MASLONLLP



TERRANCE C. NEWBY

Partner
Co-Chair of Business Litigation Group
Chair of Maslon Diversity, Equity, and Inclusion Committee

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OVERVIEW

Terry Newby has extensive experience assisting clients with their intellectual property, e-commerce, and complex commercial litigation needs. He has successfully represented clients in state and federal courts throughout the country in a broad range of infringement matters involving patent, trademark, copyright, and trade dress as well as licensing disputes. In addition, Terry has taken intellectual property matters to trial, including federal jury trials in patent infringement, trademark infringement, and false advertising cases under the Lanham Act. His clients include software companies, consumer products companies, e-commerce and emerging technology companies, and medical device companies.

With a relentless focus on practical solutions to difficult problems, Terry regularly helps his clients navigate complex intellectual property matters. He devotes a large part of his practice to proactively drafting IP licenses, including confidentiality and non-disclosure agreements and software license agreements, so his clients can avoid litigation. When litigation is the only remaining option, Terry has the litigation and trial experience necessary to protect his client's intellectual property. Counseling clients and providing practical, commonsense solutions are the core of Terry's practice.

Terry has significant appellate experience and has briefed and argued appeals involving complex commercial disputes, patents, and trademarks in various jurisdictions, including the Federal Circuit Court of Appeals and appellate courts in Minnesota, Iowa, and Illinois. He is also licensed to appear before the United States Supreme Court.

When not practicing law, Terry writes fiction, including novels and plays. His first play, "The Cage," was professionally staged in St. Paul in 2016; his next, "The Body Politic," was staged in June 2018; and his latest, "Little Rock, 1942," ran in St. Paul in 2024 and 2025. His most recent novel is *Dangerfield's Promise*, which explores what freedom means to two Black men living in different centuries.

AREAS OF PRACTICE

Litigation
- Appeals
- Business Litigation

BAR ADMISSIONS

Minnesota

U.S. District Court
- Minnesota
- Michigan, E.D.
- Wisconsin, E.D.

U.S. Court of Appeals
- Eighth Circuit
- Ninth Circuit
- Federal Circuit

U.S. Supreme Court

LANGUAGES

- French

EDUCATION

William Mitchell College of Law
J.D., 1995

University of Wisconsin-Madison
B.A., 1989

SELECTED EXPERIENCE

Representative Jury Trial Cases

- *Exhibit Development Group (EDG), LLC, v. City of Rochester*, Second Judicial District. Trial counsel for plaintiff, the former owner of the Chateau Theatre, in successful breach of contract case in which the jury awarded EDG $335,000 in damages.
- *GTT v. Emtrac, et. al*, U.S. District Court, District of Minnesota. Trial counsel for defendants in a patent infringement case. Case was tried before a jury in 2013.
- *National Products, Inc. v. Gamber Johnson*, U.S. District Court, Western District of Washington. Trial counsel for defendants in a false advertising case under the Lanham Act. Case was tried before a jury in 2010.
- *Carpad, Inc. v. Brookstone, Inc.*, U.S. District Court, District of Nevada. Trial counsel for defendants in a trademark infringement case under the Lanham Act. Case was tried before a jury in 2003.

Other Notable Intellectual Property Cases

- *Seshadri Raju, M.D., P.A. v. Medtronic, Inc*., Case No. 3:17-cv-357, 2021 WL 1232102 (S.D. Miss. March 31, 2021). Successfully obtained summary judgment dismissing plaintiff's trade secrets misappropriation claims and preventing plaintiff from seeking statutory damages or attorney's fees on copyright infringement claims. Also obtained a ruling striking plaintiff's expert witness reports, while denying plaintiff's request to strike defendant's expert report.
- *B-50 v. InfoSync*, U.S. District Court, Northern District of Texas. Lead trial counsel for plaintiff in a patent infringement case venued in Texas federal court. Case settled in 2015 on terms favorable to client.
- *Ian LeBauer v. Bracketron, Inc.*, private arbitration matter. Lead trial counsel for defendant in a lawsuit involving eight separate intellectual property licenses. Case was tried to an arbitrator in Minnesota in 2012, resulting in a favorable arbitration ruling in favor of the client. The arbitration award was upheld on appeal.
- *Piao Shang, Ltd. v. Bracketron, Inc.*, U.S. District Court, Central District of California. Lead trial counsel for defendant in a patent infringement case. Client was sued in California federal district court in 2011. Case was litigated for over a year in the Central District of California, with numerous. fact and expert depositions and discovery. Negotiated a favorable settlement on behalf of client two days before the scheduled start of trial.
- *B-50 v. Monolith, LLC*, U.S. District Court, District of South Carolina. Lead trial counsel for plaintiff in a patent infringement case venued in South Carolina federal district court. Case was litigated for almost three years before the parties settled in 2007 on terms favorable to the client.
- *B-50 v. XFormity, LLC*, U.S. District Court, Northern District of Texas. Lead trial counsel for plaintiff in a patent infringement case venued in Texas federal court. Case was litigated for two years, with significant fact and expert discovery, numerous depositions, and extensive *Markman* briefing. *Markman* briefing led to a favorable summary judgment ruling, which led to a favorable settlement in 2007.

Representative Published Decisions

- *Tamarack Village Shopping Center v. Galyan's Trading Co.*, Inc., 2006 WL 224180 (Minn. Ct. App. 2006) (commercial lease dispute)
- *Barkema v. Williams Pipeline Co.*, 666 N.W.2d 612 (Iowa 2003) (class action)
- *Mars, Inc. v. Heritage Builders of Effingham, Inc.*, 763 N.E.2d 428 (Ill. App. Ct. 2002) (case of first impression regarding the economic loss doctrine)
- *Gordon v. Microsoft Corp.*, 645 N.W.2d 393 (Minn. 2002) (class action)

LEADERSHIP & COMMUNITY

- Southern Minnesota Regional Legal Services: Board Member 2005-present, Vice President 2015-Present
- Maslon UPLIFT: Legal Institute for Teens: Volunteer Coach
- Roseville Multicultural Advisory Committee: Member 2020-Present

- Minnesota State Bar Association: Legal Services Advisory Committee 2001-2004
- Hennepin County Bar Association
- Ramsey County Bar Association
- Volunteer Lawyers Network: Pro Bono Attorney Volunteer
- Southern Minnesota Regional Legal Services: Pro Bono Attorney Volunteer
- William Mitchell College of Law: Adjunct Professor, Legal Writing and Advocacy 2009-2010

SELECTED HONORS

- **Recognized as a Top Lawyer**, *Minnesota Monthly*, 2026 (The research for the Top Lawyers list, created by Professional Research Services, is based on an online peer-review survey sent to all attorneys in Minnesota.)
- **Recognized on Minnesota Super Lawyers® list**, 2024-2025 (*Minnesota Super Lawyers® is a designation given to only 5% of Minnesota attorneys each year, based on a selection process that includes the recommendation of peers in the legal profession.*)
- **Notable Diverse Leaders in Law,** *Twin Cities Business*, 2024
- **Selected for inclusion in *The Best Lawyers in America*®**, 2021-2027
- **Professor of the Year Award**, William Mitchell College of Law, 2009-2010
- **Pro Bono Attorney of the Year**, Minnesota Legal Services Coalition, 1999 *(Award for "extraordinary service" in providing fair access to justice.)*
- **Adult Achiever Recognition**, YMCA of St. Paul Black Achievers Program *(Responsible for preparation of materials and coordinating annual Mock Trial program for inner city youth of St. Paul from 1997-2000.)*
- **North Star Lawyer**, Minnesota State Bar Association, 2022 (*North Star Lawyer is a designation that recognizes members who provide 50 hours or more of pro bono legal services in a calendar year.*)

SELECTED PRESENTATIONS

- "The Patent Dispute Leverage Map: How to Test – and Recalculate – Settlement Value," co-presenter, Midwest IP Institute, Minnesota CLE, 2026
- "Corporate Governance and Data Privacy: Oversight, Compliance, and Litigation Preparedness," co-presenter, Corporate Counsel Institute, Minnesota State Bar Association, 2026
- 1L Out-of-State Student Reception
- "Patent Damages 2025 – Lessons from New Virtual Marking Cases, Daubert Gatekeeping Decisions, and More," co-presenter, 2025 Midwest IP Institute, Minnesota CLE, 2025
- "5 Legal Writing Tips for New (And Not So New) Lawyers," Legal Writing in the Age of AI, Minnesota CLE, 2025
- "Legal Lessons from the Little Rock Civil Rights Lawsuit of 1942," Minnesota Landmarks, 2024
- "The Response to the Complaint Including Best Practices for Responding to an Unfiled Complaint After Mandatory eFiling," Civil Practice in Minnesota State District Court, Minnesota CLE, 2024
- "Why We Write: An Authors' Roundtable," panelist, Minnesota State Bar Association Convention, 2023
- "2022 United States Patent and Trademark Office Update," co-presenter, Midwest IP Institute, Minnesota CLE, 2022
- "Identification of Trade Secret Claims—Conundrums and Solutions," panelist, ABA Litigation Section, Business Torts & Unfair Competition Committee, 2021
- "Protecting Intellectual Property and Avoiding IP Missteps in the Era of E-Commerce," co-presenter, 2021 Midwest IP Institute, Minnesota CLE, 2021
- Maslon Attorneys to Present at the Virtual 2021 Midwest IP Institute for Minnesota CLE
- Intellectual Property – What to Reveal, and What to Keep Secret, Litigation Management: A Helping Hand on the Rio Grande, The Network of Trial Law Firms, 2019
- "2018 Cybersecurity Year in Review: Technological and Legal Highlights," 2019
- "Intellectual Property - What to Reveal and What to Keep Secret," In-House Super Course, ACC Minnesota, 2019

- "Ethics: Lawyers Behaving Badly—Avoiding Sanctions You Never Saw Coming," Litigation Management in a New York Minute, The Network of Trial Law Firms, 2017
- "Surviving the Waves: Implied, Express, and Subject Matter Waivers of Attorney-Client Privilege," 2017
- "The 'Hybrid Expert' – Special Challenges and Opportunities," The Expert Witness, Minnesota CLE, 2016
- "Patent Infringement Claims: What All In-House Counsel Need to Know," Litigation Management in a New York Minute, The Network of Trial Law Firms, 2016
- "Dealing with the Aftermath of the *Akamai*, *Alice* and *Nautilus* Decisions," panel member, webcast, Minnesota CLE, 2016
- "Digital, Software, Licensing, and Technology Agreements: Transactional & Litigation Perspectives," panel member, Contracts In Context, ACC Minnesota, 2016
- "M&A in Today's Business Climate: What In-House IP Counsel Need to Know to Enhance Their Contributions to the M&A Team," The 2015 Midwest Intellectual Property Institute, Minnesota CLE, 2015

SELECTED PUBLICATIONS

- Featured in "Medcalf: St. Paul play highlights life of Black woman who fought for equal pay," *Star Tribune*, 2025
- Featured in "Lawyer explores history through creative writing," *Minnesota Lawyer*, 2024
- "MAC Member Profile: Terry Newby," Roseville (MN) *City News*, 2024
- "Elements of Privilege: Privilege and Experts," *Attorney-Client Privilege Deskbook*, Minnesota CLE, 2023
- "Art and Law: Not So Different?" *Hennepin Lawyer*, Hennepin County Bar Association, 2023
- "False Advertising Cases Under the Lanham Act: What is True, What is False, and What is Somewhere in Between," *The IPC Legal Browser*, Summer 2010
- "Jurisdictional Issues in Patent Litigation," *The IPC Legal Browser*, Winter 2004