MARK H. BLOOMBERG
Zuber Lawler LLP

SUMMARY

Intellectual property attorney with over 35 years of experience, including first-chair experience, representing clients in patent infringement actions and counseling clients concerning patent infringement, validity, remedies and licensing. Experience includes representing clients in all phases of litigation through trial and appeal, advising clients how to redesign products to mitigate risk and to achieve settlement, preforming presuit investigations, preparing non-infringement opinions, and negotiating settlement and license agreements. Participated in all aspects of patent litigation, including jury trials, bench trials, claim construction hearings, PTAB hearings, arbitrations and appeals.

Experience ranges from representing an American-based international consumer product company in a landmark damages trial that resulted in a $925 million damages award, to representing a start-up satellite radio company that successfully launched its satellite radio service after designing around patents asserted by its competitor, to representing a computer company in connection with litigation to expedite program to obtain royalties for licensing patents to industry-wide competitors. Represented clients in a number of technology areas, including computers, video games, telecommunication systems, electronic trading systems, business methods and medical devices, and has substantial experience representing clients in connection with patent damages and injunctive remedies. Experience with patent litigation and counseling concerning a variety of products in the consumer electronics field, including personal computers, video monitors, satellite radios, cellular telephones and cameras.

Experience includes counseling clients in connection with various intellectual property issues and disputes, including evaluating potential infringement and validity of patents, developing strategies to redesign products to avoid infringement, assessing the merits, potential damages and potential injunctive relief for ongoing litigation in connection with diligence, and negotiating and preparing patent licenses, settlement agreements and purchase agreements.

EXPERIENCE

Zuber Lawler LLP, New York, New York **August 2012-present**

Ropes & Gray LLP, New York, New York **2005-August 2012**
(merged with Fish & Neave LLP, January 1, 2005)

Fish & Neave LLP, New York, New York **1984-2004**

EDUCATION

Harvard Law School
J.D., 1984, *cum laude*

Massachusetts Institute of Technology
S.M., 1981
Major: Mechanical Engineering

Massachusetts Institute of Technology
S.B., 1980
Major: Mechanical Engineering

BAR ADMISSIONS

Massachusetts

New York

U.S. Patent and Trademark Office

FEDERAL COURT ADMISSIONS

Court of Appeals for the Federal Circuit

Southern District of New York

Eastern District of New York

Northern District of California

BAR ASSOCIATION ACTIVITIES

New York Intellectual Property Law Association

Member of Board of Directors (2016-2019)

Co-Chair Law Firm Management Committee (2020-2023)

Co-Chair CLE Committee (2010-2016)

Co-Chair Membership Committee (2014)

Member of Nominating Committee (2014)

Intellectual Property Owners Association

Member of Damages and Injunctions Committee (2010-2012)

Member of Litigation Committee (2008-2009)

REPRESENTATIVE MATTERS

***Trials and Adjudicated Matters*:**

Endoheart v. Edwards Lifesciences. Represented plaintiff in action for infringement of patent relating to surgical method for replacing aortic heart valves against defendant and intervenor Brigham And Women's Hospital. After prevailing on all claim construction issues, case settled.

Virco v. Hertz Furniture and Academia Furniture. Represented defendants in action for alleged infringement of design patents and trade dress relating to school furniture. Obtained summary judgment of non-infringement of key patent, and remainder of case settled shortly thereafter.

Lincoln v. Transamerica. Represented Transamerica in a 2-week jury trial for alleged infringement of patent relating to method for administering annuity contracts. Retained three months before trial, after completion of fact and expert discovery. Responsible for damages case, including examining and cross-examining damages witnesses at trial, and developed non-infringement argument that prevailed on appeal.

Merit v. JVL. Represented JVL in a 2-week jury trial for alleged infringement of 3 patents relating to countertop video game machines, and advised JVL in connection with redesigning its products to avoid the asserted patents. Responsible for developing claim constructions and case strategy, for examining and cross-examining liability witnesses at trial and for communicating with client. The jury found that none of JVL's redesigned products infringed and that most of the claims of two asserted patents were invalid, enabling JVL to avoid an injunction against any of its products.

***Ariel v. Reuters, NASDAQ, Instinet and Silver Lake*.** Represented Instinet and Silver Lake in an action for alleged copyright infringement and breach of contract relating to Instinet's electronic trading system software. Developed license defense that resulted in dismissal of Ariel's $50 million copyright infringement claim with prejudice, and dismissal of the remaining state law claims from the federal action without prejudice.

***Schneider v. SciMed*.** Represented SciMed in 2-month bench trial for alleged infringement of a patent relating to angioplasty catheters. Responsible for developing damages case and for examining and cross-examining damages witnesses at trial.

Elan v. Alza. Represented Elan in connection with Elan's acquisition of, and assertion of, a patent relating to nicotine patches against Elan's competitor, which had received FDA approval while Elan's application was still pending before FDA. Obtained temporary restraining order, which enabled Elan to obtain FDA approval and to introduce its product at the same time as its competitor.

Polaroid Corporation v. Eastman Kodak Company. Represented Polaroid at 8-month bench trial for damages relating to Kodak's infringement of Polaroid's instant photography patents. The Court awarded $925 million in damages.

***Appellate and Post-Judgment Matters*:**

In re AAMP of Florida Inc. Represented patent owner in appeal from decision of PTAB from reexamination finding claims of patent relating to automobile aftermarket stereo systesms to be invalid.

In Re Youman. Represented applicant in appeal to Federal Circuit from Board of Patent Appeals and Interferences involving rejection of claims for electronic program scheduling system for television.

***Odetics v. Storage Technology Corporation*.** Represented StorageTek after a jury found that StorageTek had willfully infringed a patent relating to data storage and retrieval systems. Obtained JMOL of non-infringement, which enabled StorageTek to redesign its products while appeal was pending and to avoid injunction, and obtained denial of enhancement of damages notwithstanding finding of willful infringement.

Motorola v. Hitachi. Represented Motorola after the court found that Motorola had infringed an Hitachi patent and enjoined Motorola from selling the microprocessors used in Apple computers. Obtained stay of injunction pending appeal from Federal Circuit, during which case settled.

Therasense v. Becton Dickinson and Nova. Represented Nova in Federal Circuit appeal from inequitable conduct finding for patent relating to disposable blood glucose test strips.

***Corning v. Sumitomo*.** Represented Corning in appeal that affirmed judgment that Sumitomo infringed 2 patents relating to optical waveguide fiber.

***Settled Matters*:**

***Sirius v. XM Radio*.** Represented XM in an action for alleged infringement of 3 Sirius patents brought against XM prior to the launch of XM's satellites, and advised XM in connection with redesigning its system to avoid the asserted patents. XM was able to launch its redesigned satellite radio service before Sirius launched its competing service.

eSpeed v. NYMEX and ***eSpeed v. CBOT and CME*.** Represented eSpeed in connection with eSpeed's acquisition of, and assertion of, a patent relating to automated futures trading systems, resulting in $48 million in royalty payments to eSpeed.

Compaq v. eMachines. Represented Compaq in an action for infringement of 13 Compaq patents relating to personal computers, which settled after Court found infringement of 9 patents on summary judgment and entered injunctions.

Digital v. Intel. Represented Digital in an action for infringement of 10 Digital patents by Intel's microprocessors and in a responsive action filed by Intel for infringement of Intel patents. It was reported that the settlement of those cases was estimated to be worth $1.6 billion to Digital.

Chung v. Vaporous. Took over representation of plaintiff's case after unfavorable claim construction and invitation of Court for defendants to move for attorney fees. Defeated motion for fees, and action was dismissed, without payment of any fees or costs.

Soteria Encryption v. Apricorn and Lenovo. Represented defendants in an action for alleged infringement of a patent relating to computer data storage systems having on-board encryption and decryption of stored data.

Haan v. De'Longhi. Represented declaratory judgment plaintiff Haan in an action for a declaration of non-infringement and invalidity of a patent relating to carpet steam cleaners.

***Round Rock v. American Apparel*.** Represented American Apparel in an action for alleged infringement of 10 patents relating to RFID readers and tags.

Magnetar v. Intamin. Represented third-party Palace Entertainment in connection with an antitrust action based on the assertion of patents relating to magnetic brakes for amusement park rides.

***Fotomedia v. Fotolog*.** Represented shareholder representative in connection with settlement of action for alleged infringement of 3 patents relating to distributing images over the Internet.

Gebre v. XM Radio. Represented XM in action involving for infringement of Gebre patent by XM NavTraffic vehicle navigation service.

Broadcast Data Retrieval and Coupon Radio v. XM Radio. Represented XM in action for alleged infringement of patent by XM's system that transmits music together with artist and title information.

Electronic Trading Systems v. Cantor Fitzgerald. Represented Cantor Fitzgerald in action for involving alleged infringement of patent by electronic futures trading systems.

Cantor Fitzgerald v. Liberty; Liberty v. Cantor Fitzgerald. Represented Cantor Fitzgerald in action for infringement and in declaratory judgment involving Cantor Fitzgerald patent relating to electronic trading systems.

WeddingChannel.Com v. The Knot. Represented WeddingChannel in action for infringement of WeddingChannel patent by Internet gift registry system.

IPI and TLC v. RealNetworks and Snell & Wilcox. Represented defendants in action for alleged infringement of 4 patents by products for reducing noise and filtering electronic video signals.

Realtime Data v. Packeteer. Represented Realtime Data in action for infringement of 4 Realtime patents by WAN optimization products.

Data Match v. Spark Networks. Represented Spark Networks in action for alleged infringement of patent by Internet dating service.

Smartrac v. On Track Innovations. Represented On Track Innovations in action for alleged infringement of patent by data cards that communicate wirelessly.

VIA Technologies and Centaur Technology v. Intel. Represented VIA and Centaur as plaintiffs and as defendants in action involving microprocessor technology.

MLMC v. AirTouch. Represented defendants and Motorola in action for alleged infringement of 2 patents by cellular telephone systems.

Alcatel v. Motorola. Represented Motorola in action for alleged infringement of 3 Alcatel patents by cellular telephone systems.

Compaq v. Packard Bell. Represented Compaq in action against defendant Packard Bell and intervener Intel for infringement of 6 Compaq patents by Packard Bell desktop and portable computers, and representation of Compaq against Packard Bell in subsequent arbitration involving patents relating to servers and portable computers.

Ford and Motorola v. Lemelson. Represented Motorola in action for declaratory judgment against patents asserted against semiconductor processing and fabrication.

Motorola v. Rockwell. Represented Motorola in action for infringement of 8 Motorola patents by Rockwell modem chips.

AMP v. AT&T. Represented AT&T in action for alleged infringement of AMP patent by AT&T electrical connectors.

***Counseling Matters*:**

Analysis Of Third Party Patents. Analyzed third party patents, including preparation of opinions of counsel concerning non-infringement and invalidity, participation in discussions with third parties concerning assertions of infringement, and advising clients concerning freedom to operate and designing around third party patents.

Analysis Of Client Patents. Analyzed client patents and patent portfolios for potential assertion in litigation against third parties, including analysis of infringement, analysis of remedies, analysis of risks of counterclaims and other actions involving third party patents, and development of litigation strategy.

Licensing And Patent Acquisition. Negotiated and prepared agreements to license client and third party patents and software, including agreements to settle litigation, and negotiated and prepared agreements to purchase third party patents.

Indemnification. Analyzed indemnification claims, and negotiated and prepared agreements concerning representation of parties in connection with indemnified claims.

Diligence. Evaluated liability risks and potential remedies for active and potential litigation involving patent, copyright and trade secret claims against targets of acquisitions and against acquired companies.

Patent And Trademark Office Practice:

Guthrie v. Espiau. Represented senior party Espiau in interference involving an Espiau patent for dielectric waveguide integrated plasma lamps.

Represented party in reexaminations in coordination with ongoing litigation.

Represented party in developing patent portfolio for assertion in licensing and litigation.

PUBLICATIONS, PRESENTATIONS AND SPEECHES

Publications:

Articles posted on Deadcatlivecat.com website:

"AI And Quantum Computing – A Marriage Of Convenience?" (March 17, 2023).

"The Public Perception Of Quantum Computing" (July 22, 2022).

"You Have Just Developed A New Quantum Product – Now What?" (March 18, 2022).

"Quantum Computing Applications: What Is Hot And Why?" (February 10, 2022).

"Patents – A Critical Element In Quantum Business Planning" (January 21, 2022).

"The Quantum Computing Horserace: Who Is Winning?" (January 2, 2022).

"Understanding "Spooky" Computers" (August 23, 2021).

"Hot Applications In Quantum Computing And Why They Are Hot" (July 25, 2021).

"A United States Patent Has Issued: Now What?" (February 19, 2021).

"Quantum Computing Patents: The Global Race To Strike Claims" (September 15, 2020).

"Some Basic Patent Issues Decided By Courts," RPI Presentation, April 5, 2015.

"Long-Awaited Patent Reform Bill Passes Congress," Ropes & Gray Alert, September 2011.

"Patents And The Video Game Industry: What You Don't Know Could Hurt You," *Gamasutra*, January 13, 2011.

"Extraterritorial Application Of Business Method Patents," *IPLaw 360*, August 25, 2006.

"Patenting Business," *LatinFinance*, November 2005.

Presentations and Speeches:

Panelist "Quantum Patent Talk" (deadcatlivecat.com, June 30, 2022).

Moderator of "Best Practices In The Covid Era" (New York Intellectual Property Law Association Webinar, New York, New York, February 24, 2021).

Panelist "Patents And Artificial Intelligence 101" (Warrall F. Mountain Inn of Court, May 24, 2021).

Panelist "Direct And Cross Examination Of Expert Witnesses," (Zuber Lawler CLE Program, December 7, 2020).

Panelist "Examination And Cross Examination Of An Expert," (Warrall F. Mountain Inn of Court, June 15, 2020).

Panelist "Preparing Witnesses for Deposition: Overcoming Challenges With 30(b)(6) Representatives and Fact and Expert Witnesses" (Strafford Publications, New York, New York, March 31, 2020).

Panelist "The Post-*Helsinn* Art of Patent Strategies" (ACC Southern California, Calabasas, California, February 15, 2019).

Panelist "Intellectual Property Assets in the Cannabis Industry" (CannaCon Seattle, Seattle, Washington, February 16. 2018).

Panelist "Patent Quarterly Update" (New York, New York, June 14, 2017).

Panelist "Preparing Witnesses for Deposition: Overcoming Challenges With 30(b)(6) Representative and Fact and Expert Witnesses" (Strafford Publications, New York, New York, January 12, 2017).

Moderator "Recent Developments in Practice Before the USPTO: Ethics In Practicing and New Programs and Procedures" segment of New York Intellectual Property Law Association "One-Day Patent CLE Seminar" (New York, New York, November 17, 2016).

Panelist "NYIPLA/USPTO Quality Check – One Year Later" (New York, New York, June 14, 2016).

Moderator "Current Initiatives of the USPTO" segment of New York Intellectual Property Law Association "One-Day Patent CLE Seminar" (New York, New York, November 18, 2015).

Panelist "Preparing and Defending Your Witness: Guidance and Ethical Considerations for Fact Witnesses, Corporate Representatives and Experts" (Commercial Law WebAdvisor, New York, New York, May 14, 2015).

Panelist "The Rapidly Changing Patent Law Landscape: What Entrepreneurs, Investors, Inventors, Lawyers and Judges Need To Know (RPI, Troy, New York, April 5, 2015).

Moderator "Litigation" segment of New York Intellectual Property Law Association "One-Day Patent CLE Seminar" (New York, New York, November 20, 2014).

Panelist "The Role Of The Patent Attorney" (U.S. Patent And Trademark Office IP Workshop, Columbia University, New York, New York, September 23, 2014).

Panelist "Interactive Ethics Presentation" segment of New York Intellectual Property Law Association "One-Day Patent CLE Seminar" (New York, New York January 16, 2014).

Panelist "Can You Practice Law In The Cloud? Ethical Considerations" (Zuber Lawler Webinar December 5, 2013).

Panelist "*Tivo v. EchoStar*: Waiver And Redesign Issues" (IPO Webinar, May 19, 2011).

Panelist "*Hyatt v. Kappos*: The Right To Introduce New Evidence And Standard OF Review" (JPPCLE 2011, New York, New York, April 27, 2011).

Panelist "Making Sense Of Developing Post-*Bilski* Jurisprudence" (Ropes & Gray Roundtable, New York, New York, April 5, 2011).

Panelist "Business Method Patents in Biopharmaceuticals: Fad Or The Real Deal?" (BIO 2007, Boston, Massachusetts, May 9, 2007).