



Matthew J. O'Hara

Partner | Chicago

mohara@sgrlaw.com

Tel: 312-360-6871

Fax: 312-360-6520

Areas of Practice

Antitrust and Trade Regulation | Appellate Practice | Intellectual Property Litigation | Litigation/Trial Law | Securities Litigation | Securities Enforcement | Trade Secrets

Matthew J. O'Hara is a Partner in the Litigation Practice of Smith, Gambrell & Russell, LLP and a member of the Firm's Executive Committee. Mr. O'Hara was previously a Partner with Freeborn & Peters, which combined with SGR in 2023.

Mr. O'Hara is a business trial lawyer who concentrates his practice in the litigation and trial of complex commercial matters in federal and state courts and matters involving the law of lawyering. He has tried cases involving the federal securities laws, antitrust laws, breach of fiduciary duty, trade secrets, trademark infringement, breach of contract, legal malpractice, contract reformation, unjust enrichment, license agreements, executive employment, the Uniform Commercial Code, fraud, and criminal defense. Mr. O'Hara also litigates private shareholder and partnership disputes, fraudulent transfers, defamation, and other commercial matters. He has represented clients in investigations by the Securities and Exchange Commission, the Federal Trade Commission, and the Illinois Attorney Registration and Disciplinary Commission. He is also experienced in briefing and arguing state and federal appeals. In the legal industry, Mr. O'Hara represents law firms and lawyers in litigation, counseling, and disciplinary defense, and serves as an expert witness in cases involving legal ethics and professional liability.

Mr. O'Hara is very active in providing pro bono legal services. In 2008, he was one of the recipients of the Constitutional Rights Foundation Chicago's "Bill of Rights in Action" Award. He has been quoted concerning his pro bono representations in a variety of publications and on a number of news programs, including *the New York Times*, *the Washington Post*, *the Chicago Tribune*, *the Los Angeles Times*, *the Miami Herald*, *The Wall Street Journal*, *El País (Spain)*, *ABC (Spain)*, *El Mundo (Spain)*, *Radio Free Europe*, *the BBC*, *Radio Nacional Argentina*, *the American Lawyer*, *the Chicago Daily Law Bulletin*, and *the CBA Record*.

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Before joining the Firm, Mr. O'Hara was a Partner at Hinshaw & Culbertson LLP, where he served on the Executive Committee and as co-chair of the Lawyers Professional Liability practice group. Mr. O'Hara began his legal career in 1996 at Sachnoff & Weaver, Ltd., which merged with Reed Smith LLP in 2007. He served as a deputy general counsel to Reed Smith, advising the firm on ethics and risk management.

Mr. O'Hara earned his B.A. in English & Economics, *with honors*, from Northwestern University. He received his J.D. from Chicago-Kent College of Law, where he graduated as Valedictorian.

Representative Experience

- Defeated plaintiff's motion for preliminary injunction against data industry clients on claims of trademark infringement, unfair competition, and tortious interference with contract and prospective economic advantage. *Where To Buy, LLC v. Datasembly, Inc., SPINS LLC, Destini Global LLC*, Case No. 22-6664 (KM) (JBC), 2023 WL 5311219 (D. N.J. Aug. 17, 2023). Plaintiff then dismissed its case with prejudice.
- Argued appeal that won reversal of trial court declaratory judgment against healthcare industry client concerning restrictive covenants ancillary to the sale of the business. The Illinois Appellate Court found that the restrictive covenants should be read as the firm's client contended, without geographic limitations. *United Methodist Homes & Services v. Symbria, Inc.*, 2022 IL App (1st) 201181-U (Ill. App. Ct. 2022).
- Won reformation of real estate purchase agreement and deed for construction industry client. After a 13-day trial, the court found that an agreement requiring the client to pay long-term royalties to the seller on aggregates mined under and around the client's property, where it operates an asphalt manufacturing plant, should be reformed because of mutual mistake. The reformation order defeated claims for ten years and millions of dollars in back royalty payments and altered the obligation going forward.
- Won jury verdict for steel processor client, proving a long-term contract for the sale of steel when no formal written contract was signed, based on the parties' writings, conversations, and course of dealings and performance under Article 2 of the UCC, after an 11-day trial. *National Material Co. v. GSI Group, L.L.C., Circuit Court of Christian County, Ill.*, Case No. 10-CH-64 (Sept. 2018). Previously won reversal of summary judgment against the client on the claim later proven to a jury. *National Material Co. v. GSI Group, L.L.C.*, 2016 IL App (5th) 140542-U (Ill. App. Ct. 5th Dist. 2016).
- Won dismissal of a lawsuit by members of a securities brokerage firm against a National Law Journal 250 law firm seeking \$10 million for alleged malpractice, breach of fiduciary duty, and unlawfully aiding and abetting and conspiring with members of the firm. The court found at the pleadings stage that the claims were time-barred.

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- Won dismissal for lack of personal jurisdiction for a commercial construction contractor, its owner, and a related company for claims of breach of contract, tortious interference with prospective economic advantage, and piercing the corporate veil. *Eclipse Aerospace, Inc. v. Star 7, LLC*, Case No. 15 C 1820, 2016 WL 901297 (N.D. Ill. Mar. 3, 2016).
- Argued a successful appeal in the Illinois Supreme Court resulting in summary judgment for a dissolved corporation based upon a statutory defense under the Illinois Business Corporation Act concerning accrual of claims before dissolution. *Pielet v. Pielet*, 2012 IL 112064 (Ill. 2012).
- Won summary judgment for former CFO of a Fortune 250 company in an ERISA stock-drop class action seeking \$360 million in damages. The court found that the CFO did not fraudulently conceal information from the company's auditors. *Harris v. Koenig*, 815 F.Supp.2d 12 (D.D.C. 2011).
- Won a defense verdict on a claim for breach of fiduciary duty by a partner in a general partnership in a commercial real estate business. The jury also awarded damages on a counterclaim for breach of contract after a 13-day trial. *Krieger v. Boey*, No. 08-L-85 (Cir. Ct. 16th Jud. Dist., DeKalb County, Ill., 2011).
- Defeated motion by seller of digital advertising for preliminary injunction of entertainment industry clients' use of trademark for apparel associated with musical artist, regarding a claim under the Lanham Act for likelihood of causing consumer confusion. *Akoo International, Inc. v. Harris*, No. 10 C 1685, 2011 WL 4007686 (N.D. Ill. Sept. 9, 2011).
- Won summary judgment on claim by distributor client against manufacturer for anticipatory breach of trademark license agreement. *Geneva Int'l Corp. v. Petrof, Spol, S.R.O.*, 608 F. Supp. 2d 993 (N.D. Ill. 2009).
- Court of appeals vacated remedies award in SEC enforcement action against public company CFO because trial court's calculation of disgorgement and penalties was erroneous. *SEC v. Koenig*, 557 F.3d 736 (7th Cir. 2009).
- Won dismissal of tort and contract claims against executives of corporate client. *Midwest Theatres, Inc. v. IMAX Corp.*, No. 08-5823 (DSD/SRN), 2009 WL 649701 (D. Minn. Mar. 11, 2009).
- Defeated motion for temporary restraining order brought by client's former trademark licensee. *Midwest Theatres, Inc. v. IMAX Corp.*, No. 08-5823 (DSD/SRN), 2008 WL 4832598 (D. Minn. Nov. 3, 2008).
- Won reversal of trial court order dismissing client's claims under a non-solicitation agreement. *Baird & Warner Residential Sales, Inc. v. Mazzone*, 893 N.E.2d 1010 (Ill. App. Ct. 1st Dist. 2008).
- Argued appeal in Illinois Supreme Court from denial of successive post-conviction petition based on claims of actual innocence. *People v. Morgan*, 817 N.E.2d 524 (Ill. 2004).
- Defeated challenge by the Illinois Attorney General under the Illinois Constitution to clemencies issued by the Governor of Illinois to prisoners whose death sentences had been vacated in post-conviction or habeas corpus proceedings. *People ex rel. Madigan v. Snyder*, 804 N.E.2d 546 (Ill. 2004).

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- Won trial verdict for industrial equipment manufacturer against a distributor for breach of a distribution agreement and breach of a software license agreement, obtaining attorneys' fees in addition to damages for lost profits and liquidated damages. *Tempco Electric Heater Corp. v. Temperature Engineering Co.*, No. 02 C 3572, 2004 WL 2931329 (N.D. Ill. Dec. 15, 2004).
- Defended a privately-held subcontractor to a military contractor against claims brought by the U.S. Department of Justice under the False Claims Act; coordinated nationwide discovery concerning financial, accounting, and regulatory issues, won reversal of an unfavorable trial court ruling on appeal. *United States v. Taber Extrusions, LP*, 341 F.3d 843 (8th Cir. 2003).
- Successfully argued in the Illinois Supreme Court for a criminal defendant seeking relief under a post- conviction petition from a death sentence. *People v. Morgan*, 719 N.E.2d 681 (Ill. 1999).
- Successfully argued that federal courts had subject matter jurisdiction over client's wrongful eviction claims even though the parties had opposed each other in a prior state court proceeding. *Long v. Shorebank Development*, 182 F.3d 548 (7th Cir. 1999).
- Successfully tried the defense of a claim by a sales executive for unpaid commissions against a public technology consulting company and won a counterclaim for overpaid commissions.

Admissions

Illinois

U.S. Supreme Court

U.S. Court of Appeals for the Seventh Circuit

U.S. Court of Appeals for the Eighth Circuit

U.S. Court of Appeals for the District of Columbia Circuit

U.S. District Court for the Northern District of Illinois

U.S. District Court for the Northern District of Illinois Trial Bar

U.S. District Court for the Central District of Illinois

U.S. District Court for the Eastern District of Wisconsin

U.S. District Court for the District of Colorado

U.S. District Court for the Eastern District of Michigan

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Recognitions

BTI Client Service All Star MVP, one of only 31 lawyers recognized nationally as "attorneys [who] are best at client service" for at least three years in a row by BTI Consulting Group through a survey of top legal decision makers at companies with revenues over \$1 billion, 2019-2022.

Leading Lawyer for Commercial Litigation and Professional Malpractice Defense Law, Legal/Technical/ Financial by the *Leading Lawyers Network*, 2014-2022.

Super Lawyers list in the areas of Business Litigation, Securities Litigation, Professional Liability, by Illinois Super Lawyers magazine, 2012-2023.

AV® Peer Review Rating from *Martindale-Hubbell*, its highest rating for ethics and legal ability.

Publications and Speaking Engagements

- "Breach of Fiduciary Duty and Operating Agreement Disputes," Law Bulletin Seminars' Ethics 2023 Conference, May 31, 2023.
- "Navigating Ethics and Professionalism Requirements in the Securities Laws," Practicing Law Institute's Understanding the Securities Laws 2020 Seminar, September 17, 2020.
- "Attorneys in Transition: Ethical Considerations for Joining a New Firm, Merging Firms, Leaving a Firm or Succession Planning," Law Bulletin Seminars/IICLE's Ethics 2020 Conference, June 11, 2020.
- "Selective Use of Attorney-Client Privilege: Beware of Sword and Shield Doctrine, Especially When Attorneys Are Witnesses," Federal Bar Association, June 4, 2020.
- "How Supply Chain Relationships May Change in the Wake of COVID-19," Juvenile Products Manufacturers Association (JPMA), June 3, 2020.
- "Illinois Court Sheds Light on Selective Use of Attorney-Client Privilege," Law360, May 6, 2020.
- "Client Alert: Supply Chain Commercial Impracticability in the COVID-19 Crisis," Freeborn & Peters LLP, March 25, 2020.
- "An Ethics Checklist for Securities Lawyers Representing Issuers and Other Entities," PLI Ethics Programs, Corporate Law & Practice Course Handbook Series, Winter 2020
- "How To Ward Off Nonclient Suits Over Lawyers' Speech," Law360, December 9, 2019.
- "Navigating Ethics and Professionalism Requirements," Practicing Law Institute's Understanding the Securities Laws 2019 Seminar, Chicago, September 19, 2019.
- "Lawyers Love to Talk: Claims Based on Lawyers' Speech," Legal Management Resources, LLC, Large Law Firm General Counsel Roundtable, Dallas, October 22, 2018.

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- "Legal Management Resources", LLC, Mid-Sized Law Firm General Counsel Roundtable, Wilmington, Delaware, October 15, 2018.
- "Navigating Ethics and Professionalism Requirements," Practicing Law Institute's Understanding the Securities Laws 2018 Seminar, Chicago, September 27, 2018.
- "When Does Zealous Advocacy Cross the Line?" Law Bulletin Publishing's Ethics 2018 seminar, Chicago, June 5, 2018.
- "There Is Middle Ground for US Lawyers on AML Regimes," Law360, April 13, 2018.
- "Navigating Ethics and Professionalism Requirements in Securities Law Practice," Practicing Law Institute's Understanding the Securities Laws 2017 seminar, Chicago, September 28, 2017.
- "Ethical Issues for In-House Counsel," Practicing Law Institute's Illinois Professional Responsibility MCLE Marathon, Chicago, April 25, 2017.
- "Guantanamo Bay - The Final Chapter, A Lawyer's Tale," Coalition of Women's Initiatives in Law, Chicago, April 5, 2017.
- "Some Observations on Global Law Firms Organized as Swiss Vereins," Legal Management Resources Large Law Firm General Counsel Roundtable, Los Angeles, January 12, 2017.
- "New Ninth Circuit Case on SOX Clawback Leaves Unresolved Issues," Bloomberg BNA's Securities Regulation & Law Report™, November 7, 2016.
- "Navigating Ethics and Professionalism Requirements for In-House Counsel," Tenneco Legal Department, Lake Forest, Illinois, June 22, 2016.
- "Will Lawyers Face Regulatory Scrutiny after the Panama Papers? (Perspective)," Bloomberg Law, June 21, 2016.
- "Navigating Ethics and Professionalism Requirements," Practicing Law Institute's Understanding the Securities Laws Fall 2015 seminar, Chicago, October 28, 2015.
- "Preparing a Business Torts Case for Trial," ABA Section of Litigation Roundtable, October 2015.
- "Conflicts: Who Is Your Client?," Legal Malpractice & Risk Management Conference, Chicago, February 2015.
- "SEC Enforcement of the Sarbanes-Oxley Clawback Statute: Increased Enforcement Pressure in an Undeveloped Area of the Law," chapter in Inside the Minds: SEC Compliance Best Practices (Aspatore Books 2015).
- "Do Lawyers Enjoy Immunity In Drafting Orders For Judges?," Law360, November 21, 2014.
- "Firms to See Shift on Unfinished Business Claims," Chicago Daily Law Bulletin, September 3, 2014.
- Business Torts: A Practical Guide to Litigation, chapter on "Trial Preparation," Business Torts & Unfair Compensation Committee, American Bar Association, First Chair Press, June 2014.
- "The General Counsel Forum," Legal Malpractice & Risk Management Conference, Chicago, March 2014.
- "Defending Disqualification Motions," Chicago Law Firm Management Roundtable, April 2013.
- "Consolidation, Collaboration and Competition—An Antitrust Perspective for Today's Healthcare Industry," Hinshaw & Culbertson Annual Health Care Conference, November 2012.

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- "7th Circuit Opinions on State Corporation Laws Follow Precedent," Chicago Daily Law Bulletin, October 11, 2012.
- "Staying Private Avoids SEC, but Not All Regulation," Business Torts Litigation, Volume 19, No. 3, Spring 2012.
- "Government Investigations—How to, and How Not to, Respond," Chicago Law Firm Management Roundtable, April 2011.
- State Deceptive Practices Laws Accompanying Lanham Act Claims for Likelihood of Confusion—Considerations as to Remedies and Applicable Law," co-author, DRI Business Litigation and Intellectual Property Conference, Chicago, Illinois, April 2011.
- "Managing Conflicts in International Law Firms: Can the Oceans Serve as Ethical Screens?" Bloomberg Law Reports, "Law Firm Management," 1, No. 2, August 2010.
- "Illinois' New Rules of Professional Conduct," Abbott Laboratories Legal Department, North Chicago, Illinois, February 2010.
- Hafetz, New York University Press, 2009.
- "Ruling Goes Against Minority Shareholder on Costs," Chicago Daily Law Bulletin, August 21, 2009.
- "Would a Prudent ERISA Fiduciary Invest in Subprime Mortgage Securities?" First Focus: The Subprime Crisis (Thompson West 2008).
- "Justice is Languishing Behind Bars at Guantanamo," Chicago Sun-Times, December 5, 2007.
- "New Amendments to the Illinois Business Corporation Act Favor Minority Shareholders," Chicago Daily Law Bulletin, October 18, 2006.
- "Minority Shareholders May Be In For a Better Deal," Chicago Daily Law Bulletin, July 27, 2005.