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Nolan M. Goldberg is a partner in the Litigation Department, co-head of the Data Privacy and Cybersecurity Litigation Group, and a member of the Patent Law Group. His practice focuses on technology-centric litigation, arbitration (including international arbitrations), regulatory investigations (including federal and state regulators), privileged investigations and counseling, covering a range of types of disputes, including cybersecurity, intellectual property (including patent), and commercial. Nolan's understanding of technology allows him to develop defenses and strategies that might otherwise be overlooked or less effective and enhances the "story telling" that is critical to bringing a dispute to a successful conclusion.

Nolan is a registered patent attorney before the U.S. Patent & Trademark Office; and an International Association of Privacy Professionals (IAPP) Certified Information Privacy Professional, United States (US CIPP) and Certified Information Privacy Technologist (US CIPT).

Cybersecurity

Nolan's electrical engineering background, coupled with a litigation and risk management-centric focus, allows him to assist companies in all phases of incident response. Nolan often acts as a bridge between the technical and legal response teams (both inside and outside forensic consultants). Nolan uses this deep familiarity

with the company and its systems to defend the company in litigations, arbitrations and regulatory investigations, including before the Federal Communications Commission (FCC); Federal Trade Commission (FTC); the Securities Exchange Commission (SEC); New York State Department of Financial Service (NYS DFS) and before various State's Attorneys General, including Multi-State investigations.

Nolan has worked on incidents that range from simple phishing attacks on e-mail accounts by cyber-criminals to intrusions by (formerly) trusted inside employees to complex technical breaches of hosted systems by state-sponsored advanced persistent threats (APTs). These incidents have involved various compromised systems, including, but not limited to internal both client systems, and systems of a vendor of a client that hosted its data.

It is often the case (both in response to an incident and for other reasons) that a company will want to undertake an assessment of its security posture, but has concerns about the discoverability of any such analysis. Accordingly, Nolan also frequently assists companies' scope and conduct privileged security assessments, including "dual purpose" assessments where privileged analysis are also used for ordinary-course purposes.

Commercial Disputes

Nolan also assists companies with commercial disputes, particularly in cases where there is a technology component, including disputes arising from hosted software agreements; outsourcing and managed services agreements; software and technology development agreements and the dissolution of joint ventures. When these disputes cannot be amicably resolved, Nolan has litigated them in State and Federal Court and in arbitrations, including international arbitrations.

Intellectual Property

Nolan's work has included numerous patent and trade secret litigations and negotiations, primarily in cases involving computer and network-related technologies. In particular, the litigations have involved at least the following technologies: cybersecurity; hosted software; telecommunications, computer networking; network and computer-related security hardware and software; microprocessors, voice-over Internet protocol ("VoIP"); bar code scanners financial business methods and

software, including securities settlement, fail management and trade execution and reporting software; data compression; handheld computers; pharmaceuticals; cardiac electro-stimulatory devices and prosthetics.

Nolan also has experience prosecuting patent applications before the U.S. Patent and Trademark Office in encryption, CMOS, HDTV, virtual private networks ("VPN"), e-commerce, XML/XSL, financial instruments, semiconductor electronics, medical device technology, inventory control and analysis, cellular communications, Check 21 and business methods. Nolan also has conducted numerous freedom-to-operate searches, written opinions, and counseled clients in the areas of bar code scanners, imaging, book publishing, computer networking, business methods, Power Over Ethernet ("PoE"), and digital content distribution.

He has assisted in evaluating patents for inclusion in patent pools involving large consumer electronics and entertainment companies concerning CD and DVD technology.

Computer Forensics and Electronic Discovery

Nolan is often called upon to develop e-discovery strategies to be used in all types of litigations, with a particular focus on selecting appropriate tools, developing proportionate discovery plans, cross border electronic discovery, managing the overall burden and cost of the electronic discovery process, and obtaining often overlooked electronic evidence, including computer forensics. He also assists clients to develop and implement information management programs to reduce expense and risk, meet compliance obligations, and tame e-discovery burdens.

Thought Leadership

Nolan has authored numerous articles and given numerous presentations on emerging issues and trends in both technology and law, and has often been called upon to comment on various media outlets including Business Week, IPLaw360, IT Business Edge, CIO.com, Forbes, and The National Law Journal.

Prior to practicing law, Nolan was a computer specialist at Underwriters Laboratories (UL).

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Nolan's representative litigation matters include:

- *Definitive Holdings, LLC v. Powerteq LLC*. Representing Powerteq in a patent infringement action filed against it relating to engine tuning technologies.
- *British Telecommunications PLC v. Fortinet Inc.* Representing British Telecommunications (BT) in a patent infringement action filed against Fortinet involving multiple cyber-security related-patents.
- Represents T-Mobile in a series of investigations relating to location information.
- Represents Tech Mahindra in an international arbitration concerning unpaid invoices for outsourcing services, theft of trade secrets, and poaching, amongst other issues.
- Represented SilkRoad Technology in connection with a series of cyber-attacks and defended Silkroad in a lawsuit brought by a suspect in the incidents. The case was successfully settled after the Court agreed that the plaintiff, the suspected hacker, had intentionally spoliated evidence prior to bringing suit. *Postle v. Silkroad Tech., Inc.*, 2019 WL 692944, at **1, 7 (D.N.H. Feb. 19, 2019)
- Represented Silkroad Technology in terminating and unwinding a software development agreement.
- Represented T-Mobile in connection with the data breach experienced by its vendor, including responding to regulatory inquiries, class action lawsuits and overall management of the breach response as well as litigating a contract disputes with its vendor regarding contractual obligations and indemnification
- Represented T-Mobile in connection with the dissolution of a reseller agreement and related commercial relationships.
- *British Telecommunications PLC v. Valve Corp.* (D. Del.) Representing British Telecommunications (BT) in a patent infringement action filed against Valve, an American video game developer and digital distribution company, for

infringement of four U.S. patents owned by BT.

- *British Telecommunications PLC v. Google, Inc., C.A.* (D. Del.) Represented British Telecommunications in a patent infringement action directed against Google's pervasive infringement of British Telecommunications patents relating to navigation (Google Maps), location-based services, bandwidth management, and access to personalized services and content.
- *Papyrus Technology Corporation v. New York Stock Exchange LLC* (S.D.N.Y.) Co-defended the New York Stock Exchange in a patent infringement action asserted by Papyrus Technology Corporation. A *Markman* hearing was conducted in December of 2007, which resulted in a favorable *Markman* ruling in September of 2008. Subsequently obtained summary judgment of invalidity of the last two patents remaining before the district court in the aftermath of the *Markman* ruling, which was affirmed by the Federal Circuit.
- *Realtime Data LLC D/B/A/ IXO v. CME Group et al.* (S.D. N.Y.) Representing NYSE Euronext, NYSE Arca, Inc., NYSE Amex, LLC, Securities Industry Automation Corporation, and the Options Price Reporting Authority in three related patent infringement suits which are directed to data compression. The court granted summary judgment in our clients' favor in September 2012, finding non-infringement of our clients' products on every claim.
- *Vraston v. Depositary Trust & Clearing Corporation* (S.D.N.Y.) Represented Depositary Trust & Clearing Corp. in a patent infringement lawsuit related to Exchange Traded Funds. The matter was dismissed for failure to state a claim following the Supreme Court's affirmance of the *Bilski* decision.
- *BIAX Corp. v. Analog Devices, Inc.* (E.D. Tex.) Represented Analog Devices, a world leader in high-performance signal processing solutions, in the defense of a five-patent litigation relating to parallel processing in computers. After jury selection, the plaintiff dropped its demand and agreed to settle the case for a token payment and to arbitrate one of the patents if it survived reexamination. Following arbitration of the remaining patent, the arbitrator ruled in our client's favor, finding no infringement and awarded attorneys' fees to our client.
- *Abbott Laboratories v. ImClone Systems, Inc.* (D. MA) Represented ImClone in a patent infringement action directed to technology allegedly used to produce Erbitux®. The asserted patent was directed to the insertion of a

vector into a cell to enhance production of an antibody of interest. The case was settled successfully shortly before hearings on motions for summary judgment.

- *Ossur North America, et al. v. Freedom Innovations, et al.* (C.D. Cal.) Obtained a favorable settlement in representing Ossur North America, et al., a leading manufacturer of prosthetic devices, in separately filed patent infringement and unfair competition actions respecting prosthetic feet
- *Datalogic Scanning, Inc. v. Metrologic Instruments, Inc.* (D. Ore.) Representing Datalogic Scanning, Inc., one of two leading manufacturers of bar code scanners of the type commonly seen at checkouts, in a patent infringement action and a trade secret action, each filed against Metrologic, Inc. in Eugene, Oregon
- *Rates Technology Inc. et al. v. Mitel Networks* (E.D.N.Y.) Successfully represented Mitel Networks, a provider of Internet Protocol telecommunications systems, in this patent infringement action - the case was settled
- *Rates Technology, Inc. v. Shoretel, Inc.* (N.D. Cal.) Successfully represented Shoretel, Inc., a provider of Internet Protocol telecommunications systems, in this patent infringement case, which was settled

Practices

Intellectual Property, Litigation, Patent Law, Privacy & Cybersecurity

Market Solutions

Regulatory & Compliance, Proskauer+Tech

Education

Hofstra University School of Law, J.D.

With Distinction

Intellectual Property Honors Award

Associate Editor, *The Hofstra Law Review*

Polytechnic Institute of New York, B.S.

(Electrical Engineering)

Admissions & Qualifications

U.S. Patent and Trademark Office
New York

Court Admissions

U.S. District Court, New York, Eastern District
U.S. District Court, New York, Southern District

Awards & Recognition

New York Super Lawyers "Rising Stars," 2013-2015
The Legal 500 United States: Cyber Law (Incl. Data Protection & Privacy) 2023