





DJ Healey

Senior Principal

 Houston, TX

 713-654-5310

 healey@fr.com

“DJ is a very effective advocate for her clients.”

— *Client testimonial, 2021 Chambers and Partners USA*

“She’s a go-to for big strategy thinking. She has a very good knowledge of the law and an ability to outthink everybody.”

— *Client testimonial, 2020 Chambers and Partners USA*

“Healey stands out for her trial and arbitration experience and dual patent and unfair competition expertise.”

— *Client testimonial, 2019 IAM Patent 1000*

Overview

About DJ

Danielle (DJ) Healey has been litigating complex cases in federal courts, state courts, and agencies, and handling licensing, antitrust, mediation and arbitration matters for over 34 years. She has focused on patent litigation and related antitrust and tort claims since 1994.

Ms. Healey has tried cases in U.S. district courts, state courts, U.S. International Trade Commission, International Chamber of Commerce (arbitration), American Arbitration Association, NASD Arbitration Forum, and private arbitration. She has argued appeals in the Federal Circuit, Fifth Circuit and Fourth Circuit courts of appeals, as well as the Texas Supreme Court and Texas Intermediate Courts of

Appeals. Ms. Healey has been actively involved in planning and executing multi-jurisdictional strategies involving courts in the U.S. and Europe, and administrative agencies (including reviews in the U.S. Patent and Trademark Office (USPTO), invalidity and declaratory judgment actions in Europe, and state regulatory matters). Ms. Healey has worked on patent and antitrust issues with the U.S. Federal Trade Commission (FTC), and has represented clients intellectual property related competition matters before the FTC, the European Union, and Texas state authorities.

Ms. Healey has been involved in negotiating patent licenses in the semiconductor and software industries, she has represented clients in dealing with obligations and licensing in standard-setting organizations, she has been general counsel to a standard-setting group, and she has litigated the substantive and anticompetitive effects of licenses in court, in arbitration, and in administrative agencies.

Ms. Healey has also been an active speaker and author on trade secret, patent extraterritorial liability, patent damages, IP related antitrust law, arbitration and mediation. She has been fortunate enough to have been recognized by industry polls and publications for her work.

Ms. Healey graduated from the University of Texas School of Law in 1985 with honors, and Brown University in 1982. Ms. Healey served as a law clerk to the Honorable James DeAnda of the U.S. District Court for the Southern District of Texas, from 1985-1987.

Ms. Healey was one of the founders of the Houston IP Inn of Court, has been active in the State Bar of Texas intellectual property committee, the Eastern District of Texas bar association, and community projects where she lives in the Houston area. Prior to opening Fish & Richardson's Houston office, Ms. Healey was a partner in the patent litigation section of an international law firm, and previously was a partner in her own patent litigation boutique firm, as well as a national patent litigation boutique firm in Houston, Texas.

Focus Areas

Services

- IP Licensing, Transactions, and Agreements
- Litigation
- Commercial Litigation
- ITC Litigation
- Patent Litigation
- Trade Secret Litigation

Industries

- Electrical and Computer Technology
- Energy and Petrochemical
- Manufacturing
- Medical Devices
- Software
- Standard Essential Patents

Education

Certificate, Advanced Arbitration Skills, University of Houston Law Center (2016) A.A. White Dispute Resolution Center

J.D. *with honors*, University of Texas Law School (1985)

B.A., Brown University (1982)

Experience

Representative Intellectual Property Litigation

Prevailed for ION Geophysical in post-trial motions and on appeal eliminating approximately \$100 million for damages for foreign use.

Prevailed in getting litigation stayed as scheduling conference in *Chart Trading v. TradeStation Group, et al.* (E.D. Tex. 2016)

Prevailed in getting litigation stayed pending CBMs in *Trading Technologies Int'l v. TradeStation Group, et al.* (N.D. Ill. 2016)

Prevailed in litigation stay pre-answer in *Trading Technology Int't v. TradeStation Group, et al.* (S.D. Fl. 2016).

Prevailed in dismissal on appeal of multiple trade secret, patent and copyright matters arising out of third-party payor claims administration systems and software in *Nexpay v. Gilman*.

Represented Cyberonics, Inc. in licensing dispute involving medical device patents.

Represented Drilformance LLC in licensing matters.

Represented smartphone manufacturer on standard-setting issues.

Represented electronic device maker on patent pool issues.

Represented LG and Zenith in patent lawsuits on television technology in N.D. Ill., E.D. Tex., and N.D. Cal.

Represented BMC in patent lawsuit on security software.

Represented McAfee in multiple lawsuits on antivirus software.

Represented LG in ICC arbitration over patent license fees.

Represented LG Electronics in a patent lawsuit on plasma displays.

Represented Adobe in multiple patent infringement cases involving distributed computing patents.

Represented manufacturer of music players and smartphones in multiple cases on software.

Represented Samsung in multi-jurisdictional litigation involving memories, including claims for patent infringement, breach of contract, unfair competition, fraud and antitrust violations in standard-setting in the Northern District of California, the Eastern District of Virginia, Delaware Chancery Court, the FTC and the EU.

Represented Samsung in Texas State Court fraud and antitrust cases involving licensing and standard-setting for DRAMs.

Represented Samsung in multiple ICC arbitrations over smartphones.

Acted as General Counsel for the University of Texas group in establishing and managing a standard-setting group in the chemical and oil refinery construction industry.

Represented Kvaerner in an antitrust and unfair competition case over patents alleged against standards for offshore oil exploration equipment.

Represented Samsung in ITC and Federal Court litigation over patents asserted against ETSI standards for wireless communications.

Represented Samsung in licensing negotiations over CDMA and WCDMA wireless technology.

Represented Samsung in licensing involving NAND Flash Memory.

Represented Exxon-Mobil in defense of a patent lawsuit against configuration of undersea pipelines.

Represented Exxon-Mobil in licensing and trade secret disputes involving chemical catalysts.

Represented Exxon-Mobil in patent litigation over chemical filters.

Represented William Riles against Amerada Hess over patent for installation of offshore drilling platform.

Represented physician in negotiations, arbitrations, and lawsuits over medical device patents.

Represented Microsoft in multiple patent lawsuits involving Windows, Office, email. Represented Samsung in a trade secret lawsuit in trial and interlocutory appeal involving “third generation switching” telephony technology.

Represented Lexar Media in trade secret and patent lawsuits against Toshiba on NAND Flash Memory technology.

Represented Samsung in trial and appeal in a patent lawsuit on amorphous silicon decided on inequitable conduct.

Represented NetIQ in AAA arbitration over computer software patents.

Represented TitleData in copyright and trade secret licensing and regulatory matters against State of Texas.

Represented computer Associates in computer software copyright litigation.

Represented Sony Music in formulating new legal strategy for confirmation of contracts with underage performers (Destiny’s Child).

Other Representative Litigation

Represented Respondents in Texas Supreme Court on First Amendment lawsuit.

Represented lawyer on certain substantive constitutional issues as part of the defense of a multi-

count RICO indictment.

Represented Hartford Insurance Group of companies in over fifty class actions involving antitrust, consumer protection (credit scoring, claims management practices, pricing and underwriting) and state regulatory issues from 1987-2005.

Represented Westinghouse (Siemens Westinghouse) in construction and trade secret litigation.

Represented Reuters in tax litigation as well as unfair competition litigation in Texas State trial and appellate courts.

Represented Oppenheimer & Co. in numerous securities arbitrations.

Represented MALDEF and ACLU in cases involving statutes to prohibit rental of housing based on immigration status.

Represented John O'Quinn in lawsuit against State Bar of Texas.

Represented MCorp in trial against FDIC.

Represented Greyhound in trial against NLRB.

Represented Texas State Optical in securities case in trial court and interlocutory appeal against Grand Metropolitan plc and Pearl Vision.

Insights

Prior to joining Fish & Richardson, Ms. Healey has spoken, participated as a panelist, and presented papers at multiple conferences each year since 1996, including for example, participating as a panelist on standard-setting and antitrust at the ABA antitrust section's spring meeting in Washington, D.C., presenting on litigation of trade secret and patent claims at University of California-Berkeley's advanced patent law seminar in San Jose, California, on re-examination strategy in litigation at George Mason University-University of Texas's advanced patent law seminar at the USPTO, and on patent pools, standards, and unfair competition and antitrust, at the state bar of Texas seminars. She has also done private seminars on patent damages and standard-setting for international corporations.

Publications

- "Supreme Court Issues Opinion in U.S. v. Arthrex," *Fish Legal Alert* (June 22, 2021)
- "Antitrust Issues with "No-Poaching" Agreements," *Fish IP Law Essentials Blog* (October 2020)

- “California Law on Reverse Payment Settlements Goes into Effect,” *Fish Litigation Blog* (January 2020)
- “Stop Trade Secret Trolls Before They Start: A New Theory of ‘Fair and Honest’ Misappropriation of Trade Secrets,” *Fish Litigation Blog* (August 2019)
- “Patent-Specific Arbitration Law in the United States – What You Need To Know,” *Fish Litigation Blog* (October 2017)
- “Lexmark Creates Problems for Licensors and Sellers of Patented Products,” *Fish Litigation Blog* (October 2017)
- Speaker and Author, 2017 Patent Antitrust Update, State Bar of Texas Advanced Patent Law Conference (July 2017)
- “Antitrust and IP update,” State Bar of Texas, *Advanced Patent Law Seminar* (August 2013)
- “Intellectual Property in Electronics and Software: A Global Guide to Rights and Their Applications,” (2013)
- “International Global Rights in Software: A Guide to Rights and Their Applications,” (2013)
- Patent Business and Legal Strategies, *patentmath.com* (2010)
- “Q&A: Often Abandoned, Patents Should Be Viewed as Assets,” *Houston Business Journal* (August 2010)

Speaking Engagements

- “Patent Pools, Licensing and Antitrust Enforcement: Current Trends and Political Tension,” *IPWatchdog Live*, Dallas, Texas (September 14, 2021)
- “Employees, Trade Secrets, and Antitrust,” *UT Law CLE’s 34th Annual Technology Law Conference* (May 26, 2021)
- “Trade Secret Update (DTSA),” *Houston Intellectual Property Law Association (HIPLA) 2020 Annual Fall Institute on Intellectual Property Law* (October 2020)
- “Antitrust and Patents – What’s happening in the Covid-19 Crisis?” *American Bar Association – 2020 IP Fall Institute* (September 2020)
- “Solutions to Pandemic Patent License Problems: Impracticability, Frustration, Impossibility and Force Majeure for IP Lawyers,” *Fish Litigation Webinar* (June 2020)
- “2017 – 2018 Patent Law Update,” *Lavender Law IP Workshop* (August 2018)
- “Application of U.S. IP Law to Exports, Offshore, on the Outer-Continental Shelf, the High Seas and Overseas,” *2nd Energy Industry Intellectual Property Law Conference* (March 2018)
- “Negotiation Ethics for In-House Counsel,” *Fish L.E.A.D. Event* (February 2018)
- “ADR in IP,” *Houston Intellectual Property Law Association’s 33rd Annual Institute on Intellectual Property Law* (October 2017)
- “Licensing Standard Essential Patents and Protecting IP Rights,” *Strafford Webinar* (November 2017)
- “Global Patent Licensing and Enforcement, Including Patent Exhaustion and the Role of the *Impression v. Lexmark* Decision,” *Patent Law in Global Perspective Seminar* (October 2017)
- “2017 Patent Antitrust Update,” *State Bar of Texas Advanced Patent Law Conference* (July

2017)

- “Damages Update” and “Damages Roundtable,” *UT Advanced Patent Law Seminar* (November 2016)
- “Can Good Behavior Avoid Bad Consequences Under Halo,” *State Bar of Texas Advances Patent Law Seminar* (July 2016)
- “Arbitration in Technology Law,” *UT Advanced Technology Law Seminar* (May 2016)
- “Recent Developments in Technology Law,” *UT Law 28th Annual Technology Conference* (May 2015)
- “Injunctive Relief for Standard-Essential Patents,” *Fish INSIGHTS Webinar* (November 2013)
- “Injunctions in Patent Cases,” *State Bar of Texas Annual Meeting*, Dallas, TX (June 2013)
- “Antitrust Enforcement in the Licensing and Technology Arenas,” *26th Annual Technology Law Conference by the University of Texas School of Law* (May 2013)
- “Patent Value,” *Texas Intellectual Property Law Journal Symposium*, University of Texas Law School (February 2012)
- “Impact of America Invents Act on Multi-Defendant Litigation,” *Intellectual Property Owners Webinar Series* (November 2011)
- “International Patenting and Enforcement: What Your Company Should Be Doing Now!” *State Bar of Texas Intellectual Property Law Seminar* (July 2011)
- “Maximizing Patent Value – Minimizing Cost: EU & IP & U,” *University of Texas Technology Law Conference* (May 2011)
- “Industry Standards in Patent Licensing and Litigation,” *BD Academy Webinar* (April 2011)
- “Are Reasonable Royalties An Equitable Remedy?” *Texas Intellectual Property Journal 2011 Annual Symposium* (February 2011)
- “Patent Damages Panel,” *University of Texas Advanced Patent Law Seminar* (2011)
- “Patent Damages,” *University of Houston-Houston Intellectual Property Law 27th Institute on Patent Law* (2011)
- “Improving Efficiency in Patent Litigation,” *Eastern District of Texas Bench Bar Conference*, Plano, Texas (2010)
- “Patent Pools and Standard-Setting: In re Princo,” *University of Texas Advanced Patent Law Seminar* (2010)
- “Patent Pools and Standard-Setting: In re Princo,” *Houston Intellectual Property Law Association*, Austin, Texas (2010)
- “Damages and presented paper on *Lucent v Gateway*, *University of Texas Advanced Patent Law Seminar*,” Austin, Texas, (2009)
- “Panel on Eastern District Practice with Judges Ward and Clark,” *Eastern District of Texas Bench Bar Conference*, Frisco, Texas (2009)
- “Chief Judge Michel of the Federal Circuit; Initial Disclosures,” *AIPLA Spring Meeting*, San Diego, California (2009)
- “Litigation Management,” *AIPLA Winter Meeting*, Miami, Florida (2009)
- “Litigation and IP Management and Trends,” *Fish & Richardson*, Houston, Texas (2009)

- “Global Patent Litigation,” *Counsel Café*, Palo Alto, California (2008)
- “Antitrust and Patent Law Recent Developments,” *University of Texas Advanced Patent Law Seminar*, Austin, Texas (2008)

Media Mentions

- “Fish Partner’s Life as a Trans Woman to Be Featured at Vail Film Festival,” *Texas Lawyer* (September 21, 2021)
- “The fight for trans rights” *World Intellectual Property Review* (2021)
- “Biden Signals Shift Toward Tech on Standard Essential Patents” *Bloomberg Law* (July 26, 2021)
- “Protecting Your Trade Secrets in a Recession,” *Corporate Counsel* (September 2019)
- “Infringement Remedies,” *UT Advanced Patent Law Institute* (November 2017)
- “The time is now to begin adapting TTO operations under America Invents Act”, *Technology Transfer Tactics, Vol. 5, No. 10, p. 149* (October 2011)
- “The Roles of Lead and Local Counsel,” *Texas Lawyer* (October 2011)
- “Patent Math: Making Sure Your Strategies Add Up,” *China IP Magazine* (August 2011)
- “Patent Reform: Plan now or pay later — patent law changes that impact your business,” *Houston Business Journal* (August 2011)
- “Beware of ‘Guillotine Licenses’ for Patents with U.S. Companies,” *China Intellectual Property Issue 42* (March-April 2011)
- “The UK’s Fast Lane for IP Enforcement” *IP Law360* (December 2010)
- “A Broken Spoke?” *The National Law Journal* (May 2010)
- “DO the Math: Overspending + Failing to Realize Patents’ Value = YOU Losing Money,” *Corporate Counsel* (May 2010)
- “A New Checklist for Patent Damages,” *Law360* (April 2010)
- “The Texas Four Step,” Initial Disclosures in the Eastern District of Texas, *IP Litigator magazine* (September 2009)

Recognition

- Listed in *Best Lawyers in America*, for Intellectual Property Litigation, Patent Litigation, and Patent Law (2007-2022)
- Named “Lawyer of the Year” by *The Best Lawyers in America*© (2021)
- Listed in *Texas Super Lawyers* (2002-2021)
- Named “Diversity Champion,” *World Intellectual Property Review* (2021)
- Recognized in *IAM Patent 1000: The World’s Leading Patent Professionals* (2016-2021)
- Named “Lawyer of the Year” by *The Best Lawyers in America*© for Litigation – Intellectual Property (2021)

- Recognized as a *World Intellectual Property Review* Leader (2021)
- Recognized as a “Top Women in IP” by *Texas Lawyer* (2020)
- Named a *WIPR* “Influential Woman in IP” (2019)
- Rated AV Preeminent by *Martindale-Hubbell*, highest possible rating for both legal ability and ethical standards (2019)
- Recognized as a “Stand Out Lawyer” by *Acritas* (2018)
- Recognized as an “IP Star” by *Managing Intellectual Property* (2013-2020)
- Recognized as a Top Rated – AV® Preeminent™ Lawyer in Intellectual Property Law (2013)
- Listed in “The World’s Leading Patent Litigators”, since 2011 by *Intellectual Asset Management*
- Ranked for Intellectual Property by *Chambers Global* (2008-present)
- Texas Lawyer, 2002 and 2007 surveys, one of top five “Go To” Intellectual Property Lawyers in Texas (the only lawyers so ranked in both surveys)

Clerkships

U.S. District Court for the Southern District of Texas, The Honorable James DeAnda, 1985 - 1987

Memberships & Affiliations

Board of Directors, Stonewall Law Association of Greater Houston

Houston Intellectual Property Inn of Court, Founding Member and Treasurer

Chairperson, Pride and Allies Subcommittee, IPO Diversity and Inclusion Committee 2020-present

Chairperson, Women in IP Committee, State Bar of Texas Intellectual Property Section 2020-present

LGBT Bar Association, Justice Council Member 2017-present

Planning Committee and program co-chair, University of Texas Technology Law Conference (May 25, 2017)

Former Director of Eastern District of Texas Bar Association (two terms)

Chairman, Eastern District of Texas Bench Bar Meeting 2006-2008

Chairman, Antitrust Committee, State Bar of Texas Intellectual Property Section, Antitrust Committee, 2004-2005

Member, ABA, AIPLA, Federal Circuit Bar Association, HBA, HIPLA

Life Fellow, Texas Bar Foundation