynolaw.com)



**Edward F. O'Connor**  
**Attorney**

Ed is a Martindale-Hubbell AV Preeminent rated attorney. The AV Preeminent rating is only awarded to 10% of the nation's lawyers.

He has completed over 30 years with the Martindale-Hubbell AV Preeminent rating. He also received a Martindale Hubbell AV rating from the judiciary. This means he has received the top rating for ability and integrity from both his fellow lawyers as well as from the many judges

before whom he has appeared.

In 2024 he was awarded both the "Superb Attorney" rating by Martindale - AVVO and acknowledged by the American Registry as being in the top 1% most honored lawyers in America.

Prior to law school, Ed obtained a degree in physics with a calculus minor from the University of Michigan. This combination of disciplines led him to become a federally registered patent lawyer.

On May 30, 2017, Ed succeeded in persuading the United States Supreme Court to reverse two long standing decisions of the Court of Appeals for the Federal Circuit. Those cases were *Jazz Photo Corp. v. International Trade Commission*, 264 F.3d 1094 (Fed. Cir. 2001) and *Mallinckrodt, Inc. v. Medipart, Inc.*, 976 F.2d 700 (Fed. Cir.1992). Ed's case was *Lexmark International, Inc. v. Impression Products, Inc.*, 137 S. Ct. 1523 (2017). This victory capped off Ed's ten-year crusade to overturn those two Federal Circuit decisions which Ed considered to be poison to remanufacturing industries worldwide, as well as terribly harmful to the environment. Ed is understandably proud of his accomplishment.

Ed previously represented Impression Products in this case in the en banc hearing before the Court of Appeals for the Federal Circuit. On September 7, 2015, the New York Times editorial board endorsed Ed's position.

As a direct result of this victory, Ed was awarded the prestigious Media Global Legal Defense Award, "Presented to an individual who provides a legal breakthrough or defense that advances the legitimacy of the aftermarket imaging supplies industry." This award was presented in Zhuhai, China by the

Recycling Times Media Corporation, an international organization for the worldwide advancement of recycling and refurbishing, particularly in the printing industry. This was Ed's second time receiving this award. He is the only lawyer to have received this award more than once.

This was Ed's second case before the United States Supreme Court. His first case was *Illinois Tool Works v. Independent Ink*, 126 S. Ct. 1281 (2006). O'Connor and his co-counsel Kathleen Sullivan, the former dean of Stanford Law School, represented Independent Ink, before the United States Supreme Court, in its antitrust case against Trident & Illinois Tool Works. The District Court had previously granted summary judgment to Defendants. The case was appealed to the United States Court of Appeals for the Federal Circuit (CAFC) by Ed. The CAFC reversed in favor of Independent Ink. *Independent Ink v. Illinois Tool Works*, (ITW) 396 F.3d 1342 (Fed. Cir. 2006). ITW obtained cert. from the Supreme Court. The Bush administration then joined with ITW in attempting to overthrow the doctrine of market power tying. While the Supreme Court reversed the doctrine of presumed market power in a patented product, in tying cases, it agreed with O'Connor that the presumption of market power over a tied product should remain intact if there is market power in the tying product. It rejected the Bush administration's position regarding the elimination of market power tying.

Ed presently serves as chair of Avyno's litigation department. His expansive career includes serving as a Public Defender in Palm Beach County, Florida; serving with Air Force J.A.G., where he wrote patent applications in computer technology, space exploration and advanced weapons systems; serving as "Senior Intellectual Property and Litigation Attorney" with Intel where he was responsible for managing Intel's litigation; and serving as patent and antitrust jury and appellate lawyer for Poms, Smith, Lande & Rose, at the time one of the oldest patent law firms in Los Angeles, California.

Prior to receiving his law degree from Indiana University Law School, Bloomington, he received his Bachelor of Science degree in physics with a calculus minor from the University of Michigan, Ann Arbor. In law school he was on the National Moot Court Team and he was elected by his classmates to be the first chairman of the Student Faculty Committee on Teaching.

Ed is an internationally recognized expert on intellectual property law, with a lecture circuit that includes New York, Los Angeles, Zurich, Dusseldorf, Rome, Prague, Shanghai, Zhuhai, Singapore, Jakarta, Barcelona and Mexico.

He is listed in the Los Angeles Times as one of the leading lawyers in Southern California and was listed in the San Diego Register as the only leading lawyer in both patent prosecution and intellectual property litigation.

In 2017, Ed was inducted into the Lawyers of Distinction, an organization whose membership is limited to the top 10% of lawyers nationwide.

In addition to representing clients in the United States Supreme Court, Ed has represented clients before the International Trade Commission and has won patent infringement, antitrust, and other intellectual property cases throughout the United States. He has won cases before the United States Courts of Appeal for the Federal Circuit, the Second Circuit, the Fourth Circuit, the Fifth Circuit, the Seventh Circuit, the Ninth Circuit, and the Eleventh Circuit. He has also served as lead attorney in complex cases before the Panel on Multidistrict Litigation.

Among the many clients he has represented in litigation are Kawasaki (antitrust, defense); Nike (patent, defense); Thermos (trade dress, defense); Bed Bath & Beyond (patent defense).

Ed is an internationally recognized expert on intellectual property law, with a lecture circuit that includes New York, Los Angeles, Zurich, Dusseldorf, Rome, Prague, Shanghai, Zhuhai, Singapore, Jakarta, Barcelona and Mexico. He is frequently used as a resource by the Intellectual Property Bar, and has authored three books on intellectual property law and litigation published by the American Bar Association.

He was designated by the American Bar Association, Intellectual Property Law Section, Special Committee on Litigation Planning and Budgeting, as an attorney “having significant patent litigation experience as identified by the managing partners of the approximately one hundred largest intellectual property law firms.”

Ed maintains a multitude of professional designations and affiliations. He is listed in Martindale Hubbell’s Bar Register of Preeminent Lawyers. He is a member of the Multi-Million Dollar Advocates Forum; (as a result of having obtained multi-million dollar jury Verdicts); Chairman Emeritus of the Intellectual Property Committee, Torts and Insurance Practice Section, for the American Bar Association; A Fellow of the Litigation Counsel of America; and has served on the Intellectual Property Advisory Board for Indiana University School of Law (Bloomington). He was a Practitioner in Residence guest lecturer at Indiana University School of Law. He was also a supervisor of the Student Extern Program at Yale University Law School.

Ed’s experience is not limited to intellectual property law and antitrust litigation. He was an assistant public defender in Palm Beach County. In fact, the first jury trial that Ed ever tried was providing the defense in an armed robbery case. He recently sued the United States Secretary of State in an immigration case. The case was filed in the Federal District Court in Washington DC. Within a few months after filing the case, the US attorney conceded the merits, and the plaintiff was allowed into the United States and granted a visa. He also sued the Commissioner of Immigration in the Federal District Court in Miami, Florida. Within weeks of that filing, the Govt. changed its position and granted Ed’s client citizenship, which had previously been denied.

Recently Ed obtained a jury verdict for his client in a defamation case he tried in San Diego. The judgement, which was entered in 2025, was in excess of a million dollars. Ed’s client had been terminated from his teaching position. The previous employer (school) had written a letter of discharge which allegedly contained false and defamatory statements. Ed relied on the seldom used legal doctrine of “compulsory self-publication.”

While a partner in his firm in Palm Beach, Florida, Ed practiced law in a multitude of areas. These included criminal law; real estate law; wills and estates; personal injury; workman's compensation; mechanics liens; eminent domain; family law; products liability; medical malpractice; dental malpractice; chiropractor malpractice; corporate law; contracts. In his real estate practice, he handled numerous multimillion dollar closings and represented not only individual purchasers and sellers of real estate, but also real estate developers. He provided all of the legal work for a shopping center (his own) as well as for condominium developments. He was a member of Lawyers Title Guarantee fund, upon which he wrote numerous real estate insurance policies.

Ed is fluent in written and spoken Spanish as a result of living in Mexico City for a number of years.

**Martindale Hubbell Rating: AV**

**Education:**

- B.S., Physics, Calculus Minor, University of Michigan, Ann Arbor, 1966
- J.D., Indiana University, Bloomington, 1969

**Bar Admissions:**

- Supreme Court of the United States of America
- California
- Florida
- U.S. Patent and Trademark Office

**Court Representations:**

- Supreme Court of the United States of America
- International Trade Commission
- U.S. Patent and Trademark Office
- U.S. Court of Appeals for the Federal Circuit
- U.S. Court of Appeals for the Second Circuit
- U.S. Court of Appeals for the Fourth Circuit
- U.S. Court of Appeals for the Seventh Circuit
- U.S. Court of Appeals for the Ninth Circuit
- U.S. Court of Appeals for the Eleventh Circuit
- U.S. District Court for the Southern District of Florida
- U.S. District Court for the Central District of California
- U.S. District Court for the Southern District of California
- U.S. District Court for the Eastern District of California
- U.S. District Court for the Northern District of California
- U.S. District Court for the District of New Jersey
- U.S. District Court for the Eastern District of Virginia
- U.S. District Court for the Southern District of Mississippi
- U.S. District Court for the Western District of Washington
- U.S. District Court for the Northern District of Ohio
- U.S. District Court for the Northern District of Illinois
- U.S. District Court for the District of Delaware

- U.S. District Court for the District of Minnesota
- U.S. District Court for the Eastern District of Texas
- U.S. District Court for the District of Connecticut
- U.S. District Court for the District of Oregon
- U.S. District Court for the District of New Hampshire
- U.S. District Court for the Eastern District of New York
- U.S. District Court for the District of Massachusetts
- U.S. District Court for the District of Nevada
- California Court of Appeals, Fourth District
- California Court of Appeals, Second District
- Florida Court of Appeals, Fourth District
- Superior Court of California, Orange County
- Superior Court of California, Los Angeles County
- Florida Circuit Court, Palm Beach County

**Selected Cases:**

- Lexmark v. Impression Products, 137 S. Ct. 1523 (2017). Convinced U.S. Supreme Court to overturn two Federal Circuit Decisions.

• Illinois Tool Works v. Independent Ink, 126 S. Ct. 1281 (2006). O'Connor represented Independent Ink, before the United States Supreme Court, in its antitrust case against Trident & Illinois Tool Works. The District Court had previously granted summary judgment to defendants. The case was appealed to the United States Court of Appeals for the Federal Circuit (CAFC). The CAFC reversed in favor of Independent Ink. Independent Ink v. Illinois Tool Works, 396 F.3d 1342 (Fed. Cir. 2006). The Supreme Court then reversed the doctrine of presumed market power in a patented product, in tying cases, but agreed with O'Connor that the presumption of market power over a tied product should remain intact if there is market power in the tying product, in the tying product market. Opposing Counsel: Sonnenschein Nath & Rosenthal; Mayer Brown; US Solicitor General.

• Systems Division, Inc. v. Teknek, 2003 U.S. App. Lexis 3288 (Fed. Cir. 2003). Obtained reversal of summary judgment against Plaintiffs. Obtained 3 million dollar jury verdict on trial after remand. Opposing Counsel: Mitchell Silberbug & Knupp.

• Scholle Corp. v. Packaging Systems, 2001 U.S. App. Lexis 11772 (Fed. Cir. 2001). Obtained reversal of summary judgment against Plaintiff. Opposing Counsel: Hanson Bridgett Marcus Vlahos and Rudy.

• Worldwide Home Products, Inc. v. Bed Bath & Beyond Inc., et al., (USDC SDNY Case No. 1:11-cv-03633(LTS)(MHD). Obtained summary judgment in favor of Defendants and a judgment against Plaintiff and its attorney for attorney fees of over \$800,000.

• Automative Products v. Tilton Engineering, Inc., 55 F.Supp. 1101 (C.D. Cal. 1994). Lead counsel in a complex patent infringement, anti-trust case, which resulted in a \$24,000,000.00 judgment for the client, including over \$3,000,000.00 in attorneys fees. In its decision, the Court stated on page 1114: (" . . . Patent and antitrust laws are not new or novel, but often involve factually difficult issues. Such was the case here. In the patent phase of the case, for example, Tilton [O'Connor] had to analyze the myriad of patent defenses raised by AP, including obviousness, best mode, indefiniteness, public use,

inequitable conduct, and noninfringement.”) “The trial judge should closely observe the attorney’s work product, his preparation, and general ability before the Court.” Tilton’s counsel, [O’Connor] demonstrated to this Court time and again that they had the requisite skill and ability to handle this complex lawsuit. Their written work product and performance before this Court have been uniformly good.” Opposing Counsel: Pepper Hamilton & Scheetz (Philadelphia); Lyon & Lyon; Crosby Heafey Roach & May; Finnegan, Henderson Farabow Garrett & Dunner.

- Hewlett-Packard Co. v. Repeat-O-Type Stencil Mfg. Corp, Inc., 123 F.3d 1445 (Fed. Cir. 1997). Obtained summary judgment against Hewlett-Packard of non-infringement based upon repair/reconstruction. Successfully defended on appeal. The case is one of the leading cases of the repair/reconstruction doctrine.

Opposing Counsel: Irell & Manella LLP; Townsend and Townsend and Crew LLP; Pennie & Edmonds.

- Martin Gardner Reiffin v. Microsoft Corporation, 214 F.3d 1915 (Fed. Cir. 2000). Wrote the appeal brief resulting in reversal of summary judgment previously obtained by Microsoft against Reiffen. One of the leading cases of the Gentry Gallery v. Berkline Corp., 134 F.3d 1973 (Fed. Cir. 1998) progeny of cases.

- St. Charles Mfg. Co. v. Mercer, 719 F.2d 380 (11th Cir. 1983). Obtained summary judgment against St. Charles and successfully defended the summary judgment on appeal. One of the leading cases on trademark infringement damages.

Opposing Counsel: Wallenstein, Wagner, Hattis, Strampel & Aubel

- The Beachcombers International, Inc. and Patrick McCarthy v. WildeWood Creative Products, Inc., 31 F.3d 1154 (Fed. Cir. 1994). Obtained a jury verdict of invalidity on behalf of WildeWood. Successfully defended the decision on appeal. One of the leading cases on the doctrine of on sale bar, established that sales by a person other than the patentee and unknown to the patentee, nonetheless constitute a statutory bar if such sales occurred more than a year before the filing of the application.

Opposing Counsel: William Brinks Olds Hofer Gilson; Lione Stevens and O’Connell.

- Abeshouse, dba Amity Products v. Ultragraphics, 754 F.2d 467 (2nd Cir. 1985). Obtained jury verdict in favor of plaintiff on a copyright infringement suit involving the Rubik’s Cube. Remanded on appeal for reduction of the jury verdict as the 2nd Circuit found that the verdict was excessive.

Opposing Counsel: Moller, Horton & Fineberg.

- Caddock Electronics v. Siemens Components, et al (USDC Eastern District of VA) (Patent Infringement; Antitrust).

Opposing Counsel: Howrey Simon Arnold & White LLP; Heller Ehrman LLP.

- PyMaH Corporation v. Propper Mfg. Co., Inc. (USDC Central District of CA) (Patent Infringement).

Opposing Counsel: Lyon & Lyon.

- Wynn Oil Company v. Prestone Products (USDC Central District of CA).

Opposing Counsel: Kirkland & Ellis.

- Scholle v. Blackhawk Molding (USDC Central District of CA) (Patent Infringement).

Opposing Counsel: Baker & McKenzie.

- Scholle v. Cap Snap Co. and Cap Snap Seal, Inc. (USDC Northern District of CA) (Patent Infringement).  
Opposing Counsel: Brobeck, Phleger & Harrison LLP.

- Oakley Inc. v. Nike Inc. (USDC Central District of CA) (Patent Infringement).  
Opposing Counsel: Knobbe Martens Olson & Bear LLP.

- Pacific Market Inc. v. Thermos LLC (USDC Western District of WA) (Trademark Infringement).  
Opposing Counsel: Dorsey & Whitney (WA).

- Mass Engineered Design v. Global Marketing Partners (USDC Eastern District of TX) (Patent Infringement).  
Opposing Counsel: Foley & Lardner (Chicago).

- Clayton Jacobson v. Kawasaki Heavy Ind. Ltd., Japan; Kawasaki Motors Corporation, USA; and Kawasaki Mfg., Corp., USA, (USDC Central District CA) (Antitrust).  
Opposing Counsel: Steven Markl Law Offices.

- Progressive Games, Inc. v. Bally's Grand, Inc., et al., CV No. 1209-NV-2-95-208, and related cases in District Courts in California, Nevada, Mississippi, and New Jersey as well as before the Judicial Panel on Multidistrict Litigation. Defended Shuffle Master, Inc. as well as most of the major U.S. casinos, including MGM Grand Hotel, Inc.; Las Vegas Hilton Corp.; Bally's Grand, Inc.; etc. Prevented issuance of preliminary injunction in Mississippi, as well as securing the dissolution of a preliminary injunction in New Jersey.  
Opposing Counsel: Reilly & Purcell P.C.

## **Published Works:**

### **Books**

- A Primer on Intellectual Property Law and Litigation, American Bar Association.
- Intellectual Property Law and Litigation, 2nd Edition, American Bar Association.
- Intellectual Property Law and Litigation: Practical and Irreverent Insights

The American Bar Association commented: "Fans of the irreverent Edward F. O'Connor will rejoice in the forthcoming new edition of his book, Intellectual Property Law and Litigation. O'Connor discusses the principles of IP law in the context of cases that he has actually tried or in which he has been involved, providing a real-world framework to make the principles easier to understand and remember. The book is written for intellectual property practitioners, including prosecutors and litigators, as well as in-house corporate counsel and people in business who may not actually practice intellectual property litigation but who employ intellectual property litigators.

In short, anyone who needs to be conversant with the fundamental principles and language of intellectual property law will benefit from—and enjoy—this book."

Ed's books are carried in many of the country's top law school libraries, including Yale, Cornell, University of Virginia, Indiana University Bloomington, University of Chicago, and many more, as well as in state and county law libraries across the country.

**Selected Articles**

- "The Interconnection and Interplay between Patent Infringement Litigation and Antitrust Litigation" (ALI-ABA publications)
- "Analyzing and Trying Intellectual Property Cases", The Practical Litigator (ALI-ABA publications)
- "Insurance Coverage and Duty to Defend in Antitrust, Trade Secret and Other Intellectual Property Litigation or Why My Insurance Agent is My Patent Lawyer's Best Friend", The Practicing Law Institute publications
- "A Practical Guide to Equitable Defenses in Patent Litigation", The Practicing Law Institute publications
- "The Pitfalls of Intellectual Property Litigation for Foreign Companies in U.S. Courts", U.S. Japan Intellectual Property Issues publications
- "Intellectual Property and the Recycling Industry", Recycler Publishing & Events, Great Britain