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Ocean Tomo provides industry leading financial products and services related to intellectual property. Our comprehensive professional offering is built upon more than three decades of experience valuing intellectual property in the most rigorous of venues – State, Federal and international courts. Our financial, market and technical experts have a unique understanding of the contributory value of proprietary innovation. This is the cornerstone of our business. This insight permeates every practice and client engagement.

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

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.

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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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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Background

A company with a significant portfolio of domestic and international patents and patent applications was considering a variety of M&A options, driven by a recent offer for the company. The portfolio of IP was clearly the most valuable asset of the business, however, it appeared to be significantly understated on the balance sheet. Due to the size of the portfolio and resource constraints, the company was unable to properly categorize its patent portfolio to its product line, and also had a keen interest in understanding the quality of its portfolio in relation to its top competitors.

Engagement

Ocean Tomo produced comprehensive and timely deliverables, providing the company with an understanding of the quality and value of its portfolio, allowing it to meet stringent internal deadlines for formulating its near-term business strategy.

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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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PUBLIC COMPANY PRIVATIZATION

Background

A private equity group was considering the acquisition of a publicly-traded company for the immediate purpose of privatization and to then provide growth capital. The target company had established a very strong and large domestic and international patent portfolio, and had a heavily experienced management team in place that provided the foundation for accelerated growth opportunities.

Engagement

Ocean Tomo was retained to provide merger and acquisition (M&A) support. With IP being the key asset in the business, Ocean Tomo performed a valuation analysis that provided the equity investor with the comfort of not only the short-term cash flow opportunities, but more importantly the long-term revenue opportunities due to the strength of the portfolios and the quality of the engineering team that showed consistent efficiency in its identification and acquisition of critical portfolios.

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Background

Nortel Networks (“Nortel”) was a multinational telecommunications and data networking equipment manufacturer with global headquarters in Ontario, Canada. Nortel was regarded as a highly technologically innovative organization and at one point, was Canada’s largest publicly traded company. Despite its past success, Nortel struggled to remain competitive in the early 2000s and by the 2008 recession it was clear the firm would no longer be able to continue servicing its debt. In early 2009 the company filed for creditor protection and subsequently auctioned off its assets. These assets included the company’s business lines and nearly 2,500 associated patents, and ultimately, the remaining Nortel IP portfolio consisting of over 7,000 patents which was sold to Rockstar, a consortium of technology companies including Apple and Microsoft. These sales generated over $7 billion in proceeds while the claims submitted by creditor consortia from Canada, from the U.S., and from Europe, the Middle East, and Africa (“EMEA”) exceeded $35 billion. After several years of failed attempts to negotiate the allocation of sales proceeds, the parties proceeded with litigation.

Engagement

Ocean Tomo was hired in 2013 by the EMEA debtors to assist with all valuation and allocation issues related to Nortel’s IP. In order to determine the appropriate allocation of sales proceeds, Ocean Tomo:

- Performed an independent valuation of the ~2,500 patents and other IP which was sold along with Nortel’s various business lines;
- Performed an independent valuation of the 7,000+ patents sold to Rockstar;
- Determined the appropriate commercial life of Nortel’s IP portfolio;
- Determined the geographic distribution of the income expected from Nortel’s patents;
- Determined the relative inventive and financial contributions made by each debtor over a period spanning more than two decades;
- Determined the relative value of exclusive and non-exclusive license rights to all Nortel patents in numerous jurisdictions;
- Analyzed and interpreted dozens of Nortel’s inter- and intra-company agreements including numerous IP licenses and transfer pricing agreements.

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CENGAGE LEARNING, INC.

Background

Cengage Learning, Inc. ("Cengage"), a private equity-backed education company, filed for bankruptcy protection on July 2, 2013 as part of an effort to shrink its $5.8 billion debt load.

Engagement

Ocean Tomo was hired by management of Cengage to serve as its lead intellectual property financial advisor and determine the value of certain intangible assets.

Our role as intellectual property advisors included participation in all aspects of the valuation of certain unperfected copyrights, as the value of these assets was an early variable between the creditors on how to allocate value under the plan of reorganization. In the case of Cengage, new copyrighted works were being generated so often that Cengage and its creditors chose to file security liens with the U.S. Copyright Office periodically (e.g., quarterly) rather than each time a new work was created. As a result, security interests in certain copyrights owned by Cengage had not been properly perfected under the U.C.C. at the time of the bankruptcy filing. Consequently, the challenge arose as to which creditor held the rights to these unperfected copyrights and how to allocate the value of those assets.

Ocean Tomo undertook a highly quantitative and nuanced approach to valuing these IP assets. In the course of this engagement, we:

• Performed an independent valuation of the 15,000+ subject copyrights by utilizing a hybrid analysis consisting of the Excess Earning and Relief from Royalty methodologies;
• Determined the appropriate economic life of the subject copyrights;
• Utilized complex content allocation factors to develop revenue projections that reflected the unique content that was created specifically for the subject copyrights;
• Developed revenue projections for future revisions of the subject copyrights to account for unique content that is carried from one textbook edition to the next;
• Analyzed and interpreted royalty rate data related to the subject copyrights, as well as data from dozens of third-party publishing license agreements.

Results

On March 31, 2014, Cengage completed its financial restructuring and successfully emerged from its Chapter 11 reorganization.

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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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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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Background
A mid-cap internet software and services company retained Ocean Tomo to help the firm both generate value from a particular subset of their IP portfolio and – more broadly – with their overall IP/innovation strategy relating to their future goals. In the first phase of this assignment Ocean Tomo provided a series of strategic options for the company, and the second phase structured to implement, at the company’s election, the chosen option(s).

Engagement
Ocean Tomo initiated the engagement with a high-level business review to further develop our understanding of the company’s market position, business strategy and goals, technology road map, and historical ability to execute its IP and business strategy. Ocean Tomo not only reviewed the company documents and product markets, but also conducted interviews with key company product development, corporate development, and C-suite personnel to gain the requisite understanding of the company’s business.

We analyzed the individual assets within the patent portfolio to distinguish the most valuable and commercially viable patents. Applying our thorough comprehension of the technology, we then classified the patent portfolio into discrete sub-technology buckets to develop patent landscapes, which allowed us to both identify third party entities with related IP and assess a high-level relative positioning of the sub-portfolios in their relevant markets.

Ocean Tomo then conducted an external review, leveraging years of director level management consulting and IP strategy expertise to consider and evaluate the successful IP strategies of other companies and industries to determine the appropriate fit as it particularly related to the company. Armed with an in-depth understanding of existing external market strategies and the company’s high-level business position and objectives, patent quality, and patent landscapes, we synthesized the results of our analyses to develop a set of tailored options, next steps, and requirements for leveraging the portfolio.

Results
The Phase I deliverable included strategic options beyond the commonplace shield and sword approaches to IP value generation, also including IP strategies to facilitate self-funding innovation cycles, outsourced innovation platforms, and the development of ecosystems.

The company has gravitated toward a few of the more creative approaches to leveraging their portfolio within their broader innovation strategy, and is awaiting internal approval to commence a Phase II engagement with Ocean Tomo.

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PORTFOLIO COMPANY MERGER

Background

A private equity group was considering the merger of two portfolio companies; one the developer of the IP and the second being the first commercial implementer of the technology.

Engagement

Ocean Tomo was retained to provide merger and acquisition (M&A) support. Ocean Tomo completed a valuation of the early stage technology where our analysis was an integral contributor to the completion of the merger and also helped establish the accurate opening balance sheet of the consolidated entity.

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Background

A Fortune 500 medical device company in the process of changing its innovation culture hired new intellectual property (IP) management to restructure the IP law group.

Engagement

Ocean Tomo was retained to assist the company in redefining its IP strategy. Ocean Tomo provided strategic consulting focused on an:

- Assessment of its current IP management practices;
- Inventory of its IP holdings;
- Alignment of its products to its patents;
- Analysis of its competitors across multiple product segments, with periodic updates of those competitors’ activities.

Results

Ocean Tomo encouraged increased internal patenting efforts through engineer training, jump-start disclosure sessions, and by developing an innovation reward program. Particular emphasis was placed on patenting in key long-term business lines. Further, Ocean Tomo identified mismatches in the client’s patent portfolio where the patents did not appear to be in line with their business objectives. Since these patents did not appear to contribute to their bottom line and forward looking strategic vision, Ocean Tomo recommended selling these assets not essential to particular businesses.

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Background

MIPS Technologies, Inc., a leading provider of industry-standard processor architectures and cores for home entertainment, networking, mobile and embedded applications, retained Ocean Tomo for the purpose of advising the company in connection with its desire to effectuate and maximize this IP driven transaction and to evaluate whether the consideration was fair to MIPS from a financial point of view.

Engagement

Ocean Tomo was retained by MIPS at the very beginning of the IP monetization process to advise on strategy. Over the course of about 18 months we helped identify the key assets and shape the type and value of the deal that was ultimately consummated. MIPS demonstrates what is possible when companies consider IP as a strategic business asset: a dramatic increase in shareholder value and an efficient transfer of technology.

MIPS and Ocean Tomo devised an atypical IP strategy early on in the monetization process, built around maximizing value, while keeping litigation and ecosystem risks to a minimum. The deal consummated closely followed the strategy and value forecasts that Ocean Tomo developed.

Results

The resulting transaction involved the sale for $350 million by MIPS to Bridge Crossing, LLC of all of its rights, title and interest in 498 active issued U.S. and foreign patents and patent applications. Bridge Crossing, LLC is a special purpose vehicle formed by Allied Security Trust I, a member-based defensive patent aggregator.

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Background

A leader in the high performance computing industry was undergoing operational restructuring. The company desired to better understand the types of technologies covered by its patent portfolio, the portfolio’s strengths and weaknesses relative to other industry participants, and how the portfolio could be used to support current and future business lines, including through monetization and acquisition of IP rights.

Engagement

The company retained Ocean Tomo to assist in developing and executing a strategic assessment of its IP. To help the client meet its goal, Ocean Tomo analyzed the client’s patent portfolio, its corporate strategy, and the market environment in which it operated. First we provided an assessment of the quality of the patents in the client’s portfolio and other related patent portfolios which was based on an analysis utilizing Ocean Tomo’s proprietary Ocean Tomo Ratings™ system, other tools and expert review. We then provided an analysis of the IP environment around the client’s patents, including a survey of IP litigation in the related technology areas, and assessment of relevant licensing and IP-driven M&A transactions. Taking a step back from IP, we provided an analysis of the markets in which the client operated, including market research to gauge the approximate market size of the products related to the potential monetization strategies we developed. Finally, we provided an analysis of various risks involved in potential monetization strategies (litigation blowback, client, vendor, ecosystem, reputation and other risks).

Results

Ocean Tomo developed three options that would generate revenue and realign the portfolio with the corporate strategy, creating opportunity for more focus on certain product lines important to the client’s growth. Ultimately the client opted to execute the option focused on divesting non-core assets in order to utilize the revenue to support development of key product lines.

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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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PRIVATE EQUITY FIRM FOR GLOBAL LIFE SCIENCES CORPORATION

Background

A leading global life sciences corporation was exploring strategic alternatives including a possible company sale. A private equity firm interested in acquiring the company engaged Ocean Tomo to perform due diligence on the potential target company's patent portfolio. To support the bid price calculation, the client required an understanding of the content and quality of the company’s intellectual property assets and their impact on the company’s business.

Engagement

Ocean Tomo provided a series of qualitative and quantitative analyses of the target company's patent portfolio and market environment.

Results

Ocean Tomo quantified the top intellectual-property related risks to revenue build and market share due to patent expirations. We identified patents expiring in key patent families and the vulnerabilities created by those expirations. Further, we identified numerous high quality recently issued or pending patents that could offset the key expirations. The client made the determination not to pursue the acquisition.

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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

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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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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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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Excerpt from the document:

**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

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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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.
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

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

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%. Untimely 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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Background

A group of Fortune 500 technology companies purchased the intellectual property portfolio of a multinational telecommunications and data networking equipment manufacturer out of bankruptcy. The technology assets, foundational to telecommunication services, network infrastructure equipment, mobile handsets, internet search and social networking, were placed into the joint-venture managed by experience technologist and licensing professionals. The owners, each with competing interests, decided that it was best to pursue strategic alternatives for the firm.

Engagement

Ocean Tomo advised management on a prospective buyout. Our team conducted extensive diligence of the opportunity, including detailed technical and financial analysis, and assisted with capital advisory. Our evaluation drove discussions around the portfolio’s value and the internal rate of return available to investors.

Results

The transaction garnished interest among various strategic and financial groups. As a result of our efforts, the portfolio sold for a 300% premium to the initial bid – having advised on two fully funded management buyout offers, initially unsolicited and then at the behest of the board.

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EXPERT TESTIMONY

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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Background

Understanding the value of the MOSAID patent portfolio was central to this transaction and required Ocean Tomo to interface directly with deal capital partners. The MOSAID transaction represents an important milestone in the evolution of IP into a discreet asset class. It is the first leveraged buyout driven exclusively by IP asset value.

Engagement

Ocean Tomo’s role as IP advisor on the transaction included participation in all aspects of IP due diligence and valuation.

Results

Ocean Tomo served as intellectual property (IP) advisor, supporting the acquisition of MOSAID Technologies Inc. by Sterling Fund Management, LLC, for a cash payment of $46.00 per share.

Contact

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Background
A global media protection technology company was seeking to increase its global footprint by bringing two of its seminal innovations to the U.S. market. Rather than pursue an aggressive intellectual property assertion strategy or sale to a non-practicing entity – both of which could alienate potential partners in the U.S. – their goal was to take a more creative approach, using their intellectual property to forge new relationships.

Engagement
Aware of Ocean Tomo’s reputation as a thought leader in multiple aspects of IP management, the company engaged us to assess both patent portfolios and develop custom monetization strategies for each. Ocean Tomo provided both Opinion and Management Services leveraging a senior team members from Innovation Management, Intellectual Property Strategy, and Valuation.

Our process began with a thorough investigation of the technologies in question, as well as the markets within which these technologies were most applicable. Subsequently, our technical experts characterized and rated the patents within the portfolios and identified additional patents issued to the company that would make the offering more attractive in the U.S. market. We then determined the value of the portfolios under several different scenarios, including acquisition by an operating company for defense, an industry-wide licensing campaign, and the formation of a technology-based consortium. Finally, we developed two custom monetization strategies: a pure asset sale for one portfolio and a commercialization / venture development strategy for the other.

Results
The company, pleased with our work product, further engaged Ocean Tomo to execute the recommended monetization strategies.

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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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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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Background

A privately-held cloud networking/optimization and mobile security firm sought to sell the business, including its foundational patent portfolio of 400+ assets. The technology developed by the selling entity over a 15-year span represented highly scalable and high reliability elements of network traffic optimization for carriers and had proven track records of deployment in mobile applications in massive scale.

Engagement

Ocean Tomo advised a prospective buyer through the process where the acquiring management team sought to create a highly integratable products and technology firm focused on cloud networking and cloud services, mobile applications and security/privacy services, and mobile device and network operations. Specifically, the new team intended to:

• Continue developing and selling the software services;
• License the technology to device manufacturers and service providers, including makers of smartphones, laptops and tablets; cloud and mobile application service providers; and network operators.

Results

Over the course of six months Ocean Tomo managed the process for the acquirer, which resulted in an offer to acquire the assets of the firm. Our team advised on all aspects of the transaction, from capital advisory to transaction diligence and valuation.

Contact

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Background

Fisker Automotive, Inc. (“Fisker”) is an American auto maker and creator of one of the world’s first production plug-in hybrid electric vehicles, the Fisker Karma. The company ceased production in November 2012 due to financial difficulties and eventually declared bankruptcy in November 2013.

Engagement

Ocean Tomo was retained by the purchaser of a defaulted Department of Energy (“DOE”) loan who succeeded the DOE as the senior secured lender. In February 2014, the assets of Fisker were successfully sold for a bid of almost six times what Fisker was seeking when it filed for bankruptcy. The various creditor groups were in dispute about the allocation of the proceeds from the sale of the company’s assets. In particular, the value contribution of the IP assets was a significant consideration as certain parties believed the international non-perfected IP rights to be of material value. Ocean Tomo provided initial valuation and advisory services related to Fisker’s IP portfolio of utility and design patents, outstanding patent applications, and trademarks.

Contact

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Background

Ocean Tomo was approached by the owners of a privately-held unified communications product and service company. The company had a large intellectual property (IP) portfolio of mobile, teleconferencing, security, endpoint and management software technologies and sought to monetize these assets.

Engagement

As part of a two-phase engagement, we first provided an in-depth evaluation and valuation of the portfolio and then assisted management with finding the optimal monetization structure.

Ocean Tomo began the project by conducting an independent technical review, categorizing and rating each individual patent in the portfolio. Concurrent with the categorization and ranking of each patent, we also reviewed relevant markets, product road maps, and the competitor landscape to better understand and assess the value of the portfolio as a whole. Our independent, phase one evaluation and valuation process deemed the portfolio to be market-ready.

As part of the second phase of the project, Ocean Tomo ran a targeted sales process for the portfolio of unified communication technologies.

Results

The company successfully monetized its portfolio, reaching numerous eight figure settlements with high-profile industry members. The company was recently acquired by a competitor, driven in part by the value of its IP.

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Background

A major financial services company began a program to regularly review its IP portfolio to establish monetization strategies to generate annuity revenue.

Engagement

Ocean Tomo’s analytics team was first retained to assess the quality of specified patents, as well as relevant competitors in terms of comparability of their IP portfolio using its proprietary Ocean Tomo Ratings™ system. The client then utilized the output of Ocean Tomo reports to make a determination as to which patents had the strongest licensing potential. Following this Ocean Tomo’s valuation group was retained in order to complete current fair market value assessments.

Results

The company was able to directly utilize Ocean Tomo’s deliverables to assist in the structure of license agreements, and were quickly able to demonstrate to senior management that a successful monetization strategy had commenced.

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EXPERT TESTIMONY

COMMONWEATH 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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Background
German chemical company, BASF, was exploring options to divest approximately 15 years of research and development in phosphorescent materials and technologies resulting in a portfolio of approximately 500 issued and pending patents related to OLED.

Engagement
BASF retained Ocean Tomo to monetize its extensive R&D efforts resulting in a portfolio of 500 issued and pending patents related to OLED. Ocean Tomo was charged with running a sales process for BASF, narrowing a list of prospective acquirers to a key group of potential strategic acquirers. Ocean Tomo packaged the portfolio, engaged companies in due diligence and managed the offer submission process.

Results
The portfolio sold for approximately $96 million USD to a wholly-owned subsidiary of Universal Display Corporation, UDC Ireland.

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A private equity group was considering the acquisition of a publicly-traded company for the immediate purpose of privatization and then to provide growth capital. The target company had established a very strong and large domestic and international patent portfolio, and had a heavily experienced management team in place that provided the foundation for accelerated growth opportunities.

Engagement

Ocean Tomo was retained to provide merger and accusation (M&A) support. With IP being the key asset in the business, Ocean Tomo performed a valuation analysis that provided the equity investor with the comfort of not only the short-term cash flow opportunities, but more importantly the long-term revenue opportunities due to strength of the portfolios and the quality of engineering team that showed consistent efficiency in its identification and acquisition of critical portfolios.

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Background

Verizon Communications Inc. Retained Ocean Tomo to Provide Intellectual Property Advisory Services focused on Yahoo! Intellectual Property Assets.

Engagement

“Our retention by Verizon represents yet another example demonstrating the relevance of IP in an industry with converging technology” explained Roy D’Souza Ocean Tomo's Managing Director responsible for IP valuations.

Results

“Ocean Tomo’s client base continues to rely upon the experienced insight of our team in the most significant and noteworthy of transactions. Coming on the heels of our announcement last week where Ocean Tomo served as transaction advisor to BASF-SE on the sale of more than 500 patent assets, the Verizon purchase illustrates the full range of Ocean Tomo’s Advisory assignments, from asset driven sales to whole company acquisitions”, reported Ocean Tomo’s Chief Executive James E. Malackowski.

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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.

Our Opinion, Management, and Advisory Services are built upon more than three decades of experience valuating intellectual property in the most rigorous of venues – State, Federal and international courts. Our financial, market and technical experts provide a unique understanding of the contributory value of proprietary innovation. This is the cornerstone of our business. This insight permeates every practice and client engagement.

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.

Headquartered in Chicago, Ocean Tomo has offices in Greenwich, 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.