



# Intellectual Property, Corporate Law, and Civil Litigation

Bar Affiliations: DC, NY, PA & USPTO

## The Law Offices of Louis M. Heidelberger Esquire LLC

Pennsylvania and New York



### Bar Admissions

- District of Columbia
- New York
- Pennsylvania
- United States Patent and Trademark Office

### Education

- Temple University School of Law J.D.
- Drexel University B.S.

### Industry Sectors

- Energy & Utilities
- Health Care & Life Sciences
- Insurance
- Media & Entertainment
- Venture Capital/Private Equity

### Court Admissions

- U.S. Court of Appeals for the Federal Circuit
- U.S. Court of Appeals for the Ninth Circuit
- U.S. Court of Appeals for the Third Circuit
- U.S. District Court - Arizona
- U.S. District Courts - Northern, Central, Southern Districts of California.
- U.S. District Court - Delaware
- U.S. District Courts -- Eastern, Middle, Western Districts of Pennsylvania
- U.S. District Court -- Idaho
- U.S. District Court New Jersey
- U.S. District Court -- Northern District of Georgia
- U.S. District Court -- Northern District of Illinois
- U.S. District Courts - Southern, Northern Districts of New York
- U.S. District Courts -- Middle, Western Districts of North Carolina
- U.S. District Courts -- Eastern, Western Districts of Texas

### Affiliations

- American Intellectual Property Association
- International Trademark Association

Louis represents clients in a variety of areas, including litigation, counseling, opinions, due diligence, licensing and transactions, prosecution, patent IPRs, PGRs, reissue and reexamination; his experience includes counseling and litigating commercial business matters, patent, SSO, SEP/FRAND, trademark, anti-counterfeiting and copyright matters, as well as licenses, unfair competition, and trade secret matters.

Louis has extensive experience assisting clients in communications, telecommunications, digital television, stock and option exchanges, technology, medical, biotechnology, pharmaceuticals, security, gaming, insurance, packaging, advanced materials, software and software systems, health care, power generation, luxury goods, food and diet, entertainment, and fashion industries. Additionally, Louis has led patent portfolio development and monetization standards, licensing and litigation matters resulting in hundred of millions of dollars for his clients.

Louis has been honored on a number of occasions for his contributions to the legal profession. He has been named Best Lawyer in Intellectual Property every year since 1999, and Best Lawyer in the Bay Area in Intellectual Property from 2003 to 2005. He is listed in Chambers as Leading Lawyer in IP, was named a Super Lawyer in both Washington D.C. and Pennsylvania, and is listed in the top 250 worldwide lawyers in IAM's leading Intellectual Property licensing and trademark attorney listings. In 2011, he was elected a member of The Cosmos Club.

Louis received his bachelor's degree in metallurgical engineering from Drexel University. He earned his J.D. from Temple University Beasley School of Law. He is a registered patent attorney with the U.S. Patent Trademark Office.

### Contact Info

FOR A FREE CONSULTATION

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### Areas of Practice

*Intellectual Property Litigation*

*Intellectual Property Law*

*General Civil Litigation*

*Corporate Law*

# Experience

Louis Heidelberger represented a major communications company for over 20 years in connection with its litigation, licensing, opinion, and patent portfolio development matters including regarding relevant standards, the company's algorithms, software, software systems, microchips, firmware, hardware and telecom infrastructure and handsets.

Louis Heidelberger represented healthcare systems in connection with the institution of programs, employment policies/manuals/agreements to incentivize employees in the development of grants, technology, patented inventions and their monetization. He set up assessment and compliance systems as well as audit systems and assisted in M&A transactions.

Louis Heidelberger represented various financial service companies, including an international stock and option exchange company in intellectual property matters and the development of its patent portfolio for licensing and enforcement purposes, and a mortgage company in connection with software development projects and systems including the automation of web-based mortgage application and approval systems and attendant contractual negotiations, patent, trade secret, and copyright protection and development of patent portfolios and attendant enforcement proceedings.

Louis Heidelberger represented an individual and his companies in the acquisition of patent portfolios and the set up of companies to hold and monetize the portfolios including the corporate structuring, licensing, patent portfolio development, and litigation of the patent portfolios, generally against multiple defendants.

Louis Heidelberger represented owners of standard essential patents for the digital television industry.

Louis Heidelberger represented Family Offices in connection with development of substantial domestic and international real estate portfolios.

Louis Heidelberger represented a web-based interactive learning and learning management company in connection with the development of its systems, its branding, trade secret protection, patent and IP portfolio development, and domestic and cross-border co-development and licensing matters. Handled enforcement matters with respect to the misappropriation of trade secrets and violation of IP rights.

Louis Heidelberger represented a juvenile goods company in the development of its intellectual property portfolio, business and licensing matters, including the enforcement of its patents in two federal court actions culminating in the entry of an exclusionary order resulting from ITC proceedings.

Louis Heidelberger represented a pharmaceutical company in the medical cosmetics industry in connection with the enforcement of its patents in two federal court actions and an ITC case. One litigation related to a reissued patent and one to the defense of and ITC action.

Louis Heidelberger represented luxury goods holders in the design of on shore and off shore corporate structures, procurement and enforcement proceedings including the trial of major trademark and unfair competition litigation matters as well as proceedings involving the license, opposition, and cancellation of applications and registrations worldwide.

Louis Heidelberger represented a platform company in the universal automation of smart grid technology into advanced communications and control networks for commercial, industrial, office, and home facilities in connection with strategic alliances, licensing, and intellectual property development.

Louis Heidelberger represented a communication platform company and its subsidiaries in connection with patent development, monetization, and business and licensing matters, including the divestiture of the IP and formation of an entity to enforce the portfolio currently valued in excess of several hundred million dollars.

Louis Heidelberger represented a venture backed technology company in connection with third party development of key software programs and control systems, acquisition of key intellectual property rights and protections and enforcement in court of the company's rights against a key professor at a major teaching Institution, the teaching institution and a related company owned by the professor.

Louis Heidelberger represented a security and gaming company in the development of its patent portfolio and enforcement of its patents, including in connection with a several hundred million dollar promotional game.

Louis Heidelberger represented a clean tech bio-fuel company in the master licensing and sub-licensing of its worldwide manufacturing and distribution infrastructure and systems.