

# IP Litigation

## IP Litigation — Make Your Strongest Case

Marshall, Gerstein & Borun LLP's IP litigation team successfully handles complex, high-stakes cases for major international companies, leading universities, and burgeoning startups. In hundreds of cases tried in court or negotiated to settlement, we draw on our extensive technical and industry backgrounds to resolve present disputes, anticipate future challenges, and proactively manage risk for our clients.

### **A full-service IP firm with a global client base**

Marshall Gerstein is one of an exclusive breed: a law firm dedicated solely to intellectual property (IP) law. Our IP trial attorneys have mastered the IP-dispute process and dedicated themselves to achieving successful outcomes for our clients. We have in-depth experience with the unique challenges such disputes present and in every judicial and administrative venue in which they are adjudicated. Our clients are supported by a deep bench of attorneys who have pioneered global strategies for the acquisition and protection of IP rights, who are adept at the assessment and valuation of IP assets, and who have negotiated, implemented, and managed complex IP transactions across every area of technology and on almost every continent. Our focused practice gives us command of all the tools needed to successfully handle a broad range of cases, from those brought by non-practicing entities, to bet-the-company litigation between fierce business competitors.

### **Decades-long partnerships with IP leaders**

We proudly serve as IP litigation counsel for U.S. and multinational industry leaders worldwide, including Amgen, Inc., Baxter Healthcare Corp., CDW Corp., Charter Communications, Emerson Electric Co., Medela, Shop-Vac Corp., The Procter & Gamble Company, and the University of Michigan. Due to our global focus on IP and our aggressive, client-centered approach, these and other leading businesses have trusted Marshall Gerstein as their strategic litigation partner for decades. Through close working relationships, we develop a deep understanding of our clients' organizations, operations, and objectives—knowledge that proves invaluable in driving our business-focused solutions.

### **Deep technical knowledge secures results and enhances client service**

Superior scientific and technical competence are among the hallmarks of our IP litigation practice. Nearly 90 percent of our professionals have degrees in science or engineering and have qualified for admission to practice before the U.S. Patent and Trademark Office (USPTO). In many instances, our professionals hold doctorates and other advanced degrees in these critical scientific disciplines. We do not need to be educated on the complex science and engineering underlying our clients' innovations, products, or services. We are able to communicate easily and effectively with inventors, experts, and others involved in those technologies and, more importantly, to then translate those concepts into persuasive language and compelling advocacy.

### **Hands-on industry and in-house experience**

Marshall Gerstein recruits lawyers that have backgrounds in a range of industries. Decades of real-life experience in corporate boardrooms, production facilities, and laboratories gives our lawyers a client's-eye view that helps them prevail in IP disputes. Armed with this knowledge, we can operate as a true partner, providing practical litigation strategies that work not just for the case, but also for the business.

### **Trial successes from coast to coast**

Wherever and in whatever forum, Marshall Gerstein has the bench strength and track record to advocate effectively. We have represented individuals, corporations, universities, and organizations in thousands of patent, trademark,

copyright, trade secret, and intellectual property-related suits from Delaware to California. Our experience and reputation in these venues strengthens our credibility before judges and opposing counsel alike, whether we are negotiating a settlement, seeking injunctive relief, or conducting a jury trial.

We achieve success in IP litigation through creative strategies executed efficiently. We comprehend nuances and distinctions lost on others. These skills allow us not only to prevail before judges and juries, but, in many cases, enable us to succeed for our clients while avoiding litigation altogether.

### **Post-grant proceedings**

Clients look to us to design comprehensive IP strategies that include inter partes review, covered business method review, post-grant review, and supplemental examination procedures, as well pre-existing reexamination and reissue procedures. We have been a national leader in implementing post-grant proceedings, improving outcomes for our clients while saving them from the considerable expenses and delays of courtroom litigation.

### **Exceptional client service**

Improving on rigid, narrowly focused client service models, we have pioneered fully integrated, multidisciplinary teams of attorneys, patent agents, paralegals, and staff (including those in litigation support, docketing, information technology, and accounting). Mobilizing such resources enhances collaboration between firm and client, efficiently expands institutional knowledge, and permits unsurpassed integration with client systems, procedures, and objectives.

### **Serving clients cost-effectively**

Our team begins each matter with a clear understanding of the client's goals and expectations, and a consensus budget against which we regularly track and report on achievement of agreed-upon milestones. We assess cases early to identify the issues most likely to result in favorable outcomes, and direct our resources to only the most fruitful avenues. Our exclusive focus on IP law, combined with the technical skills of our professionals, permits more judicious and efficient staffing. We further reduce costs through experienced workflow management and the use of highly skilled non-lawyer staff where appropriate. To keep clients fully apprised of the progress of cases at all times, we make extensive use of client extranets and customized, client-accessible databases.

## **Client Successes**

### **Fierce Advocates**

In presenting this gift of Samurai armor to Marshall, Gerstein & Borun LLP, a grateful client explained that he chose the gift because Marshall Gerstein's team of trial lawyers had "represented him as loyally and fiercely as any Samurai warrior." Also, he added, he feared he could not have carried an actual Samurai sword through the building security.

Our client, a pioneer in reconstructive surgery, invented a revolutionary device known as a differential tissue expander. This balloon-like device, when implanted beneath the skin and inflated in stages over time, permitted a surgeon to expand a patient's skin—in fact prompting the body to grow new tissue—for use in reconstructing adjacent wounds or defects. The invention, for the first time, permitted surgeons to tailor this skin expansion to more easily perform truly anatomic surgical reconstructions.

A professor of surgery who had devoted his career to academic medicine, the client faced the deliberate infringement of his patent by one of the largest manufacturers of these silicone devices. Despite relentless assaults by the defendant and its expansive team of attorneys, we did not waver, shrink or give ground. Through such tenacity, we successfully achieved a highly favorable result for the client.

Whether our client is an individual or corporation, patentee or defendant, we approach each engagement with the same commitment, the same fierce dedication, the same tenacity and the same focus and resolve which prompted this particular grateful client to liken us to Samurai warriors.

### **Illumina Continues Critical Work in Human Genomics**

Working at the cutting edge of science and medicine, Marshall, Gerstein & Borun LLP's client, Illumina, Inc., created its Genome Analyzer, HiSeq, and MiSeq instruments to sequence DNA at extremely high speeds. When Life Technologies Corp. claimed that the sequencers infringed three of its DNA amplification patents, Marshall Gerstein's trial attorneys led a three-year defense of Illumina. Ultimately, the district court granted our motion for summary judgment disposing of the infringement claims, later affirming its ruling on Life Technologies' motion for reconsideration. As a result, Illumina can continue with its critical work in the field of human genomics.

### **Eliminating Spillover via an Inter Partes Victory**

The Firm secured a complete victory for SSW Holding Company, Inc., in an inter partes review proceeding challenging the validity of an SSW patent, making its client one of just a handful to emerge from the newly established inter partes review process with every challenged patent claim fully intact.

Inter partes review (IPR) is a streamlined process for challenging patents created through the Leahy-Smith America Invents Act of 2011 and, to date, has proven favorable to those challenging patents. Of the 78 decisions issued in IPR proceedings through June of 2014, the Patent Trial and Appeal Board cancelled or invalidated nearly 80 percent of the patent claims before it. In only 14 percent of such cases did the board find in favor of the patent owner with respect to all of the patent claims under consideration, as it did in *Schott Gemtron Corp. v. SSW Holding Company, Inc.* The Patent Trial and Appeal Board's decision rejected arguments that SSW's patent—which covers spill-containing refrigerator shelving technology used by major appliance manufacturers—was “obvious” and therefore invalid. Oral argument in the case took place on June 23, 2014.

### **Protecting Carbon-Capture Technologies**

Marshall, Gerstein & Borun LLP obtained a successful result for CO<sub>2</sub> Solutions, Inc., in an Inter Partes Review (IPR) of one of CO<sub>2</sub> Solutions' patents covering its enzyme-based technology for capturing carbon dioxide from exhaust gas. The Patent Trial and Appeal Board (PTAB) at the U.S. Patent and Trademark Office ruled in favor of CO<sub>2</sub> Solutions on four of the five grounds of review, upholding CO<sub>2</sub> Solutions' commercially significant claims of the challenged patent.

CO<sub>2</sub> Solutions' proprietary carbon-capture technologies, as covered by the upheld patent claims and by other patents in CO<sub>2</sub> Solutions' portfolio, provide environmentally-friendly, efficient, and cost-effective methods for reducing carbon emissions. As stated by Evan Price, President and CEO of CO<sub>2</sub> Solutions, “We believe this confirms CO<sub>2</sub> Solutions' possession of the least expensive and most environmentally friendly carbon capture technology available on the market.”

### **Vanguard Approach to Protect IP Rights in Bankruptcy**

Marshall, Gerstein and Borun LLP's Tiffany D. Gehrke, Maureen Beacom Gorman and Julianne M. Hartzell forged new law in a recent intellectual property counterfeiting case. After the team had obtained a multi-million dollar judgment and an injunction, two of the defendants sought discharge of the injunction and financial judgment in bankruptcy court. Finding no published decisions, the team successfully argued that the injunction could not be discharged, analogizing intellectual property injunctions to environmental protection injunctions that prevent further pollution. The team argued that the IP injunctions should be excluded from discharge in bankruptcy because they do not constitute debts. The California bankruptcy court agreed with this novel argument and entered summary judgment in favor of the Firm's client, ruling that the injunction entered in the district court would be unaffected by the opposing party's bankruptcy filing and any resulting discharge.

This innovative application of bankruptcy law is Marshall Gerstein's most recent example of its vanguard approach to intellectual property enforcement. Over 50 years, Marshall Gerstein has had highly regarded experience in complex intellectual property litigation, enjoying a distinguished history before courts, including the United States Supreme Court in the landmark cases *Blonder-Tongue Labs, Inc. v. University of Illinois Foundation*, establishing the fundamental

principle of offensive collateral estoppel, and *Walker Process Equipment, Inc. v. Food Machinery & Chemical Corporation*, setting forth the basic principles for antitrust liability under the patent laws.

### **IPR Win for ACCO's ClickSafe® Locks**

Marshall Gerstein successfully represented ACCO Brands Corporation and ACCO Brands USA LLC in Inter Partes Reviews (IPR) before the Patent Trial and Appeal Board (PTAB), appeal of that decision to the U.S. Court of Appeals for the Federal Circuit, and in related infringement litigation in the Eastern District of New York, in which Think Products accused ACCO's ClickSafe® line of computer locks of infringing two Think Products patents.

Marshall Gerstein petitioned for IPR of each asserted patent, arguing that the Think Products patents were obvious over combinations of prior-art references, and anticipated by a published video disclosing the accused ClickSafe® product.

In both IPRs, the PTAB ruled in favor of ACCO on all grounds of review, cancelling all challenged claims of the patents, and these decisions were upheld on appeal to the Federal Circuit.

### **Patentee Prevails: Complete Victory Achieved for Ergonomics Manufacturer's Infringement on Amazon**

Through the guidance of Marshall, Gerstein & Borun LLP a leading home and office ergonomics manufacturer secured a complete victory for patent infringement. Through Amazon's Neutral Patent Evaluation Process Program, which works to determine the invalidity of infringement allegations, Marshall Gerstein was able to prevail and all infringing items were removed from Amazon following the decision.

### **Intellectual Property Infringement Lawsuit filed by CureVac Against BioNTech**

Marshall, Gerstein & Borun LLP represents CureVac, a global biopharmaceutical company developing a new class of transformative medicines based on mRNA, in an intellectual property infringement lawsuit filed originally in June 2022 relating to COVID-19 variant adapted vaccines, including the Omicron and XBB1.5 variants and EP4023755, relating to split poly A tail mRNA vaccines.

In May 2023, CureVac filed a counterclaim in the U.S. that alleges infringement of nine U.S. patents, expanding the scope of the case beyond the three patents originally named by Pfizer/BioNTech. These nine patents have now been extended by a tenth patent (US11667910), which relates to mRNA purification methods, a critical part of the overall mRNA manufacturing process.

Partner [Mark Izraelewicz](#) represents CureVac in the U.S. and Oliver Jan Jüngst from Bird & Bird and Andreas Graf von Stosch from Graf von Stosch Patentanwaltsgesellschaft represent CureVac in Germany.