

Rising Star: Morgan Lewis' Julie S. Goldemberg

By Dani Kass

Law360 (June 7, 2021, 2:18 PM EDT) -- Morgan Lewis & Bockius LLP partner Julie S. Goldemberg has been involved in high-profile patent eligibility cases and defended TCL Communications in its patent disputes with Ericsson, earning the patent litigator a spot among intellectual property attorneys under age 40 honored by Law360 as Rising Stars.

WHY SHE'S AN IP ATTORNEY:

Goldemberg earned her undergraduate degree in electrical engineering and said she didn't want to let that go to waste even if she knew she wanted to pursue law school. She said patent law was the best way to combine those interests.

"I found it to be incredibly interesting and challenging," she said. "You get to learn all sorts of new technologies, many of which only tangentially relate to what I learned in college. When you learn it, you really get to drill down. You get to talk to an expert or two in the field and work with them, and learn all the new stuff regarding how products work or what a patent discloses. You also get to do all the lawyer stuff, like writing motions and being an advocate. I love the mix of advocacy and science."

THE BIGGEST CASES OF HER CAREER:

The former clerk for Federal Circuit Chief Judge Sharon Prost said her biggest opportunity was the first time she got to argue before that court. She was defending TCL Communications' Patent Trial and Appeal Board win, where it had gotten a patent owned by Ericsson invalidated.

The court returned a precedential decision in her favor, allowing an old article in a German journal to be used as prior art.

"Being able to argue that and talk to the Federal Circuit and defend the board was a very exciting moment," she said. "The judges certainly knew me, so it was just very exciting to be up there in



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 2021

Julie S. Goldemberg
 Morgan Lewis

Age: 35
 Home base: Philadelphia
 Position: Partner
 Law school: University of Pennsylvania Carey Law School
 First job after law school: Akin Gump associate

front of them, arguing."

Additionally, Goldemberg said she took a lot of pride in litigation they won for Praxair Inc., where the company got five patents covering Mallinckrodt's respiratory drug Inomax invalidated in 2019 under Section 101 of the Patent Act, in addition to winning appeals in related inter partes reviews.

OTHER NOTABLE CASES:

Goldemberg was part of the team representing HP Inc. against Berkheimer, in a 2018 case where the Federal Circuit issued a precedential ruling making it harder to invalidate patents under Section 101 at the summary judgment stage.

"The Berkheimer case was one of the hottest cases in IP for a couple of years," she said. "It's cool that it had an important impact on Section 101 law. Between that and Praxair, and the Chamberlain case, it's been really exciting to be on the forefront of the Section 101 debate."

In Chamberlain, she represented Techtronic Industries Co. Ltd., which got a garage door opener patent invalidated at the Federal Circuit.

HER MOST INTERESTING RECENT CASE:

Goldemberg said she's been working on an arbitration for the first time, as part of a trade secrets case.

"It's been very interesting to get used to the wild west that is arbitration," she said. "The arbitrator sometimes orders a brief by the end of the week, and you just do it."

"[Trade secrets] are becoming a growing part of my practice," she continued. "Before it was almost all patent litigation. It's very much the same concepts, you're still working with experts, you're still learning about what's in the technology, but you don't have a patent as the rules of the game. The trade secret sometimes is a moving target in progress as the litigation goes on, making it a moving target."

HER PROUDEST MOMENT:

While Goldemberg regularly handles high-profile patent litigation, she said her proudest moments have been in unrelated pro bono cases: one where she was able to help reunite a separated family at the U.S.-Mexico border, and one where she was able to bring a police brutality claim for a client who was improperly tased.

"After the trial, the client's mother, who had sat through the whole thing, called me up and left me this wonderful voicemail thanking me for giving her son a chance to tell his story," she said. "That was a very heartwarming moment."

— *As told to Dani Kass*

Law360's Rising Stars are attorneys under 40 whose legal accomplishments belie their age. A team of Law360 editors selected the 2021 Rising Stars winners after reviewing more than 1,400 submissions. Attorneys had to be under 40 as of April 30, 2021, to be eligible for this year's award. This interview has been edited and condensed.