

Attorney Bio.

Patricia A. Martone



PARTNER

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Patricia A. Martone is a trial lawyer with more than 30 years of experience litigating intellectual property cases. She specializes in cases that involve cornerstone IP, high-stakes patent cases, and global litigation. She represents plaintiffs and defendants in federal, and appellate courts throughout the U.S. Her clients in the U.S., Japan, and Europe have included Aisin AW, British Telecommunications, Casio, Plasma Physics, Ricoh, Sanyo Electric, and Solar Physics.

Ms. Martone has tried 12 cases to verdict or judgment. Her trial experience encompasses patent and trademark infringement cases as well as commercial litigation. She played a leading role for Polaroid in the landmark patent infringement liability and damages trials in *Polaroid v. Kodak*, which still holds the record for largest damages award ever paid in a patent case at over \$900 million. Her groundbreaking work in the courtroom and legal arguments at the damages trial defeated Kodak's main defense and helped establish many of the standards by which damages are calculated in patent cases.

Her trial experience includes other seminal IP and commercial cases including the *NBA v. Motorola, et al.*, a widely publicized case concerning the protectability of on-line content. Her closing argument after trial and appellate briefing led Motorola to a complete victory, defeating the NBA's efforts to assert a protectable ownership interest in basketball scores and statistics displayed on a paging device. Ms. Martone also served as lead counsel representing Plasma Physics and Solar Physics in more than 20 patent infringement suits involving seminal inventions in the fields of semiconductor manufacturing processes and display technology. She successfully resolved the litigations brought by her client against 20 semiconductor wafer and flat panel display manufacturers, as well as the cases brought against her clients by suppliers to the defendants. In the end, she licensed more than ninety percent of the amorphous silicon flat panel display market, and the world's largest manufacturers of semiconductor wafers in a program profiled by *EE Times* and *Corporate Counsel*. In *British Telecom v. Verizon, et al.*, she was lead counsel in six plaintiff cases and three equipment manufacturer defense cases and successfully licensed British Telecom's groundbreaking "blown cable" patents, which provided new technology for the installation of fiber optic cable. This technology was so innovative that its invention was recognized by Queen Elizabeth II with her Technology Award.

This is MoFo.

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While IP cases usually resolve before trial, Ms. Martone litigates every case as if it will go to trial, taking into account the value of the case to her client. Her strategic and tactical litigation and courtroom expertise informs her abilities as a highly



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effective negotiator. Over the past 10 years, she has negotiated settlements that have yielded over \$180 million in licensing fees for her clients. She has personally closed more than 40 license agreements. She is also experienced in resolving, through negotiation or litigation, contract claims and defenses arising out of patent license agreements.

Ms. Martone is a Fellow of the Litigation Counsel of America, a trial lawyer honorary society, and perennially ranked as a leader in the field of intellectual property law by publications such as *Chambers Global*, *Best Lawyers in America*, *Who's Who Legal*, and *Legal 500*. *Chambers Global*, in its rankings, describes Ms. Martone as having an "impressive international IP practice... 'she is very eager and committed to protecting her clients' interests'." Prior to joining Morrison & Foerster, she was with Ropes & Gray, where she was the co-head of that firm's International Practice group. From 1983-2005, Ms. Martone was a partner at Fish & Neave.

Honors & Awards

- < *Chamber Global* (2011) – Intellectual Property Patents Regional Expert: Japan
- < *The Best Lawyers in America* (2003-2011)
- < *New York Super Lawyers* (2006-2011)
- < *Litigation Counsel of America* (Trial Lawyer Honorary), Fellow
- < Who's Who Legal – The International Who's Who of Patent Lawyers (2010-2011)
- < *The Legal 500 US* (IP Patent Licensing: National) (2010)
- < Honored by New York Lawyers for the Public Interest in 2006 for service to the organization
- < Recipient, 2009 Women of Power & Influence Award, National Organization of Women, NYC Chapter
- < New York Bar Foundation, Fellow
- < Who's Who in America

Professional & Civic Activities

- < Adjunct Professor of Law, New York University School of Law (1990-present)
- < Board of Directors, New York Lawyers for the Public Interest, 1988-2006 (Chair, 1996-98; Vice Chair, Development, 2002-2005). Joined Emeritus Board in 2006
- < Board of Directors, Legal Services of New York (1991-1995)

Speaking Engagements

- < *Strategies for Enforcing Essential Patents in the United States (speaker) ; Developments in Japanese Patent Law (panelist)*, Fordham Intellectual Property Institute, 18th Annual Conference Intellectual property Law and Policy, New York, New York (April 8-9, 2010)
- < *Multi-Jurisdictional Litigation*, Joint Seminar with Nishimura & Asahi, Tokyo, Japan (March 4, 2010)
- < *Policy Interplay Between IP Rights and Antitrust/Competition (Panelist); Standards (Panelist)* Fordham Intellectual Property Law Institute, Seventeenth Annual Conference on Intellectual Property Law and Policy, Cambridge University, UK (April 15-16, 2009)

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- < *Why Japanese Companies Can Be Comfortable with Jury Trials in the United States*, Joint Seminar with TMI Associates, Tokyo, Japan (October 15, 2008)
- < *Creative Strategies for Plaintiffs in United States Patent Litigation*, National Chiao Tung University, Hsinchu, Taiwan (October 13, 2005)
- < *Patent Misuse*, PLI Program: Intellectual Property Antitrust 2005, New York, New York (June 13, 2005)
- < *Licensing Disputes*, PLI Program: Patents & High Technology Licensing, New York, New York (June 1, 2005)
- < *Patents in the Blue LED Industry, Friend or Foe?*, Blue 2005 LED Industry Conference, Hsinchu, Taiwan (May 18, 2005)
- < *Generating Revenue Through Patent Licensing*, Boston Patent Law Association, Boston, Massachusetts (April 20, 2005)
- < *New York University School of Law*, Adjunct Professor of Law, Patents (2005 to present)

Pro-Bono Litigation

- < Joint Conference for Women's Organizations on the Importance of Being a Volunteer, co-sponsored by the Government of Sicily and the National Organization of Italian American Women, Palazzo dei Normani, Palermo, Sicily (April 2010)

Publications

Book Chapters

- < Strategies for Enforcing Essential Patents in the United States, *Festschrift für Wolfgang vom Meibom zum 65. Geburtstag*, (Carl Heymanns Verlag, 2010)
- < Attorney-Client Privilege and Work Product Immunity, *Patent Litigation* (PLI Press, 2010)
- < Hybrid Licenses and Royalty Agreements, *Drafting License Agreements* (4th Ed., Aspen Publishers, 2008)

Articles

- < The Patent Misuse Defense: Does it Still Have Vitality, *Intellectual Property Antitrust 2005: PLI IP Series, No. G-832* (June 2005)
- < Gentry Gallery and the Written Description Requirements, *International Legal Strategy* (June 2001)
- < Markman Proceeding in Patent Litigation: Current Case Law and Practice, *International Legal Strategy* (April 2001)
- < Doctrine of Equivalents and Prosecution History Estoppel After Festo, *AIPPI*, vol. 46, No. 2 (February 2001)
- < Litigating the Business Method Patent, *Patenting the New Business Model*, PLI IP Series No. G-636, (Winter 2001)
- < U.S. Court Strips Authors of On-line Rights – Newspaper and Magazine Publishers Can Freely Reprint Works in Electronic Form, *IP Worldwide* (January/February 1998)
- < Intellectual Property Protection for Computer Software – As Copyright Protection Narrows, Can Patents Fill the Gap? *Computer Software Protection*, PLI Patent Series No. 479 (1997)

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- < Fundamental Issues in Patent/Technology Licensing, *Understanding The Intellectual Property License*, PLI Patent Series No. 496 (1997)
- < Avoiding Intellectual Property Misuse Problems and Antitrust Violations in Multimedia Licensing,” *Multimedia and Technology Licensing Law Report*, Vol. 1, No. 8 (January 1995)
- < Copyrights in Cyberspace, *National Law Journal* (October 31, 1994)
- < Damages in Patent Cases are Redefined as Courts Weight Market Concepts, *National Law Journal* (October 7, 1991)

Memberships & Affiliations

- < American Bar Association
- < Association of the Bar of the City of New York (Past Member, Committee on Environmental Law; Committee on Trademarks and Unfair Competition)
- < New York Bar Association
- < American Intellectual Property Law Association
- < American Chemical Society
- < Licensing Executives Society
- < New York Intellectual Property Law Association

Bar Admissions

- < New York
- < U.S. Patent and Trademark Office, 1983

Courts

- < Supreme Court of the United States
- < U.S. Court of Appeals for the 1st Circuit
- < U.S. Court of Appeals for the 2nd Circuit
- < U.S. Court of Appeals for the Federal Circuit
- < U.S. District Court for the Eastern District of New York
- < U.S. District Court for the Southern District of New York
- < U.S. District Court for the Eastern District of Michigan
- < U.S. District Court for the Northern District of California
- < U.S. District Court for the District of Colorado

Education

- < 1973, J.D., New York University School of Law; Managing Editor, *Review of Law & Social Change*; Founder's Day Award (top 10% of class)
- < 1969, M.A. (Physical Chemistry), The Johns Hopkins University; National Science Foundation Graduate Traineeship
- < 1968, B.A. (Chemistry), New York University; Washington Square College

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Representative Matters

- < ***Realtime Data, LLC, D/B/A IXO v. Packeteer, et al.***, CA No. 6:08-CV-00144-LED (E.D. Tex.)
Co-lead counsel for Realtime Data in a patent infringement suit in the Eastern district of Texas against four manufacturers of equipment and software and their customers in the WAN Optimization and Application Delivery markets. Obtained favorable *Markman*, pretrial, and summary judgment rulings for Realtime Data. Took the cases through the beginning of trial in January of 2010, and negotiated successful settlements with the remaining defendants after jury selection. These cases established a licensing program for Realtime Data.
- < ***In re: Halftone Color Separations ('809) Patent Litigation***, CA No. 8:08-ML-01926 CJC (C.D. Cal.)
Lead counsel for Ricoh Americas. Successfully settled patent infringement case in a multidistrict litigation about printing technology.
- < ***Sanyo Electric Co., Ltd. v. MediaTek, Inc.***, CA No. 05-2580 (C.D. Cal.)
Lead counsel for Sanyo Electric in a patent infringement action brought against MediaTek for infringement of two patents relating to CD-ROM decoder chips. Obtained dismissal of MediaTek's counterclaim for patent infringement on summary judgment. Successfully defeated defendant's motions for non-infringement winning all claim construction issues. Defeated summary judgment motions directed to Sanyo's damages case, establishing the right of a foreign plaintiff to recover lost profits in the United States. The case settled after being fully prepared for trial as part of a global settlement of this case and the Texas case between the same parties. Reported decisions can be found at 2006 WL 454 2736 (C.D. Cal.) and 2006 WL 453 2984. (C.D. Cal.)
- < ***MediaTek, Inc. v. Sanyo Electric Co., Ltd.***, CA No. 6:05 CV 323 (E.D. Tex.)
Lead counsel for Sanyo Electric in a patent infringement action brought against Sanyo for infringement of three patents relating to digital signal processing chips. *Markman* decision was largely favorable to Sanyo. The case settled on the eve of trial as part of a global settlement of this case and the Los Angeles case between the same parties.
- < ***Combined Logic Co. v. Avid Tech., Inc.***, No. 96 CV 4038 (RO), (S.D. N.Y.)
Lead counsel for Avid Technology in a patent infringement action brought against the company for infringement of a patent on an interactive video system. Successfully argued motion to dismiss the case for failure to prosecute. Reported decision can be found at 2004 U.S. Dist. LEXIS 23875 (SDNY Nov. 22, 2004).
- < ***British Telecommunications v. Verizon Communications et al.*** CA 03-528 et al. (D. Del.)
Lead counsel for BT in six patent infringement suits brought by BT against telecom companies for infringement of patents covering the installation of fiberoptic cable. The cases were successfully settled at various stages.
- < ***Sherman & Reilly v. British Telecommunications***, No. 1:03-CV-206 (E.D. Tenn.) and related cases.
Lead counsel for BT in three declaratory judgment litigations arising out of BT's patent infringement suits in Delaware against telecom companies. All were successfully resolved.

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- ⟨ ***Plasma Physics and Solar Physics v. various flat panel and semiconductor makers***, CA 99-8593 (E.D. N.Y.)
Lead counsel for plaintiffs in patent infringement actions brought against 14 major Japanese and Korean manufacturers of semiconductors and flat panel displays. Successfully settled all of the cases, establishing a major patent licensing program for Plasma Physics and Solar Physics.
- ⟨ ***Plasma Physics v. IBM***, CA 02-3463 (E.D. N.Y.)
Lead counsel for Plasma Physics in cases against IBM, AMD, TI, STMicroelectronics, Analog Devices, and Conexant. The cases were filed in June 2002. Successfully settled all cases, some on the eve of trial.
- ⟨ ***Applied Materials v. Plasma Physics, et al.***, CA 00-02199 (E.D.N.Y.)
Lead counsel for Plasma Physics in an action for declaratory judgment of patent invalidity and non-infringement brought by equipment maker whose customers were defendants in case brought by Plasma Physics. Successfully settled the case with no license rights granted to Applied.
- ⟨ ***SEL v. Sanyo***, CA 00-01 (D. Del.)
Co-lead counsel for Sanyo Electric in a suit for infringement of patents alleged to cover liquid crystal displays in popular Sanyo cell phones. The case settled successfully.
- ⟨ ***Yamaichi v. Enplas***, C97-04388 (N.D. Cal.)
Lead counsel for Yamaichi in a patent infringement action brought by Japanese corporation and its U.S. subsidiary against a Japanese corporation and its U.S. subsidiary. Successfully opposed defendant's motion to dismiss the case on forum nonconveniens grounds. Successfully argued *Markman* hearing on claims construction. The case settled successfully.
- ⟨ ***NBA v. Motorola & STATS***, 96 Civ. 1615 (LAP) (S.D. N.Y.)
Bench trial of trademark, copyright, and unfair competition action in April 1996. Handled the bulk of the courtroom work and made the closing argument after trial. Motorola won on all but the unfair competition claim in the District Court, and won on unfair competition in the Second Circuit. Reported decisions can be found at 939 F. Supp. 1071 (S.D.N.Y. 1996); rev'd in part, vacated in part and aff'd in part; 105 F.3d 841 (2 Cir. 1997).
- ⟨ ***Motorola v. Rockwell***, No. 95-575-SLR (D. Del.)
Action for patent infringement of Motorola modem patents. Responsible for damages case and response to Rockwell's defenses based upon Motorola's participation in ITU standard setting process. The case was successfully settled after completion of expert discovery.
- ⟨ ***Scripto-Tokai Corp. v. Gillette Co.*** (C.D. Cal.)
Jury trial of action for declaratory judgment of patent invalidity and non-infringement. Lead counsel for Gillette in its damages case. Won a court ruling entitling Gillette to seek lost profits even though it did not practice the invention of the patent in suit. Examined key witnesses in the liability trial. In late October 1993, the jury found Gillette's patents infringed but invalid. The case settled, and no judgment of patent invalidity was entered, after the court found the patents enforceable and dismissed Scripto-Tokai's antitrust case on summary judgment. Reported decisions can be found at 788 F. Supp. 439 (C.D. Cal. 1992) and 1994-2 Trade Cases ¶70, 821 (C.D. Cal. 1994).

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- ⟨ ***Allied-Signal v. Allegheny Ludlum***, (D. Conn.)
Lead counsel in bench trial of action brought in 1989 to challenge result of interference in the patent office. Successfully defeated Allegheny Ludlum's efforts to dismiss the case, as well as its motion for summary judgment. The case was tried in May 1995, and final arguments were presented to the court. No decision was rendered. The case was settled in 1998. Reported decisions can be found at 132 FRD 134 (D. Conn. 1990) and 29 USPQ 2d 1039 (D. Conn. 1993).
- ⟨ ***American Hospital Supply et al. v. Fisher Scientific Company***, 84-5405 (C.D. Cal.)
Lead counsel for defendant in trial of patent infringement action. The case, which was tried to a jury in January 1987, successfully settled during trial.
- ⟨ ***Pino v. Dalsheim***, (S.D. N.Y.)
Lead counsel for plaintiff in bench trial of prisoner's rights action in 1984. Plaintiff was awarded injunctive relief, expungement of his record, and damages. At the time, Ms. Martone was a partner in the firm of Fish & Neave. The court awarded Fish & Neave its attorneys' fees. The firm also received an award from the Legal Aid Society of New York City for its work on the case. Reported decision can be found at 605 F. Supp. 1305 (S.D.N.Y. 1984).
- ⟨ ***Polaroid Corp. v. Eastman Kodak Co.***, (D. Mass.)
Bench trial of patent infringement case. Seven Polaroid patents were found valid and infringed after the five-month liability trial in 1981. While still an associate, Ms. Martone had a major role before, during, and after the trial in overall case strategy and organization, and writing key briefs. She also argued evidentiary motions and examined a witness at the trial. As a young partner, she had a leading courtroom role in the 1989 damages trial. The court awarded Polaroid \$900 million, and ruled in Polaroid's favor on the issues presented by Ms. Martone at the damages trial, rejecting Kodak's main defense that its entry into the instant photography market benefited Polaroid by expanding the market. The case was settled for \$925 million. Reported decisions can be found at 641 F. Supp. 828 (D. Mass. 1985), *aff'd*, 789 F.2d 1556 (Fed. Cir. 1986) (liability) and 16 U.S.P.Q.2d 1481 (D. Mass. 1990), modified 17 U.S.P.Q.2d 1711 (D. Mass. 1991) (damages trial).