

# Hemingway & Hansen LLP

*An Intellectual Property Law Firm*

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## Practice Description:

Intellectual Property Litigation and Dispute Resolution.

Patent prosecution and counseling.

Licensing and patentability infringement opinions.

## Education:

B.S. Electrical Engineering, B.S. Computer Science, & B.S. Computer Engineering (1988), Southern Methodist University; NCAA Division I All-American 1987-88 (Swimming)

J.D. (1991) Emory University

## Professional Experience:

Partner, Hemingway & Hansen, LLP 2000-present

Associate, Richards, Medlock & Andrews 1991-1999

## Admissions:

State Bar of Texas (1991)

The United States Patent & Trademark Office (1991)

The United States District Court for the Northern District of Texas (1991)

The United States District Court for the Southern District of Texas (1993)

The United States District Court for the Eastern District of Texas (1998)

The Court of Appeals for the Federal Circuit (1993)

The Court of Appeals for the Fifth Circuit (2000)

The United States Supreme Court (1999)

## Professional Activities:

Dallas-Fort Worth Intellectual Property Law Association

President (1998)

Dallas Bar Association

Board of Directors, Intellectual Property Law Section (2013- present)

Texas Bar Foundation

Life Fellow (1998-present)

State Bar of Texas Intellectual Property Law Section

Chair, Inventor Recognition Committee (2002-2003)

## Speaking and Publications:

Cost-Shifting Issues Arising in Electronic Discovery, Dallas Bar Association, Headnotes, p. 12, November 1, 2005.

What Happens if BlackBerry Loses Its Juice?, Opinion Section (co-authored with Eugenia S. Hansen) Texas Lawyer, Feb. 14, 2006.

Onward Into the Breach, Patentees No Longer Need to Repudiate Licenses Before Suing, (co-authored with Eugenia S. Hansen) Texas Lawyer, Jan. 29, 2007.

Determining Obviousness, Developments in Substantive Law, Intellectual Property Annual Review (co-authored with Eugenia S. Hansen) Texas Lawyer, Jan. 29, 2007.

Summary Judgments of Patent Invalidity in a Post-KSR World, Headnotes, Dallas Bar Association, p. 6, July 1, 2008.

Impact of KSR Decision on Patent Litigation (Paper and Speech), 22nd Annual Intellectual Property Law Advanced Course and Patent Prosecution Workshop, Intellectual Property Law Section of State Bar of Texas, San Antonio, Texas, March 5-6, 2009.

Practicing Along State Lines (Paper and Speech), 25th Annual Intellectual Property Law Advanced Course, Intellectual Property Law Section of State Bar of Texas, Austin, Texas, November, 2012.

## Significant Representations:

D. Scott Hemingway is a partner in Hemingway & Hansen, LLP, an Intellectual Property Law Firm organized in Dallas, Texas in 2005. Mr. Hemingway has over twenty years of litigation and trial experience in addition to extensive experience with the prosecution and management of valuable patent, copyright and trademark portfolios held by his clients. He maintains an active patent prosecution docket before the United States Patent & Trademark Office in addition to his litigation workload. As part of his management efforts, he coordinated licensing and litigation efforts involving intellectual property asset portfolios producing multi-million dollar licensing royalty revenues and court settlements.

## Several exemplary client representations led by Mr. Hemingway include the following:

\* **Red River Fiber Optic Corporation** - client representation began in 1994 with the representation of Mr. Joseph Zelikovitz in patent prosecution matters. Mr. Zelikovitz passed away in 1996, but Mr. Hemingway continued to represent his estate and obtained issuance of U.S. patent rights for his disclosed inventions. Red River Fiber Optic Corporation filed its first lawsuit in 2000 accusing a major telecommunications company based on a fiber optic transmission network of patent infringement, which resulted in a favorable settlement. The patent at issue survived a reexamination proceeding at the United States Patent & Trademark Office without significant modifications to the patent, and Red River Fiber Optic filed a second lawsuit in 2008 against three major telecommunications companies using fiber optic transmission networks. The Defendants in this second lawsuit settled the patent infringement matters under favorable terms for Red River Fiber Optic, and Mr. Hemingway has represented Red River's efforts to collect \$20 million in licensing and settlement revenues.

\* **Wellogix** - client representation against Accenture related to a second trade secret litigation began in the fall of 2010, and client was the plaintiff suing Accenture for trade secret misappropriation. Mr. Hemingway prepared responses to Defendants' Motion for Summary Judgment of No Trade Secret Misappropriation and Daubert Motion to Exclude its technical expert. Based on Mr. Hemingway's responses, the Defendants' motions for summary judgment and Daubert motions were denied by the trial court, and the case went to a jury trial in 2011. Mr. Hemingway provided assistance to the lead trial counsel at the jury trial of this second case. In the first trade secret case handled without Mr. Hemingway's assistance, lead trial counsel and former IP counsel obtained a \$1 award. In the second trade secret case litigated with Mr. Hemingway's assistance (with the same lead trial

counsel but not the former IP counsel), the jury awarded over \$94 million dollars including compensatory and punitive damages.

\* **Nortel Networks** - client representation began in 1999. Mr. Hemingway was retained to prepare and prosecute patent applications relating to cellular telecommunication protocols used in CDMA, 3G and 4G LTE cellular transceiver and transmission technology. Mr. Hemingway was responsible for the filing, prosecution and issuance of United States and foreign patents, including applications filed under the PCT protocols. Several hundred patent filings were coordinated and managed by Mr. Hemingway and his firm over this ten year representation. Due to financial troubles, Nortel Networks auctioned its patent portfolio and obtained auction sales revenue of over \$7 billion dollars for its patent portfolio. The CDMA, 3G and 4G LTE patents obtained by Mr. Hemingway for Nortel Networks were some of the patent assets included in Nortel patent portfolios auctioned in 2011 and 2012.

\* **SecureTrans** - client representation began in 2005. Mr. Hemingway was retained to prepare and prosecute patent applications related to an escrow-based purchasing system and method used to prevent fraudulent on-line transactions. Mr. Hemingway was responsible for the filing, prosecution and issuance of five United States patents, with other patent applications still pending.

\* **Sony BMG and Weston** - client representation began in 2004. Mr. Hemingway was retained to litigate claims of copyright infringement against Sony BMG Music and Wesley Weston (a/k/a "Lil' Flip"). After a two week jury trial, Mr. Hemingway's client obtained a verdict of willful copyright infringement with maximum statutory damages against Sony BMG and Mr. Weston. In a related matter against these same defendants for another plaintiff, Mr. Hemingway obtained a Fifth Circuit Court of Appeals reversal of a summary judgment order issued by the trial court, which ultimately led to a favorable settlement of that matter.

\* In 2012, Mr. Hemingway represented clients in three jury trials in the first six months of the year. These jury trials included two patent matters, and one trade dress infringement matter. Mr. Hemingway was greatly assisted by co-counsel on one of those matters.

Apart from electrical and computer-related patent prosecution, Mr. Hemingway has prosecuted, litigated and licensed patented technologies involving thermoelectric storage containers, aluminum baseball bat designs, frozen food preparation techniques, foam-based equipment and furniture, thermo heating and cooling medical packs, safety automotive seat belt technology, and soft drink bottling systems. Mr. Hemingway has also prosecuted and litigated copyrights and trademarks, including enforcement of the trademarks on the "Big Tex" logo for the State Fair of Texas.

#### **Selected Litigation Matters (Participation as lead counsel or co-counsel, patent consultant)**

Red River Fiber Optic Corporation v. Verizon, AT&T and Qwest, 2:08-cv-00215 (E.D. Tex. 2008) (patent infringement action relating to fiber optic communications networks used with FIOS, U-Verse, and Qwest fiber services)

U.S.F. Equipment Services, Ltd. v. Allied International Emergency, Inc., et al., 2:07-cv-00490 (E.D. Texas 2007) (patent infringement defense relating to two patents covering coal mine fire extinguishing method and system, claim construction pending)

In re Translogic (U.S. Patent No. 6,162,666) (reissue application and petitions at U.S. Patent & Trademark Office to reissue patent subject to vacated \$150 million jury verdict against Hitachi in District of Oregon federal action)

Granville v. Sony BMG, Wesley Weston & Suckafree Records (Civil action 03-cv-3002) (Platinum album copyright infringement, jury trial finding willful copyright infringement)

Whitson Wells PMG, LLC v. Adventure Prods., (two actions pending in N.D. Texas and S.D. Cal., favorable settlement just reached, attorney fees paid by other side)

Spenco Medical Corp. v. Edge Marketing, 6:07-cv-00102 (W.D. Tex.)(trademark infringement matter representing plaintiff)

Board of Regents, University of Texas v. AFP Imaging Corp., 3:06-cv-02245 (N.D. Tex.) (patent infringement and licensing matter representing UT)

Bender v. Texas Instruments and Bender v. Analog Devices, 2:06cv-00221 and 2:06-cv-00192 (E.D. Tex. 2007) (patent infringement action, favorable settlement reached)

Medical Research Institute v. Bio-Engineered Supplements & Nutrition Inc., 6:05-cv-00417 (E.D. Tex.) (initial investigation and development of successful counterclaims and defenses in patent infringement defense)

Medi-Temp v. CVS Pharmacy & Rite-Aide Pharm., Civil action: 05-cv-3241 (D. Ariz.)(patent infringement defense over hot/cool packs, favorable settlement reached)

Rally Concepts v. The Spalding Group, RNC and Rally Concepts , 5:05-cv-00041 and 5:06-cv-00097 (E.D. Tex.) (copyright infringement jury trial, Jan. 2007)

Corporate Safe Specialists v. Tidel Technologies, 3:05-cv-01835 and 2:05-cv-00260 (N.D. Tex. and E.D. Tex) (patent infringement actions, successful transfer to N.D. Texas from N.D. Ill.)

Tewari v. Mitsubishi Gas Chemical Co., 2:05-cv-00112 (E.D. Tex. and S.D. N.Y, 2006) (misappropriation claim for oxygen scavengers used in meat packing, favorable settlement reached after filing counterpart actions in E.D. Texas)

Texas Recreation Corp. v. Sport Dimension, 4:04-cv-00221 (E.D. Tex.) (patent infringement claim filed, favorable settlement reached)

Transgroup Express, Inc. v. Lone Star Transgroup, LLC, 4:03-cv-01419 (N.D. Tex.) (defense against trademark infringement allegations, settled favorably)

Solomon v. Herter's & Overton's Sporting Goods, 2:02-cv-00060 (E.D. Tex.) (patent and misappropriation claims over motion duck decoys, settled favorably)

CD Solutions v. Tooker, 15 F.Supp.2d 986 (D. Ore. 1998) (summary judgment of no trademark infringement over website domain name, generic mark defense), discussed in "Pursuing Domain Name Registrants Can Backfire," The National Law Journal, p. B6-7 (Monday, April 26, 1999).

Fix My PC v. NPN Associates, 48 F.Supp.2d 640 (N.D. Tex. 1999) (dismissal of action for lack of personal jurisdiction, trademark infringement claim for service mark domain name), covered in Mealey's Litigation Report: Intellectual Property, Vol. 7, No. 14, p. 8-9 (April 19, 1999).

TN Technologies Inc. v. TN Tech. Holding Inc., 1:97-cv-00051 (W.D. Tex.) (successful in getting preliminary injunction denied)

Hillerich & Bradsby (Louisville Slugger) v. McKay (E.D. Tex.) (defense against patent infringement over popular baseball bat design and employment contract claims, favorable settlement reached)

Texas State Fair v. Mr. Jim's Pizza (N.D. Tex.)(“Big Tex” trademark infringement claim, successful settlement)

Promotional Partners v. Tricon Global Rest., 3:01-cv-01412 (N.D. Tex.) (breach of contract action against KFC, settled favorably)

Texas Instruments Inc. v. Hyundai Electronics, et al. (25.2 million jury award, 1 billion dollar license) (eight companion cases litigated simultaneously/Jones Day representation)

Marlow Indus. v. Igloo Prods. Corp., 3:96-cv-02668 (N.D. Tex.) (initial investigation and development of successful defenses to patent infringement allegations)

Amtech Corp. v. AT/Comm Inc., No. 3:92-CV-2053-D (N.D. Tex. 1994) (defense against patent infringement matter, Richards Medlock representation)

Dippin'Dots v. Mosey & Frosty Bites (Civil Action: 96-1959) (pending Pet. for Writ, authored by firm), various distributors sued, Dippin' Dots, Inc. v. Frosty Bites Florida (successful preliminary injunction obtained)