



INTELLECTUAL PROPERTY DISPUTES
**FEATURED
ENGAGEMENTS**

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EXPERT TESTIMONY

CENTRIPETAL NETWORKS, INC. V. CISCO SYSTEMS, INC.

United States District Court for the Eastern District of Virginia;
Case No. 2:18-cv-00094

Engagement

Deposition & Trial Testimony

Technology

Cybersecurity

Case Issues

Centripetal called two economic witnesses at trial. The first presented an accounting of the apportioned revenues accused of infringement as well as the applicable reasonable royalty rate. Ocean Tomo's Senior Managing Director James E. Malackowski testified as the plaintiff's final witness and addressed the options Centripetal held pre-infringement for monetizing its proprietary technology, including through licensing, commercializing or selling the asserted patents. Mr. Malackowski then addressed the adverse impact of Cisco's infringement on Centripetal's ability to realize the true value of its innovations. This evidence was presented to both put the damages claim into context and provide an economic foundation for Centripetal's claim of irreparable harm.

Results

Following a twenty-two-day bench trial and hearing on damage evidence, conducted live via a video platform, the Court returned a decision on both past damages and interest totaling \$1.9 Billion (\$1,903,239,288) as well as future royalties, in a range of \$700 Million (\$754,701,723) to \$1.3 Billion (\$1,305,345,753). The Court's future royalty is based on rates of 10.0% (of apportioned net sales for the first 3-year term) and 5.0% (of apportioned net sales for the second 3-year term) over the six-year future damages period.

The Judgment in favor of Centripetal Networks set a new high-water mark for damages award in a patent infringement case in the U.S, eclipsing a 2016 decision in Idenix Pharmaceuticals Inc., et al. v Gilead Sciences Inc., et al.

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EXPERT TESTIMONY

SECURITYPOINT HOLDINGS, LLC, V. THE UNITED STATES OF AMERICA

Civil Action No. 1:11-cv-00268-EGB

Engagement

Deposition & Trial Testimony

Technology

System of recycling trays through security screening checkpoints by use of movable carts

Case Issues

Claims of patent infringement

Results

On August 31, 2021, the United States Court of Federal Claims issued an opinion containing one of the largest, if not the largest, damages award ever against the United States. Judge Eric G. Bruggink found the TSA's use of carts to move around trays at airport security screenings would cost the agency 2 cents for every passenger, dating to 2008, as the agency was infringing a SecurityPoint patent. The total amount owed by the government was calculated at just under \$133.8 million. Ocean Tomo Senior Managing Director James E. Malackowski opined as to the damages in the case and found evidence that the TSA had gone through over a decade of failed efforts at moving bins around quicker and more efficiently before it began using SecurityPoint's method as outlined in its' U.S. Patent No. 6,888,460.

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EXPERT TESTIMONY

HUAWEI TECHNOLOGIES CO. LTD. V. VERIZON COMMUNICATIONS, INC., ET AL

United States District Court for the Eastern District of Texas, Case No. 2:20-CV-00030

Engagement

Deposition Testimony

Technology

Optical Transport Network (OTN)

Case Issues

Patent Infringement related to standard-essential patents (SEPs) related to Huawei's commitment to license such SEPs on reasonable and non-discriminatory (RAND) terms.

Results

Ocean Tomo was retained by counsel for Huawei Technologies Co. Ltd. to prepare expert report and provide deposition testimony. The matter settled three days into the jury trial before U.S. District Judge Rodney Gilstrap.

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EXPERT TESTIMONY

BIO-RAD LABORATORIES, INC. AND PRESIDENT AND FELLOWS OF HARVARD COLLEGE V. 10X GENOMICS, INC.

United States District Court for the District of Massachusetts, Case No. 1:19-cv-12533

Engagement

Deposition Testimony

Technology

Genetic Analysis Tools

Case Issues

Antitrust

Results

The parties settled during trial.

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EXPERT TESTIMONY

DALMATIA IMPORT GROUP, INC. AND MAIA MAGEE V. FOODMATCH, INC., LANCASTER FINE FOODS, INC., EARTH PRIDE ORGANICS, LLC, AND MICHAEL S. THOMPSON

Case No. 2:16-cv-02767-EGS

Engagement

Deposition & Trial Testimony

Technology

Recipes, ingredient specifications, and production processes for fig spread

Case Issues

Claims of misappropriation of trade secrets, breach of contract, trademark infringement, trademark counterfeiting, unfair competition, and conversion

Damages calculated as lost profits and unjust enrichment

Results

On February 24, 2017 a Pennsylvania jury returned the first verdict under the Defend Trade Secrets Act, which was signed into law in 2016. The case, Dalmatia Import Group, Inc. v. FoodMatch Inc. et al. was heard in the United States Court for the Eastern District of Pennsylvania. The jury awarded Dalmatia \$2,567,000 in compensatory damages related to trade secret misappropriation, along with trademark infringement and counterfeiting. The final award was increased for statutory damages and trebling. Ocean Tomo Senior Managing Director James E. Malackowski opined as to the damages in the case.

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EXPERT TESTIMONY

IDENIX PHARMACEUTICALS INC. ET AL. V. GILEAD SCIENCES INC. ET AL.,

United States District Court for the District of Delaware Civil Action No.1:13-cv-01987

Engagement

Deposition & Trial Testimony

Technology

Patent pertaining of Hep C medication

Case Issues

Patent Infringement, Idenix sought a 10% Gilead's US sales

Results

Jury awarded Mr. Carter's claim for 10% (\$2.5 B) resulting in the largest patent verdict in history.

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EXPERT TESTIMONY

PETTER INVESTMENTS, INC. V. HYDRO ENGINEERING, INC.

United States District Court for the Western District of Michigan
Civil Action No. 1:2007-cv-01033

Engagement

Trial and Deposition Testimony

Technology

Wash Racks and Wastewater Recycling Systems

Case Issues

Patent Infringement

Results

Dispute involving two direct competitors in the heavy machinery wash rack industry. Ocean Tomo determined damages including lost profits and reasonable royalties. After Ocean Tomo's deposition, the case settled favorably to the client.

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EXPERT TESTIMONY

MOTOROLA SOLUTIONS, INC. V. HYTERA COMMUNICATIONS CORPORATION LTD.

Case No. 1:17-cv-01973

Engagement

Deposition & Trial Testimony

Technology

Trade Secrets and source code for DMR two-way digital radios

Case Issues

Claims of misappropriation of trade secrets and copyright infringement. Damages calculated as lost profits and unjust enrichment.

Results

On February 14, 2020 a federal Jury returned a verdict in the case of Motorola Solutions, Inc. v. Hytera Communications Corporation Ltd. The jury awarded plaintiff Motorola Solutions over \$764 million in damages, including compensatory damages of \$345.76 million and punitive damages of \$418.8 million related to trade secret misappropriation and copyright infringement. This was the full amount sought by Motorola. The case was heard in the United States District Court for the Northern District of Illinois. Ocean Tomo Senior Managing Director James E. Malackowski opined as to the damages in the case.

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EXPERT TESTIMONY

SUNOCO PARTNERSHIP MARKETING & TERMINALS L.P. V. U.S. VENTURE, INC., U.S. OIL, AND TECHNICS, INC.

Case No. 1:15-cv-08178

Engagement

Trial and Deposition Testimony

Technology

Fuel Blends

Case Issues

Patent infringement. Plaintiff damages calculated as lost profits (and a reasonable royalty alternative). Defendant damages calculated as reasonable royalty only.

Results

On January 29, 2020, Judge Rebecca R. Pallmeyer returned a bench trial opinion and order in the case of Sunoco Partnership Marketing & Terminals L.P. v. U.S. Venture, Inc., U.S. Oil, and Technics, Inc. Sunoco's expert sought lost profits damages of \$31.59 million, or alternatively, a reasonable royalty ranging from \$17.1 to \$25.7 million. Judge Pallmeyer agreed with U.S. Venture that lost profits damages were not appropriate in this case, and awarded Sunoco with a reasonable royalty of \$2 million, the exact amount calculated by U.S. Venture's expert. The case was heard in the United States District Court for the Northern District of Illinois. Ocean Tomo Senior Managing Director James E. Malackowski opined as to the damages in this case on behalf of U.S. Venture.

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EXPERT TESTIMONY

CONCEPTUS, INC. V. HOLOGIC, INC.

United States District Court for the Northern District of California
Civil Action No. 3:09-cv-02280

Engagement

Trial and Deposition Testimony

Technology

Permanent Birth Control System

Case Issues

Patent Infringement

Results

In *Conceptus v. Hologic*, the plaintiff accused the defendant of infringing the patent for a revolutionary method of permanent birth control. At trial, Ocean Tomo's expert successfully presented a case for 100% lost profits, resulting in award of the full amount calculated. In a post-trial settlement, the defendant agreed to remove its infringing product from the market.

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EXPERT TESTIMONY

FIRST AMERICAN CORELOGIC, INC. V. FISERV, INC. ET AL.

United States District Court for the District of Texas (Marshall)
Civil Action No. 2:10-cv-00132

Engagement

Trial and Deposition Testimony

Technology

Automated Real Estate Software

Case Issues

Patent Infringement

Results

Ocean Tomo testified in Marshall, Texas as the damages expert for the defendant in this patent infringement action related to internet services. Ocean Tomo's testimony rebutted CoreLogic's claim of \$26 million in damages, demonstrating that the patent-in-suit had minimal value as used by the defendant. Interthinx was found to not infringe.

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EXPERT TESTIMONY

OMEGA PATENTS, LLC V. FORTIN AUTO RADIO, INC.

United States District Court for the Middle District of Florida (Orlando)
Civil Action No. 6:05-cv-01113

Engagement

Trial and Deposition Testimony

Technology

Electrical Connectors and In-Vehicle Car Alarm Systems

Case Issues

Patent Infringement

Results

Ocean Tomo testified as a damages expert for the defendant in a patent infringement action concerning electrical components. The plaintiff claimed damages of approximately \$20 million. Ocean Tomo demonstrated to the jury why the damages should be only roughly \$400,000. Although the infringement was found to be willful, the jury substantially agreed with Ocean Tomo and awarded roughly just \$600,000 in damages.

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EXPERT TESTIMONY

LUCENT TECHNOLOGIES, INC. V. EXTREME NETWORKS, INC.

United States District Court for the District of Delaware
Civil Action No. 03-508 (JJF)

Engagement

Trial and Deposition Testimony

Technology

Improvements to Router Technology

Case Issues

Patent Infringement, Reasonable Royalty

Results

Lucent alleged infringement on virtually all of Extreme Networks' sales and determined a royalty of 1% for each of the 5 patents allegedly infringed for a total of 5%. Ocean Tomo conducted a thorough analysis of all Extreme Networks' sales channels and, with additional technical analysis of the actual use and set-up of the alleged improvements, reduced the royalty base by 20 fold. Ocean Tomo further opined a royalty rate that included stacking considerations. The jury found in favor of Ocean Tomo's damages opinion and the parties settled soon thereafter.

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EXPERT TESTIMONY

ST. CLAIR INTELLECTUAL PROPERTY CONSULTANTS V. FUJI PHOTO FILM CO., LTD., FUJI PHOTO FILM U.S.A., INC., FUJIFILM AMERICA, INC. ET AL.

United States District Court for the District of Delaware
Civil Action No. 03-241 JJF

Engagement

Trial and Deposition Testimony

Technology

Digital Cameras

Case Issues

Patent Infringement

Results

Ocean Tomo represented Fuji in a patent case involving the type of file formats used by digital cameras to store images and movies. Ocean Tomo Testified that, assuming the patent is valid and infringed, Fuji should pay damages based on a reasonable royalty ranging from 0.5% - 0.75% of sales and the opposing expert opined to a royalty of 3.0%. Ultimately the jury award damages based on a 0.5% royalty, based on the low end of the royalty rate range testified to by Ocean Tomo.

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EXPERT TESTIMONY

CARTER BRYANT V. MATTEL, INC. AND CONSOLIDATED ACTIONS

United States District Court for the Central District of California, Southern Division
Case No. CV 04-9049-DOC (RNBx) Consolidated with Nos. CV 04-9059 and CV 05-2727

Engagement

Trial and Deposition Testimony

Technology

Dolls and Children's Toys

Case Issues

Trade Secret Misappropriation, Copyright Infringement

Results

In the second trial regarding Mattel's claim of ownership of rights to Bratz dolls, Ocean Tomo testified that MGA had suffered \$85 million in damages due to Mattel's misappropriation of MGA's trade secrets. MGA was awarded \$85 million in trade secret misappropriation damages and the jury rejected all of Mattel's claims to the Bratz dolls and did not award Mattel any copyright damages. MGA was also awarded punitive damages and legal fees and costs.

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EXPERT TESTIMONY

IN THE MATTER OF SEMICONDUCTOR CHIPS WITH MINIMIZED CHIP PACKAGE SIZE AND PRODUCTS CONTAINING SAME (III)

United States International Trade Commission

On behalf of Respondents Acer, Nanya and Powerchip Investigation No. 337-TA-630

Engagement

Hearing and Deposition Testimony

Technology

Specific Technology Related to the "Packaging" of DRAM Chips

Case Issues

Determining the Number of the Unlicensed Chips Imported into or Sold in the U.S. by the Defendants Versus Remaining Suppliers and Licensees.

Results

Ocean Tomo opined that the majority of units sold in or imported into the U.S. by defendants were purchased from suppliers or subcontractors directly licensed by Tessera. The Administrative Law Judge, in agreement with Ocean Tomo, found that all chips Defendants purchased from Tessera licensees were authorized thus, Tessera's rights in those chips were subject to exhaustion, and that none of Tessera's patents had been infringed. The ITC made a final determination that there was no violation of Section 337.

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EXPERT TESTIMONY

LIGHTING BALLAST CONTROL, LLC V. ADVANCE TRANSFORMER CO., FULHAM CO., INC., GENERAL ELECTRIC CO. AND UNIVERSAL LIGHTING TECHNOLOGIES, INC.

United States District Court for the District of Texas, Wichita Falls Division
Civil Action No. 7:09-cv-00029-0

Engagement

Trial Testimony

Technology

Electronic Lighting Ballasts

Case Issues

Patent Infringement and Lump Sum Royalties

Results

In a trial relating to the infringement of several patents, plaintiff's expert opined to a running royalty ranging from \$9.3 - \$15.6 million, plus additional post-trial royalties. Ocean Tomo testified that the proper form and amount of the reasonable royalty was a fully paid up lump-sum royalty of \$1.5 million, and no post trial royalties. Following findings of validity and infringement, the plaintiff was awarded a fully paid-up lump sum royalty of \$3.0 million and no post-trial royalties.

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EXPERT TESTIMONY

EXTREME NETWORKS, INC. V. ENTERASYS NETWORKS, INC.

United States District Court for the Western District of Wisconsin
Civil Action No. 07-C-0229-C

Engagement

Trial and Deposition Testimony

Technology

Enterprise Switches and Routers

Case Issues

Patent Infringement

Results

Ocean Tomo testified that Extreme Networks was due reasonable royalty damages due to Enterasys Networks' infringement of three Extreme Networks patents relating to switch and router technology. Extreme Networks was awarded over \$200,000 in reasonable royalty damages consistent with Ocean Tomo calculations. Enterasys Networks was permanently enjoined from selling the infringing products.

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EXPERT TESTIMONY

BROCADE COMMUNICATIONS SYSTEMS, INC. AND FOUNDRY NETWORKS, LLC V. AIO NETWORKS, INC. ET AL.

United States District Court for the Northern District of California, San Jose Division
Case No. 10-cv-03428 LHK

Engagement

Trial and Deposition Testimony

Technology

Application Delivery Controllers, Load Balance Servers

Case Issues

Patent Infringement, Copyright Infringement, Trade Secret Misappropriation, Breach of Contract, Intentional Interference with Contract

Results

In a trial regarding Brocade and Foundry's allegations against A10 Networks regarding broad-based intellectual property infringement and unfair competition, Ocean Tomo testified that Brocade and Foundry had suffered damages resulting from patent infringement, copyright infringement, trade secret misappropriation and unfair interference with contract. The jury found for Brocade and Foundry on each of these claims and awarded Brocade and Foundry \$112 million in damages equal to the amount determined by Ocean Tomo.

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EXPERT TESTIMONY

COMMONWEALTH SCIENTIFIC AND INDUSTRIAL RESEARCH ORGANIZATION V. LENOVO ET AL.

United States District Court for the Eastern District of Texas, Tyler Division
Civil Action No. 6:09-cv-00400-LED

Engagement

Testimony

Technology

WiFi

Case Issues

Patent Infringement, Multi-Defendant, Standards-Based Technology

Results

Ocean Tomo determined the damages related to the widespread infringement of CSIRO's essential WiFi patent against multiple defendants across multiple industries. After depositions were completed, all parties settled the case totaling over \$220 million.

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EXPERT TESTIMONY

SAINT GOBAIN AUTOVER U.S.A., INC. ET AL V. XINYI AUTOMOBILE GLASS CO. ET AL

United States District Court for the Northern District of Ohio (Cleveland)
Civil Action No. 1:06-cv-02781

Engagement

Trial and Deposition Testimony

Technology

Automotive Windshields

Case Issues

Patent Infringement

Results

Ocean Tomo testified as a damages expert for the plaintiff, St. Gobain, in a patent infringement action concerning automotive windshields, demonstrating why St. Gobain should be awarded both lost profits and price erosion damages. The jury awarded the exact damages figure requested by Ocean Tomo, which was in excess of \$10 million.

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EXPERT TESTIMONY

FUJITSU LTD. V. TELLABS, INC., TELLABS OPERATIONS, INC. AND TELLABS NORTH AMERICA, INC.

United States District Court for the Northern District of Illinois, Eastern Division
Civil Action No. 09-cv-04530

Engagement

Trial and Deposition Testimony

Technology

Optical Network Signal Amplification and Routing

Case Issues

Patent Infringement and Reasonable and Non-Discriminatory ("RAND") Royalties

Results

Ocean Tomo prepared expert reports on both traditional and RAND royalties and testified as an expert in the field of damages and patent licensing, including the economics of RAND obligations. The jury found in favor of Ocean Tomo's opinions.

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EXPERT TESTIMONY

MILWAUKEE ELECTRIC TOOL CORP., ET AL V. SNAP-ON INC.

United States District Court for the Eastern District of Wisconsin
Case No. 2:14-cv-01296

Engagement

Patent Infringement Litigation

Technology

Lithium-Ion Batteries in Cordless Power Tools

Case Issues

Milwaukee Tool, a Wisconsin based power-tool company, is a major innovator in the cordless power tool industry. In 2005, Milwaukee Tool introduced the V28™ line of lithium-ion powered tools, the world's first high-current cordless handheld power tools powered by lithium-based battery packs. The V28™ provided the power of corded tools while being light and compact enough for cordless use. Milwaukee Tool's parent company, Tooltechnic Industries Co. Ltd., is headquartered in China and is a leading marketer, manufacturer and supplier of power tools and home improvement products. Defendant, Snap-on, Inc., like many toolmakers, introduced lithium-ion battery packs in its tools after Milwaukee Tool's launch of the V28™.

Plaintiffs alleged that Snap-on, Inc.'s use of the technology described in three of Milwaukee Tool's patents constituted infringement. Mr. Malackowski testified on behalf of the plaintiffs on the matter of financial damages resulting from the alleged patent infringement. The Ocean Tomo team assisting Mr. Malackowski on the engagement included Rich Lettiere and Chelsea Nacker.

Results

Plaintiffs won on patent validity, infringement and willfulness. The jury awarded damages of \$27.8 million, matching Mr. Malackowski's opinion.

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EXPERT TESTIMONY

IN THE MATTER OF CERTAIN BOTULINUM TOXIN PRODUCTS, PROCESSES FOR MANUFACTURING OR RELATING TO SAME AND CERTAIN PRODUCTS CONTAINING SAME

**United States International Trade Commission Investigation
Civil Action No. 337-TA-1145**

Engagement

Hearing and Deposition Testimony

Technology

Trade secrets including the manufacturing process and bacterium strain used in manufacturing certain botulinum toxin products.

Case Issues

Determining whether a domestic industry exists in the United States for botulinum toxin products, including BOTOX® Cosmetic, determining whether such domestic industry will be harmed by the importation of a competing botulinum toxin product, Jeuveau®, and determining the appropriate remedy and bond

Results

Ocean Tomo opined that a domestic industry existed for the domestic industry products, including BOTOX® Cosmetic alone, due to Allergan's substantial, significant, and extensive investments and activities in the United States and that Respondents' importation and sale of the accused Jeuveau® product has the threat and effect of substantially injuring the domestic industry that exists for the domestic industry products. In the ITC's Final Initial Determination, dated July 6, 2020, the ITC determined that the domestic industry requirement had been satisfied, confirming Ocean Tomo's analysis.

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EXPERT TESTIMONY

SELEX GALILEO, INC. v. NOMIR MEDICAL TECHNOLOGIES, INC.

American Arbitration Association International Centre for Dispute Resolution
Case No. 01-17-0003-0930

Engagement

Submittal of Opinions to Arbitration Tribunal and Testimony at Hearing

Technology

Laser device intended for used by healthcare providers on patients to combat MRSA and other superbug infections.

Case Issues

In 2014, Selex agreed with Nomir to develop and commercialize Nomir's proprietary laser device intended for use by healthcare providers on patients to combat MRSA and other superbug infections. Nomir terminated the agreement in 2017, contending that Selex had ceased to materially develop the technology. Selex sued for wrongful termination, and Nomir countersued, seeking the recovery of the alleged lost value of its technology.

At the arbitration hearing, Mr. Malackowski addressed the appetite of Venture Capital ("VC") firms for life science and medical device investments during the 2014 to 2017 time period. Mr. Malackowski also addressed the opportunity for Nomir to secure alternative VC funding to continue development, assuming the viability of the technology. Mr. Malackowski contended that the failure of the VC market to recognize the viability of Nomir's technology undermined the annual sales forecasts and risk factors within Nomir's damages calculations. Mr. Malackowski also asserted that, were Nomir's technology viable, Nomir could have mitigated its losses by securing VC funding within a short period of time.

Results

The Arbitration Tribunal ruled in favor of Selex, holding that Nomir had failed to prove its technology was "safe and effective" or commercially viable, making its damages claim too speculative. The Tribunal awarded Selex Galileo \$7.4 million in damages, interest, and costs, upholding Selex's claim that Nomir had wrongfully terminated the 2014 agreement.

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EXPERT TESTIMONY

CP KELCO, U.S., INC. V. CHIENKUO YUAN ET AL.

**Superior Court of the State of California, County of San Diego
Case No. 37-2015-00022453-CU-BT-CTL**

Engagement

Alleged Trade Secret Misappropriation

Technology

Gellan Gums (Food Additives)

Case Issues

The Plaintiff is a major innovator and producer of hydrocolloids for use in food & beverage and personal care products. In particular, the Plaintiff's product Gellan Gum is used in many beverages and produced through a complex bioindustrial fermentation process using highly controlled conditions, including proprietary and valuable materials and technology that are protected as trade secrets. The Defendant was previously employed for 14 years by the Plaintiff as a food applications scientist, focused on beverages. Plaintiff alleges that the defendant downloaded files containing confidential and proprietary process information, including raw material specifications containing step-by-step instructions to make a range of proprietary formulations of Gellan Gum, Xanthan Gum, and Rhamsan Gum; and documents related to marketing and sales strategies. Mr. Lewis testified on behalf of the defendant on a matter related to financial damages resulting from the alleged misappropriations of trade secrets.

Results

Although the defendant lost on liability and was subject to pay damages related to unjust enrichment, the jury only awarded damages matching Mr. Lewis' opinion which was less than 3% of the opposing expert's position.

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EXPERT TESTIMONY

LOTES CO., LTD. V. HON HAI PRECISION INDUSTRY CO., LTD., AND FOXCONN ELECTRONICS, INC.

United States District Court for the Northern District of California – San Jose Division
Case No. 3:11-Cv-01036-WHA

Engagement

Deposition Testimony

Technology

CPU sockets and accompanying accessories, memory sockets

Case Issues

Hon Hai, also known by its trade name Foxconn, is the world's largest contract electronics manufacturer and specializes in the manufacture and sale of computer, component, and consumer electronic products. Lotes is an electronics manufacturer that specializes in connectors, thermal modules, antenna tuners, and other peripherals for electronic devices.

In 2006 the parties entered into an agreement to resolve a number of disputes. As part of the agreement, Hon Hai and Foxconn granted Lotes a license to certain U.S. and foreign patents, while Lotes agreed to pay royalties on certain CPU and memory socket connectors.

In 2010 Hon Hai and Foxconn engaged an outside firm to conduct a royalty audit in relation to the license agreement. The audit revealed a royalty underpayment of several million New Taiwan Dollars and a dispute arose between the parties regarding the scope of the license.

In the current action, Lotes filed suit against Hon Hai and Foxconn seeking declaratory judgement of non-infringement regarding certain Hon Hai patents, in addition to declaratory judgement regarding the scope of the license agreement and breach of contract. Hon Hai and Foxconn responded with counterclaims for patent infringement and breach of contract.

Results

Ocean Tomo, on behalf of Hon Hai and Foxconn, calculated three measures of damages caused by Lotes: reasonable royalty damages for patent infringement, unpaid royalty damages under the license agreement, and breach of contract damages incurred defending against patent validity challenges initiated by Lotes. In addition, Ocean Tomo rebutted damages opinions put forth by Lotes' damages expert.

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EXPERT TESTIMONY

INTERNATIONAL TRADE COMMISSION (ITC) SELF- BALANCING SCOOTERS

**In the matter of certain personal transporters, components thereof, and
packaging and manuals therefor
United States International Trade Commission Investigation No. 337-TA-1007/1021**

Engagement

Patent and Trademark Infringement Litigation | Technology:

Technology

Self-Balancing Electric Scooters

Case Issues

Segway, Inc., manufacturer of the famous “Segway Personal Transporters,” created the selfbalancing electric scooter market. Segway’s parent company, Ninebot (Tianjin) Technology Co., Ltd., is headquartered in China and is also a leading marketer, manufacturer and supplier of self-balancing electric scooters. The Respondents, which included several companies such as Razor and Swagway, were accused of importing infringing one-wheel and two-wheel selfbalancing electric scooters (e.g. “hoverboards”) into the United States. Mr. Milani offered testimony on behalf of the Complainants. Mr. Milani’s testimony related to the existence of a domestic industry and the appropriate remedy and bond. Mr. Milani also testified regarding the statutory public interest factors and the commercial success of the patented and accused products. The Ocean Tomo team assisting Mr. Milani on the engagement included Chet Dominik and Christopher Huh.

Results

Complainants won on its trademark infringement claims. Consistent with the opinions offered by Mr. Milani, The International Trade Commission found the existence of a domestic industry and granted cease and desist orders and limited exclusion orders against the guilty Respondents. The Commission also agreed with Mr. Milani that public interest concerns did not weigh against the issuance of the requested remedies.

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EXPERT TESTIMONY

BIO-RAD LABORATORIES, INC. AND THE UNIVERSITY OF CHICAGO V. 10X GENOMICS, INC.

United States District Court for the District of Delaware, Case No. 15-152-RGA

Engagement

Trial and Deposition Testimony

Technology

Genetic Analysis Tools

Case Issues

Patent Infringement

Results

The court entered a permanent injunction and over \$34 million judgement equal to Ocean Tomo's opinion for Bio-Rad.

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EXPERT TESTIMONY

IN THE MATTER OF CERTAIN POCKET LIGHTERS

Investigation No. 337-TA-1142

Engagement

Hearing and Deposition Testimony

Technology

Disposable Lighters

Case Issues

BIC brought suit against several respondents who were accused of infringing certain trademarks relating to the well-known BIC lighter. Ocean Tomo offered testimony relating to the existence of a domestic industry, remedy, and bond.

Results

Consistent with Ocean Tomo's opinions, the ALJ granted summary determination regarding the existence of a domestic industry. The investigation later settled, prior to a hearing.

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EXPERT TESTIMONY

IN THE MATTER OF CERTAIN AUDIO PLAYERS AND, CONTROLLERS, COMPONENTS, THEREOF, AND PRODUCTS CONTAINING THE SAME

Investigation No. 337-TA-1191

Engagement

Report, Deposition, and Hearing Testimony

Technology

Music Streaming, Playback, and Distribution

Case Issues

Sonos brought suit against Google for infringing several patents relating to music streaming, playback and distribution. Ocean Tomo offered testimony relating to the existence of a domestic industry, remedy, and bond.

Results

Consistent with Ocean Tomo's opinions, the ALJ granted summary determination that the domestic industry requirement had been satisfied. That ruling was later affirmed by the Commission, which also affirmed Ocean Tomo's opinions relating to remedy and the amount of a bond.

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EXPERT TESTIMONY

APPIAN CORPORATION V. PEGASYSTEMS INC., AND YOUYONG ZOU

Circuit Court of Fairfax County, Virginia, Case No. 2020 – 07216

Engagement

Deposition & Trial Testimony

Technology

Low-code software development platform

Case Issues

Corporate espionage and trade secret misappropriation related to low-code software development platform.

Results

Ocean Tomo was retained in October 2021 by counsel for plaintiff, Appian Corporation ("Appian") to determine the measures and amounts of monetary recovery due Appian in the event one of its primary competitors, Pegasystems Inc. ("Pegasystems") was found to have misappropriated its trade secrets. Appian alleged that Pegasystems illicitly retained Dr. Youyong Zou, a software developer then working for an Appian contractor, to steal proprietary technical data relating to Appian's low-code software development platform as well as proprietary commercial information concerning Appian's contractual arrangements with its clients/business partners.

At trial, Ocean Tomo's expert provided the jury with two alternative measures of Pegasystems' unjust enrichment. The first – in the amount of \$479.0 million – was based on Pegasystems' profits from contracts pursued by both Appian and Pegasystems, which Pegasystems won due in part to the use of Appian's commercial trade secrets. The second – in the amount of \$3.0 billion – was based on Pegasystems' profits from revenues generated through Pegasystems' incorporation of Appian's technical trade secrets into its software development platform.

Following the trial, the jury returned a verdict for Appian in an amount exceeding \$2.0 billion, representing 67.16 percent of Ocean Tomo's second alternative measure of unjust enrichment, making it one of the largest awards for trade secret misappropriation in U.S. history. The Ocean Tomo trial team for Appian included Robert McSorley, Frank Vido, and James E. Malackowski.

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About Ocean Tomo

Ocean Tomo LLC provides Expert Opinion, Management Consulting, and Advisory services focused on matters involving intellectual property (IP) and other intangible assets. Practice offerings address economic damage calculations and testimony; business licensing strategy and contract interpretation; trade secret reasonable measures; asset and business valuation; strategy and risk management consulting; merger and acquisition advisory; debt and equity private placement; and IP brokerage.

Ocean Tomo experts are routinely qualified in U.S. District Courts, U.S. Bankruptcy Courts, U.S. Tax Court, U.S. Court of Federal Claims, state courts, the U.S. Patent and Trademark Office Patent Trial and Appeal Board, international courts, and arbitration tribunals on questions relating to intellectual property economics. The firm's professionals have provided expert opinions on IP valuation, reasonable royalty, lost profits, price erosion, commercial success, corrective advertising, creditor allocations, Hatch-Waxman Act market exclusivity, business licensing terms including RAND obligations, venture financing, and equities of a potential injunction. The firm's experience extends to general business valuation and commercial disputes, domestic and foreign, as well as policy issues affecting international technology transfer and economic matters before the International Trade Commission.

Intangible assets comprise 90 percent of business value but are also subject to significant impairment due to enterprise and regulatory compliance risk. Our services are built upon more than three decades of experience assessing intellectual property in the most rigorous of venues. Our financial, market, scientific, and technical experts have deep experience with tangible and intangible assets protected by intellectual property. We bring a unique understanding of the contributory value of proprietary innovation to every engagement. This is the cornerstone of our business.

Subsidiaries of the firm include Ocean Tomo Investments Group, LLC, a registered broker-dealer. As a part of J.S. Held, Ocean Tomo works alongside more than 1500 professionals globally and assists clients – corporations, insurers, law firms, governments, and institutional investors – on complex technical, scientific, and financial matters across all assets and value at risk.

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About J.S. Held

J.S. Held is a global consultancy providing technical, scientific, and financial expertise across all assets and value at risk. Our professionals serve as trusted advisors to organizations facing high-stakes events demanding urgent attention, staunch integrity, clear-cut analysis, and an understanding of both tangible and intangible assets. The firm provides a comprehensive suite of products, data, and services that enable clients across industries to navigate complex, contentious, and often catastrophic situations.

In 2022, Ocean Tomo joined J.S. Held, continuing the strategic growth of the firm. Leveraging the J.S. Held team of more than 1,500 professionals around the world, our clients will now have access to J.S. Held's suite of specialized services, including:

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Headquartered in New York, J.S. Held has offices across the United States, Canada, Latin America, Europe, Asia Pacific, and the Middle East.

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