

FRANK UBELL BIOGRAPHICAL SKETCH

Frank majored in Electrical Engineering at the University of Illinois, Champaign Urbana, where he ranked first in his class with a 4.99/5.00 GPA and received numerous University honors for academic excellence and extracurricular contributions to the University and the Department of Electrical Engineering.

As a college Senior, Frank competed with graduating EE Seniors from other high-ranking institutions like MIT, Stanford, Cal Tech, UC Berkeley, for a summer internship at the NASA Manned Space Craft Center, Houston, Texas, and was ultimately one of two Seniors in the country selected for the internship. At NASA, Frank received his first hands-on computer design experience, working on developing the data management system for the Space Shuttle.

Frank then attended the George Washington University National Law Center at night and was employed full time by the Washington D. C. patent operation of a major computer manufacturer where he became a registered U.S. patent agent and worked daily performing patent searches at the US Patent Office, interviewing Patent Examiners, and preparing US patent and trademark applications. While in law school, Frank honed his litigation skills as a member of the GW law school patent moot court team which placed second in the nation in the annual Giles Sutherland Rich Patent Moot Court competition.

After law school, Frank accepted a job in California as in-house patent counsel with his law school employer where he continued to prepare and prosecute patents and copyrights related to computers, computer software, and semiconductors and earned a California Community College teaching credential in computer science.

Frank then jumped into major patent infringement/antitrust litigation with the Orange County firm Jackson & Jones, which was embroiled in multi-district patent/antitrust litigation with AT&T, Western Electric, Bell Labs, and other manufacturers over patents on data modem technology which included lawsuits in U.S. District Courts in Boston, Kansas City, Los Angeles, Miami, New Jersey, and New York, and ultimately the government-filed antitrust suit in Washington DC, which resulted in the break-up of the Bell System.

During the five year span of the litigation, Frank developed and implemented a successful defense strategy against 7 Western Electric data modem patents, second chaired patent infringement trials in Kansas City and Boston, wrote a winning brief on appeal in the 10th Circuit, and traveled continuously between residences in California, New Jersey, and Miami, arguing countless discovery and other motions and taking depositions of numerous Bell Systems engineers and high ranking Bell Labs and AT&T executives.

At the conclusion of the multi-district litigation, Frank and his firm joined with a prominent Los Angeles antitrust firm to bring a contingency fee patent/antitrust suit against AT&T on behalf of

another supplier of telephone network related equipment, which resulted in a rewarding settlement.

Frank and two of his Jackson and Jones partners then formed the firm of Price, Gess & Ubell where they litigated and tried numerous patent, copyright, trademark, and trade secret cases, while also procuring scores of patents, trademarks, and copyrights for their clients. During this period, Frank was retained to represent Masco Corporation (F500) California subsidiary Watkins Manufacturing Corp. (Hot Springs Spas) and by LED lighting manufacturer Tempo Industries for whom he procured 42 US patents in the LED lighting space. Frank also litigated and went to trial in California State Court in cases involving claims of fraud, defamation, breach of contract, trade libel, right of publicity, and unfair competition.

During this time, Frank also litigated the landmark trademark infringement case of *Adray v. Adrymart*, tried the case to a jury, and later prevailed on appeal in a case which changed the law of trademark infringement damages in the Ninth Circuit, opinion reported at 76 F.3d 984 (9th Cir. 1995). Frank also tried several trademark cancelation and opposition proceedings before the Trademark Trial and Appeal Board, including a win over Hard Rock Café. *Elsea v. Hard Rock Café Licensing Corp.*, 48 USPQ 2d 1400 (TTAB 1998) - a leading case on the subject of admissibility of evidence in TTAB proceedings.

Frank then moved to Brobeck, Phleger, and Harrison, where he appeared as a first chair member of litigation teams in a string of high profile patent infringement cases including *Qualcomm, Inc. v. Conexant Systems and Skyworks Solutions, Inc.*; *Oakley, Inc. v. Sunglass Hut, Luxxotica et al.*; and *Perkin Elmer v. Amersham Pharmacia Biotech*, the last of which involved patents on the basic DNA sequencing machines and chemistry used to sequence the human genome. In *Oakley*, Frank was principal author of a brief on appeal to the Federal Circuit.

In the *Amersham* case, Frank was one of four partners who divided up the presentation of the case, supported by fourteen associate attorneys. In particular, Frank was tasked with preparing the damage case for the jury comprising lay witness and expert testimony sufficient to prove lost profits/reasonable royalties in excess of one billion dollars.

The Brobeck firm went out of business during the 2000 dot.com crash, and Frank went on to become a partner in the IP Group of Paul Hastings and subsequently Greenberg Traurig LLP, where he served for several years as the Chair of the IP Practice of GT's Orange County office. Among the many litigation matters he first-chaired at GT, Frank spent roughly five years representing computer manufacturer Dell, Inc. in Federal District Court and FTC proceedings related to assertion of patents alleged to cover the IEEE 802.3 Ethernet and 802.11 Wi Fi networking standards - in other words every computer in the United States. During the FTC proceedings, Frank served as lead patent counsel for Dell and conducted fact-finding interviews of numerous industry engineers who designed and developed the technology and the standards and then made an oral presentation to the FTC which contributed to entry of a consent decree

in 2008 requiring compulsory licensing of the patents in question by patent owner Negotiated Data Solutions.

Following ten years as a partner at Greenberg Traurig, Frank joined his former colleague Matt Lapple to form Lapple Ubell IP Law, LLP, where Frank continues his IP counseling, procurement, and litigation practice. Of note, Frank has prepared patent applications involving robotics and artificial intelligence and has participated in the firm's litigation efforts directed at foreign knock-off products, such as the case of *Glam&Glitz v. iGel Beauty* currently pending in U.S District Court in Orange County and involving claims of design patent and trade dress infringement.

Disclaimer: the results of all cases discussed above and below are dependent on the specific facts of each case, and results will differ in other cases, dependent on the specific facts of those cases.

Additional Examples of IP Cases Litigated By Frank

1. *Paraskevas v. Hajek et al* (O.C. Superior Court) – this case was a five-day trial to the Court on state law claims of fraud, business torts, and right of publicity involving who had the right to claim they had the original 1966 Gas Ronda Mustang funny car. Frank represented the defendants and conducted all direct and cross examination of both lay and expert witnesses during trial. The Court found defendants not liable on all counts.
2. *Joystick Technologies v. Kraft Systems* (S. D. Cal.) - patent infringement defense, case ended when the Court granted Frank's motion for summary judgment holding that a previous settlement between the parties was res judicata as to plaintiff's claims.
3. *Clark v. Everitt Associates, Inc.* (C. D. Cal.) - represented plaintiff in patent infringement case on a pioneer folding portable massage table patent. Frank won a finding of willful infringement and infringement under the doctrine of equivalents on summary judgment in front of Judge Gary Taylor (*Ret.*) in Santa Ana. See 57 F. Supp. 2d 874-888.
4. *ATR Sales v Lovejoy* (C.D. Cal.) – patent infringement suit over mechanical flexible couplings. Case settled favorably after tentative finding of infringement on Frank's motion for summary judgment before Judge Carter.
5. *Robbins and Craig v. American Electro Products, Inc.* (C.D. Cal) – suit for trade secret theft of process for manufacturing electro plating belts. After discovery, the Court, per Judge Tashima, granted Frank's motion for a preliminary injunction putting Defendant's copied process out of business.

6. *Kavlico Corp. v. Hilbert* (C.D. Cal) – defended individual ex-employee/engineer against motion for preliminary injunction based upon alleged theft of trades secrets pertaining to Linear Variable Differential Transformers and succeeded in obtaining denial of the motion, the Court finding that the alleged secrets were generally known in the trade or discernable from well-known design principles.
7. *Dark v. Smiletote, Inc.* (C. D. Cal.) - represented plaintiff in patent infringement case with contract and business tort issues involving molding technology and design of toddler juice cups. Case settled after filing of 300 pleadings.
8. *Oakley, Inc. vs. Gatorz Sport Optiks* (S. D. Cal.) – defended patent infringement case on Oakley sunglass patents. Case settled after complete pretrial preparation.
9. *Lighting World, Inc v. Tivoli Industries* (S. D. N. Y.) - defense of suit filed for infringement of electric lighting patents. Case settled after extensive proceedings.
10. *ATR Sales v. QM Industries* (C.D. Cal) – Frank represented plaintiff in a suit for Lanham Act and trade secret violations and unfair competition against Canadian distributor of ATR's flexible mechanical coupling products. Dismissal of case was appealed to the 9th Circuit and reversed after oral argument. Case settled on eve of trial of companion Canadian lawsuit.
11. *Tivoli Industries, Inc. v. Tivoli Systems/ IBM* (TTAB) - represented opposer Tivoli Industries in trademark opposition involving "Tivoli" for lighting apparatus vs. "Tivoli" for computer software. Case settled after filing of 107 pleadings.