

DONALD M. BOLES



Donald M. Boles
Patent Licensing - Strategic
Patent Portfolio Management

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EDUCATION

Juris Doctor, 1979 University of Dayton School of Law

BSEE, 1976 University of Dayton

BAR ADMISSIONS

Admitted to the practice of law in Pennsylvania, 1979; New York, 1985; New Jersey, 1986. Also admitted to various Federal District Courts.

PROFESSIONAL CERTIFICATIONS & AFFILIATIONS

CERTIFIED LICENSING PROFESSIONAL (CLP) by Licensing Executive Society

Registered to practice before the United States Patent and Trademark Office as a Patent Attorney, 1980.

Pennsylvania Bar Association, American Intellectual Property Association and Licensing Executive Society

PROFESSIONAL EXPERIENCE

Principal, Patent Intelligence Consulting International, LLC **2/2018- Present**

Consultant and advisor to several retained significant Asian manufacturers (including the Chinese government), domestic companies such as Rockstar Consortium (which purchased the Nortel patent portfolio for the record amount of \$4.5B) and Foxconn as well as Venture Capital firms regarding licensing surveys, licensing negotiations, portfolio management, patent sales and acquisitions, and third-party litigation matters.

President – MiiCs & Partners America, Inc.

8/2013- 2/2018

MiiCs was a business unit of Foxconn, one of the largest contract manufacturers in the world. Responsibility for technical as well as administrative staff for acquiring and monetizing patent portfolios including strategic plans, budgets, litigations and licensing negotiations as well as portfolio analysis and management of third party patent programs. Advised Foxconn business units on licensing and negotiation strategies including newly acquired Japan's Sharp Electronics.

Principal, Patent Intelligence Consulting International, LLC

7/2010- 2013

Consultant and advisor to several retained significant Asian manufacturers (including the Chinese government), domestic companies such as Rockstar Consortium (which purchased the Nortel patent portfolio for the record amount of \$4.5B) and Foxconn as well as Venture Capital firms regarding licensing surveys, licensing negotiations, portfolio management, patent sales and acquisitions, and third-party litigation matters.

Wi-Lan, Inc., Vice President, Program Development, Ottawa, Canada 6/2009- 7/2010

Responsible for growth of the company, principally through patent portfolio acquisitions and sales and coordinating the sourcing, analysis and acquisition of patent portfolios and establishing teams to successfully monetize acquired patent portfolios.

InterDigital Communications LLC, King of Prussia, PA
(Wireless Technology Developer. NASDAQ: IDCC)

3/1997-5/2009

Chief Patent Strategist (Senior Vice President)

- Vice President and Chief Patent Counsel for patent holding subsidiaries, InterDigital Technology Corporation, Tantivy Communications and IPR Licensing, Inc.
- Member, Board of Directors for InterDigital Technology Corporation, Tantivy and IPR Licensing.
- Drafted and implemented Intellectual Property Strategic Plan
- Established a department enlarging the patent portfolio from a yearly filing of six original applications per year to over 160 in 2005 and now in the top 300 companies in the world for US issued patents
- Developed company licensing strategy formulation and implementation including royalty pricing, and agreement policy and structure
- 90-100% of yearly company revenue derived from Patent Monetization
- Negotiation with multiple licensees from initial contact through license execution Extensive international experience - Asia (China, Taiwan, Korea, and Japan) and Europe (England, Germany, France, Sweden, Italy, and Finland)

- Represented company in several IPR standards setting groups including ETSI (responsible for 2G, 3G, 4G, etc. wireless standards)
- M&A activities, Strategic Planning (for the patent and licensing department and overall corporate planning)
- Litigation responsibilities for domestic and international matters
- Created companywide policy and procedures for all Intellectual Property matters including strategies for filing, prosecuting, quality review/control and maintenance/annuity payment strategies/policies
- Regularly provided advice to the Board of Directors and Executive Officers

Senior Patent Attorney, Siemens Corporation, Iselin, NJ

3/1992-3/1997

Counseled and solely responsible for advising several subsidiaries having annual sales ranging from \$20 million to \$2 billion. Representative technologies included programmable logic devices and controllers, semiconductor devices and related manufacturing activities, software, process control and automation, power control and distribution of large scale power grids down to residential components, semiconductor manufacturing, solar cells and panels, network and system communication and control.

- Responsible for M&A (including divestitures) for numerous business units
- Handled all licensing matters as well as domestic and international patent preparation and prosecution and inventor compensation plans
- Developed and implemented litigation and anti-counterfeiting programs and enforcement

Patent Attorney, IBM, Fishkill, NY

6/1990-3/1992

Responsibilities included preparation and prosecution of domestic and international patent applications, client counseling, legal opinions, licensing, portfolio review and management. Representative technologies included semiconductor design, implementation and manufacturing, computer architecture, memory devices, semiconductor test equipment and software.

Associate, Weingram & Zall, Midland Park, NJ

7/1987-6/1989

Licensing Attorney – Refac, Inc., NY, NY

9/1986-7/1987

Patent Licensing and litigation management of third party patent holders – such as Jerome Lemelson - for various technologies including cash machines.

Associate, Ostrolenk, Faber, Gerb & Soffen, New York City, NY

10/1985-9/1986

IP related litigation (in various roles from litigation support to first and second chair), preparation and prosecution of domestic and international patent applications, client counseling, legal opinions trademarks, extensive licensing of patents and trademarks. Representative technologies included fiber optics, consumer items and packaging, cardiac catheters, endoscopic devices and implantable prosthetic devices.

Senior Attorney, AMP Incorporated, Harrisburg, PA

7/1982-10/1985

Client counseling, preparation and prosecution of domestic and international patent applications and full responsibilities for several business units, the R&D center and several newly-acquired companies, M&A assistance, management of a department located in Tokyo and overall responsibility for Asia, management of department and of U.S. attorney activities as they related to the business in Asia, including anti-counterfeiting program and enforcement. Technologies included digital PBX's, network and communications systems and devices, electrical connectors and touch-type input devices.

Junior Attorney, Westinghouse Electric, Pittsburgh, PA

8/1980-7/1982

Preparation and prosecution of U.S. patent applications, drafting and negotiation of confidentiality agreements, full patent responsibility for several business units. Technologies included low, medium and high voltage power control, distribution and management, and plasma type heliarc heaters.

ADDITIONAL ACTIVITIES

Adjunct Faculty – CW Post College, Graduate Program at West Point Military Academy and the university Sparkill Campuses 1986-1994

Designated by IAM publications which is a source of worldwide news, analysis and data on the management of intellectual property as a key business asset as one of 300 of the World's Leading IP Strategists.

Specific to Licensing, SEP's and FRAND

For the last 25 years, I have been in charge of formulating and managing strategic patent portfolios containing Standard Essential Patents (SEPs) starting with InterDigital Communications Corporation as well as several subsidiaries thereof as Chief Patent Strategist, continuing on with WILAN, Inc. as Vice President of Business Development and thereafter President of MIICS, Inc. a subsidiary of Foxconn International and most recently Principal of Patent Intelligence Consulting International, LLC.

I have been in charge of and responsible for licensing SEPs including formulation of licensing programs, constructing standard terms and conditions and Fair, Reasonable and Non-Discriminatory (FRAND) rates.

In addition to numerous presentations and panel discussions I have over the course of hundreds of meetings negotiated FRAND terms in Asia, concluding in SEP licensing agreements. Frequently, these agreements provided various rate structures which included specific allowances for geographical regions, timing, and payment scheduling all in the context of FRAND.

I have been part of and attended working groups/committees that were part of standard setting organizations such as ETSI in Europe, TIA in the United States and the

TDSCDMA-Forum in China. This work involved the requirement for disclosure and licensing of Intellectual Property Rights including Declarations and the definition, logistics, policy and philosophy of FRAND obligations, including my direct involvement with the Ad Hoc Group authorized by the ETSI General Assembly to consider proposals from ETSI members to more clearly define what FRAND means, criteria to determine FRAND rates, if and when declarations should be filed and regionality. A portion of this effort was directed at forming patent pools as a way of ensuring FRAND terms and conditions.

I have also conducted in-house seminars for Chinese governmental and private entities on strategic formulation and monetization of patent portfolios including SEP's and what constitutes FRAND as well as if and when FRAND applies.

SPEAKING AND PUBLICATIONS

Participated on numerous Panels and Presented workshops and lectures to various organizations such as:

2016 – **IAM magazine** – co-author IP CLIMATE CHANGE IN ASIA

2015 – **World Intellectual Property Forum** – Bangkok Thailand, Invited Speaker – THE KEYS OF RUNNING A GLOBALLY SUCCESSFUL PATENT LICENSING PROGRAM

2014 – **Association of University Technology Managers** – Taipei, Taiwan – Invited speaker – VALUATION, INVESTMENT & FINANCE

2011 – **Chinese Ministry on Telecommunications (CATT)** - Beijing, China – Invited lecturer to senior management and staff – IPR instruction on strategic worldwide patent management of Standard Essential Patents

2008 – **Licensing Executive Society** – Orlando, Florida – Seminar presenter – GLOBAL TECHNOLOGY LICENSING

2008 – **ACI Technology Licensing Conference** – San Francisco, Calif., Invited speaker – ENFORCING THE LICENSE: MONITORING, MAINTAINING, AND TERMINATING THE LICENSE AGREEMENT POST-DEAL

2007 – **IP Global Licensing and Enforcement** – Houston, Texas, Invited speaker IP LICENSING AND ENFORCEMENT STRATEGIES IN EUROPE AND ASIA

2007 – **World Research Group** – Presenter MANAGING PATENT PORTFOLIOS FOR INTERNATIONAL LICENSING PROGRAMS

2005 – **AIPLA Spring Meeting** – Philadelphia, Pennsylvania, - Invited speaker A U.S. PERSPECTIVE AND RECOMMENDATIONS FOR UTILITY MODEL STRATEGIES

2005 – **ABA Meeting** in Toronto, Canada – Invited seminar speaker INTERNATIONAL

PATENT FILING STRATEGIES AND LICENSING

2005 – **Licensing Executive Society Annual Meeting** in Phoenix, Arizona – speaker
ENHANCING PORTFOLIO VALUE THROUGH MERGERS AND ACQUISITIONS

1994-1997 – **Lecturer – American Society of Mechanical Engineers (ASME)**

**LIST OF CASES WITH TESTIMONY AS
AN EXPERT AT TRIAL OR BY DEPOSITION**

US District Court, NY: (Refac, Inc.) Deposition on behalf of plaintiff regarding scope of patent rights.

US District Court, Illinois (Carol Touch Technology) advised and testified for defendant on scope of patent claims.

US District Court, Delaware: (2012 Nokia Corporation) advised client as to FRAND rates as applied to telecommunications patents.

International Trade Commission (ITC), Washington, DC – (Nokia Corporation) advised client as to FRAND declarations and FRAND rates.

Washington D.C. – (Confidential, a Taiwan Corporation) arbitration: advised and testified as to breadth of patent claims and their applicability to FRAND rates.

Republic of China (Taiwan) – Taiwan Patent Court: – (Quanta Corporation) advised client as to whether different rates to different licensees was considered to be satisfy FRAND obligations.

UK litigation before the High Court: (Nokia v IPC) testified as to FRAND declaration obligations.

Supreme Court of the State of New York (Access Advance v Zheijiang Dahua Technology Co. Ltd; and Dahua Technology USA, Inc , testified for Plaintiff as expert on FRAND licensing terms, conditions and requirements.