

People



## Alejandro J. Fernandez

Partner, Intellectual Property  
Intellectual Property Litigation

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vCard

” [Alex] is THE BEST lawyer...  
the outcome was better than I  
could have imagined.

- Founder, Digital Marketing Company

Alejandro (Alex) Fernandez is Board Certified by the Florida Bar as an expert in Intellectual Property Law, a distinction he has held for nearly 20 years. Alex’s energetic, strategic, and collaborative service to clients led to his selection as one of the “Top 100 Lawyers in Florida” and “Top 50 Lawyers in Hillsborough County” by *Super Lawyers Magazine*. In 2022, *The Best Lawyers in America* awarded Alex with Lawyer of the Year for his work in trade secrets law.

Alex counsels clients in the protection of their patents, trademarks, trade secrets, and copyrights. Clients and other attorneys frequently engage Alex to step into and efficiently resolve complex, contentious intellectual property disputes. He has represented clients in every stage of litigation in many intellectual property disputes nationwide and internationally, and has distinguished himself by successfully arguing numerous times before federal judges and magistrates.

Alex is also an experienced patent attorney adept at applying his patent litigation experience to drafting complex patent applications and protecting leading edge technology. He has two decades of experience drafting and prosecuting complex patents involving mechanical, fluid power, medical, energy, software, and consumer devices.

Alex also frequently represents clients in various forms of corporate transactions requiring intellectual property expertise. He has served as due diligence counsel on deals involving more than \$700 million

### Areas of Experience

Intellectual Property  
Intellectual Property Litigation  
Intellectual Property Licensing  
Patent Litigation  
Patent Prosecution and Portfolio Management  
Copyrights  
Trademarks  
Trade Secrets, Restrictive Covenants, and Unfair Competition

### Education

J.D., University of New Hampshire Franklin Pierce School of Law, 2001  
B.S., Palm Beach Atlantic University, Biology, Chemistry Minor, 1998

### Admissions

#### Bars

Florida  
Illinois

#### Courts

U.S. Patent and Trademark Office

### Languages

Spanish

### Related Content

Akerman Represents DMI Personal Care in Acquisition by TruArc Partners  
January 28, 2025

Akerman Represents Fort Point Capital in Acquisition of NewBold Corporation  
August 19, 2024

in transactions. Similarly, he has extensive experience in complex licensing transactions involving patents, trademarks, trade secrets, and copyrights. He does everything possible to facilitate closing deals, while counseling clients thoughtfully about true IP risks.

Akerman Lawyers Ranked in Florida by *Super Lawyers Magazine*  
July 16, 2024

## Notable Work

### **Federal Trademark Infringement and Unfair Competition**

**Litigation:** Represented a medical device manufacturer in asserting multiple federal trademarks for the client's most important products. After successfully asserting multiple sanctions and fee motions, and more than five years of hotly contested litigation, the case settled on highly favorable terms that included public admissions by defendants of the validity of our client's marks.

**Patent Infringement Litigation:** Represented a medical device manufacturer in a multi-patent infringement action. Successfully settled the action with admissions of patent validity, payment of an undisclosed amount to our client, and the defendants' agreement to cease use of the patented devices.

**Corporate Transaction and Due Diligence:** Represented a private equity group in the acquisition of an industrial products conglomerate. Conducted due diligence involving numerous patents, trademarks, and trade secrets, as well as freedom-to-operate analysis.

**Corporate Transaction and Due Diligence:** Represented the seller of a defense industry enterprise in its acquisition of an international patent and trademark portfolio. Conducted intellectual property related due diligence and analysis.

**Corporate Transaction and Due Diligence:** Conducted intellectual property related due diligence and analysis on behalf of a Japanese client during its acquisition of a large international patent portfolio relating to immunotherapy devices.

**Patent Infringement Litigation:** Represented firearms parts manufacturer in a multi-patent infringement action. Secretly acquired ownership interest in patents-in-suit, forcing settlement on terms highly favorable to client.

### **Trademark, Copyright, and Trade Dress Infringement Litigation:**

Represented U.S. consumer products manufacturer in asserting numerous federal trademark, unfair competition, and cybersquatting claims against multiple competitors. After a judicial warning regarding an attorneys' fees award against defendants, dismissal of nearly all of defendants' copyright and trade dress counterclaims, and a subsequent multi-day contested trial, the case settled on terms highly favorable to client. In addition to undisclosed economic and injunctive terms, the settlement included a public acknowledgement by defendants that the client's trademarks were valid and infringed.

**Trade Secret Misappropriation Litigation:** Represented multi-billion dollar healthcare company in multi-year, federal trade secret action against a former employee and a number of competitors.

Successfully argued more than ten motions about discovery abuses by multiple defendants. Established extensive spoliation of evidence during multiple evidentiary hearings. The court granted the client the ultimate remedy, terminating sanctions, against numerous defendants. A final judgment on the award of attorneys' fees and damages is pending.

**Corporate Transaction and Due Diligence:** Conducted intellectual property due diligence and analysis on behalf of a private equity group in its acquisition of software company.

**Corporate Transaction and Due Diligence:** Conducted intellectual property due diligence and analysis on behalf of private equity group in its acquisition of medical equipment company.

**Licensing:** Successfully negotiated multi-year cooperative research and development agreement regarding drone technology with NAVAIR.

**Counterfeit Goods Seizures:** Represented a variety of consumer goods manufacturers in aggressively policing and stopping foreign and U.S. counterfeiting operations. Successfully seized large quantities of counterfeit goods, accounts associated with the sale of counterfeit goods, and fraudulent websites, by acquiring and executing *ex parte* seizure orders from multiple federal courts.

## Related Professional Experience

- Judicial Intern to the Honorable Chief Judge Randall Rader, U.S. Court of Appeals, Federal Circuit, 2000

## Published Work and Lectures

- Florida Bar 12th Annual Intellectual Property Symposium, Speaker, “Board Certification in Intellectual Property,” April 22-23, 2022
- Modern IP Practice, Stetson Law School, Guest Panelist for Trademarks Course, March 29, 2021
- *Law360*, Co-Author, “If We Used Current Patent-Eligibility Tests On Vintage Patents,” June 19, 2020
- *Law360*, Author, “Redefining Innovation: Mayo, Myriad and Alice Collide With Vintage Patents,” 2020
- *Federal Bar Magazine*, Author, “Judicial Profile of the Honorable Virginia M. Covington,” August 2019
- Florida Bar Association, Speaker, “Essential IP and Related Transactions,” April 5, 2018
- American Advertising Federation, Speaker, “IP Essentials in Advertising,” March 22, 2018
- Brinks Webinar, Speaker, “2017 Litigation Update,” June 14, 2017
- Hillsborough County Bar Association, Speaker, “Trademark Law,” 2012
- BioFlorida, Moderator, “The Venture Capitalist Is In,” 2011

## Affiliations

- The Florida Bar, IP Board Certification Committee, 2008-2014

## Honors and Distinctions

- Board Certified in Intellectual Property Law, The Florida Bar Board of Legal Specialization and Education
- *Best Lawyers*, 2016-2025, Listed in Florida for Litigation – Intellectual Property, Litigation – Patent, Trade Secrets Law
- *Best Lawyers*, 2022, 2024, Named as “Lawyer of the Year” for Trade Secrets Law in Tampa
- *Managing Intellectual Property*, 2013-2024, Trademark and Patent Star - Florida
- *Florida Trend*, 2021, 2016, 2012, Listed in the “Legal Elite”

- *Super Lawyers* Magazine, 2014-2024, Listed in Florida for Intellectual Property
- *Super Lawyers* Magazine, 2018, Listed as one of the “Top 50 Tampa Bay Attorneys”
- *Super Lawyers* Magazine, 2018, Listed as on of the “Top 100 Attorneys” in Florida
- *Super Lawyers* Magazine, 2010-2011, Listed in Florida as a ”Rising Star”