

## James W. Morando

Of Counsel

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James Morando is a leading trial lawyer who has a diverse litigation practice with an emphasis in intellectual property, technology-related disputes, and complex litigation. Trusted by clients for more than 30 years, James has a depth of experience in handling and winning high-stakes cases. His comprehensive background includes providing advice, counseling, and handling disputes relating to patent, antitrust, copyright, trademark, trade secret, Internet, software, and other technology and licensing disputes.

James is known for his extraordinary talents in translating the complicated, technical, and/or the scientific into a straightforward and compelling language that is understood and appreciated by juries, judges, his colleagues, and his clients. He is chosen to serve as lead counsel on significant, bet-the-company types of engagements repeatedly for his winning track record, insightful judgment, strategic intelligence, and his financial aptitude that result in winning solutions. To his clients, he is a devoted adviser, a highly effective strategic case evaluator, and a powerful advocate.

He has tried numerous high-profile cases in both federal and state courts, as well as in complex arbitration proceedings throughout the country. James has significant experience in handling numerous multi-party cases. He was the founder of the firm's Intellectual Property Litigation Practice Group.

Recent notable mentions:

- In 2011, James was the lead trial counsel and strategist for Volterra Semiconductor in a three-week trial resulting in a jury verdict upholding the validity of all asserted claims of Volterra's key patents for flip chip integrated power switches for use in voltage regulators against a multitude of validity challenges by much larger and well funded defendants.
- In 2011, James obtained complete dismissal of a lawsuit filed against his client Limelight Networks by a patent broker alleging significant claims for intentional interference and breach of a non-disclosure agreement. He was not only able to have the complaint dismissed at the outset based on a motion to strike under California's Anti-SLAPP statute, he also obtained a substantial award of fees and costs for his client.

### Services

- Intellectual Property Litigation
- Business Litigation
- Patent Litigation

### Education

- University of California, Berkeley, School of Law (J.D., 1979)
  - . Associate Editor, *California Law Review*
- University of California, Berkeley (A.B. - Economics, 1976)
  - . Economics

### Court Admissions

- U.S. Supreme Court
- Federal Circuit Court of Appeals
- 9th U.S. Circuit Court of Appeals
- U.S. District Court (N.D. Cal.)
- U.S. District Court (C.D. Cal.)
- U.S. District Court (E.D. Cal.)
- U.S. District Court (S.D. Cal.)
- U.S. District Court (E.D. Texas)
- U.S. District Court (W.D. Texas)

- James acted as lead counsel defending Dell in several patent infringement cases in the District of Delaware involving aspects of smart phone and tablet technology.
- James is active with the Sedona Patent Law Conference, which is a one of the leading “think tanks” to address the cutting edge issues in patent law to move the law forward in a reasoned and just way. He recently served as a panel group leader at the 12th annual Sedona Patent Law Conference, and is a group leader of WG9 focusing on patent law damages and remedies.

## **Distinctions**

- Northern California Super Lawyers

## **Memberships and Affiliations**

- Fellow of the Litigation Counsel of America

## **Experience**

### **Volterra Semiconductor v. Primarion & Infineon Technologies**

We obtained a unanimous verdict in a three-week patent jury trial for our client Volterra Semiconductor in the United States District Court for the Northern District of California upholding the validity of Volterra's key patents for flip chip integrated power switches against challenges by defendants Infineon and Primarion. Infringement in favor of our client had been determined prior to trial as a result of key rulings we obtained in favor of Volterra in connection with claims construction and summary judgment proceedings.

### **Creo Products v. Dainippon Screen**

Successfully defended Japanese manufacturer Dainippon Screen against patent infringement and trade secret claims brought in the United States District Court for the Western District of Washington. Obtained summary judgment of non-infringement in our client's favor based on application of prosecution history estoppel, and summary judgment dismissing all other claims and an award for attorneys' fees in favor of our client. The district court judgment was affirmed in all respects by the Federal Circuit.

### **321 Studios v. Metro-Goldwyn-Mayer Studios, Inc. et al.**

Represented nine major motion picture production companies in litigation related to a software product called "DVD Copy Plus," which allowed users to decrypt copy-protected DVDs and to duplicate and transfer the copyrighted contents and issues of first impression relating to the Digital Millennium Copyright Act, as well as copyright infringement claims, including challenge to the constitutionality of the anti-trafficking provisions of the DMCA.

### **Actus LLC v. Bank of America Corp, et al**

We defended Sonic Solutions in litigation filed in the Eastern District of Texas by Actus LLC, a patent holding company, that asserted infringement claims on four patents relating to an electronic payments system directed at companies offering prepaid gift cards and online payment options for customers. We were able to obtain an early favorable settlement for Sonic to avoid further costly legal proceedings.

### **BCCI v. Principal Builders, et al.**

Successfully defended the founders of a start-up company who were sued in California state court by their former employer in the commercial design business based on claims of alleged misappropriation of trade secrets, breach of employment contracts and restrictive covenants.

### **Chris Arsenault v. Roger Wagner Publishing, Inc.**

Successfully defended the former owner of Roger Wagner Publishing, Inc. against a claim by a software programmer for alleged joint authorship and ownership of the copyright to the successful multimedia educational software program Hyperstudio.

**City of San Jose v. Paine Webber, Jackson Curtis, Inc., et al.**

Defended William E. Pollack & Company in trial against claims by the City of San Jose arising from losses in excess of \$70 million for alleged securities fraud and churning of City funds invested in reverse repurchase bond transactions. (*U.S. District Court, Northern District of California*)

**Compression Labs v SanDisk Corporation, et al**

Represented AverMedia, a Taiwanese manufacturer, in connection with patent infringement claims asserted by Compression Labs relating to patents for digital compression technology.

**Corporate Health Care Financing, Inc. v. Chris Fletcher and Tri-City Benefits, et al.**

Successfully defended Tri-City Benefits and Chris Fletcher in a lawsuit filed in the United States District Court for the District of Maryland by the former employer of Mr. Fletcher which sought preliminary injunctive relief based on claims of alleged misappropriation of trade secrets, breach of restrictive covenants and solicitation clauses in Mr. Fletcher's employment contract, as well as alleged theft and improper disclosure of confidential business information relating to the employee benefit plan industry. After conducting extensive expedited discovery proceedings and avoiding a preliminary injunction, was able to settle this case for our clients on favorable terms.

**CyberMedia v. Symantec, et al.**

Represented an Atlanta-based software development company and its officers in connection with copyright and trade secret claims arising out of the development and sale of a popular software program.

**Danisco, et al. v Syngenta**

Representing Danisco in litigation pending in United States District Court for Northern District of California relating to enforceability of restrictive covenant in senior executive employment contract.

**Digital Instruments v. Topometrix**

Represented Topometrix in defending claims of patent infringement and asserted Walker-Process antitrust counterclaims in litigation involving two of the leading manufacturers of atomic force microscopes. We obtained a favorable settlement for our client.

**Diversified Collection Services, Inc. v. E.A. Smith**

Obtained a judgment in excess of \$1 million after trial in a AAA arbitration based on claims of breach of contract arising from a custom software development project for one of the nation's leading student loan collection companies.

**Do-Lin Metal, et al. v. DS-Max Int'l, et al.**

Represented DS-Max in this patent infringement action filed in the Northern District of California. The case involved several design and utility patents on a carrying container for tools, and was successfully settled.

**Dolby Laboratories v. Smart Devices, Inc.**

Represented Dolby in a suit for trademark infringement, unfair competition and false advertising to enforce Dolby's intellectual property rights related to one of its latest sound innovations – SURROUND EX. The case was filed in the Central District of California and resulted in a favorable settlement for our client.

**Drexler Technology v. Dolby Laboratories, Inc., et al.**

This case, filed in the Northern District of California, involved patent infringement claims asserting that Dolby Digital sound-on-film technology infringed patents held by the plaintiff, Drexler Technology Corporation. In addition to defending Dolby Laboratories, also represented a number of major entertainment companies (including Walt Disney Pictures, Fox, MGM, Universal Studios and Columbia Pictures) in this action. After obtaining a claim construction (“Markman”) order supporting virtually every claim construction position advocated on behalf of our clients, the Court entered summary judgment in the defendant's favor on grounds of non-infringement and patent invalidity.

**Eltoukhy v Castagna**

Defended Paul Castagna and Golden Gate Financial against claims of trade secret misappropriation relating to development of computerized market timing systems. Evidentiary hearing in Santa Clara Superior court on application for preliminary injunction.

**Grunfeld v Taldan Investment Co.**

Represented Ernie Grunfeld (current President of Basketball Operations for the Washington Wizards and former NBA star) in a two week trial before U.S. District Court Judge Lowell Jensen to successfully prosecute claims for breach of contract and breach of fiduciary duty against Taldan Investment Company arising from failed real estate investments. (*U.S. District Court, Northern District of California*)

**Gump v Wells Fargo Bank (San Francisco Superior Court)**

Defended Wells Fargo Bank in a four month trial against multi-million dollar claims for breach of trust and breach of fiduciary duty. The trial involved a challenge to the bank's role as trustee for the Gump trust, whose primary assets were the Gump's department store in San Francisco, in addition to various real estate holdings and other assets. (*San Francisco Superior Court*)

**Hewlett-Packard v. Advanced Laser Products**

Successfully represented a small company that was charged with trademark infringement by Hewlett-Packard. After defeating Hewlett-Packard's application for a preliminary injunction, was able to negotiate a favorable settlement for our client.

**In Re Napster, Inc. Copyright Litigation**

Represented both Napster, Inc. and Musicnet in connection with the Napster litigation involving copyright and antitrust claims.

**Ischemia Research and Educational Foundation v Pfizer, Inc., et al.**

We defended Pfizer, Inc. against claims of trade secret misappropriation in Santa Clara County Superior Court. The plaintiffs' misappropriation claims arise out of clinical drug trials for Bextra, a second generation COX-2 inhibitor.

**Macromedia v. Ashford.com**

Represented Macromedia in connection with an action against Ashford.com for claims arising from a software license and consulting agreement relating to Macromedia's LikeMinds software. We succeeded in avoiding extensive discovery and obtaining a prompt and favorable settlement for our client.

**MPS Acquisition, Inc. v Micro Power Systems, Inc., et al.**

Defended Micro Power Systems, Inc. in a multi-million dollar suit for breach of contract, fraud and conspiracy resulting from failed acquisition negotiations. Obtained judgment for the defendant, and then acted as lead counsel in a trial in Santa Clara Superior Court before the Honorable Conrad Rushing to successfully establish alter-ego liability against the principals of MPS Acquisition, Inc. to enforce recovery on cross-

complaint. Obtained a verdict in favor of plaintiffs on all issues, which was affirmed on appeal.

#### **Pragmatic C Software v. Cadence Design Systems**

Represented a third party software developer in arbitration to assert claims relating to a dispute over licensing royalties and copyright infringement. Successfully obtained a multi-million award the developer after a 14 day trial.

#### **S.Com v InServe**

Successful defended venture capital fund at trial against various alter ego theories seeking to establish liability of investment entity.

#### **Steele v. Nokia**

Represented Nokia in a first-impression case in which the plaintiff has brought a products liability claim against Nokia arising out of the use of cellular technology in an automobile. A successful dismissal was obtained.

#### **Visa International v. J. Frank Consulting**

Represented Visa International and obtained a significant settlement through mediation based on claims of breach of contract and fraud in a custom software performance and development dispute involving Visa's global customer support service software.

#### **Wavelink Media v. Stoneground Solutions**

Represented three former employees and their start-up website design company in litigation filed by their former employer (another website design company) based on claims of alleged misappropriation of trade secrets (including client lists, marketing strategies and website design techniques and styles), trademark infringement and copyright infringement. The case was settled favorably for our clients through mediation.

## **Publications**

June 17, 2016

#### **Supreme Court Lowers the Bar for Willfulness and Provides Major Win to Patent Holders**

May 5, 2016

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

November 28, 2012

#### **Northern District of California Issues New Guidelines and Model Order on E-Discovery**

November 26, 2012

#### **Insurance Coverage Against Patent Infringement Suits by Non-Practicing Entities**

September 21, 2011

#### **What's Hot in Patent Law?**

July 13, 2011

#### **Prometheus: Bound for Clarification or Confusion?**

April 1, 2011

#### **Gene Patents at Risk in Information Age**

February 10, 2011

**Federal False Patent Marking Payments to the United States**

December 22, 2010

**Exposure And Settlement Value In False Marking Claims**

August 19, 2010

**Strategic Considerations in the Parallel Universe of Patent Reexamination and Patent Litigation**

May 20, 2008

**Defending Trade-Secret Claims: How companies can best protect themselves**