



## Eugene Y. Mar

Partner

[emar@fbm.com](mailto:emar@fbm.com)

San Francisco: 415.954.4927

Eugene Mar leads Farella's Technology Industry Group. He specializes in representing technology companies in intellectual property litigation, advising emerging companies on strategies for building and diversifying their intellectual property portfolios, and counseling clients on IP licensing and best practices for trade secret protection.

As an IP litigator, Eugene has prevailed in trade secret, patent, trademark, and IP licensing litigations at every level, including multiple jury trials and appeals. His cases have involved an equally broad range of technologies including solid state disk controllers, QR codes, computer storage and networking products, web browser architecture, topological data analysis, mobile device operating systems, microprocessor architecture, drug-eluting stents, protein synthesis, capillary electrophoresis, data encryption and decryption, payment card security technology, and signal abstraction.

Clients value Eugene for his ability to align legal strategy with the client's business interests and his strategic thinking in seeking the quickest path to an early adjudication on the merits of a case. If, however, a trial is inevitable, Eugene is an experienced, aggressive, and effective advocate, equally skilled at handling both day-to-day disputes, and major, bet-the-company cases.

Eugene also advises emerging and growth companies on cost-effective intellectual property protection strategies. He typically bases his strategy on an analysis of the location and impact of a client's core technology in the marketplaces in which it competes, particularly relative to competitors. He also counsels early-stage clients in developing diversified intellectual property assets with the ultimate objective of building a strong, defensible portfolio. This work has included conducting due diligence for companies looking to build IP portfolios by acquiring patents.

Day-to-day, Eugene also assists emerging companies with drafting and negotiating a variety of IP-related agreements, including non-disclosure, assignment and license agreements as well as cloud-based software usage agreements and licenses.

### Distinctions

- *Managing Intellectual Property's* IP Stars - Patent Litigation (2018-2022)
- Euromoney Legal Media Group, Americas Rising Stars shortlist, Best in Patent (2019)
- *Benchmark Litigation* "40 & Under Hotlist" (2017-2019)
- *The Recorder's* inaugural list of 50 "Fast Track" lawyers in California (2012)
- Euromoney Legal Media Group to the shortlist of the inaugural Americas Rising Stars Awards in the "Best in Patent" category (2018)
- *Best Lawyers in America* in Litigation - Patent Law (2023)

### Memberships and Affiliations

- Past Chair, Intellectual Property Section, Bar Association of San Francisco
- Co-chair, Intellectual Property Roundtable Committee, ABA Litigation Section

### Services

- Intellectual Property Litigation
- Trade Secrets Litigation
- Patent Litigation
- Technology
- Data Center
- Internet Law
- Privacy and Cybersecurity
- Platforms

### Education

- Harvard Law School (J.D., 2003)
  - Article Editor, *Harvard Journal of Law and Technology*
- University of California, Berkeley (B.A., 2000)
  - Graduated with Distinction in General Scholarship
  - Legal Studies and History

### Bar Admissions

- California

## Experience

### **Profectus Technologies v. Google LLC**

Represented Google LLC in its complete defense verdict from a Texas federal jury in the Western District of Texas in a case alleging that Google's Nest Hub and Nest Hub Max devices infringed a patent asserted by Profectus Technologies. The jury found that the asserted claims of the patent were invalid and that Google did not infringe.

### **Networking and Cybersecurity Solutions Company Patent Infringement Lawsuit**

Represented a multinational networking and cybersecurity solutions company in a 6-patent infringement lawsuit in the Western District of Texas and in the related IPR proceedings. The lawsuit accused a broad range of data center-related technology, including routers, switches, firewall devices, and the company's operating system of infringement. The matter resolved with a settlement favorable for our client.

### **Symbology Innovations v. Muji Ltd.**

As lead counsel, successfully defended Muji in the U.S. District Court for Delaware in a multi-patent case relating to QR code technology.

### **Adobe Prevails in Writ of Mandamus Petition Seeking Transfer Out of WD of Texas**

The Federal Circuit Court of Appeals granted Adobe Inc.'s writ of mandamus petition seeking to transfer a patent case from the U.S. District Court for the Western District of Texas to Adobe's home forum in the Northern District of California.

### **Altbaier v. Down-Lite**

In this action, we represented the defendant/employer, Down-Lite, who develops and sells proprietary blends of down and feather, in the California-based companion action brought by the employee/shareholder to a misappropriation of trade secrets and breach of contract action filed in the Southern District of Ohio that had been filed by our client. The employee/shareholder was seeking preliminary injunctive relief to enjoin our client from enforcing a non-compete restriction and non-disclosure of trade secrets limitation in agreements he had signed with our client. Following a court hearing, we successfully defeated plaintiff's emergency motion for a temporary restraining order and obtained a complete dismissal of this action pending further proceedings in the Ohio proceedings brought by our client.

### **Huawei Technologies and Futurewei Technologies v. Yiren "Ronnie" Huang and CNEX Labs, Inc.**

After a 3-week jury trial in Eastern District of Texas, successfully defended start-up CNEX Labs in a bet-the-company case against all claims of trade secret misappropriation, CFAA, RICO, and tortious interference brought by Huawei Technologies and Futurewei Technologies and attained a finding of misappropriation of trade secrets against Huawei in the field of SSD controller technology.

### **BladeRoom v. Facebook and Emerson**

After a five-week jury trial before the U.S. District Court for the Northern District of California, our team won for UK-based BladeRoom a \$30 million verdict against global manufacturing giant Emerson for willful and malicious misappropriation of trade secrets and breach of a non-disclosure agreement relating to BladeRoom's revolutionary new methodology for constructing warehouse-sized data centers. The Daily Journal named this one of the "Top Verdicts" in California in 2018. The Court subsequently awarded BladeRoom an additional \$30 million in exemplary damages and \$17 million in prejudgment interest, for a total judgement exceeding \$77 million. Our client settled with Facebook after the first week of trial.

**Blue Spike v. Adobe Systems**

Defended Adobe Systems in a five-patent case relating to signal abstraction technology involving 70+ defendants. We successfully obtained a transfer of venue from the Eastern District of Texas to the Northern District of California followed by a judgment of non-infringement. Argued appeal before Federal Circuit seeking recovery of attorney's fees.

**Tridia Corp. v. NTT Resonant Corp.**

Served as lead counsel for this subsidiary of Japan's largest telecom company, Nippon Telegraph & Telephone Co., in its first ever patent litigation in the United States. The case filed in Georgia Northern District Court presented unique questions involving the role of special masters to resolve section 101 motions and personal service of Japanese companies in the United States under the Federal Rules of Civil Procedure.

**Purple Leaf v. Google, Inc.**

Defended Google Checkout in the Eastern District of Texas against assertions that it infringed a patent owned by Purple Leaf that purportedly disclosed a way to conduct an online transaction directly between merchant and buyer. After initial pleadings, we were able to attain a dismissal of the claims against Google.

**MAZ Encryption v. Dell Inc.**

Defending Dell Inc. in the U.S. District Court for the District of Delaware against allegations that its DDPE and DDPA products infringe two patents.

**Rotatable Technologies v. Motorola Mobility LLC and Quickoffice Inc.**

Obtained a non-infringement judgment for defendants Motorola Mobility and Quickoffice Inc. on 47 mobile devices in a patent case in the U.S. District Court for the Eastern District of Texas. Judgment was upheld on appeal.

**Round Rock Research v. Dell Inc.**

Defended Dell in the U.S. District Courts for the Eastern District of Texas and the District of Delaware against allegations that its products infringed 20 patents across a wide range of technologies involving DRAM, server management and monitoring, and BIOS.

**e-Micro Corporation v. Google, Inc.**

Defended Google against allegations that Google Checkout infringes a patent allegedly related to electronic payment transactions conducted on the Internet.

**Cioffi, et al. v. Google Inc**

Defended Google in the U.S. District Court for the Eastern District of Texas in a four-patent case relating to multi-process web browsers. The case is currently pending a post-trial invalidity decision based whether the reissue patents improperly recaptured disclaimed subject matter under 35 USC section 251.

**Restricted Spending Solutions v. Allow Card**

We won summary judgment of invalidity for our client Visa USA, Inc. in this patent action filed in Chicago asserting a patent over an "allowance" card for teens that can be controlled by the parent. This was a significant victory. Not only is a summary judgment of invalidity rare, but the well-known NPE Acacia was the ultimate owner of the plaintiff and had managed to exact settlements with many of the other eighteen defendants. 743 F. Supp. 2d 954 (N.D. Ill. 2010)(granting summary judgment).

**Every Penny Counts, Inc. v. American Express Co., et al.**

Defended Visa U.S.A. Inc. in a case where the plaintiff accused Visa's gift card technology of infringing five

patents. We prevailed on a case-dispositive claim construction at the district court, leading to a stipulated judgment of non-infringement on all five patents. The Federal Circuit upheld the claim construction and judgment on appeal. 563 F.3d 1378 (Fed. Cir. 2009). A petition for en banc rehearing and petition for writ of certiorari were both denied.

### **3M Innovative Properties v. The Clorox Company**

We represented Clorox, Brita, Pentair and Sears in a patent infringement lawsuit brought by 3M and its Cuno subsidiary in Minneapolis. The case involves two patents covering replacement water filters used in refrigerators. The court issued a favorable claims construction for Defendants in December 2007 as part of a ruling denying summary judgment. The case then settled on terms favorable to our clients.

## **Publications**

January 31, 2023

### **Failures Are Valuable IP: Protect Your Startup's Negative Trade Secrets**

*TechCrunch+*

January 27, 2023

### **How To Avoid Allegations of Trade Secret Misappropriation in California**

*Daily Journal*

January 18, 2023

### **Under FTC's New Proposed Rule, Employers Will No Longer Be Able to Rely on Noncompete Agreements**

November 21, 2022

### **Highlights from 2022 Unified Patents Corporate IP Strategy Conference**

November 9, 2022

### **How Companies Can Stop Trade Secret Disclosure in California**

*Bloomberg Law*

October 5, 2022

### **Protecting "What Not to Do" as a Negative Trade Secret**

*Daily Journal*

July 27, 2021

### **SCOTUS Copyright Fair Use Decision: Google vs. Oracle Recap and Takeaways**

January 28, 2021

### **Tips For Banks As USAA Check Deposit Patent Dispute Grows**

*Law360*

January 26, 2021

### **IP Law up for Best Supporting Role in the COVID-19 Relief Spending Bill and Other New Legislation**

*The Recorder*

October 22, 2020

### **Insights Into the First Patent Trial in Waco, Texas - MV3 Partners v. Roku**

February 3, 2020

### **Strategy Lessons From Wells Fargo Fintech Patent Litigation**

*Law360*

December 31, 2019

### **Trade Secret Hygiene for Current Employees**

*ACCDocket.com*

November 21, 2019

**How Defense Strategies Can Go Awry When Pursuing Concurrent PTAB Relief in Financial Services Patent Litigation**

November 6, 2019

**Practices to Protect Trade Secrets in Failed Acquisitions and Customer Relationships**

*ACCDocket.com*

October 4, 2019

**Securing Against Trade Secret Pitfalls and Dangers Arising From Employee Mobility Situations**

*ACCDocket.com*

2/2/2017

**The Northern District of California Seeks to Bring More Clarity to Damages with its Latest Revised Patent Local Rules**

12/28/2016

**IP Law December Developments: What to Expect in the Future**

5/5/2016

**IP and Employment Implications of the Defend Trade Secrets Act to be Discussed at May 24-25 Roundtable Programs**

4/20/2016

**Keep These Cases in Mind When Segmenting Patents**

11/12/2015

**ITC Has No Jurisdiction to Block Infringing “Electronic Transmissions”**

9/25/2015

**Drafting Intellectual Property Agreements: Best Practices From a Litigator’s Perspective**

5/14/2013

**Federal Circuit Issues Decision on Section 101 Patent Eligibility of Computer-Implemented Inventions**

2/13/2013

**Court Hears Arguments on Patent Eligibility of Computer-Implemented Invention**

12/29/2008

**In Re Bilksi: Has the Federal Circuit Overly Restricted What is Patentable Subject Matter?**

12/1/2008

**Fighting The Brand Your Trademark from Being Misused on Search Engines**

## Outside the Office

Eugene is a Bay Area sports fan, an enthusiastic (if amateur) swimmer, and fond of exploring new restaurants and premium whiskeys.