



## Mark K. Dickson, Ph.D.

### Partner

#### *Phase M, LLP*

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#### **Legal Experience:**

- IP Protection and Counseling
- Patent Procurement and Strategy
- Technology Licensing
- Portfolio Evaluation, Risk Assessment and Litigation

#### **Education:**

- University of Houston, JD, 1988
- Washington State University Ph.D., Chemistry, 1982
- University of Southern Colorado B.S., Chemistry, 1977

#### **Bar Admissions:**

- California
- Texas
- District of Columbia (inactive)
- U.S. Patent & Trademark Office

#### **Court Admissions:**

- U.S. Supreme Court
- USCA - Federal Circuit
- USCA - 9<sup>th</sup> Circuit & D.C. Circuit
- Northern District of California
- Central District of California
- Eastern District of California
- Southern District of California
- Northern District of Texas

#### **Clerkships:**

- Hon. Pauline Newman, USCA - Federal Circuit (1988 - 1990)

Mark K. Dickson is a patent attorney specializing in intellectual property acquisition, strategy, licensing and counseling. He has over twenty years of experience helping clients of all sizes successfully navigate the intellectual property landscape. He has represented corporations and individuals in patent and trademark litigation, as well as handling procurement, portfolio development, licensing and client counseling in intellectual property matters for a wide range of industries. His legal background includes prosecution, risk assessment, patent analysis, product clearance/freedom to operate, and litigation. His range of technical experience includes nanotechnology crystalline films, software, hospital medication systems, pharmaceuticals, oil field and biofuels technology, biotechnology and chemical instrumentation, chemical and semiconductor manufacturing processes, plant variety protection, infrared motion detection systems, polymers, and resins.

Prior to co-founding Phase M, LLP, Mr. Dickson was a partner in Winston & Strawn's San Francisco office, concentrating in intellectual property protection, litigation, and enforcement. He is a former partner of Howrey LLP in the Silicon Valley office, and was a Shareholder at Arnold White & Durkee prior to the firm's merger with Howrey. Mr. Dickson was selected as a Super Lawyer in intellectual property litigation for Northern California in 2006.

Mr. Dickson served as a law clerk for the Hon. Pauline Newman in the U.S. Court of Appeals for the Federal Circuit in 1988-90. In 1984-85, he was selected as a Congressional Science Fellow from the American Chemical Society and worked in Washington, DC for Congressman Ed Zschau, 12<sup>th</sup> District, California. He previously worked as a Research Chemist for Shell Development Company and a Patent Agent in the Shell Oil Company Patents & Licensing Department.

#### **Education:**

Mr. Dickson received a B.S., with Special Distinction, in Chemistry, from the University of Southern Colorado (now Colorado State University - Pueblo) in 1977, a Ph.D. in Inorganic Chemistry from Washington State University in 1982, and a J.D. from the University of Houston in 1988.

**Activities:**

Mr. Dickson is a member of the American Bar Association and has been an officer or committee chair in the ABA Section of Intellectual Property Law for nearly 20 years. He has been nominated for a four year term on the Section's Council beginning in August 2009. He served as Section Financial Officer (2001-2004) and Annual Publications Officer (1998-2001). He is currently a member of the Content Advisory Board for managing the Section's publications. He is a past president and board member of the San Francisco Intellectual Property Law Association and a member of the Federal Circuit Bar Association, American Intellectual Property Law Association, AIPPI (International Association for the Protection of Intellectual Property) and the American Chemical Society.

**Speeches and Publications:**

Mr. Dickson has spoken to various groups on current issues of patent enforcement and prosecution. His most recent presentations include a January 30, 2008 program on ethical obligations under the PTO Rules at the Los Angeles Intellectual Property Law Association 11<sup>th</sup> Annual Washington in the West Conference, a Sept. 7, 2007 program on inequitable conduct for the Loyola Law School IP Focus Series: "Patent Prosecution," and an August 15, 2007 panel presentation on recent inequitable conduct litigation for the Patent Standing Committee of the California State Bar. Mr. Dickson was the editor for the third edition of "Marketing Your Invention," released by the ABA Section of Intellectual Property Law in March 2009. Mr. Dickson is the co-author of "U.S. Expands Patentability of Software and Business Methods: Can There Be Patents on Familiar Ways to Solve Business Problems?" which was published in *IP Worldwide* in the 1999 January-February issue. In addition, he is the author or co-author of 20 technical papers and presentations, a patentee of U.S. Patent No. 4,533,740, "β-Lactone Process," and a member of Sigma Xi, The Scientific Research Society.

**Representative Trials and Pre-Trial Decisions***McKesson Information Solutions Inc. v. Bridge Medical, Inc.*

Mr. Dickson represented McKesson as the patent owner in this infringement suit regarding wireless patient bedside medication equipment. The patent was held unenforceable, but Mr. Dickson successfully opposed a multi-million dollar motion for attorney fees, one of only two known published decisions at the time denying such fees.

*3D Systems, Inc. v. James V. Crivello and Rensselaer Polytechnic Institute*

Mr. Dickson represented the defendants in this patent and contract action involving polymer modeling materials. After defeating a preliminary injunction motion, he obtained a favorable settlement.

*Allcare Healthcare Management System, Inc. v. Cerner Corp. Healthcon Corp., McKesson HBOC Corp., IDX Systems Corp., Merck-Medco*

*Managed Care, LLC, Eclipsys Solutions Corp., Express Scripts, Inc., PCS Health Systems, Inc., Science Applications Int'l Corp., Envoy Corp., and Diversified Pharmaceutical Services, Inc.*

Mr. Dickson represented McKesson in this patent infringement litigation involving medical information software and obtained a favorable settlement.

*Primus Corporation v. Bio-Rad Laboratories, Inc.*

Mr. Dickson represented Bio-Rad in a patent infringement and antitrust case for medical instrumentation. A favorable settlement was obtained after a grant of summary judgment dismissing the antitrust claims.

*KLA-Tencor Corp. v. Tokyo Seimitsu Co., Ltd and TSK America, Inc.*

Mr. Dickson represented Tokyo Seimitsu and TSK America in a patent infringement matter involving semiconductor equipment for defect detection. The patent was invalidated on summary judgment motion.

*Cleangro Ltd. v. North American Royalty Administration, Inc., GroLink Chrysanthemums, et al.*

Mr. Dickson represented the plaintiff Cleangro in this plant patent infringement and contract breach claim. The case was settled.

*Arbor Software Company v. Planning Sciences, Inc. and Planning Sciences, Int'l*

Mr. Dickson represented the defendants in this patent litigation involving multidimensional database software. The case settled following a claim construction hearing.

*Applied Materials Inc. v. Novellus Systems, Inc.*

Mr. Dickson represented Applied Materials in patent litigation on semiconductor manufacturing equipment. The case settled after successful summary judgment motions and a favorable jury trial decision for Applied.

*Trilogy Development Group v. Teknowledge Corp.*

Mr. Dickson represented Teknowledge in this patent litigation involving artificial intelligence software. The case was settled.

*Hoechst Celanese Corp. v. Brewer Science*

Mr. Dickson represented Hoechst in a patent infringement declaratory judgment action involving polymers used in semiconductor mask manufacturing process. A favorable settlement was obtained after Brewer dismissed its patent claims and granted a covenant not to sue.

*Intel v. Hyundai Electronics Industries Co., Ltd and Hyundai Electronics America, Inc.*

Mr. Dickson represented Intel in this patent litigation on a semiconductor manufacturing process. The case was settled on favorable terms.

*Fuji Optical Systems, Inc. v. High Tech Medical Instrumentation, Inc., et al.* (Counterclaim Defendants Skjerven, Morrill, MacPherson, Franklin & Friel, Steven Caserza, and Leydig, Voit & Mayer)

Mr. Dickson represented Skjerven, Morrill in a trade secrets and patent litigation for dental video cameras. The case was settled.

*Leviton Mfg. Co. v. Intelectron Prods. Co.*

Mr. Dickson represented Intelectron in a patent infringement matter involving motion detector systems. The case settled after a jury trial on liability and a separate jury trial on damages.

### **Markman Hearings**

*McKesson Information Solutions Inc. v. Bridge Medical, Inc*

Mr. Dickson represented McKesson on claim construction matters that began with a two-day hearing on 18 claim terms at issue for a patient identification and verification system using bar code scanning for bedside patient medication delivery.

*Arbor Software Company v. Planning Sciences, Inc. and Planning Sciences, Int'l*

Mr. Dickson represented Planning Sciences, Inc. and Planning Sciences, Int'l in this infringement case involving multidimensional database software, including a one-day claim construction hearing.