McKool Smith

Blair M. Jacobs

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Representing high technology innovators large and small, Mr. Jacobs serves as lead trial counsel and strategist in intellectual property and trade secret matters in district courts nationwide and is a leading practitioner at the Federal Circuit Court of Appeals, where he has presented numerous oral arguments. He has served as lead appellate counsel on several well-known, precedential opinions shaping patent law. Mr. Jacobs is first and foremost a nationally recognized trial attorney with extensive experience trying and winning cases in courts throughout the country. From his time in the Department of Justice forward, he has been sought out and has led teams in bet-the-company cases destined for trial from the outset.

Mr. Jacobs routinely handles high-stakes disputes in the most active patent forums including the District of Delaware, Eastern District of Texas, Western District of Texas, Eastern District of Virginia, and Northern and Central District of California, among others. After leading a series of trial teams in the District of Delaware, Mr. Jacobs was selected as one of the few outside counsel to serve as a member of that court's Patent Study Group, created to advise on best practices in complex patent litigation.

Mr. Jacobs also has litigated extensively before the U.S. International Trade Commission (ITC), representing both complainants and respondents in Section 337 investigations involving a wide range of products and technologies. He has successfully handled numerous cases through trial and Commission review, and he has a deep understanding of the unique rules and practice in this forum as well as related proceedings before the Customs and Border Protection, the Federal Circuit, and the Court of International Trade.

Over more than three decades of practice, Mr. Jacobs has handled a myriad of patent competitor and trade secret cases and has resolved disputes across the gamut of contentious IP issues. He is often selected to lead teams in matters requiring the highest level of trial acumen and planning and prides himself in working collaboratively with in-house counsel on trial strategy from the outset. And when it comes to trial, Mr. Jacobs has led trial teams through multi-week jury trials on numerous occasions and this has provided unique insights on what it

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Education

J.D., University of Richmond School of Law, 1990

- Notes and Comments Editor, University of Richmond Law Review
- National Moot Court Team

B.A., Wake Forest University, 1987

Clerkships

Chief Judge Walter E. Hoffman, U.S. District Court, Eastern District of Virginia

Court Admissions

District of Columbia

Commonwealth of Virginia

The U.S. Court of Appeals for the Fourth, Fifth, Eighth, Eleventh, and Federal Circuits

The U. S. Court of Appeals for the Armed Forces

The U.S. District Court for the Eastern District of Virginia

The U.S. District Court for the Eastern District of Texas

The U.S. Supreme Court

Softex Ex. 2001, p. 1
Microsoft v. Softex
IPR2023-01185

Blair M. Jacobs (cont'd)

takes to win. According to *IAM Patent 1000*, he "creatively puts arguments together in a way that juries find entertaining – and persuasive."

Mr. Jacobs frequently lectures and writes on trial tactics and trial advocacy, patent litigation strategies, practice before the ITC and Customs, strategies concerning allegations of trade secret misappropriation, appellate advocacy, and issues associated with complex trial strategy.

Prior to entering private practice, Mr. Jacobs served in the Army and then with the United States Department of Justice (DOJ), where he acted as first-chair trial counsel in highly publicized civil cases brought against various agencies of the federal government. While at DOJ, he was selected to serve at the White House as counsel for the President's Foreign Intelligence Advisory Board on investigations involving human rights issues and the intelligence community. He also served on the faculty of the Attorney General's Advocacy Institute.

Representative Matters

Recent District Court Experience

- *Fairchild Semiconductors v. Power Integrations*. Lead trial counsel for the plaintiff in the District of Delaware. Jury returned verdict in favor of Fairchild on claims of induced infringement and awarded damages.
- *Power Integrations v. Fairchild International, et al.* Lead defense counsel in several multi-week NDCA jury trials involving patents related to semiconductors used in power chargers for improving the efficiency of power conversion. In post-trial motions, convinced court to throw out jury's damages award, resulting in a new trial.
- *Power Integrations v. Fairchild II*. Lead defense counsel in a Delaware patent infringement case involving power conversion semiconductor technology. At trial, obtained a verdict of non-infringement on behalf of Fairchild and infringement by Power Integrations on its subsidiary System General's patents.
- *Align Technology, Inc v. 3Shape A/S and 3Shape, Inc*. Represented Align Technology in multiple Delaware cases involving patent infringement related to digital dentistry.
- *Oyster Optics LLC v. Ciena Corporation.* Defending Ciena in Eastern District of Texas (EDTX) and Northern District of California (NDCA) in three separate actions alleging infringement patents concerning 40G and 100G optical fiber communications equipment.
- *Core Optical v. Ciena Corporation.* Lead trial counsel for Ciena in a Central District of California (CDCA) case involving patented architecture for switching of signals in optical domains. Obtained a favorable settlement based on a strong ownership defense developed through targeted discovery.
- *Labyrinth Optical v. Ciena Corporation*. Lead trial counsel for Ciena in its defense against patent infringement claims brought in CDCA by Labyrinth Optical, an Acacia entity, involving patented architecture for switching equipment in transmitters and receiver telecommunications equipment.
- *Gordium Innovations v. Ciena Corporation*. Lead defense counsel in a Delaware case involving patented architecture for configurable packet re-timing in network repeater hubs. Settled favorably.

Softex Ex. 2001, p. 2
Microsoft v. Softex
IPR2023-01185

Blair M. Jacobs (cont'd)

- *Vellata LLC v. Ciena Corporation*. Lead defense counsel in a CDCA case involving allegations of infringement against Ciena's fiber optic switching products. Dismissed with prejudice after prior art was presented to plaintiff prior to an Answer being filed.
- I*ntellectual Ventures v. Trend Micro.* Represented Trend Micro in cybersecurity patent dispute in Delaware and Federal Circuit. Obtained complete victory for Trend based on patent ineligibility rulings, upheld by Federal Circuit.
- *Lambda Optical LLC v. Ciena Corporation, et al.* Lead counsel for Ciena and ADVA Optical in a patent infringement action involving optical switches in telecommunication systems including node architecture for modularized and reconfigurable optical networks.
- *Ciena Corporation v. Koninklijke KPN, N.V. et al.* Lead trial counsel in the Eastern District of Virginia (EDVA) for Ciena in a multi-patent enforcement action involving fiber optic telecommunications patents related to multi-signal switching to relieve congestion in optical networks.
- *Far North v. ADVA*. Defended ADVA in case involving router technology. Convinced plaintiff to drop case prior to answer being filed.
- *Sycamore IP Holdings v. ADVA.* Defending ADVA in EDTX, secured an extremely favorable post-claim construction settlement on a patent related to coding schemes for optical communication systems.
- *CCE v. AT&T et al.* Defended AT&T in a case involving LTE technology. AT&T was dismissed from case shortly before trial in EDTX.
- *Telecommunications Research Laboratories v. AT&T Corp.* Lead counsel in the District of New Jersey defending infringement allegations involving optical networking technology patents including ring-mesh networks and methods for creating telecommunications paths in a network after a span failure.
- *Innovative Communications v. ooVoo, LLC.* Lead defense counsel in an EDVA patent infringement case involving point-to-point Internet communication and Internet telephony software technologies.
- *Vextec Corporation v. Sentient Corporation*. Lead counsel for Vextec in a District of Tennessee patent infringement and trade secret case brought in parallel with the Economic Espionage Act. The technology involved predictive models and computer-aided engineering services related to product reliability, risk assessment and life of product prediction. Settled favorably.
- *Sybase v. Telecommunications System*. Obtained a very favorable settlement in after filing counterclaim lawsuits and obtaining a positive claim construction ruling in EDVA. The technology at issue involved enterprise software that manages, analyzes and mobilizes information on handheld devices using relational databases, analytics, and data warehousing solutions.
- *Telecommunications Systems v. Sybase, et al.* Defended Sybase in Delaware and EDVA and obtained an extremely favorable settlement after securing positive claim construction rulings in a case involving software patents related to location-based services for tracking mobile devices.
- *Tec Sec, Inc. v. IBM et al.* Defended Sybase in an EDVA patent infringement case involving encryption software methods and products.
- *NTP, Inc. v. HTC, et al.* Defense counsel for HTC in EDVA patent infringement allegations involving wireless cell phone and RF technology patents.
- *Mars, Inc. v. Naturex, S.A.* Represented Mars in an EDVA enforcement action related to nine patents involving cocoa flavanol and polyphenol. Convinced defendant to stop making the infringing products and to exit the U.S. market.

Blair M. Jacobs (cont'd)

- *McKesson Corp. v. Swisslog*. Lead trial counsel representing McKesson in a case involving automated robotic storage systems for the packaging and dispensing of prescriptions within hospital wards. The case settled favorably after a multi-week jury trial in Delaware and Federal Circuit appeal.
- *Ciena Corporation v. Corvis Corporation.* Trial counsel for Corvis in a competitor suit filed by Ciena in Delaware asserting infringement of five patents related to wavelength division multiplexing technology in fiber optic networks including multiplexers, switches, amplifiers, transmitters, and receivers. The cases were tried before juries on multiple occasions and resulted in a favorable settlement after the appellate briefs were filed.

Recent Federal Circuit Experience

- *SSL Services v. Citrix Systems, Inc.* Lead counsel for Citrix in an appeal involving GoToMyPC® and GoToMeeting® software products.
- *AstraZeneca v. Hanmi Pharmaceutical Co., Ltd.* Lead counsel defending the first Korean pharmaceutical company involved in ANDA litigation in the U.S. Obtained an affirmance of complete summary judgment victory based on a claim construction ruling and an entry of judgment of non-infringement.
- *Pixion v. Citrix.* Lead counsel for Citrix. Obtained a complete affirmance of summary judgment victory based on the invalidity and non-infringement of Pixion's patents.
- *Power Integrations v. Fairchild*. Lead counsel for Fairchild. Obtained a reversal of a large jury damages award and an Order that the plaintiff was entitled to virtually no damages, based on faulty claims of extraterritorial damages and other legal errors.
- *Convolve v. Seagate*. Defended Seagate in the Southern District of New York and on appeal against claims of alleged patent infringement and trade secret misappropriation of disk drive technology, where the plaintiff sought damages in excess of $800 million. The case prompted the landmark decision *In re Seagate Technology, LLC*, 497 F.3d 1360 (Fed. Cir. 2007) (en banc) in which the court overturned 24 years of precedent in Seagate's favor, thereby abolishing the duty of care standard for willful infringement. Obtained a complete dismissal of all claims. On second appeal, the Federal Circuit affirmed the trade secret victories for Seagate, eliminating virtually all of the plaintiff's potential damages.

Recent International Trade Commission (ITC) Experience

- *In the Matter of Certain Dental and Orthodontic Scanners and Software*. Lead trial counsel for Align Technology, maker of Invisalign and intraoral scanners, in three ITC investigations through trial. Secured findings of infringement on Align Technology patents and an exclusion order recommendation.
- Represented a Japanese consumer electronics company in an ITC investigation that resulted in an initial determination of no infringement, invalidity, and no domestic industry. The case settled favorably.
- Represented Nintendo and a Japanese consumer electronics company as respondents in an ITC investigation. The Administrative Law Judge issued an order granting summary determination to our clients.
- *In the Matter of Certain Electronic Devices, Including Mobile Phones and Tablet Computers, and Components Thereof* - Trial counsel for HTC in an ITC investigation involving nine patents and three district court actions involving an additional nine patents. The patents related to various aspects of handset technology. After knocking out five of the nine patents in the ITC prior to the hearing and two more as a result of trial, the parties reached a successful global settlement after the Commission

Blair M. Jacobs (cont'd)

granted review on multiple grounds concerning the two remaining patents.

- *In the Matter of Certain Tunable Laser Chips, Assemblies, and Products Containing Same* - Lead ITC counsel for Tellabs, Ciena, Nortel and ADVA Optical Networking in an ITC investigation involving fiber optic tunable lasers.
- *In the Matter of Certain Alendronate Products and Salts Containing Same* - Lead ITC counsel for Cipla in its defense against patent infringement claims relating to a generic version of Fosamax®.
- *In re Certain Products Containing Interactive Program Guide and Parental Controls Technology*. Counsel for Rovi Corporation in a matter against Toshiba involving program guides and parental controls. After a successful Markman argument, obtained a favorable settlement that resolved multiple lawsuits filed against Toshiba. As part of the settlement, Toshiba agreed to take a license to Rovi's interactive program guide (IPG) patent portfolio. Toshiba and Rovi also agreed to work together to implement Rovi's technology in Toshiba's products.

Rankings & Honors

- Recognized in the guide to the *Lawdragon* 500 Leading Litigators in America, 2022
- Fellow of the Litigation Counsel of America, an honor limited to less than one-half of one percent of North American lawyers, judges and scholars
- Received Silver Star ranking for Washington, D.C. Litigation and highly recommended nationally for the Court of Appeals for the Federal Circuit and the International Trade Commission by *IAM Patent 1000: The World's Leading Patent Practitioners.* (2021-2023)
- Ranked in *IAM Patent Litigation 250* (2011-present)
- Ranked in *IAM Patent 1000* in both patent litigation and appellate categories (2014-present)
- Named an IP Star by *Managing IP* (2013-present)
- Named by *The Legal 500* for ITC acumen (2010-present)
- *Daily Journal* - Top Verdicts of 2014 - *Power Integrations v. Fairchild Semiconductor, Int'l*
- Recognized as a "Trailblazer" by *The National Law Journal* (2016) for complete win for AT&T in EDTX case
- Named a "Legal Lion" by *Law360* for securing a California federal judge's agreement to toss a significant jury verdict (2015)
- Named by his peers to the list of *Super Lawyers*

Community & Professional Activities

- National Institute for Trial Advocacy
- Litigation Counsel of America

Softex Ex. 2001, p. 5
Microsoft v. Softex
IPR2023-01185

Blair M. Jacobs (cont'd)

Publications

Blair Jacobs published, "The Conundrum Concerning Perceived Partiality and Financial Incentives in the AIA Review Process" in *IPWatchdog*
10.06.2022

Blair Jacobs published, "PTAB Prevails Against 'Big Tech' Bias Complaint" in *World Intellectual Property Review*
09.22.2022

Speaking Engagements

McKool Smith a sponsor and participant at LABEST 2023
05.18.2023

Blair Jacobs and Christina Ondrick to speak at the 15th Annual Practitioners' Think Tank on ITC litigation & Enforcement
03.21.2023

McKool Smith serves as Conference Chair at *World IP Review*'s 2023 Summit
03.09.2023

Blair Jacobs participates at IP Dealmakers Forum
12.02.2022

Blair Jacobs and Christina Ondrick to serve as Panelist at the IPWatchdog Masters Program - Standards, Patents & Competition 2022
11.09.2022

Blair Jacobs will Moderate "Patents & Trade Secrets" at the AIPLA Annual Conference
10.27.2022

Blair Jacobs served as a panelist at the Federal Circuit Bar Association's Fall 2021 Global Series
11.01.2021

Softex Ex. 2001, p. 6
Microsoft v. Softex
IPR2023-01185