



## Sean S. Wooden

Partner

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### Practices

FOCUS: Intellectual Property

Copyrights and Copyright Litigation

Corporate

Intellectual Property Litigation

Patents

Patent Litigation

Privacy, Data and Cybersecurity

Trademark Licensing and Strategy

Trademarks and Trademark Litigation

Trade Secret Protection and Litigation

### Industries

Energy

Sports and Sports Facilities

Technology

### Recognition

Legal 500, 2019

### Education

JD, Rutgers School of Law–Camden, with honors

Sean S. Wooden is a partner in the firm's Intellectual Property practice, focusing on advising clients regarding patents, copyrights, trademarks and trade secrets and other areas of law related to technology. He develops, manages and exploits IP portfolios. Sean's practice involves the procurement of intellectual property rights such as patents, trademarks and trade secrets.

Sean has particular experience in building patent portfolios that may be sold for significant return on investment. He recently helped sell one client's patent portfolio for greater than a 5x return on investment, and is actively negotiating the sale of other patent portfolios.

Sean handles numerous technology and IP licensing transactions and a wide variety of other types of agreements. He regularly handles complex licensing, master service agreement, outsourcing, and other technology transaction negotiations. He works closely with his corporate colleagues to negotiate IP and technology relevant sections of M&A agreements, run IP, information technology, open source and export-compliance diligence, and otherwise support the firm's corporate client IP needs. He often acts as outside IP counsel, working directly with officers and in-house counsel to ensure adequate protection of company IP.

Sean helps clients pursue infringers through litigation and licensing. His litigation experience includes matters in federal district courts, the Trademark Trial and Appeal Board, and the US International Trade Commission. He regularly assists clients to evaluate their IP and potential claims, to build a case and litigation strategy against potential targets, and to obtain litigation funding to pursue such claims and strategy. Sean also regularly renders opinions and advice regarding patentability, infringement and validity issues.

Sean advises clients on various export matters, including obtaining export licenses, registration, licensing and compliance with and under the US Commerce Department Export Administration Regulations, International Traffic in Arms Regulations and the Bureau of Industry and Security requirements.

His technical areas of experience include software; alternative and renewable energy; semiconductors and other circuitry; telecommunications; digital signal processing; network technology; and mechanical devices and systems.

Sean is also a frequent lecturer on US intellectual property law for degree programs offered at universities in Germany, the Netherlands and Switzerland.



BSEE, Cornell  
University, College of  
Engineering

**Bar Admissions**  
District of Columbia  
New Jersey

### **Selected Experience**

- Successful assertion of a technology innovator's patent claims against a multinational smartphone component supplier.
- Defense of an upscale American retailer against plaintiff appeal of summary judgment of non-infringement.
- Defense of a provider of infrastructure communications solutions in a patent infringement action before the US District Court for the Northern District of California involving cellular and Wi-Fi technology.
- Successful defense of an upscale American retailer in a software/business method case before the US District Court for the Eastern District of Texas; obtained summary judgment of non-infringement.
- Defense of an online flower delivery service in a software business method patent infringement action before the US District Court for the Eastern District of Texas.
- Defense of a provider of restaurant business intelligence against alleged patent infringement involving a point-of-sale reporting system using the Internet.
- Defense of a provider of IA solutions against two patent counterclaims involving web-based certification and accreditation systems.
- Representation of an American multinational technology company in three patent counterclaims filed by the client and copyright infringement and contract claims against the client arising out of source code contributions to LINUX.
- Representation of a provider of sterilization management services as plaintiff in a patent infringement claim for an irradiation system before the US District Court for the Central District of California.

### **Memberships**

- International Association of Privacy Professionals

### **Speaking Engagements & Presentations**

- Presenter | Intellectual Property Issues for Startups | Village Capital Health: US 2015 | Washington, DC (November 4, 2015 )
- Presenter | Intellectual Property Issues for Startups | Techstars Austin Chapter | Austin, Texas (August 30, 2013)
- Presenter and Moderator | Lecture 2: Copyright and Trademarks | Nation Council of Entrepreneurial Tech Transfer (April 24, 2008)
- Panelist | Legal Considerations and Strategies for Cleantech Start-ups | WIREC 2008 Official Side Event (March 6, 2008)
- Panelist | Legal Considerations and Strategies for Cleantech Start-ups | Clean Energy Venture Summit (May 14, 2007)