

Snell & Wilmer



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Main Bio

Ketan Vakil is the managing partner of Snell & Wilmer's Orange County office and co-chair of the firm's intellectual property group. He counsels clients on matters related to intellectual property protection, litigation, counseling, and licensing including the procurement and litigation of patents, trademarks, copyrights and trade secrets. He has significant experience in preparing and prosecuting patents and trademarks, evaluating prior art for patentability, infringement and validity, preparing infringement and validity opinions, and counseling clients on intellectual property strategies, development, licensing and infringement. He is also lead counsel on several Inter Partes Review (IPR) Proceedings before the Patent Trial and Appeal Board.

Ketan's apparel and footwear experience includes sandals, skateboard shoes, dress shoes, high-heeled shoes, shorts, jackets, backpacks, skateboards, snowboards and outdoor sports equipment. Ketan also has experience in the areas of construction, equipment and tools, mechanical devices, toothbrushes, chemical compositions and formulations, bottles, connectors and automobile accessories.

Ketan's electrical engineering and software design experience includes computer architecture, memories and software, semiconductor devices, processes and machinery, network systems, storage and security, image and signal processing, electrical circuits, telecommunications devices, aircraft systems and medical devices.

Representative Transactions

Representative Transactional Experience

- Responsible for building the patent portfolio of a Fortune 500 medical device company. Within a four-year period of time, Ketan and his team drafted and prosecuted over 200 patents related to electronically and mechanically controlled implantable medical devices. We also prepared non-infringement, invalidity and freedom-to-operate opinions for this medical device company. The patents and business unit were sold for over \$75 million to a private equity group.
- Serves as the lead IP partner for drafting and obtaining cutting edge patents for hybrid automobile technology for a top automotive company. Continues to manage their patent portfolio of over 200 patents and has drafted and obtained key patents that are infringed and licensed by a competing automotive company
- Prepared and prosecuted over 100 patents for leading wireless company related to peer-to-peer networks, telecommunications devices, image and signal processing, software methods and

processes, communications protocols and electrical circuits

- Prepared and obtained over 25 patents related to critical care monitoring devices for a large medical device company
- Drafted and obtained leading and key patents and trademarks for a leading consumer dental products company. Also helped draft and negotiate agreements with large retail suppliers and distributors
- Lead outside patent counsel for a UK-based international company with 10 wholly-owned US subsidiaries. Responsibilities include driving innovation and the patent process for all 10 subsidiaries. The patent portfolio includes over 100 patents related to electronic and medical devices
- Prepared and obtained 12 patents in the field of LED televisions for a small start-up optics company. After obtaining these broad patents related to LED televisions, the patent portfolio was sold to an optics company for \$12 million
- Analyzed competitors' patents and prepared freedom-to-operate opinion for powered prosthetics devices
- Analyzed competitors' patents and prepared freedom-to-operate, non-infringement and invalidity opinions for electronic chip testing devices
- Analyzed patent landscape and prepared freedom-to-operate opinion for guidance devices for the visually and hearing impaired
- Analyzed patent landscape and prepared freedom-to-operate opinion for cases for tablet devices

Representative Litigation Experience

- Represented medical connector company in design patent infringement action involving connectors for medical devices
- Represented medical device prosthetics company in patent infringement action involving prosthetics device for lower limbs
- Represented oral care dental company in patent infringement actions involving dental kits, electronic toothbrushes and mouthwashes
- Represented consumer products company in patent infringement actions involving car chargers, phone and tablet cases, screen protectors and display packaging
- Represented electronic storage company in patent infringement action involving remote storage of electronic data
- Represented dynamic random access memory (DRAM) company in patent infringement action involving 21 patents related to DRAM devices against a major competitor

Education

- University of Florida Levin College of Law (J.D., 1996)
- Franklin Pierce Law Center (Master of Intellectual Property Law, 1995)
- University of Florida (M.E., Electrical Engineering, 1992)
- Vanderbilt University (B.E., Electrical Engineering, magna cum laude, 1990)

Professional Memberships & Activities

- American Bar Association
- American Intellectual Property Law Association

- Orange County Bar Association
- Association of University Technology Managers

Representative Presentations & Publications

- "[Five Practical Tips to Avoid Willful Infringement After Halo](#)," Co-Author, Orange County Business Journal (July 23, 2018)
- "[Amendments to Rights of Federally Funded Inventions and Government Owned Inventions](#)," Co-Author, Snell & Wilmer Legal Alert (April 23, 2018)
- "Developing and Protecting Your Company's IP Portfolio," Speaker and Panel Moderator, Colorado BioScience Association (CBSA) Annual Medical Device Symposium, Broomfield, CO (January 24, 2017)
- "[New Supreme Court Ruling Kills Vague Patents](#)," Co-Author, Orange County Business Journal (June 30, 2014)
- "Clinic in a BoxSM Program" (Training Program for Non-profit Entity Intake – IP Issues), Presenter, ACC-SoCal, Public Law Center, Corporate Pro Bono (February 5, 2014)
- "U.S. and California Supreme Court Game-Changing Cases of 2012 and Beyond: How Will They Impact Your Business?," Speaker, Roundtable Presentation, Snell & Wilmer, Costa Mesa, CA (February 26, 2013)
- "[Patent Reform Act: Implications For Your Business](#)," Co-Author, Orange County Business Journal (July 9, 2012)
- "Double Patenting – Basics, Updates and Best Practices," Co-Presenter, CLE Seminar for In-House Pharmaceutical Legal Department (June 2012)
- "U.S. and California Supreme Court Game-Changing Cases of 2011 and Beyond: How Will They Impact Your Business?," Speaker, Roundtable Presentation, Snell & Wilmer, Costa Mesa, CA (April 2012)
- "Washington in the West Conference," Speaker, sponsored by Los Angeles Intellectual Property Law Association (February 14, 2012)
- "[Building a Strong Patent Portfolio - Five Tips to Stay Ahead of the Game](#)," Author, Orange County Business Journal (July 11, 2011)
- "Patent Litigation: The New Normal, Panelist, Be On Your Offensive Game: Managing Intellectual Property Litigation Costs With a Team Approach," Association of Corporate Counsel SoCal, Long Beach, CA (June 2011)
- "Faster Pace at U.S. Patent Office Seen as Boost for IP," Author, Orange County Business Journal (January 23, 2011)
- "Recent California Decision Reinforces Need for Drafting High Quality Patents," Author, Los Angeles Intellectual Property Law Association (March 2005)
- "Outsourcing Technology Overseas? Ten Tips to Help Safeguard Your Intellectual Property," Author, Orange County Business Journal (August 9, 2004)
- "Safeguarding IP Overseas," Author, California Lawyer Magazine (June 2004)

Professional Recognition & Awards

- Southern California Super Lawyers®, Rising Stars Edition, Intellectual Property (2006-2007)

Other Professional Experience

- Stout Uxa Buyan & Mullins LLP, Associate
- Sheppard Mullin Richter & Hampton LLP, Associate
- Townsend and Townsend and Crew LLP, Associate

Bar Admissions

- California
- United States Patent and Trademark Office

Court Admissions

- Supreme Court of California
- United States District Court, Central District of California
- United States District Court, Northern District of California
- United States Court of Appeals, Federal Circuit