

**Kenneth R. Adamo**  
**Significant Lead Trial Counsel Representations**  
**(July 2019)**

**Maxell, Ltd. v. Huawei Device USA, Inc. et al.**

Representing Huawei in *Maxell, Ltd. v. Huawei Device USA, Inc. et al.*, 5:18-cv-00033, in the United States District Court for the Eastern District of Texas before Judge Schroeder. Maxell sued in March 2018, asserting infringement of 10 patents covering a variety technology including 3G cellular standards, image capture and storage, fingerprint scanners, and power management. The case is part of a global patent infringement battle between Maxell and Huawei, and Maxell has accused dozens of different Huawei devices of infringement. Huawei filed its answer on June 13, 2018. On August 29, 2018, the case was consolidated with a case against ZTE involving the same set of patents. On September 11, 2018, the court entered a docket control order setting the case for trial starting February 24, 2020, with dispositive motion deadline of September 20, 2019 and a Markman hearing on April 10, 2019. Also on September 11, 2018, the court entered a discovery order concerning initial disclosures, patent disclosures, depositions, expert discovery, etc. The court has set a case management conference for Oct. 2, 2018 to finalize a protective order and resolve certain issues relating to source code access, which will also mark the official opening of discovery. A number of petitions for *inter partes* review by the USPTO are in progress as well.

**Intellectual Ventures II LLC v. JP Morgan Chase & Co.**

*Intellectual Ventures II LLC v. JP Morgan Chase & Co., et al.*, in the United States District Court for the Southern District of New York, Case No. 1:13-cv-03777; *Intellectual Ventures II LLC v. SunTrust Banks, Inc., et al.*, in the United States District Court for the Northern District of Georgia, Case No. 1:13-cv-02454; *Intellectual Ventures II LLC v. First National Bank of Omaha*, in the United States District Court for the District of Nebraska, Case No. 8:13-cv00167; *Intellectual Ventures II LLC v. BBVA Compass Bancshares, Inc., et al.*, in the United States District Court for the Northern District of Alabama, Case No. 2:13-cv-01106; *Intellectual Ventures II LLC v. Commerce Bancshares, Inc., et al.*, in the United States District Court for the Western District of Missouri, Case No. 2:13-cv-04160; *Intellectual Ventures II LLC v. U.S. Bancorp., et al.*, in the United States District Court for the District of Minnesota, Case No. 0:13-cv-02071; and *Intellectual Ventures II LLC v. Huntington Bancshares Inc., et al.*, in the United States District Court for the Southern District of Ohio, Case No. 2:13-cv00785.

Intellectual Ventures II LLC (“IV II”) filed these patent infringement lawsuits between May 29, 2013 and August 7, 2013 against a variety of banking and financial services companies (the “Defendants”), alleging infringement of five patents. In particular, IV II alleged that the banks’ use of IBM’s z System mainframes (“z Systems”) infringe United States Patent No. 7,634,666 (the “’666 patent”).

On January 20, 2015, Intellectual Ventures II LLC sued Great West Casualty Company in the Eastern District of Texas.

On February 23, 2016, Intellectual Ventures II LLC sued Kemper Corporation, Trinity Universal Insurance Co d/b/a Kemper Preferred, Unitrin County Mutual Insurance Co. d/b/a Kemper Direct and Kemper Specialty, and Charter Indemnity Co. d/b/a Kemper Specialty in the Eastern District of Texas. IV alleged infringement of United States Patent Nos. 6,516,442 and 7,516,177 (the “’177 patent”). In particular, IV alleged that defendants’ use of systems that implement WebSphere Portal infringe the ’177 patent.

On October 29, 2013, Judge Alvin K. Hellerstein of the United States District Court for the District of New York held a technology tutorial in the JP Morgan Chase & Co. (“JPMC”) case. The judge held a *Markman* hearing on March 5 and 6, 2014, and issued a claim construction order on March 18, 2014, directed to the ’666 patent and United States Patent Nos. 6,715,084 (the “’084 patent”); 6,314,409 (the “’409 patent”); 5,745,574 (the “’574 patent”); and 6,826,694 (the “’694 patent”). Claim construction was fully briefed in the SunTrust Banks, Inc. (“SunTrust”) case, but a *Markman* hearing has not taken place.

On January 15, 2014, Intellectual Ventures I and Intellectual Ventures II (collectively, “IV”) filed a new case, *Intellectual Ventures I LLC, et al. v. Capital One Financial Corp., et al.*, in the United States District Court for the District of Maryland, Case No. 8:14-cv-00111, alleging infringement by Capital One Financial Corp. (“Capital One”) of the ’084 patent; the ’409 patent; and United States Patent Nos. 6,819,271 (the “’271 patent”); 7,984,081 (the “’081 patent”); and 6,546,002 (the “’002 patent”). In particular, IV alleged infringement of the ’081 patent by systems running IBM DB2 software. Raphael Lupo was appointed as Special Master in the case.

On June 24, 2014, IV filed a new case, *Intellectual Ventures I LLC, et al. v. Citigroup, Inc., et al.*, in the United States District Court for the Southern District of New York, Case No. 1:14cv-04638. IV alleged infringement of the ’574; ’002; ’271; ’666; and ’081 patents. In particular, IV alleged infringement of the ’666 patent by use of z Systems; infringement of the ’271 patent by use of compression features within IBM Netezza systems; and infringement of the ’081 patent by systems running IBM DB2 software.

Also on June 24, 2014, IV filed a new case, *Intellectual Ventures I LLC, et al. v. PNC Financial Services Group, Inc., et al.*, in the United States District Court for the Western District of Pennsylvania, Case No. 2:14-cv-00832. IV alleged infringement of the ’574; ’002; ’409; and ’666 patents, as well as United States Patent No. 7,757,298. In particular, IV alleged infringement of the ’666 patent by the use of z Systems.

Representing defendants as lead counsel or co-counsel in each case.

IV served infringement contentions upon First National Bank of Omaha (“FNBO”) (November 22, 2013); Commerce Bancshares, Inc. (“Commerce”) (November 25, 2013); SunTrust (November 25, 2013); Huntington Bancshares Inc. (“Huntington”) (December 2, 2013); BBVA Compass Bancshares (“BBVA Compass”) (December 23, 2013); and U.S. Bancorp (January 10, 2014). IV served supplemental infringement contentions upon SunTrust on March 6, 2014, and second supplemental infringement contentions upon SunTrust on July 18, 2014. IV served infringement contentions upon Capital One on July 21, 2014. IV served supplemental infringement contentions upon Capital One on September 22, 2014, and on JPMC on September 30, 2014. IV served contentions identifying asserted claims upon Citigroup (“Citi”) on December 24, 2014, and additional supplemental contentions on JPMC on January 5, 2015 and January 22, 2015. IV served supplemental infringement contentions on January 20, 2015 and January 28, 2015. IV’s January 20, 2015 contentions against Capital One newly identified IBM Security Fusion as potentially meeting certain elements of the asserted ’084 patent claims. IV served supplemental contentions on Citi on May 11, 2016.

On February 20, 2015, Capital One moved to strike IV’s infringement contentions relating to improperly identified instrumentalities, and moved to compel sufficient infringement contentions from IV on several of the remaining accused products. At the same time, IV moved to compel supplemental interrogatory responses from Capital One relating to identification of relevant products. Oppositions were filed on February 25, 2015, and replies were filed on February 27, 2015. On April 23, 2015, the special master denied Capital One’s request to strike

improperly identified instrumentalities, granted in part its request to compel sufficient infringement contentions, granted IV's motion to compel sufficient interrogatory responses, granted in part IV's motion to strike portions of the invalidity contentions, and granted IV's motion to compel proper invalidity contentions. On May 7, 2015, Capital One sought reconsideration of the special master's report and recommendation. On May 19, 2015, the special master granted Capital One's request, adjusting the deadlines for supplemental invalidity contentions but keeping in place limitations on the number of references. Capital One objected to the special master's report and recommendation, and the objections are now fully briefed.

On March 2, 2015, Capital One was granted leave to amend its answer to assert anti-trust counterclaims against IV. IV moved to dismiss the counterclaims on March 19, 2015, Capital One filed its opposition to the motion on April 3, 2015, and the reply was filed April 20, 2015. On May 8, 2015, three joined IV entities (Intellectual Ventures Management LLC, Invention Investment Fund I LP, and Invention Investment Fund II LLC) also filed motions to dismiss and strike the antitrust counterclaims. On July 1, 2015, the court denied the motion to dismiss but requested supplemental briefing on whether the IV entities are separate companies. Capital One filed its brief on this issue on July 22, 2015. On January 14, 2016, the court granted the IV's motion to dismiss as to the original IV entities (Intellectual Ventures I LLC and Intellectual Ventures II LLC) without prejudice to re-plead before February 4, 2016. The court denied the three joined IV entities' motion to dismiss.

The parties in the Commerce case participated in a settlement conference before Magistrate Judge Knox on November 12, 2013, but did not settle IV's claims. The contentions served upon Huntington with respect to the '084 and '694 patents cited IBM products, including Trusteer Pinpoint and Rapport. The contentions served upon U.S. Bancorp and the supplemental contentions served upon SunTrust, with respect to the '694 patent, cited IBM products including Trusteer Pinpoint, Rapport, Apex, and certain functions within the z/OS operating system: AT-TLS and CS IPsec. The contentions served upon Capital One with respect to the '084 patent and the '081 patent cited IBM Proventia; IBM RealSecure; IBM SiteProtector; IBM Virtual Patch; IBM BigFix primary IP patching server, including threat intelligence feeds from IBM X-Force Advantage; IBM DB2 software; and IBM Websphere, including Websphere Application Server; IBM HTTP Server; and IBM Worklight Server. The most recent supplemental contentions served upon JPMC regarding the '666; '409; '084; '694; and '574 patents cited the 4765 Crypto Coprocessor; IBM Infosphere Guardium products including Data Encryption; Data Security Data Activity Monitor; Guardium S-TAP for DB2 z/OS; Guardium S-TAP for VSAM; and Guardium S-TAP for IMS; z/OS PKI Services; and TN3270 terminal access protocol.

On October 14, 2014, JPMC moved to strike IV's contentions with respect to products and claims not raised in its initial contentions, which was denied. On October 16, 2014, Capital One wrote to the court informing it of disputes with respect to the sufficiency of IV's infringement contentions with respect to late identification of accused instrumentalities, insufficient detail, and conception and reduction to practice dates, and the court ordered the party to meet and confer with technical experts present.

FNBO, Huntington, Commerce, and SunTrust Bank served invalidity contentions on IV throughout the month of January 2014. On January 22, 2014, IV served a notice of subpoena to IBM in the case against FNBO. IBM served a response and objections on February 7, 2014, and efforts to collect and produce documents in response to the subpoena are ongoing. IV served a notice of subpoena to IBM and several IBM personnel in the case against SunTrust on March 4, 2014. IV also served a notice of subpoena to Trusteer in the case against SunTrust on March 7, 2014. IV served a notice of subpoena to IBM in the case against JPMC on June 18, 2014. IV's counsel also communicated their intent to take depositions of additional IBM

personnel in the JPMC case. On November 21, 2016, IV filed a motion to compel IBM's compliance with a subpoena served on IBM in the case against Capital One. IBM filed its opposition on December 12, 2016. IV filed its reply on December 12, 2016, and IBM filed an objection to the reply evidence on December 14, 2016. Oral argument was heard on January 3, 2017. On January 5, 2017, the court issued an order denying the motion and quashing the thirdparty subpoena.

IBM filed a petition for *inter partes* review ("IPR") to invalidate claims of the '666 patent on November 20, 2013. PTAB instituted the IPR for all challenged claims on April 16, 2013. On April 3, 2015, the PTAB issued a final decision declining to find the challenged claims unpatentable. On June 1, 2015, IBM filed a Notice of Appeal to the Federal Circuit. On February 8, 2016, the court affirmed the PTAB's decision.

IBM filed further IPR petitions challenging the validity of claims of the '694 patent on April 7, 2014; the '574 patent on April 17, 2014; the '409 patent on April 18, 2014; and the '084 patent on April 23, 2014. IBM filed a second petition for IPR relating to the '574 and '694 patents between August 28, 2014 and September 9, 2014.

On September 24, 2014, the PTAB instituted an IPR for all challenged claims of the '694 patent. On February 17, 2015, the PTAB instituted an IPR on all challenged claims of the '694 patent on IBM's second petition. On September 23, 2015, the PTAB issued its final written decision in IBM's first IPR against the '694 patent finding that IV established an earlier date of conception and reduction to practice. The PTAB thus declined to invalidate the challenged claims. On September 29, 2015, IBM filed a request for rehearing, which was denied.

On October 20, 2014, the PTAB instituted an IPR for all challenged claims of the '574 patent. On December 18, 2014, the PTAB instituted an IPR on all challenged claims of the '574 patent on IBM's second petition. On October 19, 2015, the PTAB concluded that claims 18-31 of the '574 patent are unpatentable. IV did not file a notice of appeal regarding the '574 patent.

On September 22, 2014, the PTAB declined to institute an IPR of the '409 patent. IBM requested rehearing on October 21, 2014, which was denied on December 23, 2014. On January 22, 2015, IBM filed a petition for *writ of mandamus* with the Federal Circuit, requesting the court to direct the PTAB to issue a consistent standard for reviewing IPR petitions and supporting evidence, and in view of this standard, reconsider IBM's IPR petitions of the '409 patent. On March 24, 2015, the Federal Circuit denied IBM's petition for *writ of mandamus*.

On October 30, 2014, the PTAB instituted an IPR on claims 26, 28, and 30-33 of the '084 patent but declined to institute an IPR on the other challenged claims. IBM requested reconsideration of the PTAB's decision on the '084 patent, which was denied on December 11, 2014. On October 21, 2015, the PTAB concluded that claims 26, 28, and 30-33 of the '084 patent are unpatentable. On December 18, 2015, IV filed a notice of appeal regarding the '084 patent. IV's opening brief was filed on April 28, 2016. IBM's response brief was filed on July 7, 2016. IV's reply brief was filed on August 23, 2016. A corrected Joint Appendix was filed on September 2, 2016. Oral argument was heard on March 7, 2017. On March, 27, the Appeal Court affirmed the PTAB's final written decision in IPR2014-00682 cancelling claims 26, 28, and 30-33, and dismissing IV's appeal and IBM's cross-appeal in IPR2014-00801 as moot. The formal mandate issued on May 03, 2017. The deadline to petition for a Writ of Certiorari is June 26, 2017.

On August 26, 2014, IBM filed a petition for IPR relating to the '081 patent. The PTAB instituted an IPR on all challenged claims of the '081 patent on February 11, 2015. On January

15, 2016, the PTAB concluded that claims 1-4, 10-13, and 21-24 of the '081 patent are unpatentable. On March 17, 2016, IV filed a notice of appeal regarding the '081 patent. IV tendered its opening brief on August 26, 2016, which was rejected on August 30, 2016. IV filed a corrected opening brief on September 1, 2016. On September 21, 2016, IBM was granted a 60-day extension to file response brief. IBM filed their opening brief on December 5, 2016. Settlement discussions took place on December 12, 2016 and it was concluded that the case was not amenable to settlement at this juncture. On December 13, IV was granted a 30-day extension to file reply brief. IV's reply brief was filed on January 18, 2017. The joint appendix was filed on January 25, 2017. On April 27, 2017, IV filed a motion to voluntarily dismiss the appeal. The motion was granted on May 3, 2017.

On September 17, 2014, IBM filed a petition for IPR relating to the '298 patent. On March 30, 2015, the PTAB declined to institute an IPR on the '298 patent.

On October 17, 2014, IBM filed a petition for IPR relating to the '002 patent. The PTAB instituted an IPR on claims 1, 2, 4, 6-12, 14, 16-26, 28, and 30-49 of the '002 patent. On April 25, 2016, the PTAB concluded that all challenged claims of the '002 patent are unpatentable. On June 24, 2016, IV filed a notice of appeal regarding the '002 patent. On September 28, 2016, IV was granted a 42-day extension to file its opening brief, now due on November 18, 2016. On November 18, 2016, IV filed its opening brief. On December 1, 2016, IBM was granted a 42-day extension to file its principal brief. IBM's principal brief is now due February 8, 2017. On February 15, IV was granted a 27-day extension to file reply brief. On March 14, 2017, IV filed a second motion for an extension of time to file reply. On March 15, 2017 IV was granted a 30-day extension to file reply brief. On April 21, 2017, IV filed a motion to voluntarily dismiss the appeal. The motion was granted on April 21, 2017.

On November 25, 2014, IBM filed four petitions for IPR relating to the '271 patent. On June 2, 2015, the PTAB instituted an IPR on all challenged claims of the '271 patent. On April 22, 2015, IBM filed an additional petition for IPR relating to the '271 patent. On October 28, 2015, the PTAB instituted an IPR on all challenged claims in IBM's additional IPR petition relating to the '271 patent. On May 27, 2016, the PTAB found all instituted claims from the first four petitions unpatentable. On July 21, 2016, the PTAB held an oral argument in the additional IPR. On October 26, 2016, the PTAB found all instituted claims from the additional petition unpatentable.

On June 23, 2015, IBM filed a petition for IPR relating to the '434 patent. On January 11, 2016, the PTAB instituted an IPR on claims 1-3, 5, and 6 of the '434 patent. On August 12, 2016, the PTAB, after request from both parties, ordered an oral hearing for September 14, 2016. On January 9, 2017, the PTAB concluded that claims 1-3, 5, and 6 of the '434 patent are unpatentable. On March 14, 2017, IV filed a notice of appeal regarding the '434 patent. On May 25, 2017, IV filed a motion to voluntarily dismiss the appeal. The motion was granted on May 25, 2017.

On July 2, 2015, IBM filed two petitions for IPR relating to the '581 patent. On April 18, 2016, the PTAB declined to institute IPRs on the '581 patent.

On June 1, 2015, IBM filed additional IPR petitions relating to the '409 patent. On December 8, 2015, the PTAB instituted IPR trials on all challenged claims of the '409 patent. On March 4, 2016, IV indicated to the PTAB that it will no longer participate in the IPR trials. On April 7, 2016, the PTAB terminated IBM's IPRs as moot except as to claim 40 which remains active in the IPR. On July 12, 2016, the PTAB held an oral hearing; IV did not participate. On July 12, 2016, the PTAB held an oral hearing, IV did not participate. On September 27, 2016, the PTAB concluded that claim 40 of the '409 Patent has not been shown to be unpatentable.

Stays have been granted in the FNBO; Commerce; BBVA Compass; Huntington; U.S. Bancorp; and SunTrust cases, pending further action from the PTAB in the IPRs. On August 12, 2014, the PNC Financial Services Group, Inc. (“PNC”) case was consolidated with existing litigation between PNC and IV and stayed. IV moved to deconsolidate the cases and lift the stay on October 13, 2015 after voluntarily dismissing several claims, but the motion was denied on October 27, 2015. Citibank moved to stay its case on October 7, 2014, which were heard on November 4, 2014, along with the discovery motions and motion to strike pending in JPMC.

JPMC’s motion to stay proceedings was denied on August 11, 2014. JPMC filed a notice of appeal of the denial to the Federal Circuit on August 13, 2014. The district court stated it would not stay the case while the appeal is pending. On April 1, 2015, the Federal Circuit denied JPMC’s appeal (F.3d (Fed Cir. 2014)). JPMC petitioned for rehearing *en banc* on May 1, 2015. Three *amicus* briefs were filed in support of JPMC’s petition. After calling for a response from Intellectual Ventures, the Federal Circuit denied JPMC’s rehearing petition on June 26, 2015.

On October 17, 2014, JPMC moved for summary judgment of invalidity for lack of patentable subject matter under § 101 as to the ’694, ’409, and ’084 patents. IV responded on November 3, 2014. A hearing was held on January 5, 2015. On April 28, 2015, the court granted JPMC’s motion for summary judgment, concluding that the ’694, ’409, and ’084 patents were invalid under § 101. On January 20, 2015, Capital One moved for summary judgment of invalidity for lack of patentable subject matter under § 101 as to the ’409, ’081, ’002, and ’084 patents. IV cross-moved for summary judgment of validity on February 19, 2015. Capital One filed its reply and opposition to IV’s cross-motion on March 26, 2015, and IV replied in support of its motion on April 6, 2015. The court held oral argument, accompanied by a technology tutorial, on April 16, 2015. In light of the recent decision in the JPMC case, the deadline for the special master in Capital One to submit his report and recommendation on § 101 issues was extended until June 11, 2015 to consider issue preclusion, with the parties to exchange briefing on the issue. Discovery as to the ’084 and ’409 patents in Capital One was also stayed for 30 days, until June 1, 2015. On May 12, 2015, the special master in Capital One issued a report and recommendation that the ’002 and ’081 patents were not unpatentable under § 101. Capital One has filed objections to the report and recommendation of the special master, which are now fully briefed. On June 11, 2015, the special master in Capital One issued a report and recommendation that the ’084 and ’409 patents were unpatentable under § 101, but that IV was not subject to issue preclusion based on the JPMC decision. Capital One and IV both filed objections to the report and recommendation on June 25, 2015, and both sets of objections are now fully briefed. The court held a hearing on the objections on August 20, 2015. On September 2, 2015, the court in Capital One rejected the special master’s conclusions of law as to the ’081 and ’002 patents and found them invalid under § 101. On September 4, 2015, the court in Capital One rejected the special master’s conclusions of law as to issue preclusion and granted summary judgment as to the invalidity of the ’084 and ’409 patents on those grounds without reaching the actual question of invalidity under § 101. On September 8, 2015, the court entered judgment in favor of Capital One as to the patent claims only, leaving open the antitrust counterclaims.

IV filed a notice of appeal on October 8, 2015. On November 10, 2015, IV also filed a motion to vacate the court’s order with respect to issue preclusion, which was denied on December 23, 2015. IV filed its opening brief in the Federal Circuit appeal on January 14, 2016, and moved to withdraw its appeal as to the ’409 patent on March 8, 2016. The Federal Circuit granted that motion on March 23, 2016. Capital One filed its responsive brief on March 28, 2016. IV tendered its reply brief on April 28, 2016. The joint appendix was filed on May 5, 2016. IV cited supplemental authority on May 13, 2016, and Capital One responded on May 20, 2016. IV filed further supplemental authority on July 6, 2016, and Capital One responded on July 25, 2016. Capital One cited supplemental authority on September 28, 2016, and IV responded on

September 29, 2016. IV cited supplemental authority on September 29, 2016, and IV responded on October 4, 2016. Capital One cited supplemental authority on October 4, 2016. Oral argument took place on October 6, 2016. On March 7, 2017, the Federal Circuit held that the asserted claims of the '081 patent do not meet the standard for eligibility under § 101 and affirmed the district court's entry of summary judgment ( \_F.3d\_(Fed Cir. 2016)). In turning to the '002 patent, the Court referred to the opinion in the companion case (Intellectual Ventures I LLC v. Erie Indemnity Co., Nos. 2015-1128, -1129, -1132) in affirming the district court's dismissal under Rule 12. The deadline to petition for a Writ of Certiorari passed on June 5, 2017. On July 11, 2017, in the District of Maryland, IV filed a motion for Summary Judgment on claim counts one, two, and three of the Third-Party Complaint and counterclaim counts twelve, thirteen, and fourteen of the Fourth Amended Answer, Defenses, and Counterclaims. On August 10, 2017, Capital One filed an opposition to the motion.

On October 1, 2015, IV moved for entry of judgment under rule 54(b) in the JPMC case on its claims regarding the '084, '409, and '694 claims. The motion was denied without responsive briefing on October 14, 2015.

On May 12, 2015, JPMC moved for summary judgment of no infringement of the '666 patent. The court denied the motion without prejudice to refile at the close of discovery on June 30, 2015. On May 13, 2015, JPMC also moved to strike IV's infringement contentions with respect to the '574 patent. On June 22, 2015, the court denied the motion to strike but required IV to amend its contentions. On June 9, 2015, IV filed a motion under Fed. R. Civ. P. 37 for sanctions against JPMC based on spoliation, JPMC responded on June 29, 2015 and IV replied on July 7, 2015. On September 16, 2015, IV attempted to submit a letter supplementing its motion for sanctions. IV's motion for sanctions was denied on September 17, 2015, although IV was granted leave to move for fees at the close of discovery.

The court in JPMC and Citi held a scheduling and discovery hearing on December 11, 2014. Both JPMC and IV were ordered to produce further documents, the discovery schedule was extended, and the court indicated that prior limits on deposition hours would be relaxed. The court denied Citi's motion for a stay and set a claim construction hearing for March 26, 2015. The parties in Citi exchanged proposed claim terms and constructions on January 13, 2015, and responsive claim constructions on January 23, 2015. Opening claim construction briefs were filed on February 13, 2015, and responsive claim construction briefs were filed on March 6, 2015. The court held a technology tutorial and *Markman* hearing on March 24-26, 2015 and issued a preliminary claim construction order on May 19, 2015. The parties filed supplemental claim construction statements on June 11, 2015 and responsive supplemental briefs on June 19, 2015. The court in Citi issued a final order regarding claim construction on June 30, 2015.

On September 17, 2015, IV agreed to dismiss with prejudice its claims against JPMC on the '574 patent, leaving only the '666 patent claims. On October 16, 2015, JPMC moved again for summary judgment of no infringement of the '666 patent as well as a motion to strike IV's infringement contentions and dismiss. The court heard both motions on January 21, 2016 and granted in part JPMC's motion to strike requiring the parties to meet and confer regarding sufficient contentions. On June 15, 2016, the court ordered that, if IV wished to reconstrue a claim term at issue in the motion, it must bring a motion and reserved ruling on the motion for summary judgment until that question was resolved. IV moved to reconstrue the term on June 29, 2016. JPMC responded on July 14, 2016, and Judge Hellerstein denied the motion to reconstrue on July 20, 2016. Judge Hellerstein denied the motion for summary judgment on July 21, 2016 and asked the parties to meet and confer about the scheduling and scope of damages and expert discovery. JPMC moved for reconsideration of the denial of the motion for summary judgment on August 4, 2016, and IV responded on August 18, 2016. On August 22, 2016, Judge Hellerstein denied the motion for reconsideration.

Judge Hellerstein asked the parties to prepare a stipulation on the scope of remaining damages fact discovery, and the parties set forth their positions on the scope of discovery in a letter to Judge Hellerstein on October 5, 2016. On December 5, 2016, IV filed a motion to compel JPMC to produce ECC related discovery and for sanctions. On December 12, 2016, JPMC filed an opposition to the motion. On December 15, 2016, IV filed its reply. On December 19, 2016, JPMC filed a surreply to the motion to compel. On December 22, 2016 the Court denied JPMC's motion to file a sur-reply. Oral argument took place on January 23, 2017. On January, 24, 2017, the Court denied IV's motion and ruled that IV may issue an additional limited interrogatory to JPMC.

On December 16, 2016, IV served infringement and damages expert reports and JPMC served invalidity expert report. On February 3, IV served a supplement damages report in JPMC. On February 17, 2017, the parties exchanged the last round of expert report, namely: (i) IV's responsive validity report, (ii) IV's responsive non-infringing alternative reports, (iii) JPMC's responsive noninfringement report, (iv) JPMC's responsive damages report, and (v) JPMC's technical report on encryption. On February 1, JPMC moved to strike portions of IV's infringement expert (Dr. Wolfe) report. On February 8, IV filed an opposition to the motion and JPMC filed its reply on February 10, 2017. On February 7, 2017, JPMC moved to strike Mr. Michael Wagner's supplemental expert opinions. On February 14, 2017 IV filed an opposition to the motion and JPMC filed its reply on February 16, 2017. On February 9, 2017, JPMC filed a Daubert motion seeking to exclude opinions of IV's technical expert (Dr. Wolfe) relating to encryption. On February 23, 2017 IV filed an opposition to the motion and JPMC filed its reply on March, 2, 2017. On February 24, 2017 JPMC filed a Daubert motion regarding the report of IV's damages expert (Dr. Wagner). On March 10, 2017 IV filed an opposition to the motion and JPMC filed its reply on March, 17, 2017. On February 28, 2017 JPMC filed a renewed motion for summary judgment of noninfringement. On March 21, 2017 IV filed an opposition to the motion and JPMC filed its reply on March, 31, 2017. On March 22, 2017 JPMC filed a second Daubert motion regarding the report of IV's damages expert (Dr. Wagner). On April 5, 2017, IV filed an opposition to the motion and JPMC filed its reply on April, 12, 2017. On April 14, 2017, JPMC filed a Motion to exclude supplemental opinions of Dr. Andrew Wolfe. On, April, 20, 2017, IV filed a motion to Compel JPMC to allow IV to inspect Source Code. On April 24, 2017 JPMC filed an opposition to the motion.

A status hearing was held on April 25, 2017. The Court granted-in-part JPMC's motion for summary judgment, ruling there has been no infringement of the '666 patent by JPMC's use of the Crypto Cards. The Court declined, however, to grant summary judgment of noninfringement as to whether the Cards are capable of infringing the '666 patent, IV's counsel stated that it wished to proceed with the case, and that a damages case would be made out. The Court denied IV's motion to compel JPMC to make IBM source code available for review. The Court denied JPMC's motion to strike IV's infringement expert's (Dr. Wolfe) opinions that Elliptic Curve Diffie Hellman (ECDH) is an infringing use of the Cards. The Court denied JPMC's motion to exclude the opinions of Dr. Wolfe related to encryption. The Court granted JPMC's motion to exclude the supplemental infringement opinions of Dr. Wolfe as untimely. The Court granted JPMC's motion to strike IV's damages expert's (Mr. Wagner) opinions relying upon the deposition testimony of Nathan Myhrvold. The Court denied (as premature) JPMC's motion to exclude the opinions of Mr. Wagner related to his reliance upon a software (not a patent) license as the basis of his royalty rate, and failure to apportion the same. The Court denied JPMC's motion to exclude the opinions of Mr. Wagner related to non-infringing alternatives. On, May 9, 2017, IV filed a motion for reconsideration of the court's order granting JPMC's motion to exclude Dr. Wolfe's supplemental report. On May 19, 2017, JPMC filed an opposition to the motion and IV filed its reply on May 24, 2017.

On, May 9, 2017, IV filed a motion for reconsideration of the court's order insofar as it grants partial summary judgment in favor of JPMC. On May 23, 2017, JPMC filed an opposition to the motion and IV filed its reply on May 30, 2017. On, June 6, 2017, IV filed a motion to exclude untimely third-party evidence and preclude JPMC's expert from relying on the same. On June 13, 2017, JPMC filed an opposition to the motion and IV filed its reply on June 15, 2017. On June 7, 2017, JPMC filed a motion for partial summary judgment of non-infringement of claim 4 of U.S. patent 7,634,666. On June 21, 2017, IV filed its opposition to the motion and JPMC filed its reply on June 28, 2017. On June 16, 2017, JPMC filed a third *Daubert* motion to exclude opinions of Mr. Michael J. Wagner. On June 30, 2017, IV filed its opposition to the motion and JPMC filed its reply on July 7, 2017. On June 19, IV filed a motion for Summary Judgment that JPMC is Estopped from Asserting that the Combination of the Matsuzaki and Glaser Patents Renders the Asserted Claim of the '666 Patent Obvious. On July 3, 2017, JPMC filed its opposition to the motion and IV filed its response on July 10, 2017.

On July 12, 2017, the Court granted IV's motion for consideration. Upon reconsideration, the court held that JPMC has not infringed, and is not infringing, the '666 Patent, and that defendants are entitled to summary judgment dismissing the complaint (F. Supp 2d (SDNY 2017)). In so holding, the Court ruled all other pending motions as moot. On August 10, 2017, IV filed a notice of appeal to the United States Court of Appeals for the Federal Circuit. The appeal was docketed on August 15, 2017.

On November 9, 2015, Citi moved for summary judgment of invalidity of the '002 and '081 patents, based on district court rulings in *Intellectual Ventures I LLC v. Old Republic Gen. Ins. Grp., Inc.*, No. 2:14-cv-01130 (W.D. Pa. Sept. 25, 2015) and the Capital One litigation, which was denied on January 19, 2016. On November 30, 2015, IV stipulated to dismissal with prejudice of its claims relating to the '574 patent. On January 27, 2016, IV stipulated to dismissal without prejudice of its claims relating to the '002 and '081 patents. On January 13, 2017, Citi moved for summary judgment of invalidity of claim 4 of the '666 patent. IV filed its opposition on February 17, 2017 and Citi filed its reply on March 3, 2017. Oral argument was heard on June 28, 2017. On July 10, 2017, the Court denied Citi's motion for summary judgment. On August 14, 2017, Citi moved for summary judgment of non-infringement of claim 4 of the '666 patent based on issue preclusion.

On April 18, 2016, Trinity Universal Insurance Company, Charter Indemnity Company, and Unitrin County Mutual Insurance Company answered Intellectual Ventures' complaint in the *Kemper* case, while Kemper Company moved to dismiss for lack of personal jurisdiction. IV answered the counterclaims on May 4, 2016 and responded to the motion to dismiss on May 19, 2016. Kemper replied on June 7, 2016, and IV surreplied on June 17, 2016. The court has ordered early and expedited discovery as to personal jurisdiction. Kemper moved to stay the litigation on June 22, 2016, and the motion is now fully briefed. Kemper withdrew its motion to dismiss for lack of personal jurisdiction on July 15, 2016 and a corrected answer was filed on August 1, 2016. IV replied to the corrected counterclaims on August 18, 2016. On September 27, 2016, the court heard argument on Kemper's opposed motion to stay. On October 6, 2016, it was ordered that all claims against Kemper concerning the '442 patent are severed into a separate cause of action. The newly severed was stayed pending resolution of IV's claims concerning the '442 patent in the related case *Intellectual Ventures I, LLC v. Lenovo Group Ltd.*, No. 1:16-cv-10860 (D. Mass.). The '177 patent remained active in the case. Kemper's motion to stay proceedings was denied on November 7, 2016. The parties in *Kemper* exchanged proposed claim terms on November 22, 2016 and preliminary claim constructions on December 13, 2016. On December 28, 2016, Kemper moved for summary judgment of invalidity for lack of patentable subject matter under § 101 as to the '177 patent. IV responded on January 11, 2017 and Kemper replied on January 18, 2017. IV filed a sur-reply on January 25, 2017. On January 3, 2017 the parties filed a Joint Claim Construction Statement and

Prehearing Statement. On February 13, 2017, Kemper filed an unopposed motion to stay the case pending the PTAB's final decision in the Oracle IPR(IPR2016-01434). The motion was granted on February 16, 2017.

On May 9, 2016, IV filed a motion to compel IBM to make available additional source code relating to Netezza in the Citi case. IBM responded on May 19, 2016. IV replied on May 23, 2016. The court granted the motion on June 20, 2016, but the same day, IV stipulated to dismissal without prejudice of its claims relating to the '271 patent, mooting the discovery.

On July 7, 2016, IV moved to compel answers to interrogatories regarding the relationship between Citi and IBM with respect to IBM's *inter partes* review of the '666 patent. Citi responded on July 22, 2016, and Judge Hellerstein granted the motion on July 27, 2016. Citi served supplemental interrogatory responses on August 12, 2016.

On August 11, 2017, IV and U.S. Bancorp stipulated and agreed to dismiss with prejudice Counts I, II, III and IV of IV's complaint (Dkt. No. 1) and to dismiss without prejudice Counts I, II, III, IV, V, VI, VII and VIII of U.S. Bancorp's counterclaims (Dkt. No. 24), relating to the '574, '694, '084 and '409 patents. On August 21, 2017, IV filed an unopposed motion to stay pending IV's appeal concerning the '666 patent in the JPMC case. The Court held a status conference on August 28, 2017.

On August 22, 2017, IV and FNBO stipulated and agreed to dismiss with prejudice Counts I, II, III, and IV of Plaintiff's Complaint (Dkt. No. 1), relating to the '574, '694, '084 and '409 patents.

The remaining major district court deadlines through the end of September 2017 include the following - **For Capital One Case:** (1) August 31, 2017 - IV Reply in Support of Summary Judgment Motion; **For Citibank Case:** (1) September 1, 2017 - IV Opposition to Motion for Summary Judgment (2) September 8, 2017 - Citi Reply in Support of Motion for Summary Judgment; **For FNBO Case:** (1) August 28, 2017: Parties shall file an updated status report

*AIA Post-Grant Review Summary* (partial summary of IPR and related Federal Circuit Activities, 2013 - 16)

## **Federal Circuit**

Intellectual Ventures II LLC v. JP Morgan Chase & Co., et al., 14–1724 (Fed. Cir.).  
In re: Intl. Business Machines Corp., 15–119 (Fed. Cir.).  
IBM v. Intellectual Ventures II LLC, 15–1837 (Fed. Cir.).  
Intellectual Ventures II LLC v. IBM, 16–1528 (Fed. Cir.).  
Intellectual Ventures II LLC v. IBM, 16– 1938 (Fed. Cir.).  
Intellectual Ventures II LLC v. IBM, 16–2251 (Fed. Cir.).

## **Patent Trial and Appeal Board**

IBM v. FST (IP) Pty. Ltd., Inter Partes Review of RE40,526, IPR2013-00078 (USPTO).  
IBM v. FST (IP) Pty. Ltd., Inter Partes Review of RE40,520, IPR201300079 (USPTO).  
IBM v. IV II LLC, Inter Partes Review of 7634666, IPR201400180 (USPTO).  
IBM v. IV II LLC, Inter Partes Review of 6826694, IPR2014-00587

(USPTO). IBM v. IV II LLC, Inter Partes Review of 6715084, IPR201400681 (USPTO). IBM v. IV II LLC, Inter Partes Review of 6715084, IPR201400682 (USPTO).

IBM v. IV I LLC & IV II LLC, Inter Partes Review of 5745574, IPR201400660 (USPTO).

IBM v. IV II LLC, Inter Partes Review of 6314409, IPR2014-00672 (USPTO). IBM v. IV II LLC, Inter Partes Review of 6314409, IPR201400673 (USPTO). IBM v. IV II LLC, Inter Partes Review of 6314409, IPR2015-01322 (USPTO). IBM v. IV II LLC, Inter Partes Review of 6314409, IPR2015-01323 (USPTO). IBM v. IV I LLC, Inter Partes Review of 7984081, IPR2014-01385 (USPTO). IBM v. IV II LLC, Inter Partes Review of 5745574, IPR2014-01410 (USPTO).

Otter Products, LLC v. Speculative Product Design, LLC, Inter Partes Review of 8204561, IPR2014-01450 (USPTO).

Otter Products, LLC v. Speculative Product Design, LLC, Inter Partes Review of 8755852, IPR2014-01464 (USPTO).

IBM v. IV II LLC, Inter Partes Review of 6826694, IPR2014-01465 (USPTO). IBM v. IV I LLC, Inter Partes Review of 7757298, IPR2014-01516 (USPTO). IBM v. IV II LLC, Inter Partes Review of 6546002, IPR2015-00089 (USPTO). IBM v. IV II LLC, Inter Partes Review of 6546002, IPR2015-00092 (USPTO). IBM v. IV I LLC, Inter Partes Review of 6819271, IPR2015-00302 (USPTO). IBM v. IV I LLC, Inter Partes Review of 6819271, IPR2015-00303 (USPTO). IBM v. IV I LLC, Inter Partes Review of 6819271, IPR2015-00304 (USPTO). IBM v. IV I LLC, Inter Partes Review of 6819271, IPR2015-00305 (USPTO). IBM v. IV I LLC, Inter Partes Review of 6510434, IPR2015-01481 (USPTO). IBM v. IV I LLC, Inter Partes Review of 6519581, IPR2015-01542 (USPTO). IBM v. IV I LLC, Inter Partes Review of 6519581, IPR201501543 (USPTO).

*Otter Products LLC v. USITC and Speculative Prod. Design, LLC*, Appeal No. 2014-1840 (Fed. Cir. 2014), *appeal from Motion to Stay Entry of GEO/Advisory Request; In re Certain Cases for Portable Electronic Devices*, Investigation No. 337-TA-867/861 (USITC 2013) [Pender, ALJ.]; *Otter Products LLC v. Speculative Prod. Design*, IPR 2014-01450 (PTAB 2014) [‘561 patent]; *Otter Products LLC v. Speculative Prod. Design*, IPR 2014-01464 (PTAB 2014) [‘852 patent]. Represented Otter Box in various patent-based proceedings relating to protective cases for smartphones and similar devices. ITC instituted two Section 337 investigations, November 2012 / January 2013, based on complaints filed by Speck; the investigations, each alleging that certain protective cases infringed claims of the ‘561 Patent, were consolidated into ITC Inv. No. 337-TA861 / 867. Speck named a number of respondents in each complaint, but did not name OtterBox, nor did Speck identify any OtterBox products. Default judgments were entered as to all nonparticipating respondents. All respondents that did participate were terminated based upon settlement agreements, consent order stipulations, or voluntary withdrawal of the complaint by Speck. Only two respondents attempted to challenge Speck’s infringement allegations: Superior Communications, Inc. (“Superior”) and Fellowes, Inc. (“Fellowes”). On July 8, 2013, ALJ Pender issued an order construing six disputed terms of the ‘561 Patent, including the term “co-molded.” Fellowes, Superior, the ITC, and Speck all submitted different constructions for “co-molded.” The ITC found all disputed terms, including “co-molded,” should be accorded their plain and ordinary meaning, as Speck contended. After participating in the claim construction process, both Fellowes and Superior were terminated from the investigation without any challenge to the validity of the ‘561 Patent, or any of Speck’s infringement allegations. Neither the Initial Determination nor any other opinion issued by the ITC addressed the ‘561 Patent’s validity. After Superior and Fellowes

were dismissed, all the remaining respondents were in default. On February 21, 2014, in an initial determination ALJ Pender determined that the defaulting respondents were in violation of Section 337 for importing products that infringed claims 4, 5, 9, and 11 of the '561 Patent, and recommended issuance of a GEO. On April 8, 2014, the Commission determined not to review the Initial Determination, and requested written submissions on remedy. On June 20, 2014, ITC issued a GEO, prohibiting the unlicensed entry of cases for portable electronic devices covered by claims 4, 5, 9, and 11 of the '561 Patent. Speck did not name either OtterBox or its Symmetry Series case in its remedy submission.

On August 15, 2014, five days before the GEO became final, Customs (CBP Port of Long Beach) alerted OtterBox that, upon Speck's request, they were examining whether OtterBox's Symmetry Series cases were subject to the GEO issued in Speck's ITC investigation.

OtterBox took immediate action to prevent its products from exclusion:

- **September 2, 2014:** Pursuant to 19 C.F.R. § 177, OtterBox filed a Request for Internal Advice with the CBP Port of Long Beach concerning whether its Symmetry Series cases were subject to the GEO.
- **September 3, 2014:** OtterBox filed a Petition for *Inter Partes* Review of the '561 Patent with the U.S. Patent and Trademark Office ("PTO") *Otter Prod., LLC v. Speculative Prod. Design, LLC*, IPR 2014-01450. A petition for IPR review was also filed later for the Speck '852 patent, IPR 2014-01464. (Trial in the '01450 IPR was instituted March 11, 2015.)
- **September 4, 2014:** OtterBox filed with the ITC a Request for an Advisory Opinion that OtterBox's Products Are Outside the Scope of the General Exclusion Order. In that request, OtterBox requested a ruling that OtterBox's products were not subject to the GEO because (1) OtterBox's products were not considered in the underlying investigation and OtterBox was not provided the statutorily required due process; (2) OtterBox's products are not covered by the asserted claims of the '561 Patent; and (3) the '561 Patent is invalid.
- **September 17, 2014:** OtterBox filed a Federal Circuit appeal.
- **September 24, 2014:** OtterBox filed a motion with the Federal Circuit to stay enforcement of the GEO pending the appeal. The court, *sua sponte*, immediately expedited briefing.

Two days after OtterBox filed the motion to stay enforcement of the GEO with the Federal Circuit, CBP issued a ruling staying the enforcement of the GEO against OtterBox products. CBP Ruling HQ H257013 ("Ruling 012"). CBP found that because the issue on appeal was "whether portable electronic devices imported by OtterBox are covered by the claims of the '561 Patent such that they are subject to exclusion from entry," excluding OtterBox's products while the appeal was pending would violate 19 C.F.R. § 177.7 and be "contrary to the sound administration of the Customs and related laws." In response to OtterBox's motion for a stay, the ITC argued, *inter alia*, that OtterBox's motion was moot in light of CBP's decision. Dkt. No. 18 at 8-9. On October 20, 2014, the Federal Circuit denied OtterBox's stay request, without prejudice to the disposition of the pending appeal. Dkt. 25 at 2. On October 22, 2014, the ITC indicated it was willing to hold an advisory opinion proceeding to determine whether OtterBox's Symmetry Series cases infringed claims 4, 5, 9, or 11 of the '561 Patent. The ITC informed OtterBox it would only allow OtterBox to present its non-infringement defenses, and that it would not give OtterBox an opportunity to present all of its other legal and equitable defenses, including the '561 Patent's invalidity. Because the ITC refused to provide OtterBox with all available defenses, and because

Otter Box's appeal was pending before the Federal Circuit, OtterBox withdrew its request for an advisory opinion.

Unbeknownst to OtterBox, after the Federal Circuit denied OtterBox's motion to stay and after CBP informed OtterBox it would not enforce the GEO pending appeal, Speck submitted *ex parte*, confidential documents to CBP alleging OtterBox's products were subject to the GEO. On November 4, 2014, CBP withdrew its previous ruling and informed OtterBox that its products would be excluded from the U.S. market starting November 7, 2014, based on a new ruling. Ruling HQ H258492 ("Ruling 492") CBP refused to provide OtterBox with the ruling, but did provide it to Speck. Speck submitted the ruling as a public filing in a parallel district court litigation, thereby allowing OtterBox to see the basis on which its products were excluded from the United States. In the new ruling, CBP construed, *ex parte*, three claim terms, and conducted an infringement analysis based on these constructions to find OtterBox's products infringed the '561 Patent. CBP's ruling did not address any of OtterBox's invalidity defenses. Based on these new facts, on November 7, 2014, OtterBox filed an emergency stay motion with the Federal Circuit to stay enforcement of the GEO against OtterBox's products while the appeal was pending. Dkt. No. 33. The Federal Circuit construed the motion as a request for reconsideration of the initial stay motion, and denied the motion. Dkt. No. 31 at 1.

OtterBox filed a protest of the Notices of Redelivery on November 7, 2014, and filed a Motion to Reconsider CBP's Ruling 492 on November 10, 2014. On December 8, 2014, OtterBox's protest was deemed denied pursuant to 19 C.F.R. § 174.21(b). On December 10, 2014, CBP issued a ruling denying OtterBox's Motion to Reconsider, and affirming Ruling 492. CBP Ruling HQ H259071 ("Ruling 071"). On the same day that CBP denied OtterBox's Motion to Reconsider, OtterBox challenged the denial of the protest with the CIT, and concurrently applied for a TRO from the CIT to prevent CBP from denying OtterBox the ability to import the Symmetry Series cases. Two days later, on December 12, 2014, the CIT granted the TRO. In granting the TRO, the CIT analyzed, *inter alia*, whether OtterBox would suffer irreparable harm and succeed on the merits of its appeal. The CIT found that OtterBox would suffer irreparable harm based on the lost market share and damage to its customer relations, particularly in view of the upcoming holiday season. CIT also found OtterBox would likely succeed because "it seems clear that the issue of whether Otter[Box]'s Symmetry [S]eries portable electronic device cases is excluded from entry pursuant to the GEO is pending before the Federal Circuit" and 19 C.F.R. § 177.7 prevents CBP from issuing a ruling on an issue which pending before the Federal Circuit. CIT also found the "public interest" factor was neutral, and the "balance of hardships" factor weighed in favor of OtterBox. CIT granted the TRO, and prevented CBP from denying OtterBox the ability to import its products until December 26, 2014.

Otter Box then filed two IPRs against Speck's '561 and '852 patents, which were initiated (IPR 2014- 01450, March 11, 2015, '561; IPR 2014-01464, March 17, 2015, '852). Based on the IPR initiations, Otterbox moved to terminate the Fed. Cir. appeal (No. 14-1840), which motion was granted May 5, 2015. The IPRs proceeded until mid-July 2015 when a confidential global settlement agreement was executed, resolving all matters very favorably to Otter Box.

*Trading Technologies International, Inc. v. CQG, Inc. and CQGT, LLC*, Civil Action No. 05-cv- 4811 (ND Ill 2005). Represented CQG and CQGT as defendants in a patent infringement action brought by Trading Technologies International, alleging infringement of two United States patents relating to placing a trade order for a commodity on an electronic exchange having an inside market. Acting as co-trial counsel to lead counsel, in completion of discovery, preparation for trial and jury selection, motion practice, completion of final pre-trial order (including jury charge), and various stay motions filed before the trial court and the Federal Circuit, relating to granted CBMR review of one of the patents-in-suit. A bench trial to the

court, was held on February 23, 2015, relating to defense of patent ineligibility of the two patents under 35 USC § 101, where acted as lead counsel, resulting in a Memorandum Opinion and Order (Dkt. 1073, Feb. 24, 2015) (2015 WL 774655 (N.D. Ill. Feb 24, 2015).) Numerous pre-trial rulings on motions *in limine*, jury charge and jury verdict were entered; CQG's motion to bifurcate willfulness and damages from liability was denied. Trial to a jury commenced on February 26, 2015.

After a three-week trial and two days of deliberation, the jury rendered its verdict on March 19, 2015, awarding Trading Technologies \$15.9 million in royalties for literal infringement of the two patents in suit. (The court dismissed the doctrine of equivalents infringement and contributory infringement claims during trial finding that a reasonable jury would not have a legally sufficient evidentiary basis to render a verdict for Trading Technologies on those claims). The jury rejected Trading Technologies claims for willfulness and induced infringement. The court (Dkt. 1217, March 31, 2015) entered orders setting post-trial motions under F.R. Civ. P. 50 and 59 for briefing and decision staying Trading Technologies application for costs, "prevailing party" attorney's fees and permanent injunctive relief until resolution of the post-trial motions.

The parties thereafter reached settlement, which left for appeal the §101 decision. The appeal was fully briefed by August 2016, *Trading Technologies v. CQG, Inc.*, Appeal No. 16-1616 (Fed. Cir.). The Federal Circuit affirmed on January \_\_\_\_, 2017. Rehearing *en banc* was denied on \_\_\_\_, 2017.

*In the Matter of Certain Standard Cell Libraries, Products Containing Or Made Using The Same, Integrated Circuits Made Using the Same, And Products Containing Such Integrated Circuits*, Investigation No. 337-TA-906 (US ITC 2013). Represented Taiwan Semiconductor Manufacturing Ltd. et al. respondents. Tela Innovations, Inc. ("Tela") filed patent infringement complaints against Taiwan Semiconductor Manufacturing, Ltd ("TSMC") at the International Trade Commission ("ITC") and in the U.S. District Court for District of Delaware. In both cases, Tela alleged that TSMC infringed U.S. Patent No. 8,490,043 ("the '043 patent") relating to standard cell libraries having cells with transistors that are annotated for gate length biasing. The ITC instituted an investigation against TSMC on January 24, 2014 ("906 Investigation"). Tela was granted leave to amend both the ITC and Delaware complaints to add U.S. Patent No. 8,635,583 ("the '583 patent"), which patent is directed to the same technology as the '043 patent. TSMC moved, without opposition, to stay the Delaware action in view of the 906 Investigation. On February 21, 2014, the Delaware court stayed that action pending completion of the 906 Investigation. TSMC's answer to the amended complaint in the 906 Investigation was filed on April 21, 2014. The hearing in the ITC case is scheduled to begin on October 1, 2014 and end on October 7, 2014. The Initial Determination is due from the ITC Administrative Law Judge on December 24, 2014, and the Target Date for final Commission review is April 24, 2015. Concurrent with the ITC investigation, TSMC sought to invalidate the '043 patent and the '583 patent through *Inter Partes* Review ("IPR") procedures at the U.S. Patent & Trademark Office. The matter was resolved favorably to TSMC in September 2014.

*Zenith Electronics LLC et al. v. ViewSonic Corp.*, Civil Action No. 9:13-cv-80570 (SD Fla. 2013). Represented ViewSonic Corp. Zenith Electronics LLC, Panasonic Corp., U.S. Philips Corp., and The Trustees of Columbia University in the City of New York (together "Plaintiffs") filed suit on June 4, 2013, alleging infringement of five patents based on ViewSonic's use, manufacture, sale and/or importation of televisions complying with the ATSC digital television standard. ViewSonic moved to dismiss, to transfer the case to the Central District of California, and to stay the litigation pending resolution of the motions.

(Pending resolution of ViewSonic's motions, the case was consolidated in the Southern District of Florida for pre-trial purposes with two other cases involving the same patents: *Zenith Electronics, LLC et al. v. Craig Electronics, Inc.*, 9:13-cv- 80567-DMM (S.D. Fla. 2013) and *Zenith Electronics, LLC et al. v. Curtis International, Ltd.*, 9:13- cv-80568- DMM (S.D. Fla. 2013).) Trial was scheduled to begin in the first-filed case against Craig Electronics on April 7, 2014, with the other cases to follow shortly thereafter.

*Ericsson Inc, et al. v. Samsung Electronics Co., Ltd., et al.*, Civil Action No. 6:12-cv-00894LED (E.D. Tex. 2012). Represented Samsung in defense of Ericsson and Telefonaktiebolaget LM Ericsson (collectively, "Ericsson") suit against SEC, Samsung Electronics America, Inc., and Samsung Telecommunication America, LLC (collectively, "Samsung") alleging infringement of a number of patents relating generally to 4G LTE, 3G, and other wireless standards, filed November 27, 2012. On March 18, 2013, Samsung denied Ericsson's allegations, asserted affirmative defenses, and filed counterclaims alleging infringement of a number of patents relating generally to 4G LTE standards and hardware (e.g., semiconductors, Doherty amplifiers, and circuit boards), breach of contract, promissory estoppel, declaratory judgment that Samsung is licensed to practice Ericsson's asserted patents, declaratory judgment of non-infringement and invalidity of Ericsson's asserted patents. Samsung filed an amended answer, affirmative defenses, and counterclaims to assert a claim of infringement of an additional patent on April 5, 2013. On April 22, 2013, Ericsson denied Samsung's allegations, asserted affirmative defenses, and filed counterclaims alleging infringement of additional patents, breach of contract, equitable estoppel, promissory estoppel, declaratory judgment that Ericsson is licensed to practice Samsung's asserted patents, declaratory judgment of non-infringement and invalidity of Samsung's asserted patents. On May 16, 2013, Samsung denied Ericsson's additional allegations, asserted affirmative defenses, and filed counterclaims alleging breach of contract, promissory estoppel, declaratory judgment that Samsung is licensed to practice Ericsson's asserted patents, and declaratory judgment of non-infringement and invalidity of Ericsson's asserted patents.

On April 17, 2013, Ericsson filed an unopposed motion pursuant to 28 U.S.C. Sec. 1659 to stay Samsung's infringement claims relating to certain patents that also were asserted in International Trade Commission Investigation 337-TA-866. The court granted Ericsson's unopposed motion and severed the patents into case 6:13-cv-00364, where the claims were stayed pending a resolution of the ITC proceeding

The parties proceeded through early stages of discovery: initial disclosures were filed on August

27, 2013 and infringement contentions due on September 13, 2013. In December 2013 - January 2014, the parties agreed to settle the Texas cases and two parallel USITC investigations through cross license agreements. Cross license agreement covers patents relating to GSM, UMTS, and LTE standards for both networks and handsets, and includes an initial payment and ongoing royalty payments.

*Ericsson Inc, et al. v. Samsung Electronics Co., Ltd., et al.*, Civil Action No. 6:12-cv-00895-LED. (E.D. Tex. 2012). Represented Samsung in defense of Ericsson and Telefonaktiebolaget LM Ericsson (collectively, "Ericsson") suit against, SEC, Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively, "Samsung") alleging infringement of a number of patents relating generally to 4G LTE, 3G, and other wireless standards filed November 27, 2012. On March 18, 2013, Samsung denied Ericsson's allegations, asserted affirmative defenses, and filed counterclaims alleging infringement of patents generally related to 4G LTE standards and hardware (semiconductors), breach of contract, promissory estoppel, declaratory judgment that Samsung is licensed to practice Ericsson's asserted patents, declaratory judgment of non-infringement and invalidity of Ericsson's asserted patents. On April 12, 2013, Ericsson denied

Samsung's allegations, asserted affirmative defenses, and filed counterclaims alleging promissory estoppel, declaratory judgment that Ericsson is licensed to practice Samsung's asserted patents, declaratory judgment of non-infringement and invalidity of Samsung's asserted patents. On May 9, 2013, Samsung denied Ericsson's additional allegations and asserted affirmative defenses.

The parties proceeded through early stages of discovery, initial disclosures were filed on August 27, 2013 and infringement contentions were filed on August 30, 2013. In December 2013 - January 2014, the parties agreed to settle the Texas cases and two parallel USITC investigations through cross license agreements. Cross license agreement covers patents relating to GSM, UMTS, and LTE standards for both networks and handsets, and includes an initial payment and ongoing royalty payment.

*PersonalWeb Technologies LLC, et al. v. IBM*, in the United States District Court for the Eastern District of Texas, Civil Action No. 6:12-cv-661-LED (E.D. Tex 2012). Represented IBM in defense of alleged infringement of five patents relating to cloud computing and data archive technology.

PersonalWeb Technologies LLC ("PersonalWeb") filed this patent infringement lawsuit on September 17, 2012, alleging infringement of United States Patent Nos. 5,978,791; 6,415,280; 6,928,442; 7,802,310; and 8,099,420 (the "'420 patent") relating to cloud computing and data archival technology. IBM was served on October 11, 2012. IBM served its answer on December 3, 2012. PersonalWeb served its preliminary infringement contentions on June 28, 2013. PersonalWeb filed an amended complaint alleging infringement of four additional patents in the same family (United States Patent Nos. 7,945,539; 7,945,544; 7,949,662; and 8,001,096) in September 2013. PersonalWeb filed supplemental infringement contentions on October 10, 2013, and confirmed in writing that IBM is only alleged to infringe United States Patent Nos. 5,978,791; 6,415,280; 6,928,442 (the "'442 patent"); 7,802,310; and 8,099,420. PersonalWeb alleges that the following IBM products are alleged to infringe: IBM CommonStore; IBM Tivoli Storage Manager; certain IBM Internet Security Systems; use of the open source Lucene or Apache Solr in certain IBM products; SoftLayer Technologies Cloud Storage; and IBM ProtecTIER. Since the filing of the lawsuit, PersonalWeb has dropped several products and claims. The only remaining claim is that Tivoli Storage Manager ("Tivoli") infringes one claim of the '420 patent.

On May 15, 2014, the Patent Trial Appeal Board ("PTAB") found several claims of United States Patent Nos. 5,978,791 (the "'791 patent") and 6,415,280 invalid in 6 *inter partes* review proceedings brought by EMC Corporation ("EMC"). This included several claims of the '791 patent that have been asserted against IBM products. PersonalWeb filed a notice of appeal of these decisions to the Federal Circuit on May 20, 2014, and the Federal Circuit affirmed on August 10, 2015. On July 14, 2014, the parties agreed to a stay of proceedings pending resolution of the Federal Circuit appeal of the *inter partes* review brought by EMC. On November 10, 2014, PersonalWeb filed an opposed motion to lift the stay. The case was reassigned to Judge Gilstrap on January 14, 2015. A notice to the court regarding the resolution of the EMC *inter partes* review was due on August 25, 2015. The parties proposed a new docket control order and IBM moved to stay pending resolution of PTAB proceedings on September 25, 2015. Judge Gilstrap entered the docket control order on October 8, 2015. Judge Gilstrap consolidated the case against IBM with PersonalWeb's case against GitHub on October 22, 2015. Judge Gilstrap held a hearing on IBM's motion to stay on December 16, 2015, and the motion was denied on January 28, 2016. On February 8, 2016, Judge Gilstrap conditionally transferred the case to the Northern District of California, pending completion of claim construction. In view of the transfer, the parties have been granted an extension on certain discovery deadlines.

The parties filed a joint claim construction statement on November 18, 2015. PersonalWeb filed its opening claim construction brief, and the parties submitted technology tutorials on January 22,

2016. Judge Gilstrap held the *Markman* hearing on March 7, 2016 and issued a claim construction order on March 11, 2016.

The case was transferred to the Northern District of California on March 14, 2016. After several intermediate transfers between judges in that district, and notices of pending related cases filed by both PersonalWeb and IBM, the case is now pending before Judge Davila in the San Jose Division, and was scheduled for an initial case management conference on August 18, 2016. All remaining cases brought by PersonalWeb are now pending before Judge Davila. IBM moved for a stay pending the outcome of the reexamination of the '420 patent on March 28, 2016, which was fully briefed as of April 18, 2016. In view of the denial of IBM's second request for *ex parte* reexamination of the '420 patent, PersonalWeb contended the motion to stay is moot in a filing on July 21, 2016. On July 29, 2016, IBM moved for a continuance of the hearing on its motion to stay, pending the PTO Director's decision on IBM's petition regarding the second *ex parte* reexamination request. The court denied the motion for stay on August 9, 2016 and entered a scheduling order on August 15, 2016.

On June 2, 2014, the United States Patent and Trademark Office ("PTO") found a claim of the '791 patent in *ex parte* reexamination proceedings initiated by NetApp that had been asserted against IBM products invalid. The PTAB affirmed the decision on September 29, 2015.

On March 25, 2015, the PTAB found several claims of United States Patent No. 7,802,310 (the "'310 patent") invalid in *inter partes* review proceedings brought by Apple Corporation. This included several claims of the '310 patent that have been asserted against IBM products. PersonalWeb requested a rehearing on May 24, 2015. The rehearing was denied on August 3, 2015. PersonalWeb filed a notice of appeal on September 30, 2015. On April 7, 2017, the Federal Circuit remanded the case to the PTAB for further proceedings.

On July 27, 2015, in *ex parte* reexamination proceedings brought by Google, the PTO issued a nonfinal office action rejecting several claims of United States Patent No. 6,415,280, of which one has been asserted against IBM products. These claims were finally rejected on November 25, 2015, and PersonalWeb filed a notice of appeal on January 26, 2016.

IBM filed a petition for *ex parte* reexamination of the asserted claim of the '420 patent on September 23, 2015. The PTO ordered a reexamination on October 16, 2015, and issued a first office action rejecting the claim on January 15, 2016. PersonalWeb responded on March 15, 2016, and the patent office mailed a notice of intent to issue a reexamination certificate confirming the validity of the asserted claim on April 21, 2016. The reexamination certificate was issued on May 10, 2016. IBM filed a second petition for *ex parte* reexamination on May 24, 2016. On June 2, 2016, IBM amended its defenses and counterclaims to assert inequitable conduct by PersonalWeb regarding the reexamination of the '420 patent. PersonalWeb answered the amended counterclaims on June 27, 2016.

On June 24, 2016, the PTAB instituted *ex parte* reexamination proceedings at the request of GitHub, Inc. on one of the asserted claims of the '442 patent. On October 24, 2016, the examiner issued a non-final office action rejecting that claim.

On May 31, 2016, PersonalWeb moved for leave to amend its infringement contentions to allege infringement by IBM Content Collector, and to assert additional patent claims against Tivoli. IBM responded on June 14, 2016, and PersonalWeb replied on June 21, 2016. The motion was heard before Magistrate Judge Cousins on July 6, 2016. On July 25, 2016, Magistrate Judge Cousins denied PersonalWeb's motion as to the addition of IBM Content Collector and additional claims against Tivoli, and granted it only as to certain unopposed clarifications to the claim charts. PersonalWeb did not object to that order. On November 29, 2016, the parties filed a joint letter regarding PersonalWeb's request for additional review of source code after the close of discovery, which Magistrate Judge Cousins granted.

On December 9, 2016, the parties exchanged opening expert reports. On December 13, 2016, the parties filed a joint letter regarding IBM's request that PersonalWeb produce documents withheld as privileged but improperly logged, which Magistrate Judge Cousins denied. On December 16, 2016, IBM moved to amend its invalidity contentions. On December 21, 2016, IBM moved to strike portions of PersonalWeb's expert report on infringement. PersonalWeb responded to both motions on January 6, 2016 and IV replied on January 12, 2016. The Court granted IBM's motion to amend and denied IBM's motion to strike on January 18, 2017. On February 13, 2017, the Court entered a schedule setting trial to begin on August 8, 2017.

On February 24, 2017, IBM filed a motion to dismiss PersonalWeb's claims relating to Tivoli for lack of standing. On March 3, 2017, IBM filed motions for summary judgment of noninfringement and no willful infringement. Both dispositive motions are fully briefed. Also on March 3, 2017, the parties filed joint stipulations dismissing with prejudice IBM's inequitable conduct defense and certain of PersonalWeb's claims under the '791 and '280 patents. Judge Davila held a hearing on the dispositive motions on April 27, 2017. On May 9, the Court: denied IBM's motion to dismiss, granted partial summary judgment that the sale of TSM software does not infringe, granted summary judgment that TSM does not infringe under the doctrine of equivalents or under a joint infringement theory, granted summary judgment of non-infringement of all patents and products aside from TSM regarding the '420 patent, denied summary judgment of no indirect infringement, denied summary judgment of no infringement by unaccused TSM features, and denied summary judgment of no willful infringement. In view of these rulings, IBM filed an administrative motion for an interim pretrial conference on May 23, 2017 to determine which theories PersonalWeb will pursue at trial. The Court denied the motion on May 31, 2017.

IBM filed a motion in limine relating to PersonalWeb's willful infringement theory on June 7, 2017.

PersonalWeb filed a letter brief requesting additional discovery on June 13, 2017, which was denied on June 16, 2017.

The parties attended mediation before Retired Judge Edward A. Infante on June 2, 2016 but did not resolve the case. On June 20, 2017, the Court referred the parties to a settlement conference before Magistrate Judge van Keulen.

On July 6, the parties exchanged and filed a joint exhibit list, a joint final pretrial statement, witness lists, deposition designations, motions in limine, and *Daubert* motions. PersonalWeb moved to strike one of IBM's proposed trial witnesses. On July 7, IBM filed its notice of prior art under 35 U.S.C. Sec. 282. The parties briefed the pretrial motions and exchanged objections to deposition designations and trial exhibits from July 10 through July 17. The Court held a pretrial conference on July 26, 2017. The Court ruled on pretrial motions on July 25 and July 26, 2017. The parties held a settlement conference on July 28, 2017, and PersonalWeb simultaneously moved for relief from the Court's July 26, 2017 order striking its damages expert. IBM renewed its *Daubert* motion to exclude PersonalWeb's damages expert on August 4, 2017, and PersonalWeb responded on August 5, 2017. On August 7, 2017, Judge Davila denied IBM's renewed *Daubert* motion.

On August 11, 2017, the parties advised the court of a settlement, and on August 14, 2017, the Court granted the parties' stipulated dismissals with prejudice.

*Futek Holdings LLC v. Magnetic Solutions, Ltd; Tokyo Electron Ltd; and Toyko Electron America*, Civil Action No. 3:12-CV-01269-HZ (D. Or. 2012). Represented the TEL entities in defense of alleged infringement of two patents relating to magnetic annealing oven technology. Case was filed on July 13, 2012. On September 28, 2012, TEL filed motions to dismiss. On

April 25, 2013, Futek Holdings LLC filed a notice of voluntary dismissal., which dismissed with prejudice all claims in the action. The matter was resolved favorably to TEL.

*In the Matter of Certain Audiovisual Components and Products Containing Same*, Investigation No. 337- TA-837 (US ITC 2012). Represented MediaTek and Ralink respondents in defense of alleged acts of unfair importation based on accusations of infringement of four (4) LSI / Agere patents, directed to wireless networking and data storage technology. Investigation was terminated by joint motion after settlement in January 2013.

*Titanide Ventures LLC v. International Business Machines Corp.*, Civil Action No. 4-12-CV-00196 (E.D. Tex. 2012). Represented IBM in defense of alleged infringement of a patent relating to systems / methods for seamless access to a remote storage server using multiple access interfaces executing on said server. IBM moved to dismiss Titanide's indirect infringement assertions on June 18, 2012. Titanide submitted an amended complaint on July 3, 2012. IBM's answer was submitted on November 28, 2012. Discovery commenced, whereafter the case settled favorably to IBM.

*Semcon Tech LLC v. Xilinx Inc.*, Civil Action No. 12-cv-691 (D. Del. 2012). Semcon Tech, LLC ("Semcon") filed a patent infringement suit against Xilinx alleging infringement of a patent relating to CMC finishing aid control, based on accusation that Xilinx uses, sells, offers to sell, and/or imports integrated circuits made by United Microelectronics Corporation and Taiwan Semiconductor Manufacturing Company Limited using an Applied Materials Reflexion CMP system. Xilinx filed its answer and counterclaims on July 23, 2012, denying the allegations of infringement and asserting that the '717 patent is invalid. An amended scheduling order was entered on January 8, 2013, scheduling a claim construction hearing on September 17, 2013, and the first trial date among co-pending cases brought by Semcon against Xilinx and other defendants on a date to be determined in August 2014. The case settled favorably to Xilinx on August 5, 2013.

*Network-1 Security Solutions, Inc. v. Alcatel - Lucent USA, Inc.*, 6:11-CV-00492 LED (E.D. Tex. 2011). Represented Samsung Electronics Co. Ltd., et al., in defense of alleged infringement of a Network-1 patent relating to methods and systems for providing remote power over Ethernet cables. After an initial motion to dismiss that the court granted in part on May 14, 2012, Network-1 filed an amended complaint on May 23, 2012. Samsung answered the amended complaint and asserted affirmative defenses and counterclaims June 11, 2012. Scheduling and discovery orders were entered on September 7, 2012 setting the case schedule and procedures, with trial set for December 8, 2014. The parties exchanged infringement and invalidity contentions. The case was thereafter stayed pending resolution of *ex parte* reexamination and IPR proceedings on March 5, 2013. IPR proceedings in IPR 2013 – 00071 (PTAB 2013), were resolved by a Board decision dated May 22, 2014, which also lifted stay of *ex parte* proceedings. The case was settled favorably to Samsung in May 2015.

*Financial Systems Technology (Intellectual Property) Pty. Ltd. et al. v. CDW LLC et al.*, 1-11-CV- 08729 (N.D. Ill 2011). Represented IBM in defense of alleged infringement of FST patents relating to expandable database data processing systems and methods. IBM answered on March 1, 2012; a case schedule was set on March 22, 2012, after the March 14, 2012 initial status conference. The parties exchanged initial disclosures and a first set of production on March 30, 2012. FST's infringement contentions were served on April 13, 2012. IBM served its initial infringement and invalidity contentions on May 18, 2012. On October 19, 2012, the parties exchanged their final infringement and invalidity contentions. In FST's final infringement contentions, FST added allegations of infringement against additional IBM software products. The parties stipulated to the dismissal of one patent, which was granted on November 20, 2012. On December 12, 2012, IBM filed petitions for *inter partes* review of the two patents remaining in the case. IBM v. FST (IP) Pty. Ltd., Inter Partes Review of RE40,526, IPR2013-00078

(USPTO). *IBM v. FST (IP) Pty. Ltd.*, Inter Partes Review of RE40,520, IPR2013-00079 (USPTO). The parties exchanged proposed constructions for disputed terms in those patents, and IBM filed its opening claim construction brief on January 11, 2013. The parties entered into a settlement agreement, after which the *inter partes* review requests were terminated by motion on February 12, 2013, and the case was dismissed by stipulation on February 13, 2013. Case settled favorably to IBM.

*HSM Portfolio LLC et al. v. Fujitsu Limited, et al.*, 1-11-CV-0070 (D. Del. 2011). Represented Xilinx in defense of alleged infringement of HSM patents relating to latching inverter circuits and high speed logic/memory devices using ring segment buffers. Case settled favorably to Xilinx while F.R.Civ.P.12(b)(6) motion was pending.

*Invest Pic LLC v. FactSet Research Systems Inc, et al.*, Civ. No. 10-1028-SLR (D.Del. 2010). Representing IBM in defense of alleged infringement of patents relating to method/system for financial information analysis using re-sampled statistical methods. FR Civ. P. 12 (b)(6) dismissal motions challenging the complaint on *Bilski* grounds, and for failure to properly plead indirect and willful infringement, were denied in September and October 2011, after which IBM answered the complaint. The court set a scheduling order that was entered in December 2011; discovery proceeded in accordance with that order. A stipulated stay of all proceedings in the case was entered on July 10, 2012, in view of *ex parte* and *inter partes* reexaminations of the '291 patent. *Inter partes* reexaminations reached the PTAB in late 2013 and 2014, with all challenged claims rejected. *Ex parte* reexamination continued with the PTAB, reaching a decision with all challenged claims rejected. Appeals to the Federal Circuit were filed in May 2015. The court reversed in part remanded in part (\_\_\_F.3d\_\_\_, WL\_\_\_(Fed. Cir. 2016). Proceedings before the PTO continue; Invest Pic moved to lift the stipulated stay, but the motion was denied ( ).

*Mosaid Technologies, Inc. v. Adobe Systems, Inc.*, Civil Action No. 1-11-CV-00096 (D. Del. 2011). Represented IBM in defense of alleged infringement of MOSAID patents relating to web caching, network caching and proxy servers. MOSAID filed a first amended complaint on October 6, 2011, withdrawing its infringement allegations under the '241 patent, but asserting the '914 against IBM. On December 12, 2011, MOSAID filed a motion for leave to file a second amended complaint asserting three additional patents against IBM. All patents issued from the same original application and related to network distributed caches. IBM opposed MOSAID's motion for leave to amend. On December 23, 2011, IBM moved to dismiss MOSAID's claims for indirect infringement and willful infringement in the first amended complaint. A motion to dismiss for lack of subject matter jurisdiction, applicable to all defendants, was also filed by one of the other defendants. No scheduling order was entered by the court. While these motions were pending, MOSAID's claims against IBM were dismissed with prejudice on May 7, 2012. Case settled favorably to IBM.

*Accenture Global Services, Ltd et al. v. Guidewire Software, Inc.* Civil Action, No. 3-11-CV-03563 (N.D. Cal. 2011). Represented Accenture Global Services et al. in assertion of patent infringement claims relating to component-based information-linking during information processing, particularly concerning processing of insurance claims. Case later settled very favorably to Accenture by cross- license.

*Guidewire Software, Inc. v. Accenture PLC et al.*, Civil Action N. 1; 11-CV-678 CMH / TRJ (E.D. Va. 2011). Represented Accenture PLC et al. in defense of alleged infringement of Guidewire patents relating to methods and systems of processing information in regards to insurance products/claims. Accenture brought on motion to transfer to ND Cal, pursuant to 28 USCS1404(a), that was granted in September 2011. Case later settled very favorably to Accenture by cross-license.

### **Prior to joining Kirkland & Ellis in 2011:**

*Rambus v. IBM*, No. C 10-03736 JSW (N.D. Cal. 2010); *IBM v. Rambus*, No. C 10-04017 JSW (N.D. Cal. 2010). Represented IBM regarding Section 146 proceedings brought by Rambus for relief from adverse interference decision on priority, and cross-Section 146 action brought by IBM.

Rambus dismissed its case with prejudice in August 2011. Cross motions for summary judgment were filed in IBM's case; Rambus's motion was granted in December 2011.

*Akbar v. Procter & Gamble*, Civil Action No. 10-CV-105 (E.D. Tex. 2010). Represented P&G in defense of alleged false marking under 35 USC 292. P&G's motion to dismiss the case under F. R. Civ. P. 12(b)(6) as duplicative was granted in August 2010.

*Powell v. Procter & Gamble*, CV-10-RRA-487-S (N.D. Ala. 2010). Represented P&G in defense of alleged false marking under 35 USC § 292. P&G's motion to dismiss the case under F.R. Civ. P. 9(b), 12(b)(6) for failure to state a claim was granted by magistrate judge in November 2010, reversed by trial judge in January 2011.

*In the matter of Certain Semiconductor Products Made by Advanced Lithography Techniques and Products Containing Same*, Investigation No. 337-TA-729 (US ITC 2010). Represented TSMC in investigation of UNM-owned patents relating to double patterning process for production of semiconductor devices. Case settled favorably to TSMC by license of the patents- in-suit.

*San Francisco Technology Inc. v. Procter & Gamble*, No. C09 06083 RS (HRL) N.D. Cal. (San Jose). Represented Procter & Gamble in defense of false marking allegations under 35 U.S.C. § 292.

*Auburn University v. IBM Corporation*, 09 Civ. 694 (M.D. Ala.). Represented IBM in defense of patent infringement, 35 U.S.C. § 256 and various state law claims relating to predictive testing processes for semiconductor devices. IBM brought motions to dismiss various common law counts, which were granted June 8, 2010 (2010 WL 2292422). *Markman* hearing was held January 2011. A claim construction order was issued by the court on April 22, 2011, which construed the claims of all four patents involved in the case. All expert reports were exchanged and all expert depositions completed as of September 2011; motions to bifurcate the trial and bar Auburn from arguing infringement under DOE were filed by October 2011; summary judgment motions were filed in mid- December 2011. A *Daubert* motion was filed in March 2012. A status conference in January 2012 resulted in a continuance of the trial without 6 date in view of motions, pending decisions. A hearing was held on May 9, 2012, resulting in an order on June 4, 2012 denying IBM's Rule 12(c) and related motions to strike expert report portions. The continuance was maintained in view of other motions, pending decisions. On August 2, 2012, the court entered an Order and Memorandum Opinion granting IBM's motion for summary judgment of non- infringement and dismissing the claims contained in Counts III and IV of Auburn's first amended complaint with prejudice. Ruling was reserved on Auburn's partial summary judgment of no invalidity of claims. Counts I and II remain pending in the case. In October 2012 Auburn filed a request for an immediate appeal of the SJ and the dismissal of the Alabama common law counts under Rule 54(b), which is pending. *Inter partes* reexaminations on both patents in suit reached the PTAB in mid 2013, with all claims rejected. All rejections in '306 reexamination were affirmed by the PTAB on Jan. 24, 2014 and in the '366 reexamination on June 18, 2014. While an appeal to the Federal Circuit Court by Auburn was pending, court-administered mediation led to settlement of the case in May, 2015, favorably to IBM.

*LSI/Agere v. Xilinx*, 09 Civ. 9717 (JSR) (S.D.N.Y. 2009); *Xilinx v. LSI/Agere*, (D. Del.). Represented Xilinx in defense of breach of license agreement claim (N.Y. Sup. Ct.) removed to S.D.N.Y., infringement claim based on 10 patents (S.D.N.Y.); and affirmative claim for infringement of 10 Xilinx patents (D. De.); motions to transfer S.D.N.Y. case to D. Del. denied, injunction of S.D.N.Y. case in D. Del. granted. Case settled favorably to Xilinx through crosslicensing.

*Koch Industries Inc. v. National Gypsum Co.*, Civ. No. 3:08-cv-00422-MR-CH (W.D.N.C. 2008); *Koch Industries, Inc. v. New NGC, Inc., d/b/a/ National Gypsum Co.*, Civ. No. 4:08-cv-00166HLM (N.D. Ga. 2008). Represented Georgia Pacific, a Koch Industries subsidiary, in cases related to waterproof wallboard technology. After dismissal of W.D.N.C. case on GP motion, N.D. Ga. case was resolved by both parties withdrawing claims, counterclaim and defenses.

*Balsam Coffee Solutions Inc. v. The Folgers Coffee Co., The J.M Smucker Co., et al.*, Civ. No. 6:09-cv- 00089-JDL (E.D. Tex. 2009). Represented Folgers Coffee and Smucker in defense of infringement allegations based on two patents relating to coffee grinding technology. Case settled favorably to Folgers & Smucker following mediation.

*CIF Licensing, L.L.C., et al., v. Lenovo Group Limited, et al.*, Civ. No. 7:09-cv-01849-SLR (S.D.N.Y. 2009). Represented Lenovo in defense of infringement allegations based on 19 patents relating to MPEG 2 compression / decompression technology.

*Wellman Inc. v. Eastman Chemical Co.*, Civ. No. 1:07-cv-00585-SLR (D. Del. 2007). Represented Eastman Chemical in defense of infringement allegations based on 2 patents relating to PET polymer technology. Immediately prior to trial, court found Wellman patents invalid on summary judgment for failing to set forth the best mode and for indefiniteness; although PET formula was within the scope of asserted claims and at least one inventor considered the formula to be the best mode, the Wellman patents did not disclose the proper information to enable a person of ordinary skill in the art to practice it; further, patents failed to specifically disclose certain parameters, leading to finding the patents invalid for indefiniteness. The Federal Circuit (Appeal No. 20101249 slip op; April 29 2011) affirmed the judgment of invalidity regarding best mode, but reversed the indefiniteness judgment. A petition for *reh/reh en banc* and a petition for certiorari were denied. After proceedings had resumed in the trial court, the case settled favorably to Eastman Chemical Co.

*In the Matter of Certain Liquid Crystal Display Devices and Products Containing the Same*, Investigation 337-TA-631 (U.S.I.T.C. 2007); *In the Matter of Certain Crystal Display Modules, Products Containing the Same, and Methods for Using the Same*, Investigation 337-TA-634 (U.S.I.T.C. 2008). Represented Sharp in two investigations (one as respondent, '631; one as complainant, '634), alleging infringement of respective Samsung and Sharp patents relating to flat screen display technology. ID issued in both investigations, Commission Review rendered in '631 and in '634; enforcement proceeding was ongoing in '631, when parties reached WW resolution favorable to Sharp.

*Pequignot v. Gillette / P&G*, No. 2:08-cv-00222-TJW E.D. Tex. (Marshall 2008). Represented Procter & Gamble and Gillette in defense of false marking allegations under 35 U.S.C. § 292. The case was stayed pending Rule 12 motion decisions in earlier (related) cases brought in other jurisdictions. The stay was later lifted; P&G then filed Rule 12 motions (F. R. Civ. P. 12(e), (f)). The case settled favorably to P&G.

*P&G v. SC Johnson*, No. 9:08-cv-00143-RC E.D. Tex (Lufkin 2008). Represented Procter & Gamble in patent infringement action relating to multiple patents directed to fabric refresher

products. After filing of P&G's *Markman* briefing, the case settled favorably to P&G by license of the patents-in-suit.

*SuperSpeed v. IBM*, No. 2:07-cv-00089-CE E.D. Tex. (Marshall 2007). Represented IBM in defense of allegations based on five patents relating to cache coherency / cache bucket software technology. After *Markman* proceedings, completion of discovery (including expert discovery), and Rule 56 practice, the case settled favorably to IBM following mediation.

*Plasma Physics re Chi Mei Optoelectronics Corp*, No. 2:08-cv-01628-LDW-WDW (E.D.N.Y. 2008) Represented CMO in defense of patent infringement allegations relating to semiconductor products and processing. CMO exhaustion Rule 12 motion denied with leave to replead as SJ motion following *Markman* proceedings. Special Master *Markman* briefing and argument completed, discovery closed in September 2009, *Markman* decision and trial court review set for February 2010.

*Network -1 Security Solutions v. Extreme Networks*, No. 6:08-cv-00030-LED (E.D. Tex. Tyler). Represented Extreme Networks in defense of patent infringement allegations relating to remotely powering access equipment over a 10/100 switched Ethernet network. *Markman* proceedings held December 2009, decision February 2010. (692 F. Supp. 2d 632 (E.D. Tex 2010)). Case tried July 2010, with favorable settlement to Extreme Networks during trial.

*MackRay v. Smucker*, No. 2:08-cv-213. E.D. Tex (Marshall 2008). Represented Smucker in defense of patent infringement allegations relating to container nozzle structures. The case was dismissed without prejudice in view of pending *ex parte* and *inter partes* reexamination requests before the USPTO. The *ex partes* / *inter partes* proceedings were merged. An examiner upheld patentability, which holding was affirmed by the BPAI.

*IC Spectrum Co., Ltd. v. Grace Semiconductor Mfg. Corp., et. al.,* Civ. Action No. 1:08-cv-323LY (W.D. Tex. 2008); Action No. 380-02700-2008 (Collin County, 380th Judicial Dist.). Represented TEL in defense of claims of violation of Texas state law trade libel, trade disparagement and related claims, allegedly arising out of activities in the People's Republic of China. After the filing of Rule 12 motions to dismiss in W.D. Tex, IC Spectrum dismissed the case and refiled in Texas (state) District Ct., Collin County. While special appearance and dismissal / transfer motions under Texas law were made / prepared, IC Spectrum again dismissed the case.

*Playtex Products, Inc. v. The Procter & Gamble Company*, Civil Action No. 08 cv 3417 (S.D.N.Y. 2008). Represented Procter & Gamble in defense of patent infringement allegations, based on Playtex '324 patent concerning tampon applicator technology, and counter claims against Playtex based on P&G's '410 patent, also directed to tampon applicator technology. The case settled favorably to P&G by cross- licenses of the patents-in-suit.

*In re Certain Semiconductor Chips With Minimized Chip Package Size and Products Containing Same*, Investigation 337-TA-605 (USITC 2007). Represented respondent Freescale Semiconductor in 8 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. Federal Circuit affirmed on appeal in December 2010.

*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 then filed and argued in June 2010, with all Newegg motions denied, JMOL granted to Soverain Software regarding '639 infringement, new trial ordered on damages, running royalty granted (August 2010). On appeal, Federal Circuit reversed, holding that claims in suit of the '314 and '492 patents were invalid for obviousness. Appeal No. 2011 - 1009, slip op. (Fed. Cir. Jan. 22, 2013). A petition for panel rehearing was granted on June 13, 2013. On rehearing the panel held, on September 4, 2013, that claims 34 and 35 of the '314 patent were invalid for obviousness, amending the judgment accordingly; the petition for rehearing *en banc* was also denied.

*General Electric Co., et. al. v. Whirlpool*, Appeal Nos. 2007-1370 and 2007-1402 (Fed. Cir. 2007). Represented General Electric in Federal Circuit cross-appeals. Whirlpool sought reversal of a SJ of invalidity on patent directed to ITM washing machine technology, while GE and LG sought reversal of the trial court's refusal to award attorneys' fees pursuant to 35 U.S.C. § 285. The SJs were affirmed, as was the denial of attorneys' fees, under Rule 38, in October 2008.

*LG Philips LCD Co. Ltd. v. Chi Mei Optoelectronics Corp.*, Civil Action No. 2:07-cv-176 (D. Del. 2007). Represented CMO in defense of patent infringement allegations concerning LCD flat panel technology, and counterclaims against LG grounded in CMO LCD flat panel technology patents. Discovery proceeded, after court denied CMO motion to dismiss for lack of jurisdiction and LG Philips motion for sanctions (4/29/08), and transfer of CMO patents claims from E.D. Tex. to D. Del.

*Asher v. The Procter & Gamble Company*, Civil Action No. 1:07-cv-00339 (D. Col. 2007), 2:07-cv- 04215 (D.N.J. 2007). Represented P&G in defense of patent infringement allegations relating to toothbrush technology. P&G moved to dismiss the D. Col. case on basis of lack of subject matter jurisdiction (ownership not vested in plaintiff) and, pending that ruling, brought a declaratory judgment action in D.N.J. involving all of the appropriate parties. The D. Col. court denied the motion and denied the alternative request for jurisdictional discovery. P&G then dismissed the D.N.J. action without prejudice. The D. Col case was settled favorably by license to P&G.

*epicRealm Licensing, LLC v. Herbalife, et al.*, civil Action No. 5:07 cv 125 / 126 / 135 (E. D. Tex. 2005). Represented Herbalife in defense of patent infringement allegations relating to dynamic web page systems and apparatus technology. *Markman* construction and extensive discovery undertaken, expert reports served and discovery ongoing, SJs ruled upon, in part favorably to Herbalife. See 492 F. Supp. 2d 608 (E.D. Tex. 2007). While final pre-trial preparations were underway with trial set for June 2009, the case settled very favorably to Herbalife.

*RFID Tracker Ltd. v. Wal-Mart Stores*, Case No. 6:06 CV 363 (E.D. Tex. 2006). Represented The Gillette Co. in defense of patent infringement allegations relating to RFID tag technology. Defendants brought an early summary judgment motion for non-infringement, which was denied

by the trial court with leave to re-assert (3/26/07). After rendering a *Markman* claim construction (2/11/08), defendants re-asserted the SJ motion on basis of admissions made during the claim construction proceedings. Faced with the motion, RFID stipulated to entry of a non-infringement judgment. The Federal Circuit affirmed the trial court's judgment of non-infringement including the court's claim construction ruling, *per curiam* (No. 2008-1412, 2009 U.S. App. LEXIS 18547 (Fed. Cir. Aug. 18, 2009)).

*In The Matter of Certain Engines, Components Thereof, and Products Containing The Same*, Investigation No. 337-TA-585 (USITC 2007). Represented American Honda Motors as complainant in a 337 investigation alleging patent infringement of certain engines used, *inter alia*, in portable gasoline generators, involving Kipor, a PRC-based importer. The matter was settled by entry of a consent order in which Kipor agreed to cease manufacturing and importing of the accused products. A related patent infringement case brought against Kipor's exclusive importer, Coast, which was settled favorably to Honda in August 2009. Civil Action No. 3:06-cv-04752 (N. D. Cal.)

*FAS Technologies, LLC v. Tokyo Electron Limited*, Case No. 3:06-cv-02217 (N.D. Tex. 2006). Represented Tokyo Electron in a breach of contract, trade secret and other state law claims case relating to technology for thin film coating devices. TEL moved to dismiss for lack of jurisdiction, as the underlying contract provided for arbitration of any disputes in Japan. FAS dismissed the case without answering the motion.

*DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.* Represented DePuy Spine as appellant in an appeal to Federal Circuit. The court upheld a \$22 MM jury verdict won below for DePuy Spine, but reversed a summary judgment in Medtronic favor on other accused products, sending the case back for trial in D. Mass (469 F.3d 1005 (Fed. Cir. 2006)). On retrial, DePuy Spine won a \$227 MM verdict for DePuy, which was affirmed in part, reversed in part on appeal. (567 F. 3d 1314 (Fed. Cir. 2009).)

*Novozymes v. Genencor International, et al.*, Civil Action No. 1:05-CV-0016 (D. Del. 2005). Represented Genencor in patent infringement case relating to certain alpha amylase enzymes used in the manufacture of fuel ethanol from corn. 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, without disruption of enzyme availability to any Genencor customer.

*In the Matter of Certain Electronic Robots and Components Thereof*, Investigation No. 337-TA530 (USITC 2005). Represented Yaskawa Electric in defense of allegations of patent infringement of Fanuc patent relating to electric robots used in painting automobiles. After two-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 crossappealed. 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 additional patents not involved in the investigation.

*Mosaid Technologies, Inc. v. Infineon Technologies North America, Inc.*, Civil Action No. 6:05 CV 120 (E.D. Tex. 2005). Represented MOSAID in patent infringement action relating to three patents directed to memory architecture and processes. The trial court denied Infineon's motion to transfer case to N.D. Cal. The case was proceeding towards *Markman* claim construction and trial when settled by license to Infineon.

*Golden Bridge Technology, Inc. v. Nokia, Inc. and Lucent Technologies, Inc.*, Civil Action No. 2 05 CV 151-LED (E.D. Tex. 2007). Represented Nokia in patent infringement action relating to spread- spectrum CDMA wireless telephony. After a *Markman* claim construction, a motion for summary judgment for invalidity was granted 2007 WL 294176 (E.D. Tex. 2007); the case settled while an appeal was pending, favorably to Nokia. (SJ was later affirmed by the Federal Circuit, 527 F.3d 1318 (Fed. Cir. 2008).)

*Motionless Keyboard Co. v. Microsoft Corp., Nokia Inc. and Saitek Industries, Ltd.*, Civil Action No. 6:04-cv 00180 (D. Or. 2004). Represented Nokia in patent infringement action relating to a keyboard configuration for a handheld wireless telephone. The trial court granted summary judgment of noninfringement and invalidity (2005 WL 1113818 (D. Or. 2005)), and awarded costs (2005 WL 1899377 (D. Or. 2005)). The Federal Circuit affirmed in relevant part (486 F.3d. 1376 (Fed. Cir.2007)).

*Procter & Gamble v. Oraceutical LLC, et al.*, Civil Action No. 1:03 CV 433 (S.D. Ohio 2003). Represented Procter & Gamble in a declaratory judgment action, seeking a declaration of noninfringement and/or invalidity of patents directed to tooth-whitening devices. After a favorable *Markman* claim construction (following hearing) that made it impossible for Britesmile to get to the jury on any allegation of infringement, the parties stipulated to entry of judgment pursuant to Rule 54(b). Before an appeal was filed, the case settled very favorably to Procter & Gamble in March 2006.

*Orion IP, LLC v. Ford Motor Co., et al.*, Civil Action No. 2:04-CV-313 (JTW) (E.D. Tex. 2004). Represented American Honda Motors in patent litigation action involving '342 and '627 patents, directed to electronic parts catalogs and software for preparation of customized product literature. Case settled very favorably to Honda after filing of *Markman* claim construction briefing.

*Soverain Software LLC v. Amazon.com LLC*, Civil Action No. 6:04-CV-14 LED (E.D. Tex. 2004). Represented Soverain Software in patent infringement action relating to three patents directed to systems and methods applicable to Internet-based e-commerce. Subsequent to a favorable *Markman* claim construction in first case, a second case that involved two additional patents was filed, and a second *Markman* hearing was held in that case. Amazon brought three reexamination proceedings in USPTO attacking the patents in the first case. The trial court entered a number of pretrial rulings, including SJ rulings: 2005 U.S. Dist. LEXIS 20280 (E.D. Tex. 2005) (denying Amazon's SJ of invalidity for indefiniteness, based on lack of antecedent basis); 383 F. Supp. 2d 904 (E.D. Tex. 2005) (granting SJ under 35 U.S.C. § 287, limiting Soverain's pre-suit damages for failure to mark website); 356 F. Supp. 2d 660 (E.D. Tex. 2005) (denying Amazon's first motion to stay case pending reexamination); 340 F. Supp. 2d 760 (E.D. Tex. 2004) (denying Amazon's motion to compel production of privileged documents). Amazon.com settled both cases for a \$40 million lump sum payment just before trial was to begin with jury selection.

*In the Matter of Certain Digital Processors, Digital Processing Systems, Components Thereof and Products Containing Same*, Investigation No. 337-TA-529 (USITC 2005); *BIAX Corp. v. Texas Instruments, Inc.*, Civil Action No. 04-M-2525 (PAC) (D. Colo.). Represented Texas

Instruments as respondent in ITC investigation and parallel district court action, relating to alleged patent infringement of five patents directed to digital signal processing architecture and operation. After entry of summary determination (SJ) of noninfringement by ALJ Luckern of one of two accused families of TI digital signal processors, case settled favorably to TI as hearing (trial) approached.

*PSN Illinois, LLC. v. Nestle Purina Petcare Company*, Civil Action No. 1:05 CV 2302 (N.D. Ill. 2005). Represented Nestle Purina in patent infringement case relating to cat litter product, sold by a company acquired by Ralston Purina, prior to its acquisition in turn by Nestle. Case settled favorably to Nestle Purina after design-around/product alterations made.

*In the Matter of the Application of The Procter & Gamble Company for An Order Pursuant to 28 U.S.C. § 1782 to Take Discovery*, 34 F. Supp. 2d 1112 (E.D. Wisc. 2004). Represented Procter & Gamble in seeking discovery in support of defense of foreign patent litigation (multiple cases alleging patent infringement of patents relating to disposable training pants). The trial court granted the application to take discovery in aid of patent litigation proceedings in GB, FR, DE NE, and Japan and refused stay of discovery pending appeal. The foreign cases later settled favorably to Procter & Gamble.

*MOSAID Technologies Inc. v. Hynix Semiconductor Inc.*, Civil Action No. 6:05 CV 13 (E.D. Tex. 2005). Represented MOSAID in patent infringement litigation relating to basic inventions in memory devices. Hynix settled very favorably to MOSAID before even answering the complaint.

*KOA Corporation, et al. v. Vishay Dale Electronics*, Civil Action No. 4:04-CV-247-A (N.D. Tex. 2004), Civil Action No. 2:04 CV 653 (W.D. Pa. 2004). Represented KOA Corporation and its U.S. subsidiary, KOA Speer Electronics, in a patent infringement action alleging infringement of patents directed to ultra thin resistor technology. Vishay Dale filed suit in W.D. Tex. on only two of six patents that had been in controversy between the parties. KOA then sought a declaration of noninfringement, invalidity, and unenforceability in W.D. Pa. for all six patents. The N.D. Tex. court then enjoined KOA from prosecuting the W.D. Pa. suit as to the two overlapping patents, in response to a Vishay Dale motion, and stated its willingness to address all six patents if W.D. Pa. would transfer, as Vishay had moved that court. The W.D. Pa. court refused to transfer the four nonoverlapping patents, however, despite Vishay Dale's motion. A settlement very favorable to KOA was reached soon thereafter.

*East Texas Technology LLP v. Apple Computer, Inc.*, Civil Action No. 3-04-CV-0281 (E.D. Tex. 2004). Represented Apple in patent infringement action relating to modem technology. The case settled favorably to Apple.

*Intergraph Hardware, Inc. v. Dell Computer Co.*, Civil Action No. 2:02 CV 312 TJW (E.D. Tex. 2002). Represented Dell in a patent infringement action based upon use of Intel-supplied general purpose microprocessors in the manufacture of computers, as allegedly infringing three Intergraph patents on cache memory coherency. After joining Intel as a party, based upon an indemnification obligation to Dell, the case settled very favorably to Dell, the settlement being funded by Intel.

*IP Innovation, Inc. v. Dell Computer, Inc.*, Civil Action No. 2:02 CV 295, 03 C 3245 (E.D. Tex., N.D. Ill.). Represented Dell in a patent infringement action based upon Dell's purchase and resale of computer printers that allegedly infringed IP Innovation patents. A transfer motion grounded on Dell's status as a customer of the printer manufacturers who were already being sued in N.D. Ill. was granted, and the case was transferred to N.D. Ill. A *Markman* claim construction was completed (2006 U.S. Dist. LEXIS 14069 (N.D. Ill. 2006)).

*Antor Media Corp. v. Apple Computer*, Civil Action No. 2:03-CV-320 (E.D. Tex. 2003). Represented Apple in a patent infringement case based upon its sale of its iPod digital music devices and related Internet-based music source business. After a *Markman* claim construction hearing, the case settled very favorably to Apple.

*Chevron Phillips Chemical Company LP v. TotalFinalElf S.A.*, Cause No. 2002-05019 (Harris County District Court 2000). Represented various Atofina entities in a breach of contract/trade secret case, where CP Chem alleged that it was entitled to grant-back rights under Atofina's double loop technology for producing polyethylene, particularly bimodel polyethylene grades useful in pipe products. Motions to dismiss for lack of personal jurisdiction were filed, and the case was stayed pending attempts to reach a settlement. Settlement through cross-licenses and certain JV agreements was reached in March 2006.

*Nestle USA v. Sara Lee*, Civil Action No. 1:01-CV-2074 (N.D. Ohio 2001). Represented Nestle in patent infringement action against Sara Lee "break and bake" refrigerated cookie products. A *Markman* construction proceeding resulted in a construction very favorable to Nestle: summary judgment of literal infringement of both of Nestle's patents-in-suit was granted. Various other motions striking Sara Lee defenses and expert reports were granted. The case settled very favorably to Nestle as trial approached.

*Nestle Purina Petcare Co. v. Clorox and Church & Dwight Co., Inc.*, Civil Action No. 03-664 (D. Del. 2003). Represented Nestle in patent infringement actions against two defendants who manufacture certain cat litter products. Each case settled favorably to Nestle Purina, with the infringing products being withdrawn from the marketplace.

*Symbol Technologies, Inc. v. Hand Held Products, Inc.*, Civil Action No. 03-102 (SLR) (D. Del. 2003). Represented Hand Held Products in patent infringement/declaratory judgment action originally involving scores of patents, relating to hand-held scanners. Various Rule 12 motions were filed, and ruled upon by the trial court, leading to a substantial reduction in the patents remaining in suit. The case settled favorably to Hand Held Products.

*STM v. Motorola*, Civil Action No. 4:03 CV 276 (E.D. Tex. 2004); *Motorola v. STM*, Civil Action No. 1:03 CV 0407 (E.D. Tex. 2004). Represented Motorola in two patent infringement cases, including 12 patents, one involving Motorola patents and the other STM patents, which all relate to various aspects of semiconductor products (including memory and microprocessors) structure, manufacture, and/or operation. After a series of pretrial rulings (307 F. Supp. 2d 845 (E.D. Tex. 2004) (refusing request by STM to supplement infringement contentions one week before *Markman* claim construction)); 308 F. Supp. 2d 687 (E.D. Tex. 2004) (denying STM motion to enforce compliance with Patent Rule 3-1 on part of Motorola); 327 F. Supp. 2d 687 (E.D. Tex. 2004) (*Markman* claim construction ruling), the cases settled favorably to Motorola.

*Digicom, Inc. v. Nokia Mobile Phones, Inc.*, 3:00-CV-1684-6 (N.D. Tex. 2000). Represented Nokia in a patent infringement case relating to digital telephony, which settled favorably to Nokia.

*PE Corp. v. Affymetrix*, 00 629 SLR (D. Del. 2001). Represented Affymetrix in defending allegations of patent infringement. On motion, the trial court dismissed the case for lack of subject matter jurisdiction.

*Simple Technologies v. Dense-Pac Microsystems, Inc.*, SA CV 98-822 AHS (C.D. Cal. 1998). Represented Dense-Pac in patent infringement action relating to stacking memory chip technology. Both parties alleged infringement of patents; each engaged in SJ practice, with result that Dense-Pac motions for, first, no literal infringement, then no infringement under the doctrine

of equivalents (*Festo* motion), were both granted and final judgment entered. (2001 U.S. Dist. LEXIS 25160 (C.D. Cal. 2001).) Simple filed an appeal and a second case, suing under the reissue of the first case patent. The second case was dismissed without prejudice. The Federal Circuit affirmed the first case (App. P. F. R. 38), but the United States Supreme Court *gvr'd* under *Festo* and remanded. DPAC again moved for summary judgment, which was granted, and the case was again dismissed. The case then settled very favorably to Dense-Pac while a second Federal Circuit appeal was pending.

*Olin Corp. v. Furukawa Electric Co.*, 66 USPQ2d 1786 (D. Conn. 2003). Represented Furukawa Electric in defending against allegations of patent infringement brought by Olin Corporation. The case was dismissed on Furukawa's motion for lack of personal jurisdiction. A motion seeking an award of Furukawa's attorneys fees in defending the case under 35 USC §285 was later denied. (73 USPQ2d 1317 (D. Conn. 2004).)

*Texas Industries, Inc. v. Southdown, Inc.*, Civil Action No. 3:99-CV-1803 (N.D. Tex. 1999). Represented Texas Industries in patent infringement litigation relating to cement processing technology. After *Markman* claim construction, case settled favorably to Texas Industries.

*Bard Mfg. v. Eubank Mfg. Enterprises, Inc.*, 3:00-CV-7711 (N.D. Ohio 2003). Represented Eubank in patent infringement action, where it was alleged to infringe several Bard patents relating to certain air conditioning units. Based upon evidence of invalidity and unenforceability, brought to Bard's explicit attention before Eubank answered and Bard's refusal to dismiss the case with prejudice, Eubank's counterclaimed for antitrust violations/bad faith litigation and other defenses. Following a *Markman* claim construction favorable to Eubank, the case settled favorably to Eubank.

*Texas Instruments v. LTC*, 2:01-CV-3, 4, 272, 273 (TJW) (E.D. Tex. 2001). Represented Texas Instruments (TI) in four cases alleging patent infringement of 12 TI patents relating to systems of manufacturing products and various analog semiconductor circuitry. After jury selection but before opening statements, the first case settled favorably to TI, with cross-licenses and substantial royalties to be paid to TI. (The remaining cases were settled as part of this resolution.)

*National Instruments v. MathWorks*, 2:01-CV-0011 (TJW) (E.D. Tex. 2001). Represented MathWorks in a case where it is alleged to infringe National Instruments patents relating to software/system modeling of processes. Following *Markman* claim construction (2002 U.S. Dist. LEXIS 27577 (E.D. Tex. 2002)), the case was tried before a jury to a split infringement verdict in January 2003. The trial court stayed injunctive relief in view of "substantial questions" presented by MathWorks, and denied MathWorks' post-trial motions (2003 WL 24049230) (E.D. Tex. 2003)). The Federal Circuit affirmed the denial of the post-trial motions and the judgment. Appeal Nos., 03-1540, 03-1553, slip op. (Fed. Cir. Sept. 3, 2004) [Rule 47.6], 113 Fed. Appx. 895, 2004 WL 2030128. MathWorks then modified the accused software product, and ceased to sell the earlier, enjoined product. National Instruments moved for contempt, alleging patent infringement and violation of the injunction. The trial court denied the motion (Feb. 2005), and the Federal Circuit affirmed the denial (164 Fed. Appx. 997, 2006 U.S. App. LEXIS 4068) (Feb. 2006). The case was dismissed by joint motion in December 2010.

*Intermatic Inc. v. Lamson & Sessions Co.* (Fed. Cir. 2001). Represented Lamson in Federal Circuit appeals from two cases originating in N.D. Ill. Lamson lost first case before jury and won second case on summary judgment. Federal Circuit reversed a \$12.5 million verdict in first case (273 F.3d 1355 (Fed. Cir. 2001)) and affirmed summary judgment in the second case. The

United States Supreme Court *gvr'd* the case in view of *Festo* and remanded for further proceedings before the trial court. The case later settled favorably to Lamson & Sessions.

*NTP, Inc. v. Research in Motion, Ltd.*, Civil Action No. 3:01 CV 767 (E.D. Va. 2001). Represented RIM in defense of patent infringement allegations 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 three-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 settled.

*Perceptive Biosystems, Inc. v. Pharmacia Biotech, Inc.*, 225 F.3d 1315, 56 USPQ2d 1001 (Fed. Cir. 2000). Represented Pharmacia in an appeal from decision below finding patent in case unenforceable for inequitable conduct relating to identification of proper inventors. The Federal Circuit affirmed, denying rehearing/rehearing *en banc*.

*Konrad v. General Motors Corp.*, Civil Action No. 2:00 CV-21-TH (E.D. Tex. 2002). Represented GM and 34 other defendants in regard to three patents directed to local/remote computer communication. After *Markman* construction ruling, Konrad stipulated to a judgment of noninfringement. The patent, on appeal from a related case, was found invalid (*Netscape Communications Corp. v. Konrad*, 295 F.3d 1315 (Fed. Cir. 2002)), and the appeal in this case was dismissed as moot.

*Tessera v. Texas Instruments*, C-00-02114 CW (N.D. Cal. 2000); *In the Matter of Certain Semiconductor Chips with Minimized Chip Package Size*, Investigation No. 337-TA-432 (2000); and *Texas Instruments v. Tessera*, 2:01-CV-163 (TJW) (E.D. Tex. 2001). Represented Texas Instruments in defense of two patents directed to certain packages for semiconductor devices. TI brought a declaratory judgment action to construe an existing TI/Tessera license agreement. Tessera declared the agreement in breach; contrary to its terms that all litigation occur in California, Tessera initiated a Section 337 investigation in the ITC. Motions were filed to enjoin Tessera’s pressing of the ITC investigation, which were successful. *Texas Instruments, Inc. v. Tessera, Inc.*, 231 F.3d 1325, 56 USPQ2d 1001 (Fed. Cir. 2000) (Tessera later dropped the ITC investigation regarding TI). Discovery was completed, dispositive motions decided (including summary judgment for TI that the license remained in effect, unless and until breach was proved, which dismissed Tessera’s patent infringement claims), when the case was settled just before trial by a new license agreement favorable to TI, in contrast to the existing agreement, and with no admission or consent judgment regarding infringement, validity, or enforceability.

*F&G Scrolling Mouse v. International Business Machines*, Civil Action No. 1:99CV460 (M.D.N.C. 2000). Represented IBM in defense of two patents directed to computer mouse technology, allegedly infringed by IBM’s “scrolling mouse,” which allowed scrolling without using the toolbar/cursor combination. After transferring the case on IBM’s motion (1999 U.S. Dist. LEXIS 7241 (N.D. Ill. 1999)), and ruling on certain pretrial motions (190 F.R.D. 385 (W.D. NC 1999)), the case was settled favorably to IBM after a court-ordered mediation.

*Ziarno v. American National Red Cross*, 99:C3430 (N.D. Ill. 2001). Represented IBM in defense of a patent directed to Internet-based fund-raising activities. The case was settled

favorably to IBM after *Markman* claim construction (2000 U.S. Dist. LEXIS 22508 (N.D. Ill. 2000)) and dispositive motions.

*The Timken Company v. SKF*, Civil Action No. 99-CV-37 (E.D. Pa.2002). Represented Timken in patent infringement action directed to alloy-plated bearings. While summary judgment motions were pending, the USPTO resolved a reexamination of the Timken patent over allegedly invalidating prior art, sustaining its claims but adopting a narrow construction. In view of the construction, noninfringement summary judgment was granted (193 F. Supp. 2d 813 (E.D. Pa. 2002)). The case settled while an appeal to the Federal Circuit was pending.

*Procter & Gamble v. Clorox Company*, Civil Action No. C-1-99-570 (S.D. Ohio 1999). Represented P&G in a patent infringement suit directed to Clorox's FreshCare™ spray multidodor treatment products. The case was settled favorably by license and royalty payments to P&G.

*Hemphill v. Procter & Gamble Co., Inc., et al.*, Civil Action No. DKC 2002-3736 (D. Md. 2002). Represented Procter & Gamble in patent infringement case. Defendants counterclaimed for declaratory judgment of noninfringement. A summary judgment motion was granted. (258 F. Supp. 2d 410 (D. Md. 2003)). The Federal Circuit affirmed and U.S. Sup. Ct. denied cert.

*SABIC v. ECAI and Mobil Yanbu*, Case No. Civil Action No. 00 C-07-161-JRJ (Del. Superior Court 2000). Represented SABIC, the Saudi Basic Industrial Corporation, in a declaratory judgment action seeking to establish that SABIC did not breach two 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. Following discovery, and extensive motion practice and rulings, including a ruling on the specifics of Saudi law that controlled the contract interpretations in issue, the case was tried to a jury in March 2003, with an adverse verdict to SABIC. Post-trial motions were filed and denied (2003 WL 22016813 (Del. Super. 2003)). The Delaware Supreme Court affirmed the trial court's denial of post-trial motions and the jury verdict (866 A.2d 1 (Del. 2005)).

*Procter & Gamble v. Reckitt Benckiser, Inc.*, Civil Action No. C-100-0112 (S.D. Ohio 2000). Represented Procter & Gamble in patent infringement action directed to R&C's Resolve Fabric Freshener. The case was settled favorably by license and royalty payments to P&G.

*SABIC v. Exxon Mobil Co.*, Civil Action No. 98-4897 (WHW) (D.N.J.). Represented SABIC in an action seeking to, among other things, establish breach of contracts between Exxon and a SABIC/Exxon joint venture, KEMYA (which produces polyethylene), and seeking, in part, judgment that certain patented technology involved in those breaches (directed to super condensed mode polymerization processes) be found to be owned by KEMYA and not Exxon. After discovery and decisions on numerous motions (194 F. Supp. 2d 378 (D.N.J. 2002)), the case was stayed pending decision on interlocutory appeals to the Third Circuit, and appeal to the Delaware Supreme Court of the adverse verdict in the Delaware Superior Court case. On the interlocutory appeals, the Third Circuit vacated and remanded each in part (364 F.3d 102 (3d Cir. 2004) [*Rooker-Feldman*]; 364 F.3d 106 (3d Cir. 2004 [private stipulation])). Certiorari was granted in the *Rooker-Feldman* appeal, with the Court reversing the Third Circuit. (544 U.S. 280 (2005)). The cases returned to the trial court, which dismissed the case in view of the affirmance of the Delaware Supreme Court (401 F. Supp. 2d 383 (D.N.J. 2005)).

*Teleflex, Inc. v. Ficosa Int'l, Inc.*, Civil Action No. 98-73335 (E.D. Mich. 2000). Represented Ficosa in a patent infringement action involving three patents directed to automotive automatic

transmission cable components. The case was tried to verdict before a jury in December 2000, resulting in a \$500,000 judgment against Ficosa, and a bench trial regarding inequitable conduct was held in March 2001. After denial of post-trial motions in May 2001, an injunction was entered and Ficosa appealed. Teleflex cross-appealed but dropped that appeal during briefing. The Federal Circuit affirmed the verdict. 299 F.3d 1313 (Fed. Cir. 2002).

*Douglas Press v. Arrow Int'l, Inc.*, Civil Action 95C3863 (N.D. Ill. 1999) and *Arrow Int'l, Inc. v. Douglas Press*, Civil Action No. 95 CV 2318 (N.D. Ohio 1999). Represented Arrow in defense of a patent infringement actions involving three patents directed to bingo game paper and methods and in enforcement of a patent directed to bingo game paper and methods of production. After extensive discovery, *Markman* briefing in the Cleveland litigation, a decision on a first summary judgment that narrowed substantially Arrow's possible exposure because of Douglas's failure to mark pursuant to 35 U.S.C. § 287(1997 U.S. Dist LEXIS 9229 (N. D. Ill. 1997), 1997 U.S. Dist. 11410 (N.D. Ill. 1997)), and a second summary judgment motion being filed and ruled upon in the Chicago action (1999 U.S. Dist. LEXIS 23137 (N.D. Ill. 1999)) with an appeal to the court from the Magistrate Judge's Report and recommendation pending, the parties settled both cases with crosslicenses under certain of the patents in suit.

*Arrow Int'l, Inc. v. Stuart Entertainment*, Civil Action No. 96-CV-1397 (N.D. Ohio 1999). Represented Arrow in declaratory judgment action relating to Stuart patent directed to method and apparatus for printing bingo game paper. Arrow alleged patent was invalid in view of Arrow's prior invention and commercialization of a process and printing press that produced an Arrow bingo paper product. After discovery, case settled with Arrow being granted a royalty-free license under Stuart patent.

*Texas Instruments v. Hyundai Electronics Industries*, 2-98-CV74 (E.D. Tex. 1999). Represented Texas Instruments in patent infringement actions filed against Hyundai Electronics Industries, et al. growing out of the expiration of Hyundai's license under TI patents. The trial 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 pretrial motions, including granting TI's motions 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 and certain prior art information]; 191 F.R.D. 119 (E.D. Tex. 1999); 190 F.R.D. 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. A hearing followed on Hyundai's patent misuse defense, which led to a finding 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 enhanced (treble) damages, prejudgment interest, and attorneys' fees with Hyundai taking a nonexclusive license and committing to royalty payments of \$1.2 billion over the ten- year life of the license.

*Cardinal American Corporation v. Jack-Post Corporation*, Civil Action No. 1:97-CV-310 (N.D. Ohio 1999). Represented Jack-Post in patent infringement/trade dress infringement action, which involved cross-claims under certain Cardinal and Jack-Post patents. After discovery and extensive motion practice, a 1999 jury trial resulted in a jury verdict for Jack-Post on its patent infringement claim of \$1.4 million, after dismissal of Cardinal's claims. A willful infringement finding was also made by the jury. Post-trials motion for JMOL (Cardinal and Jack-Post) and for enhanced damages, attorney's fees, and interest (Jack-Post) were decided in Jack-Post's favor. Cardinal appealed but dropped the appeal, and the case settled favorably to Jack-Post.

*In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). Represented Procter & Gamble in an appeal from a Board of Patent Appeals and Interferences decision affirming the rejection of the claims pending in the application. The court reversed, ruling in P&G's favor,

finding that the BPAI had misapplied the law of inherent anticipation, such that the Wilson reference relied upon by the PTO examiner did not defeat patentability.

*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). Represented Amiad U.S.A. Inc. in a patent infringement action alleging infringement of a Drori patent directed to a fluid pressure control device used to monitor the differential pressure in filters used in filtration and irrigation systems. After denial of cross SJ motions, the case was tried to a jury and settled during trial during Amiad's case-in-chief by exchange of licenses and releases.

*Picker Int'l, Inc. v. Mayo Foundation*, Civil Action No. 95CV2028 (N.D. Ohio 1998). Represented Picker in a declaratory judgment action challenging the alleged infringement of a Mayo patent directed to a software-based artifact correction process for MRI imaging units. The court ruled on SJ brought by Mayo, removing certain claims from the case (6 F. Supp. 2d 685 (N.D. Ohio 1998)). The case was then tried to a jury and settled during trial at the beginning of Mayo's defense case-in-chief, when Picker agreed to license the patent and make a negligible payment (in contrast to Mayo's pretrial settlement demand).

*Nastoff's .45 Shop, Inc. v. Colt's Mfg.*, Civil Action No. 4:97-CV-1784 (N.D. Ohio 1998). Represented Colt's in defense of a trademark infringement action, based upon a federal trademark registration held by Nastoff's directed to a skeletonized hammer used on certain semiautomatic handguns. After discovery, Colt's filed a motion for summary judgment on a variety of grounds, including genericness, lack of confusing similarity, prior use by Colt's and others, and lack of secondary meaning. SJ was granted in November 1998, and the registration was canceled. The decision was adhered to on reconsideration in January 1999. The case was settled while an appeal was pending before Sixth Circuit, with it being stipulated in a consent judgment that Colt's did not infringe and no damages were owed by it, and with freedom to use its skeletonized hammer without further interference.

*Encyclopedia Britannica v. Commissioner of Patents and Trademarks*, Civil Action No. 1:98-CV-00209 (D.D.C. 1998). Represented Encyclopedia Britannica in the commissioner-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, 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 report reversed the Board, and judgment was entered on the report in November 2001 without appeal by PTO. (The reexamination certificate thereafter issued.)

*Procter & Gamble v. Unilever PLC*, Civil Action Nos. 3:98-CV-955 (D. Conn. 1998) (S.D. Ohio 1998) (N.D. Ga. 1998) (D.N.J. 1998). Represented P&G in a series of suits brought by Unilever on patents directed to detergent products and processes, and by P&G on patents directed to detergent products. After Unilever's Connecticut case was transferred to Cincinnati and consolidated with a case filed by P&G (23 F. Supp. 2d 208 (D. Conn. 1998)), the parties reached a worldwide settlement, with P&G taking and giving licenses, with a lump sum payment far below Unilever's pre-suit minimum demand.

*Charleswater Products, Inc. v. Nevamar Corp.*, Appeal No. 97-1402 (Fed. Cir. 1998). Represented Nevamar as appellee in Charleswater's appeal from the trial court's grant

of summary judgment in Nevamar's favor. In an unpublished opinion, the court reversed, and returned the case to D. Md. for further proceedings. The case subsequently settled in March 2006.

*Key Pharmaceuticals v. Hercon Labs Corp.*, 161 F.3d 709, 48 USPQ2d 1911 (Fed. Cir. 1998). Represented Hercon Labs as appellant from a judgment of infringement entered after a bench trial in D. Del. The court affirmed the decision of the trial court.

*In the Matter of Certain Electronic Products, Including Semiconductor Products, Manufactured by Certain Processes*, Investigation No. 337-TA-381 (USITC 1996) and *Texas Instruments Incorporated v. Samsung*, 2:96-CV-1 and 2:96-CV-2 (E.D. Tex. 1996). Represented Texas Instruments in an International Trade Commission (ITC) investigation seeking exclusion of various Samsung products made by processes that infringed three TI patents, and in related civil actions in federal district court, seeking damages for the infringement of a substantial number of other TI patents, exceeding 10 in total. After extensive discovery, hearings, and motion practice before ALJ, the commission, and the courts, with trial in the ITC approaching, the cases settled by Samsung taking a nonexclusive license and committing to royalty payments of \$1.1 billion over the 10-year life of the license.

*Texas Instruments v. Analog Devices, Inc.*, Civil Action No. 3-90-1590-H (N.D. Tex. 1995). Represented Texas Instruments in patent infringement action against five defendants. One defendant, IDT, settled early in the case. Analog Devices settled on April 1, 1995, almost literally on the eve of trial, with substantial cross-licensing rights and resolution of other TI/Analog litigation resulting in a favorable position for TI. Trial in April-May 1995 led to a jury verdict for TI against the three remaining defendants, Cypress Semiconductor Corp., LSI Logic Corp., and VLSI Technologies, Inc., for \$51.8 million in damages, and finding each to be willful infringers.

The trial court granted JMOL against the jury verdict in August 1995 (39 USPQ2d 1481 (N.D. Tex. 1995)). An appeal was taken to the Federal Circuit, which affirmed (90 F.3d 1558 (Fed. Cir. 1996)). A petition for rehearing and rehearing *en banc* was denied; certiorari was also denied (570 U.S. 1228 (1997)).

*Sturtevant et al. v. Van Remortel, et al.*, Civil Action No. 93 Civ. 3466 (JFK) (S.D.N.Y. 1995). Represented Van Remortel in a case directed to claims of wrongful procurement of patents of Sturtevant's alleged inventions (the '502 patent directed to post-retirement health care funding) and other allegations of misappropriation, breach of contract, and unfair competition. After ruling on certain pretrial SJ and Rule 12 motions (*see* 38 USPQ 2d 1134 (S.D. NY 1995)), the case was settled on the day of trial through an exchange of cross-licenses.

*Molnlycke AB v. Procter & Gamble Co.*, Civil Action No. 93 C 0884 (E.D. Wis. 1993). Represented Procter & Gamble in a patent infringement action brought by Molnlycke AB relating to tape fasteners for disposable diapers. The case settled in late 1994, as trial approached, the settlement disposing of additional substantial foreign litigation and providing P&G and Molnlycke with certain license rights with payment of an insubstantial amount for worldwide alleged past damages by P&G.

*Timken Co. v. AM General Corp.*, U.S.D.C., Case No. 5:91 CV 3203 (N.D. Ohio 1991). Represented Timken in patent infringement action brought against AM General relating to central tire inflation systems; litigated to confidential settlement in late 1993 on terms favorable to Timken.

*Exxon Chemical Patents, Inc. v. Lubrizol Corp.*, Civil Action No. H-89-3203 (S.D. Tex.), 131 F.R.D. 668 (S.D. Tex. 1990) (discovery issues), 935 F.2d 1263, 19 USPQ2d 1061 (Fed. Cir.

1991) (interlocutory appeal on motion to dismiss); 64 F.3d 1553 (Fed. Cir. 1995) (reversing judgment below), *cert. denied*, 518 U.S. 1020, 116 S. Ct. 2554 (1996). Represented Lubrizol in patent infringement litigation brought by Exxon in Houston, Texas. The case was tried in December 1992 and November 1993, with a substantial adverse jury verdict, later enhanced for willful infringement and an award of attorneys fees (26 USPQ2d 1871 (S.D. Tex. 1993); 30 USPQ2d 1813 (S.D. Tex. 1994)), entered against Lubrizol. After two appeals from the liability and damages verdicts were fully briefed and argued in the Federal Circuit, the decision was reversed in an opinion dated September 1, 1995 (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 August 1996. That denial was reversed (137 F.3d 1475 (Fed. Cir.), *cert. denied*, 525 U.S. 877 (1998)), and the case remanded. A 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.

*B.F. Goodrich Co. v. Hercules Inc.*, Case No. 1:89-CV-2435 (N.D. Ohio 1989). Represented The B.F. Goodrich Company (BFG) in an action where BFG sought a declaratory judgment of noninfringement, invalidity, and/or unenforceability with a number of Hercules Incorporated (Hercules) patents relating to DCPD RIM technology. The trial court granted BFG's SJ motions as to three of the patents-in-suit. The case was settled in late 1992 on the eve of trial, with payment of an insubstantial monetary amount for alleged past damages by BFG, with BFG gaining covenants not to sue under Hercules' DCPD patents.

*Golden Franchising v. KFC*, Civil Action No. 3:93-CV-1901-T (N.D. Tex. 1993). Represented KFC in trademark infringement action brought against KFC in Dallas, directed against KFC's Rotisserie Gold chicken products. Plaintiff dismissed its case without prejudice after discovery, with no monetary payment or other consideration from KFC.

*Armond D. Budish v. Harley Gordon*, 784 F. Supp. 1320, 22 USPQ2d 1241 (N.D. Ohio 1992). Represented Armond Budish in a copyright infringement matter relating to his book, *Avoiding the Medicaid Trap: How to Beat the Catastrophic Costs of Nursing Home Care*. After evidentiary hearing and entry of a preliminary injunction, the case was settled, including payment of substantial monetary damages to Budish.

*American Sterilizer Co. v. Surgikos, Inc.*, Civil Action No. 4-89-238-Y (N.D. Tex. 1992). Represented American Sterilizer in patent infringement action relating to sterilization systems brought against Surgikos, coming into the case after a preliminary injunction motion against Surgikos had been defeated (17 USPQ2d 1081 (N.D. Tex. 1990)). After briefing and arguing the appeal on the injunction before the Federal Circuit and defeating a motion to disqualify the Firm (24 USPQ 2d 1547 (N.D. Tex. 1992)), the case was settled by payment of substantial monetary damages to American Sterilizer and license rights awarded to Surgikos.

*ETEK v. Picker Int'l, Inc.*, Civil Action Nos. 89-034825 and H-89-3283 (S.D. Tex. 1989). Represented Picker in extensive antitrust, unfair competition, and trade secret litigation brought in Houston, Texas state and federal courts. The case was tried and settled, with a jury verdict in favor of Picker on the antitrust issues, and with an award of damages against Picker on other counts, very much below plaintiff's expectations and minimal from Picker's standpoint.

*Advanced Dynamics Corp. v. Mitech*, Civil Action Nos. 1:90 CV 0059 (consolidated), 1:90 CV 0440 (consolidated) (N.D. Tex., N.D. Ohio 1990), 729 F. Supp. 519 (N.D. Tex. 1990) (transfer motion). Represented Advanced Dynamics in a declaratory judgment action brought against Mitech and countersuit for patent infringement. The case settled on the eve of trial (after a

summary jury trial verdict awarding substantial damages to Advanced Dynamics), for substantial damages paid to Advanced Dynamics.

*Pressco, Inc. v. Ball Corp.*, Civil Action No. 5:90 CV 0110 (N.D. Ohio 1990). Represented Ball Corporation in patent infringement action, the case being settled on the eve of trial in 1991 with a covenant not to sue granted by Pressco to Ball, for a *de minimus* payment for alleged past damages.

*Dow Chemical Co. v. Packaging Industries*, Civil Action No. 90 CV 787 (N.D.N.Y. 1990). Represented Dow in patent infringement action brought against Packaging Industries relating to hydrocarbon-blown, non-CFC polystyrene foam, wherein counterclaims for antitrust violations and unfair competition were lodged. The case settled in 1993 as trial approached, with dismissals with prejudice and a royalty bearing license being granted under the Dow patents.

*Olan Mills, Inc. v. Senior Wallet Photos, Inc.*, Civil Action No. CA 3-88-2739D; 89-948 (N.D. Tex., D.N.J. 1990). Represented Senior Wallet Photos in copyright infringement action, the matter being resolved while cross-motions for summary judgment were pending in D.N.J., where the case had been transferred after having originally been filed in Dallas, Texas.

*Picker Int'l, Inc. v. Blanton*, 756 F. Supp. 971, 17 USPQ2d 1036 (N.D. Tex. 1990). Represented Picker in an employment break off/trade secret violation case, where, after entry of a preliminary injunction, the case settled with return of misappropriated material by Blanton and acceptance of a continued injunction.

*Environmental Testing and Certification Corporation, et al. v. Automated Compliance Systems, Inc. et al.*, Civil Action No. 89-206 (JCL) (DNJ 1989) Represented ETTC in a covenant not to compete / trade secret case, which turned on whether a covenant signed by defendant Norman while an employee of O- Han ETTC subsidiary, was enforceable. The court found the covenant enforceable under Ohio law, with allowable “blue pencil” modifications to two provisions (Opinion, Feb 27, 1989). The case then settled favorably to ETTC.

*Picker Int'l, Inc. v. Varian Associates, Inc.*, 869 F.2d 878, 10 USPQ2d 1122 (Fed. Cir. 1989) (disqualification motion). Represented Picker for patent infringement in 1986 action brought as declaratory judgment action, wherein Varian counterclaimed. After resolution of representation issues, the case settled favorably to Picker with exchange of cross-licenses between the parties.

*Pizza Hut v. Little Caesars*, Civil Action No. 89-CV-707 48 (E.D. Mich., S.D. Tex. 1989). Represented Pizza Hut in trademark infringement action brought by Little Caesars, the case settling favorably to Pizza Hut on the eve of preliminary injunction hearing.

*Syrelec v. Pass & Seymour, Inc.*, 869 F.2d 838, 10 USPQ2d 1479 (5th Cir. 1989). Represented Pass & Seymour, Inc. (owner of Syracuse Electronics) in a trademark matter that obtained protection for the client’s full name.

*Lubrizol Corp. v. Exxon Corp.*, 696 F. Supp. 302, 7 USPQ2d 1513 (N.D. Ohio 1988); 104 F.R.D. 583 (N.D. Ohio 1985). Represented Lubrizol in a patent infringement action brought against Exxon on eight Lubrizol patents relating to lubricating compositions and additives for such compositions. The four-and-a-half-year-old patent case was settled on the eve of trial in 1988 after entry of a preliminary injunction following an evidentiary hearing; Exxon agreed to cease manufacture and sale of hundreds of products covered by the unexpired patents and to pay substantial monetary damages for past infringement.

*Phillips Petroleum v. Hoechst Celanese Corp.*, Case No. 88-0618 (D. Del. 1988) and *In re Certain Phenylene Sulfide Polymer Products*, Investigation No. 337-TA-296. Represented Phillips Petroleum Company in three different venues: a federal district court action in Delaware, a Section 337 investigation before the International Trade Commission, and patent revocation and infringement proceedings in the United Kingdom. The three actions involved two patents of Phillips on poly(phenylene sulfide) (PPS), an engineering plastic having a variety of uses. Phillips initiated the ITC investigation and secured favorable settlements from Hoechst Celanese, Inc.; Kureha Chemical Industries, Inc.; and Polyplastics, Inc. in late 1989. The settlements included entry of consent judgments that Phillips' patents were valid and enforceable. Phillips was granted a nonexclusive license to all patents, patent applications, and inventions of Hoechst Celanese and Kureha relating to PPS. Substantial monetary damages for past infringement and royalty fees were also paid to Phillips.

*The Continuum Co. Inc. v. Incepts, Inc. et al.*, No. 87-4645-L (193rd Judicial District, Dallas District Court 1987). Represented Incepts, Inc. et al. in defense of claims of alleged breach of contract and misappropriation of trade secrets. Continuum marketed a software system called LifeComm III for the life insurance industry, having acquired Life-Comm III and the insurance division of Informatics in 1984. Incepts had been formed in 1979 by a group of former Informatics employees; an earlier suit between Informatics and Incepts was resolved in 1979 by a settlement, which was assumed by Continuum. Continuum alleged Incepts improperly acquired possession of Life-Comm III, breached the settlement agreement and misappropriated trade secrets by using the system to design a system called inTIME. After two months of testimony in the hearing for a temporary injunction, the court held, in January 1988, that Continuum demonstrated a probability of prevailing on certain of its claims but not on others, and entered a temporary injunction restraining Incepts from certain uses of the Life-Comm III system. The full trial was set for April 1988, wherein all the temporary injunction hearing findings were to be re-litigated, along with cross-claims filed by Incepts on its allegations of antitrust violations, breach of contract and tortious interference. The case thereafter settled, before trial began.

*EMI v. Picker Int'l, Inc.*, 6 USPQ2d 1054 (S.D.N.Y. 1987). Represented Picker in a royalty dispute relating to settlement of earlier patent infringement litigation between the parties in which the Firm had also represented Picker. The matter was later settled favorably to Picker.

*Electro-Biology, Inc. v. American Medical Electronics, Inc.*, Civil Action No. 3-84-0630-6 (N.D. Tex. 1986), Appeal No. (Fed. Cir. 1987). Represented American Medical Electronics in patent infringement action relating to bone-regenerating medical devices. After trial led to a substantial adverse bench trial verdict, the case settled while a Federal Circuit appeal pending (after oral argument) very favorably to American Medical Electronics.

*Picker Int'l, Inc. v. Philips Ultrasound*, (S.D. Ohio 1985). Represented Picker International in patent infringement litigation relating to ultrasonic imaging technology. The case settled after one day of jury trial, with payment to Picker for past damages and license rights under the involved Picker patent for sale of remaining infringing units.

*Jacoby v. Farino*, Civil Action No. C85-1394 (N. D. Ohio 1985). Represented Farino in a contractual- based dispute concerning bunion splints, which Jacoby allegedly developed and which Farino agreed to contract-manufacture under an exclusive license agreement. The contract provided for resolution of any disagreements by AAA Arbitration. A disagreement arose relating to both the license and to the joint inventorship of a patent application filed directed to the splint, naming both Jacoby and Farino as inventors. The case was originally in D. Ariz., but then was transferred to N.D. Ohio. An arbitration was set to commence in September 1985. Farino moved to stay the case under 9 U.S.C. §3, while Jacoby moved to stay

the arbitration. The court (Aug 12, 1985 Memorandum and Order), granted the motion to stay the case, denied the motion to stay the arbitration and ordered arbitration of all counts of the complaint. The case later settled favorable to Farino.

*KangaROOS U.S.A., Inc. v. Caldor, Inc.*, 778 F.2d 1571, 228 USPQ 32 (Fed. Cir. 1985). Patent infringement covering athletic shoes with side pockets for valuables.

*Rhône-Poulenc Specialties Chimiques v. SCM Corp.*, 769 F.2d 1569, 226 USPQ 873 (Fed. Cir. 1985). Represented SCM in a breach of contract, misappropriation of trade secrets, and patent infringement action. SCM moved to enforce an arbitration clause in an agreement, which was denied by the trial court. The Federal Circuit reversed, enforcing the arbitration provision, despite the agreement having been entered into prior to the passage of 35 U.S.C. § 294. The case later settled, on the eve of the arbitration hearing, favorably to SCM.

*In re Certain Automatic Right Angle Shearing Machines*, Investigation No. 337-TA 172 (USITC 1984). Represented Bendix as complainant in ITC investigation, relating to patent infringement of three patents relating to automated shearing machines. The case settled favorably to Bendix as hearing (trial) approached.

Mr. Adamo has also represented a number of companies — including The Dow Chemical Company; Air Products and Chemicals, Inc.; Ball Corporation; and The Procter & Gamble Company — in arbitrations and other contested ADR matters, which are confidential proceedings, not a matter of public record. P&G has given permission for certain of the arbitrations where Mr. Adamo was lead counsel to be identified:

*In re Kellenberger* – Defended P&G against K-C’s allegation of infringement of the Kellenberger patent relating to Absorbency Under Load in a disposable diaper.

*In re Carstens* – Asserted that K-C infringed the P&G Carstens patent relating to Free Fiber Index of facial tissues.

*In re Robertson* – Asserted that K-C infringed the P&G Robertson patent relating to a third mechanical fastening means on a disposable diaper.

*In re Melius* – Defended P&G against K-C’s allegation of infringement of the Melius patent concerning Pressure Absorbency Index in a disposable diaper.

In each proceeding, a live, multiple-day evidentiary arbitration hearing was held before a 3 member panel, involving live witness testimony.

Prior to 1983, Mr. Adamo was involved in a number of significant representations, including representing Phillips Petroleum Company in *Standard Oil of Indiana v. Montedison SpA Consolidated*, Civil Action 22 No. 4319, 494 F. Supp. 370 (D. Del. 1980), *aff’d* 664 F.2d 356 (3d Cir. 1981), *cert. denied* 456 U.S. 915 (1982); *Phillips Petroleum Co. v. United States Steel Corp.*, 673 F. Supp. 1278 (D. Del. 1987); Air Products & Chemicals in *Air Products & Chems. Inc. v. Chas. S. Tanner Co.*, 219 USPQ 223 (D. S. Car. 1983); Eli Lilly in *Driscoll v. Cebalo*, 731 F.2d 878 (Fed. Cir. 1984) and a number of related patent interference proceedings; and Velsicol Chemical Co. in *Velsicol Chem. Inc. v. Monsanto*, 579 F.2d 1038 (7th Cir. 1978).