

## Michael P. Adams

Member

### Austin

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### Areas Of Practice

Intellectual Property  
Copyright  
Intellectual Property Litigation  
Patent Prosecution  
Portfolio Due Diligence  
Trademark

### Bar Admissions

Texas, 1989  
Illinois, 1988  
U.S. Patent and Trademark Office

### Court Admissions

U.S. Court of Appeals, Federal Circuit  
U.S. District Court, Northern District of Texas  
U.S. District Court, Southern District of Texas  
U.S. District Court, Eastern District of Texas  
U.S. District Court, Western District of Texas  
U.S. District Court, Northern District of Illinois

### Education

ITT Chicago-Kent College of Law, J.D.  
Purdue University, B.S., Electrical Engineering

Michael Adams is a member of the Intellectual Property Practice Group in Dykema's Austin, Texas office. For almost 30 years, Mike has focused his practice on patent, trademark, copyright and trade secret law, with an emphasis on the procurement, due diligence, licensing and litigation of intellectual property rights. Making use of his electrical engineering degree, his practice has concentrated on intellectual property issues arising in the following industries: computer, semiconductor, electronics, software, e-commerce and internet. Mike has participated in patent infringement trials before the U.S. District Courts for the Eastern (Marshall) and Western (Austin) Districts of Texas and the Eastern District of Virginia, and appeals to the U.S. Court of Appeals for the Federal Circuit. He has been recognized in *The Best Lawyers* and *Texas Super Lawyers* for the past several years.

### Career Highlights

Mr. Adams served as lead counsel for a jury trial in Marshall, Texas, representing the defendants who had numerous claims asserted against them, including for infringement of a patent involving software used on the internet for comparing configured vehicles. Prior to trial, plaintiffs agreed to withdraw three other patents from the case and to dismiss a fourth patent. Defendants asserted counterclaims for trade secret misappropriation and breach of contract. The jury found in favor of the defendants on all of plaintiffs' remaining asserted claims. Additionally, the jury found that the remaining patent-in-suit was invalid, and found in favor of defendants on its breach of contract and misappropriation of trade secret counterclaims, awarding damages to defendants in the amount of \$2,000,001. In 2014, the Court of Appeals for the Federal Circuit affirmed the final judgment. *See Versata Software, Inc. v. Internet Brands, Inc.*, 902 F. Supp. 2d 841 (E.D. Tex 2012); Decision reached on appeal, 2014 U.S. App. LEXIS 1062 (Fed. Cir., Jan. 17, 2014)

### Litigation Experience

- Lead counsel in an *inter partes* proceeding in which the USPTO rejected all claims in a patent involving software used on the internet for comparing configured products. The USPTO's Board of Patent Appeals and Interferences issued a decision on appeal affirming the decision to reject all of the patent claims.
- One of the trial counsel representing the defendant in a patent infringement and trade secret misappropriation case involving cell phone power amplifier circuitry. The jury ruled in favor of the defendant on almost all patent and trade secret allegations, and awarded zero

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damages to the plaintiff.

- Lead counsel for the defendant in a software patent infringement suit. In response to defendant's non-infringement arguments, plaintiff voluntarily dismissed its suit before defendant filed its answer.
- On the trial team that represented the defendant in a patent infringement suit involving thin film transistors and active matrix displays. After a bench trial, the District Court ruled the plaintiff's patent was unenforceable because of inequitable conduct. On appeal, the Federal Circuit affirmed this decision. See *Semiconductor Energy Lab. Co. v. Samsung Elecs. Co.*, 4 F. Supp. 2d 477 (E.D. Va. 1998) and 204 F.3d 1368 (Fed. Cir., 2000)
- Lead counsel for one of the defendants in a state court trade secret case. The case settled under terms that were very favorable to defendants, including a lack of restrictions placed on the marketing or sale of defendants' database software products.
- Served as co-counsel for the defendants in a software patent infringement case. At trial, the jury concluded that the current software release did not infringe and limited the damages on prior releases to well below the amount requested by the plaintiff. On appeal, the Federal Circuit vacated the judgment on the prior releases and remanded the case to the District Court for further determination regarding defendants' invalidity arguments.
- Counsel for defendants in a patent infringement suit involving CRM internet technology in the Eastern District of Texas, and for plaintiffs in a parallel suit in the Southern District of California. The case settled very favorably to clients.
- Brought in as co-lead trial counsel for defendants in a patent infringement case in which infringement had been found prior to our involvement. At trial, damages were limited to \$53,000.
- Lead counsel in trademark cases in U.S. district courts and before the U.S. Trademark Trial and Appeal Board.
- Lead counsel in numerous cases involving alleged sales of counterfeits of famous and designer goods protected by federal trademark registrations.
- Involved in Texas Attorney General, Civil Investigative Demand regarding copyright protection of client's land title evidence plant and associated software. The matter was settled.

## Licensing

- Responsible for drafting and negotiating several license agreements for high end computer software; these agreements have involved parties such as software companies, semiconductor companies, retailers, retail management companies and oil companies.
- Responsible for drafting and negotiating numerous agreements involving other intellectual property transactions, including acquisition, distribution and development agreements.

## Procurement

- Drafted and prosecuted numerous utility patent applications pertaining to semiconductors, software, electronics, medical devices, transportation products, retail products and related technologies.
- Drafted and prosecuted design patent applications for retail products.
- Drafted and prosecuted numerous trademark applications for clients in the semiconductor, software, electronics, medical device, retail products, professional services, and restaurant industries.
- Drafted and prosecuted copyright applications.

## Seminars & Speeches

Litigating Trade Secrets and Patents: When, Where, Who, Why and Other Questions You Were Afraid to Ask  
July 23, 2019

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### **Memberships & Involvement**

- Austin Bar Association
  - Technology Section
  - Computer Law Section
- American Intellectual Property Law Association
- Austin Intellectual Property Law Association - Outstanding Inventor Award Committee, Past Chairman

### **Awards & Recognition**

- Recognized by *The Best Lawyers in America*® for Intellectual Property Law (2011-2018), Intellectual Property Litigation (2011-2019), Patent Litigation (2016-2019) and Trademark Law (2016-2019). Copyright 2015 by Woodward/White, Inc., Aiken, SC
- Recognized as a *Texas Super Lawyer* in Intellectual Property Litigation and Intellectual Property Law, Thomson Reuters, 2014-2018