

## Recent Intellectual Property Representations

### Patent Litigation

#### RECENT PATENT REPRESENTATIONS

- Desktop Metal v. Markforged, et al. v. Ricardo Fulop, et al. (D. Mass. 2018). QE's new Boston office won its first jury trial in July 2018 during phase one of a bet-the-company litigation involving major players in the desktop 3D metal printing market. The case may have set a record for our firm's fastest time to trial ever in a patent suit (11 weeks from initial scheduling conference to trial). At trial, after hearing three weeks of evidence, the jury returned a verdict against Desktop Metal and in favor of our client, **Markforged**, finding no infringement by Markforged on any of the asserted patents. Markforged also filed counterclaims for trade secret misappropriation, breach of fiduciary duty, and breach of contract, which were tried before another jury during phase two of the litigation in September 2018. We obtained a very favorable (confidential) settlement on behalf of Markforged after opening statements and our CEO taking the stand on direct examination for multiple days.
- Affinity Labs of Texas LLP v. Netflix, Inc. (PTAB 2018). We were engaged by our client, **Netflix, Inc.**, in two inter partes review proceedings challenging the validity of patents owned by Affinity Labs of Texas, LLC relating to streaming systems for digitally stored audio, video, and textual content. Following the Oral Hearing, the PTAB issued Final Written Decisions in each proceeding finding that all challenged claims were unpatentable. We represent Netflix in an appeal of the PTAB's ruling that was recently filed by Affinity and is currently pending before the Federal Circuit. We also represent Netflix in the related District Court proceeding that currently is stayed.
- SWM v. Hydac (German Patent and Trademark Office 2018). We represented **SWM** in an opposition proceeding against Hydac, involving a patent covering filter materials for fluids and, in particular special plastic netting used for such filter materials and methods of creating such plastic netting. The German PTO revoked the patent for lack of sufficient disclosure.
- The Lincoln Electric Company et al. v. Harbor Freight Tools USA, Inc. (N.D. Ohio 2018). **Lincoln** is a prominent maker of welding power supplies. Lincoln filed an omnibus complaint against Harbor Freight in the Northern District of Ohio (Lincoln's home district) asserting patent infringement, trade dress infringement, and other ancillary claims in connection with Harbor Freight's line of competing welding power supplies. Shortly thereafter, Lincoln moved for a preliminary injunction to block future all future sales of Harbor Freight's products based on their alleged infringement of three Lincoln patents. Operating under a highly compressed schedule, we took discovery and put together a robust opposition to Lincoln's motion. Based on the strength of our opposition, Lincoln voluntarily withdrew two of the three patents and provided Harbor

Freight with Covenants Not to Sue. The Court denied the preliminary injunction based on the remaining patent.

- Sony v. Fujifilm ITC Investigation, In the Matter of Certain Magnetic Tape Cartridges and Components Thereof (ITC 2018). We represent **Sony** in a multifront battle against Fujifilm arising from Fujifilm's anticompetitive conduct seeking to exclude Sony from the Linear Tape-Open magnetic tape market. LTO tape products are used to store large quantities of data by companies in a wide range of industries, including health care, education, finance and banking. Sony filed a complaint in the ITC seeking an exclusion order of Fujifilm's products based on its infringement of three Sony patents covering various aspects of magnetic data storage technology. The ALJ issued the initial determination on August 17, 2018 finding multiple Section 337 violations by Fujifilm.
- Jazz Pharmaceuticals, Inc. v. Amneal Pharmaceuticals LLC (D.N.J. 2018). We represented **Jazz** in a Hatch-Waxman patent litigation involving Jazz's Xyrem® (sodium oxybate) drug product, which is indicated to cataplexy and excessive daytime sleepiness in narcolepsy patients. The case began in 2010 with one generic filer and five patents-in-suit. By October 2018, there were nine generic filers and nearly 20 patents-in-suit. The settlement permits entry of generic sodium oxybate before the Jazz's last-to-expire patent-in-suit, but generic entry will not occur until January 2023, with an authorized generic from which Jazz will receive a royalty. Generic entry will be allowed after the term of the authorized generic expires which may occur from July 2023 to January 2028 depending on whether various options are exercised by the parties.
- Apotex Inc. et al. v. Celgene Corp. (PTAB 2018). We won a complete victory for our client **Celgene Corporation** in an inter partes review challenging U.S. Patent No. 8,741,929, which expires in 2028. The patent covers methods of using Celgene's Revlimid drug product for the treatment of mantle cell lymphoma ("MCL"), a deadly and hard-to-treat blood cancer. Apotex is seeking to market a generic version of Revlimid with a label indication for MCL. The PTAB rejected Apotex's positions in their entirety, upholding the validity of the '929 patent.
- Inter Partes Review Proceedings filed by 10X Genomics (PTAB 2018). We represented **Bio-Rad Laboratories** in a series of twelve *inter partes* review proceedings filed by 10X Genomics that challenged a family of patents Bio-Rad was asserting against 10X in parallel litigation. We filed Preliminary Responses on behalf of Bio-Rad, challenging 10X's primary positions that Bio-Rad's patents were simple combinations of inventions that were already known. The Patent Trial and Appeal Board agreed and denied institution of all twelve petitions, thus preventing 10X from challenging the validity of the patents Bio-Rad was asserting against it.
- Carucel Investments, LP v. Novatel Wireless, Inc., Verizon Communications, Inc. and Cellco Partnership d/b/a Verizon Wireless (Fed. Cir. 2018). We represented **Novatel Wireless and Verizon** in a case involving mobile wireless hotspots and obtained a jury verdict of non-infringement on all 7 asserted claims from 4 asserted patents. The plaintiff, a non-practicing entity, asserted four patents related to a movable base station that they argued covered Novatel's MiFi hotspot. We argued to the jury that the patents were not infringed, but if read broadly enough to cover the MiFi hotspot, they were

invalid. The jury agreed there was no infringement. The plaintiff appealed the decision to the U.S. Court of Appeals for the Federal Circuit and requested that they reverse the verdict and render judgment for the plaintiff, or in the alternative, order a new trial on all 7 asserted claims with a revised claim construction order. The Court of Appeals rejected all of plaintiff's requested relief and affirmed the jury trial verdict of no infringement on all asserted claims.

- Power Integrations Inc. v. Fairchild Semiconductor Corp. (Fed. Cir. 2018). We obtained vacatur of a \$139.8 million patent infringement judgment for our client **ON Semiconductor/Fairchild Semiconductor** in its long running battle with its rival Power Integrations. The Federal Circuit ruled that the patentee had improperly relied on the entire market value rule to prove damages for patents related to switching regulation in power supplies. The case is the latest in a series of important Federal Circuit damages decisions narrowing the entire market value rule.
- Philips v. Google et al. (Mannheim District Court, 2018). We represented **Google**, first as intervenor and later on also as co-defendant, in a patent infringement action before the Mannheim District Court brought by Dutch company Philips against several mobile phone and tablet manufacturers. On May 16, 2018 the court handed down a judgement dismissing Philips' case in its entirety.
- Cascades Projection LLC v. Sony Corp. of Am. et al.; Petitioner Sony Corporation v. Exclusive Licensee Cascades Projection LLC (C.D. Cal.; USPTO; Fed. Cir., 2018). We represented **Sony Corp.** in patent proceedings relating to optical display system technologies, obtaining complete victories at each stage of the IPR life cycle. After non-practicing entity Cascades Projection, LLC sued Sony for infringement in federal court, we quickly obtained a stay and filed for *inter partes* review of Cascades' patent. The PTAB instituted all seven challenges and invalidated each claim in its final written decision. On appeal, the Federal Circuit summarily affirmed the PTAB's decision, and also rejected Cascades' petition to hear constitutional challenges *en banc*. The district court action was dismissed shortly thereafter.
- Apotex Inc. et al. v. Abraxis BioScience; Cipla Ltd. v. Abraxis BioScience (Patent Trial and Appeal Board 2018). QE won three complete victories for our clients **Celgene Corporation** and **Abraxis BioScience, LLC**, in *inter partes* reviews challenging U.S. Patent Nos. 7,820,788, 7,923,536, and 8,138,229. These patents cover aspects of Celgene's Abraxane drug product, which is approved to treat metastatic breast cancer and other aggressive cancers. *Inter partes* review of all three of these patents had previously been instituted based on identical prior art, arguments, and expert testimony in a related case that had settled. We prevailed in these IPRs by obtaining key admissions from the opposing parties' expert during his deposition. The PTAB relied on these fatal admissions in denying institution of each IPR, despite having previously instituted on the same grounds. We had previously successfully defended against another IPR covering an unrelated patent related to Abraxane, U.S. Patent No. 8,853,260.
- Huawei Technologies, Co., et al. v. Samsung Electronics Co., et al. (N.D. Cal. 2018). We represent **Samsung** in a ND Cal case brought by Huawei involving the assertion by

both parties of numerous declared essential standards patents and FRAND defenses. Samsung is also asserting an antitrust counterclaim for attempted monopolization. We persuaded Judge Orrick to issue an antisuit injunction that bars Huawei from enforcing an injunction order it obtained on two SEPs in China while the ND Cal action is pending.

- ChargePoint, Inc. v. SemaConnect (D. Md. 2018). We defended **SemaConnect, Inc.** in a patent infringement lawsuit brought by one of its competitors, ChargePoint, Inc. SemaConnect won a contract to install electric vehicle charging stations as part of the \$15 billion settlement of Volkswagen's vehicle emissions scandal. ChargePoint sought a TRO to prevent SemaConnect from installing those electric vehicle charging stations. We defeated ChargePoint's TRO motion within a week of being hired, we filed a motion to dismiss ChargePoint's Complaint within a month, and approximately two months later the Court issued a 70-page decision invalidating all of ChargePoint's asserted claims. The Court entered judgment in SemaConnect's favor.
- Barco, N.V. et al. v. EIZO Corporation et al. (N.D. Ga. 2018). We represented **EIZO** in a patent infringement action filed by Barco – EIZO's chief competitor – related to high end liquid crystal displays (LCDs) for medical applications. Between 2011 and 2016, the district court case was stayed while Quinn Emanuel successfully invalidated a majority of asserted claims in post-grant proceedings. Once the district court case resumed, Quinn Emanuel swiftly obtained summary judgment invalidating all but three asserted claims. Barco took its appeal after dismissing the three remaining claims with prejudice. The Federal Circuit heard oral argument on April 2, 2018 and issued a summary affirmance of the district court's ruling a mere 24 hours later, resulting in a complete victory for our client.
- Apple Inc. v. Samsung Electronics Co., Ltd. et al., C.A. No. 5:12-cv-00630-LHK (N.D. Cal.) We represented Samsung in a case involving Apple patents relating to minor user interface features. Following a \$100 million award of damages for patent infringement, Apple sought more than \$117 million in additional ongoing royalties for Samsung's designed around phones. Following a January 2018 hearing, the court agreed with Samsung, finding no liability for any of Samsung's design arounds.
- Google, ASUS, Wiko v. Philips, case no. 6 Ni 32/16 On November 29, 2017, the Federal Patent Court invalidated all claims of Philips' key speech codec patent EP 0 821 848, allegedly essential for the AMR standard, that Philips asserted against the Android OEMs HTC, ASUS, Archos and Wiko . Speech codecs (codecs for compression of digital speech information) can be used in Android functionalities such as dictation (e.g., as an input method). This patent was the most serious threat in a series of patent infringement actions that Philips filed globally against Android OEMs.
- Kind Consumer Ltd v. Nicovations and BAT (1998) (ICC Arbitration 2017). We acted for a **start-up innovator of novel technology** that had entered into exclusive commercialization arrangements with a multinational partner. That partner had fallen short of its obligations to our client but refused to release our client from its exclusive relationship. We were instructed to find a route for the client to terminate their arrangements. This involved two ICC arbitration proceedings and proceedings in the

Commercial Court in London. We have obtained a full exit for our client, together with the transfer to them of substantial additional intellectual property. The effect of this is that our client can now enter into alternative commercialization arrangements with a new partner.

- Apple Inc. v. Samsung Electronics Co. Ltd. (Northern District of California/Federal Circuit/U.S. Supreme Court 2015/2016/2018). On behalf of our client **Samsung**, we obtained a landmark opinion in the United States Supreme Court in the first design-patent case to reach the Supreme Court in over a century. A federal jury had awarded Apple \$399 million—the entire profits on Samsung’s accused Galaxy phones—for supposed design-patent infringement of certain narrow portions of an iPhone’s external appearance. After successfully petitioning for certiorari, we obtained a stunning 8-0 reversal vacating that award and adopting Samsung’s argument that, in a multicomponent device, infringer’s profits under Section 289 of the Patent Act are limited to profits from the component of the device to which the patented design is applied, not profits from the entire device. The high court win was one of the last chapters of the “smartphone wars” between Apple and Samsung, in which our firm has represented Samsung in all trials and appeals for the past seven years. Earlier in this case, we had already overturned a different \$382 million portion of the initial judgment, convincing the Federal Circuit to reverse all trade-dress dilution awards and to invalidate Apple’s iPhone trade dresses. All in, therefore, we eliminated almost all of the original \$930 million judgment. A retrial on certain design and utility patent damages occurred in May of 2018 with the parties settling the dispute shortly thereafter, bringing an end to seven years of litigation between the parties.
- TEK v. DunlopTech (District Court Mannheim 2016). We represent **Sumitomo Rubber Industries** against its competitor TEK in both offensive and defensive patent litigation involving tire repair kits.
- Philips v. Archos, ASUS, HTC, and Wiko (District Court Mannheim 2016). On October 11, 2016, the Mannheim Court dismissed all claims asserted by Philips against the Android OEMs HTC, Asus, Archos and Wiko for infringement of their key speech codec patent EP 0 821 848, allegedly essential for the AMR standard. Speech codecs (codecs for compression of digital speech information) can be used in Android functionalities such as dictation (e.g., as an input method). This patent was the most serious threat in a series of patent infringement actions that Philips filed globally against Android OEMs (8 patents in Germany, four standard essential, four feature patents). **Google** decided to intervene in those actions relating to Android, coordinating and actually leading the defense.
- Opposition against EP 1 482 815 (Board of Appeal of the European Patent Office 2016). We represented **Schweitzer-Mauduit International, Inc.** in opposition proceedings before the European Patent Office which resulted in the maintenance of one of their key patents relating to certain types of low-ignition proclivity paper wrappers for smoking article (“LIP” technology).
- David Netzer Consulting Engineer LLC v. Shell Oil Co. et al. (Fed. Cir. 2016). We represented **Shell** in a patent infringement appeal involving benzene purification, and won a unanimous affirmance from the Federal Circuit that Shell did not infringe the

asserted patent. In a precedential opinion, the Federal Circuit adopted our claim construction and non-infringement arguments in full, holding that the patent required a boiling-point purification process and that Shell's solubility-based purification process did not infringe as a matter of law.

- Sata GmbH & Co. KG v. Anest Iwata Corp (PTAB 2016). We defended **Anest Iwata Corporation** against an *inter partes* review petition filed by its competitor Sata GmbH, obtaining a complete denial of the petition and of Sata's request for rehearing.
- SimpleAir, Inc. v. Sony Ericsson Mobile Communications AB (Fed. Cir. 2016). At the U.S. Court of Appeals for the Federal Circuit, we obtained a complete reversal of an \$85 million verdict of patent infringement against **Google** in the Eastern District of Texas. Plaintiff SimpleAir, Inc. had sued Google, Microsoft, and numerous other providers of smartphones and software, claiming its patents covered the technology used to send notifications to mobile devices. Google, while represented by previous counsel, had been found by two juries to infringe and to owe \$85 million in royalties. On Quinn Emanuel's successful appeal, the appellate court first reversed the district court's key claim construction ruling, namely that the term "data channel" could not be a device's connection to the Internet because that would make the term redundant. Instead, the Federal Circuit held that the well-known canon of construction that each claim term should be given meaning could not trump the overriding requirement to stay true to the patent's specification. As a result, the court of appeals agreed with Quinn Emanuel that the verdicts should be reversed, and instructed the Eastern District of Texas to enter a judgment of non-infringement in favor Google.
- Brite Smart Corp. v. Google Inc. (E.D. Tex and N.D. Cal. 2016). We recently obtained a dismissal of all claims brought by Brite Smart Corp. against client **Google**. Brite Smart filed suit in July 2014 in the Eastern District of Texas asserting four patents allegedly directed at the problem of "click fraud" and accusing Google's online advertisement systems of infringement. After taking over the case from predecessor counsel, we obtained an unprecedented writ of mandamus from the Federal Circuit directing the district court to rule on our long-pending motion to transfer and staying all proceedings pending a ruling on that motion. The district court subsequently granted our motion and transferred the case to the Northern District of California. Following transfer to the Northern District, plaintiff's counsel withdrew from the litigation and we obtained a dismissal of all claims for want of prosecution.
- 3M v. TransWeb, LLC (D.N.J. 2014, Fed. Cir. 2016). We represented **TransWeb** in the defense of patent infringement claims asserted by 3M and the pursuit of antitrust claims against 3M. After a two-and-half-week trial, we obtained a unanimous jury verdict that 3M's asserted patent claims were invalid, not infringed, and (in an advisory capacity) unenforceable due to inequitable conduct. The jury also found that 3M violated the antitrust laws by attempting to enforce fraudulently obtained patents against TransWeb and awarded lost profits and attorneys' fees as antitrust damages, resulting in an approximately \$26 million judgment. The district court subsequently adopted the jury's advisory verdict that 3M had committed inequitable conduct rendering the asserted patents unenforceable. On appeal by 3M, the Federal Circuit issued a unanimous and precedential decision affirming the judgments entered below, including specifically the

finding of inequitable conduct before the Patent and Trademark Office and the award of trebled attorneys' fees as antitrust damages pursuant to the *Walker Process* fraud claim.

- Win in patent infringement case about insulation materials (Germany 2015): We represented **one of the leading German suppliers of insulation materials** against a competitor. We defended the client's patent in front of the Federal Patent Court and in front of the Federal Supreme Court and finally obtained a victory through three instances in the parallel infringement case confirming infringement on the client's patent by its competitor.
- Trusted Knight Corporation v. International Business Machines Corporation and Trusteer Inc. (D. Del. 2015). We obtained a complete defense victory for **IBM** in a District of Delaware patent case brought by plaintiff Trusted Knight Corp, a small software company with a single issued patent. Before the close of discovery, we crafted a strategy to knock out every claim of Trusted Knight's bet the company patent on invalidity grounds. At claim construction, we argued that every claim of the patent was indefinite, a strategy that is not often successful in Delaware, particularly in front of Chief Judge Stark. Judge Stark ultimately found that every claim of Trusted Knight's patent is indefinite.
- Celgene Corporation v. Natco Pharma Limited, et al. (D. N.J. 2015). We represented **Celgene Corporation** in a Hatch-Waxman patent litigation involving Celgene's Revlimid® (lenalidomide) drug product, which is indicated to treat multiple myeloma and other types of cancer. After more than five years of litigation, we obtained a favorable settlement for Celgene that does not permit full generic entry until 2026, after all but one of the nearly 30 patents covering Revlimid have expired.
- SimpleAir v. Google (E.D. Tex. 2015). We recently obtained a complete defense verdict for Google in an E.D. Texas patent case where plaintiff SimpleAir sought hundreds of millions in damages. In a prior case on related patents, handled by predecessor counsel, SimpleAir had prevailed against Google in a 2014 jury trial and obtained an award of \$85 million. SimpleAir had also previously sued on related patents and obtained settlements from a number of large technology companies, including Apple, Microsoft, Amazon, and Facebook. SimpleAir then filed suit again on two continuation patents, accusing the same Google product of infringing the continuation patents. We were retained as replacement lead counsel to handle the appeal of the 2014 verdict and to try the second case. Our team successfully obtained pretrial rulings that precluded SimpleAir from using the 2014 verdict to bolster its infringement and validity arguments in the new trial. After nearly six hours of deliberation, the jury returned a verdict of no infringement. *The Recorder* headlined Google's victory aptly as "Google Gets Sweet Revenge in E.D. Texas Patent Case," and *The American Lawyer* headlined the win as "Google Avoids New IP Headache With Help from Quinn Emanuel."
- Smartflash v. Samsung Electronics & HTC (Fed. Cir. 2015). We represented **Samsung** and **HTC** in a case involving patents related to the online payment for and distribution of content, such as apps, videos, and music. Weeks before trial, we obtained a reversal of the district court order denying a motion to stay the case pending covered business method review of the patents by the Patent Trial and Appeal Board.

- France Telecom S.A. v. Marvell Semiconductor, Inc. (N.D. Cal. Court 2015). We represented **Marvell Semiconductor** in a patent lawsuit filed by France Telecom in NY federal court. We successfully moved to transfer the lawsuit to San Francisco. Despite the fact that a number of licensees took licenses under the patent-in-suit, including competitors of our client, and allegations of willful infringement, we successfully obtained critical pre-trial rulings on partial summary judgment, claim construction and to exclude infringement under the doctrine of equivalents and obtained a very favorable jury verdict well below what France Telecom sought, with no enhanced damages and no finding of willfulness. On post-trial motions, the Court granted judgment as a matter of law and entered a defense judgment, giving Marvell Semiconductor a complete defense victory. The matter is pending appeal to the Federal Circuit.
- Google v. Nokia EP'375 (German Federal Patent Court, Sixth Nullity Senate 2015). We represented **Google** in a nullity action against Nokia concerning the German part, of Nokia's European patent EP 0 882 375 on "a communication network terminal supporting a plurality of applications". We obtained a complete victory for our client, with the German Federal Patent Court revoking Nokia's patent in its entirety and rejecting all of Nokia's 40 auxiliary requests. The decision is subject to appeal.
- Everlight Electronics Co., Ltd. v. Nichia Corporation and Nichia America Corporation (E.D. Mich. 2015). We represented **Everlight Electronics, Co., Ltd.** and its subsidiary **Everlight Americas, Inc.**, in a case involving two patents relating to specific LED technology. After a two-week jury trial in the Eastern District of Michigan, the jury found that all claims asserted against Everlight were invalid for obviousness, and that certain of the asserted claims were also invalid for lack of enablement.
- SME Holding GmbH v. Thomson Sales Europe S.A. (District Court of Hamburg 2015). Our client **Technicolor** was sued by SME Holding GmbH for damages incurred through third party patentees against a distressed company that Technicolor had sold to SME. QE took over after the initially retained firm had spent three years litigating without bringing the case any further. We completely changed the line of defense and the court dismissed the complaint with prejudice, following us on every major argument.
- Vasudevan Software, Inc. v. Microstrategy, Inc., et al. (Fed. Cir. 2015). We represented **Microstrategy, Inc.** in a case involving four patents relating to online analytical processing. After achieving a complete win at the district court, we obtained a decision affirming the district court's rulings on claim construction and non-infringement from the Federal Circuit.
- MicroUnity Systems Engineering, Inc. v. Apple, Inc. et al. (E.D. Tex. 2014). We represented **Qualcomm Inc.** in patent infringement suit brought by MicroUnity Systems Engineering, Inc. in the Eastern District of Texas. MicroUnity accused Qualcomm of infringing 10 of its patents relating to certain computer architecture and software used to facilitate efficient computer operation and performance, including architectures and software useful in parallel processing. Case resolved prior to trial through a settlement on terms favorable to Qualcomm.

- ViaSat v. Loral (S.D. Cal. 2014). We represented **ViaSat, Inc.**, a company that develops and designs satellites, in a patent infringement and breach of contract suit against Space Systems Loral (“SSL”). The jury found ViaSat’s asserted patents valid. The jury also found that SSL infringed the asserted patents and breached its contractual obligations to ViaSat by improperly using and disclosing ViaSat proprietary information to manufacture a competitive satellite for Hughes Network Systems. The jury’s findings on liability were affirmed by the District Court. Thereafter, the parties entered into a global settlement on terms favorable to ViaSat, including \$100 million in cash.
- Agincourt Gaming LLC v. Zynga, Inc., et. al. (D. Nev. and D. Del. 2014). We represented **Zynga, Sony Online Entertainment, and Blizzard** in the District of Delaware against Agincourt Gaming LLC’s allegations that our clients infringed three patents directed to awarding prizes based on game outcomes. We obtained a favorable settlement after filing Markman briefs and winning a critical discovery motion in two jurisdictions.
- Motorola Mobility Germany GmbH v. Microsoft Corp. (German Federal Patent Court 2014). We represented **Motorola Mobility** in a nullity action filed with the German Federal Patent Court against Microsoft Corp. regarding the German Part of the European Patent EP 1 304 891. Based on the prior art identified and submitted by the firm, the German Federal Patent Court completely revoked this patent. The decision is subject to appeal.
- Furuno Electric Co., Ltd., et al. v. Raymarine UK Limited (D. Or. 2014); Furuno Electric Co., Ltd., et al. v. Raymarine, Inc. (D. Or. 2014); Certain Navigation Products, Including GPS Devices, Navigation and Display Systems, Radar Systems, Navigation Aids, Mapping Systems and Related Software (ITC 2014). We represented **Furuno Electric** in cases brought to enforce their IP rights in maritime navigation patents. Cases were brought in U.S. district court and the ITC. The case settled on extremely favorable terms with each defendant.
- Gemalto v. HTC et al. (E.D. Tex. 2013, Fed. Cir. 2014). We represented defendants **Google, Motorola Mobility, HTC, and Samsung** against French digital security company Gemalto, brought and won a motion for summary judgment of non-infringement in the Eastern District of Texas, affirmed by the Federal Circuit. Plaintiff alleged that Defendants’ Android devices infringed three of its patents directed at allowing Java-based applications to run on smart cards and microcontrollers.
- Certain Opaque Polymers (ITC 2014). We are representing **The Dow Chemical Company** and **Rohm and Haas** against Turkish chemical company Organik Kimya in the International Trade Commission alleging infringement of two patents and numerous trade secrets related to opaque emulsion polymers made in Turkey and imported into the United States. Over the course of a six month discovery period, we obtained multiple orders for forensic inspection of Organik Kimya’s computers and networks, uncovering evidence of alleged trade secret misappropriation and spoliation. Organik Kimya consented to a 25-year exclusion order.

- Certain Audiovisual Components and Products Containing the Same (ITC 2014). We successfully defended respondents **MediaTek**, **Ralink** and **Funai** in an investigation brought by LSI and Agere alleging infringement of four patents concerning Wi-Fi and MPEG technology.
- 3M v. TransWeb, LLC (D.N.J. 2014). We represented **TransWeb** in the defense of patent infringement claims asserted by 3M and the pursuit of antitrust claims against 3M. After a two and half week trial, we obtained a unanimous jury verdict that 3M's asserted patent claims were invalid, not infringed, and (in an advisory capacity) unenforceable due to inequitable conduct. The jury also found that 3M violated the antitrust laws by attempting to enforce fraudulently obtained patents against TransWeb and awarded lost profits and attorneys fees as antitrust damages, resulting in a \$26 million judgment. The court subsequently found that 3M had committed inequitable conduct rendering the asserted patents unenforceable.
- Personalized User Model, LLC v. Google Inc. (D. Del. 2014). We won a complete defense verdict for client **Google Inc.** Google was accused to have infringed two patents relating to personalization services, and the plaintiff asserted that four different Google products infringed those patents. The jury unanimously found in Google's favor. It found that one of the named inventors breached his employment agreement with his prior employer (whose rights Google had purchased) by failing to assign the inventions to his employer, that none of Google's products infringed a single asserted claim of the patents, that the asserted claims were invalid as anticipated by three separate prior art references, and that the asserted claims were invalid as obvious in light of the prior art.
- Denso Corporation and Clarion Co. Ltd. v. Beacon Navigation GmbH (United States Patent and Trademark Office 2014). We recently won a complete victory for our client, **Clarion Co. Ltd.**, in one of the first-ever filed and argued inter partes review (IPR) proceedings. We coordinated across our Tokyo and Los Angeles offices to identify the strongest Japanese and English language prior art references. Working with a technical expert, we presented a report and extensive briefing to explain the complex references that were found. Because depositions are allowed in IPRs, as opposed to the prior inter partes reexamination system, we were able to establish a number of key admissions from the opposition's expert that were then used in the invalidation procedure. The IPR culminated in our successful oral argument at the PTAB before a gallery well-attended with legal and automotive industry observers. The IPR concluded when the PTAB issued its final written decision, finding every challenged claim unpatentable and giving our client a total victory.
- Motorola Mobility Germany GmbH et al. v. Apple Inc. (European Patent Office 2014). We represented **Motorola Mobility Germany GmbH** in an opposition proceeding against Apple concerning Apple's European patent EP 2 098 948 on a touch event model. We obtained a complete victory for our client, with the European Patent Office revoking Apple's patent in its entirety and rejecting all of Apple's auxiliary requests. The decision can be appealed.

- Network Protection Sciences LLC v. Fortinet, Inc. (N.D. Cal. 2013). We represented **Fortinet, Inc.**, a publicly traded network-security company, in patent litigation against a non-practicing entity, NPS. In litigation pending in federal court in Northern California, NPS targeted Fortinet's franchise product line, FortiGate firewall products, and sought damages of over \$18 million, trebled to over \$50 million. We succeeded in procuring numerous court orders finding that NPS had engaged in litigation misconduct, including attempts to conceal evidence and making false or misleading statements to the court. We also succeeded in procuring a court order excluding NPS's damages expert from trial. In the face of those rulings, NPS agreed to abandon its campaign outright. The case was dismissed with prejudice and—as disclosed in Fortinet's recent SEC filing—Fortinet paid nothing at all to NPS for that result. This was a complete win for Fortinet. It was reported widely by *Law360*, *Courthouse News*, *TechDirt* and *Network World*.
- Motorola vs. TiVo (E.D. Texas 2013). We represented **Motorola Mobility** and **Time Warner Cable** against TiVo in a case involving patented DVR technology and obtained a successful settlement for a fraction of the amount sought by TiVo during trial. We took over the case during expert discovery and less than three months before the start of trial. Our trial strategy resulted in key victories in pre-trial motions that led to the successful settlement.
- Vasudevan Software, Inc. v. MicroStrategy, Inc. (N.D. Cal. 2013). We represented **MicroStrategy, Inc.**, a database and business intelligence company, in a patent litigation suit filed by Vasudevan Software, Inc., a NPE, in the Northern District of California. The plaintiff asserted that MicroStrategy infringed four related patents. The court granted summary judgment that all four patents were invalid due to lack of enablement and adopted our construction of a key claim term that prompted the plaintiff to stipulate to non-infringement.
- Motorola v. Apple (German Federal Patent Court 2013). We represented **Motorola** in a nullity action against the German part of EP 2 059 868 (member of Apple's 'rubber band patent' family) and obtained full nullification (decision appealable).
- Nokia v. HTC et al. (District Court of Mannheim 2013). We represented **Google**, intervening in a case involving the alleged infringement of one of Nokia's video coding patents through the VP 8 codec used in Android and obtained a dismissal for non-infringement.
- Certain Electronic Digital Media Devices and Components Thereof (ITC 2013). We represented **Samsung** against Apple in the U.S. International Trade Commission in an investigation based on seven Apple patents. After a trial in June 2012, the Commission issued its Final Determination on August 9, 2013, finding violations of Section 337 based on old designs but permitting importation of newer Samsung products that use designs adjudicated by the Commission to be non-infringing.
- Motorola Mobility Germany GmbH vs. Apple Inc. (Federal Patent Court of Germany 2013). We represented **Motorola Mobility** in a nullity action against Apple concerning the German part of Apple's European patent EP 1 430 380 on dynamic light effects for computing devices. We obtained a complete victory for our client, with the German

Federal Patent Court revoking Apple's patent in its entirety and rejecting all of Apple's auxiliary requests. The decision can be appealed.

- Motorola Mobility Germany GmbH et al. v. Apple Inc. (Federal Patent Court of Germany 2013). We represented **Motorola Mobility Germany GmbH** in a nullity action against the German part of EP 1 964 022, Apple's often cited 'slide to unlock patent' and obtained nullification in its entirety (first instance).
- Function Media, LLC v. Google, Inc. and Yahoo, Inc. (E.D. Tex. 2010, Fed Cir. 2013). We were brought in five months before trial to defend **Google**'s AdSense advertising products against Function Media's \$600 million claim of infringement of three patents. We won a unanimous jury verdict of both non-infringement and invalidity in the Eastern District of Texas in Google's first patent trial and a complete affirmance of the judgments from the United States Court of Appeals for the Federal Circuit.
- Micron Technology, Inc. v. Rambus Inc. (D. Del. 2013). On behalf of **Micron Semiconductor Products, Inc.** and **Micron Technology, Inc.**, we obtained a ruling declaring 12 Rambus patents unenforceable due to Rambus's bad faith spoliation of evidence.
- SpendingMoney LLC v. American Express Company and Visa U.S.A. Inc. d/b/a Visa U.S.A. (D. Conn. 2012, Fed. Cir. 2013). We won a Federal Circuit affirmance of the summary judgment of non-infringement that we won for **American Express Company** against SpendingMoney LLC in the District of Connecticut, in which the court ruled that American Express's Travelers Cheque Card does not infringe SpendingMoney's patent. Confirming the strength of our brief and oral argument on appeal, the Federal Circuit entered its affirmance under Fed. Cir. Rule 36, meaning that we showed that each of SpendingMoney's appellate arguments lacked substantial merit.
- Finjan v. Symantec (D.Del. 2012). We obtained a complete defense verdict for **Symantec Corporation** following a three week jury trial in the District of Delaware before Chief Judge Gregory M. Sleet. The jury concluded that Symantec and two other defendants did not infringe two patents owned by Finjan Inc. relating to the protection of computers and networks against hostile "downloadable" programs. The jury further found the asserted patents to be invalid, handing the defense a complete victory. Finjan asserted that Symantec's consumer and enterprise security products—including its popular Norton AntiVirus and Symantec Endpoint Protection lines—violated the asserted patents. Finjan's attorneys argued that the patents covered "behavior-blocking" technology to protect against known and unknown malware threats, and it sought over \$1 billion dollars in damages from Symantec based on past damages, willful infringement, and an ongoing running royalty. This victory comes on the heels of an earlier case brought by Finjan against Secure Computing, in which Finjan prevailed in a jury trial before Judge Sleet that involved one of the two patents later asserted against Symantec.
- Stiefel Labs v. Perrigo (D. Del. 2012). We represented plaintiff **Stiefel** in Paragraph IV patent infringement litigation involving Olux®-E clobetasol propionate emulsion foam.

- Apple Inc. v. Samsung Electronics Co. (N.D. Cal., Fed. Cir. 2012). In a widely covered decision, the court vacated a preliminary injunction issued against our client **Samsung** in the Apple-Samsung smartphone wars, holding that Apple failed to show causal nexus to harm that would justify a preliminary injunction against Samsung's Galaxy Nexus. The opinion clarifies and strengthens the legal standard for finding causal nexus between patent infringement and the irreparable harm required to issue an injunction. For products like modern smartphones, which contain hundreds or thousands of patented features, this decision will make it more difficult for any patent holder to justify an injunction based on alleged infringement of a single feature patent. The court also held that, under the proper claim construction, the Galaxy Nexus likely does not infringe Apple's '604 patent.
- Certain Projectors with Controlled-Angle Optical Retarders, Components Thereof, and Products Containing Same (ITC 2012). We represented **Sony** in an ITC Investigation regarding ultra-high resolution LCD projectors, including those used in movie theaters throughout the U.S. Two weeks before trial and for nothing in return, Complainants requested that the investigation be terminated in its entirety, securing a total defense victory on behalf of Sony.
- Deep9 Corporation v. Barnes & Noble (W.D. Wash. 2012, Fed. Cir. 2013). After being brought into the case as lead trial counsel several months before trial, we obtained summary judgment of non-infringement on behalf of **Barnes & Noble** in a case involving allegations that Barnes & Noble's NOOK eReader devices infringed two patents claiming methods of synchronizing data in multiple devices over a network. The Federal Circuit subsequently affirmed the summary judgment of non-infringement.
- Microsoft Incorporation v. Motorola Mobility Germany GmbH (District Court Munich 2012). We represented **Motorola** in a preliminary injunction proceeding for patent infringement brought by Microsoft. We obtained a full dismissal of the action.
- Applied Medical Resources Corp. v. Tyco Healthcare Group LP d/b/a Covidien (C.D. Cal. 2012). We won summary judgment of non-infringement for **Covidien** against Applied Medical Resources Corp., obtaining a judgment that Covidien's VERSAPORT™ PLUS surgical trocar products do not infringe Applied's patent.
- Plantronics, Inc. v. Aliph, Inc. (N.D. Cal. 2012). We obtained a complete defense victory in a patent case for **Aliph, Inc.**, the maker of popular Bluetooth products known as Jawbone headsets and Jambox speakers. Aliph, a venture backed company, was sued by the much larger headset manufacturer, Plantronics, Inc. for infringement of a patent allegedly covering the earbud component of all Jawbone headsets. We were retained after the patent had emerged from reexamination and the case had been transferred to Northern California from Texas. We obtained a favorable claim construction relatively early in the case, then moved for summary judgment of both noninfringement and invalidity. The court issued a 32-page opinion in Aliph's favor, finding that Aliph both did not infringe and that the patent was invalid, despite Plantronics' argument that the reexamination strengthened the patent against an invalidity challenge.

- 3M v. Tredegar (D. Minn. 2012). We obtained a complete victory on behalf of our client **Tredegar** against 3M. 3M had asserted four patents related to elastomeric film laminates commonly used in diapers. The court issued a Markman order in which we won on virtually every issue. After considering the devastating effect of this ruling on its infringement claims, 3M stipulated to non-infringement and the district court entered judgment in favor of Tredegar.
- Motorola v. Apple (District Court Mannheim 2011/2012 and Court of Appeal Karlsruhe 2012). In the ongoing patent dispute between Motorola Mobility and Apple, we scored an important strategic victory for **Motorola**. In December 2011, we achieved a widely noticed first-instance victory for Motorola when the Mannheim District Court awarded an injunction against Apple Sales International out of a standard essential mobile communications patent. In February 2012, we scored a second offensive victory (case is now pending on appeal) for Motorola against Apple Sales International, this time based on a patent claiming the synchronization of, *inter alia*, the message status of a plurality of transceivers such as mobile phones or tablet computers. Very recently, this first-instance victory was repeated against the ultimate parent company of the Apple group, Apple Inc. (case is now pending on appeal). Motorola asserted said synchronization patent against Apple's MobileMe and iCloud services. The patent was also asserted against Apple's mobile devices for contributory infringement. The Mannheim court found that Apple's synchronization method directly infringed Motorola's patent and issued an injunction. The court also found that the accused mobile devices indirectly infringed Motorola's patent and issued an injunction in this regard as well. Following the judgment, Apple switched off the "push" synchronization functionality of its iCloud and MobileMe services in Germany.
- Motorola Mobility Inc. v. Microsoft (District Court Mannheim 2011 and Court of Appeal Karlsruhe 2012). We have been representing **Motorola Mobility Inc.** and its subsidiaries in the German courts on a regular basis. We won very important first instance victories for Motorola Mobility Inc. and its subsidiary General Instrument Corp. in patent infringement cases against Microsoft Corp. and its subsidiaries Microsoft Germany GmbH and Microsoft Ireland Operations Ltd. On behalf of General Instrument, we asserted two patents essential to the H.264 video coding standard which is used e.g. in the software products Windows 7, Internet Explorer 9, Media Player 12, and the video game console Xbox 360. General Instrument sued Microsoft for infringement of its patents with the District Court Mannheim back in July 2011, and we achieved a full win for the client. We won another important first instance victory for Motorola Mobility Inc. and its subsidiary Motorola Mobility Germany GmbH in defending the Android operating system against a complaint brought by Microsoft Corp. After two oral hearing, we achieved a complete dismissal of the complaint by establishing non-infringement on the patent. The cases are pending on appeal level now.
- St. Gobain Isover v. Knauf (German Federal Supreme Court 2011 (nullity action), District Court Mannheim 2011/2012 and Court of Appeal Karlsruhe (infringement case)). We are representing **St. Gobain-Isover** in a patent infringement case against Knauf and in the parallel nullity action. We managed to maintain the patent in suit before the German Federal Supreme Court in December 2011. Following this decision,

infringement was litigated before the Mannheim court. We obtained a full win for the client. The hearing in the infringement case was mostly about claim construction, but also on rules for evidence (when does the burden of proof shift from the plaintiff to the defendant). The infringement case is pending on appeal level now.

- University of Virginia Patent Foundation v. General Electric Company et al. (W.D. Va. 2011). We defended **GE** in a patent infringement case brought by The University of Virginia Patent Foundation in the Charlottesville Division of the Western District of Virginia—the Patent Foundation’s “home court.” The Patent Foundation’s asserted patent covered magnetic resonance imaging (MRI) technology. Shortly after the Patent Foundation filed the case, GE successfully sought reexamination of the asserted patent. During reexamination, the Patent Foundation filed an amendment and, in response, the USPTO issued a reexamination certificate. We then filed a motion for partial summary judgment of no liability prior to the issuance of the reexamination certificate. The court granted our motion—substantially reducing the potential damages that the Patent Foundation could recover if it prevailed on liability—and the case soon settled on very favorable terms.
- ICHL, LLC v. Sony Electronics Inc. et. al. (E.D. Tex. 2010, Fed. Cir. 2011). We obtained a complete victory for **Sony Electronics Inc.** (“Sony”) and 15 other defendants in a patent infringement action in the Eastern District of Texas and the Federal Circuit against Intellectual Capital Holdings Limited (“ICHL”). In a case that had far reaching damages implications for Sony and other manufacturers of computers, gaming consoles, televisions and any other products that use a heat sink to reduce internal heat, we convinced the Magistrate Judge, District Court Judge, and the Federal Circuit that the defendants’ products did not infringe ICHL’s patent.
- Soverain Software LLC v. J.C. Penney et al. (E.D. Tex. 2011). We won a unanimous jury verdict on both infringement and validity in the Eastern District of Texas. The technology at issue in this case concerned e-commerce technology that retailers use to facilitate sales made through their websites.
- Eon-Net LP et al. v. Flagstar Bancorp (Fed. Cir. 2011). We obtained a complete victory on claim construction, a stipulated judgment of non-infringement, and an award of over \$600,000 in attorney fees and sanctions for our client **Flagstar Bancorp** in a patent infringement case related to converting hard copy documents to computer files using templates and content instructions. On appeal, the Federal Circuit affirmed the judgment for our client in its entirety.
- OptimumPath, L.L.C. v. Belkin International et al. (N.D. Cal. 2011, Fed. Cir. 2012). We obtained a complete summary judgment victory for clients **Belkin, Cisco, D-Link, and NETGEAR**. The plaintiff filed suit against our clients in the District of South Carolina. We successfully moved to have the case transferred to the Northern District of California. We then obtained summary judgment of non-infringement and invalidity on all asserted claims. On appeal, we won affirmance of summary judgment of non-infringement and invalidity.

- Toshiba Corporation v. Coby Electronics Co., Ltd. (AAA/ICDR 2011). We won a \$18.5 million dollar AAA/ICDR arbitration award for **Toshiba Corporation** (as Licensor for the DVD6C Patent Licensing Group) in a patent license dispute against Coby Electronics, a manufacturer of DVD video players, for unpaid and underreported royalties.
- SmartMetric, Inc. v. American Express Company (C.D. Cal. 2011 and Fed. Cir. 2012). In June 2011, we won a stipulation of non-infringement in a patent infringement case for **American Express** concerning Amex's contactless ExpressPay® card products. The suit was originally filed in December 2010 in the Central District of California, and we structured the case for an early claim construction. A claim construction hearing, consolidated with a related case, was held in March 2011, and the court adopted verbatim American Express's proposed construction of the key claim term, issuing its claim construction ruling in May 2011. This construction completely undermined the plaintiff's case, making it impossible for the plaintiff to prove infringement. The stipulation of non-infringement followed. Plaintiff appealed the key claim construction to the Federal Circuit, and we won an appellate affirmance in April 2012.
- Creative Internet Advertising Corp. v. Yahoo! Inc. (Fed. Cir. 2011). We obtained a complete reversal of a \$12 million patent infringement judgment on behalf of **Yahoo! Inc.** The plaintiff alleged that the Yahoo! Instant Messenger feature called "IMVironments" infringed a patent on displaying advertisements in the background of electronic messages. The trial in the Eastern District of Texas, at which Yahoo! was represented by another firm, resulted in a finding of willful infringement and no invalidity, and the district court ordered a 23% ongoing royalty. On appeal, we persuaded the Federal Circuit that the district court erred by not resolving a key claim construction dispute and not granting Yahoo!'s motion for judgment as a matter of law of no infringement.
- Paid Search Engine Tools, LLC v. Yahoo! Inc., et al. (E.D. Tex. 2010, Fed. Cir. 2012). Representing **Google**, we brought and won an early summary judgment motion of invalidity. The patent-in-suit was asserted against Google by Paid Search Engine Tools ("PSET"). PSET had accused Google's AdWords system of infringing the patent, which involved a bid management system that could adjust bidders' bids in online auctions in order to obtain their desired positions and eliminate "bid gaps." The Federal Circuit affirmed the district court's order *per curiam*.
- Alpla Werke Alwin Lehner GmbH & Co.KG v. Cobarr S.p.A. (Nullity action before German Federal Patent Court, Munich). We obtained a complete victory in a patent nullity action on behalf of **INVISTA Resins and Fibers GmbH** who joined the action as intervenor. The patent-in-suit related to a gas barrier functionality of polyester bottles. The nullity action was filed in response to a patent infringement action brought before the District Court Düsseldorf by Cobarr S.p.A. (a subsidiary of M&G). The court adopted our position and revoked the relevant claims of the patent-in-suit. As a result, the corresponding infringement action was fully withdrawn.
- Zamora Radio, LLC v. Last.FM, Ltd et al. (S.D. Fla. 2010). On behalf of clients **Real Networks** and **Rhapsody**, we won summary judgment of non-infringement on all

grounds in an internet radio patent infringement case filed in the Southern District of Florida.

- PrivaCash, Inc. v. American Express Company et al. (W.D. Wis. 2010 and Fed. Cir. 2011). We successfully represented **American Express and its affiliate** in a patent infringement action targeting their gift card products, in which plaintiff PrivaCash sought over \$100 million in past damages and future royalties. The firm obtained a dismissal of co-defendant American Express Incentive Services, LLC (“AEIS”) early in the case after proving that AEIS’s gift cards were distributed and sold in the business-to-business environment and therefore could not infringe plaintiff’s patent. We then sought and secured a favorable claim construction ruling for remaining defendant American Express, and shortly thereafter filed a motion for summary judgment of non-infringement. Approximately one month before trial, the District Court granted American Express’s motion and entered summary judgment of non-infringement. In August 2011, the Federal Circuit affirmed the District Court’s summary judgment of non-infringement in favor of American Express.
- Bright Response LLC v. Google Inc. and Yahoo Inc. (E. D. Tex 2010). Defending **Google** against a \$128 million patent infringement claim brought by Bright Response LLC against Google’s AdWords advertising system in the Eastern District of Texas, we won a complete non-infringement and invalidity verdict after a six-day jury trial.
- Software Rights Archive, LLC v. Google Inc., Yahoo! Inc., IAC Search and Media, Inc., AOL, LLC, and Lycos, Inc. (E.D. Tex. 2010). Our client, **IAC Search and Media, Inc. (“IACSAM”)**, was sued by a patent troll for the alleged infringement of several patents that allegedly covered key parts of the search algorithms used in IACSAM’s Internet search engine. The plaintiff, who was represented by several plaintiffs’ firms, sought extensive damages for the alleged infringement by IACSAM and other search engine operators, such as Google and Yahoo!. Our firm played a key role in the preparation of invalidity contentions on behalf of the joint defense group, and the filing of a motion to transfer the case to the Northern District of California, which was recently granted. The plaintiff agreed to a favorable settlement for IACSAM in an amount that was significantly smaller than the plaintiff’s initial demand.
- Performance Pricing Inc. v. Google Inc., et al. (E.D. Tex., Fed. Cir. 2010). On behalf of **Google** and **AOL**, we won affirmance of summary judgment of non-infringement in a patent infringement litigation in which the patent-in-suit was asserted against the defendants in September 2007 by Performance Pricing Inc., an Acacia entity. Performance Pricing had accused Google’s AdWords and AOL’s Search Marketplace systems of infringing the patent, which involved a method of doing business over the Internet “wherein various forms of competition and/or entertainment are used to determine transaction prices between buyers and sellers.”
- PA Advisors, LLC v. Google Inc. and Yahoo! Inc. (E.D. Tex. 2010). On behalf of **Google Inc.**, we obtained summary judgment of non-infringement, of all asserted claims of the patent owned by nXn Tech. f/k/a/ PA Advisors LLC, a non-practicing entity of Erich Spangenberg. The plaintiff had accused Google’s personalized search and advertising products of infringing a patent that involved a method of personalizing

search results based on “linguistic patterns” favored by a user. Plaintiff had sought \$121 million in damages and an ongoing royalty.

- Catalina Marketing Corporation and Catalina Health Resource v. LDM Group, LLC. (E.D. Mo. 2010). We were retained by plaintiffs **Catalina Marketing Corporation** and its wholly owned subsidiary, **Catalina Health Resource** (collectively “Catalina”), to take over as lead counsel in an action alleging infringement of U.S. Patent No. 6,240,394 (“the ‘394 patent”) shortly before the Markman hearing. The ‘394 patent disclosed and claimed a novel method and computer system for generating targeted messages for pharmacy patients at the point of sale. Catalina alleged that LDM Group LLC’s “Carepoint” product and related services infringed the ‘394 patent. The parties resolved the case informally pursuant to a confidential settlement agreement.
- Societa Italiana per lo Sviluppo dell’Elettronica S.p.A. (Sisvel S.p.A.) v. Hang Shing Technology Corp. (Court of Appeal Karlsruhe/Germany 2010). We have been representing **Sisvel** for years enforcing the Philips, France Telecom, IRT and TDF patents covering MP3 in numerous cases. In March 2010, the first decision was rendered by the Court of Appeal Karlsruhe confirming infringement and rebutting the counterpart’s antitrust defense based on the standard essentiality of the enforced patent
- ESN, LLC v. Cisco Systems, Inc. (E.D. Tex. 2010, Fed. Cir. 2010). We obtained a complete victory for **Cisco** in this closely watched patent infringement dispute. The plaintiff, a patent holding company, asserted a patent on a method for Voice over Internet Protocol telephony against Cisco’s line of Integrated Services Routers. We discovered that the invention had been conceived while the inventor was subject to an invention assignment agreement with his former employer. We moved to dismiss the complaint for lack of standing, arguing that because the patent was related to the former employer’s business, ownership was automatically transferred to the employer under the assignment agreement. The court agreed and dismissed the case. The Federal Circuit subsequently affirmed after oral argument.
- Source Search Technologies, L.L.C. v. LendingTree, LLC, IAC/InterActiveCorp, and ServiceMagic, Inc. (D.N.J. 2009, Fed. Cir. 2010). On behalf of our clients, **IAC/InterActiveCorp**, **LendingTree**, and **ServiceMagic**, we obtained a summary judgment of invalidity. The District Court granted our motion for summary judgment that the asserted claims were invalid for obviousness. If the patent had survived, it could be asserted against any and all Internet buyer-vendor matching sites.
- Desenberg v. Google, Inc. (S.D.N.Y 2009). We defended **Google** in a patent infringement suit brought by Roger Marx Desenberg, the inventor of U.S. Patent No. 7,139,732. The patent claims a method for connecting consumers and service providers with matching interests. Mr. Desenberg alleged that Google’s AdWords system infringed the patent by targeting users of its search engine for service-related advertisements based on the user’s queries. Mr. Desenberg claimed more than \$1 billion in damages and sought a preliminary injunction. We successfully defeated the preliminary injunction and simultaneously obtained dismissal of Mr. Desenberg’s claims. The asserted claims required acts by multiple independent parties, including separate “users” and “service providers” to interact with a third-party matching system,

and then purchase services based on that match. Google did not and could not play each of these separate roles, and could not credibly be alleged to control the acts of Internet users. The court accepted our position in its entirety, denying the preliminary injunction and dismissing Mr. Desenberg's claims with prejudice.

- IGT v. Alliance Gaming Corp., Bally Gaming, Inc., and Bally Gaming International, Inc. (D. Nev. 2009). We defended **Bally** in a patent infringement suit brought by IGT, a Fortune 100 Company and the dominant player in the gaming machine industry. IGT asserted patents pertaining to its Wheel of Fortune slot machine, which is widely regarded as the most successful slot machine in the history of gaming. Bally counterclaimed that IGT violated federal and state antitrust laws by asserting these wheel game patents it knew to be invalid and unenforceable in an attempt to eliminate competition from the marketplace. Bally prevailed on invalidity, with the court finding one of the wheel patents indefinite and the remainder invalid as obvious. The court also granted Bally's summary judgment motion of non-infringement with regard to the wheel patents and found all but one of the remaining asserted patents not infringed, invalid, or both. The court denied IGT's motion for summary judgment on Bally's antitrust counterclaims. When word of the impending summary judgment rulings obtained by our firm reached the market (the day before the written orders issued), Bally's stock price increased 10%, even though the Dow Jones Industrial Average declined over 8% that day.
- Sony Corporation v. Westinghouse Digital Electronics, LLC (C.D. Cal. 2009) We won a Final Judgment by Consent on behalf of client, **Sony Corporation**, in a patent-infringement suit against Westinghouse Digital Electronics, LLC over patents directed to digital closed captioning, on-screen display and digital copy protection technologies used in digital televisions and monitors. Sony filed a complaint for infringement of seven of its patents in the United States District Court for the Central District of California and later amended its complaint to add three additional patents. Just nine months after Sony filed its original complaint, Westinghouse Digital acknowledged infringement of each of Sony's ten patents. Westinghouse Digital also admitted to the validity and enforceability of each of the patents and agreed to take a license under the patents, which was a complete victory for Sony. Sony has also commenced a patent infringement action under the same ten patents against Vizio, Inc., whose televisions are manufactured by Taiwan-based AmTRAN Technologies, Inc. The action against Vizio is currently pending before the same judge who entered the consent judgment against Westinghouse Digital.
- Micron Technology, Inc. v. Rambus Inc., et al. (D. Del. 2009) We represented **Micron Technology** in its long running battle against Rambus in a patent case arising out of Dynamic Random Access Memory ("DRAM") technology. The U.S. District Court of Delaware trifurcated the trial into three phases – the "unclean hands" phase, the "patent" phase, and the "conduct" phase. In the unclean hands phase, the court, following a five-day bench trial, issued a written opinion finding that Rambus spoliated evidence and declared the patents in the suit unenforceable. The case was appealed to the Federal Circuit which upheld the finding that Rambus destroyed documents in anticipation of litigation and remanded for further proceedings regarding bad faith and prejudice.

- Activision Publishing Inc. v. Gibson Guitar Corp. (C.D. Cal. 2009) We represented **Activision** and won summary judgment of non-infringement in a patent infringement litigation, disposing of all patent claims in the case. The litigation concerned the popular *Guitar Hero*® video games, one of the best-selling video games of all time. Activision filed the lawsuit in the Central District of California, seeking a declaration that the accused video games did not infringe a patent owned by Gibson directed to a “System and Method for Generating and Controlling a Simulated Musical Concert Experience.” The court’s ruling was issued less than a year after the case was filed.
- Bid For Position v. AOL (Fed. Cir. 2009). We won affirmance of summary judgment of non-infringement for **Google** in a patent infringement litigation in which plaintiff sought in excess of \$150 million in past damages and a royalty on future revenue in the billions. The litigation concerned the AdWords auction system used by Google to sell advertisement space on search results pages for Google.com and partner sites.
- Girafa.com v. Amazon Web Services LLC; Amazon.com, Inc., Alexa Internet, Inc.; IAC Search & Media, Inc.; Snap Technologies, Inc.; Yahoo! Inc.; Smartdevil, Inc.; Exalead, Inc.; and Exalead S.A. (D. Del. 2009). We defeated a patent troll at the pre-trial stage, having claims declared either invalid or not infringed. The patent addressed the use of thumbnails and storage and the retrieval of the same in the context of a search engine.
- Web Tracking Solutions, LLC and Daniel Wexler v. Google, Inc. (E.D.N.Y. 2008). We represented **Google** against an Acacia entity (Web Tracking Solutions) and a Brooklyn-based inventor (Daniel Wexler) in a suit alleging infringement of United States Patent No. 5,960,409. The patent purported to cover basic tracking mechanisms for online advertisements, including the use of a third-party tracking service. Plaintiffs claimed they were owed royalties on essentially all of Google’s advertising revenues. Based on aggressive claim construction strategies, we secured favorable claim constructions with two Brooklyn-based judges: first, a favorable ruling by Magistrate Jose Reyes, following an eight-hour Markman hearing; and second, a confirmation of that favorable ruling by Judge Roslyn Mauskopf, after several months of briefing. In light of the Court’s claim construction, plaintiffs stipulated to dismiss the case.
- ShuffleMaster v. Bally Technologies (D. Nev. 2008). We won a summary judgment of non-infringement and obviousness on asserted patents concerning casino table game monitoring.
- Litton/Northrop v. Tyco (C.D. Cal. 2008). We won six consent judgments and over \$170 million on a single patent covering optical fiber amplifiers.
- Intertainer, Inc. v. Apple Computer, Inc., Google Inc., and Napster, Inc. (E.D. Tex. 2008). We represented **Google** in a case brought against it, Apple and Napster by Intertainer claiming infringement of U.S. Patent No. 6,925,469, which relates to a digital entertainment service platform. We responded by requesting an inter partes reexamination of all claims of the ‘469 patent. The Patent Office issued a non-final office action rejecting all claims. As a result of the reexamination victory, the plaintiff

sought a stay of the infringement lawsuit pending completion of the reexamination proceedings.

- IBM v. PSI (S.D.N.Y. 2008). We represented **IBM** in a patent, trade secret, and antitrust case involving mainframe computer technology. The case settled on terms very favorable to IBM.
- Gillette v. Dorco (D. Mass 2008). Representing **Pace Shave** and various **Dorco entities** as defendants, we successfully obtained a cost-effective and early global settlement in this razor industry litigation involving eleven patents spanning over 250 claims, as well as numerous assertions of trademark and trade dress.
- University of Texas v. BenQ (W.D. Tex. 2007, Fed. Cir. 2008). We represented **most of the cell phone industry** (30+ defendants) in a patent case in Texas brought by the University of Texas involving predictive text messaging. After convincing the court to stay discovery on everything except claim construction and hold a separate trial on validity of the patent, the court granted defendants' motion for summary judgment of non-infringement. The Federal Circuit upheld this judgment on appeal.
- Friskit v. RealNetworks (N.D. Cal. 2007). We won summary judgment of invalidity due to obviousness on all four asserted patents, based on *KSR Int'l v. Teleflex*, in a case involving Internet media search and playback technology. This was the first reported post-KSR summary judgment decision resulting in a dismissal based on obviousness.
- Ethos v. RealNetworks (D. Mass. 2006). We won a defense jury verdict of patent invalidity and non-infringement for a major Internet digital media delivery company in a five-week trial in which plaintiff sought in excess of \$200 million in damages.
- Unova/Intermec v. Hewlett Packard (C.D. Cal. 2006). We obtained seven consent judgments and over \$250 million on a portfolio of patents covering the smart batteries used in notebook computers.
- Planet Bingo LLC v. GameTech International 472 F.3d 1338 (Fed. Cir. 2006). We obtained by motions in limine a judgment of non-infringement in the defense of **GameTech** and three of its officers or directors, and won an order invalidating various claims of the plaintiff's asserted patents. Those rulings were affirmed by the Federal Circuit.
- Freedom Wireless Inc. v. Boston Communications Group Inc. (D. Mass. 2005). We conducted a 15-week trial against 12 defendants for infringement of prepaid wireless telephone systems and methods. We won a \$128 million jury verdict against several wireless telephone carriers. The verdict was the largest ever awarded in Massachusetts, and was the eighth biggest verdict awarded in the U.S. that year.
- LL International Shoe Co. v. Nike (C.D. Cal. 2005, Fed. Cir.). We defended **Nike** in \$40 million trade dress and design patent infringement claims over Nike's Air Jordan basketball shoes. We obtained a concession on the trade dress claims and summary

judgment of non-infringement on the patent infringement claim, which was later affirmed by the Federal Circuit.

- TME Enterprises v. Dakota Block (C.D. Cal. 2005). We won summary judgment of non-infringement for multiple defendants on patents involving chemical adhesives for construction materials.
- Hoffer v. IBM (N.D. Cal., Fed. Cir. 2005). We won a summary judgment of non-infringement and invalidity on behalf of **IBM** in a case alleging infringement by IBM's Universal Description Discovery and Integration offering. The Federal Circuit affirmed the lower court's finding of non-infringement.
- Adkins v. Mattel (C.D. Cal. 2005). We successfully defended **Mattel** in a patent infringement suit involving clam-shell packaging used for Mattel's famous HOT WHEELS line of die-cast cars. The final judgment included a declaration of non-infringement.
- Seiko Epson v. Print-Rite (D. Or. 2004). We obtained a summary judgment of infringement of **Epson**'s ink jet cartridge patent portfolio against a major aftermarket supplier.
- Farmer v. Medo Industries (N.D. Cal. 2003). One of our partners was retained two months before trial by **Medo Industries** and **Pennzoil-Quaker State** in a two-patent patent infringement action related to various after-market automobile products. He obtained summary judgment of non-infringement on all claims asserted.
- Bancorp v. Hartford (E.D. Mo. 2002). We earned a jury verdict of \$118.3 million and a judgment of \$134 million for a **plaintiff financial products company** in a misappropriation of trade secrets and breach of confidentiality agreement case against a major insurance company.
- InTouch v. Amazon (N.D. Cal. 2002). We won a summary judgment for a **defendant entertainment company** that invalidated the independent claims of a notable on-line music patent asserted against over 200 on-line music companies. The court found non-infringement as to the remaining claims, ruled that the case was exceptional and awarded defendant its costs and fees.
- Tegic Communications v. Zi (N.D. Cal. 2002). We were retained by AOL subsidiary **Tegic Communications** less than three months before the trial date. During a three-week jury trial involving complex text input software technology, we defeated the attack on the validity of two Tegic patents and won a unanimous verdict of willful infringement and \$9 million in compensatory damages.
- Xircos v. 3Com/Palm (C.D. Cal. 2002). In patent infringement suits involving PC card technology, we obtained for **3Com/Palm** an approximately \$15 million settlement payment and cross-licenses.

- 3M v. Seiko Instruments (W.D. Tex. 2001). Representing **Seiko Instruments**, we obtained a summary judgment of non-infringement of 3M patents directed to fiber optic ferrule designs and manufacturing techniques.
- Cadence v. Audiodigital Imaging (C.D. Cal. 2000). We defeated Cadence's motion for a temporary restraining order against our client and successfully compelled arbitration in a dispute regarding patent rights to MPEG video chips. Cadence then abandoned and dismissed the suit.
- Avery Dennison v. ACCO (C.D. Cal. 1999). We represented **Avery Dennison** in a suit for infringement of several adhesive patents. After Avery Dennison moved simultaneously for a preliminary injunction and summary judgment, the defendant agreed to cease manufacture of all goods utilizing the accused materials.

## RECENT PHARMACEUTICAL/LIFE SCIENCE REPRESENTATIONS

- Coalition for Affordable Drugs VI LLC v. Celgene Corporation (USPTO PTAB 2015). We represented **Celgene Corporation** in connection with an IPR petition filed by Hedge fund manager Kyle Bass and patent troll Erich Spangenberg (and related funds and other entities) against Celgene Corporation's U.S. Pat. No. 5,635,517, which covers the active ingredient in Celgene's blockbuster cancer therapy, Revlimid®. The Patent Trial and Appeal Board denied institution of the IPR, adopting nearly all of Celgene's arguments against institution.
- Anavir Pharmaceuticals, Inc. et al. v. Par Pharmaceutical Inc. et al. (Fed. Circ. 2015). We secured a key victory at the Federal Circuit for our client **Anavir Pharmaceuticals, Inc.**, an innovator pharmaceutical company, in a "bet-the-company" Hatch-Waxman patent litigation relating to Anavir's flagship Nuedexta® product. Chief Judge Leonard P. Stark of the District of Delaware had previously issued a well-reasoned and thorough 63-page opinion in Anavir's favor. Our adversary appealed, and oral argument was held on Friday, August 7, 2015. The morning of Monday, August 10, 2015—less than one business day later—the Federal Circuit issued a Rule 36 affirmance of the District Court's decision, thereby ensuring patent protection for Nuedexta® until 2026.
- Merck Sharp & Dohme Corp. v. Xellia Pharms. ApS & Xellia Pharms. Inc. (D. Del. 2015). We represented **Merck** in a Hatch-Waxman patent litigation involving Xellia's proposed generic version of Merck's CANCIDAS product. After a two-day bench trial, the Court found that Xellia's proposed generic product infringes Merck's patent and issued an injunction prohibiting approval of Xellia's generic product until the expiration of Merck's patent
- The Dow Chemical Co. v. Nova Chemicals Corp. and Nova Chemicals Inc. (D. Del. 2010, Fed. Circ. 2012, D. Del 2014). We represented **The Dow Chemical Company** in a supplemental damages proceeding of a patent infringement suit against Nova Chemicals Corporation (Canada) and Nova Chemicals Inc. The district court awarded Dow more than \$30 million in supplemental damages following up on an earlier verdict that Nova infringed Dow's patents on a new type of plastic. The total damages awards between the two cases, including interest, exceeded \$107 million.

- Classen Immunotherapies, Inc. v. Shionogi, Inc. and Merz Pharmaceuticals, LLC (D. Md. 2014). We represented **Merz** in a patent infringement case involving Merz's Cuvposa drug product brought by Classen Immununotherapies. We successfully had the Complaint dismissed in the early stages of the case, avoiding costly litigation and potential damages for Merz.
- BSN Medical v. Mölnlycke Healthcare AB (German Federal Patent Court 2012). We represented **Mölnlycke Healthcare AB** ("MHC"), a global leader in the field of wound care products, in a German nullity action filed by BSN medical. The action concerned the German part of a European patent covering gel coated wound dressings. At the end of the trial, the German Federal Patent Court maintained MHC's patent in the form requested by MHC.
- Jazz Pharmaceuticals, Inc. v. Roxane Laboratories, Inc. (D.N.J. 2012). On September 14, 2012, we obtained a favorable claim-construction ruling for **Jazz Pharmaceuticals, Inc.** in a patent-infringement action against Roxane Laboratories, Inc. regarding Jazz's narcolepsy treatment Xyrem® in which the court ruled in Jazz's favor on virtually all disputed claim terms.
- Sanofi-Aventis Deutschland v. Genentech, Inc. and Biogen Idec, Inc. (N.D. Cal. 2011, Fed. Cir. 2012) We successfully defended **Genentech, Inc.** in high-stakes patent litigation brought by Sanofi-Aventis Deutschland in the Eastern District of Texas. Sanofi sought damages on Genentech's Rituxan® and Avastin® products, which earn billions of dollars in revenues each year. After we secured a writ of mandamus from the Federal Circuit transferring the case to the Northern District of California—in an opinion now routinely cited in transfer motions—the district court granted summary judgment of non-infringement of all asserted claims, which the Federal Circuit subsequently affirmed.
- Atos Medical AB v. Servona GmbH (District Court Munich 2011). In Germany, we obtained reversal of ex parte preliminary injunction preventing our client from selling medical products based on alleged infringement of competitor's patents.
- Apotex Inc. v. Forest Laboratories, Inc., Forest Laboratories Holdings, Ltd. and H. Lundbeck A/S (E.D. Mich.). We helped innovator pharmaceutical companies **Forest Laboratories, Inc.**, **Forest Laboratories Holdings, Ltd.**, and **H. Lundbeck A/S** protect their multi-billion-dollar blockbuster antidepressant LEXAPRO® in a lawsuit brought by generic drug company Apotex Inc. in the Eastern District of Michigan. Through early motion practice, we made the case unwinnable for Apotex, which voluntarily dismissed the case only six months after filing it.

- Affymax, Inc. v. Ortho-McNeil-Janssen Pharmaceuticals, Inc. (7<sup>th</sup> Cir. 2011). We represented **Ortho-McNeil**, a Johnson & Johnson subsidiary, in a unanimous victory that made an important new law narrowing “manifest disregard of the law” almost to the vanishing point as a ground for district court vacatur of arbitral awards. Some courts have treated this ground as a freestanding warrant to vacate arbitral awards for purported legal error even though it falls outside the statutory criteria in the Federal Arbitration Act. The Seventh Circuit flatly rejected such an approach, reversing the district court’s partial vacatur of the award and remanding for full confirmation of an award that favored Ortho in a dispute over inventorship and ownership of two patent families relating to new biological drugs for the production of red blood cells—products potentially worth billions of dollars in annual sales.
- Billups-Rothenberg Inc. v. ARUP Laboratories and Bio-Rad Laboratories Inc. (C.D. Cal. 2010, Fed. Cir. 2011). We achieved a complete defense victory in a biotech patent case relating to genetic testing for an iron disorder. We obtained a ruling that one patent was invalid for failing the written description requirement of the patent laws, and another patent was invalid over prior art. This successful judgment was affirmed in a precedential opinion in the Court of Appeals for the Federal Circuit on April 29, 2011.
- Infosint S.A. v. H. Lundbeck A/S, Lundbeck, Inc., Forest Laboratories, Inc., and Forest Pharmaceuticals, Inc. (S.D.N.Y. 2010 and Fed. Cir. 2011). We successfully represented **Forest Laboratories** and **H. Lundbeck** as defendants in a patent infringement action brought by Infosint in the Southern District of New York regarding the manufacture of their antidepressant drugs CELEXA® and LEXAPRO®, which had over \$2 billion in annual U.S. sales. In June 2010, the S.D.N.Y. Judge Kaplan presiding, ruled that no reasonable jury could fail to find the asserted patent invalid due to obviousness. The Federal Circuit subsequently affirmed, and did so decisively, issuing a Rule 36 affirmation three days after the appellate oral argument in March 2011. The district court JMOL and Federal Circuit affirmation eliminated a claim for damages and ongoing royalties of roughly \$600 million, and removed the possibility of any type of injunction being entered with respect to CELEXA® or LEXAPRO®.
- Medicis Pharmaceutical Corp. v. Nycomed U.S. Inc. et al. (S.D.N.Y. 2011). We represented **Medicis Pharmaceutical** in series of Hatch Waxman actions related to Loprox® shampoo. Obtained favorable settlement.
- Tyco Healthcare Group LP, et al. v. Applied Medical Resources Corp. (E.D. Tex. 2010). We successfully represented **Tyco Healthcare Group LP** in a patent infringement jury trial against Applied Medical Resources Corp. to enforce Tyco patents against certain of Applied’s surgical trocar products. The jury returned a verdict of infringement by Applied and awarded Tyco \$4,810,389 in damages, out of Applied’s alleged total profit of \$6,734,544 on the infringing sales.
- Mölnlycke Health Care AB v. Smith & Nephew GmbH and Smith & Nephew Medical Ltd. (District Court Düsseldorf 2010). We are representing **Mölnlycke Health Care**, one of the world’s leading providers of single-use surgical and wound care products and services to the health care sector. Defendants are its competitors (i.e. the Smith & Nephew group), which is another leading player in this field. Accused devices are certain

wound care products. This new generation of wound care products with silicone are significant for the leading players in this market. We achieved a full victory for the client in the first instance; however, an appeal is pending as well as a nullity action against the patent in suit.

- Medicis Pharmaceutical Corp. v. Taro Pharmaceuticals U.S.A., Inc. et al. (S.D.N.Y. 2010). We represented **Medicis Pharmaceutical** in series of Hatch Waxman actions related to the topical steroid Vanos®. Obtained favorable settlement.
- LifeCycle Pharma A/S v. Impax Laboratories, Inc. (D. Del. 2010). We represented **LifeCycle Pharma** and **Shionogi Pharma** in Hatch Waxman action related to the cholesterol lowering drug Fenoglide®. Obtained favorable settlement.
- Connetics v. Pentech Pharmaceuticals (N.D. Ill. 2009). We represented plaintiff **Connetics** in Paragraph IV patent infringement litigation involving Luxiq® betamethasone valerate foam. Settled on favorable terms.
- Connetics v. Pentech Pharmaceuticals (N.D. Ill. 2009). We represented **Connetics** in Paragraph IV patent infringement litigation involving Olux® clobetasol propionate foam. Settled on favorable terms.
- PDL Biopharma, Inc. and EKR Therapeutics, Inc. v. Sun Pharmaceutical Industries Ltd. (D.N.J 2009). We obtained summary judgment in favor of our client **EKR Therapeutics, Inc.**, in a Hatch Waxman dispute involving infringement of EKR Therapeutics' patent covering the manufacturing formula for its brand name drug Cardene® I.V. Cardene® I.V. is one of the leading therapies for the treatment of acute hypertension in emergency settings. Generating sales of about \$360 million per year, Cardene® I.V. came under attack from the generic drug company Sun Pharmaceuticals Industries, Ltd., which was threatening to launch a generic copy of Cardene® I.V. prior to expiration of the patent-in-suit. Believing that it would prevail on a theory that it characterized as "unavoidable," Sun Pharmaceuticals filed an early motion for summary judgment of noninfringement in July 2008. The firm's decision to oppose that motion by having EKR Therapeutics file its own cross-motion for summary judgment paid off. On March 31, 2009, the court issued an order and opinion finding that Sun Pharmaceuticals' generic copy of Cardene® I.V. infringes the patent-in-suit, both literally and under the doctrine of equivalents.
- Bio-Rad v. Eppendorf (N.D. Cal., E.D. Tex. 2008). We represented **Bio-Rad Laboratories, Inc.** as lead counsel in multiple patent infringement suits regarding microplate, electroporation, and multiporation technology. Multiple cases were settled on favorable terms for Bio-Rad.
- Wade v. Nobel Biocare USA (JAMS 2006). We represented an **individual inventor** in an arbitration involving a snap-fit device used for dental implants. Immediately following the claim construction hearing, Nobel initiated discussions that resulted in a favorable settlement.

- Regents of the University of California v. Monsanto (N.D. Cal. 2006). We defended **Monsanto** when the plaintiff patentee alleged that Monsanto's recombinant bovine growth hormone product infringed its patent. The plaintiff sought \$1.8 billion in treble damages and a permanent injunction. After we won summary judgment eliminating one of the two accused products, the case settled favorably the day before trial.
- Szoka v. ALZA (N.D. Cal. 2006). We defended **ALZA** in a patent inventorship dispute in which two individuals alleged that they were the inventors of an ALZA patent covering liposomes used for the targeted delivery of pharmaceuticals. After a one-week bench trial, the court rejected the claim of inventorship and entered judgment for ALZA.
- Connetics v. Agis Industries (D.N.J. 2005). We represented **Connetics** in Paragraph IV patent infringement litigation involving Olux® clobetasol propionate foam. The case settled following a favorable claim construction and after the defendant's motion for summary judgment of no infringement was denied.
- Reliant Pharmaceuticals v. Abbott Laboratories (D. Del. 2004). Representing **Reliant** in a patent litigation related to competing branded fenofibrate products, we sought a declaratory judgment of non-infringement, invalidity and unenforceability due to inequitable conduct. The case then settled on favorable terms.
- Genentech v. Columbia University (N.D. Cal., D. Mass. 2004). When Columbia demanded that **Genentech** license a "new" patent on co-transformation--a widely used recombinant DNA technique for producing protein in a host cell--we sued for obviousness-type double patenting. With our summary judgment motion looming, the university filed a broad covenant not to sue Genentech for past, current or future infringement of the "new" patent or any reissued patent with the same or similar claims.
- Mentor H/S v. MDA and Lysonix (C.D. Cal. 1999). We prevailed in a jury trial regarding a pioneering patent on the ultrasonic liposuction method, winning a multi-million dollar verdict and a finding of willful infringement later affirmed by the Federal Circuit.

## **SUPREME COURT RECENT REPRESENTATIONS**

- Stanford University v. Roche Molecular Systems and Roche Diagnostics (Supreme Court 2011). We represented **Roche** in a patent infringement case brought by Stanford University for infringement of Stanford HIV patents relating to viral load and AIDS therapy decisions. Roche initially asserted that it owned the patents because the patents arose from a collaboration between Stanford and Roche's predecessor, Cetus Corporation. The Court denied this defense. After extensive litigation and claim construction, Roche moved for—and the Court granted—summary judgment that the Stanford patents asserted against Roche were invalid because they were obvious in light of the prior art. The lead prior art reference was a joint publication between Stanford and Cetus in the Journal of Infectious Diseases. On appeal, the Federal Circuit agreed with our defense that Roche was a co-owner of the patents in suit due to the collaboration. With the support of the Solicitor General's office, Stanford petitioned

the United States Supreme Court to reverse the Federal Circuit and allow Stanford to void its prior contracts based on the existence of federal funding for research at Stanford. The Supreme Court agreed with Roche and ruled 7-2 that Stanford must abide by its contracts and that the Bayh Dole Act—the statute governing federal research funding—does not give automatic ownership of patents to universities.

- KSR, International v. Teleflex (Supreme Court 2007). Representing **Time Warner, IAC/Interactive** and **Viacom**, we filed an amicus brief. The Supreme Court adopted an argument we made that many high technology inventions are not published, thus making that strict requirement of documentary evidence unwarranted.
- EBay v. MercExchange (Supreme Court 2006). Representing **Time Warner, Amazon, Chevron, Cisco, Google, Shell, Visa, IAC/Interactive, Infineon, and Xerox**, we filed an amicus brief arguing against automatic injunctions because with respect to high technology products, a patent may relate only to a small and relatively insignificant component. Justice Kennedy's concurring opinion adopted our argument as a basis for opposing the issuance of automatic injunction.

## **International Trade Commission Proceedings**

### **OUR MOST RECENT REPRESENTATIONS:**

- Organik Kimya v. ITC 15-1774 (2017): We obtained an important victory in the Federal Circuit for **Dow Chemical**, upholding the International Trade Commission's entrance of judgment against Organik Kimya and an unprecedented 25-year exclusion order and \$2 million sanction as a result of our opponent's extensive discovery abuse.
- Certain Microfluidic Devices, Inv. No. 337-TA-1068 (2017): We represent **Bio-Rad** in a patent infringement action against 10X Genomics.
- Certain Mobile Electronic Devices and Radio Frequency and Processing Components, Inv. No. 337-TA-1065 (2017): We represent **Qualcomm** in a patent infringement action against Apple.
- Certain Magnetic Tape Cartridges and Components Thereof, Inv. No. 337-TA-1058 (2017): We represent **Sony** in a patent infringement action against Fujifilm.
- Certain Robotic Vacuum Cleaning Devices, Inv. No. 337-TA-1057 (2017): We represent **bObSweep** in a patent infringement action filed by iRobot.
- Certain Graphics Systems, Inv. No. 337-1044 (2017): We represent third party **Samsung** in a patent infringement action between ATI and multiple electronics companies. The target date is set for August 2018.
- Certain Electronic Devices, Inv. Nos. 337-TA-1038/1039 (2017): We represented third party **Samsung** in patent infringement actions between Nokia and Apple. The cases settled.

- Certain Magnetic Tape Cartridges and Components Thereof, Inv. No. 337-TA-1036 (2017): We represent **Sony** in a patent infringement action against Fujifilm.
- Certain Flash Memory Devices, Inv. No. 337-TA-1034 (2017): We represent third party **Samsung** in a patent infringement action between Memory Technologies LLC and SanDisk and Western Digital. The target date is set for May 2018.
- Certain Memory Modules and Components Thereof, Inv. No. 337-TA-1023 (2016): We represent third party **Samsung** in a patent infringement action between Netlist and SK Hynix. The target date is set for February 2018.
- Certain Carbon and Alloy Steel Products, Inv. No. 337-TA-1002 (2016): We represent complainant **U.S. Steel** against a host of Chinese steel manufacturers and importers in an action based on price-fixing, false designation of origin, and trade secret misappropriation. The case is set for trial in September 2017.
- Certain Table Saws Incorporating Active Injury Mitigation Technology and Components Thereof, Inv. No. 337-TA-965 (2016): We represent complainant **SawStop, LLC** in a patent infringement action against Robert Bosch GmbH of Germany and its subsidiary Robert Bosch Tool Corporation. An Initial Determination found a violation of Section 337 based on infringement of two asserted SawStop patents. On November 10, 2016, the Commission determined not to review an Initial Determination finding a violation of Section 337 of the Tariff Act of 1930, as amended. We successfully obtained a limited exclusion order on behalf of SawStop.
- Certain Computing or Graphics Systems, Inv. No. 337-TA-984 (2016): We represented third party **Samsung** in a patent infringement action between Advanced Silicon Technologies and various automobile manufacturers. The case settled.
- Certain Woven Textile Fabrics and Products Containing Same, Inv. No. 337-TA-976 (2015): We represent **AAVN** in a patent infringement action against 15 respondents. Most respondents have settled and/or taken a consent order. Trial is set for August 2016.
- Certain Radiotherapy Systems and Treatment Planning Software, and Components Thereof, Inv. No. 337-TA-968 (2015): We represent **Varian** in a patent infringement action against Elekta and a variety of subsidiaries. The trial is set for June 2016.
- Certain Standard Compliant Electronic Devices, Including Communication Devices and Tablet Computers, Inv. No. 337-TA-953 (2015): We represent third party **Samsung** in a patent infringement action between Apple and Ericsson.
- Certain Electronic Devices, Including Wireless Communication Devices, Computers, Tablet Computers, Digital Media Players, and Cameras, Inv. No. 337-TA-952 (2015): We represent third party **Samsung** in a patent infringement action between Apple and Ericsson.

- Certain Light-Emitting Diode Products and Components Thereof, Inv. No. 337-TA-947 (2015): We were hired by **Cree** to bring patent infringement and false advertising claims against Feit Electric Company, Inc. and Unity Opto Technology, Ltd. The case went to trial in October 2015. We were able to obtain monetary and non-monetary sanctions against Respondent Feit for its discovery misconduct.
- Certain Ink Cartridges and Components Thereof, Inv. No. 337-TA-946 (2015): We are representing **Seiko Epson** as complainant against nearly 20 respondents for patent infringement. We obtained an initial determination of violation, which was affirmed by the ITC.
- Certain Integrated Circuits and Products Containing the Same, Inv. No. 337-TA-920 (2014): We defended **MediaTek** and **Sony** against patent infringement allegations brought by Freescale Semiconductor, Inc. The case settled favorably only a few months after institution.
- Certain Set-Top Boxes, Gateways, Bridges, and Adapters and Components Thereof, Inv. No. 337-TA-915 (2014): We defended **DIRECTV** against patent infringement allegations brought by ViXS Systems, Inc. of Canada. We obtained a walk-away settlement for DIRECTV during early discovery.
- Certain Navigation Products, Including GPS Devices, Navigation and Display Systems, Radar Systems, Navigational Aids, Mapping Systems and Related Software, Inv. No. 337-TA-900 (2014): We represented **Furuno** as complainant against Garmin, Navico and Raymarine for patent infringement. We settled on very favorable terms against all three respondents prior to the hearing.
- Certain Optical Disk Drives, Components Thereof, and Products Containing Same, Inv. No. 337-TA-897 (2014): We defended **MediaTek** in a Section 337 investigation brought by Optical Devices, LLC alleging patent infringement. The case settled favorably.
- Certain Consumer Electronics with Display and Processing Capabilities, Inv. No. 337-TA-884 (2013): We defended **Toshiba** against allegations of patent infringement from non-practicing entity Graphics Properties Holdings, Inc. (formerly Silicon Graphics). We obtained summary determination of invalidity on one patent. The case was tried as to the remaining patents in April 2014 and settled after trial.
- Certain Opaque Polymers, Inv. No. 337-TA-883 (2013): We successfully represented **The Dow Chemical Company** and **Rohm and Haas** as complainants against Turkish producer Organik Kimya for patent infringement and trade secret misappropriation on hollow-sphere polymers used in paints. The ALJ hearing the case found the respondent in default for document spoliation and ordered it to pay millions of dollars in Dow's legal fees.

- Certain Media Devices, Including Televisions, Blu-Ray Disc Players, Home Theater Systems, Tablets and Mobile Phones, Components Thereof and Associated Software, Inv. No. 337-TA-882 (2013): We defended **Toshiba** as respondent against allegations of patent infringement from non-practicing entity Black Hills Media. The case went to trial in February 2014, and we obtained a complete win for Toshiba with a finding of no violation.
- Certain Microelectromechanical Systems, Inv. No. 337-TA-876 (2013): We represented complainant **ST Microelectronics** against InvenSense for patent infringement of gyroscopes and accelerometers contained in consumer electronics products. After a successful Markman ruling and several important pre-trial rulings the case settled favorably for ST Microelectronics on the second day of trial.
- Certain Wireless Electronic Devices, Inv. No. 337-TA-853 (2012): We represented **Barnes & Noble** as respondent against allegations of patent infringement from non-practicing entity TPL. The case was terminated with a finding of no violation.
- Certain Radio Frequency Integrated Circuits and Devices, Inv. No. 337-TA-848 (2012): We represented respondents **RF Micro Devices**, **Motorola Mobility** and **HTC** in responded to a Section 337 investigation relating to five semiconductor patents asserted by Peregrine Semiconductor. Shortly after the ITC Staff adopted our claim construction positions on the asserted patents, Peregrine filed a motion to voluntarily withdraw its complaint, leading to termination of the ITC proceedings.
- Certain Audiovisual Components and Products Containing the Same, Inv. No. 337-TA-837 (2014): We successfully defended respondents **MediaTek**, **Ralink** and **Funai** in an investigation brought by LSI and Agere alleging infringement of, among other patents, two patents purportedly relating to 802.11 wi-fi technology: U.S. Patent No. 6,452,958, which Complainants argued disclosed the “complementary code keying” modulation system used in the 802.11b physical layer, and U.S. Patent No. 6,707,867, which Complaints argued disclosed the timestamp-based synchronization protocol used in the 802.11 MAC layer. After a trial in April 2013, the ALJ issued an initial determination finding that, as a matter of claim construction, neither patent read on the 802.11 standard. Accordingly, the ALJ found no infringement of any the 38 asserted claims from these patents. The Commission terminated the investigation with a finding of no violation.
- Certain Integrated Circuits, Chipsets, and Products Containing Same Including Televisions, Inv. No. 337-TA-822 (2012): We represented **MediaTek** in responding to serial-patent infringement complaints filed by Freescale. The ITC dismissed Freescale’s complaint based on res judicata.
- Certain Projectors with Controlled-Angle Optical Retarders, Components Thereof, and Products Containing Same, Inv. No. 337-TA-815 (2012). We represented **Sony** in an ITC Investigation regarding ultra-high resolution LCD projectors, including those used in movie theaters throughout the U.S. Two weeks before trial and for nothing in return, Complainants requested that the investigation be terminated in its entirety, securing a total defense victory on behalf of Sony.

- Certain Automotive GPS Navigation Systems, Inv. No. 337-TA-814 (2012): We represented **Ford, Nissan, Clarion, e-Ride and Mitsubishi Electric** in wide-ranging patent infringement litigation brought by Swiss NPE Beacon Navigation. The complaint was withdrawn in the middle of discovery and the section 337 investigation was terminated.
- Certain GPS Navigation Products, Components Thereof, and Related Software, Inv. No. 337-TA-810 (2011): We represented **Furuno Electric Co., Ltd.** and **Furuno U.S.A., Inc.** against Honeywell International, Inc. in a 337 action where Furuno was accused of importing GPS products alleged to infringe four patents. The case settled favorably.
- Certain Portable Electronic Devices, Inv. No. 337-TA-797 (2012): We represented **HTC** in an ITC investigation initiated by Apple involving five patents covering multi-finger gestures, sensor-based rotation of user interface, and touch panel sensor design. One of the patents was dismissed by Apple prior to trial, following Markman hearing. Shortly before the initial determination was due, Apple settled with HTC, resulting in a 10-year cross license with HTC reporting no material financial impact on its business. This was the first major settlement involving Apple's claims against Android-based smartphone and tablet manufacturers.
- Certain Electronic Digital Media Devices and Components Thereof, Investigation, Inv. No. 337-TA-796 (2013). We represented **Samsung** against Apple in the U.S. International Trade Commission in an investigation based on 7 Apple patents. After a trial in June 2012, the Commission issued its Final Determination on August 9, 2013, finding violations of Section 337 based on old designs but permitting importation of newer Samsung products that use designs adjudicated by the Commission to be non-infringing.
- Certain Electronic Devices, Including Wireless Communication Devices, Portable Music and Data Processing Devices, and Tablet Computers, Inv. No. 337-TA-794 (2013): We represented **Samsung** against Apple in an International Trade Commission Investigation involving a Samsung patent, U.S. Patent No. 7,706,348, which had been declared as potentially essential to the ETSI UMTS (3G) standard. The ITC found that Apple violated Section 337 through the importation and/or sale of UMTS-compliant products that infringe that patent. After a trial and extensive rounds of briefing on technical and public interest issues, the Commission issued an exclusion and cease and desist order against Apple, that will prevent the importation of the iPhone 3G, 3GS (UMTS versions), 4 (UMTS versions), iPad 3G, and iPad 2 3G (UMTS versions) into the United States after a 60 day Presidential Review Period. In finding a violation, the ITC rejected all of Apple's defenses including its assertion that Samsung had allegedly violated certain FRAND obligations with respect to its assertion and licensing of its declared essential patents. Although Apple has been named a respondent in the ITC a number of times, this is first ITC exclusion order to be issued against Apple, and the first exclusion order obtained by Samsung at the ITC.

- Certain Hydroxyprogesterone Caproate and Products Containing Same (2012): KV Pharmaceutical filed a complaint with the ITC alleging that **Wedgewood Pharmacy** and others were unlawfully importing and selling compounded Hydroxyprogesterone Caproate in the United States, allegedly in violation of KV's exclusive rights to market this product for certain indicated uses under FDA's orphan drug program. We successfully argued that KV had failed to state a cognizable claim under Section 337 and, in particular, that the FDA, rather than the ITC, has jurisdiction to enforce the Food, Drug and Cosmetic Act.
- Certain Handheld Electronic Computing Devices, Inv. No. 337-TA-769 (2011). We represented **Barnes & Noble** in defending its popular Nook e-readers from claims of patent infringement by Microsoft. The case was tried in February 2012 and settled favorably prior to the judge's final determination.
- Certain Digital Television and Components Thereof, and Certain Electronic Devices Having a Blu-Ray Disc Player and Components Thereof, Inv. No. 337-TA-764/765 (2011): We represented **Sony** in 337 actions filed against LG Electronics. The cases were settled favorably.
- Certain Semiconductor Chips and Products Containing the Same, Inv. No. 337-TA-753 (ITC): We served as lead counsel for a large group of chip suppliers (**MediaTek, Broadcom, nVidia, Freescale, and STMicroelectronics**) and certain of their customers (including **Cisco, Motorola, and Oppo Digital**) in an ITC investigation initiated by Rambus. The ITC action involves six patents. Three of the patents are owned by Rambus and concerning methods of writing data to a DRAM. The other three patents are owned by MIT, exclusively licensed by Rambus. Rambus is asserting the MIT patents infringe the use of a certain chip-to-chip SerDes (serialization-deserialization) equalization technique in a wide range of standardized interfaces including PCIe, SATA, SAS, and Displayport. We tried the case in October 2011 and prevailed on all patents.
- Certain Mobile Devices and Related Software, Inv. No. 337-TA-750 (2011): We represented **Motorola Mobility, Inc.** against Apple Inc., in an action brought by Apple alleging infringement of three patents. After a two week hearing, ALJ Essex issued an initial determination finding no violation of any of the asserted patents for various reasons. The Commission affirmed the initial determination and found no violation, terminating the investigation.
- Certain Mobile Devices, Associated Software, and Components Thereof, Inv. No. 337-TA-744 (2010): We are currently representing **Motorola, Inc.** in several patent actions brought by Microsoft Corp. According to Microsoft, the asserted patents allegedly describe features that "are essential to the smartphone user experience, including synchronizing email, calendars and contacts, scheduling meetings, and notifying applications of changes in signal strength and battery power." In the ITC case, filed on October 1, 2010, Microsoft seeks an Exclusion Order barring Motorola's importation of Android smartphone devices, prohibiting further sales of such products that have already been imported, and halting the marketing, advertising, demonstration and warehousing of inventory and use of such imported products in the United States. The

ITC case was tried in August 2011; a final determination is pending. In the District Court actions in the Western District of Washington (also filed on October 1, 2010), Microsoft seeks damages for Motorola's alleged infringement of Microsoft's patents.

- Certain Digital Set Top Boxes and Components Thereof, Inv. No. 337-TA-712 (2011): On behalf of **Cablevision**, we successfully obtained a finding of no violation with respect to all patents asserted by Verizon against Cablevision in the ITC. Verizon originally filed its complaint with the ITC in March 2010, asserting one claim from each of five patents against digital set-top boxes ("STBs") that Cablevision acquires from third-party vendors, as well as software that is downloaded by customers in connection with their use of certain services on those STBs. After a 7-day hearing, the Administrative Law Judge issued an Initial Determination finding no violation with respect to four of the five asserted patents, but finding a violation of the fifth asserted patent. Although the Commission initially determined not to review the ALJ's determination, Cablevision persuaded the Commission to reconsider that decision. On reconsideration, the Commission found no violation by Cablevision and terminated the investigation, thereby giving Cablevision a complete victory.
- Certain Personal Data and Mobile Communications Devices and Related Software (2010-2011): We represented **HTC Corp., HTC America, Inc. and Exedeia, Inc.**, in patent litigation brought by Apple. HTC Corp., HTC America, Inc., and Exedeia manufacture and supply mobile communication devices and components to customers in the United States. The case was tried in April 2011, and the Commission found no violation on all patents for which Quinn Emanuel was responsible. The dispute was later settled while on appeal.
- Certain Ink Cartridges and Components Thereof, Inv. No. 337-TA-565 (enforcement) (2011): We represent Complainants **Epson Portland Inc., Epson America, Inc.** and **Seiko Epson Corporation** against Ninestar Technology Co., Ltd. and its U.S. distributor Ninestar Technology Company, Ltd. in the ITC. In 2007, during the Violation Phase of the ITC Investigation, Epson showed widespread infringement of its patents resulting in the ITC's issuance of a general exclusion order, a limited exclusion order and cease-and-desist orders stopping the importation and sale of infringing ink cartridges by the Ninestar respondents and others. The investigation involved 31 claims from 11 patents against 24 respondents and more than one thousand infringing products. The Federal Circuit affirmed the ITC's orders in a *per curiam* decision. In 2008, Epson brought an Enforcement action against Ninestar and others for continued infringing imports in violation of the ITC's remedial orders. After a hearing in the ITC, the ITC imposed penalties of over \$20 million. On December 13, 2010, the Ninestar respondents sought an advisory opinion that (1) certain of their products did not violate the remedial orders and (2) the remedial orders should be modified. Epson responded by requesting that the remedial orders be modified to exclude from entry components of infringing cartridges. The ITC has consolidated the proceedings. The case was tried November 2011.
- Certain Ink Cartridges, Inv. No. 337-TA-565 (ITC 2007 and 2009): On behalf of **Seiko Epson**, we brought one of the largest patent infringement cases ever filed with the ITC, asserting 11 patents and 31 claims against more than 1,000 different cartridge models

sold by 25 manufacturers, importers and distributors of aftermarket ink cartridges. After a 7-day hearing, we prevailed on every asserted patent against every accused product that was adjudicated and every respondent that had not entered into a consent order. The ITC then prohibited all companies, whether or not they were parties, from importing and selling infringing cartridges in the U.S. After a three-day trial in January 2009, an Administrative Law Judge (“ALJ”) at the ITC issued an Initial Determination ruling that several foreign respondents and their U.S. subsidiaries violated certain ITC orders that bar imports and sales of infringing inkjet cartridges. The ITC has affirmed the ALJ’s findings that the ITC orders were violated and has imposed penalties of \$11.1 million against one group of related respondents, \$9.7 million against another group and \$700,000 against another group. The penalties are among the largest penalties ever imposed in an ITC enforcement proceeding.

#### **OTHER REPRESENTATIONS INVOLVING OUR LAWYERS:**

- Certain Electronic Devices, Including Mobile Phones, Mobile Tablets, Portable Music Players, and Computers, Inv. No. 337-TA-701/704/771 (2011): Some of our partners represented a **global telecommunications company** in high-stakes patent litigation against Apple, which spanned three separate ITC investigations and resulted in an extraordinarily large settlement in the client’s favor.
- Certain Muzzle-Loading Firearms and Components Thereof, Inv. No. 337-TA-777 (2011): Some of our partners defended a **Spanish manufacturer of black powder rifles** in a patent suit brought by Smith & Wesson. The case is in discovery.
- Certain Automated Media Library Device, Inv. No. 337-TA-746 (2011): Some of our partners represented one of the **world’s largest computer makers** in litigation relating to media libraries. The case was tried in September 2011 and settled before the judge issued his final determination.
- Certain Components for Installation of Marine Autopilots with GPS or IMU, Inv. No. 337-TA-738 (2011): Some of our partners represented a **marine navigation company** in patent litigation involving autopilot systems. The case settled favorably before trial.
- Certain Flash Memory Chips, Inv. No. 337-TA-735 (2011): Some of our partners represented a **global telecommunications company** in a patent dispute regarding NAND and NOR flash memory.
- Certain Electronic Imaging Devices, Inv. No. 337-TA-726 (2011): Some of our partners represented a **global telecommunications company** in a camera-related patent dispute brought by Flashpoint. The case was settled prior to trial.
- Certain Electronic Paper Towel Dispensing Devices and Components Thereof, Inv. No. 337-TA-718 (2011): Some of our partners represented a **global paper products company** in a patent dispute against numerous manufacturers and importers of infringing paper towel dispensers. After a finding of infringement on summary determination, the client obtained a general exclusion order prohibiting importation of all infringing devices from any source.

- Certain Display Devices, Including Digital Televisions and Monitors, Inv. No. 337-TA-713 (2010): We represented a **global electronics manufacturer** against multiple respondents for infringement of patents relating to display devices. The cases settled favorably.
- Certain Mobile Telephones and Wireless Communications Devices Featuring Digital Cameras, Inv. No. 337-TA-703 (2010): Some of our partners represented **the most well-known photography company in the world** against Apple and RIM.
- Certain DC-DC Controllers and Products Containing Same, Inv. No. 337-TA-698 (2010): Some of our partners represented a **Taiwanese semiconductor company** in seeking relief for patent infringement and trade secret misappropriation. Respondents filed a consent order agreeing not to import accused products on the eve of trial.
- Certain Welding Bulk Welding Wire Containers and Components Thereof and Welding Wire, Inv. No. 337-TA-686 (2010): Some of our partners represented a **European welding wire supplier** against allegations of infringement. The case was tried in 2010, and the Commission found no infringement and terminated the investigation.
- Certain Non-Shellfish Derived Glucosamine, Inv. No. 337-TA-668 (2010): Some of our partners represented a **Chinese health products company** accused of patent infringement by Cargill. The investigation was settled favorably very early in the litigation.
- Certain Electronic Devices, Including Handheld Wireless Communications Devices, Inv. No. 337-TA-673 (2009): Some of our partners represented a **global telecommunications company** in an investigation brought by licensing entity Saxon Innovations. The case settled favorably early during discovery.
- Certain Unified Communications Systems, Products Used with such Systems, and Components Thereof, Inv. No. 337-TA-598 (2008): One of our partners successful defended a respondent in an ITC action against Microsoft alleging infringement of 4 patents involving unified communication systems. After trial, the Commission found none of the patents infringed and one of the patents invalid.
- Certain Catheters, Consoles, and Other Apparatus for Cryosurgery, Inv. No. 337-TA-642 (2008): Some of our partners represented a **small, Canadian medical products company** in a bet-the-company litigation brought by its market rival CryoCor, Inc., which settled favorably prior to trial. Immediately thereafter, our client was acquired by Medtronic.
- Certain Variable Speed Wind Turbines, Inv. No. 337-TA-641 (2008): Some of our partners represented a **Spanish alternative energy utility** in third party practice. The Commission terminated the investigation after finding no violation.

- Certain Short-Wavelength Light Emitting Diodes, Laser Diodes and Products Containing Same, Inv. No. 337-TA-640 (2008): Some of our partners represented a **global telecommunications company** in responding to allegations that certain LEDs infringe a patent owned by a former university professor who seeks exclusion of products containing those LEDs from the United States. The investigation was settled favorably.
- Certain R-134a Coolant (otherwise known as 1,1,1,2-tetrafluoroethane), Inv. No. 337-TA-623 (2008): Our of our partners represented a **global chemical company** in an investigation brought against SinoChem for infringement of a patented process of producing an ozone-friendly refrigerant. The investigation was settled favorably on appeal.
- Certain Hard Disk Drives, Inv. No. 337-TA-616 (2008): Some of our partners represented a **California-based hard disk drive manufacturer** in an investigation brought against hard drives and computers that contain them. Complainant withdrew its case prior to trial.
- Certain 3G Mobile Handsets, Inv. No. 337-TA-613 (2008): Some of our partners represented a **global telecommunications company** in an investigation brought by Interdigital Communications LLC. The ITC found non-infringement of any of InterDigital's patents and terminated the investigation.
- Certain Nitrile Rubber Gloves, Inv. No. 337-TA-612 (2008): Following trial, some of our partners obtained a finding of no violation on behalf of a **global medical equipment supplier** and its affiliates in an investigation regarding medical examination gloves. The victory was confirmed by the Federal Circuit.
- Certain Magnifying Loupe Products, Inv. No. 337-TA-611 (2008): Some of our partners represented a respondent in this investigation. The case settled favorably.
- Certain Digital Cameras, Inv. No. 337-TA-593 (2007): Some of our partners represented complainant in this investigation. The case was settled favorably.
- Certain Stringed Instruments, Inv. No. 337-TA-586 (2007): Some of our partners represented one of the respondents in this investigation. The case settled favorably.
- Certain Mobile Telephone Handsets, Inv. No. 337-TA-578 (2007): In one of the largest global intellectual property wars ever, we represented a **global telecommunications company** in multiple cases in the United States, including an I.T.C. action, and coordinated cases in the U.K., France, Italy, Germany, Finland, Holland, and China. The Administrative Law Judge denied the plaintiff's request to enjoin our client from importing its handsets into the United States. It also held that none of the three asserted patents were infringed and that one was invalid under *KSR Int'l v. Teleflex*. This provided a complete defense victory—allowing our client to continue importing hundreds of millions of handsets into the United States—and set the stage for a global settlement on the eve of trial in another case in Delaware.

- Certain NAND and NOR Flash Memory Products, Inv. No. 337-TA-560 (2006): Some of our partners represented a **global telecommunications company** in third party discovery. The investigation was terminated with a finding of no violation.
- Certain NAND Flash Memory Products, Inv. No. 337-TA-553 (2006): Some of our partners represented a **global flash memory company** against Toshiba. The case settled favorably.
- Certain Automotive Grilles, Inv. No. 337-TA-540 (2005): Some of our partners defended the principal importer of aftermarket automotive body parts from Taiwan in an investigation brought by one of the big three US automakers. Early in the investigation, we found a public disclosure that rendered the asserted patent invalid and the case was withdrawn.
- Certain Automotive Fuel Caps, Inv. No. 337-TA-532 (2005): Some of our partners represented the respondent in this investigation. The case was terminated when the complainant withdrew the complaint.
- Certain Electric Robots and Component Parts Thereof, Inv. No. 337-TA-530 (2005): Some of our partners represented a **German paint robot manufacturer** who was sued by its Japanese rival. Following trial, the case was terminated with a finding of no infringement and invalidity.
- Certain NAND Flash Memory Circuits, Inv. No. 337-TA-526 (2005): Some of our partners represented a third party in an investigation relating to flash memory.
- Certain Point of Sale Terminals, Inv. No. 337-TA-524 (2004): Some of our partners defended an **Irish manufacturer of credit and debit card processing machines** against a claim filed by a non-practicing entity. In November 2004, we won a final determination that the ITC lacked jurisdiction over the client or its products.
- Certain Injectable Implant Compositions, Inv. No. 337-TA-515 (2004): Some of our partners represented multiple respondents in an investigation regarding injectable implants. The case settled favorably.
- Certain Encapsulated Integrated Circuit Devices, Inv. No. 337-TA-501 (2004): Some of our partners represented a **global semiconductor company** in a case brought by a competitor. The case was terminated with a finding of no violation.
- Certain Insect Traps, Inv. No. 337-TA-498 (2004): Some of our partners represented the lead respondent in an investigation involving propane-based insect traps. In a novel move, we succeeded in terminating the investigation as to one of the patents and certain of the accused products during the discovery period without a hearing and without any findings of a Section 337 violation. We tried the remaining case in late May 2004 and won a final determination of non-infringement.

- Certain Universal Transmitters for Garage Door Openers, Inv. No. 337-TA-497 (2004): Some of our partners represented one of the **largest garage door manufacturers** in an investigation against its competitors under the Digital Millennium Copyright Act
- Certain Zero-Mercury-Added Alkaline Batteries, Inv. No. 337-TA-493 (2003): Some of our partners represented a **global battery company** in an investigation against multiple respondents.
- Certain Machine Vision Systems, Inv. No. 337-TA-484 (2003): Some of our partners represented a respondent in an investigation for patent infringement. The case settled favorably.
- Certain Electronic Educational Devices, Inv. No. 337-TA-475 (2003): Some of our partners represented a respondent in an investigation for patent infringement. The case settled favorably.
- Certain Two-Handle Centerset Faucets, Inv. No. 337-TA-422 (2000): Some of our partners represented one of **America's largest plumbing products companies** and obtained a rare “general exclusion order” instructing U.S. Customs to seize or deny entry to any imported infringing faucets. The victory was highlighted by the ITC Bar Association as the most significant ITC patent litigation of the year and resulted in detentions and seizures by U.S. Customs of many competitive products.

## **Copyright Litigation**

### **RECENT COPYRIGHT REPRESENTATIONS**

- J&J Sports Productions, Inc. v. Javier Teran Mojica and Evelia Mojica Carpio (N.D. Cal. 2014). We represented *pro bono* **owners of a small restaurant in the Monterrey Peninsula** against claims of pirating a pay-per-view boxing match and obtained a dismissal due to Plaintiff's failure to prosecute.
- Bouchat v. NFL Properties LLC (D. Md. 2013). We have successfully represented the **NFL** and the **Baltimore Ravens** professional football franchise in a series of copyright actions stemming from the Ravens' adoption of an inaugural logo for its 1996-1998 seasons that plaintiff Frederick Bouchat alleged was substantially similar to a copyrighted drawing he had submitted for consideration. Most recently, Bouchat alleged that the appearance of the Ravens' inaugural logo in certain video games sold by Electronic Arts (EA) was infringing. We successfully had the case entirely dismissed on summary judgment, persuading the Court that the NFL did not license EA to use the logo in the games at issue.
- AeroManagement, Inc. v. Sukhoi Civil Aircraft Co., Alexander Pimenov, Victor Olenin, and Luigi de Franceso (S.D.N.Y. 2013). We represented one of the largest Russian jet manufacturers, **Sukhoi Civil Aircraft**, and three of its senior officers in a breach of contract, trade secret, copyright infringement and trade secret misappropriation lawsuit filed by AeroManagement. Plaintiff claimed it provided interior design plans for the

Sukhoi Super Jet, and that our client was going to commercially exploit those plans without paying for them. AeroManagement sought an expedited preliminary injunction to prevent our client from displaying its Jet at the 2013 Moscow Air Show, one of the biggest air shows in the world. After we cross examined the plaintiff's CEO at the preliminary injunction hearing, the court denied the motion for preliminary injunction, allowing our client to display its Jet in the Moscow Air Show.

- Perfect 10 v. Yandex (N.D. Cal. 2013). We represented Russian technology company **Yandex**, which operates the world's fourth largest search engine, in a massive copyright infringement lawsuit brought by adult entertainment publisher Perfect 10, seeking over \$100 million in damages. The suit alleged that Yandex had willfully infringed Perfect 10's copyrights in tens of thousands of its images of nude women by crawling, indexing and linking to third party websites hosting infringing Perfect 10 images, and by hosting unauthorized Perfect 10 images uploaded by users of Yandex's user-generated content sites. Early in the case, Yandex defeated Perfect 10's motion for a preliminary injunction on its copyright claims directed to Yandex's search and hosting services, obtaining a court ruling that Perfect 10 was unlikely to succeed on the merits of its claims and that Perfect 10 had not demonstrated irreparable harm. Subsequently, Yandex obtained summary judgment on the vast majority of Perfect 10's claims, on extraterritoriality and fair use grounds. Specifically, Yandex showed that most of Perfect 10's claims concerned "extraterritorial" acts of alleged copyright infringement not cognizable under the U.S. Copyright Act, and that the thumbnail-sized images in Yandex's image search results are a non-actionable "fair use" under the U.S. Copyright Act. After that victory, Perfect 10 quickly settled for a fraction of its original demand.
- Viacom International, Inc. v. YouTube Inc. (S.D.N.Y. 2013). We won summary judgment on behalf of **YouTube** and its parent **Google** in a precedent-setting, billion-dollar copyright case brought by Viacom in U.S. District Court in New York. Viacom argued that YouTube should be held liable for the presence of allegedly unauthorized, infringing material on the site. In a decision that helps to establish the rules of the road for Internet services that host user-generated content, the district court agreed with us that YouTube and Google are fully protected by the safe-harbor provisions of the Digital Millennium Copyright Act.
- Mattel, Inc. v. MGA Entertainment Inc., et al. (and consolidated actions). (9<sup>th</sup> Cir. 2013). On behalf of Mattel, Inc., we obtained a complete reversal in the Ninth Circuit Court of Appeals of a \$172.5 million judgment entered against Mattel following a jury verdict on a trade-secrets misappropriation claim raised by toy company MGA Entertainment, Inc. The Ninth Circuit agreed with Mattel that MGA's trade-secrets claim, which was raised as a "counterclaim-in-reply," was procedurally barred because it was not a "compulsory" response to any claim Mattel had raised, and therefore "should not have reached this jury." The Ninth Circuit therefore vacated the jury verdict and remanded the claim to the district court with instructions that it be dismissed.
- Benay v. Warner Bros. Entertainment, Inc., et al. (C.D. Cal. 2012). We successfully defended the **producers, writers and director of the motion picture "The Last Samurai"** in a lawsuit alleging that they had used material written by the plaintiffs to

write and produce the film. The plaintiffs asserted claims for copyright infringement and breach of implied-in-fact contract. After a two week trial in the United States District Court, the jury unanimously rejected the plaintiffs' claims and rendered a verdict in favor of our clients.

- Barclays v. Flyonthewall (2d Cir. 2011). We represented **Google** and **Twitter** as amicus in the Second Circuit in a successful effort to narrow the tort of "hot news" misappropriation.
- Perfect 10, Inc. v. Google Inc. (C.D. Cal. 2010, 9<sup>th</sup> Cir. 2011). For our client **Google**, we successfully obtained the complete dismissal with prejudice of the long-running *Perfect 10 v. Google* litigation. At issue were Perfect 10's claims of copyright infringement seeking to shut down Google's popular Web Search, Image Search and Blogger services. Prior to the dismissal, we successfully obtained summary judgment of safe harbor under the Digital Millennium Copyright Act on Perfect 10's copyright infringement claims against Google's Web Search, Image Search and Blogger services. The decision precluded Perfect 10 from seeking any monetary damages for almost all of the more than two million alleged copyright infringements Perfect 10 claimed were hosted by Google's Blogger service or linked to by Google's Web and Image Search services. We also defeated Perfect 10's motion for a preliminary injunction on its copyright and publicity claims, obtaining a court ruling that Google was likely to succeed on the merits, and that Perfect 10 had not demonstrated irreparable harm. We successfully defended that victory on appeal before the Ninth Circuit in 2011. And finally, on the eve of the close of discovery, after obtaining damaging admissions during several key depositions (including of Perfect 10's CEO Norman Zada) and winning several critical discovery motions, Perfect 10 offered to dismiss the entire lawsuit with prejudice in exchange for Google's agreement not to seek attorneys' fees and costs. The dismissal, coming after more than seven years of protracted litigation, completely vindicated Google's legal position, as Google had maintained all along that Perfect 10's case lacked any merit. The case ended without Google paying Perfect 10 a cent.
- SocialApps v. Zynga, Inc. (N.D. Cal. 2012). We successfully represented **Zynga** in a copyright and trade secret misappropriation lawsuit involving Zynga's famous Farmville game. After a series of very favorable discovery rulings, the case settled extremely favorably to Zynga.
- Zynga Game Networks v. Green Patch, Inc and Playdom, Inc. (N.D. Cal. 2010). We represented **Zynga** in a copyright infringement suit against former competitor Green Patch and current competitor (now owned by Disney) arising out of the outright copying of Zynga java script in four Zynga games, and the incorporation of that code in 6 Green Patch/Playdom games. The case resulted in the entirely changing the accused games and in a very favorable monetary settlement to Zynga.
- Deborah Thomas v. The Walt Disney Company (9th Cir. 2009). We successfully represented **Disney** in a suit by a screenwriter and poet who claimed that Disney's blockbuster Finding Nemo feature film was an unauthorized derivative work from the plaintiff's poem and treatment. We convinced the trial court to dismiss the plaintiff's

complaint on grounds of lack of substantial similarity, which was affirmed in all respects by the Ninth Circuit on appeal.

- German Software Litigation (Frankfurt District Court 2010). One of the partners in our Hamburg office successfully defended a **German software company** against an individual who had claimed to have acquired rights in a standard Enterprise Resource Planning (ERP) software product. The dispute centered around a number of licensing/copyright and insolvency law related questions that were still uncharted at the time of the proceedings. Adopting the position advanced on behalf of the defendant software company, the Frankfurt District Court fully dismissed the case in a final and binding judgment.
- Flaherty v. Filardi (S.D.N.Y. 2009). We represented **The Walt Disney Company, Executive Producer Dana Owens (p/k/a “Queen Latifah”), screenwriter Jason Filardi and various independent producers** of the hit comedy film “Bringing Down the House” (starring Steve Martin) in a long-running copyright infringement lawsuit filed by an aspiring screenwriter. Along the way, we obtained published summary judgment rulings dismissing all claims against our clients, including copyright, Lanham Act and fraud claims relating to the final motion picture as well as similar claims relating to draft screenplays created during the development of the film. In addition, we also defeated countless motions filed by the plaintiff, including one seeking to enjoin the network and cable premieres of the movie and another challenging the propriety of a single firm jointly representing multiple defendants in such cases to promote efficiency and reduce legal costs.
- Funky Films, Inc. v. Time Warner Entertainment Co., 462 F.3d 1072 (9th Cir. 2006). On behalf of **Time Warner Entertainment** and **HBO**, we obtained a summary judgment dismissal of copyright and trademark infringement claims valued in excess of \$50 million challenging the originality of the popular hit series “Six Feet Under.” Our win was later affirmed by the Ninth Circuit in an oft-cited ruling articulating the application of copyright law to television and film properties.
- Corbis v. TemplateMonster.com (S.D. Fla. 2006). One of our partners represented **Corbis** against Ukrainian and other foreign professional copyright pirates, obtaining a TRO and injunction against all defendants that permanently shut down several foreign copyright pirate operations, and winning a \$20 million judgment against several of the defendants.
- MCS Music America v. Napster (E.D. Tenn. 2006). We successfully defended **Napster** in an alleged mass copyright infringement suit brought by a copyright administrator and some 26 music publishers. The suit alleged that thousands of digital music tracks offered for download and/or streaming on **Napster’s** service were infringing. Plaintiffs had claimed more than \$220 million in damages. After our depositions of plaintiffs’ representatives cast doubt on their ownership rights and claims of unauthorized use, plaintiffs voluntarily dismissed their suit.
- Mattel v. Radio City Entertainment (2d Cir. 2006). As appellate counsel, we won a decision by the Second Circuit vacating a district judge’s adverse verdict after a bench

trial against **Mattel** in a copyright infringement case litigated at the trial level by a different firm.

- Nicholls v. Tufenkian Import/Export Ventures (S.D.N.Y. 2005). Even though we were retained by **Tufenkian Carpets** less than a month before trial, we won a defense verdict, including specific findings of lack of access and lack of substantial similarity in a rug design case.
- Ninox Television v. Fox Entertainment Group (S.D.N.Y. 2005). We represented **Fox Entertainment Group** and **FreemantleMedia** against a New Zealand-based production company over the format to “The Complex: Malibu,” a home renovation reality competition series. After we obtained an early stay of discovery and moved for summary judgment on the ground that generic elements of television programming are not entitled to copyright protection, the plaintiff withdrew its complaint with prejudice.
- Robbins v. Mattel (S.D. Ohio 2005). In complex suit alleging reversion of previously assigned copyright and trademark ownership rights to the famous game UNO, we won summary judgment for **Mattel** on the bulk of plaintiffs’ claims, which plaintiffs asserted were worth in excess of \$75 million. The case subsequently settled on terms that included the entry of final judgment declaring Mattel’s exclusive, superior rights to the UNO properties.
- Mattel v. American First Run Studios (C.D. Cal. 2003). We defended **Mattel** against state and federal suits claiming Mattel’s **TARZAN** action figures infringed a studio’s copyrights and related rights, winning summary judgments in both actions, later affirmed by the California Court of Appeal and the Ninth Circuit Court of Appeals, respectively.
- Greiner & Hausser GmbH v. Mattel (C.D. Cal. 2003). In cross-border actions in the U.S. and Germany, we defeated a former owner’s claims seeking to rescind the assignment of copyright and patent rights that formed the basis of **Mattel’s BARBIE** product line, worth more than \$2 billion in annual revenues. Reported decisions include 354 F.3d 857 (9th Cir. 2003).
- Kling v. DIC Entertainment (C.D. Cal. 2003). We successfully defended **production and merchandising entities** against a \$20 million copyright claim based on a highly successful television and motion picture property, winning a complete defense verdict. *See also* prior appeal: Kling v. Hallmark Cards, Inc., 225 F.3d 1030 (9th Cir. 2000)
- Kling v. DIC Animation (C.D. Cal. 2001). We won a unanimous defense verdict on behalf of **Artisan Pictures, DIC Animation, Hallmark Cards, Mattel and United Feature Syndicate** when they faced a multi-million dollar copyright infringement trial over the RAINBOW BRITE and ROBOTMAN TV programs and videocassettes.
- MP3Board v. AOL Time Warner (S.D.N.Y. 2001). We obtained a dismissal with prejudice of claims against **AOL Time Warner** for alleged contributory and vicarious copyright infringement based upon its “Gnutella” information-sharing software.

- Gemisys v. Phoenix American, 50 U.S.P.Q.2d 1876 (N.D. Cal. 1999). One of our partners successfully defended **Phoenix American** and two of its subsidiaries against charges of copyright infringement, trade secret misappropriation, unfair competition and breach of a license agreement.
- Russo v. Russomanno (Los Angeles Super. Ct. 1999). We successfully defended a “deep pocket” motion picture studio in an entertainment industry trial, winning a nonsuit after closing statements even though a \$52 million verdict was entered against other defendants. We subsequently acted as lead appellate counsel, winning an affirmative of nonsuit and summary adjudication. The appellate rulings focused on the copyright preemption of claims for interference with contract and misappropriation of trade secrets.
- Danjaq LLC v. Sony Pictures Entertainment (C.D. Cal. 1998). One of our partners represented the producers and distributors of the **James Bond** film franchise in a copyright and trademark dispute concerning the right to create James Bond films. He obtained a preliminary injunction (affirmed by the 9th Circuit) and later won a defense judgment on a copyright infringement counterclaim, subsequently affirmed by the Ninth Circuit in a published opinion.
- Trio v. Intuit (C.D. Cal. 1997). One of our partners represented **Intuit**, successfully defending a claim that Intuit had incorporated the plaintiff’s code into its award-winning Quicken products.
- Martin Cano v. A World of Difference (ADL), 1996 WL 371064 (N.D. Cal. 1996). One of our partners obtained a dismissal of a copyright infringement and trademark infringement case brought against the **Anti-Defamation League** in which the plaintiff claimed ownership of certain ADL educational materials.
- Florentine Art Studio v. Vedet K. Corp., 891 F. Supp. 532 (C.D. Cal. 1995). On behalf of a manufacturer of hydrocal statuary, we turned the tables on the plaintiff. After proving at trial that our client’s acts of infringement were committed innocently, we persuaded the court that the plaintiff had unreasonably failed to settle. In a published decision, our client obtained an award of attorneys’ fees more than 150 times greater than the plaintiff’s damage award.

- Brøderbund Software, Inc. v. Unison World, Inc., 648 F. Supp. 1127 (N.D. Cal. 1986). One of our partners represented **Brøderbund** in this precedent-setting case involving a competitor who created a visual clone of Brøderbund's best-selling "Print Shop" software product. This is the first reported case to recognize and enforce the copyrightability of the user-interface of a non-video game computer program.

## Trade Secrets Litigation

### **RECENT TRADE SECRET REPRESENTATIONS**

- Desktop Metal, Inc. v. Markforged, Inc. et al. (D. Mass 2018). We obtained a jury verdict for our client **Markforged**—a 3D printer manufacturer—in a bet-the-company case that was tried on an accelerated schedule before a Boston jury. Markforged was sued by Desktop Metal, a competing 3D printing company, on claims that Markforged misappropriated Desktop Metal's trade secrets and incorporated those trade secrets into Markforged's 3D printers. Desktop Metal also sought an injunction that would have forced Markforged to stop selling its newest 3D printer. Markforged asserted counterclaims against Desktop Metal for trade secret misappropriation, among other claims, arising from Desktop Metal's founding. During that second trial, shortly after opening statements and Markforged's CEO taking the stand, Desktop Metal agreed to a confidential settlement with favorable terms for our client.
- uCar Technology (USA) Inc. and uCar Inc. v. Yan Li, Hua Zhong, Da Huo, and Zhenzhen Kou (N.D. Cal 2018). We represented **four California-based scientists** accused of misappropriating data and other information related to smart car/driverless car technology. We defeated plaintiff uCar's effort to secure a preliminary injunction, with the court finding provisionally that there was no evidence that our clients had engaged in any trade secret theft or breached any obligation to uCar. After forcing uCar to bring its chief scientists to the United States for deposition, and after we filed key motions challenging whether uCar even owned any trade secrets, we achieved a favorable settlement. uCar dismissed its complaint with prejudice.
- Calendar Research LLC v. StubHub, Inc., et al. (C.D. Cal. 2018). We represent **StubHub** in a case brought by a startup investor alleging trade secret misappropriation, among other claims. We obtained summary judgment on the trade secret claim following an expedited expert and fact discovery period, during which the experts examined over 7 million lines of code for several apps.
- Waymo LLC v. Uber Technologies, Inc., et al. (N.D. Cal. 2018). We represented **Waymo LLC**, formerly Google's self-driving car program, in an action asserting misappropriation of trade secrets related to Waymo's self-driving LiDAR (Light Detection and Ranging) technology against Uber Technologies, Inc. and Ottomotto LLC. The parties reached a settlement on the fourth day of trial, after Waymo had presented much of its case-in-chief, granting Waymo a percentage of equity in Uber (valued at \$245 million) as well as injunctive relief that assures Uber will not use Waymo's trade secret hardware and software self-driving car technology.

- MGA Entertainment, Inc. v. Mattel, Inc. (LA Superior Court 2018). We recently obtained summary judgment on behalf of our client **Mattel** in its long-running battle against toy-company MGA Entertainment. Litigation between the parties started in 2004 and has spanned two lengthy trials in federal court, two appeals to the Ninth Circuit Court of Appeals, and a host of other significant trial and appellate court work. After more than a decade of litigation, the only remaining claim between the parties was a claim by MGA for alleged trade-secret misappropriation pending in the Los Angeles County Superior Court, for which MGA was purporting to seek more than \$1 billion in damages. Recognizing that Mattel had a strong defense based on the statute-of-limitations, we convinced the court to bifurcate the case to address that defense first. Mattel then moved for summary judgment on the basis that MGA had discovered its trade-secrets claim more than three years before it was first raised. In granting Mattel's summary judgment motion, the court agreed that MGA's claim was untimely, and thus closed the latest (and hopefully final) chapter in this marathon litigation.
- West v. eBay (N.D. NY 2018). We represented **eBay**, defending it against trade secret misappropriation and related claims arising out of the development of eBay's valet service. The case settled on confidential terms after we deposed the plaintiff and obtained an admission that he had altered evidence.
- Curvature LLC et al v. PivIT Global, Inc. (C.D. Cal. 2018). We are representing a computer hardware company, **PivIT**, and its founders against trade secret claims brought by their former employer, Curvature, regarding the alleged theft of customer lists and other business information.
- United States of America v. Pangang Group Company (N.D. Cal. 2018). We are currently representing the **Pangang Group Company** in a criminal prosecution pending in the Northern District of California related to the alleged theft of trade secrets from the DuPont Co. The United States government filed charges in 2012, alleging that Pangang conspired to steal titanium dioxide technology from DuPont. The case was considered one of the most significant prosecutions ever brought under the Economic Espionage Act and was the subject of a front page profile in the *Wall Street Journal*. While the case is still pending, we have staved off prosecution for over six years through a series of pretrial motions and by an appeal to the Ninth Circuit. Our lawyers have deep substantive expertise in this area as well as considerable ties to the Northern District Courthouse and the U.S. Attorney's Office.
- Vertellus v. W.R. Grace (D. Md. 2018). We currently represent **Vertellus** as plaintiff in a trade secrets theft case, including under the DTSA, arising out of the defendant's accused theft of intellectual property for catalysts used in the manufacture of agrochemicals.
- Complete Entertainment Resources LLC formerly d/b/a Songkick v. Live Nation Entertainment, Inc., et al. (C.D. Cal. 2017). We represented **Songkick** in a lawsuit alleging that Ticketmaster used 85,000 documents misappropriated by a former Songkick Vice President to design its competing system for artist presales technology, along with claims under the Computer Fraud and Abuse Act. After completing fact and expert discovery, we defeated the defendants' motion for summary judgment. Faced with

imminent trial, the defendants settled the case for \$110 million and also acquired Songkick's assets for a confidential sum.

- *Google LLC v. Equustek Solutions Inc., Clarma Enterprises Inc., and Robert Angus* (N.D. Cal. 2017). **Google** retained Quinn Emanuel to bring a suit for a declaratory judgment and injunction to prevent the enforcement of an order in the United States issued by a Canadian court concerning search results worldwide. The order, which the Supreme Court of Canada affirmed, required Google, which was not a party to the underlying dispute, to remove the websites of the defendants (who had defaulted) from search results served in every country on the grounds the Canadian defendants' websites offered products that violated plaintiffs' trade secrets. The action contends that the order is not enforceable in the United States because it is repugnant to U.S. policy as expressed by the First Amendment and Communications Decency Act, and violated international comity. The Canadian court's 2014 order was the first global delisting order, and Google's United States challenge squarely tees up whether foreign countries can restrict the speech of U.S. internet services in the United States. On November 2, 2017, Judge Davila of the Northern District of California granted a preliminary injunction prohibiting enforcement of the Canadian order in the United States. He found that enforcing "the Canadian order undermines the policy goals of Section 230 and threatens free speech on the global internet."
- *Mattel, Inc. v. MGA Entertainment Inc., et al. (and consolidated actions)* (9<sup>th</sup> Cir. 2013). On behalf of **Mattel, Inc.**, we obtained a complete reversal by the Ninth Circuit Court of Appeals of a \$172.5 million judgment entered against Mattel following a jury verdict on a trade-secrets misappropriation claim raised by toy company MGA Entertainment, Inc. The Ninth Circuit agreed with Mattel that MGA's trade secrets claim, which was raised as a novel "counterclaim-in-reply," was improper because it was not a "compulsory" response to any claim Mattel had raised and the claim therefore "should not have reached this jury." The Ninth Circuit vacated the jury verdict and remanded the claim to the district court with instructions that it be dismissed. The victory for Mattel was named one of the year's most significant appellate decisions in the legal press.
- *Qualcomm Inc. v. Apple Inc.* (San Diego Superior Court 2017). We currently represent **Qualcomm Inc.** in a state court action alleging trade secret misappropriation and breach of contract. Qualcomm alleges that Apple misappropriated its trade secrets by using them to advance the competing technologies of Intel, a competitor in cellular modem chipsets. Qualcomm also alleges that Apple breached agreements protecting its proprietary information from disclosure. Trial in this case is currently set for April 29, 2019.
- *LIQWD, Inc. and Olaplex LLC v. L'Oréal* (D. Del. 2017). We represent **Olaplex LLC** in a trade secret, breach of NDA and patent infringement case against various L'Oréal entities. Olaplex is a small California start-up that discovered and developed a game-changing product in a Santa Barbara garage that strengthens and rebuilds broken disulfide bonds in hair that has been chemically treated for bleaching and coloring. Olaplex was an overnight success and literally created a brand new product category known as "bond builders." L'Oréal, the world's largest beauty company, took notice and approached Olaplex for confidential discussions under an NDA. L'Oréal is accused

of using our client’s trade secret information to develop infringing competitor products. The court has issued a Ruling and Recommendation granting our client Olaplex LLC a preliminary injunction against L’Oréal’s continued manufacture and sale of the infringing “bond builder” products. The case is ongoing.

- *ArcherDX, Inc. et al. v. QIAGEN Sciences, LLC et al.* (D. Del. 2017). We are defending **QIAGEN**, a firm that specializes in DNA testing, in a theft of trade secret action brought by Archer Therapeutics, alleging that QIAGEN took its trade secrets related to customer identity and pricing. Archer also alleges that QIAGEN stole information related to technical details of its products used for preparing DNA for sequencing.
- *Theravance Biopharma v Junning Lee* (N.D. Cal. 2017). We represented **Theravance Biopharma** against one of its chief scientists who was alleged to have taken to a Chinese competitor over 150,000 electronic files—the equivalent of 600 bankers’ boxes of documents—for use after termination of the defendant’s employment with Theravance. After securing a preliminary injunction against the defendant, the case settled through entry of a permanent injunction and other benefits to Theravance.
- *International Game Technology et al. v. Leap Forward Gaming, Inc. et al.* (D. Nev. 2016). We represented **International Game Technology** (“IGT”) in its trade secret action against Leap Forward Gaming, in which IGT alleged that its former employees misappropriated IGT’s trade secrets to set up a competing venture. Among the misappropriated trade secrets at issue was a player-tracking technology that allows the gaming machines in a casino to store, retrieve, and update player’s activity data from the casino’s server.
- *Beacon Sales Acquisition, Inc. v. Robert Ricci, Mirta Valdes and SRS Distribution, Inc.* (Miami-Dade County Circuit Court 2016). We were retained mid-way through the litigation as trial counsel to defend a trade secrets case against **SRS Distribution**, a competitor and new employer to several former employees of plaintiff. After obtaining discovery and filing a summary judgment motion, the case settled favorably for our client.
- *Fair Isaac Corporation v. eBay Enterprise* (NY Commercial Division 2016). We represented **eBay** and eBay Enterprise in counterclaims against Fair Isaac Corporation (of FICO score fame), including trade secret misappropriation based upon a former eBay employee’s move to Fair Isaac Corporation. The case settled on confidential terms after the court indicated that it would grant eBay’s request to disqualify in-house counsel and prevent the former employee from testifying in the case.
- *Lifesize, Inc. v. Chimene* (W.D. Tex. 2016). We represented **Lifesize, Inc.** against Beau Chimene, its former employee, for misappropriating Lifesize’s trade secrets for the benefit of Lifesize’s direct competitor. Claims included trade secret theft under the DTSA and state law, as well as violations of the Computer Fraud and Abuse Act. We reached a favorable settlement on behalf of our client.
- *Virgin Galactic, LLC v. Thomas E. Markusic* (AAA Arbitration 2016). We represented **Virgin Galactic, LLC** in an arbitration against a former employee who started a competing small satellite rocket propulsion company using Virgin Galactic trade secret information and in violation of contractual and fiduciary duties owed to Virgin Galactic.

Using forensic evidence, we were able to establish that our adversary engaged in evidence spoliation and ultimately obtained an order for terminating sanctions, conclusively finding that the employee had misappropriated Virgin Galactic's trade secrets and violated his duties to Virgin Galactic.

- PPG Industries, Inc. v. Jiangsu Tie Mao Glass Co., Ltd. et al. (W.D. Pa. 2016). We represent **PPG Industries, Inc.** ("PPG") in an action against a China-based competitor and its agents. Defendants conspired with a former PPG employee to misappropriate PPG's trade secrets, including a proprietary report that details the manufacture of windows to be used in commercial aircrafts. No other company in the industry has the technology outlined the proprietary report.
- Agilent Technologies, Inc. v. Twist Bioscience Corp., Emily LeProust, and Does 1-20 (Santa Clara Superior Court 2016). We are currently defending **Twist Bioscience**, an innovative San Francisco biotech company, and its top executive, Emily Leproust, against Agilent's attempt to stifle Twist's cutting-edge synthetic DNA technology. Agilent filed this case in February 2016, alleging trade secret misappropriation, breach of contract, and breach of duty of loyalty.
- Ischemia Research and Education Foundation v. Pfizer Inc. (Santa Clara Superior Court 2016). Quinn Emanuel obtained a defense victory for **Pfizer, Inc.** in a state court action alleging trade secret misappropriation. At the initial trial in 2008, when other counsel represented Pfizer, plaintiff prevailed on all claims and obtained a judgment of almost \$60 million. The court ordered a retrial, and Quinn Emanuel entered the case. In 2015, Quinn Emanuel defended Pfizer at a seven-week liability retrial. The jury found only 7 of 159 alleged trade secrets were misappropriated by a third-party consultant who was working part-time for Pfizer. In 2016, Quinn Emanuel defended Pfizer during the three-week damages trial. With Pfizer facing exposure in excess of \$100 million, the jury awarded only \$165,000 in damages.
- American Leather Operations, LLC, et. al. v. Ultra-Mek Inc. (Middle District of North Carolina 2016). We represented **American Leather Operations, LLC** asserting trade secret misappropriation against a furniture hardware manufacturer for using American Leather's trade secrets that it learned in the course of a confidential business relationship with American Leather.
- Zimmer Biomet v. Heraeus – Declaratory Proceedings (Frankfurt Appellate Court 2016). We represented **one of the world's leading orthopedic companies** in a dispute with its main competitor about the territorial scope of an injunction rendered by a German appellate court. While our adversary argued that the German injunction had worldwide effect, the court agreed with our position that the injunction must be construed narrowly and did not extend beyond Germany.
- IQVIA Inc. et al v. Veeva Systems Inc. (D.N.J. 2016). We are representing **IQVIA**, one of the world's largest healthcare data providers, in pursuing trade secrets claims against Veeva Systems. IQVIA alleges that Veeva exploited its access to IQVIA data obtained through the parties' mutual clients in order to develop and enhance Veeva's competitive healthcare data offerings and data management systems.

- In the Matter of Certain Opaque Polymers (International Trade Commission 2015). We represented as complainants **Dow Chemical** and **Rohm & Haas** against Organik Kimya in an investigation related to opaque emulsion polymers. We uncovered evidence of spoliation and obtained a default judgment on the trade secret claims. The ITC issued a 25-year exclusion order and affirmed almost \$2 million in monetary sanctions.
- Koninklijke Philips N.V. and Lumileds Lighting Company LLC v. Elec-Tech International Co., Ltd., Elec-Tech International (H.K.) Co. et al. (N.D. Cal. 2015). We successfully represented eleven companies and executives in the **Elec-Tech** corporate family, one of world's largest LED manufacturers, in suit alleging trade secret misappropriation and violation of the Computer Fraud and Abuse Act ("CFAA"). We obtained a dismissal with prejudice of the entire suit on the grounds that the asserted CFAA claim failed to satisfy federal jurisdictional requirements and thereby created new CFAA law in the Ninth Circuit. The Court further declined to retain supplemental jurisdiction over the remaining state law claims. The new case filed by plaintiffs is pending in California state court.
- Colin Veitch and VSM Development Inc. v. Virgin Management USA, Inc., Virgin Group Investments Ltd., Virgin Group Holdings Limited, Virgin Enterprises Limited and Virgin Cruises Intermediate Limited (S.D. Florida 2015). We defended a group of the **Virgin** companies accused of trade secret misappropriation, breach of fiduciary duty and breach of contract by the former CEO of Norwegian Cruise Lines relating to cruise industry financial, business, and ship designs. After significant favorable rulings on motions that compelled the plaintiff to identify its trade secrets with particularity and after deposing the plaintiff, the case settled favorably for our clients.
- Machine Zone, Inc. v. Kabam, Inc. (San Francisco Superior Court 2015). We successfully defended software publisher and developer **Kabam** in a trade secret infringement suit brought by rival Machine Zone. After the firm defeated two successive efforts by Machine Zone to obtain temporary restraining orders against Kabam, Machine Zone dismissed the case through settlement.
- Lilith Games (Shanghai) Ltd. v. uCool, Ltd and uCool, Inc. (N.D. Cal. 2015). We represented software publisher **uCool**, whose award winning game *Heroes Charge* was accused of trade secret misappropriation and copyright infringement. After we successfully defeated Lilith's attempts to obtain a preliminary injunction against the *Heroes Charge* game pending the trial on the merits, the case settled on favorable terms.
- craigslist, Inc. v. eBay Inc., eBay Domestic Holdings, Inc., Pierre Omidyar, and Joshua Silverman (San Francisco Superior Court 2015). We obtained a favorable settlement on behalf of **eBay, Inc.**, along with its founder and a former executive, in a state court action alleging trade secret misappropriation, unfair competition, trademark infringement, and breach of fiduciary duty, among other claims. craigslist alleged that eBay used its 28.4% ownership interest in craigslist (and the associated board seat) to gather confidential information used to launch eBay's own competing classified ads platform. In 2014, after years of litigation with craigslist, eBay (previously represented by another firm)

brought in Quinn Emanuel as co-counsel as this action approached a 2015 trial date. With Quinn Emanuel as counsel for eBay, the parties resolved their dispute in advance of trial on terms that included craigslist buying back eBay's entire ownership interest.

- *Genband LLC v. Metaswitch Networks* (E.D. Tex. 2014). We defended our client **Metaswitch** against trade secret misappropriation claims when former employees of Genband were recruited by Metaswitch. Genband alleged that the employees brought confidential trade secrets to Metaswitch during the transition relating to Voice-over-IP infrastructure equipment and related software. We won a motion to dismiss all trade secret claims a few weeks before trial for lack of subject matter jurisdiction. The case is now pending in Texas state court.
- *Fortinet Inc. v. Sophos Group PLC* (N.D. Cal 2014). We represented **Fortinet Inc.** as the plaintiff in wide-ranging patent and trade secret dispute with its competitor Sophos and certain former employees. The dispute included parallel proceedings in the N.D. Cal, JAMS arbitration, the District of Delaware and three *inter partes* reviews before the PTAB. In the JAMS arbitration, we successfully convinced the arbitrator that one former Fortinet employee had engaged in “despicable,” “deceitful and malicious” conduct, resulting in an award in favor of Fortinet for actual damages, punitive damages and attorneys’ fees. The parties settled shortly before trial in the N.D. Cal case on Fortinet’s trade secret and patent infringement claims, with the competitor agreeing to make a confidential one-time payment to Fortinet.
- *Perlan Therapeutics Inc. v. Ansun BioPharma, Inc. (formerly known as NexBio, Inc.)* (San Diego Superior Court 2014). We defended **Ansun** in a trade secret misappropriation and breach of fiduciary duty dispute concerning flu treatment technology. Perlan claimed that the founders of Ansun, who also founded Perlan, invented the flu technology while employed at Perlan and misappropriated the technology by leaving to form Ansun to develop the novel therapeutic. Ansun counterclaimed for breach of license agreement on a technology related to the common cold that Perlan failed to develop. After nine years of litigation, the parties settled on terms that allowed Ansun to continue developing its novel flu therapy.
- *Gotham City Online, LLC v. Art.com, Inc.* (N.D. Cal. 2014). We represented **Art.com** in a case brought by Gotham City Online LLC that alleged trade secret misappropriation, among other claims. We defeated plaintiff’s request for a temporary restraining order, successfully disqualified opposing counsel for using Art.com’s privileged documents to prepare Gotham’s case and effectively shut down the dispute, which was subsequently dismissed.
- *Schroeder, Rendezvous LLC and Skoop Media v. Pinterest, et al.* (New York Supreme Court—Commercial Division 2014). We represented social networking service **Pinterest** in a trade secret misappropriation action filed by an alleged former business partner of Pinterest’s first investor. The suit alleged that the idea for the successful Pinterest website was originally developed by plaintiffs and later stolen from them by Pinterest’s first investor. Plaintiffs further alleged that the investor gave the idea to the Pinterest founders who then used the ideas to develop the website [www.pinterest.com](http://www.pinterest.com). We

moved to dismiss all of plaintiffs' claims against Pinterest. After briefing, the court granted our motion to dismiss on Pinterest's behalf in its entirety.

- *Viasat v. Space Systems/Loral* (S.D. Cal. 2014). In a patent infringement and breach of contract action, our client had developed trade secrets that one of its manufacturers misappropriated; however, by the time we were retained, the statute of limitation on a trade secrets claim had expired. We therefore framed the trade secrets claims as a breach of the NDA. Because of the overlap in those claims, we still litigated all the typical trade secret issues and, at trial, obtained a \$123mm verdict on the breach claim, alongside a \$180mm patent infringement verdict.
- *AeroManagement, Inc. v. Sukhoi Civil Aircraft Co., Alexander Pimenov, Victor Olenin, and Luigi de Franceso* (S.D.N.Y. 2013). We represented one of the largest Russian jet manufacturers, **Sukhoi Civil Aircraft**, and three of its senior officers in a trade secret misappropriation, breach of contract and copyright infringement suit filed by AeroManagement. Plaintiff claimed it provided interior design plans for the Sukhoi Super Jet and our client intended to commercially exploit those plans without paying for them. AeroManagement sought an expedited preliminary injunction to prevent our client from displaying its jet at the Moscow Air Show, one of the biggest air shows in the world. After we cross-examined the plaintiff's CEO at the preliminary injunction hearing, the court denied the preliminary injunction motion, allowing our client to display its jet at the Moscow Air Show.
- *Wamco Inc. v. Oshino Lamps, Ltd. et al.* (Orange County Superior Court 2013). We defeated a motion to enjoin **Oshino Lamps, Ltd.**, the fledgling U.S. distributor and subsidiary of a Japanese manufacturer, and two independent contractors from selling manufacturer's product in the United States on the basis of alleged trade secret misappropriation.
- *Dassault Systems Solid Works v. Mat Andresen and Rod Walker* (D. Mass 2013). We represented **Solid Works** in a computer and customer theft case against a former employee and his colleague, which resulted in preliminary and permanent injunctions as well as damages awards against both defendants.
- *Maxwell Technologies, Inc. v. Linda Zhong, Jacky Au, Harbin Jurong and New Power Co, Ltd.* (San Diego Superior Court 2012). We obtained a TRO, preliminary injunction and permanent injunction against our client's former chief scientist who had been recruited and paid by a Chinese company to misappropriate our client's trade secrets and confidential information (both in the U.S. and in China) in order to develop a product that directly competed with our client **Maxwell Technologies**' ultra capacitor products.
- *United States of America v. Elliot Doxer* (D. Mass. 2011). One of our partners that previously served as a U.S. Attorney for the District of Massachusetts prosecuted an individual for stealing trade secrets from Akamai and providing them to an undercover agent posing as an Israeli intelligence officer. The trade secrets consisted of confidential business information, including Akamai's entire customer list and highly confidential information about contract terms.

- Trust Company of the West, et al. v. Jeffrey Gundlach, et al. (Los Angeles Superior Court 2010). We represented **Trust Company of the West** (“TCW”) in a lawsuit against its former portfolio manager Jeffrey Gundlach and his new company, DoubleLine Capital. After a two-month jury trial, we obtained a jury verdict finding in favor of TCW on its claim for theft of trade secrets and related claims.
- INVISTA S.à r.l., et al. v. Rhodia S.A. (3d Circuit 2010). On behalf of Koch Industries’ Invista subsidiaries, we enabled a Delaware state court trade secret action by **Invista** to proceed against French chemicals firm Rhodia S.A., despite Rhodia’s efforts to dismiss or stay the action in favor of a French arbitration proceeding. We defeated Rhodia’s motion and then won in the Third Circuit dismissal of Rhodia’s appeal as moot, using the foreign arbitrator’s ruling issued during the course of the appeal to show that Rhodia was not a proper party.
- Coty Inc. v. Harvey P. Alstott; Bruce C. Kowalsky; Diversified Beauty Products (f/k/a MBA Beauty, Inc.); and Harvey P. Alstott Associates, Inc. (New York Supreme Court 2010). We obtained a TRO against two former executives of client **Coty, Inc.**, stopping them from violating their covenant not to compete by marketing a nail polish line which, “coincidentally,” consisted of many colors identical to Coty’s line.
- Rudamac, Inc. v. Daniel Chambers, Thousand Oaks Printing & Specialties, Inc. and Consolidated Graphics, Inc. (Los Angeles Superior Court 2009). We represented **Rudamac, Inc.**, a printing company, in a case against a former employee and his new employer for trade secret misappropriation, breach of fiduciary duty and interference with economic advantage. After a month-long trial, we won a jury verdict for \$5.7 million in compensatory damages and over \$8 million in punitive damages.
- Zynga Game Network v. Kyle McEachern (N.D. Cal. 2009). We represented **Zynga** against a former employee and contractor who hacked Zynga’s secure servers post-employment and misappropriated company code. We obtained a temporary restraining order and preliminary injunction against the employee. After the court threatened to hold the plaintiff in criminal contempt, the case settled with a permanent injunction and monetary judgment against the employee.
- Limitnone LLC v. Google, Inc. (N.D. Ill., 7th Cir. 2008). We represented **Google** in a case where plaintiff sought \$1 billion for alleged trade secret theft and other claims related to the Google Apps suite of application programs. We won a district court order transferring the case to Google’s forum of choice, which the Seventh Circuit affirmed on appeal. The case subsequently settled on terms favorable to our client.
- SPS Technologies v. Motorola (Florida Circuit Court 2008). We were retained by **Motorola** for the retrial of a trade secret theft action following a mistrial. The plaintiff sought to wage a classic David versus Goliath battle, claiming that his small, defunct technology company was driven out of business by Motorola to facilitate the theft of its trade secrets valued at \$10 billion. After challenging the claims in pretrial motion practice, the case favorably settled days before the retrial was to commence.

- *Think Partnership v. Nelson* (D. Utah 2008). We represented various individuals accused by their employer of forming a competing company using the employer's trade secrets while working for the employer. We negotiated a favorable settlement for our clients.
- *Rent IT v. Home Depot* (C.D. Cal. 2008). After the Ninth Circuit partially reversed a summary judgment, we represented **Home Depot** in a suit filed by a disgruntled software vendor alleging trade secret theft and breach of a non-disclosure agreement. We prevailed at trial, obtaining a complete defense verdict on all claims.
- *IBM v. PSI Corp.* (S.D.N.Y. 2007-2008). We represented **IBM** in an intensely fought trade secret, patent and antitrust action against PSI Corp., a spinoff of Amdahl, which had announced it would offer an emulator allowing IBM's proprietary mainframe computer architecture to be implemented on Itanium-based servers. During discovery, we learned that several Amdahl programmers with prior access to highly confidential IBM information under a strict NDA had taken that information to PSI and used it in source code they wrote. We amended IBM's Complaint to add trade secret claims and outmaneuvered PSI's lawyers in working through source code written both in IBM Assembler and Intel Itanium assembly language as well as C, defining the trade secrets, distinguishing them from information that was publicly known and taking the depositions of the key employees. The case settled very favorably shortly after PSI's general counsel attended a deposition of one of the lead programmers and saw the damaging admissions we obtained.
- *UniRam v. TSMC* (N.D. Cal. 2007). One of our partners represented **UniRAM** in a trade secrets claim against TSMC, the world's largest independent chip foundry. After a jury trial, UniRAM obtained a \$30.5 million verdict.
- *Newton Research v. Shell Exploration & Production Company* (N.D. Tex. 2007). We defended **Shell Exploration & Production Company** in a trade secret misappropriation and breach of NDA suit concerning gas centrifuge technology. We convinced the district court to dismiss the case before trial on jurisdictional grounds.
- *Intematix v. Symyx Technologies* (Alameda Superior Court 2006). We represented **Symyx** in a trade secret misappropriation suit filed by Intematix. After we defeated Intematix's efforts to obtain preliminary relief, the case settled on terms favorable to our client.
- *Navitaire v. easyJet Airlines and Bullet Proof Software* (D. Utah 2005). We defended **easyJet Airlines** and **BulletProof** in a trade secret misappropriation and copyright infringement lawsuit arising out of the alleged theft and copying of Navitaire's reservations software. Upon the successful trial of a corresponding copyright infringement and breach of contract lawsuit, the case settled on terms favorable to our client.
- *Zions Investment Securities, Inc. v. Ruzek* (Third Judicial District Court of Summit County, Utah 2005). We obtained a sweeping temporary restraining order on behalf of **Zions Investment Securities, Inc.**, a financial services company, on the grounds that a departing employee had misappropriated trade secrets and violated the non-solicitation provision in his contract. The defendant subsequently agreed to the entry of a stipulated injunction.

- *Configuration Data v. Northrop Grumman* (Los Angeles Superior Court 2003). We successfully defended **Northrop Grumman** in a trade secret suit brought by a former Northrop software vendor that claimed that Northrop stole its proprietary software. The case was dismissed after Northrop moved for summary judgment and the trial court imposed sanctions against plaintiff.
- *Research-In-Motion v. Good Technology, Inc.* (Orange County Superior Court 2003). One of our partners represented **Good Technology** in a trade secret action filed by Research-In-Motion (“RIM”), distributor of BlackBerry wireless email solutions, against allegations that Good Technology had misappropriated RIM’s customer lists and reverse engineered part of its software for a competing solution. After defeating RIM’s motion for a temporary restraining order and motion for a preliminary injunction, the matter settled on terms favorable to our client.
- *Bancorp v. Hartford* (E.D. Mo. 2002). We won a jury verdict of \$118.3 million and a judgment of \$134 million for plaintiff **Bancorp**, a financial products company, in a misappropriation of trade secrets and breach of confidentiality agreement case against Hartford, a major insurance company.
- *Broadcom v. Sarnoff* (C.D. Cal., 9th Cir. 2002). We obtained summary judgment in favor of our client **Sarnoff**, a General Electric/RCA spinoff, on trade secret misappropriation claims involving QAM modem technology. The judgment was affirmed by the Ninth Circuit.
- *3M v. Avery Dennison* (D. Minn. 2002). After **Avery** hired three of its scientists, 3M filed suit and spent tens of millions trying to prove its trade secret misappropriation claims, seeking a nine-figure recovery. After we demonstrated that the claimed trade secrets were unprotectable, the case settled favorably to Avery.
- *Callidus v. Jacob Arital* (Santa Clara Superior Court 2002). One of our partners defended a chief scientist at **PeopleSoft** against allegations of trade secret misappropriation. The matter settled favorably.
- *Avery Dennison v. Four Pillars* (N.D. Ohio 2000). A Taiwanese competitor collaborated with an Avery Dennison employee to steal trade secrets. On behalf of **Avery Dennison**, we worked with the FBI and the Department of Justice to catch the thieves. A sting operation videotaped the competitor accepting trade secrets. The defendants were arrested that night, and served with a complaint and a temporary restraining order the next morning. We additionally won an \$80 million civil jury verdict for our client.
- *Litton v. Honeywell*, 234 F.3d 358 (Fed. Cir. 2000). One of our partners represented **Litton** (now **Northrop**) in an action alleging Honeywell caused an ex-Litton employee to breach agreements obligating him to protect trade secrets. The jury awarded Litton \$1.2 billion. The parties settled the case for \$440 million.

- PeopleSoft, Inc. v. Annuncio, Inc. (Santa Clara Superior Court 2000). One of our partners represented **PeopleSoft** for claims of trade secret misappropriation and breach of confidence against a competitor and several former PeopleSoft employees. After PeopleSoft secured a temporary restraining order against the former employees and the competitor, the matter settled on terms favorable to PeopleSoft.
- Compuware v. Serena Software (E.D. Mich 2000). One of our partners represented **Compuware** in a trade secret and copyright infringement suit brought against a competitor, based on access to trade secrets via customers who were under non-disclosure obligations. The case settled favorably to Compuware.
- 3M v. Avery Dennison (Orange County Superior Court 1999). We represented **Avery Dennison** when it hired a salesperson from 3M who, unbeknownst to Avery, brought 3M documents with him. Alleging trade secret misappropriation, 3M sued both Avery and the employee. Although the relevant documents came to light after a raid on the employee's house, we persuaded the jury after a three-month trial that Avery had no knowledge of the employee's activities and obtained a complete defense verdict.
- PeopleSoft, Inc. v. Evolve Software, Inc. (Alameda Superior Court 1999). One of our partners represented **PeopleSoft** with respect to its assertion of claims against a competitor arising out of the alleged misuse of confidential information by former employees. The matter settled favorably to PeopleSoft.
- Lasergraphics, Inc. v. CalComp, Inc. (Orange County Superior Court 1999). We represented **CalComp** in a two-month trial involving multiple claims of misappropriation of trade secrets, fraud, and breach of contract involving the computer protocol for high-speed color printers, obtaining a directed verdict on five of six of the claims at the close of the plaintiff's case. Lasergraphics appealed, but ultimately abandoned its suit after our firm's briefing in the Court of Appeal.
- Celeritis v. Rockwell and AT&T, 150 F.3d 1354 (Fed. Cir. 1998). Representing **Celeritis** in a trade secrets misappropriation action involving cellular transmission of data, one of our partners ultimately won a judgment of over \$70 million.
- Litton v. Ssangyong, 109 F.3d 30 (Fed. Cir. 1997). On behalf of **Litton** (now **Northrop**), following judgment and remand on appeal, one of our partners negotiated a settlement involving an eight-figure payment and defendant's withdrawal from the marketplace based on evidence that defendant had misappropriated exported trade secrets to make fine control radar for the F-16 fighter plane.
- General Motors v. Lopez de Arriortua (E.D. Mich. 1997). We represented **General Motors** against Volkswagen and GM's former head of sourcing for stealing secret GM documents. Working closely with in-house lawyers from GM, we amassed devastating evidence and defeated all of Volkswagen's jurisdictional and substantive motions. On the eve of the Volkswagen chairman's deposition, we obtained a \$1.1 billion settlement for GM.

- *Apex Wholesale v. GameTech Int'l.* (S.D.Cal. 1997). One of our partners represented GameTech International, one of the leading manufacturers of electronic gaming equipment, in defense of copyright infringement, trade secret misappropriation and related claims. The matter settled favorably to GameTech.
- *Litton v. Sundstrand and Allied Signal* (C.D. Cal. 1987). One of our partners represented **Litton**, now **Northrop**, in a trade secret case alleging a former senior employee misappropriated the production plans for a ring laser inertial navigation system. On the first day of trial, defendants agreed to close their competing business and pay Litton an eight-figure sum.
- *Honeywell v. Litton* (C.D. Cal. 1983). One of our partners represented **Litton**, now **Northrop**, in defending a trade secret case brought by Honeywell alleging Litton had won a government contract by misappropriating trade secrets. After twice successfully defeating Honeywell's request for injunctive relief, the case was settled by Honeywell paying the client's attorney's fees.

## **Internet Litigation**

### **RECENT INTERNET REPRESENTATIONS**

- *Alibaba Group Holding Limited v. Alibabacoin Foundation et al.* (PTAB 2018). We were engaged by our client, **Netflix, Inc.**, in two inter partes review proceedings challenging the validity of patents owned by Affinity Labs of Texas, LLC relating to streaming systems for digitally stored audio, video, and textual content. Following the Oral Hearing, the PTAB issued Final Written Decisions in each proceeding finding that all challenged claims were unpatentable. We represent Netflix in an appeal of the PTAB's ruling that was recently filed by Affinity and is currently pending before the Federal Circuit. We also represent Netflix in the related District Court proceeding that currently is stayed.
- *Gottlieb et al. v. Alphabet Inc. et al.* (N.D. Cal. 2018). We represented **Google, Alphabet, and several of its senior executives** in a case involving 13 claims, including RICO violations, securities fraud, antitrust, and breach of contract, arising out of plaintiff's termination from Google's AdSense program. The case was originally filed in New York, where plaintiffs reside, and we first successfully moved to transfer the case to California. We then moved to dismiss the case for failure to join the real party in interest, which the Court granted without prejudice. Once the amended complaint came in, we immediately moved to dismiss on statute of limitations grounds, arguing plaintiffs did not get the benefit of tolling or relation back. The Court agreed, granting our motion with prejudice.
- *Edible International, LLC et al v. Google, LLC* (D. Conn. 2018). We represented **Google, LLC** in a case involving allegations of trademark infringement, trademark dilution, and unfair competition, brought by a customer of Google's advertising services. We successfully won a motion to compel the dispute to arbitration.

- Google LLC v. Equustek Solutions Inc., Clarma Enterprises Inc., and Robert Angus (N.D. Cal. 2017). **Google** retained Quinn Emanuel to bring a suit for a declaratory judgment and injunction to prevent the enforcement of an order in the United States issued by a Canadian court concerning search results worldwide. The order, which the Supreme Court of Canada affirmed, required Google, which was not a party to the underlying dispute, to remove the websites of the defendants (who had defaulted) from search results served in every country on the grounds the Canadian defendants' websites offered products that violated plaintiffs' trade secrets. The DJ action contends that the order is not enforceable in the United States because it is repugnant to US policy as expressed by the First Amendment and Communications Decency Act and violated international comity. The Canadian court's 2014 order was the first global delisting order, and Google's United States challenge squarely tees up whether foreign countries can restrict the speech of U.S. internet services in the United States.

On November 2, 2017, Judge Davila of the Northern District of California granted a preliminary injunction prohibiting enforcement of the Canadian order in the United States. He found that enforcing "the Canadian order undermines the policy goals of Section 230 and threatens free speech on the global internet."

- SimpleAir, Inc. v. Sony Ericsson Mobile Communications AB (Fed. Cir. 2016). At the U.S. Court of Appeals for the Federal Circuit, we obtained a complete reversal of an \$85 million verdict of patent infringement against **Google** in the Eastern District of Texas. Plaintiff SimpleAir, Inc. had sued Google, Microsoft, and numerous other providers of smartphones and software, claiming its patents covered the technology used to send notifications to mobile devices. Google, while represented by previous counsel, had been found by two juries to infringe and to owe \$85 million in royalties. On Quinn Emanuel's successful appeal, the appellate court first reversed the district court's key claim construction ruling, namely that the term "data channel" could not be a device's connection to the Internet because that would make the term redundant. Instead, the Federal Circuit held that the well-known canon of construction that each claim term should be given meaning could not trump the overriding requirement to stay true to the patent's specification. As a result, the court of appeals agreed with Quinn Emanuel that the verdicts should be reversed, and instructed the Eastern District of Texas to enter a judgment of non-infringement in favor Google.
- Broadband iTV, Inc. v. Time Warner Cable, Inc.; Oceanic Time Warner Cable, LLC (D. Haw. 2015). We were retained by **Time Warner Cable** for a patent case venued in Hawaii. The plaintiff, BBiT, is a Honolulu-based company that failed in the video-on-demand (VOD) business and turned to asserting its patent portfolio. BBiT sued TWC for infringement of a patent directed to creating a bridge between the internet and closed, cable systems by using metadata to facilitate the automation, hierarchical organization, and display of video content on customers' electronic programming guides. TWC invalidated the asserted patent under the Supreme Court's recent Section 101 jurisprudence holding that abstract ideas are not patentable in the context of software inventions and that the addition of conventional technologies cannot provide the inventive concept.

- Smartflash v. Samsung Electronics & HTC (Fed. Cir. 2015). We represented **Samsung** and **HTC** in a case involving patents related to the online payment for and distribution of content, such as apps, videos, and music. Weeks before trial, we obtained a reversal of the district court order denying a motion to stay the case pending covered business method review of the patents by the Patent Trial and Appeal Board.
- Hanginout, Inc. v. Google Inc. (S.D. Cal. 2014). We represent **Google Inc.** in a case against Hanginout, Inc. Hanginout claims that Google's use of HANGOUTS infringes Hanginout's alleged common law HANGINOUT trademark. Hanginout moved for a preliminary injunction but was soundly defeated. The Court's 34-page opinion found in Google's favor on all of the preliminary injunction factors. The Court's opinion also raised serious doubts that Hanginout even has common law trademark rights in its alleged mark or that there is any likelihood of confusion.
- Parts.com, LLC v. Google Inc. (S.D. Cal. 2014). We represented **Google Inc.** in a trademark case involving Parts.com LLC and obtained dismissal of all claims against Google at the pleading stage under the doctrine of laches. The state law claims were also found to be barred by the Communications Decency Act's immunity provision. Parts.com had alleged that Google impermissibly used its trademark in its AdWords program constituting federal and state trademark infringement, dilution, and unfair competition.
- Zhang v. Baidu.com Inc. and the People's Republic of China (JMF) (S.D.N.Y. 2014). We obtained complete dismissal of an action in the Southern District of New York against our client **Baidu, Inc.**, the most popular Internet search engine in the People's Republic of China. Plaintiffs alleged that Baidu violated various civil rights statutes by failing to return links in search results to their works advocating political change in China. The court held that Baidu's search results were protected speech and the action was therefore barred by the First Amendment.
- Booking.com v. HRS (District Court Hamburg 2013). We obtained a first instance verdict for **Booking.com** against a main competitor regarding German unfair competition law.
- Function Media, LLC v. Google, Inc. and Yahoo, Inc. (E.D. Tex. 2010, Fed Cir. 2013). Brought in five months before trial to defend **Google**'s AdSense advertising products against Function Media's \$600 million claim of infringement of three patents, we won a unanimous jury verdict of both non-infringement and invalidity in the Eastern District of Texas in Google's first patent trial and a complete affirmance of the judgments from the United States Court of Appeals for the Federal Circuit.
- Bouchat v. Baltimore Ravens & NFL Enterprises. (D. Md. 2012). We have successfully represented the **NFL** and the **Baltimore Ravens** professional football franchise in a series of copyright actions stemming from the adoption by the Ravens of an inaugural logo for its 1996-1998 seasons that plaintiff Frederick Bouchat alleged was substantially similar to a copyrighted drawing he had submitted for consideration. Most recently, Bouchat alleged that the fleeting appearance of the Ravens' inaugural logo in football documentaries shown on the NFL Network and on the NFL's website, as well as the

appearance of the logo in photographic displays at the Ravens' stadium commemorating historical events, infringed his copyright in his drawing. We successfully had the cases entirely dismissed on summary judgment, persuading the Court that the uses at issue are all fair uses.

- Perfect 10, Inc. v. Yandex Inc. (N.D. Cal. 2012). For our client **Yandex N.V.**, a Dutch holding company whose Russian subsidiary, **Yandex LLC**, operates the leading Internet search engine in Russia, we defeated Perfect 10's motion for a preliminary injunction on its copyright claims directed to Yandex's search and hosting services, obtaining a court ruling that Perfect 10 was unlikely to succeed on the merits of its claims against Yandex N.V., and that Perfect 10 had not demonstrated irreparable harm.
- Eon-Net LP et al. v. Flagstar Bancorp (Fed. Cir. 2011). We obtained a complete victory on claim construction, a stipulated judgment of non-infringement, and an award of over \$600,000 in attorney fees and sanctions for our client **Flagstar Bancorp** in a patent infringement case related to converting hard copy documents to computer files using templates and content instructions. On appeal, the Federal Circuit affirmed the judgment for our client in its entirety.
- Barclays v. Flyonthewall (2d Cir. 2011). We represented **Google** and **Twitter** as amicus in the Second Circuit in a successful effort to narrow the tort of "hot news" misappropriation.
- Soverain Software v. J.C. Penny, et al. (E.D. Tex. 2011). We represented **Soverain Software** in a patent infringement case involving online shopping cart technology and order tracking systems used on ecommerce websites. Following a five-day jury trial, we obtained a verdict of infringement with respect to all five asserted claims and \$18 million in pre-judgment damages. Soverain's motion for post-judgment damages is pending.
- Perfect 10, Inc. v. Google Inc. (C.D. Cal. 2010, 9<sup>th</sup> Cir. 2011). For our client **Google**, we successfully obtained the complete dismissal with prejudice of the long-running *Perfect 10 v. Google* litigation. At issue were Perfect 10's claims of copyright infringement seeking to shut down Google's popular Web Search, Image Search and Blogger services. Prior to the dismissal, we successfully obtained summary judgment of safe harbor under the Digital Millennium Copyright Act on Perfect 10's copyright infringement claims against Google's Web Search, Image Search and Blogger services. The decision precluded Perfect 10 from seeking any monetary damages for almost all of the more than two million alleged copyright infringements Perfect 10 claimed were hosted by Google's Blogger service or linked to by Google's Web and Image Search services. We also defeated Perfect 10's motion for a preliminary injunction on its copyright and publicity claims, obtaining a court ruling that Google was likely to succeed on the merits, and that Perfect 10 had not demonstrated irreparable harm. We successfully defended that victory on appeal before the Ninth Circuit in 2011. And finally, on the eve of the close of discovery, after obtaining damaging admissions during several key depositions (including of Perfect 10's CEO Norman Zada) and winning several critical discovery motions, Perfect 10 offered to dismiss the entire lawsuit with prejudice in exchange for Google's agreement not to seek attorneys' fees and costs. The dismissal,

coming after more than seven years of protracted litigation, completely vindicated Google's legal position, as Google had maintained all along that Perfect 10's case lacked any merit. The case ended without Google paying Perfect 10 a cent.

- Viacom International, Inc. v. YouTube Inc. (S.D.N.Y. 2013). We won summary judgment on behalf of **YouTube** and its parent **Google** in a precedent-setting, billion-dollar copyright case brought by Viacom in U.S. District Court in New York. Viacom argued that YouTube should be held liable for the presence of allegedly unauthorized, infringing material on the site. In a decision that helps to establish the rules of the road for Internet services that host user-generated content, the district court agreed with us that YouTube and Google are fully protected by the safe-harbor provisions of the Digital Millennium Copyright Act.
- Performance Pricing Inc. v. Google Inc., et al. (E.D. Tex., Fed. Cir. 2010). On behalf of **Google** and **AOL**, we won affirmance of summary judgment of non-infringement in a patent infringement litigation in which the patent-in-suit was asserted against the Defendants in September 2007 by Performance Pricing Inc., an Acacia entity. Performance Pricing had accused Google's AdWords and AOL's Search Marketplace systems of infringing the patent, which involved a method of doing business over the Internet "wherein various forms of competition and/or entertainment are used to determine transaction prices between buyers and sellers."
- Paid Search Engine Tools, LLC v. Yahoo! Inc., et al. (E.D. Tex. 2010, Fed. Cir. 2012). Representing **Google**, we brought and won an early summary judgment motion of invalidity. The patent-in-suit was asserted against Google by Paid Search Engine Tools ("PSET"). PSET had accused Google's AdWords system of infringing the patent, which involved a bid management system that could adjust bidders' bids in online auctions in order to obtain their desired positions and eliminate "bid gaps." The Federal Circuit affirmed the district court's order *per curiam*.
- Software Rights Archive, LLC v. Google Inc., Yahoo! Inc., IAC Search and Media, Inc., AOL, LLC, and Lycos, Inc. (E.D. Tex. 2010). Our client, **IAC Search and Media, Inc. ("IACSAM")**, was sued by a patent troll for the alleged infringement of several patents that allegedly covered key parts of the search algorithms used in IACSAM's Internet search engine. The plaintiff, who was represented by several plaintiffs' firms, sought extensive damages for the alleged infringement by IACSAM and other search engine operators, such as Google and Yahoo!. Our firm played a key role in the preparation of invalidity contentions on behalf of the joint defense group, and the filing of a motion to transfer the case to the Northern District of California, which was recently granted. The plaintiff agreed to a favorable settlement for IACSAM in an amount that was significantly smaller than the plaintiff's initial demand.
- Bright Response LLC v. Google Inc. and Yahoo Inc. (E. D. Tex 2010). Defending **Google** against a \$128 million patent infringement claim brought by Bright Response LLC against Google's AdWords advertising system in the Eastern District of Texas, we won a complete non-infringement and invalidity verdict after a six-day jury trial.

- In re Jonathan Mitchell Schiff (U.S. Bankruptcy Court for the S.D. Cal. 2010). We represented **DIRECTV** in a cybersquatting case against an individual, Jonathan Schiff, who previously ran one of the largest and most successful independent DIRECTV retailers. After his company was terminated in 2007, Schiff started working as a partner/consultant for another independent DIRECTV retailer. While working with the new DIRECTV retailer, Schiff registered sixty-six domain names using “directv” followed by a city or state name. All of the domain names were registered without DIRECTV’s permission or knowledge and in violation of the DIRECTV retailer agreement, which forbids retailers from using DIRECTV trademarks in domain names. The Court found that Schiff violated the Anti-cybersquatting Protection Act and that the violation was willful because he “clearly used the mark in anticipation of personal profit and did so with the clear understanding that his use of the mark . . . was inconsistent with DIRECTV’s rights, desires, and contractual, oral, and written instructions.” Although DIRECTV did not offer any evidence of actual damages or Schiff’s profits, the court awarded DIRECTV \$7,000 per domain name in damages for a total of \$462,000.
- Bid For Position v. AOL (Fed. Cir. 2009). We won affirmance of summary judgment of non-infringement for **Google** in a patent infringement litigation in which plaintiff sought in excess of \$150 million in past damages and a royalty on future revenue in the billions. The litigation concerned the AdWords auction system used by Google to sell advertisement space on search results pages for Google.com and partner sites.
- Source Search Technologies, L.L.C. v. LendingTree, LLC, IAC/InterActiveCorp, and ServiceMagic, Inc. (D.N.J. 2009). On behalf of our clients, **IAC/InterActiveCorp**, **LendingTree**, and **ServiceMagic**, we obtained a summary judgment of invalidity. They had been sued in New Jersey for infringement of a business method patent assigned to a New Jersey corporation, owned by a New Jersey resident (who also happened to be the named inventor), and represented by a New Jersey IP firm. The claim for damages was \$100 million. The District Court granted our motion for summary judgment that the asserted claims were invalid for obviousness. If the patent had survived, it could be asserted against any and all internet buyer-vendor matching sites.
- Applied Information Sciences v. eBay Inc. (C.D. Cal., 9th Cir. 2007). We obtained a grant of summary judgment for **eBay** against trademark infringement and unfair competition claims related to its use of the terms "Smart Search" as the label for a hyperlink on its Web site home page. The Ninth Circuit affirmed summary judgment in eBay's favor. 511 F.3d 966 (9th Cir. 2007).
- Jews for Jesus v. Google (S.D.N.Y. 2006). We represented **Google** in a trademark suit arising from a third party's unauthorized use on blogspot of the plaintiff's registered trademark as the title of a blog critical of plaintiff's organization.
- eDirect Publishing v. eStaffMax (C.D. Cal. 2005). We won preliminary and permanent injunctions for **eDirect Publishing** in a false advertising, copyright, trademark and trade dress suit involving automated resume posting site and related software. We also obtained enhanced monetary damages under the Lanham Act, punitive damages and an award of attorney's fees.

- Hermes v. Bluefly (S.D.N.Y. 2004). We represented leading Internet retailer **Bluefly** in a false advertising suit brought by luxury goods manufacturer Hermes challenging the use by Bluefly of rare and high-priced Hermes handbags as prizes in an online sweepstakes. We have represented Bluefly in many other disputes arising from its online commerce model and marketing.
- Long v. Walt Disney Co. (Cal. Ct. App. 2004). We won summary judgment for **Disney** on tort and equitable claims arising out of the unauthorized use of 25-year old student photographs on a television show and related Internet sites based upon the Uniform Single Publication Act. Our win was then affirmed on appeal.
- International Bancorp, LLC v. Société des Bains de Mer et du Cercle des Étrangers à Monaco (4th Cir. 2003). On behalf of Monaco's resort arm, we won an injunction against an online gambling site trading on the equity of Monaco's famous Casino de Monte Carlo and an affirmance by the 4th Circuit.
- TVT Records v. MP3.com (S.D.N.Y. 2003). We represented **MP3.com** in a jury trial of the plaintiffs' copyright claims arising from MP3.com's Internet-based music listening service, and obtained a unanimous verdict of no actual damages.
- ASCAP v. MP3.com (S.D.N.Y. 2002). We represented **MP3.com** in an ASCAP rate court proceeding to determine the reasonable level of public performance license payments for audio streaming over the Internet, resulting in a favorable license rate settlement for the client.
- Newman v. MP3.com (C.D. Cal. 2002). We represented **MP3.com** in numerous actions brought in New York and California by record labels, music publishers and artists/songwriters including Bob Dylan, James Taylor, Billy Joel, Randy Newman, Heart, Hanson, Hamstein Music, and Soundgarden arising from the reproduction of musical compositions and sound recordings to facilitate MP3.com's Internet music listening service. In the course of more than 20 lawsuits, many novel issues regarding copyright standing, liability and damages as they relate to Internet music were litigated and determined.
- Grey Advertising v. Gray (C.D. Cal. 2000). We obtained a preliminary injunction for **Grey Advertising** that shut down a competitor's infringing website on false advertising and unfair competition grounds.
- Estate of Kurt Cobain v. Smith (C.D. Cal. 1999). Representing the **Estate of Kurt Cobain**, we recovered the domain name kurtcobain.com as well as other domains from cybersquatters.

## **Trademark, Trade Dress, Unfair Competition/False Advertising, and Publicity Rights Litigation**

### **SELECT RECENT REPRESENTATIONS**

- Alibaba Group Holding Limited v. Alibabacoin Foundation et al. (S.D.N.Y. 2018). Earlier this year, we brought suit on behalf of **Alibaba Group Holding Limited** against a group of Dubai- and Belarus-based companies and individuals using Alibaba's trademarks to promote a new cryptocurrency called "Alibabacoins" or "Alibaba Coins." On October 22, 2018, the Court issued an order granting us a preliminary injunction that (1) enjoins Defendants from using Alibaba's marks anywhere in the United States, including in connection with the provision of products or services to internet users located in the United States and (2) enjoins Defendants from making false or misleading statements concerning Alibaba's marks. Thereafter, the Court issued an order denying Defendants' motion to dismiss the complaint.
- We represent **Gucci** in a case against Forever 21, which brought claims for declaratory judgment of non-infringement and cancellation of trademark registrations against Gucci America, Inc. relating to Gucci's famous green-red-green and blue-red-blue striping trademarks. We filed a motion to dismiss the claims, and filed counterclaims of trademark infringement and dilution. The parties recently filed cross-motions for summary judgment which are currently pending before the court. Trial is scheduled for November, 2018.
- Edible International, LLC et al v. Google, LLC (D. Conn. 2018). We represented **Google, LLC** in a case involving allegations of trademark infringement, trademark dilution, and unfair competition, brought by a customer of Google's advertising services. We successfully won a motion to compel the dispute to arbitration.
- Moldex-Metric, Inc. v. McKeon Products, Inc. (9<sup>th</sup> Cir. 2018). We represented **Moldex-Metric, Inc.**, which manufactures ear plugs. Since 1982, Moldex has made a specific ear plug in a lime-green color. Over the years, that color became associated with Moldex and Moldex claimed to have a common-law trademark on the color. Years later, McKeon Products began to sell an ear plug in a nearly identical color. Moldex-Metric sued in the U.S. District Court for the Central District of California. McKeon defended by arguing that the lime-green color is functional (insofar as it allows for easy visibility) and therefore is ineligible for trademark protection. The district court granted summary judgment to McKeon, and Moldex appealed. In an unpublished 2-1 decision, the Ninth Circuit vacated, ruling that the district court had failed adequately to consider the U.S. Supreme Court's decision in Qualitex. On remand, the district court again granted summary judgment to McKeon, purporting to distinguish Qualitex. Moldex again appealed, and on June 5, 2018, in a published decision, a different panel of the Ninth Circuit vacated and remanded, holding that the issue of functionality cannot be determined on summary judgment in the context of this case, and more specifically that the availability of alternative colors that are equally visible as Moldex's lime-green shade must be considered by the factfinder.

- Apple v. Samsung (Fed. Cir. 2015). We represented **Samsung** in its high-profile litigation brought by Apple that, among other claims, alleged infringement and dilution of Apple's alleged trademark and trade dress rights in its iPhone and iPad products. After discovery, Apple abandoned all of its iPhone infringement claims, but continued to pursue its iPhone trade dress dilution claims and iPad trade dress infringement and dilution claims. At trial, we obtained a defense verdict in Samsung's favor on Apple's iPad trade dress claims. On appeal, in a landmark Federal Circuit decision, we invalidated Apple's iPhone trade dresses, both registered and unregistered, in their entirety on functionality grounds. 786 F.3d 983 (Fed. Cir. 2015).
- American Airlines, Inc. v. Despegar.com USA, Inc., et al. (S.D. Fla. 2016) We represented **Despegar.com** in a false advertising lawsuit brought by American Airlines. Just before initiating suit, American withdrew its tickets from all of Despegar's websites throughout the world. In addition to mounting a vigorous defense against American's claims, we brought an antitrust counterclaim on behalf of Despegar's U.S.-based subsidiary relating to American's anticompetitive air fare distribution scheme. On the eve of depositions we obtained a favorable settlement agreement which paved the way for Despegar to resume selling American tickets.
- Federal Treasury Enterprise Sojuzplodoimport v. Spirits Int'l B.V. (2d Cir 2016). We represent a Russian government agency, **Federal Treasury Enterprise Sojuzplodoimport (FTE)**, which is seeking to establish that it is rightful owner of the world-famous Stolichnaya trademarks. The district court dismissed FTE's trademark infringement claims for lack of standing, ruling that the Russian Government's assignment of its ownership interest in the trademarks to FTE violated *Russian* law and was therefore invalid. We obtained unanimous reversal in the Second Circuit. The panel held that the district court violated principles of international comity and the act of state doctrine by even considering the validity of the Russian Government's actions under Russian law. As a result, the panel reversed the district court and reinstated FTE's trademark infringement claims.
- Mattel, Inc. v. Excite Inc. (C.D. Cal. 2016). We represented **Mattel** in a suit for infringement and dilution of Mattel's famous BARBIE trade dress. Suit settled on favorable terms that included a permanent injunction.
- WildFireWeb, Inc. v. Tinder Inc. and IAC/Interactive Corp. (C.D. Cal. 2015). We represented **Tinder, Inc. and IAC/InteractiveCorp** in a trademark infringement lawsuit brought by a website designer called WildFireWeb, which had a prior federal registration in a "Tinder" trademark for one of its product offerings. The plaintiff alleged substantial actual confusion resulting from Tinder's use of its name for its hugely popular social media application, and sought an order requiring Tinder to change its name. Despite the similarity between the parties' marks and the evidence of alleged actual confusion, we obtained a highly favorable settlement for Tinder that has allowed Tinder to continue to own and use its valuable mark.
- Exclaim Marketing, LLC v. DIRECTV, LLC (E.D. N.C. 2015). We represented **DIRECTV** in a case brought by Exclaim Marketing involving unfair and deceptive trade practices and cross-claims for trademark infringement. After a seven-day jury trial

and post-trial briefing, we not only obtained a complete defensive victory for DIRECTV, but also won substantial damages and a sweeping nationwide permanent injunction against Exclaim.

- Chih Lin v. American Rena (Los Angeles Superior Court 2014). We defended **American Rena International Corporation** in a \$25 million breach of contract and fraud lawsuit brought by a former sales representative, defeated the suit on summary judgment, and won summary judgment of liability on American Rena's cross-complaint for trademark infringement. At the damages trial, we obtained an award of the former sales representative's profits, together with American Rena's attorney's fees and costs.
- J. Christopher Burch, et al. v. Tory Burch, et al. (Del. Ch. 2013). In less than four months, we achieved a highly favorable settlement for **Chris Burch** and his new fashion brand, **C. Wonder**. After Mr. Burch was blocked from selling his interests in Tory Burch LLC—the successful label he co-founded—by Tory Burch and other directors of the Company, we brought claims for breach of fiduciary duties in Delaware Chancery Court before Chancellor Strine. We then pursued an aggressive litigation strategy by convincing Chancellor Strine to grant expedited discovery and proceedings, thereby forcing the company to face the prospect of a trial in six months, or else accept a settlement on unfavorable terms. The confidential settlement resulted in the dismissal of the company's trade dress allegations, and enabled Mr. Burch both to consummate a sale of his interests in Tory Burch LLC in a very successful M&A transaction, and to operate C. Wonder free from the cloud of Ms. Burch's interference.
- Apple v. Samsung (District Court Düsseldorf 2013). We obtained a full defense victory for **Samsung** against Apple in German proceedings regarding various smartphones, defeating alleged unfair competition claims.
- Jurin v. Google Inc. (E.D. Ca. 2012). We won a complete summary judgment for **Google Inc.**, by which all remaining claims that decorative home trim supplier Daniel Jurin had asserted based on Google's advertising programs and trademark policies were dismissed with prejudice. In a comprehensive opinion, the Court held that Google was not liable for trademark infringement (whether direct, contributory, or vicarious) or dilution. The summary judgment order was the ultimate victory in a string of successful motions for Google. At the pleading stage, Quinn Emanuel obtained dismissal of Jurin's state law negligent and intentional interference with contractual relations and prospective economic advantage claims, as well as his unjust enrichment and breach of contract claims. Google also obtained its costs and fees under Rule 41(d) after Jurin refiled his case in the Eastern District of California after having dismissed a similar complaint against Google in the Central District of California without prejudice.
- adidas America, Inc. and adidas AG v. Wolverine World Wide, Inc. (D. Oregon 2012). We represent **Wolverine Worldwide, Inc.**, manufacturers of casual footwear under well-known brands such as Merrill, Patagonia and Hush Puppies, in a suit brought by adidas America, Inc. in the U.S. District Court of Oregon alleging that certain styles of athletic shoes put out by Wolverine infringe and dilute adidas' Three Stripe trademark.

- Google AdWords litigation. Since 2009 we have represented, and continue to represent, **Google Inc.** in a number of actions primarily alleging trademark infringement in connection with its offering advertisers the opportunity to bid on keywords that include third-parties' trademarks to trigger advertising. In five of those cases—Ascentive LLC v. Google Inc. (E.D. Pa.); Dazzlesmile v. Epic Advertising (D. Utah); Flowbee Int'l, Inc. v. Google Inc. (S.D. Tx., transferred, on our motion, to N.D. Cal.); Groupion, LLC v. Groupon Inc. (N.D. Cal.); and Soaring Helmet Corp. v. Nanal, Inc. (W.D. Wa.)—the plaintiffs voluntarily dismissed their claims from Google; they simply walked away with no payment or settlement agreement from Google, usually after the first motion we filed in each case. In another case, Jurin v. Google Inc. (E.D. Cal.), we made several successful motions to dismiss, which narrowed the scope of the case, and then obtained summary judgment on all remaining claims.
- Uggiebo Clogs, LLC v. Deckers Outdoor Corporation (D. Minn. 2011). We represented **Deckers Outdoor Corporation** (“Deckers”) in a suit in which Uggiebo Clogs, a Swedish clog manufacturer, claimed that its designation UGGLEBO had priority over the Deckers’s UGG trademark and sought to enjoin the sale of UGG-brand boots nationwide; Deckers filed counterclaims alleging that Deckers had priority and Uggiebo Clogs was, in fact, the infringer. After successfully moving to amend its counterclaims to add a breach of contract claim that would have entitled Deckers to immediate injunctive relief and attorneys’ fees, the parties settled on terms favorable to Deckers.
- Mattel, Inc. v. MGA Entertainment, Inc. (C.D. Cal. 2010). On the trade dress claims in this wide-ranging action, we succeeded in obtaining summary judgment on behalf of **Mattel** in defense of MGA’s trade dress infringement and dilution claims concerning Mattel’s packaging for various Barbie and “Wee 3 Friends” dolls. The trial court agreed that MGA’s asserted trade dresses, including a registered trade dress, were not protectable on two independent grounds; they had not acquired secondary meaning and were functional. The trial court also agreed that even if the trade dresses were valid, there was no likelihood of confusion, and therefore no infringement. In addition, the trial court found the asserted packaging ineligible for protection under the dilution statute and found that Mattel’s accused packaging could not dilute MGA’s as a matter of law because it was too dissimilar.
- Deckers Outdoor Corporation v. Tom Romeo and Romeo & Juliette, Inc. (C.D. Cal. 2010) and Deckers Outdoor Corporation v. Emu Australia, Inc. (C.D. Cal. 2010). We represented **Deckers** in two disputes involving trademark rights associated with Deckers’s famous and popular UGG-brand boots. In the Romeo action, we brought claims against the manufacturer and seller of BearPaw boots—shoddy imitations of Deckers’s most popular boots, including the Classic, the Cardy, and the Sundance II—for trade dress infringement. In the Emu Australia action, we brought claims against Emu, a manufacturer and seller of pull-on sheepskin boots, for referring to its own boots as “ugg boots” on its website—a blatant attempt to “genericize” the UGG trademark and deprive Deckers of its long-standing U.S. trademark rights in the designs. The firm successfully moved to dismiss Romeo & Juliette’s counterclaims, and successfully the defendants in both actions to voluntarily withdraw multiple affirmative defenses. Both cases thereafter settled on favorable terms.

- Major League Baseball Properties, Inc. v. The Upper Deck Company (S.D.N.Y. 2010). We represented **The Upper Deck Company** (“Upper Deck”) in a lawsuit brought by Major League Baseball Properties, Inc. (“MLBP”) in a trademark dispute over baseball trading cards. MLBP sought a TRO against Upper Deck, alleging that Upper Deck infringed MLBP’s trademarks and trade dress, and breached its contract with MLBP, by selling certain baseball card sets in early 2010 after a license between the parties had expired. Specifically, MLBP sought an injunction barring the sale of three sets of baseball cards that had already been released to Upper Deck distributors. Quinn Emanuel opposed the TRO, arguing that Upper Deck’s use of baseball players in uniform was a fair use of MLBP’s trademarks and trade dress in baseball cards, and that MLBP had not established irreparable injury, given that a license previously existed between the parties. After reviewing Quinn Emanuel’s briefing, MLBP’s motion for a TRO was denied by Judge Sweet, and Upper Deck was able to continue selling its already-released baseball trading sets unencumbered. The parties settled the action shortly after Judge Sweet’s denial of the TRO.
- Louis Vuitton Malletier, S.A. v. Hyundai Motor America (S.D.N.Y 2010). We represented **Hyundai Motor America** (“Hyundai”) in a dispute concerning the use of a basketball bearing a parodic design of Louis Vuitton’s “LV” design trademark in a television commercial for the 2010 Hyundai Sonata. While Louis Vuitton alleged in its complaint that this use constitutes trademark infringement, the use of the LV design was less than one second long and couched in a 30-second commercial that portrayed humorous combinations of ordinary activities with luxury experiences. Hyundai’s defenses included important discussions of parody, satire, trademark fair use and the First Amendment and led to a favorable settlement agreement for Hyundai.
- Miller International, Inc. v. Clinch Gear, Inc. et al. (D. Colo. 2010). We represented **Collective Brands Inc.** in a dispute between two trademarks: CINCH and CLINCH GEAR. Miller is the owner of CINCH, a trademark used in association with jeans, button-down shirts and marketed exclusively toward rodeo and western-wear enthusiasts. Collective Brands is the owner of CLINCH GEAR, a trademark used in association with mixed-martial arts (“MMA”), grappling, and wrestling performance gear, and marketed exclusively toward MMA athletes and enthusiasts. In defending Collective Brands, we first successfully moved the Court to dismiss six of Miller’s claims, including fraud, conspiracy, and alter-ego liability. Next, we convinced the Court that Miller’s motion for a preliminary injunction was premature, and as a result, the Court instructed Miller to withdraw its motion. The parties then settled on terms favorable to Collective Brands.
- Coty Inc. v. Harvey P. Alstodt; Bruce C. Kowalsky; Diversified Beauty Products (f/k/a MBA Beauty, Inc.); and Harvey P. Alstodt Associates, Inc. (N.Y. State Supreme Court 2010). We obtained a TRO against two former executives of client **Coty, Inc.**, stopping them from violating their covenant not to compete by marketing a nail polish line which, “coincidentally,” consisted of many colors identical to Coty’s line.
- Fifth Avenue of Long Island Realty Associates v. Caruso Management Company, Ltd. (E.D.N.Y. 2010). After a six-day bench trial, we obtained a complete defense victory for **Caruso Management Company, Ltd.** in a trademark infringement action brought in

the Eastern District of New York. The Court not only found that Caruso did not infringe or dilute any of Plaintiff's trademarks, but granted Caruso's counterclaim and canceled Plaintiff's federal registration of the AMERICANA mark. This lawsuit, which sought disgorgement of profits and a permanent injunction preventing Caruso from using the name THE AMERICANA AT BRAND for its town center development in Glendale, California, was critically important to Caruso since the Plaintiff strategically filed suit a few short months before Caruso's town center was scheduled to open to the public, and after a significant amount of time and money had been invested in promoting THE AMERICANA AT BRAND name throughout the Los Angeles area.

- Rosetta Stone Ltd. v. Google Inc. (E.D. Va. 2010, 4th Cir. 2012). At the pleading stage, Quinn Emanuel obtained dismissal of Rosetta Stone's false endorsement claim under 15 U.S.C. 1125(a) and its state law business conspiracy and unjust enrichment claims. We then won a complete summary judgment for **Google Inc.**, by which all remaining claims that language software provider Rosetta Stone had asserted based on Google's advertising programs and trademark policies were dismissed with prejudice. In a lengthy opinion, the Court held that Google was not liable for trademark infringement (whether direct, contributory, or vicarious) or dilution. On appeal, the Fourth Circuit upheld the ruling on vicarious infringement and dismissal of the unjust enrichment claims, agreed with our legal analysis of the dilution claim, and found disputed issues of fact on the direct and contributory infringement claims and remanded those issues. We then moved in limine to lay the grounds for a new summary judgment motion. Following argument on that motion, the case quickly resolved.
- Dallas Cowboys Football Club and NFL Properties v. America's Team Properties (N.D. Tex. 2009). We obtained summary judgment for clients the **Dallas Cowboys** Football Club and NFL Properties LLC in a dispute concerning ownership of the trademark **AMERICA'S TEAM** in federal district court in Dallas, Texas. The Defendant in the case, a Minnesota-based company, claimed that it owned the rights to the famous trademark because it had obtained a federal registration in 1990. We were tasked with proving that the Cowboys rights in "America's Team" were superior to those of Defendant, notwithstanding that the Cowboys did not own a federal trademark registration for the mark. In a forty-page decision the Court granted the Cowboys and NFL Properties summary judgment on all claims, finding that they had proven federal and common law trademark infringement, unfair competition, dilution and that Defendant had committed fraud on the United States Patent and Trademark Office. America's Team—a nickname understandably despised by rivals of the Dallas Cowboys—remains today, as it has been for decades, an enduring part of the Cowboys' great legacy.
- George V Restauration S.A. and Creative Designs for Restaurants and Bars, Ltd. v. Little Rest Twelve, Inc. (N.Y. App. Div. 1st Dept.). We represented **George V** and **Creative Designs**, owners of the world-famous (and federally-registered) **BUDDHA-BAR** trademark and proprietary restaurant concept in a case brought against their former licensee for trademark infringement and dilution regarding their unauthorized use of the BUDDHA BAR trademark and concept in connection with a Manhattan restaurant. The Appellate Division of the Supreme Court, First Department, reversed the trial court's denial of our clients' motion for preliminary injunction and held that the

small disclaimer placed on defendant's website was not sufficient to dispel likely consumer confusion.

- adidas America, Inc. v. Payless ShoeSource, Inc. (9<sup>th</sup> Cir. 2009). We represented **Payless ShoeSource, Inc.** on the appeal to the Ninth Circuit of a jury verdict rendered against it in the United States District Court for the District of Oregon finding that Payless infringed adidas' trademark and trade dress and awarding adidas over \$66 million dollars in damages. On appeal, Payless argued that the district court erred by, *inter alia*, allowing the jury to hear consumer survey evidence that tested allegedly infringing shoes put out by manufacturers other than Payless, by permitting monetary damages for post sale confusion absent a showing of any actual injury and based upon a reasonable royalty theory and by failing to dismiss adidas' trademark dilution claims because Payless used the allegedly infringing stripes as decoration. Although the case settled before the argument, we helped Payless reduce the largest trademark verdict in history.
- Pro-Football, Inc. v. Harjo (U.S. Supreme Court 2009). In defending the long-running challenge by six Native American petitioners to the **Washington Redskins'** trademark registrations, we employed the infrequently used "de novo" appeal to the D.C. District Court to overturn an adverse decision by the Trademark Trial and Appeal Board. The decision was appealed by the Native Americans to the D.C. Circuit, which found no abuse of discretion and affirmed the grant of summary judgment in all respects. The petitioners next filed a petition of certiorari with the U.S. Supreme Court, arguing that the Circuit Courts are split as to whether laches is available as a defense to the cancellation of an allegedly disparaging trademark. Quinn Emanuel opposed the petition, arguing that no such split existed. The U.S. Supreme Court denied the petition in November 2009, thus ending the case. It was a complete win for Quinn Emanuel's clients Pro-Football and the Washington Redskins.
- PlayShare PLC v. Societe des Bains de Mer et du Cerle des Estrangers a Monaco (S.D.N.Y. 2008). We represented Société des Bains de Mer et du Cercle des Etrangers à Monaco ("SBM"), the founder and manager of Monaco's five casinos, including the famous **Casino de Monte-Carlo**, in an action against PlayShare, an online casino gaming operating operator in the District Court for the Southern District of New York. SBM alleged that the PlayShare's Grand Monaco Casino website and use of at least 100 domain names employing the terms "Monaco," "Monaco Casino," or variations thereof in connection with the online casino website constitutes unfair competition, trademark infringement, and cybersquatting. Our representation led to a quick and favorable settlement agreement for SBM.
- Yuri Kucklachev v. Mark Gelfman (E.D.N.Y. 2008). We represented **Ticketmaster L.L.C** ("Ticketmaster") in an action for trademark and copyright infringement, unfair competition, and violations of the right of publicity, brought by Plaintiffs, who purport to be world famous clowns, brought this action against the Gelfman Defendants, the plaintiff's former U.S. promoter. The complaint alleges that in 2007, after the Plaintiffs returned to Russia after a successful U.S. tour their show entitled "Moscow Cats Theatre," the Gelfman defendants misappropriated the Plaintiff's show, including its title and copyrighted cat-tricks, conducting performances in the United States without

Plaintiffs' consent. Ticketmaster was among a set of named Defendants who unknowingly sold tickets to the allegedly infringing show. Plaintiffs moved for a preliminary injunction prohibiting all of the Defendants from continuing to sell tickets to the allegedly infringing show. On the strength of the briefing submitted by Quinn Emanuel on behalf of Ticketmaster, the Court denied Plaintiffs' request for injunctive relief against Ticketmaster and Defendant Onlineseats.com (who had not yet appeared in the action, but was deemed to be similarly situated to Ticketmaster) on the grounds that that Plaintiffs failure to put Ticketmaster on notice of the alleged infringement for well over a year precluded the possibility of injunctive relief. An injunction did issue, however, against all of the other appearing Defendants.

- Argus Research v. Argus Media (D. Conn. 2008). We were retained by the board of an **English publishing company** when trademark and fraud claims filed by a U.S. equity research firm proved intractable. With our client's regular IP counsel, we conducted depositions to support a successful multi-faceted motion gutting all but a single claim, and moved in limine to strike all three of the plaintiff's experts. The case settled shortly thereafter with a global co-existence agreement and no payment by our client.
- CMG Worldwide v. The Upper Deck Company (S.D. Ind. 2008). We defended **Upper Deck** in a suit alleging the use of various images and signatures of deceased baseball players that had previously been licensed to Upper Deck but were then exclusively licensed to Topps. We were hired after a TRO issued enjoining our client's usage of certain player images in its entire line of 2008 trading cards. We succeeded in overturning the TRO several days later, persuaded the court to transfer the case from Indiana to New York, and moved to dismiss the plaintiff's claims, which motion is pending.
- The Romantics v. Activision Publishing, 532 F. Supp. 2d 884 (E.D. Mich. 2008). We defeated a lawsuit seeking to enjoin **Activision's** sales of its phenomenally popular "Guitar Hero" videogame, brought by members of the '80s rock band "The Romantics," who asserted that the use of their signature song "What I Like About You" in the game violated their rights of publicity and constituted an implied endorsement. We later secured a complete dismissal on the merits, effectively validating the business model underpinning the billion-dollar "Guitar Hero" franchise. *See* 574 F. Supp. 2d 758.
- Gillette v. Dorco (D. Mass. 2008). Representing **Pace Shave** and various **Dorco** entities as defendants, we successfully obtained an early, cost-effective global settlement in a razor-industry litigation involving eleven patents spanning over 250 claims, as well as numerous assertions of trademark and trade dress.
- Bouchat v. Bon-Ton Department Stores (4th Cir. 2007). In the first phase of this case, we defended the **NFL** and **Baltimore Ravens** against claims brought by an artist regarding the Raven's helmet logo. After the NFL and Ravens – represented by a different firm – lost on liability, we tried the damages case. We obtained a verdict of no damages and persuaded the jury that the logo did not derive any revenue-generating activity and that our clients' large revenues were solely the result of the inherent power of the NFL brand and the sport itself. The verdict was affirmed by the Fourth Circuit

and the Supreme Court denied *cert.* Later, we prevailed on behalf of hundreds of licensees in separate actions on the basis of claim preclusion principles, again through the 4th Circuit and the U.S. Supreme Court.

- Applied Information Sciences v. eBay Inc. (C.D. Cal., 9th Cir. 2007). We obtained summary judgment for **eBay** against trademark infringement and unfair competition claims related to its use of the terms “Smart Search” as the label for a hyperlink on its Web site home page. The Ninth Circuit affirmed summary judgment in eBay’s favor. 511 F.3d 966 (9th Cir. 2007).
- Omicron Capital v. Omicron Capital (S.D.N.Y. 2006). We obtained summary judgment dismissing all trademark infringement and unfair competition claims asserted against **Omicron Capital**, a St. Louis-based mortgage finance company, by a New York hedge fund with the identical name and trademark. The opinion provides a comprehensive tutorial on the burdens of proof in trademark litigation and was featured on the front-page of the *New York Law Journal*. *See Omicron Capital LLC v. Omicron Capital LLC*, 433 F. Supp. 2d 382 (S.D.N.Y. 2006).
- The Franklin Mint v. Lord Simon Cairns, The Diana, the Princess of Wales, Memorial Fund (C.D. Cal. 2006). We represented the Board of Trustees of a charitable fund established to honor the memory of **Princess Diana** in a \$400 million malicious prosecution suit filed in California against the Fund’s prior outside counsel and the Trustees. The suit alleged that infringement and right-of-publicity claims unsuccessfully pursued in 1998 in an effort to stop The Franklin Mint from marketing dolls and plates commemorating the deceased Princess were frivolous. All claims against the Fund’s clients, who included Princess Diana’s sister and the Bishop of London, were withdrawn prior to trial in return for a commitment by the Fund and the Mint to carry out a mutually-agreed program of charitable giving to worthwhile causes.
- Helio LLC v. Palm, Inc. (N.D. Cal. 2006). We brought holiday good cheer to **Palm**, winning a dismissal with prejudice in a trademark and false advertising suit brought two days before Christmas.
- Shell Oil v. Shell-oil.biz and Shell Oil v. Shell-oil.org (E.D. Va. 2006). We represented **Shell Oil** in two trademark infringement anti-dilution and anti-cybersquatting cases against foreign entities operating infringing Web sites. Such suit resulted in a permanent injunction against the defendants and a transfer of the defendants’ illegal domain names to Shell.
- H&R Block v. Intuit (E.D. Mo. 2006). In a false advertising and trademark infringement suit brought by its chief competitor, H&R Block, we represented **Intuit** in defeating efforts to secure injunctive relief and obtaining a favorable settlement.
- Intuit v. H&R Block (N.D. Cal. 2006). We also represented **Intuit** in a copyright infringement, trademark infringement and false advertising suit against H&R Block arising out of Block’s arising of a knock-off television advertisement. The case settled favorably, with the offending television advertisement being withdrawn.

- Hawaii-Pacific Apparel Group, Inc. v. Cleveland Browns Football Co. (S.D.N.Y. 2006). In a dispute that hounded the **Cleveland Browns** for over a decade, the court granted the **Browns'** and **NFL's** motion for summary judgment, finding that the Browns have priority of use over an apparel company in the trademark DAWG POUND. The decision recounted the history of the "Dawg Pound," which today primarily refers to the rowdy area of the bleachers and the seasoned fans who sit there (often in dog masks), but which was originally used to describe the Browns' defensive linesmen, who would bark and growl at their adversaries.
- Funky Films, Inc. v. Time Warner Entertainment Co., 462 F.3d 1072 (9th Cir. 2006). On behalf of **Time Warner Entertainment** and **HBO**, we won a summary judgment dismissal of copyright and trademark infringement claims valued in excess of \$50 million challenging the originality of the popular hit series "Six Feet Under." Our win was later affirmed by the Ninth Circuit in an oft-cited ruling articulating the application of copyright law to television and film properties.
- Playmakers LLC v. ESPN (9th Cir. 2006). We won a reverse-confusion appeal for **ESPN** against a claim that a sports agency with a federal registration for PLAYMAKERS had priority over ESPN's use of "Playmakers" for its popular television program.
- C.V. Starr & Co. v. American International Group (S.D.N.Y. 2006). We defeated a motion to dismiss our client **AIG**'s counterclaim for trademark infringement concerning the ownership of the CV Starr brand in an action filed by the company controlled by former AIG head, Hank Greenberg. The case subsequently settled.
- Harlan v. Agenjca Wydawniczo-Reklamowa "Wprost" Sp.Zo.o (D.S.C. 2006). Representing **Wprost**, a Polish national news magazine akin to *Time* or *Newsweek*, against claims by the daughter of a prominent Polish politician that facts published about her father's involvement in a controversial stock purchase were false. The case was dismissed when it was shown that the court could not exercise personal jurisdiction over *Wprost*, and that the magazine's website, written almost entirely in Polish, was not targeting readers in South Carolina, where the suit was brought.
- Nike v. Adidas (D. Or. 2006). After Adidas prevailed on claims in Europe that **Nike's** use of two stripes on apparel infringed Adidas's three-stripe trademark, we filed a complaint on Nike's behalf in the District Court of Oregon seeking a declaration that Nike was entitled to use two stripes and other decorative striping on apparel and footwear in the United States. When we positioned the case to put the scope of Adidas's three-stripe mark at issue, Adidas conceded the case and filed a broad covenant not to sue Nike in the United States.
- SightSound Technologies v. Napster (D. Del., TTAB 2006). In litigation before the District of Delaware and TTAB involving the intersection of trademark and bankruptcy law, we defeated assignment-in-gross challenges asserted against the validity of **Napster's** federal registrations for, and its ownership rights to, the NAPSTER marks that had been acquired in Chapter 11 proceedings.

- LowerMyBills v. NexTag (C.D. Cal. 2005). We represented **NexTag** in a case involving allegations of trademark and copyright infringement in online advertisements. The case settled favorably to NexTag.
- David Kramer v. Intuit, 121 Cal. App. 4th 574 (2004). We prevailed on behalf of **Intuit** in an unfair competition and false advertising case that resulted in the first California appellate decision addressing the subject of illegal rebates under the California Consumer Legal Remedies Act.
- Mattel v. BBurago S.p.A. (N.D. Ill., C.D. Cal. 2004). We obtained the dismissal with prejudice of a suit brought against **Mattel** by BBurago in the Northern District of Illinois alleging trade dress infringement of its scale die-cast replica cars and false advertising. In addition, in actions in the Central District of California and Italy involving FERRARI patent, trademark and trade dress rights, we obtained a final judgment on behalf of Mattel that included a worldwide injunction against infringement and payment of monetary damages in a confidential amount.
- Delphi Consulting v. Borland (N.D. Cal. 2004). We successfully defended **Borland** against a suit asserting Lanham Act and related claims in connection with computer programming software. After winning summary judgment on key aspects of the plaintiff's case and obtaining favorable in limine rulings, including an order precluding the plaintiff's damages expert from testifying on *Daubert* and other grounds, we settled the case on terms favorable to our client.
- Century 21 Real Estate v. Lending Tree (D.N.J., D. Colo. 2003, 2005). We represented **Lending Tree** in New Jersey and Colorado suits brought by archrivals Cendant and Re-Max challenging Lending Tree's advertising of its innovative online real estate broker referral network as false and deceptive. We ultimately persuaded the Third Circuit to adopt a form of "nominative use" doctrine as a defense in the context of trademark and advertising claims brought under Section 43(a) of the Lanham Act. *See* 425 F.3d 211 (3d Cir. 2005).
- International Bancorp, LLC v. Société des Bains de Mer et du Cercle des Étrangers à Monaco (4th Cir. 2003). On behalf of Monaco's resort arm, we won an injunction against an online gambling site trading on the equity of Monaco's famous **Casino de Monte Carlo** and an affirmance by the 4th Circuit.
- Mattel v. Artin (C.D. Cal. 2002). On behalf of **Mattel**, we obtained a multi-million dollar verdict, permanent injunction and award of attorneys' fees in a trade dress infringement action involving the HOT WHEELS packaging trade dress.
- Amanda Blackhorse v. Pro Football, Inc. This TTAB action to cancel the trademark registrations of the Washington Redskins for Redskins on the basis that they disparage Native Americans had been stayed pending resolution of the Suzanne Harjo case, which we won. The parties recently filed trial memoranda and a trial hearing will be scheduled soon.

In addition to litigation before federal courts, we also have represented clients in other adversarial contexts. Recent examples include the following:

- On behalf of the **Producers Guild of America**, in 2011 we obtained the first-ever “No Action” letter from the Antitrust Division of the Department of Justice respecting a certification mark. Because actors, financiers, lawyers and others often request “producer” credits for motion pictures, the PGA wanted to find a way to inform the public who has actually performed a producer’s duties with respect to any given motion picture. It therefore proposed to perform that investigation and allow the actual producers to use its certification mark with their names in the credits. The PGA is not, however, a bargaining unit and could not compel the motion picture studios to use the mark and, believing that “no good deed goes unpunished,” the studios were reluctant to include the certification mark out of antitrust concerns. We persuaded the Antitrust Division that the use of the certification would benefit competition and most major studios have now agreed to include the PGA’s certification mark in credits and advertising.
- On behalf of the **Academy of Motion Picture Arts and Sciences**, we are challenging a “drafter’s error” affecting the Lanham Act in a proceeding before the Trademark Trial and Appeal Board. When Congress amended Section 43(c), 15 U.S.C. Section 1125(c), to provide that the federal registration of a mark would provide an absolute defense to any claim that the registered mark dilutes a mark that is either unregistered or registered only under state law, the amendment was somehow repunctuated during the process of enactment. As a consequence, Section 43(c)(6)(A)(ii) now purports to make registration a defense to a claim that a newly registered mark dilutes famous marks registered years ago. We have pointed to the change in punctuation that occurred, the understanding of the bill’s drafters that such claims would remain viable, and inconsistencies between the amendment and other sections of the Lanham Act.