



KYLE ST. JAMES

Partner

Intellectual Property

Orange County

(714) 338-1805

kstjames@rutan.com

Kyle St. James advises clients on patent portfolio development, prosecution strategies in the U.S. and abroad, and patent litigation matters. Companies and individuals often seek Kyle's counsel on offensive and defensive patent portfolio reviews as well as validity and non-infringement analyses and opinions of patents directed to computer- and medical-related technologies. He also assists patent holders and licensees with drafting and reviewing licensing agreements.

Kyle is at the forefront of the intersection of artificial intelligence (AI) and patent law. He has developed an expertise in both the technology underlying AI as well as how best to obtain patent protection on products or services that incorporate AI regardless of whether the models are open-source or closed-source. To that extent, many of his clients develop and manufacture computer hardware and software, 3D printers, medical devices and products within the fields of data analytics, internet and wireless network technologies and cybersecurity.

Additionally, Kyle has a particular passion in viticulture and oenology having clients that develop devices that utilize sensors to measure properties of grapes and wine including pH and levels of acetic acid and sulfur dioxide as well as perform analytics thereon. Similarly, Kyle seeks to apply his expertise in AI to assist technology companies that produce sensors or equipment used in agriculture settings in building a patent portfolio and protecting their intellectual property (IP).

During law school in Silicon Valley, Kyle gained experience in the legal departments of Aruba Networks (acquired by Hewlett Packard) and eBay working on their patent portfolio development and prosecution strategies. In addition to this in-house experience, he has guided numerous start-ups through the initial stages of filing their first patent applications.

Representative Experience

Patent Strategy & Portfolio Development

Related Services

- Intellectual Property
- Patents
- Cybersecurity, Privacy and Corporate Governance Practice Group

Related Industries

- Food and Beverage
- Sports and Entertainment
- Technology
- Aerospace and Defense
- Blockchain, Smart Contracts and Cryptocurrencies
- Cybersecurity
- Internet of Things (IoT)
- Life Sciences and Healthcare
- Hardware
- Software
- Physical Sciences
- Automotive

Bar & Court Admissions

- State Bar of California
- U.S. Patent and Trademark Office

- Developing the artificial intelligence patent portfolio for a Silicon Valley tech company that was recently acquired by a Fortune 100 tech company.
- Developing the patent portfolio for company offering tech-centric sports experiences. The portfolio has grown 20x since taking over development and has garnered multiple rounds of funding.
- Counseling several Silicon Valley start-ups on IP protection and portfolio development strategy in view of Series A or B fundings.
- Assisting in development of the patent portfolio of a Fortune 500 medical device company with a focus on AI and fiber optic technologies

- U.S. District Court for the Northern and Central Districts of California

IP Transactions

- Routinely conducts IP due diligence on mergers or acquisitions on both buy and sell side deals.

IP Litigation + Opinion Counseling

- Drafted several freedom to operate (FTO) opinions for a Fortune 500 medical device company involving transjugular intrahepatic portosystemic shunt (TIPS) technologies.
- Member of a team that litigated a patent infringement lawsuit, where the client had 10 employees and indemnified a Fortune 100 company, thus business strategy was of the utmost importance.
- Represented numerous clients at various stages of litigation – pre-assertion, pre-trial and thru settlement.

Speaking Engagements & Publications

- “The CAN-SPAM Act of 2003 and Its Applicability Today,” Rutan & Tucker, LLP Cybersecurity Newsletter, April 2017
- “Pro-Bono Small Business Legal Clinic,” presented by Public Law Center, ACC So-Cal and Rutan & Tucker, LLP, March 2017
- “Privacy and Security Concerns Resulting From A Lack of Regulation of IoT Devices and the Data Collected Therefrom,” Rutan & Tucker, LLP Cybersecurity Newsletter, October, 2016
- “Applying Alice: Summer 2016 in Review,” Daily Journal publication, August 2016

Memberships & Associations

- Orange County Bar Association
- OC Intellectual Property Associations
- California Bar Association
- Eta Kappa Nu – Electrical And Computer Engineering Honor Society

Education

- Berkeley Center for Law & Technology, Certificate in Chinese IP Law
- Santa Clara University School of Law (J.D.)
- Pennsylvania State University, College of Engineering (B.S.), Eta Kappa Nu – Electrical And Computer Engineering Honor Society

Awards & Honors

- Southern California Super Lawyers, Rising Stars Edition, 2023
- High Tech Law Certificate with Honors
- High Tech Excellence Award
- Senior Comments Editor for the Santa Clara Computer and High Technology Law Journal, Vol. 29
- CALI Excellence for Constitutional Law II