



## Michael J. Thomas Partner

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### Practice Areas

Complex Business Litigation | Employment Litigation | Food & Agriculture Litigation | Intellectual Property & Licensing | Intellectual Property Litigation | Privacy & Data Integrity | Products Liability

Mike Thomas is one of a few registered patent attorneys based in Sacramento with a law practice focused on intellectual property litigation, including prosecuting and defending claims involving patents, copyrights, trademarks, and trade secrets.

Mike has handled cases in federal and state courts from coast to coast, and has served as lead counsel in a wide variety of technology centric cases from cutting-edge computer software to food processing methods and equipment.

Mike first developed an interest in intellectual property law over 25 years ago while working as a practicing design engineer in Sunnyvale, California, the heart of Silicon Valley. With his science and engineering background, Mike is unique in his ability to understand and convey technical details to clients in a concise and comprehensive manner. Mike also manages Downey Brand's domestic and international trademark practice – appearing regularly before the United States Patent and Trademark Office registering, managing and protecting many hundreds of trademarks for a variety of clients from multi-billion-dollar corporations to closely-held family businesses.

Mike has scored a number of significant legal victories. Just last year, Mike was a key member of Downey Brand's team representing Sierra Pacific Industries in its defense of a claim asserted by the California Attorney General. Mike was deeply involved in all aspects of the case including a multi-day pre-trial argument that led to dismissal of all claims, and an award of \$32.4 million to defendants. [Read media coverage on the Moonlight Fire Litigation here.](#)

The year before, in federal court in Sacramento, Mike represented an industry leading software provider in a case involving a competitor's infringement of computer software copyrights and trade secret misappropriation. Mike obtained an order imposing extraordinary sanctions against the competing software company, which ultimately yielded a seven figure recovery for his client.

His practice is not limited to intellectual property litigation; he also enjoys representing clients in complex litigation and commercial disputes ranging from wildland fire origin and cause litigation to product defect claims. Mike has earned the reputation as a formidable litigator who is focused on protecting his client's interests.

## Experience

- Mike was a member of the Downey Brand team representing Sierra Pacific Industries in its defense of claims arising out of the Moonlight Fire, which burned nearly 100 square miles of forest land. Mike was deeply involved in all aspects of the case from discovery through pretrial arguments that resulted in the state court's dismissal of all claims. The case has garnered national attention in the Wall Street Journal, L.A. Times and the Sacramento Bee and an award of \$32.4 million to defendants. [Read media coverage on the Moonlight Fire Litigation here.](#)
- Represented large supplier of mobile phone accessories in a federal court action alleging infringement of a utility patent, design patent, and alleged product trade dress. After filing dispositive motions on key claims, the action settled promptly on favorable terms for our client.
- Represented one of the nation's leading dried fruit processors in an action alleging infringement of various food processing patents. Obtained favorable claim constructions of key patent claim terms, which provided the foundation for the granting of summary judgment on all claims. Ultimately, after the case returned to the district court following appeal to the Court of Appeals for the Federal Circuit, the action settled on extremely favorable terms for client.
- Successfully represented one of the nation's largest credit union in the United States in a patent infringement dispute concerning client's patented apparatus and method for automatic credit evaluation and loan processing used in connection with car dealer transactions. By forcefully pursuing our client's patent rights, we obtained a successful resolution, in the form of a multimillion dollar sale of the patent to one of its licensees.
- Currently represents this same financial institution in the periodic inflow of patent infringement claims by "non-practicing entities" purporting to have patents on various transactional processes allegedly used by our client.
- Represented a leading developer and vendor of metadata cleaning software in a patent suit brought by a direct competitor, which was alleged to have infringed our client's method and apparatus patent claims pertaining to the software. We have successfully emerged from the claim construction proceedings (which involved extensive briefing and oral argument) wherein *ten out of ten* of our proffered claim constructions were adopted by the Court, and *none* of the competing claim constructions proffered by our opponent (which is represented by a large international law firm) were adopted by the Court. Ultimately, the case resolved on favorable terms with the alleged infringer agreeing to pay royalties going forward.
- Represented the owner and licensor of a patented method and apparatus (and associated trade secrets and know-how) used in California's tomato processing industry for the past fifteen years. One case involved the prosecution of contested claims of patent infringement. Through our strategic efforts, we have successfully secured millions of dollars in royalties over the past decade. We also helped steer our client through a challenge to its patent via a reexamination process initiated by a licensee, and emerged with a patent *stronger* than it had been.
- Lead counsel for AtPac, Inc., a leading supplier of database software used by Clerk-Recorder offices throughout California, in a bet-the-company suit against its direct competitor for copyright infringement and trade secret misappropriation concerning AtPac's proprietary source code. When AtPac filed suit against its much larger competitor and a governmental entity, Defendants hired intellectual property specialists from Los Angeles to handle the defense opposite our team. Through tenacious discovery efforts, Mike oversaw a team that uncovered key evidence of defendants' malfeasance, and demonstrated that defendants had failed to comply with their discovery obligations and had destroyed evidence of their wrongdoing. Through strategic advocacy, Mike obtained substantial monetary sanctions against the defendants and their

counsel, and a critical order requiring that the jury would be instructed on the adverse inference arising from Defendants' destruction of evidence. With the benefit of these hard fought rulings, we secured a \$1.9 million settlement for AtPac, Inc. before trial.

- Lead counsel for therapeutic seat manufacturer Eagle Advanced System Engineering, in a patent infringement action filed in federal court in Sacramento by competitor SenTech Medical Systems. Won case by demonstrating non-infringement and obtaining complete dismissal of all claims following briefing on claim construction. Obtained covenant from SenTech never to sue client over products in dispute and reimbursement of a portion of client's legal fees and costs.
- Served as lead counsel representing a laptop power supply distributor in a design patent infringement suit by a leading computer and mobile device manufacturer. Case resolved favorably for client, after we exploited the fact that plaintiff did not mark its competing products with the pertinent U.S. patent numbers, thus drastically minimizing available damages under U.S. patent law.
- Defended leading toner cartridge wholesaler Printer Essentials.com, Inc. and others against claims of patent infringement by Lexmark. In two separate jurisdictions, Lexmark subpoenaed our clients in an effort to develop evidence of patent infringement to support its efforts to join our clients to an action already pending in federal court against other suppliers. We successfully moved to quash both subpoenas as overbroad and seeking irrelevant information. After winning in both jurisdictions, Lexmark then dropped its efforts, and has made no further claims of infringement.
- Defended large distributor of golf products in an action alleging infringement of a patent for certain magnetic golf putter head covers. Secured total vindication for our client. After our client was sued, we conducted a thorough examination and developed evidence invalidating the patent and demonstrating our client's product did not infringe. Plaintiff reluctantly dismissed the case when presented with the results of our investigation and analysis.
- Also on the copyright front, Mike represented a joint author of a copyrighted series of training videos used by a major university for various special education teaching certifications offered to teachers throughout the State of California. Our client came to us for help when she received a demand from the heirs of her co-author for a share of her licensing profits. We successfully defended that claim, allowing our client to retain all proceeds. We then analyzed the arrangement with the university, and determined that our client was, in fact, entitled to a much larger share of the university's profits under U.S. copyright law. As a result, we obtained an approximately \$800,000 cash payment for our client, an unexpected life changing amount for a special needs school teacher.
- Represented auto dealership purchaser in prosecuting an action for fraud and breach of contract against the seller of the dealership. Through our dogged efforts and deposition techniques, we were able develop evidence showing that defendant/seller had failed to disclose material restrictions on the use of the property, and obtained a \$3 million recovery/settlement for our clients, which accounted for the difference in value of the property in view of the use restrictions plus the bulk of the attorney fees and costs in prosecuting the action.
- Worked with a team of Downey Brand attorneys representing a leading provider of medical care for spine and nerve disorders in an action against a medical billing service provider. Prepared briefing for, and argued, key pretrial motion in which the Court reduced what had been the billing service provider's claim for over 1/2 half million dollars, to no more than \$1 dollar.
- Represented Agilent Technologies in an action alleging wrongful termination by an employee released in a companywide reduction in force (RIF) along with some 19,000 other employees. The action involved claims

brought under Labor Code § 1102.5 by an employee alleging retaliation for reporting alleged workplace safety violations. Developed a wealth of evidence on our client's behalf establishing the employee's prior misconduct that would have justified termination for cause, and which disproved any claims of health and safety violations or retaliation. Through our tenacious and creative defense of the action, our team was able to develop critical evidence after discovering a marriage dissolution filing by plaintiff's spouse, and working with her to develop evidence which refuted much of plaintiff's sworn testimony. The action settled on terms extremely favorable to Agilent.

- Mike also manages Downey Brand's domestic and international trademark practice – appearing regularly before the United States Patent and Trademark Office registering, managing and protecting many hundreds of trademarks for a variety of clients from multi-billion-dollar corporations to closely-held family businesses. He helps protect clients' interests in a broad range of industries including advertising, agriculture, food producers, apparel, wineries, grocers, gaming, software and trade organizations.

## Professional & Community Service

- American Society of Mechanical Engineers
- Federal Bar Association
- Sacramento County Bar Association, IP Section
- Aerospace Museum of California, Board of Directors
- Eureka Schools Foundation, Former Board Member
- Intellectual Property Section, Sacramento County Bar Association, Former Board Member
- California State Bar's Standing Committee on Trademarks, Former Co-Chair
- University of the Pacific, McGeorge School of Law, Former Patent Law Adjunct Professor

## Education

- J.D., University of California, Hastings College of the Law, 1994
- B.S.M.E., California Polytechnic State University, San Luis Obispo, 1989

## Honors & Rankings

- *Sacramento Magazine*, Top Lawyer, Anti-Trust, Intellectual Property, Intellectual Property Litigation, Patent Litigation, Trade Secrets, Business Litigation, Commercial Litigation, 2015-2020
- Best Lawyers in America<sup>®</sup>, Commercial Finance Law, 2020-2021
- Extern, Hon. Ronald M. Whyte, United States District Court, Northern District of California
- *Hastings Law Journal*, Articles Editor
- American Jurisprudence Award, Legal Writing

## Speaking Engagements / Events

- *Protecting Intellectual Property*, Presenter, Metro Chamber 2016 Seminar Series, November 10, 2016