

Dana M. Herberholz is an intellectual property attorney who advises and represents clients in technology disputes involving patents, trademarks, copyright and trade secrets. He chairs Parsons Behle & Latimer's Intellectual Property Litigation Practice team and is based in the firm's Boise office.



Dana M. Herberholz

Intellectual Property Practice Area Chairperson
Shareholder | Boise

Biography

With particular emphasis on patent litigation, Dana maintains a national practice and regularly serves as lead counsel in patent disputes in various courts across the United States, including the Federal Circuit Court of Appeals and the Patent Trial and Appeal Board. His patent litigation practice spans diverse technology areas including consumer electronics and hardware, computer software, image processing, wireless communication devices, laboratory equipment, medical devices and internet technologies, among others. Dana also has extensive experience assisting clients in international patent disputes, including proceedings in Canada and in Europe.

Active in numerous bar associations and committees, Dana has served as the President of the Idaho Chapter of the Federal Bar Association and as the chair of the Intellectual Property Law Section of the Idaho State Bar.

Contact information

208.562.4906

dherberholz@parsonsbehle.com

Capabilities

Patent Litigation
Trademark and Trade Dress Litigation
Federal Circuit Appeals
Copyright Litigation
Trade Secret Litigation
USPTO Proceedings
Intellectual Property Licensing
Antitrust & Competition
Technology

Licensed/Admitted

U.S. Dist. Court, Dist. of Idaho
U.S. Dist. Court, Eastern Dist. of Texas
U.S. Patent & Trademark Office
U.S. Court of Appeals, Federal Circuit
U.S. Court of Appeals, 9th Circuit
Idaho
Washington

Experience

Patent Litigation

- Won a jury verdict, enhanced damages, attorneys' fees, and a permanent injunction as lead trial counsel for railroad technology company in a case against a direct competitor. A Texas federal jury found that the competitor willfully infringed the company's patent for machine vision railroad track inspection technology.
- Lead counsel representing railroad technology company on appeal before the U.S. Court of Appeals for the Federal

A *Different*
LEGAL
PERSPECTIVE

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BEHLE &
LATIMER**

Circuit. Secured affirmance of jury verdict, enhanced damages, attorneys' fees, and a permanent injunction in favor of client.

- Represented manufacturer of optical systems in separate appeals before the U.S. Court of Appeals for the Federal Circuit. Secured affirmance of USPTO decisions invalidating asserted patents directed to microscope slide staining technology.
- Represented consumer electronics retailer in the Northern District of California in patent infringement case involving 802.11 wireless encryption technology. Obtained judgment of non-infringement and successfully defended judgment on appeal before the U.S. Court of Appeals for the Federal Circuit.
- Represented retail grocery chain in the Eastern District of Texas in patent infringement case involving digital image processing for surveillance systems.
- Represented manufacturers of infrared thermometers on appeal before U.S. Court of Appeals for the Federal Circuit. Successfully reversed \$2.5 million verdict against client and invalidated one of three asserted patents on appeal.
- Defended laboratory equipment manufacturer in the Southern District of California in patent infringement case involving fluorescent optical imaging technology. Successfully defeated all claims on summary judgment and recovered costs for client.
- Defended online retailers in the Eastern District of Texas in patent infringement case involving webcam technology. Obtained complete dismissal of all claims against client with prejudice shortly before trial.
- Represented one of the world's largest consumer electronics companies in the Northern District of Illinois in patent infringement case involving noise reduction, signal transmission, and motion-adaptive deinterlacing technology. Case settled favorably shortly before trial.
- Represented networking services company in patent infringement case in Eastern District of Texas involving WiFi technology. Case settled favorably during claim construction.
- Represented one of the world's largest consumer electronics companies in the Eastern District of Texas in patent infringement case involving LCD backlight technology.
- Represented online retailers in the Northern District of Georgia in patent infringement case involving personalized web content technology. Obtained complete dismissal of all claims against client with prejudice.
- Represented retail grocery chain in the Eastern District of Texas in patent infringement case involving web-based purchasing platform and "shopping cart" technology.
- Defended medical device company in District of Massachusetts in patent infringement case involving non-contact infrared thermometers.
- Represented medical device company in Southern District of Florida in in case involving design patents for infrared thermometers.
- Represented online retailers in the Eastern District of Texas in patent infringement case involving computerized sales force automation technology.
- Defended online retailers in Southern District of Florida in patent infringement case involving power supply technology.

- Defended consumer electronics company in the Eastern District of Texas in patent infringement case involving parental control and signal encryption technology.
- Represented consumer electronics retailer in the Northern District of Georgia in patent infringement case involving LCD and DLP projector technology.
- Defended dairy equipment company in the District of Idaho in patent infringement case involving technology used to prevent mastitis in cattle.
- Represented firearm technology company in the District of Idaho in patent infringement case involving interchangeable firearm components.
- Represented manufacturing company in the District of Utah in patent infringement case involving elastomeric gel technology.
- As co-counsel, represented five automobile manufacturers in District of Idaho in patent infringement case matter involving electronic vehicle braking technology.
- Representing agribusiness company in the District of Idaho in patent infringement litigation involving pulsed electric field technology.
- Represented utility company and patent owner in the District of Idaho in lawsuit involving mechanical systems for installing underground utilities. Case settled favorably after early motion practice.

Patent Infringement and Abuse of Process

Defended client New U Life Corp. involving allegations of patent infringement, abuse of process and wrongful use of civil proceedings with favorable outcome.

Copyright and Trademark Litigation

- Represented agribusiness company and trademark owner in the Northern District of California in trademark infringement matter involving fertilizers. Successfully obtained injunctive relief prohibiting infringing and misleading labelling.
- Represented trademark owner and manufacturer of aftermarket powersports equipment in the District of Idaho in trademark infringement matter involving high-performance snowmobiles. Case settled favorably after motion for preliminary injunction was filed.
- Represented manufacturer of luxury trailers and toy haulers in trademark infringement lawsuit in the District of Idaho. Defeated plaintiffs' venue arguments and obtained transfer of plaintiffs' claims to the U.S. District Court for the Northern District of Indiana.
- Defended fuel distributor against allegations of copyright infringement. Defeated plaintiff's motion for preliminary injunction and secured dismissal of all claims against client with prejudice.
- Defended vocational school in the District of Utah against claims of copyright infringement seeking more than \$35 million in damages. Case settled favorably after court dismissed majority of plaintiff's claims on summary judgment.
- Represented a national testing company asserting copyright infringement claims in an action filed in the Western District of Washington.

- Defended a packaging systems equipment manufacturer sued in the District of Idaho for misappropriation of trade secrets and trade dress infringement.
- Obtained favorable settlement for Boise-based real estate agency accused of copyright infringement based on use of image on website.
- Obtained favorable settlement for agricultural supplier accused of copyright infringement based on use of image on website.

Accomplishments

Professional

Recognized in Best Lawyers in America since 2021 for Litigation - Patent

Listed in the category of Intellectual Property Litigation - Mountain States Super Lawyers & Rising Stars (2009-present)

Martindale-Hubbell AV-rated

Academic

Gonzaga University School of Law, Spokane, Washington (J.D., 2006)

University of Washington, Seattle, WA

- Cellular and Molecular Biology (B.S., 2002)
- Law Societies and Justice (B.A., 2002)

Associations

Professional

President, Federal Bar Association, Idaho Chapter
(2018-2019)

Local Civil Rules Committee – U.S. District Court District of Idaho
(2016-present)

Executive Committee, Idaho Technology Council
(2017-2020)

Board Member, Federal Bar Association, Idaho Chapter
(2016-present)

Chair, Idaho State Bar Intellectual Property Law Section
(2010-2011, 2013-2014)

Member, Idaho State Bar Litigation Section
(2006-present)

Member, American Bar Association, Intellectual Property Section
(2007-present)

Member, Federal Circuit Bar Association
(2011-present)