



## → Robert M. Masters

### Partner

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Robert Masters is a partner in the Intellectual Property Practice Group in the firm's Washington, D.C. office.

### Areas of Practice

Robert focuses his practice on intellectual property law, routinely handling patent, trade secret, copyright and trademark/trade dress litigation in courts throughout the U.S., before the International Trade Commission, and before the U.S. Patent Trial and Appeal Board (PTAB). In addition, he regularly advises clients on intellectual property licensing, negotiations, due diligence investigations, portfolio management and monetization, combating counterfeiting issues, best practices for corporate intellectual property legal departments and on intellectual property issues arising in corporate mergers and acquisitions matters.

Robert represents clients in matters involving technologies such as consumer electronics; semiconductor designs/processes; computer hardware; software, including artificial intelligence and apps for smartphones and tablets; secured internet/network communications and protocols, including Internet of Things (IoT); industrial equipment, including welding and cutting equipment; consumables; telecommunications; financial services and technology (fintech); automotive; medical devices; and sporting goods, including golf equipment, among many others.

### Honors

Leading Individual - Intellectual Property, *Chambers USA*

Leading Lawyer - Patent Litigation, *Legal 500*

### Experience

#### Recent Representations:

- Lead counsel for two **European manufacturers of semiconductor testing devices and probes** in a patent infringement matter, and defending their patent before the Patent Trial and Appeal Board.
- Lead counsel for a Chinese telecommunication company in a patent infringement matter involving mobile SIM sharing technologies, and defending their patents before the Patent Trial and Appeal Board.
- Lead counsel for leading **welding company** in an international arbitration under the ICC in Zurich, Switzerland. The case involves allegations of breach of technology and license agreements involving the manufacture and sale of consumable welding equipment.

- Lead counsel for an **Asian joint venture entity** in a matter involving the licensing of optical disk drives and related components, including issues of standard essential patents (SEPs) and fair, reasonable and non-discriminatory licensing (FRAND) agreements.
- Lead counsel for a Japanese consumer electronics company to assist in the enforcement and licensing of its standard essential patent portfolio and representation of the company before a standard setting organization on technology relating to stylus and touch displays.
- Counseled a **multi-billion dollar company** in an over-haul of its intellectual property department by utilizing IP corporate best practices and strategies to institute new policies and practices to build and maintain a robust patent/trademark portfolio.
- Lead counsel for a **Japanese company** in a series of *inter partes* reviews (IPRs) of several patents directed to semiconductor design/process patents.
- Counseled **client** in a patent infringement matter involving gambling and state lottery games.
- Lead counsel for **Japanese company** in several matters defending its semiconductor-related patents before the Patent Trial and Appeal Board.
- Lead counsel for **Pacific Bioscience**, a L'Oreal company, in a patent and trade dress infringement matter involving the company's highly successful line of Clarisonic products. In this matter, we represented Pacific Bioscience in actions filed in U.S. District Court and the U.S. International Trade Commission to stop the importation of counterfeits and infringing devices by over 20 companies into the U.S., and to obtain a general exclusion order against all other infringing products.
- Lead counsel for **ESAB Group, Inc.**, a subsidiary of Colfax Corporation, in a matter involving claims of infringement of 11 patents and breach of contract/license agreement. The technology involved welding and cutting equipment. The case was filed against our client in the Eastern District of Wisconsin. After extensive discovery, we successfully resolved the case on terms favorable to our client.
- Lead counsel for **Motivate** and **New York City Bike-Share** in patent/copyright infringement and trade secret/employment matters against one of its competitors involving the successful bike-sharing technology deployed in New York and other cities across the U.S.
- Lead counsel for **Cesca Therapeutics** in a patent infringement matter involving point-of-care blood separation devices used to process and prepare cell concentrates from blood and bone marrow aspirates, and antitrust claims related to the filing of a sham litigation.
- Co-lead counsel for **Samsung** in a patent infringement matter involving chipsets used in smartphones and tablets.
- Lead counsel for several major investors in **DeltaWing Technologies**, an innovator in the design of narrow-front-track automobiles, in matters involving theft of trade secrets and defamation.
- Lead counsel for **Waddell & Reed Financial** in a patent infringement matter involving the interpretation of a general public license used for open source software and a copyright infringement action involving the right to use accounting software.
- Lead counsel for **BMO Harris, N.A.** in several patent infringement actions involving check imaging, authentication methods and secure communications and methods of payment across websites from smartphone and related apps.
- Lead counsel for **NEC Corp.** and **NEC Corp. of America** in patent infringement actions involving computer servers and network communications, protocols and establishing secure communications.

- Lead counsel for **Flexsys America, LP** in a patent infringement action involving antidegradants used for tires and other rubber products.
- Lead counsel for **Japanese manufacturer** in a patent infringement action involving semiconductor memory devices.
- Lead counsel for leading companies, including **Ford Motor Company, Goldman Sachs, Petco, Johnson & Johnson, GlaxoSmithKline, Delta Airlines, AstraZeneca Pharmaceuticals LP** and others in a series of patent infringement actions involving authenticating and securing communications over a network.
- Lead counsel for **HTI IP, LLC** and **Networkfleet, Inc.** in a patent infringement matter involving vehicle telematics.
- Lead counsel for **Konami Digital Entertainment** in a patent infringement matter involving musical video games, including Rock Band® and Rock Revolution® rhythm games.
- Lead counsel for **Bridgestone Sports Co., Ltd.** in a patent infringement action against Acushnet Company involving golf ball.
- Lead counsel for several **Japanese manufacturers of consumer goods** in patent infringement actions involving facsimile machines enabled to communicate via emails; digital photo processing; and LCD-based projectors.

## Articles

- Federal Circuit Makes It More Difficult for Accused Infringers to File Declaratory Judgment Actions  
*IP Litigator*, July/August 2020
- Intellectual Property Outlook: Cases and Trends to Follow in 2020  
*IP Litigator*, May/June 2020
- The Advent of 5G Cellular Technology Will Amplify Inefficiencies in the Licensing of Standard Essential Patents  
*Corporate Counsel*, 01.17.2020

## Intellectual Property Law Blog Posts

- "Intellectual Property Outlook: Cases and Trends to Follow in 2020 – PART 4," March 25, 2020
- "Federal Circuit Makes It More Difficult for Accused Infringers to File Declaratory Judgment Actions," March 17, 2020
- "Intellectual Property Outlook: Cases and Trends to Follow in 2020 – PART 3," March 4, 2020
- "Intellectual Property Outlook: Cases and Trends to Follow in 2020 – PART 2," February 3, 2020
- "Intellectual Property Outlook: Cases and Trends to Follow in 2020 – PART 1," January 17, 2020

## Events

Five Keys to Successful IPR Petitions  
Webinar, 01.27- 01.28.2021

Retail Law Conference 2020  
Retail Industry Leaders Association  
October 20-22, 2020

## Podcasts & Webinars

Nota Bene Episode 99: Unpacking the Pendulum of American Patent Policy Then, Now, and Forward with Rob Masters  
09.30.2020

## Practices

Entertainment and Digital Media  
Healthcare  
Intellectual Property  
Copyrights  
False Advertising, Lanham Act and Unfair Competition  
International Trade Commission (ITC)  
IP Licensing, Technology and Commercial Transactions  
Patent Litigation  
Patent Prosecution and Counseling  
Post-Grant Proceedings  
Trade Secrets  
Trademarks and Trade Dress  
International Arbitration  
International Reach  
China  
Japan  
Korea  
Litigation

## Industries

Esports & Games

## Education

J.D., University of Baltimore, 1990  
B.S., Pennsylvania State University, 1985

## Admissions

District of Columbia

Maryland

U.S. Patent and Trademark Office

U.S. District Court for the District of Columbia

U.S. District Court for the District of Maryland

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

U.S. District Court for the Eastern District of Wisconsin

U.S. Court of Appeals for the Federal Circuit