



## FISH & RICHARDSON



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Litigation  
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Patent Litigation  
ITC Litigation

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Medical Devices  
Cleantech

Frank Scherkenbach is a trial lawyer who specializes in complex high technology litigation, with particular expertise in computer software, semiconductors, and medical devices.

After co-founding the *Harvard Journal of Law & Technology*, Mr. Scherkenbach clerked for the Honorable H. Robert Mayer at the United States Court of Appeals for the Federal Circuit. He began his private practice career with Fish & Richardson in the firm's Silicon Valley office, where he immediately made a mark winning jury trials for Power Integrations, among others. In 2001 he relocated to the Boston office.

Since then, Mr. Scherkenbach has proceeded to litigate patent disputes in a wide range of technologies. Examples include a patent relating to the use of voice control in a robotic surgical system in the 2002 case, *Intuitive Surgical, Inc. and IBM v. Computer Motion, Inc.*; the 2005 case involving patents for spinal surgery devices, *Kyphon, Inc. v. Disc-O-Tech Medical Technologies, et al.*; and the 2006 case, *Fairchild Semiconductor Corporation, et al v. Power Integrations*, which involved patents relating to semiconductors used in switching power supplies and which resulted in a \$34 million verdict for Mr. Scherkenbach's client.

Mr. Scherkenbach also won a patent defense verdict for the Microsoft Corporation in a 2004 suit brought by Arendi U.S.A., Inc. In fact, a few of Mr. Scherkenbach's jury trial wins have been selected by *The National Law Journal* as particularly significant: *Power Integrations, Inc. v. Motorola, Inc.*, in which Mr. Scherkenbach and his team achieved a jury award of \$32.3 million, was named as one of the "most significant intellectual property cases" of 2004; and both *Adobe Systems, Inc. v. Quanta Ltd.* and the

*Microsoft adv. Arendi* verdicts were named as "Top 10 Defense Verdicts" of the year in 1997 and 2004, respectively.

More recently, the Microsoft victory and the jury verdicts for Power Integrations Inc., in the cases against Motorola, Inc. and Fairchild Semiconductor, respectively, earned him recognition in *The American Lawyer's* 2007 "Young Litigators Fab Fifty." He was one of the 'Magnificent 7' in *IP Worldwide's* 2002 "Rising Stars: Best Young Trial Lawyers" list, and has been named as a "recommended lawyer" in 2005 by *Chambers U.S.A.* Additionally, in 2007 and 2008, he made the *Best Lawyers in America* list in Intellectual Property Law.

Mr. Scherkenbach also practices before the International Trade Commission (ITC), where he successfully tried a multi-patent semiconductor case in 2006, and regularly handles appeals to the Federal Circuit. Recently in 2006, he led the trial team for the ITC case, *Power Integrations, Inc. v. System General Corporation and System General USA*, in which the ITC determined that Power Integrations' asserted patents were infringed and not invalid, and entered an exclusion order covering both the chips at issue and downstream products.

## Experience

### Litigation examples

#### SOFTWARE OR SOFTWARE-RELATED

*Microsoft adv. Arendi, U.S.A., Inc. and Arendi Holding Limited* (Office XP "smart tags")

Defended Microsoft as lead trial counsel in a patent case brought by Arendi U.S.A., Inc. and Arendi Holding Limited in the United States District Court, District of Rhode Island. Won jury verdict of non-infringement - the first ever for Microsoft - after a two week trial. Accused technology was Office XP "smart tag" technology, which involves associating actions with certain content in an electronic document. Verdict selected by *The National Law Journal* as one of the ten top defense verdicts of 2004.

*Microsoft adv. HyperPhrase Technologies, LLC and HyperPhrase, Inc.* (Office XP "smart tags")

Successfully defended Microsoft in a patent case brought by HyperPhrase Technologies, LLC and HyperPhrase, Inc. in the United States District Court, Western District of Wisconsin, seeking over \$2 billion in damages. Accused technology was Office XP "smart tag" technology, which involves associating actions with certain content in an electronic document. Won case on eve of trial on summary judgment.

*Google, Inc. adv. HyperPhrase Technologies, LLC and HyperPhrase, Inc.* (search technology, ad serving, autolinking)

Successfully defended Google, Inc. in a multi-patent case brought by HyperPhrase in the United States District Court, Western District of Wisconsin. The accused technology included Google Search, AdSense, and the autolink feature of the Google toolbar. Won summary judgment of noninfringement of all asserted claims.

*Microsoft adv. Spacone/Morrow* (Office XP "smart tags")

Successfully defended Microsoft in a patent case brought by various trusts affiliated with the bankrupt At Home Corporation in the United States District Court, Northern District of California. Asserted patent related to the automated generation of hypertext links. Won case on summary judgment of non-infringement and invalidity.

*Microsoft adv. Mallory Ventures, Inc.* (internet software)

Defending Microsoft in a patent case brought by Mallory Ventures, Inc. in the United States District Court, District of Massachusetts. Asserted patent relates to a method for identifying clients accessing network sites using cookies.

*Microsoft, et al adv. Fred B. Dufresne* (client/server internet software)

Defending Microsoft in a patent case brought by solo inventor in the District of Massachusetts. Accused technology relates to client-server programming environment where executable tags are embedded in an html file.

*Microsoft adv. Uniloc USA* (anti-piracy software)

Defending Microsoft in a patent case brought by Uniloc USA in the United States District Court, District of Rhode Island. Asserted patent relates to software registration technology. District court granted post-

currently pending before the Federal Circuit.

*Google, Inc. adv. Netjumper Software, L.L.C.* (web page navigation)

Defending Google, Inc. in a patent case brought by Netjumper Software, L.L.C. in the United States District Court, Eastern District of Michigan. Asserted patent relates to methods for navigating among search results in a web browser.

*Sandel Avionics, Inc., et al adv. Honeywell International, Inc.* (avionics software) Successfully defended Sandel Avionics, Inc. in a five patent suit brought by Honeywell International, Inc. in 2002 in the District of Delaware relating to aircraft terrain awareness and warning systems (TAWS). Case ultimately resolved by jury trial verdict of noninfringement in favor of Sandel in December 2008.

*National Instruments/SoftWIRE Technology, LLC and Measurement Computing Corporation* (graphical programming)

Asserted National Instruments' pioneering patents relating to graphical programming, embodied in LabVIEW, against SoftWIRE Technology and Measurement Computing in the United States District Court, District of Massachusetts. Also defending countersuit on two patents relating to virtual instrumentation. Case settled.

*Adobe Systems Inc. adv. Quantel Ltd.* (computer graphics software)

Successfully defended Adobe Systems in a patent infringement suit by Quantel Limited on five patents relating to various aspects of computer graphics. Defense verdict. One of the Top 10 Defense verdicts of 1997 according to *The National Law Journal*.

*National Instruments Corp. adv. Cognex Corp.* (machine vision software)

Defended National Instruments in a suit alleging infringement of two patents and related copyrights and trademarks, as well as unfair competition, relating to machine vision software algorithms and programming methods. Also asserted two National Instruments' machine vision patents against Cognex in a separate action. Cases settled on eve of trial.

*Identix, Inc. adv. Digital Biometrics, Inc.* (fingerprint image processing)

Successfully defended Identix in a patent infringement suit brought by Digital Biometrics, relating to fingerprint image recognition and processing. Summary judgment was affirmed on appeal to the Federal Circuit, reported at 149 F.3d 1335.

*Multum Information Services adv. First DataBank* (drug dosing and prescription software)

Defended Multum in a trade secret and unfair competition case relating to a software database application for drug dosing and prescription. Case settled.

*National Instruments Corp. v. PPT Vision, Inc.* (machine vision software)

Represented National Instruments in a multi-patent infringement suit against PPT. Patents related to virtual instrumentation software programmed to perform machine vision functions. Case settled on eve of trial.

*National Instruments Corp. v. Coreco, Inc.* (machine vision software)

Represented National Instruments in a multi-patent infringement suit against Coreco. Patents related to virtual instrumentation software programmed to perform machine vision functions. Case settled.

*National Instruments Corp. v. Intelligent Instrumentation, Inc.* (virtual instrument software)

Represented National Instruments in a patent infringement suit against Intelligent Instrumentation. The patents related to software that allows a PC to function as a "virtual instrument". Case settled.

*SRI International, Inc. v. Internet Security Systems, Inc. and Symantec Corp.* (Network Surveillance and intrusion detection)

Asserting SRI International, Inc. patents relating to network surveillance against ISS and Symantec in the United States District Court, District of Delaware. The patents relate to intrusion detection systems for enterprise networks.

## **TELECOMMUNICATIONS**

*Level 3 Communications adv. British Telecommunications* (installation of fiber optic cable)

Defended Level 3 Communications in a multi-patent case brought by British Telecommunications in the United States District Court, District of Delaware, relating to methods of installing fiber optic cable. Case settled.

*Oplink Communications, Inc. adv. Chorum Technologies LP* (fiber optic interleavers)

Defended Oplink in a three patent case with associated claims of trademark infringement and unfair competition relating to fiber optic interleavers, and asserted Oplink patent against Chorum in separate action relating to dense wavelength division multiplexing. Cases mutually dismissed.

*Oplink Communications, Inc. adv. E-Tek Dynamics, Inc.* (dense wavelength division multiplexing products)

Defended Oplink in a patent case relating to DWDM products and components, and counterclaimed for infringement of an Oplink patent also relating to DWDM products. Case settled.

*Level One Communications, Inc. v. SEEQ Tech. Inc.* (networking technology)

Represented Level One in a patent infringement suit brought by SEEQ Technology. The patents related to Ethernet LAN transceivers. Case settled on eve of trial.

### **BROADCAST AND CABLE TELEVISION**

*Rembrandt IP Management, LLC adv. Comcast Corporation, et al* (cable modems, VoIP, digital television)

Representing Rembrandt IP Management, LLC in a patent case against Comcast Corporation in the United States District Court, Eastern District of Texas. The patents generally relate to digital television transmission, cable modems, and high-speed internet services such as VoIP.

*Gemstar Development Corporation v. Scientific-Atlanta, Pioneer Electronics, EchoStar* (interactive program guides, set-top boxes)

Called in on eve of trial in the U.S. International Trade Commission to assist in prosecution of multi-patent case on core television technologies, including IPGs and set-top box electronics. Adverse U.S. International Trade Commission determination reversed on appeal to Federal Circuit. Case subsequently settled.

*Gemstar Development Corporation, Personalized Media Communications v. Scientific-Atlanta* (set-top boxes, cable head-end equipment)

Asserted Gemstar's exclusive rights under five Personalized Media Communications patents relating to interactive program guides, video on demand, and pay per view technologies. Case settled.

*Gemstar Development Corporation adv. Scientific-Atlanta* (set-top boxes, cable head-end equipment)

Defended Gemstar Development Corporation in a patent case brought by Scientific-Atlanta in the United States District Court, Northern District of Georgia. Asserted patent relates to cable set top box software. Case settled.

*Interactive Network, Inc. adv. NTN Communications, Inc.* (interactive television)

Successfully defended Interactive Network's basic patent on an interactive television entertainment system in a declaratory judgment action challenging infringement, validity and enforceability. Handled all aspects of case including Federal Circuit appeal and recovered over \$350,000 in attorney fees for client.

Successfully defended Interactive Network in an action alleging trademark, trade dress and copyright infringement by an interactive football game. Case settled after favorable summary judgment, reported at 875 F. Supp. 1398 (N.D. Cal. 1995).

*Interactive Network, Inc. v. Zing Sys., L.P.* (interactive television)

Brought suit for Interactive Network against Zing Systems for infringing a patent relating to an interactive television entertainment system. Case settled.

### **ELECTRONICS AND SEMICONDUCTOR**

*Lemelson Medical, Education & Research Foundation, LP v. Cypress Semiconductor Corp., et al* (semiconductor devices and manufacturing)

Defending Cypress Semiconductor, Linear Technology Corporation, LSI Logic and Micrel Semiconductor Incorporated in a multi-patent case brought by Lemelson Medical, Education & Research Foundation, LP in the District of Arizona. The patents allegedly relate to semiconductor devices and manufacturing.

*Power Integrations, Inc. v. System General Corporation and System General USA* (Circuits for PWM Controllers)

Asserting Power Integrations, Inc. patents relating to circuits for PWM controllers against System General Corporation and System General USA in the United States District Court, Northern District of California as well as the ITC. The patents relate to power supply controllers that employ pulse width modulation. Prevailed at trial in the ITC, where the patents were found to be valid and infringed.

*Power Integrations, Inc. v. Fairchild Semiconductor International, Inc. and Fairchild Semiconductor Corporation* (Circuits for PWM Controllers)

Successfully asserted Power Integrations, Inc. patents relating to circuits for PWM controllers against Fairchild Semiconductor International, Inc. and Fairchild Semiconductor Corporation in the United States District Court, District of Delaware. The patents related to integrated pulse width modulation integrated circuits that are used in power supplies for electronic devices such as cellular telephones, LCD monitors and computers. Jury found that Fairchild had willfully infringed all four Power Integrations patents asserted in the case, and awarded Power Integrations damages of \$34 million.

*Micron adv. Motorola, Inc.* (semiconductors, telecommunication, software)

Defended Micron in a 34 patent case initially brought by Motorola, Inc. and Freescale Semiconductor, Inc. in the United States District Court, Western District of Texas. Assert patents related to a host of semiconductor, electronic, and software technologies used in DRAMS, microprocessors, cell phones, and semiconductor manufacture and test. Case settled.

*Power Integrations, Inc. v. Motorola, Inc.* (high voltage analog integrated circuits)

Represented Power Integrations, Inc. as lead trial counsel in a five patent case relating to various aspects of chips used in high-voltage AC-to-DC power conversion. Jury found willful infringement and awarded Power Integrations \$32.3 million in damages, at the time the largest patent jury verdict ever awarded in Delaware. One of the most significant intellectual property cases of 1999 according to *The National Law Journal*.

*Cypress Semiconductor Corp. v./adv. Integrated Circuit Systems, Inc.* (integrated circuits for use in timing applications)

Represented Cypress Semiconductor in asserting three patents against Integrated Circuit Systems in the District of Delaware and one in the ITC, and defended Cypress against patent asserted by Integrated Circuit Systems in the Northern District of California and two patents asserted in the ITC. The patents related to timing products of various kinds (clock generators with power-down functionality and dual-function pins, and programmable clocks). Cases settled on eve of ITC trial.

*Advanced Micro Devices, Inc. v. Cypress Semiconductor, Inc.* (programmable logic devices, arithmetic logic units) Represented Cypress Semiconductor in the defense of a two patent case brought by Advanced Micro Devices. The patents involved macrocells in programmable logic devices and an architecture for a microprocessor commonly used in peripheral devices. Case settled.

*AVID Mktg., Inc. v. Beigel Tech. Corp.* (RF identification systems)

Represented AVID in an arbitration of a royalty dispute and a breach of contract and tort suit against Beigel Technology Corporation. The patent involved a passive RF identification system for use in live animals. Case settled.

*Fluke Corp. adv. Omega Engineering* (infrared thermometers and digital multimeters)

Successfully defended Fluke Corporation against charges of patent infringement by Omega Engineering. Case settled after getting summary judgment of noninfringement.

*Goldstar Instrument and Electric adv. Robertshaw Controls* (electronic range and oven controls)

Successfully defended Goldstar Instrument and Electric against a charge of patent infringement by Robertshaw Controls. Case settled.

*Diversified Technologies adv. Polarity, Inc.* (solid-state high power modulators)

Asserting Diversified Technologies patent in the Northern District of California. Accused technology relates to solid-state high power modulators for use in large radar transmitters.

*Applied Materials, Inc. adv. SEZ Holding AG, et al* (semiconductor manufacturing equipment)

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