



# Tom Hoehner

*Partner*

*Syracuse*

*P: 315.425.2839*

*thoehner@barclaydamon.com*

## Education

- Syracuse University College of Law, *Magna Cum Laude*, JD
- Cornell University, BS, Electrical Engineering

## Practices & Industries

- Intellectual Property Litigation
- Patents & Prosecution
- Trademarks, Copyrights & Licensing
- Technology
- Medical Devices
- Communications & Networking Technology
- Emerging Technologies

## Admitted to Practice

- New York
- Massachusetts
- US Patent and Trademark Office

## Court Admissions

- US Court of Appeals for the Federal Circuit
- US District Court for the Eastern District of New York
- US District Court for the Northern District of New York
- US District Court for the Southern District of New York

## Biography

A former software engineer and senior executive for an international tech consulting firm, Tom primarily concentrates his practice on representing clients in patent, trademark, and other intellectual-property matters, with an emphasis on complex patent litigation. He also counsels clients on challenging the validity of patents in the US Patent and Trademark Office, and defending clients' patents from such challenges.

With his extensive experience litigating in both the USPTO and district courts nationwide, Tom counsels clients in effectively managing the nuanced interplay between infringement and validity issues. In addition, Tom advises clients on obtaining patents and trademarks, trademark-opposition proceedings, the licensing and transfer of intellectual property, pre-purchase and merger due diligence, product-clearance studies, and the development of overall intellectual property strategies. He has represented numerous Fortune 500 companies in intellectual property matters.

Tom has significant experience working with leading high-tech industry clients, and has extensive knowledge of a variety of electrical, chemical, mechanical, and life-science technologies that include digital data compression, digital television systems, engine technologies, internet services and systems, medical devices, networking and communications systems, semiconductors, smartphones and other mobile devices, software, polymers, and video-on-demand systems.

## Bar Associations

- New York State Bar Association
- Patent Trial and Appeal Board Bar Association

- US District Court for the Western District of New York

## Selected Memberships & Affiliations

- American Intellectual Property Law Association
- Boston Patent Law Association

## Representative Experience

- Represented a global high tech company in defending against patent infringement claims relating to computer networks and print management software brought by a nonpracticing entity. Successfully invalidated all asserted patent claims through ex parte reexamination in the USPTO.
- Represented a global high tech company in defending against patent infringement claims relating to fundamental Wi-Fi technology brought by a nonpracticing entity. Aggressive litigation strategy resulted in a nuisance-value settlement and portfolio license.
- Represented a patent owner against a leading e-reader provider in pending infringement litigation and corresponding inter partes reviews involving multiple patents relating to remote asset-management technologies.
- Served as lead counsel for a patent owner in four inter partes reviews involving a variety of technologies related to medical infusion pumps, in which all litigation critical claims were confirmed as patentable, thereby clearing the way for the client's infringement case against its primary competitor.
- Represented a consortium of several global consumer-electronics companies and a preeminent US university in enforcing their collective patent rights through a series of infringement actions relating to the transmission and reception of digital television signals and the ATSC digital television standard.
- Represented a consortium of several global consumer-electronics companies in enforcing their collective patent rights through a series of infringement actions relating to the compression of digital signals and the MPEG-2 digital-compression standard.
- Represented a consortium of leading smartphone companies in complex patent infringement action involving the assertion of multiple patents against an industry competitor, resulting in a favorable settlement and licensing agreement.
- Defended an industry founding provider of video-on-demand technologies in obtaining the denial of a \$100 million motion for contempt of a patent injunction entered while the client had been represented by other counsel. Obtained affirmance of the district court's decision on appeal to the US Court of Appeals for the Federal Circuit.
- Represented a leading computer-networking equipment provider in resolving a long-standing patent infringement

action involving multiple patents and cross-claims between the parties.

- Defended a popular online car-buying website in resolving a patent infringement action brought against it, resulting in a favorable settlement and license agreement.
- Defended a national footwear retailer in resolving a design patent and trademark infringement and licensing dispute brought by a famous international brand.
- Represented a leading provider of telecommunications equipment in an International Trade Commission proceeding involving utility and design patents for coaxial cable connectors, successfully obtaining exclusion orders to prevent the importation of infringing products.

## Prior Experience

- Hiscock & Barclay, LLP, Partner
- Proskauer Rose LLP, Senior Associate
- Marjama Muldoon Blasiak & Sullivan LLP, Associate
- Keane, Inc., Senior Principal Consultant
- beMANY.com, Inc., Product Development Director
- Accenture, Communications and High-Tech Industry Portfolio Manager

## Selected Community Activities

- Cornell Alumni Admissions Ambassador Network, Member

## Selected Honors

- Selected to *Super Lawyers* Upstate New York Rising Stars: Intellectual Property Litigation, 2018