



EDWARD O'CONNOR

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Ed is a highly experienced patent and antitrust trial lawyer, as well as an experienced appellate lawyer and a U.S. Supreme Court lawyer.— He has been first chair in numerous jury trials, and has handled appeals in Federal appellate courts across the country, as well as state appellate courts in Fl. and Cal.

His appellate work includes briefing and oral argument in en banc proceeding before the Court of Appeals for the Federal Circuit. He has been counsel on the merits briefs in two United States Supreme Court cases.

Ed's background makes him a rarity in the legal profession. Patent litigation is almost always divided up — large firms hand their appeals to an appellate group, appellate specialists rarely try cases, and most registered patent attorneys never see a jury at all. Ed doesn't divide it. He is a registered patent lawyer who tries his own cases to verdict, argues his own appeals, and has twice been counsel on the merits briefs in cases in the United States Supreme Court , which resulted in the reversal of long term precedents.

The Supreme Court

On May 30, 2017, Ed made U.S. Supreme Court history. He was counsel on the merits briefs in the first case in which the United States Supreme Court, in a single case, overturned two separate long-standing decisions of any appellate court — two distinct questions, decided by two different majorities. No other case has been found in which the Court has done so.

(Sources: *Impression Products, Inc. v. Lexmark International, Inc.*, 581 U.S. 360 (2017); *Lexmark International, Inc. v. Impression Products, Inc.*, 816 F.3d 721 (Fed. Cir. 2016) (en banc); Ropes & Gray, *Supreme Court Holds That Patent Exhaustion Applies to All Sales, Domestic and International* (June 1, 2017) (“The Supreme Court overruled both lines of Federal Circuit precedent”); Perkins Coie, *First Impressions: New Strategies in the New Era of Patent Exhaustion* (“*Mallinckrodt* and *Jazz Photo* are no longer good law”); McDonnell Boehnen Hulbert & Berghoff, *Patent Exhaustion: Supreme Court Expands Patent-Limiting Doctrine* (the “now-overruled” *Mallinckrodt* and “now also overruled” *Jazz Photo*); Taft Stettinius & Hollister (8-0 on domestic exhaustion, 7-1 on international, Justice Gorsuch not participating).)

The case was *Impression Products, Inc. v. Lexmark International, Inc.*, 581 U.S. 360 (2017). The decisions overturned were *Mallinckrodt, Inc. v. Medipart, Inc.*, 976 F.2d 700 (Fed. Cir. 1992), and *Jazz Photo Corp. v. International Trade Commission*, 264 F.3d 1094 (Fed. Cir. 2001).

Ed represented Impression Products at every stage — the district court, the Federal Circuit panel, the Federal Circuit sitting en banc, where he argued the case, and the Supreme Court. In February 2016 the en banc Federal Circuit reaffirmed both precedents by a vote of 10-2. Fifteen months later the Supreme Court reversed on both questions: 8-0 on domestic exhaustion and 7-1 on sales abroad, Justice Gorsuch taking no part.

This victory capped Ed's ten-year crusade to overturn two Federal Circuit decisions he considered poison to remanufacturing industries worldwide and terribly harmful to the environment. On September 7, 2015, the editorial board of the *New York Times* endorsed his position.

As a direct result, Ed received the 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" — presented in Zhuhai, China by Recycling Times Media Corporation. It was his second time receiving the award; he is the only lawyer to have received it more than once.

Ed's first Supreme Court case was *Illinois Tool Works Inc. v. Independent Ink, Inc.*, 547 U.S. 28 (2006).

With co-counsel Kathleen Sullivan, former dean of Stanford Law School, he represented Independent Ink in its antitrust case against Trident and Illinois Tool Works.

The district court granted summary judgment to the defendants. Ed took the appeal, and the Federal Circuit reversed in Independent Ink's favor. *Independent Ink v. Illinois Tool Works*, 396 F.3d 1342 (Fed. Cir. 2005). Illinois Tool Works obtained certiorari, and the Solicitor General joined it in urging the Court to dismantle market power tying doctrine altogether.

The Court declined. While it held that a patent does not by itself establish market power in the tying product — the plaintiff must prove it — it rejected the government's broader position and left tying doctrine intact. The case was returned to the district court for further proceedings.

Background

Prior to law school, Ed earned a degree in physics with a calculus minor from the University of Michigan, Ann Arbor. His senior research project developed a radial density distribution formula for pi-meson particle showers resulting from proton-proton collisions in the lower stratosphere. That combination of disciplines led him to become a federally registered patent lawyer.

He received his law degree from Indiana University, Bloomington, where he served on the National Moot Court Team and was elected by his classmates as the first chairman of the Student Faculty Committee on Teaching.

Ed presently serves as chair of Avyno's litigation department. His career includes service as a Public Defender in Palm Beach County, Florida; with the Air Force Judge Advocate General's Corps, where he wrote patent applications in computer technology, space exploration, and advanced weapons systems at the civilian equivalent rank of major; as Senior Intellectual Property and Litigation Attorney with Intel, responsible for managing Intel's litigation; and as patent and antitrust jury and appellate lawyer with Poms, Smith, Lande & Rose, then one of the oldest patent law firms in Los Angeles.

Recognition

Ed is a Martindale-Hubbell AV Preeminent rated attorney, a rating awarded to 10% of the nation's lawyers, and has held it for over 30 years. He also holds a Martindale-Hubbell AV rating from the judiciary — the top rating for ability and integrity from both his fellow lawyers and the judges before whom he has appeared.

In 2024 he received the "Superb Attorney" rating from Martindale-AVVO and was recognized by the American Registry as among the top 1% most honored lawyers in America. In 2017 he was inducted into Lawyers of Distinction, whose membership is limited to the top 10% of lawyers nationwide.

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.

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 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, American Bar Association; and a Fellow of the Litigation Counsel of America. He has served on the Intellectual Property Advisory Board for Indiana University School of Law (Bloomington), was a Practitioner in Residence guest lecturer there, and supervised the Student Extern Program at Yale Law School.

Trial and Appellate Practice

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

Clients he has represented in litigation include Kawasaki (antitrust, defense), Nike (patent, defense), Thermos (trade dress, defense), and Bed Bath & Beyond (patent, defense).

Ed is an internationally recognized expert on intellectual property law, with a lecture circuit that has included 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.

Beyond Intellectual Property

Ed's practice has never been limited to intellectual property and antitrust. He began as an assistant public defender in Palm Beach County — the first jury trial he ever tried was defending an armed robbery case.

He continues to try cases. In December 2024 he obtained a jury verdict in a defamation case tried in San Diego, with judgment entered in excess of one million dollars; his client had been terminated from a teaching position by a letter of discharge containing false and defamatory statements, and Ed relied on the seldom-used doctrine of compulsory self-publication. He is trying a multi-million-dollar medical malpractice case in January 2027.

He also maintains a pro bono practice in immigration appeals and habeas corpus. He sued the United States Secretary of State in an immigration case filed in the federal district court in Washington, D.C.; within a few months the U.S. Attorney conceded the merits and the plaintiff was admitted to the United States and granted a visa. He sued the Commissioner of Immigration in the federal district court in

Miami; within weeks the government reversed its position and granted his client citizenship, which had previously been denied. Recently he has won a number of habeas corpus cases on behalf of incarcerated immigrants.

As a partner in his firm in Palm Beach, Florida, Ed practiced in criminal law, real estate, wills and estates, personal injury, workers' compensation, mechanics liens, eminent domain, family law, product liability, medical and dental malpractice, corporate law, and contracts. In his real estate practice he handled numerous multimillion-dollar closings, representing individual buyers and sellers as well as developers, and provided all legal work for a shopping center and for condominium developments. He was a member of the Lawyers Title Guarantee Fund, for which he wrote numerous title insurance policies.

Ed is fluent in written and spoken Spanish, having lived 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

California

Florida

U.S. Patent and Trademark Office

Designations

Supreme Court of the United States

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 Fifth 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 Appeal, Fourth District
California Court of Appeal, Second District
Florida Court of Appeal, Fourth District
Superior Court of California, Orange County
Superior Court of California, Los Angeles County
Florida Circuit Court, Palm Beach County

Selected Cases

Impression Products, Inc. v. Lexmark International, Inc., 581 U.S. 360 (2017). Represented Impression Products from the district court through the Federal Circuit panel, the Federal Circuit en banc, and the Supreme Court. The en banc Federal Circuit reaffirmed *Mallinckrodt* and *Jazz Photo* 10-2; the Supreme Court reversed on both questions, 8-0 and 7-1, overturning both Federal Circuit decisions.

Opposing Counsel: Latham & Watkins. [VERIFY — this entry previously listed no opposing counsel; confirm or delete]

Illinois Tool Works Inc. v. Independent Ink, Inc., 547 U.S. 28 (2006). Represented Independent Ink before the United States Supreme Court in its antitrust case against Trident and Illinois Tool Works. The district court had granted summary judgment to defendants. On appeal, the Federal Circuit reversed in favor of Independent Ink. *Independent Ink v. Illinois Tool Works*, 396 F.3d 1342 (Fed. Cir. 2005). The Supreme Court held that a patent does not by itself establish market power in a tying case, but rejected the Solicitor General's broader position urging the elimination of market power tying doctrine, and remanded for further proceedings.

Opposing Counsel: Sonnenschein Nath & Rosenthal; Mayer Brown; U.S. 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 jury verdict at trial after remand.

Opposing Counsel: Mitchell Silberberg & 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 & Rudy.

Worldwide Home Products, Inc. v. Bed Bath & Beyond Inc., No. 1:11-cv-03633 (LTS)(MHD) (S.D.N.Y.). Obtained summary judgment in favor of defendants and a judgment against plaintiff and its attorney for attorney fees of over \$800,000.

Automotive Products plc v. Tilton Engineering, Inc., 855 F. Supp. 1101 (C.D. Cal. 1994). Lead counsel in a complex patent infringement and antitrust case resulting in a \$24,000,000 judgment for the client, including over \$3,000,000 in attorneys' fees. The court stated at 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 had to analyze the myriad of patent defenses raised by AP, including obviousness, best mode, indefiniteness, public use, inequitable conduct, and noninfringement. . . . Tilton's counsel 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., 123 F.3d 1445 (Fed. Cir. 1997). Obtained summary judgment against Hewlett-Packard of non-infringement based on repair/reconstruction, and successfully defended it on appeal. One of the leading cases on the repair/reconstruction doctrine.

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

Reiffin v. Microsoft Corp., 214 F.3d 1342 (Fed. Cir. 2000). Wrote the appeal brief resulting in reversal of summary judgment previously obtained by Microsoft against Reiffin. One of the leading cases in the *Gentry Gallery v. Berkline Corp.*, 134 F.3d 1473 (Fed. Cir. 1998) line of cases.

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

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

The Beachcombers International, Inc. v. WildeWood Creative Products, Inc., 31 F.3d 1154 (Fed. Cir. 1994). Obtained a jury verdict of invalidity on behalf of WildeWood and successfully defended it on appeal. One of the leading cases on the on-sale bar, establishing that sales by a person other than the patentee, and unknown to the patentee, nonetheless constitute a statutory bar if made more than a year before the application was filed.

Opposing Counsel: William Brinks Olds Hofer Gilson & Lionie; Stevens & O'Connell. [VERIFY — the original ran two firm names together]

Abeshouse v. Ultragraphics, 754 F.2d 467 (2d Cir. 1985). Obtained a jury verdict for plaintiff in a copyright infringement suit involving the Rubik's Cube. Remanded on appeal for reduction of the verdict, which the Second Circuit found excessive.

Opposing Counsel: Moller, Horton & Fineberg.

Caddock Electronics v. Siemens Components (E.D. Va.) (patent infringement; antitrust).

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

PyMaH Corp. v. Propper Mfg. Co. (C.D. Cal.) (patent infringement).

Opposing Counsel: Lyon & Lyon.

Wynn Oil Co. v. Prestone Products (C.D. Cal.).

Opposing Counsel: Kirkland & Ellis.

Scholle v. Blackhawk Molding (C.D. Cal.) (patent infringement).

Opposing Counsel: Baker & McKenzie.

Scholle v. Cap Snap Co. (N.D. Cal.) (patent infringement).

Opposing Counsel: Brobeck, Phleger & Harrison LLP.

Oakley Inc. v. Nike Inc. (C.D. Cal.) (patent infringement).

Opposing Counsel: Knobbe Martens Olson & Bear LLP.

Pacific Market Inc. v. Thermos LLC (W.D. Wash.) (trademark infringement).

Opposing Counsel: Dorsey & Whitney.

Mass Engineered Design v. Global Marketing Partners (E.D. Tex.) (patent infringement).

Opposing Counsel: Foley & Lardner (Chicago).

Clayton Jacobson v. Kawasaki Heavy Industries Ltd. (C.D. Cal.) (antitrust).

Opposing Counsel: Steven Markl Law Offices.

Progressive Games, Inc. v. Bally's Grand, Inc., No. CV 1209-NV-2-95-208, and related cases in California, Nevada, Mississippi, and New Jersey, and before the Judicial Panel on Multidistrict Litigation. Defended Shuffle Master, Inc. and most of the major U.S. casinos, including MGM Grand Hotel, Las Vegas Hilton, and Bally's Grand. Prevented issuance of a preliminary injunction in Mississippi and secured dissolution of a preliminary injunction in New Jersey.

Opposing Counsel: Reilly & Purcell P.C.

Published Works

A Primer on Intellectual Property Law and Litigation, American Bar Association.

Intellectual Property Law and Litigation, 2d ed., 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. . . . 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, the University of Virginia, Indiana University Bloomington, and the University of Chicago, 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

"Analyzing and Trying Intellectual Property Cases," *The Practical Litigator*, ALI-ABA

"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," Practising Law Institute

"A Practical Guide to Equitable Defenses in Patent Litigation," Practising Law Institute

"The Pitfalls of Intellectual Property Litigation for Foreign Companies in U.S. Courts," *U.S.-Japan Intellectual Property Issues*

"Intellectual Property and the Recycling Industry," Recycler Publishing & Events, Great Britain
