

Rising Star: Glaser Weil's Erica Van Loon

By Jeff Zalesin

Law360, New York (April 22, 2016, 5:16 PM ET) -- Glaser Weil Fink Howard Avchen & Shapiro LLP's Erica Van Loon has led Vizio to a favorable trademark settlement and helped technology company Nero defeat JVC's patent claims, landing the versatile partner among Law360's top intellectual property lawyers under 40 for 2016.

One of 10 IP attorneys on this year's Rising Stars list, Van Loon, 38, who leads Glaser Weil's trademark, copyright and media practice, said she has actively tried to cultivate an IP practice that covers a broad range of industries and areas of the law. That effort has paid off with a diverse roster of clients who turn to Van Loon for cases involving patents, trademarks and copyrights.

"It's fun for me to learn about my clients' business and blend that with all of the changes that are constantly happening in the law," Van Loon said. "I think it's a dynamic area to practice in."

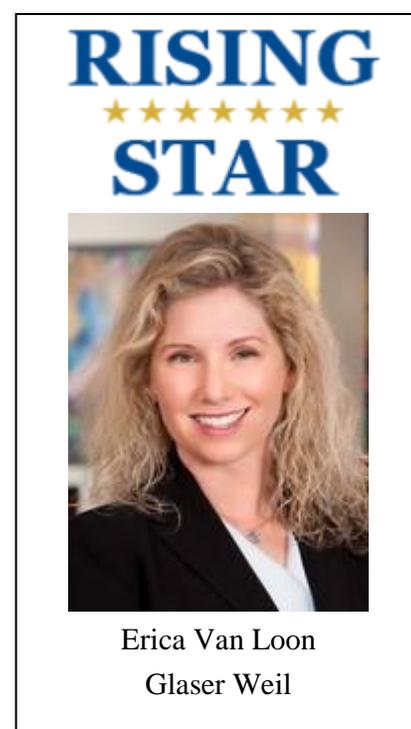
In one recent case, Van Loon defended Vizio Inc. against scooter maker Razor USA LLC, which alleged that Vizio's Razor LED and Razor Thin televisions infringed the trademark on its name.

Van Loon said that as she delved into the case, it quickly became clear to her that Vizio chose the TV names to describe the products, not to trade off the scooter company's brand. Therefore, she said, Vizio had not infringed or diluted Razor's marks willfully, which meant that Razor would not be able to obtain disgorgement of profits.

Instead of moving for summary judgment on every possible issue, Van Loon and her colleagues asked for a more limited pretrial ruling for Vizio on the issue of willfulness. U.S. District Judge S. James Otero of the Central District of California granted the motion, which effectively "gutted [Razor's] case from the inside out," Van Loon said.

That development set the stage for what Van Loon described as a highly favorable settlement for Vizio. Under the settlement, reached in November shortly before a scheduled trial, Razor agreed to buy the Razor LED and Razor Thin marks and allow Vizio to phase out its use of the name.

"We were targeted on willfulness the whole time," she said. "This was, I think, a good example of setting



an early strategy in a case and trying to whittle it down to key issues.”

In another trademark case, Van Loon helped OneWest Bank defeat a claim that its “Magic by Magic Johnson” debit card infringed another company’s trademark on the phrase “magic card.” The basketball great was a co-defendant in the case.

Van Loon said that a turning point in the case came when she took the deposition of the main witness for the plaintiff company, Celebrity Cards International Inc.

“I got away from my outline very quickly, and it was just him and me, one-on-one,” she said. “He admitted that he wasn’t using ‘magic card’ in commerce, and that was definitely a blow to plaintiff’s case.”

While many trademark and copyright lawyers steer clear of patent law, Van Loon has embraced the latter area with impressive results. She was part of the team that successfully defended Nero Inc. against claims that it caused infringement of JVC Kenwood Corp. patents through its software for burning data onto DVDs and Blu-rays.

A California federal judge, the late Mariana R. Pfaelzer, sided with Nero in 2013, finding that patent exhaustion and an express release barred JVC’s infringement claims. The Federal Circuit affirmed the ruling in August, finding that JVC’s evidence did not support its infringement theory, though the appeals court did not agree with Judge Pfaelzer on patent exhaustion.

Van Loon, a graduate of Loyola Law School, started her career at Quinn Emanuel Urquhart & Sullivan LLP. She left in 2007 to help start the boutique firm Pruetz Law Group LLP with her mother, Adrian Pruetz. Pruetz Law Group joined forces with Glaser Weil in 2011.

Van Loon said her mother has been her “number one mentor,” teaching her a great deal about how to win cases and form productive relationships with clients. But Van Loon has also benefited from other mentors at Glaser Weil and in-house counsel at her client companies, she said.

Meanwhile, being a young attorney with a focus on up-and-coming technology puts Van Loon in a position to teach as well as learn.

“I have set myself up within my firm as a go-to person on all types of technology issues, so I think my partners feel very comfortable calling me if they have a particular technology question or a particular question concerning IP,” she said.

--Editing by Bruce Goldman.

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