

TAKAO SAITO

CONSULTING COUNSEL

tsaito@wiggin.com

EDUCATION

LL.B., Doshisha University, Japan

Diploma, School of Business, Economics and Law, Göteborg University, Sweden
Intellectual Capital Management for lawyers

PhD., Kyoto University

ADMISSIONS

Japan Patent Attorney

California

COURT ADMISSIONS

US District Court (Central District of California)

AWARDS AND RECOGNITIONS

IAM Strategy 300 – The World's Leading IP Strategists
(2017-2026)

Takao Saito is consulting counsel for Wiggin and Dana, LLP and is also the sole proprietor of Saito International IP Firm & Squall IP LLC.

Takao's practice focuses on representing clients in patent licensing matters and patent infringement litigation. Takao also counsels clients on patent portfolio management, intellectual property strategy developments, patent monetizing negotiations, and other IP related matters in cross-border M&A and strategic business and technology alliances. Prior to joining Wiggin, Mr. Saito worked for more than 18 years at Panasonic Corporation. Takao Saito's keen understanding of patent licensing, transactions and litigation has made him a valuable resource for clients facing the most complex IP challenges. His experience includes a large number of patent cases in a variety of high-tech fields, including consumer technology, electronics, computers, semiconductors, smartphones, and medical devices.

Experience

Therasense, Inc. v. Becton, Dickinson & Co., 649 F.3d 1276 (Fed. Cir. 2011), a medical device case that Takao Saito handled as an in-house strategist involving Panasonic Health Care which was a supplier of a defendant. He led the settlement discussions as the lead negotiator and obtained a successful summary judgment on one patent and a verdict of invalidity/inequitable conduct on a second patent, including an award of millions of dollars in attorneys' fees paid by the opposing party and setting the current standards for inequitable conduct through an en banc appeal.

Typhoon Touch Technologies v. Dell, Inc., 659 F.3d 1376, (Fed. Cir. 2011), in a computer case filed by an NPE that Takao Saito handled as an in-house strategist involving Panasonic Corporation as a defendant. He studied the accused patents and developed the claim construction, which was successfully admitted in the Markman hearing and led to Panasonic obtaining a successful summary judgment on the patents.

Ditzik v. Panasonic Corporation of North America, Civil Action No. 090-CV-1661 JAH NLS, in a computer case filed by an ex-Panasonic employee that Takao Saito handled as a lead negotiator in the mediation, obtaining a favorable settlement to dismiss the case.

Mariner IC Inc. v. Funai Electric Co., Ltd., et al., Case No. 2:16-CV-0525-JRG-RSP, in a semiconductor device case filed by an NPE that Takao Saito handled as an in-house strategist involving Panasonic Corporation as a defendant. He studied the accused patents and developed the claim construction, resulting in a favorable settlement to dismiss the case.

M-Red v. Panasonic Corporation, et al., Case No. 2:19-CV-00251-JRG-RSP, in a semiconductor device case filed by an NPE that Takao Saito handled as an in-house strategist involving Panasonic Corporation as a defendant. He researched the limited business exposure of the sales of the accused products in the US and found a compelling argument for the relevant royalty fees, resulting in a favorable settlement to dismiss the case.

Takao was the in-house strategist for three arbitrations of patent matters that were successful, ranging from semiconductors/electronics to medical devices. He was the lead negotiator for settlement discussions and was active in managing the defense, including discovery and working with counsel on the substantive merits arguments.

Takao has handled complex license, cross-license and software licensing matters totaling hundreds of millions of dollars in successful transactions. He has also led patent sales and other patent monetization efforts. Takao has worked on complex audits where license agreements were reviewed, and payment history was investigated.

Takao handled the divestiture of Panasonic Semiconductor Company to Nuvoton Technology, based in Taiwan, which closed in September 2020, by reviewing 300 patent and software license agreements, drafting the letter agreements and obtaining consents from nearly all of the opposing parties to assign and transfer the agreements to Nuvoton Technology Japan.

Takao handled the renewal of a joint venture agreement between Tower Jazz, based in Israel, and Panasonic Semiconductor Company, which closed in September 2019, by conducting due diligence of the patent portfolio and license agreements, and drafting and revising several joint venture agreements.

Takao handled the divestiture of Panasonic HDD laboratory to Toshiba, based in Japan, which closed in May 2005, by conducting due diligence of the patent portfolio and license agreements, and drafting and revising several joint venture agreements.

Publications and Seminars

- Evaluation Methods for FRAND rates in British Cases - Focusing on 3 FRAND British Cases, Chizai Prism, April 10, 2025.
- “License Subspecies” and Intellectual Property Trust - Evaluation of Patents Through IP Due Diligence, Seibundo, December 10, 2024.
- Study on Intellectual Property Trust in Japan – Focusing on Patent Trust, Chizai Prism, May 1, 2024.
- “License Subspecies” and Intellectual Property in the Web 3.0 Era - Tension between Contract Law and Intellectual Property Law, Kyoto University, Dissertation Kou-24368, March 23, 2023.
- Standstill in Intellectual Property Licensing - Considering Japanese Contract Law Reform, Law & Technology (L&T) Vol.91, 58-64, 2021-04.
- IP Strategy for New Technology Era, EU - Japan Technology Transfer Helpdesk, December 2019.
- Evaluation of Patents for Transfer-Patent Evaluation Through IP Due Diligence, Patent, Vol.72 No.2, 49-55. 2019-02.
- IPBC Asia 2017 -Study on “Springing License”- Does it bring a peace to IP Monetization? Law & Technology (L&T) Vol. 78, 33-38. (2018).
- A Beginner's Guide to IP Commercialization - From patent gazette to commercial products, Patent, Vol. 70, 40-53, 2017-07.
- Legal Protection for LINE Stamps - For Creator's Business Planning, Patent, Vol. 69, 95-106, 2016-03.
- Overview and Practical Notes Regarding Patent Assignment Agreements Based on US Patent Case Law, Intellectual Property Management 65(7), 873-887, 2015-07.
- Analysis of "Non-assertion" Clause in the Patent Law: Focusing on legal nature of non-assertion clause and protection of licensee in case of patent assignment, Intellectual Property Management 64(6), 916-935, 2014-06.