



Joshua M. Weeks

Partner

+1 404 881 7405 | joshua.weeks@alston.com

Atlanta | One Atlantic Center, 1201 West Peachtree Street, Suite 4900 | Atlanta, GA 30309-3424

Related Services

Intellectual Property Litigation ■ Patent Litigation ■ Post Grant Review Proceedings ■ Intellectual Property

Joshua focuses his practice on the enforcement of intellectual property rights, including patents, trade secrets, and other forms of intellectual property. Joshua represents clients in disputes from inception through appeals and has litigated cases before district courts, the U.S. International Trade Commission, the Patent Trial and Appeal Board, and the U.S. Court of Appeals for the Federal Circuit.

Joshua also counsels clients on various intellectual property issues, including pre-litigation diligence, validity and enforceability investigations, freedom to operate opinions, and licensing.

Joshua has experience with a wide range of technologies, including automotive safety products, banking systems, building products, food and beverage equipment, fire apparatus, manufacturing equipment, medical devices, oil drilling equipment, personal care products, infant gear and furniture, and e-commerce technologies.

Joshua received his J.D., with honors, from the University of North Carolina School of Law, where he was an editor of the *North Carolina Journal of Law & Technology* and was also a member of the Holderness Moot Court. He holds a B.S. in mechanical engineering, magna cum laude, from North Carolina State University.

Representative Experience

Litigation and Related Appeals

- Representing the plaintiff in district court litigation and appeals in a dispute with a competitor relating to aerial fire apparatus. Obtained a preliminary injunction for the client prohibiting sales of infringing fire apparatus, and a jury verdict finding that the defendant's infringement was wilful. *Pierce Mfg. Inc. et al. v. E-One Inc. et al.*, No. 8:18-cv-617 (M.D. Fla.); No. 2019-1276 (Fed. Cir.).
- Representing the plaintiff in a patent infringement suit against a competitor relating to cleaning and hygiene products. *Diversey Inc. v. POPS Technologies LLC*, No. 1:18-cv-4210 (N.D. Ga).
- Representing the plaintiff in district court litigation and appeals in a dispute with a competitor relating to waste disposal systems.
- Representing the plaintiff in a patent infringement suit against a competitor relating to passenger airbag technologies. *Autoliv ASP Inc. v. Hyundai Mobis Co. Ltd., et al.*, No. 13-cv-00141 (M.D. Ala.).

- Represented the plaintiff in a dispute relating to 3D printing technology against former employees and related entities alleging misappropriation of trade secrets, breach of contract, conversion, and civil conspiracy, resulting in favorable settlement. *Jabil Inc. v. Essentium, Inc. et al.*, No. 8:19-cv-1567 (M.D. Fla.).
- Represented the plaintiff in a patent infringement litigation suit against competitor relating to fire apparatus, resulting in a favorable settlement. *Pierce Mfg. Inc. v. Spartan Fire, LLC*, No. 1:20-cv-01539 (E.D. Wis.).
- Represented the respondent in an ITC investigation, appeals, and district court litigation relating to deposit automation technologies in which the competitor's patent was found invalid. *Certain Automated Teller Machines, ATM Modules, Components Thereof, and Products Containing the Same*, Inv. No. 337-TA-989 (ITC); *Diebold Nixdorf Inc. et al. v. International Trade Commission*, No. 2017-2553 (Fed. Cir.); *Hyosung TNS, Inc. v. Diebold Nixdorf Inc.*, No. 3:16-cv-364 (N.D. Tex.).
- Represented the respondent in an ITC investigation relating to razor blade refills, resulting in voluntary termination of the investigation by the complainant. *Certain Shaving Cartridges, Components Thereof, and Products Containing Same*, Inv. No. 337-TA-1079 (ITC).
- Represented the complainant in an ITC investigation and appeals relating to check deposit and ATM service technologies resulting in the finding of violations by a competitor. *Certain Automated Teller Machines, ATM Modules, Components Thereof, and Products Containing the Same*, Inv. No. 337-TA-972 (ITC).
- Represented the defendant in a patent infringement suit related to automated refuse collection systems and compressed natural gas (CNG) fuel systems. *The Heil Co., et al. v. McNeilus Companies Inc., et al.*, No. 17-cv-02527 (N.D. Ga.).

Post-Grant Proceedings and Related Appeals

- Representing the petitioner-appellee in an appeal from IPR relating to oil drilling technologies. *James N. McCoy v. HEAL Systems LLC*, No. 2020-1484 (Fed. Cir.).
- Represented the patent owner in post-grant proceedings challenging the validity of patents related to an aerial fire apparatus, resulting in PTAB decisions not to institute a review.
- Represented the patent owner in a post-grant challenge to the validity of patents related to tissue grafts. *Vivex Biomedical Inc. v. MiMedx Group Inc.*, IPR2017-01220 (PTAB).
- Represented the patent owner in post-grant proceedings relating to waste disposal systems, resulting in PTAB decisions to not institute a review. *Munchkin Inc. v. International Refills Company Ltd.*, IPR2016-01154 and IPR2017-00050 (PTAB).
- Represented the patent owner in post-grant proceedings relating to automated deposit technology. *Nautilus Hyosung Inc., et al. v. Diebold Incorporated, et al.*, IPR2016-0529, IPR2016-0530 (PTAB).
- Represented the patent owner in post-grant proceedings and Federal Circuit appeals related to passenger airbag technology, finding the challenged claims valid. *Hyundai Mobis Co. Ltd, et al. v. Autoliv ASP Inc.*, IPR2014-01005 and -01006 (PTAB).
- Represented the petitioners in post-grant proceedings and Federal Circuit appeals related to customer loyalty systems, resulting in the cancellation of all challenged claims. *Walgreen Co., et al., v. Advanced Marketing Systems LLC*, CBM2016-00012, -13, -14, and -15 (PTAB).
- Represented the petitioners in post-grant proceedings relating to athletic shoes. *Skechers USA Inc. v. Aura Technologies LLC*, IPR2014-00955 (PTAB).

Intellectual Property Counseling

- Counsel to a multinational heavy equipment manufacturer on intellectual property enforcement issues.
- Counsel to a multinational commercial kitchen equipment manufacturer on issues related to intellectual property enforcement and licensing.
- Counsel to a battery manufacturer on intellectual property enforcement issues.
- Counsel to a software developer on intellectual property issues including copyright enforcement and licensing.
- Counsel to a building products company on intellectual property enforcement issues.

Other Experience

- Represented the defendant in a patent infringement suit relating to beverage dispensing technology.
- Represented an ATM manufacturer in a suit relating to network protocols. *Open Network Solutions Inc. v. Diebold Incorporated*, No. 14-cv-00703 (D. Del).
- Represented the defendant in a patent infringement suit brought by Intellectual Ventures. *Intellectual Ventures I LLC, et al. v. FTD Companies Inc.*, No. 16-cv-00195 (E.D. Tex.).
- Represented multiple defendants in a suit relating to e-commerce technology. *Select Retrieval LLC Litigation*, No. 11-cv-00812 (D. Del); No. 11-cv-01104 (D. Or.); No. 11-cv-02158 (S.D. Cal.).
- Represented multiple defendants in a patent infringement suit relating to location-based services. *GeoTag Inc. Litigation*, Nos. 10-cv-00265 and 10-cv-00572 (E.D. Tex.).
- Represented the defendant in district court litigation against patent infringement claims related to child swings and related technology. *Fisher-Price Inc., et al. v. Kids II Inc.*, No. 10-cv-00988 (W.D.N.Y.)

Publications & Presentations

Publications

- *USPTO Post-Grant Trials Handbook*, 3rd Edition, Wolters Kluwer, 2023.
- *USPTO Post-Grant Trials Handbook*, 2nd Edition, Wolters Kluwer, 2018.
- *USPTO Post-Grant Trials Handbook*, Wolters Kluwer, 2016.
- *USPTO Post-Grant Trials Handbook*, contributor, Wolters Kluwer, 2016.
- “To Be or Not to Be —Software Patents and MSOs,” *CableFAX*, May 5, 2014.

Presentations

- “The Use of AI in the Practice of Law: Addressing the Risks and Opportunities,” Ad Idem Network, webinar, April 25, 2023.

Education

- The University of North Carolina (J.D., 2011)
- North Carolina State University (B.S., 2008)

Admitted to Practice

- Georgia
- U.S. Patent and Trademark Office