

JACK C. GOLDSTEIN
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Law Office of Jack C. Goldstein – Houston, Texas **1999–**

Arbitrator, mediator, special master, or testifying expert in intellectual property law (“IPL”) matters. Listed on Federal Arbitration, Inc.’s (“FedArb’s”) list of “qualified Patent Arbitrators and Mediators.”

The Whitaker Corporation – Wilmington, Delaware **1998-99**

Vice President and later President of this \$370 million IP holding company and its two subsidiaries. An accompanying sheet describes Whitaker, its parent (AMP Incorporated, which was acquired by Tyco International Ltd. on April 2, 1999), and Whitaker's two subsidiaries.

South Texas College of Law – Houston, Texas **1974-84**

Adjunct Professor of Law, teaching patent and copyright law in different semesters and years.

Arnold, White & Durkee – Houston, Texas **1969-97**

Associate, then a shareholder, during this firm's growth from 12 Houston attorneys to the nation's second largest IPL boutique with more than 150 attorneys in six offices nationwide. (After a February 2000, the merged firm – eventually named Howrey LLP – dissolved on March 15, 2011.)

U.S. Court of Customs and Patent Appeals – Washington, D.C. **1968-69**

The first Law Clerk and Technical Advisor to Judge Phillip B. Baldwin. (In October 1982, this court and the appellate division of the U.S. Court of Claims merged into the U.S. Court of Appeals for the Federal Circuit with, *inter alia*, exclusive nationwide *appellate* jurisdiction over federal patent cases.)

Office of Naval Research Patent Branch – Washington, D.C. **1967-68**

Patent Advisor, later a Patent Agent, at the U.S. Naval Ordnance Laboratory in White Oak, Maryland.

Patent Office (now, the United States Patent and Trademark Office) – Washington, D.C. **1964-67**

Patent Examiner in Group 430 and, upon the Patent Office's reorganization, in Art Unit 285.

EDUCATION

Certificate in Advanced Arbitration Skills, University of Houston Law Center, 2015

J.D. with Honors, The George Washington University Law School, 1968
Law Review; Order of the Coif (National Legal Honorary Fraternity)

B.S. in Mechanical Engineering, Purdue University, 1964
Pi Tau Sigma (National Mechanical Engineering Honorary Fraternity)

BAR ADMISSIONS

State Bar of Texas
United States Patent and Trademark Office

SELECTED PROFESSIONAL ORGANIZATIONS AND SOME POSITIONS THEREIN

American Bar Association House of Delegates (IPL Section Delegate, 1999-2015)
American Bar Association Section of Intellectual Property Law (Chair, 1992-93)
American Bar Association Section of Dispute Resolution (Advisory Comm. Liaison to Council, 2017-18)
American Bar Foundation (Life Fellow)
American Intellectual Property Law Association (President, 1988-89; Life Member)
American Intellectual Property Law Foundation (Life Fellow)
Association Internationale pour la Protection de la Propriété Industrielle (Treasurer General, 2000-01)
AIPPI United States (President, 2001-04)
Association of Former CCPA Law Clerks and Technical Advisors (President, 1979-80)
Copyright Society of the U.S.A. (Board of Trustees, 1979-82)
Federal Circuit Bar Association (President, 1987-88)
Foundation for a Creative America (Board of Directors, 1989-94)
George Washington Law Alumni Association (Board of Directors, 1980-84, 1993-2004)
The George Washington University Law School (Intellectual Property Advisory Board, 2000-08)
Houston Bar Foundation (Life Fellow)
Houston Intellectual Property Law Association (President, 1979-80)
The Intellectual Property Law Strategist (Board of Editors, 1994-97)
Intellectual Property Owners Association (Board of Directors, 1998-2000)
Library of Congress (Copyright Advisory Committee, 1981-82)
Patent, Trademark and Copyright Journal (Advisory Board, 1978-2003)
State Bar of Texas Intellectual Property Law Section (Chair, 1988-89)
Texas Bar Foundation (Life Fellow)
United States Court of Appeals for the Federal Circuit (Advisory Committee, 1984-92)
University of Houston Law Center (Intellectual Property Advisory Board, 1991-97)

SELECTED HONORS AND AWARDS

One of only Five Top Texas IPL Firms, *Super Lawyers Business Edition* (2011)
The Best Lawyers in America (1991-98, 2005-)
Texas Super Lawyers (2003-)
Guide to the World's Leading Trademark Law Practitioners (2000)
One of the Best Lawyers in Houston, *Inside Houston* (1998)
Guide to the World's Leading Patent Law Experts (1997)
Jacob Burns Award, The George Washington University Law School (1996)
One of the 100 Most Influential Lawyers in America, *The National Law Journal* (1994)
Chair's Award, State Bar of Texas Intellectual Property Law Section (1992)
President's Award, Houston Intellectual Property Law Association (1988)
Gerald Rose Memorial Award, The John Marshall Law School (1986)
Alumni Service Award, The George Washington University Law School (1985)
Journal Finalist Award, Texas Bar Foundation (1981)
Superior Performance Award, U.S. Patent Office (1967)

The Whitaker Corporation
(Circa January 1, 1998, through April 30, 1999)

Located in Wilmington, Delaware, **The Whitaker Corporation** was a wholly owned subsidiary of **AMP Incorporated**, a Pennsylvania corporation having its headquarters in Harrisburg, Pennsylvania. AMP was the world leader in electrical, electronic, fiber-optic, and wireless interconnection devices and systems – with 1998 sales of approximately \$5.5 billion. Incorporated in 1941, AMP was publicly held from 1956 until it was acquired by Tyco International Ltd. on April 2, 1999.

Whitaker was a Delaware corporation formed to hold and safeguard the intellectual property ("IP") developed by AMP or acquired by AMP from others. Whitaker owned the legal rights in all inventions, trademarks, works of authorship, and trade secrets or confidential information which AMP created or acquired. Through in-house and outside attorneys and agents, Whitaker filed and prosecuted applications for patents, trademark registrations, and a few copyright registrations. Whitaker had a wholly owned Delaware subsidiary, **AMP International Enterprises Limited** with offices in Switzerland and Japan, which assisted with respect to the patent applications filed in Europe and Asia, respectively.

Whitaker was among the 25 United States corporations that received the most United States patents in 1997 and in 1998. In 1998 Whitaker owned – on a worldwide basis – approximately 8,500 patents, 6,000 patent applications, 1,500 trademark registrations, and 400 applications for trademark registrations.

Whitaker enforced its IP rights by notifying and, if necessary, suing infringers or misappropriators of its IP. For IP lawsuits filed by Whitaker (with AMP as a co-plaintiff) against others or filed by others against AMP, Whitaker selected, employed, and supervised outside trial counsel. In 1998 Whitaker negotiated settlements in five IP litigations and managed fourteen other IP court cases and contested patent office proceedings around the world.

Whitaker licensed its IP to AMP and handled the legal work regarding IP licenses taken by AMP from others. Historically, AMP and Whitaker did not, as a general rule, grant patent licenses to entities that were not affiliated with AMP – unless required to do so pursuant to an industry standard. That changed in 1996 when Whitaker formed a second wholly owned Delaware subsidiary, **AMP Technologies, Inc.**, not only to develop an active licensing program for granting licenses under selected patents to third parties but also to negotiate and prepare those licenses for execution by Whitaker. Whitaker's patent license revenues were over \$370 million in 1998, and Whitaker was structured and operated so that neither it nor AMP had any Delaware or Pennsylvania *state* income tax liability on the lion's share of Whitaker's substantial net income. (That had *no* effect on AMP's *federal* income tax liability.)

In essence, Whitaker not only managed its IP but also provided to AMP what were formerly its in-house IP legal services, including risk assessments (sometime called "product clearances") and counseling. When AMP had its own in-house IP law department, AMP's Chief IP Counsel reported directly to the Chairman of AMP's board of directors. In 1992 the personnel from AMP's IP law department moved from Harrisburg to Wilmington and became employed by Whitaker; and AMP's former Chief IP Counsel became Whitaker's President and reported to the Chairman of Whitaker's board of directors (who also was the Chairman of AMP's board of directors). In August of 1998, AMP's Chief Financial Officer was elected to replace AMP's Chairman as the Chairman of Whitaker's board.

In 1998, Whitaker and its subsidiaries had 58 employees, including 26 attorneys and patent engineers. The 43 *U.S.* employees, including 17 attorneys, worked in Whitaker's Wilmington office. After Tyco acquired AMP, Whitaker and its subsidiaries were promptly "restructured" to 17 employees, including 8 attorneys and patent engineers. The 10 *U.S.* employees, including 5 attorneys, remained in Wilmington.