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**KOPPEL, PATRICK, HEYBL & PHILPOTT**

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EDUCATION

J.D. Seton Hall Law School, 1972

D.Sc. Chem. Engr., Newark College of Engineering, 1966

M.S. Chem. Engr., Newark College of Engineering, 1963

B.S. Chem. Engr., Lafayette College, 1962

EXPERIENCE

9/99 - Present

KOPPEL, PATRICK, HEYBL & PHILPOTT

Law firm specializing in the protection of Intellectual Property and business contracts relating to the transfer and commercialization of the Technology related thereto

11/97 - 9/99

LOEB & LOEB LLP

Law firm with broad practice area and a 20+ person Intellectual Property Department.

Handled full range of intellectual property issues; represented and advised technology based companies on a broad range of technology related legal issues including licensing and acquisition matters; led the Loeb & Loeb Chemical, Medical and Biotechnology IP practice group.

9/92 - 10/97

ARANT KLEINBERG LERNER & RAM, LLP

Law firm specializing in protection of intellectual property.

The primary emphasis of my practice is the protection and licensing of inventions in the chemical and medical arts conceived or developed by individual inventors, institutions of higher learning, and medical device manufacturers. Areas of expertise includes chemical technologies, materials, mechanical devices, combustion systems.

- (1) Handled all aspects of the protection of intellectual property with emphasis on patent and trademark applications, drafting and prosecution and the licensing of the technology;
- (2) Prepared agreements and advised on acquisitions, mergers and asset purchases;
- (3) Advised on and prepared agreements regarding assignments of intellectual property, employment relationships, confidential disclosures and distributor arrangements;
- (4) Consulted in the area of management and development of businesses and related technology with emphasis on the small to medium-size corporation, particularly in the medical device industry;
- (5) Counseled in areas of Food and Drug Regulations and the regulation and administration of medical reimbursement, particularly under Medicare; and
- (6) Knowledgeable regarding tax consequences of licensing arrangements and transfer pricing on the import/export of goods.

2/90 - 8/92

SHELDON & MAK

Law firm specializing in protection of intellectual property.

11/86-2/90

KABI PHARMACIA OPHTHALMICS, INC.

Major U.S. manufacturing division (\$100 million sales) of a \$1 billion Swedish corporation - General Counsel, Asst. Secretary, Member of Senior Management Committee.

Worked closely with headquarters staff in Sweden; conducted and directed all legal activities for the division and recommended programs and procedures to reduce legal exposure including:

- (1) Patent, trademark, copyright filings and litigation management;
- (2) Drafting and negotiation of agreements covering business relationships of the company with sales representatives, consultants, licensees, suppliers and customers;
- (3) Legal analysis of advertisements and marketing and sales programs including patent, trademark, antitrust and Medicare fraud and abuse issues;

- (4) Review of employee benefit programs and the recommendation of procedures to minimize liability resulting from personnel terminations;
- (5) With the regulatory department reviewed product complaints; assisted in establishing programs to reduce products liability;
- (6) Administered leases for eight facilities; negotiated and supervised the drafting of a lease for a new 140,000 sq. ft. facility; and handled all contracts for services related to the new facility and the termination of all old leases;
- (7) Established a high level of expertise regarding Medicare reimbursement and Medicare fraud/abuse issues; worked actively with HIMA, filed comments and proposals with the Comm. of HEW and the IG regarding the formulation and revision of Statutes and Regulations affecting the delivery of medical care; and
- (8) Highly knowledgeable in the location and licensing of technology, products and ideas for acquisition; acted in a business development role in locating new technology; participated in and conducted due diligence for acquisitions and a leveraged buyout. Also, General Counsel prior to, during and after the acquisition of Intermedics Intraocular by Pharmacia AB; acted in a business development role in locating new technology for Pharmacia Ophthalmics, Inc.

11/85-11/86

INTERMEDICS INTRAOCULAR, INC.

Major (\$30 million) manufacturer of intraocular lenses - General Counsel, Corporate Secretary, Director of Engineering, Development and Research.

- (1) Responsible for all legal activities and direction of outside counsel in rendering litigation support;
- (2) Handled protection of inventions (patent studies and application filing), trademarks, drafted contracts, evaluated products liability issues, agreements and negotiated acquisitions;
- (3) Handled internal legal activities and assisted outside counsel in preparing all legal documents for an agreement which resulted in the purchase, through a leveraged buyout of the intraocular division of the company from its parent corporation;
- (4) Handled all legal matters for the acquisition of the new company by a large Swedish pharmaceutical company;

- (5) Lectured on patent law, the reading of patents, avoidance of infringement and the use of patents as a tool in the development of new products; and
- (6) Responsible for the management of technical development programs in the research department.

1/85-10/85

STAAR SURGICAL COMPANY

Manufacturer of intraocular lenses - Vice President of Research and Development.

Responsible for all internal patent activities; worked closely with outside counsel on several key patents and patent litigations; responsible for research and development of new products; supervised engineers; developed a propriety sterile fluid delivery system which was placed in market test in less than six months from project start; personally researched, developed and brought to preclinical stages a new patentable, implantable, optical material which had significant clinical advantages over prior materials.

1974-1984

C.R. BARD, INC.

Major developer, manufacturer and marketer of medical devices (\$420 million sales in 1984).

- (1) Division Patent Counsel. Law Department responsibilities:
  - (a) Responsible for patent, trademark and copyright activities in Bard's three fastest growing divisions while supporting similar activities in the other divisions;
  - (b) Advised on FDA regulations relating to the manufacture and sale of medical devices; and
  - (c) Administered assimilation of newly acquired technologies into the corporation and the establishment of a comprehensive protective patent position.
- (2) Director of Technical Liaison - Internal consultant for technical problems throughout the corporation. Technical responsibilities:
  - (a) Designed and implemented a program for monitoring and coordinating all product research and development throughout the corporation;
  - (b) Evaluated new technologies for acquisition or development; and

- (c) Supplied technical direction and administered research and development activities through six years of significant sales growth (from \$170 million to \$420 million, over 50% of which were new products).

1973-1974

BROOKS, HAIDT & HAFFNER

New York, New York. Patent law firm. Associate.

Prepared and prosecuted, throughout the world, patent applications directed to chemical and mechanical inventions covering organic compounds, processes and equipment; prosecuted trademark and copyright applications.

1967-1973

CELANESE RESEARCH COMPANY

Corporate research center for leading manufacturer of polymers, chemicals and fibers - Senior Research Engineer.

- (1) Established basic techniques and processes for the production of graphite fibers leading to a major corporate commitment.
- (2) Conducted research in the development of membranes for dialysis, desalination and ultrafiltration and designed systems utilizing these membranes.
- (3) Principle investigator on significant classified government research contracts which resulted in major changes in U.S. defense strategy.

1965-1967

FIRST LOGISTICAL COMMAND

U.S. Army Ordnance Corps, Saigon, Vietnam.

Captain, Assistant Inspection Officer.

In 1967, was the youngest D.Sc./Ph.D. in the U.S. Army.

PROFESSIONAL AFFILIATIONS

American Chemical Society  
Licensing Executives Society  
California Invention Center -Founding Board Member  
Southern California Biomedical Council

BAR ADMISSIONS & AWARDS

New Jersey Bar  
New York Bar  
California Bar

Court of Customs and Patent Appeals  
Registered Patent Attorney  
Certified Licensing Professional

## PUBLICATIONS

Patentee on 21 U.S. Patents and numerous foreign patents.

“Patent Fraud; A New Defense?” Journal of the Patent Office Society, Vol. 54, Nos. 6, (June, 1972) pp. 363-382.

Collaborator on paper: U.S. Government Policies Relating to Technology Licensing, PLI Symposium on Current Trends in Domestic and International Licensing, 1974.

Chaired session on Noninvasive Diagnostics at Innovation, 1984. National Conference on Technology Exchange.

“Noninfringing Sales of An Infringing Medical Device - Lilly v. Medtronic,” Medical Device & Diagnostic Industry, Vol. 12, No. 9, (September, 1990), pp. 36-39.

“U.S. Patent System - Important Differences to Non-U.S., Manufacturers” - International Medical & Diagnostic Industry, Vol. 1, No. 4, (Nov-Dec. 1990), pp. 22-25, 51.

“Licensing Your Invention to a Corporation,” Speaker, Invention Convention, September 1990; September 1991; September 1992.

“Recent Changes in International Licensing,” Speaker, Orange County World Trade Center, February, 1991.

Managing Intellectual Property, Fourjays Publications, London, England, Editorial Advisory Board.

“Licensing for Entrepreneurs”, Guest Lecturer, UCLA Extension Division - April 1991; April 1992.

“Noninfringing Sales of Infringing Medical Devices - Lilly v. Medtronic”, Patent World, May 1991.

“Due Diligence Clauses - Damned If You Do, Damned If You Don’t”, AUTM Western Regional Meeting, July, 1992.

California Civil Practice, Business Litigation, Vol. 3 - Contracts, Bancroft-Whitney, 1993 (Practice Consultant)

“Factual Basis of the Agreement: Recitals, Representations, and Warranties”, Drafting Business Contracts: Principles, Techniques & Forms, Continuing Education of the Bar, 1994, Chapter 7 (“Factual Basis of the Agreement: Recitals,

Representations, and Warranties”); 1996, 1998, 2000, 2002, 2004, 2006, 2007, 2009, 2010 and 2011. Provided update revisions of Chapter 3 (Preliminary Considerations), Chapter 4 (Client Interview), Chapter 7 (“Factual Basis of the Agreement: Recitals, Representations, and Warranties”), Chapter 13 (“Rights of Nonparties; Assignment Delegation, and Third Party Beneficiaries”), Chapter 17 (“General Provisions), Chapter 18 (Execution and Signatures, Chapter 19 (“Amendment and Modifications to Executory Contracts”) and Chapter 20 (Letters of Intent)

“Legal Aspects of Technology Transfer” Technology Transfer and Commercialization, (part two of a six week seminar series), UC Berkeley Extension Division, 9/30 - 10/1, 1994.

“The Protection Process”, “Licensing vs. New Ventures”, Inventors & Entrepreneurs Workshop, Center for New Venture Alliance, California State University, Hayward, Dec. 3, 1994. Panel speaker.

“Successful Licensing - The Process of Investigation and Negotiation”, Technology Transfer: Commercialization For Economic Development, The Association of Federal Technology Transfer Executives, 2-3 March 1995, Panel speaker.

“Patent, Publish, or Perish,” Faculty Technology Transfer Conference, New Jersey Institute of Technology, February 22, 1996.

Editorial Advisor/Practice Consultant, Trade Secret Law And Practice, Continuing Education of the Bar, 1996.

“Establishing Values for New Inventions and Technologies” Licensing Executive Society National Meeting Workshop, September 30, 1996.

“Celestial Commotion,” Los Angeles Daily Journal, November 7, 1997, p.7, 11.

“What I Know Now That I Wish I Knew Then on Intellectual Property”, So. Cal. Chapter, Amer. Chem. Soc. Oct. 20, 1998.

"Protecting the Intellectual Property Rights in Software" Loyola Consumer Law Review, Loyola University Chicago, 11, 2, p. 99-114 (1999)

"Technology of Safety Devices for Firearms" Loyola Consumer Law Review, Loyola University Chicago, 12, 1, p - (March 13, 2000)



**LITIGATION**  
**EXPERT WITNESS**

**SEE v SEA-SHELL CORPORATION**

Represented Dr. See against licensee See-Shell Corporation in dispute involving non-payment of royalties and termination of license by Licensor. Provided opinion regarding interpretation of terms of License Agreement and reasonable royalty. Testified in binding arbitration.

Case result: Arbitrator adopted all of the reasoning and conclusions reached in opinion and awarded damages as recommended in the opinion.

**JILES v PSE&G CO**

Represented Jiles in action against defendant alleging that former employer stole Jiles trade secrets and obtained a patent covering his invention without naming him as an inventor, sought correction of patentee and an award of reasonable royalties. Provided opinion as to existence of trade secrets, violation of confidentiality agreement, fraud on the patent office, false designation of inventorship and damages (reasonable royalties) for said breach.

Case result: Jiles was unable to show that the listed inventors had knowledge of disclosures made by Jiles to inventor's employer. Case dismissed.

**SUNCOAST MERCHANDISE CORP v CCL PRODUCTS ENTERPRISES et al**

Represented Suncoast, alleged infringer of US Patent 6,178,085 issued to CCL, in a Declaratory Judgement action. Opined on validity and infringement; recommended non-infringing design which was adopted. (Prior design was used prior to issuance of the patent).

Case result: On May 12, 2004, the US Dist. Ct, Central Dist CA (Case No. SACV 03-991 CJC (RNBx)) granted Suncoast's Motion for Summary Judgment on all counts. Fed Cir. Reversed and remanded to lower court for reconsideration of the scope of the claim language. Still pending.

**MAGIC KITCHEN AND KITCHEN CONNECTION v THE PAMPERED CHEF AND GOOD INTERNATIONAL**

Represented plaintiff Magic Kitchen in allegations of trade dress infringement and unfair competition (California Superior Court).

Case Result:

1) Summary Judgment motion by defendant on all 7 counts denied. Court quoted liberally from expert's opinion regarding the existence of trade dress and that defendant's product is a trade dress infringement in denying summary judgment and finding that substantial factual issues exist in the case to proceed to trial.

2) Appeared as expert witness at trial against two expert witnesses presented by Defendants. Jury found my testimony to be clear, concise, easy to understand and well supported by Plaintiff's evidence. Opposing experts were found to be condescending and not believable. Judge took over the case before the jury reached a verdict. Finding for Defendant based on laches (unrelated to my testimony as expert).

### **CALIBRE INTERNATIONAL & CALYPSO v YANOVA INC.**

Represented Calibre (owner of US Patent 6,233,971) and Calypso (new Licensee) against prior licensee Yanova for infringement by Yanova for sales after termination of the agreement. Provided opinion regarding terms of License Agreement between Calibre and Yanova, whether agreement was properly terminated and reasonable royalties for continued sales of infringing products sold by Yanova after termination. Also provided opinion regarding scope of claims and whether Yanova products infringe the claims of the patent.

Case Result: Case settled –Calibre and Calypso were the prevailing parties.

### **PR-OSTEO LLC v HEALTH ASSURE INC.**

Represented PR-Osteo (Owner of two patents to a migraine treatment product) against prior licensee Health Assure for patent infringement, trademark infringement and unfair competition after termination of license for non-performance. The new Health Assure product intended to avoid the patent claims was still infringing; Heath Assure marketing continued to use data and testimonials generated for the PR Osteo product to sell the new, still infringing Health Assure product

Case Result – Case settled when Heath Assure agreed to stop selling any migraine treatment formula and withdraw from the marketplace.