maschoff brennan



Kenneth Cheney

Registered Patent Attorney • Partner

let's connect

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education

- J.D., Loyola Law School, Los Angeles
- B.S., Computer Engineering, University of California, Irvine

expertise

Patent Prosecution • Intellectual Property Transactions • Freedom-to Operate & Due Diligence Investigations • Intellectual Property Litigation • Inter Partes Review Proceedings • Patent Validity & Infringement Opinions

Kenneth Cheney advises clients on the full spectrum of intellectual property matters, with an emphasis on patent-related disputes, patent prosecution, and transactional matters. Ken manages large patent portfolios for multinational corporations, coordinating patent prosecution activities between the United States and across other countries worldwide. Ken also represents clients before the US Patent and Trademark Office, and in appeals and post-issuance patent challenges before the USPTO Patent Trial and Appeal Board. Ken routinely conducts freedom-to-operate and IP due diligence investigations in connection with funding, acquisition, and merger transactions, and prepares legal opinions on patent validity, infringement, and non infringement.

Ken has extensive experience in devising long-term comprehensive patent protection strategies for the benefit of extended product lifecycles and “bet-the-company” innovations. He also brings years of litigation experience involving patent and trademark infringement, trade secrets, fraud, and breach of contract.

With his degree in computer engineering and industry experience, Ken is intimately familiar with existing and emerging technologies involving computer hardware and software systems. Representative technologies include networking, analog and digital technology, semiconductor devices, electrical and electromagnetic circuits, integrated circuits, mixed signal systems, RF devices, volatile and nonvolatile memory systems and devices, artificial intelligence, big data, social networks, mathematical and computer modeling, visualization and simulation software,virtual reality software and systems, spacecraft applications,solar and battery cell technology, and quantum mechanics. Ken's technical experience in the life sciences includes medical devices and methods (e.g., stents, catheters,implantable devices, glucose monitoring, infusion pumps,ultrasound, electric and magnetic field therapy, and MRI), drug delivery and medication management systems, external and intra-body therapies, DNA chromatography, and stem cell technologies.

Ken has authored numerous articles on IP-related issues, and is a contributing author of *Computer Games and Immersive Entertainment: Next Frontiers in IP Law*, published by the American Bar Association. Ken's first legal publication explored international norms in stem cell research. Prior to attending law school, Ken gained experience as a software engineer in the aerospace and healthcare industries.

my focus

Artificial Intelligence	Aviation	Computers & Databases	Data Privacy & Security
Electric Systems	Clean Technology & Renewable Energy	Health Care	Licensing & Transactions
Life Sciences	Medical Devices	Networking & Wireless Technology	Opinions & Counseling
Patent Disputes	Patent Prosecution	Portfolio Management	Post-Issuance Proceedings

Semiconductor | Software | Technology Transfers & Transactions

representative matters

- Served as counsel for US multinational oil and gas corporation in *inter partes* review proceedings against 93 patent claims asserted by nonpracticing entity. Drafted and filed three petitions for *inter partes* review, obtaining consolidation of all petitions and PTAB institution on all 93 claims, resulting in a favorable settlement for the corporation. (*Haliburton Energy Servs., Inc. v. Dynamic 3D Geosolutions LLC*, IPR2014-01186, IPR2014-01189, IPR2014-01190)
- Obtained favorable settlement and termination of *inter partes* review proceedings initiated against multiple DNA chromatography patents for US multinational medical diagnostic company. (*Bio-Techne Corp. v. Caliper Life Scis.,Inc.*, IPR2016-00139, IPR2016-00227, IPR2016-00228)
- Drafted and filed petition for *inter partes* review, obtaining PTAB institution on a patent that was previously confirmed in reexamination and unsuccessfully challenged in four other petitions for *inter partes* review during the same district court litigation. (*Linear Tech. Corp. v. In-Depth Test LLC*, IPR2015-01998, Inst. Decision, Apr. 1, 2016)
- Served as counsel in advising numerous clients, as petitioners and patent owners, in *inter partes* and post-grant review proceedings in connection with co-pending district court litigation.
- Represented defendant against alleged violation of the Lanham Act arising from purchase of plaintiff's business, resulting in favorable settlement by which defendant obtained ownership of the subject trademark.
- Represented plaintiff in case involving misappropriation of its trade secrets in the Southern District of Florida, obtaining preliminary injunction enjoining defendants from competing with plaintiff in the subject territories.
- Served as counsel for multiple out-of-state defendants in patent infringement suit brought in the District of Colorado.
- Represented US multinational semiconductor manufacturer in multiple patent licensing disputes.
- Negotiated and drafted license agreements and nondisclosure agreements for US multinational semiconductor manufacturer, healthcare corporations, and video game development companies.
- Conducted numerous IP due diligence investigations related to acquisitions and mergers for various entities, including US healthcare corporation, global pharmaceuticals and healthcare products company, US multinational financial services corporation, US airline, US computer manufacturers, American aerospace company, and private investment foundations.
- Conducted numerous freedom-to-operate analyses related to diabetes monitoring devices and pumps, automated drug dispenser systems, ventilation systems, integrated circuits, positive train control system, and electric and magnetic field therapy devices.
- Drafted and filed Request for Patent Term Extension under 35 USC §156 for global pharmaceuticals and healthcare products company, receiving determination of eligibility from FDA.
- Ongoing representation of numerous US multinational companies in large-volume patent prosecution-related activities, including providing strategy on, and day-to-day servicing of, domestic and international patent prosecution portfolios.

professional admissions & associations

- State Bar of California
- U.S. Patent and Trademark Office
- U.S. District Court for the Central District of California

publications & presentations

- "The Latest Trends and Developments in Post-Grant Proceedings," *PTAB Digest 2021/2022* (July 2022)
- "The Latest Trends and Developments in Post-Grant Proceedings," *PTAB Digest 2020*, (March 2021)
- Panelist, *Inter Partes Reviews: What Have We Really Learned?*, 2016 Patent Disputes Forum South (Oct. 19, 2016)
- Team Captain, Judge Paul R. Michel Intellectual Property American Inn of Court (2010–2011)
- Speaker, Los Angeles County Bar Association, Dialogues in Freedom (2008–2009)
- Senior Production Editor, *Loyola International & Comparative Law Review*

awards & recognition

- Member, Practice Group of the Year, Intellectual Property, *Law360* (2019)
- Member, Litigation Department of the Year–Intellectual Property, *The American Lawyer* (2019)
- Recommended, Intellectual property: Patents: licensing, *The Legal 500 US* (2019)

- Recommended, Intellectual property: Patents: prosecution (including re-examination and post-grant proceedings), *The Legal 500 US* (2019)