



## Mindy M. Morton, Partner

Practice Areas	Appellate Law Services Intellectual Property Litigation, Intellectual Property Litigation, Corporate and Commercial Trade Secrets Privacy and Cybersecurity Software
Admissions	California New York
Address	1117 S California Ave, Suite 200 Palo Alto, CA 94304
Direct Phone	650.645.9020
Direct Fax	650.687.8320
Email	<a href="mailto:mindy.morton@procopio.com">mindy.morton@procopio.com</a>

### Professional Summary

Mindy's practice focuses on internet and intellectual property litigation. She litigates cutting-edge cases at the intersection of technology and free speech issues. She defends internet companies against defamation, copyright, trademark and related claims on First Amendment, Communications Decency Act Section 230, DMCA and US SPEECH Act grounds. She also helps clients resolve disputes involving trade secret, patent, trademark, copyright, computer fraud and complex commercial litigation.

Mindy works closely with clients to resolve disputes quickly and efficiently when litigation is not in their strategic interests. When early resolution is not possible, she is a zealous and professional advocate with jury trial experience. Mindy is admitted to practice before the United States Supreme Court, the United States Court of Appeal, Ninth and Federal Circuits, and the United States District Court, Northern, Central, Eastern and Southern Districts of California and Southern and Eastern Districts of New York.

### Representative Matters

- Lead counsel for plaintiff, a cooling design company, in trade secret and breach of contract case

involving data center cooling technology; confidential settlement before trial.

- Lead counsel for defendant, a consumer tea company, in trade secret, breach of contract and trademark case; case settled on favorable terms.
- Lead counsel for defendant, a leading online platform, in a case involving trade secret, CFAA, and ECPA claims; confidential settlement following the filing of a motion to dismiss under Section 230.
- Obtained judgment and costs defending a leading online publishing platform in a case involving Communications Decency Act, US SPEECH Act, and First Amendment issues. The case was one of the first cases involving the US SPEECH Act.
- Negotiated an early dismissal in a case involving alleged trademark infringement for third-level domain names.
- Served as first chair in a \$10M jury trial in Santa Clara County Superior Court (*DVS v. Sun, et al.*), in which she obtained a nonsuit verdict. Mindy briefed and argued the successful appeal.
- Represented a group of investors in a \$60M breach of contract case involving novel issues of Chinese and New York law, obtaining two motions to dismiss, a \$60M writ of attachment and transfer order and a contempt order.
- Successfully moved to dismiss declaratory relief complaint in case involving patent for embryo imaging.
- Represented medical device company in patent case involving first sale doctrine.
- Represented plaintiff in patent dispute involving mobile banking technology.
- Obtained a temporary restraining order, preliminary injunction, and contempt citation for violation of temporary restraining order against a former employee who started a competing company using client's technology; confidential settlement on the eve of trial.
- Represented Napster in its dispute with the recording industry.
- Defended a group of multinational companies at the district court level for patent infringement involving Intel chipsets. *Quanta v. LG Electronics*, 553 U.S. 617 (2008).

## Recognitions

- 2021 Woman Leader in the Law, *American Lawyer Magazine*
- Northern California Super Lawyer, 2015 - 2020



- 2019 Diversity Award Winner, Santa Clara County Bar Association
- 2019 Top Rated Litigator, ALM
- 2019 West Coast Top Rated Lawyers, ALM
- Outstanding Program Award Winner, American Inns of Court, 2018-2019
- AmLaw Top Rated Lawyer in Intellectual Property Law, 2018
- Fellow - American Bar Foundation
- 2016 Women of Influence Honoree - Silicon Valley Business Journal
- Martindale-Hubbell® AV Preeminent Rating

## Community

- ChIPs –Co-Chair, Next Gen Mock Pitch Committee
- The Club - Board of Directors – Former Vice President - Operations
- Santa Clara County Bar Association –2012 President
- ABA- Vice Chair of Trade Secrets Committee and Trial and Appellate Rules Committee, Intellectual Property Section
- Member of Drafting Team for the Sedona Conference Working Group 12 on Trade Secrets
- Schola Cantorum – Co-Chair of 50th Anniversary Committee, Past Chair of the Board of Directors
- UC Berkeley Class of 1994 Reunion Committee –Chair
- UC Berkeley- Women in Leadership- Co-Chair of Equity and Inclusion Committee
- SF Bay Area Intellectual Property Inn of Court-Master of the Bench and June Pupillage Group Leader
- Co-Director, Lyric Theatre Victorian Carolers

## Education

- JD, Yale Law School, 1997 (Editor – *Yale Law Journal*)
- BA, University of California, Berkeley, Highest Distinction in General Scholarship, Highest Honors in Political Science, Phi Beta Kappa, 1994



## News Coverage

- Posses, Shayna. "Emerson Can't Review Facebook Deal In Trade Secrets Row," Law 360, November 26, 2018.
- "On the Move," The Recorder, June 14, 2013

## Seminars

- Panelist. "Global Perspectives to Maintain Your Competitive Edge Through IP," ABA Intellectual Property Law Section Annual Meeting, April 14, 2021.
- Co-presenter. Webinar. "Recent Developments in Trade Secrets: What In-House Counsel Need to Know," February 18, 2021. [Recording](#) and [PowerPoint](#).
- Speaker. "RBG & me," The Club SV event, October 29, 2020.
- Moderator. "Federal Sentencing and the Presentence Investigation Report." Santa Clara County Bar Association event, September 24, 2020.
- Co-presenter. "[Part One: Navigating Anticipated CCPA Enforcement & Mitigating Litigation](#)," July 21, 2020.
- Co-presenter. "Contract Drafting Tips From the Litigator's Perspective: Avoiding Lawsuits in the Post COVID-19 World," May 27, 2020
- Co-presenter. "Trade Secrets and Cybersecurity in the COVID-19 World: Tips and Trends," May 20, 2020.
- Co-presenter. "Avoiding Litigation While Resolving Disputes: Commercial Contract Challenges During COVID-19," May 5, 2020.
- Co-presenter. "Trade Secret Tips and Trends," March 5, 2020.
- Speaker. "Tips and Trends in Trade Secrets Law: DTS Act," SCCBA Federal Courts Committee – MCLE Seminar, San Jose, June 27, 2019.
- Panelist. "Become Cyber-Trained In-House Counsel, Part Three," Procopio seminar with ACC San Diego, May 21, 2019
- Moderator. "Work Life Balance at Different Stages of Your Career," IP Counsel Café, Palo Alto, CA, May 8, 2019.

- Panelist. "Become Cyber-Trained In-House Counsel, Part Two," Procopio seminar with ACC San Diego, April 16, 2019.
- Presenter. "Defend Trade Secrets Act," Intellectual Property Owners Association, February 20, 2019.
- Mindy is a frequent speaker on electronic discovery, document management, and litigation strategy. She has authored articles on electronic discovery and document management.
- Presenter. "The Defend Trade Secrets Act," Intellectual Property Owners, Software-Related Inventions Committee, February 20, 2019.
- Co-presenter. "Exploring the Stages of a Trade Secrets Case Through Hypotheticals," Association of Corporate Counsel, September 12, 2018.
- Co-presenter. "Trade Secrets - An Emerging Force in Intellectual Property," West LegalEd Center, September 11, 2018.
- Co-presenter. "Ethical Considerations in Intellectual Property Litigation: An Interactive Dialogue and Case Study," Menlo Park, CA, May 7, 2014.

## Publications

- Co-editor (with Tyler Paetkau). "California Federal Civil Rules, Northern District of California Civil Local Rules," LexisNexis 2020 edition and update, October 2020.
- Co-author. "[Avoiding Litigation While Resolving Disputes: Commercial Contract Challenges During COVID-19](#)," April 27, 2020.
- Co-author. "[Cybersecurity, Sports Betting, Hemp, and Child Welfare: 2020 Indian Law Updates](#)," January 6, 2020.
- Author. "[The Rise of Criminal Enforcement for Trade Secret Theft](#)," *Law360*, September 6, 2019.
- Author. "[Why Companies Should Care About Increasing Criminal Enforcement of Trade Secret Theft](#)," September 4, 2019.
- Co-author. "[Practical Issues of the Defend Trade Secrets Act: Lessons from Waymo v. Uber and Impact of the DTSA on Corporate Practice](#)," *Intellectual Property Law and Policy Journal* (Hokkaido University School of Law), April 2019. *(Article in Japanese)*
- "[5 Steps to Keeping Your Trade Secrets Secret](#)." February 7, 2018.



- "Technology-Assisted Review: an Effective Way to Tackle the Mountains of Electronic Data," *ABTL Report*, April 2015.
- Co-author. "Technology-Assisted Review: The Judicial Pioneers," *The Sedona Conference Journal*® Volume 15, December 2014.
- Co-author. "Dealing With IP Theft By Employees," *The Recorder*, September 12, 2012.
- "Don't Let Confidential Information Walk Out the Door," *The Bottom Line*, Vol. 30, No. 5.
- "Drafting and Challenging Section 2019.210 Statements in Trade Secret Litigation," *Northern California Association of Business Trial Lawyers Report*, Vol. 15, No. 2.
- Contributing author. "Copyright, Trademark and Trade Dress Litigation Model Jury Instructions," *ABA Section of Litigation*.