

# Patents

Cozen O'Connor represents diverse clients, from global blue chips to family-owned enterprises, in complex patent matters, including federal district court litigation, global patent prosecution, Patent Trial and Appeal Board (PTAB), and International Trade Commission (ITC) litigation.

We do this because patentable IP drives the advancement of human knowledge. We also just really like working with smart and ambitious clients who've got IP worth patenting.

Our dedicated team includes IP litigators with decades of first-chair trial experience; licensed patent attorneys with advanced degrees in chemistry, biology, immunology, biophysics, and electrical and mechanical engineering; and former senior research scientists in the telecommunications, software, pharmaceutical, industrial products, and defense industries.

## Litigation

Cozen O'Connor represents clients in jury and bench trials in jurisdictions across the country. In many cases, we achieve client goals through practical, business-minded settlements. But when litigation must be pursued, our track record is one of big-dollar plaintiff verdicts and summary judgment defense victories. We handle patent litigation in a wide range of industries:

- pharmaceuticals, nutraceuticals, life sciences, biomedical, and medical devices
- computer, internet, telephone, telecom, and wireless network
- banking and finance
- defense, chemical, industrial, automotive, energy, manufacturing, and aviation
- consumer products, food and beverage, sports, and entertainment

## Post-Grant Review Proceedings

The PTAB has become a common venue for validity claims and an integral part of a broader litigation strategy. Cozen O'Connor routinely represents clients before the PTAB, either initiating or defending critical *inter partes* review (IPR), post-grant review, and covered business method review proceedings.

## International Trade Commission (ITC)

Cozen O'Connor has attorneys who are admitted to lead infringement hearings before the ITC and adept at obtaining or defending exclusion orders on the importation of goods in this specialized venue.

## Appeals

The firm's patent litigators frequently argue matters before the Federal Circuit Court of Appeals and are often retained as appellate counsel in cases that peer firms lost at trial.

## Procurement & Prosecution

Cozen O'Connor's patent prosecutors obtain U.S. and foreign patent approval to help clients protect inventions and monetize their IP. Our attorneys characterize advancements, structure patent applications, provide design-around advice, manage patent portfolios, and negotiate acquisition, transfer or licensing agreements. The team is adept at winning U.S. protection of foreign-originated work and foreign protection of U.S.-originated work.

## Services

- Assert or defend patents with respect to infringement claims or other disputes
- Prosecute patent applications in the U.S. Patent and Trademark Office and foreign agencies



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- Develop strategies to maximize patent protection
- Analyze patentability of inventions not yet protected
- Assist with searches of prior art and survey competitors' patent activities
- Perform freedom-to-operate, clearance, validity, due diligence, and infringement studies
- Represent clients in reissue, reexamination, *inter partes*, post-grant, and derivation proceedings
- Represent clients in federal litigation, arbitrations, and appeals
- Counsel clients about leveraging domestic and international patent rights
- Provide transactional advice on acquisitions, joint ventures, transfer, and licensing agreements
- Lead patent arbitration in the context of licensing disputes

## Experience

Represented a pharmaceutical company as a Respondent in an arbitration proceeding over a failure to pay royalties on licensed patents. The arbitrator sided with our argument that the patents were invalid, and awarded the Claimant no royalties.

Litigation counsel for Apotex Inc. and Apotex Corp. in a patent infringement action concerning Apotex's ANDA to make a generic version of Otsuka Pharmaceutical Company, Ltd.'s REXULTI® (Brexipiprazole) oral tablets. The case settled the day before trial.

Represented London Luxury LLC in a patent infringement action and a post-grant review against E & E Co., Ltd. Case settled prior to trial.

Currently representing Solar Paste, LLC in a patent infringement action against Changzhou Fusion New Material Co., Ltd. and Risen Energy Co., Ltd. Case is pending in Delaware district court.

Successfully represented Ascend Performance Materials in a Patent Opposition hearing before the European Patent Office's Opposition Board, resulting in the revocation of all claims of a granted EMS Chemie patent broadly covering particular high-performance plastic formulations.

Handle the global intellectual property portfolio and related enforcement and litigation for Nielsen-Kellerman.

Prevailed on behalf of Ascend Performance Materials LLC in an *Inter Partes* Review before the Patent Trial and Appeal Board (PTAB) challenging ten claims of a Samsung patent relating to rechargeable lithium battery electrolyte technology. The representation included detailed Petition preparation, substantial expert testimony, multiple depositions (conducted in Korean with translators), and a virtual oral hearing. The PTAB issued its Final Written Decision finding all of the challenged claims to be invalid on two separate grounds, each based on different prior art.

Secured an *inter partes* review victory before the U.S. Patent and Trademark Office's Patent Trial and Appeal Board (PTAB), and affirmance by the U.S. Court of Appeals for the Federal Circuit, successfully defending three patents relating to water treatment systems.

Represented Zero Zero Robotics, Inc. in a patent infringement action concerning Zero Zero's HOVERPASSPORT® drone product. Plaintiff voluntarily dismissed its case prior to our client's answer.

Represented Amneal Pharmaceuticals, Inc. in a patent infringement action concerning Amneal's ANDA to make a generic version of Pfizer's KERYDIN® (Tavaborole) topical solution product. After a favorable result on *inter partes* review petitions at the Patent Trial and Appellate Board, the district court case was dismissed.

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## Related Practice Areas

- Copyright & Content
- Entertainment Law
- Franchising
- Hatch-Waxman & Biologics
- Intellectual Property
- Intellectual Property Litigation
- IP Transactions & Licensing
- Trade Secrets, Restrictive Covenants, and Computer Abuse
- Trademark & Brand

Successfully represented Marquee Brands, LLC in connection with its multi-million dollar acquisition of Martha Stewart Omnimedia's intellectual property rights -- including patent, trademark and copyrights pertaining to Martha Stewart and Emeril Lagasse. The project involved data privacy issues and investigating extensive worldwide intellectual property rights and employee and contractor rights.

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Successfully represented Marquee Brands, LLC in connection with a substantial due diligence project culminating in its multi-million dollar acquisition of the outdoor sports and lifestyle brand Dakine, and all related intellectual property. The project involved investigating Dakine's extensive worldwide trademark and patent portfolio, third-party rights in Europe, employee and contractor intellectual property rights concerning copyright and patent issues in the United States and Europe, as well as data privacy issues.

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Represented Kyowa Kirin, Inc. and Strakan International S.A. against Actavis Labs' attempt to make a generic version of Kyowa Kirin's SANCUSO® (granisetron) transdermal patch product. Following a bench trial, the judge ruled in our clients' favor on all contested issues and rejected the defendant's claims of non-infringement, invalidity, and unenforceability. Successfully argued on appeal with the Federal Circuit affirming the trial court decision without opinion.

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Won summary judgment on three of four counts in a case alleging breach of an agreement entitling the plaintiff to approximately \$3 million plus interest. In granting summary judgment, the court found no obligation to make the payment and that the provision at issue did not even apply to the client. The court also granted summary judgment on counts for unjust enrichment and promissory estoppel, holding that those equitable claims failed in the face of the written agreements. The fourth count, seeking comparatively minimal amounts, was settled on terms favorable to the client days before the trial was scheduled to begin. In a separate order, the trial court found that federal subject matter jurisdiction under U.S. patent law existed because the patents were still in effect, the equitable claims were based on allegations for unauthorized use of the patents, and the issues litigated included defenses to the patents' enforceability. In a subsequent order, the court awarded the client more than \$200,000 in attorneys' fees.

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Won a judgment of non-infringement of multiple patents directed toward vehicular tilt control apparatuses on behalf of a German auto parts maker. These judgments were affirmed by the U.S. Court of Appeals for the Federal Circuit, which agreed with our arguments that intrinsic evidence and the prosecution history supported the district court's constructions of the claim terms at issue and finding of non-infringement based thereon.

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Lead counsel in damage phase of a patent infringement action regarding Sandoz's ANDA to make a generic version of Pfizer's seizure and neuropathic pain product, Neurontin®, the active ingredient of which is gabapentin. The case settled during the pre-trial phase and after successful Motions in Limine by Sandoz.

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Represented Apotex Inc. in a patent infringement action regarding Apotex's ANDA to make a generic version of AVODART® (dutasteride). Settled prior to trial.

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Handled a patent infringement action regarding Sandoz's ANDA to make a generic version of Alcon's eye allergy product Pataday®, the active ingredient of which is olopatadine hydrochloride.

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Handled a patent infringement action regarding Sandoz's ANDA to make a generic version of Pfizer's antimuscarinic tablet Detrol and Detrol LA®, the active ingredient of which is tolterodine tartrate.

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Handled a patent infringement action regarding Sandoz's ANDA to make a generic version of Pfizer's antifungal medication VFEND®, the active ingredient of which is voriconazole.

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Represented Sandoz Inc. in a patent infringement action regarding Sandoz's ANDA to make a generic version of Alcon's eye allergy product PATANOL® (olopatadine hydrochloride). Case settled.

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Represented Sandoz Inc. in a patent infringement action concerning Sandoz's ANDA to make a generic version of Abbott's NIASPAN® (Niacin) controlled-release tablets. Case settled prior to trial.

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Represented Sandoz Inc. in a patent infringement action concerning Sandoz's ANDA to make a generic version of Abbott's TRILIPIX® (Fenofibric Acid) capsules. Case settled prior to trial.

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Represented Innopharma, Inc. and Amneal Pharmaceuticals, Inc. in patent infringement actions concerning our clients' ANDAs to make generic versions of Spectrum's FUSILEV® (Levoleucovorin) Injection product.

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Represented Sandoz Inc. in patent infringement action concerning Sandoz's ANDA to make a generic version of Helsinn's anti-nausea product Helsinn's ALOXI® (Palonosetron Hydrochloride) injection product. Case settled prior to trial.

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Represented Sandoz Inc. in a patent infringement action concerning Sandoz's ANDA to make a generic version of Roche's VALCYTE® (Valganciclovir Hydrochloride) capsule product. Case settled prior to trial.

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Represented Sandoz Inc. in a patent infringement action concerning Sandoz's ANDA to make a generic version of Shire's ADHD product INTUNIV® (Guanfacine Hydrochloride). Case settled prior to trial.

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Represented Apotex Inc. and Apotex Corp. in a patent infringement action concerning Apotex's ANDA to make a generic version of Pfizer's PRISTIQ® (Desvenlafaxine) extended-release oral tablet products. Case settled prior to trial.

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Represented Apotex Inc. in a patent infringement action regarding Apotex's ANDA to make a generic version of ACULAR LS® (0.4% ketorolac tromethamine). Led the negotiations that resulted in a successful settlement of the matter after the close of expert discovery.

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Trial counsel for Apotex Inc. and Apotex Corp. in a patent infringement action regarding Apotex's ANDA to make a generic version of LYSTEDA® (tranexamic acid). After a two week trial, received a favorable decision of non-infringement on all three patents in-suit. Successfully argued on appeal with the Federal Circuit affirming the trial court decision.

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Represented Sandoz Inc. in a patent infringement action concerning Sandoz's ANDA to make a generic version of Abbott's ZEMPLAR® (Paricalcitol) oral capsule product. Case settled prior to trial.

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Represented Mylan Pharmaceuticals, Inc. in a patent infringement action concerning Mylan's ANDA to make a generic version of Pfizer's CADUET® (Atorvastatin Calcium and Amlodipine Besylate) oral tablet products. Case settled prior to trial.

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Represented Actavis in a patent infringement action concerning Actavis's ANDA to make a generic version of King's pain product AVINZA® (Morphine Sulfate) oral capsule products. Case settled prior to trial.

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Lead counsel for Chimei InnoLux Corporation, f/k/a InnoLux Display Corporation, in a patent infringement case involving Honeywell's patent to brightness-enhancing films used in LCD devices. Plaintiff dismissed its case against our client, with prejudice, after the special master indicated he would recommend granting our motion for summary judgment of noninfringement.

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Represented Sandoz Inc. in a patent infringement action regarding Sandoz's ANDA to make a generic version of Merck's anti-nausea product EMEND® (aprepitant).

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Represented our client, Sandoz Inc. in a patent infringement action regarding Sandoz's ANDA to make a generic version of Alcon's eye allergy product PANTANOL® (olopatadine hydrochloride).

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Represented Sandoz Inc. in a patent infringement action regarding Sandoz's ANDA to make a generic version of Allergan's glaucoma drops COMBIGAN® (brimonidine tartrate/timolol maleate).

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Represented Apotex Inc. in a patent infringement action regarding Apotex's ANDA to make a generic version of Sanofi-Aventis' anticancer product TAXOTERE®, the active ingredient of which is docetaxel. Following a two-week trial, obtained an order for Apotex striking down the patents-in-issue as invalid as obvious and unenforceable due to Sanofi-Aventis' inequitable conduct in procuring the patents. Successfully argued on appeal with the Federal Circuit affirming trial court decision (April 2012). Of import is that inequitable conduct defense remains viable in ANDA litigations because of this ruling.

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Represented Apotex Inc. in a patent infringement action regarding Apotex's ANDA to make a generic version of Wyeth's anti-depressant product EFFEXOR XR® (venlafaxine hydrochloride). Settled on favorable terms during trial.

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Represented Sandoz Inc. in a patent infringement action regarding Sandoz's ANDA to make a generic version of Endo's pain product OPANA® ER (oxymorphone hydrochloride).

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Lead counsel for Sandoz Inc. in a patent infringement action regarding Sandoz's ANDA to make a generic version of Medicis' acne product SOLODYN® (minocycline hydrochloride).

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Represented defendant Walmart Inc. on appeal to the Federal Circuit. Settled the case on terms the client found favorable just prior to oral argument.

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Represented Signalization Ver-Mac in declaratory judgment patent infringement action relating to solar tilt and rotate features of roadside message boards. Settled the case on terms the client found favorable after discovery.

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Represented a German-based biotech company in a patent infringement action regarding a method for synthesizing nucleic acids.

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Represented Chi Mei Optoelectronics in a jury trial against a plaintiff who had received 42 licenses totaling \$180-plus million in license royalties. Non-infringement found on one of three patents, reducing potential \$900 million damages award to \$10 million.

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Represented relator in qui tam action involving patent false marking.

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Represented Chi Mei Optoelectronics in patent infringement action relating to modules for monitor and television displays.

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Represented Peter Kiewit & Sons in patent infringement relating to fiber optic cable communications systems. Settled the case on terms the client found favorable following substantial discovery.

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Represented NuVox in patent infringement action relating to Voice Over Internet Protocol (VoIP). Settled the case on terms the client found favorable following substantial discovery.

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Represented Vonage Holdings in a jury trial of a patent infringement action relating to Voice Over Internet Protocol (VoIP). Settled the case on terms the client found favorable following trial.

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Represented Signalization Ver-Mac in declaratory judgment patent infringement relating to smart work zones on highways. Settled the case on terms the client found favorable after summary judgment motions were filed.

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Patent infringement action representing defendant Chi Mei Optoelectronics (CMO) relating to modules for monitor and television displays. Received summary judgment of non-infringement in favor of CMO.

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Lead counsel for Barr Labs in a patent infringement case involving Barr's drug, TAMBACOR®.

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Served as lead trial counsel for Wilmington Trust Company in largest multidistrict patent litigation suit in defense of claims of patent infringement of RAKTL concerning call processing patents.

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