

Haynes Boone Team Secures Appellate Victory in Federal Circuit

January 13, 2022 Stephanie Sivinski, Russ Emerson, Debbie McComas, Angela Oliver

PRACTICES Litigation, Intellectual Property Litigation

A Haynes Boone team led by Partner [Stephanie Sivinski](#) persuaded the Federal Circuit Court of Appeals to uphold a rare defense judgment the firm won in an IP jury trial in the Eastern District of Texas. The Federal Circuit also reversed a smaller breach-of-contract judgment against our client, resulting in a complete defense victory in this bet-the-company case.

After a weeklong trial before Chief Judge Rodney Gilstrap, a Marshall jury in 2019 returned a verdict in favor of Haynes Boone client Dong Weon Hwang, a Korean engineer and inventor sued by Dallas-based Plastronics Socket Partners, Ltd.

Plastronics and Mr. Hwang's company, HiCon Co., Ltd., both provide burn-in and test sockets and related components for the semiconductor industry. In 2018, Plastronics sued HiCon and Mr. Hwang, alleging patent infringement, breach of contract, tortious interference, and conspiracy, among other claims.

Mr. Hwang invented the patented product while in Korea before joining Plastronics as its CTO. Later, Mr. Hwang agreed to share his worldwide patent rights — excluding Korea — with Plastronics in exchange for patent-prosecution fees and a royalty on Plastronics' sales of the patented product. Plastronics claimed it spent millions commercializing the invention before Mr. Hwang resigned, returned to Korea, and began competing with Plastronics.

Plastronics asked the jury for about \$26 million in actual damages, and three times that number in punitive damages, for a total of about \$104 million in damages.

After deliberating less than two hours, the jury returned a verdict finding that HiCon and Mr. Hwang did not infringe the patent-in-suit, did not tortiously interfere with Plastronics' business, and did not conspire to harm Plastronics. The jury also found that Plastronics failed to pay Mr. Hwang royalties and awarded him \$1.36 million in damages — the full amount requested.

Plastronics recovered only \$622,000 — on a single claim, for alleged breach of a royalty agreement.

On appeal, the Federal Circuit issued an opinion January 12, 2022, that *affirmed* the judgment in favor of HiCon and Mr. Hwang and *reversed* the judgment in favor of Plastronics.

The ruling can be viewed [here](#).

Sivinski was assisted by Partners [Russ Emerson](#) and [Debbie McComas](#) and Associate [Angela Oliver](#).

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