



EXPERT TESTIMONY FEATURED ENGAGEMENTS



OCEAN TOMO®
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Our Opinion, Management, and Advisory Services are built upon more than three decades of experience valuing intellectual property in the most rigorous of venues – State, Federal and international courts. Our financial and market experts along with leading technologists, provide a unique understanding of the contributory value of proprietary innovation.

Collectively, Ocean Tomo professionals have:

- Completed over 1000 engagements involving IP worth in excess of \$10 billion including over 300 valuation and 500 financial damages expert testimony engagements;
- Successfully closed hundreds of IP sale transactions with a cumulative transaction value well in excess of \$750 million;
- Served as a trusted advisor involving the biggest IP transactions in history;
- Originated more successful IP monetization solutions than any other firm, including creation of the world's oldest and most successful live patent auction.

Our track record of results spans more than 100 different industry segments. Because our past success provides the best indication of our capabilities, we are proud to feature a few representative engagements and encourage potential clients to seek references from past clients.

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 Managing Director James E. Malackowski opined as to the damages in the case.

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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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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 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

Deposition & Trial Testimony

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 Managing Director James E. Malackowski opined as to the damages in this case on behalf of U.S. Venture.

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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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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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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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IN THE MATTER OF CERTAIN 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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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 en-joined from selling the infringing products.

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EXPERT TESTIMONY

BROCADE COMMUNICATIONS SYSTEMS, INC. AND FOUNDRY NETWORKS, LLC V. A10 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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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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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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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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About Ocean Tomo

Ocean Tomo, the Intellectual Capital Merchant Bank® firm, provides financial services related to intellectual property and intangible assets including financial expert testimony, intellectual property and complex financial instrument valuation, strategy consulting, risk and regulatory compliance, patent analytics, investment advisory, innovation management consulting and transaction brokerage.

Headquartered in Chicago, Ocean Tomo has offices in Greenwich, Houston, San Francisco, and Shanghai.

Subsidiaries of Ocean Tomo include: Ocean Tomo Investment Group, LLC, a licensed broker-dealer under Federal and State securities law (brokercheck.finra.org Broker Check CRD #: 172912); OTI Data Networks, LLC and Patent Marking, LLC..

Ocean Tomo assists clients – corporations, law firms, governments and institutional investors – in realizing Intellectual Capital Equity® value broadly defined.

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