



James P. Martin

PARTNER

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AREAS OF EXPERTISE

Intellectual Property, Technology Transactions, Litigation, Internet and E-Commerce, Competition and Preparations to Compete, Emerging Companies and Startups, Patents, Trademarks, Copyrights, Trade Secrets, Wine Industry

Overview

James Martin is the Chair of the Intellectual Property Group and has more than 25 years of experience representing high-tech companies and their employees in intellectual property matters and technology-based transactions. James' practice focuses on drafting and negotiating agreements involving the development, acquisition, licensing and protection of intellectual property. James also counsels clients with respect to commercial transactions, negotiation of executive employment packages, consumer privacy and doing business online. James has deep experience in patent and other intellectual property litigation, and he leads cases and provides strategic oversight and direction with respect to his clients' intellectual property litigation. James also analyzes patent portfolios and provides freedom to operate opinions. In addition to his high-tech practice, James has also worked with non-technical clients, such as wineries, restaurants, authors, artists and entrepreneurs, to protect and enforce their intellectual property rights. Prior to attending law school, James worked for Hewlett-Packard and IBM.

Experience

TECHNOLOGY TRANSACTIONS AND COUNSELING

James negotiates transactions and agreements involving a broad array of technologies. James also acts as outside general counsel to companies of various sizes, ranging from early-stage startups to publicly traded companies. James creates intellectual property protection plans specifically tailored to each client to help protect and secure patents, trademarks, and copyrights, and advises employers and employees regarding trade secrets issues and covenants not to compete. James also counsels clients regarding Internet websites, and conducts due diligence on patents and other intellectual property assets in mergers and acquisitions.

Representative matters include:

- Licensing (inbound and outbound) of technology, content, computer software, patents, trademarks, copyrights and other intellectual property.
- Technology agreements, including research and development, strategic alliance, collaborations and co-development, marketing, private label and co-branding agreements.
- Software and mobile device application agreements, including end user licenses, terms of service, support and maintenance, hosting, source code escrow and software as a service (SAAS) agreements.
- Sales and distribution agreements, including customer, reseller, OEM and sales representative agreements.
- Outsourcing agreements, manufacturing and supply agreements and master services agreements.
- Confidentiality and nondisclosure agreements, employment agreements, independent contractor agreements, subcontractor agreements and invention assignment agreements.
- Internet privacy policies, terms of use and backbone agreements for online and e-commerce businesses.
- Open source software analysis and agreements, including licensing, auditing, compliance and analysis regarding free and open source software.

- Representation of officers and executives in negotiations with new employers, and advice and counseling regarding preparations to compete.
- Due diligence on behalf of buyers and investors with respect to patents, trademarks, copyrights, trade secrets, and open source software.
- Intellectual property advice and counseling, trade secret audits and protection programs, copyright and trademark applications, and branding.

Publications/Speaking

INTELLECTUAL PROPERTY LITIGATION

James works closely with the trial lawyers at the firm in cases involving patents, trademarks, copyrights, trade secrets and other business disputes. James is a trial lawyer who has successfully represented numerous clients in intellectual property disputes and other commercial litigation. James now leads cases and provides strategic insight and guidance to the firm's litigation attorneys. After understanding his clients' goals and objectives, James manages cases as a powerful advocate for his clients' interests. James formulates and executes innovative strategies to obtain successful early outcomes. Such strategies are discussed with clients along with other options and alternatives so that each client can make informed business decisions with respect to litigation.

Representative matters include:

- Patent infringement cases on behalf of patent holders and alleged infringers in technology areas including software, hardware, mobile device applications, semiconductors, electronics, mechanical devices, chemical compositions, e-commerce, and Internet.
- Trademark prosecution and defense across all industries, including Internet websites, computer hardware and software, technology, consumer goods, financial and investment services, food and beverage, restaurants and wine.
- Copyright litigation, including cases involving mobile device applications, digital content, the Digital Millennium Copyright Act (DCMA), fair use and other emerging issues relevant to software, apps, social media and Internet businesses.
- Trade secret cases on behalf of corporate employers and former employees in cases involving intellectual property misappropriation and ownership, breach of fiduciary duty, covenants not to compete, unfair competition and unfair business practices.
- Internet disputes, including cybersquatting, defamation and privacy cases relating to website content, blogs, message boards, chat rooms and social media.
- Breach of license and breach of contract cases, false advertising and other complex litigation with intellectual property implications.

FREEDOM TO OPERATE OPINIONS

James analyzes patents and patent portfolios, and provides IP portfolio management and strategic planning counseling, as well as freedom to operate and validity opinions.

LITIGATION ANALYSIS

James monitors and analyzes patent and intellectual property litigation for our investment adviser clients for cases in which the firm is not representing one of the litigants. He provides legal analysis relating to trials, motions, claim construction hearings and other significant events in cases of market significance for publicly-traded companies. Our clients have made successful investment decisions based in part on the information provided through this unique service.

Professional Activities

James is a member of the United States Patent Bar and is registered to practice before the United States Patent and Trademark Office. James is also a member of the American Intellectual Property Law Association ("AIPLA") and the Intellectual Property Law Sections of the California Bar Association and the Bar Association of San Francisco. He has written and lectured on a variety of topics related to intellectual property and the Internet.

Education

University of Florida

B.S. in Electrical Engineering, highest honors

Minor in business administration

University of Michigan Law School

J.D., *cum laude*

The Hon. Laughlin E. Waters

U.S. District Court for the Central District of California

Law Clerk

Admissions

California State Bar