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Expanded Write-Ups for Major Cases Tried to Verdict/Judgment
(February 2011)

Prior to joining Kirkland & Ellis in 2011:

Velsicol Chem. Corp.. v. Monsanto Co., 74-C-3702 (N.D. Ill. 1976)

Bench trial, Judge Thomas R. McMillen, Jr., relating to the determination of priority of invention/right to a United States Letters Patent directed to 1, 2, 4, - oxadiazolidines. One (1) day trial, where sat second chair to lead partner. Responsible for assisting with direct examination of Velsicol witness, evidence issues and record admission. Adverse decision on priority was later affirmed on appeal.

See 579 F. 2d 103 (7th Cir. 1978).

Standard Oil, et al. v. Montedeson S.p.A., Consolidated Civil Action No. 4319 (D. Del 1975)

Bench trial, Chief Judge Caleb Wright, relating to the determination of priority of invention/right to a United States Letters Patent, directed to crystalline polypropylene. Sat second chair to lead partner, representing Phillips Petroleum Company. Trial began September 1977 with completion of evidence in May 1978. Responsible for assisting with direct/cross-examination of fact witnesses and experts for all parties, exhibits and demonstratives presentation, evidence issues and record admissions. Four parties, approximately 40,000 exhibits, trial transcript of approximately 16,000 pages; following four part briefing cycle completed in late October 1980, case was submitted. Affirmative ruling in favor of Phillips Petroleum Company received in January 1980, later affirmed by United States Court of Appeals for the Third Circuit, *certiorari* denied by United States Supreme Court.

See 494 F. Supp. 370 (D. Del 1980), *aff'd*, 664 F. 2d 356 (3d Cir. 1981), *cert. denied.*, 456 U.S. 915 (1982).

JP Tool, Ltd. v. Valeron, Civil Action No. 79-74134-DT (E. D. Mich. 1983)

Bench trial, Judge Horace W. Gilmore, relating to accusation of patent infringement, involving helical half-round broaching tool, sat as co-lead/second chair to senior partner. Presented JP Tool Ltd.'s case-in-chief, including adverse fact witness and expert witness to establish infringement and damages. After one (1) week trial, adverse directed verdict entered.

Air Products and Chemicals, Inc. v. Chas. S. Tanner, Inc., Civil Action No. 79-826 (D. S. Car. 1983)

Bench trial, Judge G. Ross Anderson, relating to alleged patent infringement and counterclaims for trade secret misappropriation, relating to polyvinyl acetate/ethylene co-polymer emulsions, representing Air Products. Sat co-lead/second chair to lead partner. After two (2) week trial, where presented APCI trade secret case, including direct testimony from fact witnesses, adverse fact witness testimony from Tanner employees, expert testimony from APCI experts and cross-examined Tanner experts, and assisted in presentation of APCI defense of infringement case, case was submitted. Successful ruling of patent infringement claim, adverse ruling concerning trade secret claim. An appeal to United States Court of Appeals for Federal Circuit was filed by Tanner, but the case was settled before any ruling.

See 219 USPQ 223 (D. S. Car 1983).

Picker International, Inc. v. Philips Ultrasound, Inc., Civil Action No. _____ (S. D. Ohio 1985)

Bench trial, Chief Judge Carl B. Rubin, relating to patent infringement for ultrasound imaging device. Lead counsel for Picker International. Presented Picker International case-in-chief, including expert witness to establish infringement. After three (3) days of trial, Phillips requested and accepted settlement that had been refused pre-trial.

Electro-Biology Inc. v. Am Medical Electronics, Inc., Civil Action No. 3-840-0630-6 (N.D. Tex. 1986)

Bench trial, Judge A. Joe Fish, relating to accusation of patent infringement for electrical bone-healing device, sat co-lead/second chair to peer partner. Cross-examined plaintiff's expert witnesses on damage issues and fact witnesses on damages and other relief, took direct testimony from defense damages and relief witnesses, and post-trial briefing, case was submitted. After two (2) week trial, adverse ruling on liability and damages led to appeal before United States Court of Appeals for Federal Circuit. While the appeal was pending, EBI was acquired; a very favorable settlement to AME was then negotiated, resolving the case.

Sturtevant, et al. v. Van Remortel, et al., Civil Action No. 93 Civ. 3466 (JFK) (S.D.N.Y 1995)

Bench trial, Judge John F. Keenan, relating to claim of wrongful procurement of patents on Sturtevant purported inventions (the '562 patent, directed to post-retirement health care funding), and other allegations of misappropriation, breach of contract and unfair competition. Lead counsel for Van Remortel. Following rulings on summary judgment and F. R. Civ. P. 12 motions, matter was called to trial, settlement reached before court during trial through exchange of cross-licenses.

See 38 USPQ2d 1134 (S.D.N.Y. 1995).

Texas Instruments, Inc. v. Cypress Semi-Conductor, et al., Civil Action No. 3-90-1590-H (N.D. Tex. 1995)

Jury trial, Judge Barefoot Sanders, patent infringement of Texas Instruments patents relating to plastic encapsulation of semiconductor devices. Lead counsel for Texas Instruments. Analog Devices, the original first-named defendant, settled on April 1, 1995, on the eve of trial, with substantial cross-licensing rights and resolution of other TI/Analog claims, in TI's favor. After a four (4) week trial, in April – May 1995, jury rendered verdict against three (3) remaining defendants, Cypress Semiconductor Corp., LSI Logic Corp., and VLSI Technologies, Inc. for \$51.8 million in damages, further finding each to be a willful infringer. The trial court granted JMOL against the verdict in August 1995; appeal was taken to the Federal Circuit, which affirmed.

See 39 USPQ2d 1481 (N.D. Tex 1995), *aff'd*, 90 F. 3d 1558 (Fed. Cir. 1996).

Cardinal American Corp. v. Jack Post Corporation, Civil Action No. 97 CV 310 (N.D. Ohio 1997)

Jury trial, Chief Judge Paul R. Matia, in patent infringement/trade dress infringement action, which involved cross-claims under certain Jack-Post and Cardinal patents. Co-lead counsel for Jack Post. After extensive motion practice, case was called for trial in 1999. Examined Jack Post fact and expert witnesses to establish Cardinal infringement, and cross-examined Cardinal expert

witnesses on infringement and damages. Jury verdict for Jack Post for \$1.4 million on its patent claim, with a willful infringement finding by the jury. Post trial motions for JMOL (Cardinal and Jack Post), and for enhanced damages, attorney's fees, and pre-judgment interest (Jack Post), were all decided in Jack Post's favor. Cardinal appealed, but dropped the appeal, and the case settled very favorably to Jack Post.

Picker International, Inc. v. Mayo Foundation, No. 95 cv. 2028 (N.D. Ohio 1998)

Jury trial, Judge James Gwin, relating to Picker's seeking a declaratory judgment of non-infringement and no breach of contract, relating to a Mayo patent directed to software-based artifact correction process for MRI units. Lead counsel for Picker. Presented Picker International case-in-chief, including expert witnesses to establish non-infringement, damages fact and expert witnesses, fact witnesses on infringement and contract issues. While taking Mayo Foundation president as adverse witness, Mayo sought recess and accepted settlement from Picker that had been refused pre-trial.

See 6 F. Supp. 2d 685 685 (N.D. Ohio 1998).

Teleflex, Inc. v. Ficosa International, Inc., Civil Action No. 98-73335 (E.D. Mich. 1998)

Jury trial, Judge John Corbett O'Meara, represented Ficosa in response to accusations of patent infringement regarding three (3) patents relating to automotive transmission cable components. Lead counsel for Ficosa. After summary judgment motion led to a ruling adverse to Ficosa, moved for reconsideration pre-trial based on grant of Ficosa patent over Teleflex patent for accused devices, court vacated summary judgment and set case down for trial. Case was tried and jury verdict rendered in December 2000, resulted in \$500,000 judgment against Ficosa. (A bench trial regarding inequitable conduct was held in March 2001, the court refusing to find the Teleflex patents unenforceable.) After denial of post-trial motions in May 2001, an injunction was entered, and Ficosa appealed. The Federal Circuit affirmed.

See 299 F.3d 1313 (Fed. Cir. 2002).

Exxon Chemical Patents, Inc. v. Lubrizol Corp., Civil Action No. H-89-3203 (S.D. Tex. 1989)

Jury trial, Judge Norman Black represented Lubrizol Corp. Co-lead/second chair, to lead partner. During trial, cross-examined key Exxon fact witnesses, including inventor; cross-examined Exxon technical experts; presented Lubrizol expert witness and fact witness during defense case. Case was tried after extensive pre-trial proceedings including an interlocutory appeal to the Federal Circuit, in December 1992 and November 1993, in two (2) separate jury trials, leading to an adverse jury verdict, later enhanced for willful infringement, and an award of attorneys' fees was entered (30 USPQ 2d 1813 (S.D. Tex. 1994)) against Lubrizol. After two (2) appeals, from the liability and damages verdicts, were briefed and argued, in the Federal Circuit, the court reversed (64 F.3d 1553 (Fed. Cir. 1995)), finding no infringement by Lubrizol, vacating the damages and attorney fee awards, and vacating the permanent injunction. Rehearing was denied (77 F.3d 450 (Fed. Cir. 1996)). *Certiorari* was denied (518 U.S. 1020 (1996)). A motion for a new trial was denied in 1996, but later reversed (137 F.3d 1475 (Fed. Cir.), *cert denied*, 525 U.S. 877 (1998)), and the case remanded. A renewed motion for a new trial was pending when the parties settled (as part of a global litigation settlement), leading to a \$17 million payment to Lubrizol.

See 935 F.2d 1263 (Fed. Cir. 1991) (interlocutory appeal).

Texas Instruments v. Hyundai Electronics Industries, 2:98 CV 74 (E.D. Tex. 1998)

Jury trial, Judge Thad Heartfield, represented Texas Instruments, patent infringement action growing out of expiration of full portfolio patent license to Hyundai under TI's patents. Lead counsel for Texas Instruments. Extensive pre-trial proceedings occurred in advance of selection of jury and trial: the court denied various SJ motions (*see* 42 F.Supp. 2d 660 (E.D. Tex. 1999); 1999 U.S. Dist. LEXIS 21560 (E.D. Tex. 1999)); and ruled on various pre-trial motions, including granting TI's motion to preclude Hyundai's reliance on certain defenses (*see* 50 F. Supp. 2d 619 (E.D. Tex. 1999) [granting motion to preclude for failure to timely disclose prior art information]; 1999 U.S. Dist. LEXIS 21523 (E.D. Tex. 1999) [granting motion to preclude reliance on attorney opinions to avoid willfulness and certain prior art information]; 190 FRD 413 (E.D. Tex. 1999) [denying motion to exclude TI expert testimony]).

A March 1999 jury trial resulted in a \$25.2 million verdict for TI, the jury also finding Hyundai's infringement to be willful. A bench trial then followed on Hyundai's patent misuse defense, which led to ruling in TI's favor (49 F. Supp. 2d 893 (E.D. Tex. 1999).) The case settled while the trial court was considering TI's motion for treble (enhanced) damages, prejudgment interest, and attorneys' fees.

Hyundai took a non-exclusive license and committed to royalty payments of \$1.2 billion over the 10 year life of the license.

Earlier, in *Texas Instruments, Inc. v. Samsung*, Civil Action No. 2:95-CV-1 and 2:96-CV-2 (E.D. Tex. 1996), and related USITC proceedings. *In re Certain Electronic Products, Including Semiconductor Products Manufactured by Certain Processes*, Investigation No. 337-TA-381 (USITC), also represented Texas Instruments as lead counsel, in parallel civil actions and an ITC investigation. The ITC action sought the exclusion of Samsung products made by processes that infringed three (3) TI patents, while the civil actions related to more than ten (10) TI patents.

After extensive discovery hearings and SD motion practice before the ALJ the Commission and the courts, with trial in the ITC investigation imminent, Samsung settled by taking a non-exclusive license and committing to royalty payments of \$1.1 billion over the 10 year life of the license.

See also Texas Instruments Inc. v. Hyundai Elecs. Indus., Co. Ltd., 1999 U.S. Dist. LEXIS 21534 (E.D. Tex. 1999) (Court adopted Special Master claim interpretation.); *Texas Instruments Inc. v. Hyundai Elecs. Indus. Co., Ltd.*, No. 2:98CV0073-TH, 1999 U.S. Dist. LEXIS 11265 (E.D. Tex. 1999) (Special Master found that the claims at issue are not in step-plus-function format, not governed by 35 U.S.C. § 112, ¶ 6.)

Mordeki Drori v. Amiad U.S.A. Inc. d/b/a Amiad Water Systems Technologies, d/b/a Amiad Filtration Systems, Civil Action no. 1:98CV2828 (N.D. Ohio 1998)

Jury trial, Judge Donald C. Nugent relating to patent infringement for filters for agricultural and irrigation applications, and counterclaims for trade secret misappropriation and tortious interference with business relationships. Lead counsel for Amiad U.S.A. Inc. Opposed Drori case-in-chief, presented Amiad defense case and case-in-chief regarding counterclaims. After three (3) days of trial (May 2000), settlement reached through exchange of licenses and releases.

Encyclopaedia Britannica, et al. v. Q. Todd Dickinson, Comm'r of Patents and Trademarks, Civil Action No. 98 CV 00209 (ESH) (D.D.C. 2001)

Bench trial, Judge Ellen Segal Huvelle. Lead counsel for Encyclopaedia Britannica. Case was a *de novo* appeal under 35 U.S.C. § 145, from the USPTO's refusal to issue a reexamination certificate for Britannica's US Letters Patent No. 5,241,671. Commissioner of Patents and Trademarks ordered reexamination of Britannica's Compton patent, which was directed to a multimedia product and process having search/access capabilities. After affirmance of the examiner's rejection of all claims by the Board of Patent Appeals and Interferences (BPAI), Britannica filed a *de novo* action pursuant to 35 USC § 145 to review that decision. After discovery, the trial court ordered the case remanded to the PTO for further proceedings, with the court supervising the proceedings and setting time constraints within which the PTO was required to act. The BPAI affirmed a rejection based on different prior art than that relied on by the examiner before the § 145 action. Proceedings in the § 145 action were resumed, with case being tried before a Special Master in July 2001. The Special Master's post-trial FF/CL report reversed the Board, judgment was entered on the report in November 2001 without appeal by the PTO, and the reexamination certificate issued.

Saudi Basic Industries v. ECAI and Mabal Yanbu, Case No. 00C-07-161, SRJ (Del. Superior Court 2000)

Jury trial, Judge Jan R. Jurden, representing SABIC in a declaratory judgment action seeking to establish that SABIC did not breach two (2) joint venture agreements setting up KEMYA and YANPET (located in Saudi Arabia, producers of polyethylene), by supposedly "overcharging" the joint ventures for use of basic polyethylene production technology owned by SABIC and licensed to the joint ventures. Lead counsel for SABIC. Following extensive motion practice and rulings, including a ruling on the eve of trial on the specifics of Saudi law that controlled the contract interpretations in issue, the case was tried in March 2003. The jury returned an adverse verdict against SABIC. Post-trial motions were filed and denied (2003 WL 22016813 (Del. Super. 2003).) The denial of post-trial motions and the jury verdict were affirmed (866 A.2d 1 (Del. 2005)).

National Instruments Corp. v. The MathWorks, Inc., Civil Action No. 2:01 CV 0011 (TJW) (E.D. Tex. 2001)

Jury trial, Judge T. John Ward, involving allegations of patent infringement of four (4) NI patents relating to software/system modeling of processes. Lead counsel for MathWorks. Following *Markman* claim construction (2002 U.S. Dist. LEXIS 27577 (E.D. Tex. 2002)), the case was tried to a jury to a split infringement verdict in January 2003, with a \$3.5 million damages award. The trial court stayed injunctive relief in view of "substantial" questions for appeal presented by MathWorks, and denied MathWorks post-trial motions (2003 WL 2404 9230 (E.D. Tex. 2003)). The Federal Circuit affirmed the denial of post-trial motions and the judgment (113 Fed. Appx. 895, 2004 WL 2030128 (Fed. Cir. 2004)).

MathWorks then introduced a modification of the accused software product, and ceased to sell the earlier, enjoined product. NI moved for contempt, alleging violation of the injunction. The trial court denied the motion in February 2005, and the Federal Circuit affirmed the denial in February 2006 (F.R. App. P. 38) (164 Fed. Appx. 997, 2006 U.S. App. LEXIS 4068 Fed. Cir. 2006). The case was dismissed by joint motion in December 2010.

NTP, Inc. v. Research in Motion, Ltd., Civil Action No. 3:01 CV 767 (E.D. Va. 2001)

Jury trial, Judge James R. Spencer, accusations of patent infringement relating to wireless “push” email technology, sat co-lead/second chair to peer partner. Partial summary judgment of infringement of certain claims of certain of patents in suit was granted in November 2002 (67 U.S.P.Q.2d 1574 (E.D. Va. 2002).) After (3) week trial, where selected jury, cross-examined plaintiff’s expert witnesses on damages and willfulness issues, took direct testimony from damages and willfulness fact witnesses, and expert testimony as to damages and willfulness, jury rendered adverse verdict on liability and damages. Post trial motions for JMOL/new trial were filed by RIM and denied (67 U.S.P.Q.2d 1587 (E.D. Va. 2003)), while post trial motions filed by NTP for enhanced damages, attorney’s fees and pre/post-judgment interest were granted (67 U.S.P.Q.2d 1594 (E.D. Va. 2003)). The Federal Circuit affirmed. *See* 392 F.3d 1336 (Fed. Cir. 2004), withdrawn in favor of 418 F.3d 1282 (Fed. Cir. 2005). The case then settled.

In the Matter of Certain Electronic Robots and Components Thereof, Investigation No. 337-TA-530 (USITC 2005)

Bench trial, USITC Administrative Law Judge Paul J. Luckern, allegations of patent infringement of Fanuc patent relating to electric robots used in painting automobiles. Lead counsel for Yaskawa. After two (2) week trial to ALJ Luckern, an Initial Determination was entered in Yaskawa’s favor, finding no infringement. Petitions for review of the ID were filed by all parties and denied. Fanuc appealed, Yaskawa cross-appealed. While the appeal was pending, immediately prior to oral argument, Yaskawa (very favorably) settled the investigation and the parallel, stayed district court case, which included two (2) additional patents not involved in the investigation.

Novozymes v. Genencor International, et al., Civil Action No. 05-CV-16 (D. Del. 2005)

Bench trials, Judge Kent L. Jordan, allegations of patent infringement relating to certain alpha amylase enzymes used in the manufacture of fuel ethanol from corn. Lead counsel for Genencor. Novozymes brought on preliminary injunction motion, which, after hearing, was denied by the trial court for failure to show a likelihood of success on the merits, based on new prior art raising questions concerning the validity of the Novozymes’ patent in suit. (79 USPQ2d 1858 (D. Del. 2005)). A bench trial on liability was held in March 2006. The trial court rendered a decision finding liability in 2006 (446 F. Supp. 2d 297 (D. Del. 2006)). Genencor introduced a new, unquestionably non-infringing product in August 2006. A second bench trial on damages and other relief was held in October 2006. The trial court rendered a split decision in February 2007, refusing lost profits damages but awarding a reasonable royalty, entered a finding of willfulness and doubling the damages, awarding limited reasonable attorneys’ fees and entering a permanent injunction directed to the original, replaced product (474 F. Supp. 2d 592 (D. Del. 2007)). The case then settled.

In re Certain Semiconductor Chips With Minimized Chip Package Size and Products Containing Same, Investigation 337-TA-605 (USITC 2007).

Bench trial, USITC Administrative Law Judge Theodore R. Essex. Lead counsel for respondent Freescale Semiconductor in investigation alleging infringement of Tessera patents relating to packaging of semiconductor devices. Final hearing, set to commence February 2008, was stayed by ALJ Essex in view of reexamination rejections of both patents in suit. On appeal of the stay, the Commission reversed, and the Federal Circuit denied a *mandamus* petition. A one week trial before ALJ Essex was held in July 2008, with ID rendered in December 2008 finding no

infringement by respondents. Comm Review followed, with the ID being partially reversed on infringement (June 2009). A motion to stay implementation of relief was denied by the Commission in July 2009; a stay motion in the Federal Circuit was denied in September 2009. The Federal Circuit affirmed in December 2011. Rehearing *en banc* petitions are pending.

Soverain Software LLC v. Newegg, Civil Action No. 6:07-cv-00511 (E.D. Tex. 2007).

Jury trial, Judge Leonard Davis, patent infringement action relating to multiple patents directed to systems and methods applicable to Internet-based e-commerce. Lead counsel for Soverain Software. Several of the defendants took licenses. The parties stipulated to Soverain's claim construction as *Markman* hearing approached. Summary judgment motions by both parties filed and decided, FPC held in January 2010. Newegg brought disqualification motion in March 2010, which was denied by court. (2010 WL 1038731 (E.D. Tex. 2010).) The case was tried to verdict in May 2010, the jury finding that Newegg had induced infringement of two of the three patents in suit, leading to an award of \$2.5 million. Post-verdict motions for further relief and JMOL were decided in August 2010: the court denied all Newegg motions, granted JMOL with respect to non-infringement of the '639 patent, granted a new trial on damages, denied permanent injunctive relief but granted a running royalty for the remaining life of two of the three patents in suit underlying jury's verdict. An appeal is pending.

Network-1 Sec. Solutions, Inc. v. Cisco Sys., Inc., et al., Civil Action No. 6:08-cv-00030-LED (E.D. Tex. 2008)

Jury trial, Judge Leonard Davis, allegations of patent infringement relating to Power over Ethernet technology (IEEE 802.3 standard). Lead counsel for Extreme Networks. After *Markman* claim construction ruling, the Court held the only apparatus claims of the '930 patent-in-suit to be indefinite (692 F. Supp. 2d 632 (E.D. Tex. 2010)), leaving only two method claims in issue. Network-1 demanded \$260 million in past royalties (The loss of the apparatus claims meant Network-1 was not entitled to claim any damages from products sold to customers ex-United States even if shipped from the United States.).

At the end of the third day of trial, Cisco announced that it had reached a settlement with Network-1. At the end of the fourth day of trial, the Court announced that he would give the jury the next day off and facilitate additional discussions between the parties instead. All remaining defendants then negotiated settlements, with Extreme settling last.