

# INTELLECTUAL PROPERTY LITIGATION

In a business climate driven by constant innovation and commercialized information, protecting intellectual property is critical to success. Our intellectual property litigation team works with clients ranging from emerging visionaries to market-leading corporations to support and defend the ideas, designs, and processes that are the lifeblood of their business.

## How We Help Clients

- Prosecuting and defending claims of infringement or misappropriation of patents, trademarks, copyrights, trade secrets, and idea
- Provide informed counsel and staunch advocacy for our clients through the litigation process from strategy development and pre-litigation investigations all the way through litigation and appeals
- Create and utilize multidisciplinary teams to ensure matters are handled effectively and efficiently for clients
- Work closely with attorneys at our firm who have advanced degrees in engineering, chemistry, biological sciences, and other subject areas to bring a thorough understanding of our clients' business, technology, and objectives.

## Who We Are

Hodgson Russ has been awarded prestigious "Best Law Firms" Metropolitan Tier rankings by *Best Lawyers/U.S. News & World Report* in the Litigation - Intellectual Property and Litigation - Patent categories.

We represent clients in numerous industries, including:

- Biotechnology
- Blockchain Technology
- Chemical engineering and manufacturing
- Children's products
- Entertainment and media
- Financial services
- Food & Beverage
- Manufacturing
- Medical devices

## Contact

Jodyann Galvin  
716.848.1520  
jgalvin@hodgsonruss.com

## Professionals

### Attorneys

Alfonzo Cutaia  
John DiMaio Ph.D.  
Emily Florczak  
Rob Fluskey  
Neil Friedman  
Jodyann Galvin  
Joshua Levitt  
John Lopinski Ph.D.  
Nathaniel Lucek  
Fallon Martin  
Christopher Massaroni  
Ryan McGonigle  
Scott Paton  
Charles Rauch  
R. Kent Roberts  
Paul Roman Jr. Ph.D.  
Alexandria Rowen  
Gary Schober  
George Snyder  
Melissa Subjeck  
James Zawodzinski Jr.

## INTELLECTUAL PROPERTY LITIGATION

- Nanotechnology
- Pharmaceuticals
- Software
- Solar technology
- And more

Our clients benefit from our extensive experience representing both plaintiffs and defendants in matters involving all forms of intellectual property, including:

- Representing clients in patent infringement matters involving a diverse range of products and services (including medical devices, pharmaceuticals, sports equipment, genetic testing, linguistic search engine technology, and nanoparticle coatings, to name just a few)
- Representing clients in proceedings before the International Trade Commission, the agency which adjudicates disputes over imported goods that infringe U.S. patents, trademarks and copyrights
- Bringing and defending challenges to domain names (ICANN and federal court proceedings)
- Bringing and defending trademark opposition and cancellation proceedings before the Trademark Trial and Appeal Board (TTAB)
- Conducting jury and bench trials of patent, trademark, and misappropriation claims in state and federal courts
- Obtaining preliminary injunctions
- Working with patent prosecutors on re-examination proceedings before the U.S. Patent and Trademark Office

Whether counseling on protection strategies in the conference room or defending our clients' interests in the courtroom, the Hodgson Russ intellectual property litigation team provides sophisticated and cost-effective legal services focused on helping clients achieve their business objectives. Without the high price tag that generally comes with firms headquartered in larger cities, our attorneys have the breadth and depth of knowledge and experience necessary to help our clients protect their intellectual property rights and strengthen their competitiveness.

### Experience

Hodgson Russ represented the defendants in an action venued in U. S. District Court for the Eastern District of Texas involving a chemical patent related to biocide formulations. While this lawsuit was pending, Hodgson Russ initiated an *inter partes* re-examination of the patent in suit. Hodgson Russ moved to stay the litigation. The court granted the stay motion over opposition from the plaintiff. Before the case was stayed, Hodgson Russ handled all aspects of defending the litigation, including the preparation and review of invalidity contentions, the preparation and review of proposed claim constructions, depositions of the inventor and plaintiff's expert, claim construction briefing, and document discovery. The re-examination resulted in office actions rejecting the relevant claims of the patent in suit, and the litigation was ultimately dismissed.

## INTELLECTUAL PROPERTY LITIGATION

Hodgson Russ represented a leading Greek yogurt manufacturer in defense of breach of contract and Consumer Protection Act claims and in support of counterclaims for trade secret misappropriation. We obtained summary judgment for our client, dismissing the Consumer Protection Act claim, and we defeated the plaintiff's summary judgment motion seeking dismissal of trade secret claims.

Hodgson Russ successfully litigated the case *BellSouth Corp. v. White Directory Publishers*, 42 F. Supp. 2d 598. The court concluded that the "walking fingers" symbol is in the public domain and is therefore not a trademark, granting our client's motion for summary judgment.

Hodgson Russ defended two banks from patent infringement allegations by non-practicing entities. Our attorneys analyzed the patents for invalidity and non-infringement. Based on this analysis, our clients negotiated favorable settlements.

Hodgson Russ attorneys defended an Internet marketing company against patent infringement allegations in the Eastern District of Texas (Marshall Division). The plaintiff was a patent assertion firm. The subject patent related to pop-up advertisements on the Internet. Hodgson Russ attorneys were able to persuade the plaintiff to discontinue the lawsuit.

Hodgson Russ attorneys are actively defending a pharmaceutical marketing company from claims of patent infringement. We initiated *inter partes* reexamination to invalidate the alleged patent. Based on our arguments, the U.S. Patent and Trademark Office held the alleged patent invalid. The USPTO decision is currently under appeal.

Hodgson Russ represented a developer and marketer of pharmaceutical co-pay offset programs as a defendant in patent infringement litigation in U.S. District Court for the District of New Jersey. Hodgson Russ placed the patent in re-examination before the U.S. Patent and Trademark Office and obtained rejections of all asserted claims.

Hodgson Russ provided litigation support defending a client in a multiparty patent infringement litigation involving amusement park rides. Our attorneys worked directly with counsel for the co-defendants to formulate a patent claim construction and Markman hearing strategy. A favorable settlement was reached following the Markman order.

Hodgson Russ intellectual property and litigation attorneys defended a manufacturing client in a patent infringement lawsuit involving automated fabric-cutting machines. Our attorneys prepared strong non-infringement positions early in the litigation to help our client reach an early and favorable settlement.

A multidisciplinary team of Hodgson Russ intellectual property and litigation attorneys worked together on behalf of a plaintiff to commence a patent infringement lawsuit involving automated fastening systems for aircraft assembly. Our attorneys attended mediation that resulted in a settlement agreement in which the defendant pledged to stop offering infringing systems.

Hodgson Russ intellectual property and litigation attorneys defended a client in a patent infringement lawsuit involving package-tracking devices. Our team of attorneys formulated non-infringement positions and participated in settlement conference to help our client reach an early and favorable settlement.

Hodgson Russ represented a leading provider of DNA-based diagnostic services in two patent infringement lawsuits concerning patents used for testing canine DNA for genetic disorders. The first suit, against an offshore testing enterprise and a large research university, was settled favorably for our client. The second suit, against a Florida-based genetic testing

## INTELLECTUAL PROPERTY LITIGATION

company, was also resolved favorably.

Commenced enforcement action for copyright infringement in the Southern District of NY in connection with artwork on tableware and successfully defeated motion to dismiss.

In *Nulux, Inc. v. Litelab Corporation et al.*, Civ. No. 1:01-cv-03023 (E.D.N.Y. 2008), the court ruled in favor of our client, deciding against the plaintiff's claims of trade dress infringement with respect to high-end retail architectural lighting.

In *American Medical Rehabilitation Providers Association v. University at Buffalo Foundation Activities, Inc.*, 2008 TTAB Lexis 509, the U.S. Patent and Trademark Office Trademark Trial and Appeal Board (TTAB) determined favorably for our client that FIM and FIM SYSTEM are not generic and are therefore registrable by our client as trademarks.

### **In the News**

Gary Schober Gives Insight to Wegmans' Discontinuation of SCAN App  
*WGRZ*, September 15, 2022

IP Law Association Honors Skretny at Mock-Trial Event  
*Buffalo Law Journal*, October 12, 2015

Jessica L. Copeland Quoted on Lessons From *TiVo v. EchoStar - Intellectual Property Law* 360  
April 21, 2011

### **Press Releases**

71 Hodgson Russ Attorneys Ranked in 2023 Edition of *Best Lawyers in America*  
*Hodgson Russ Press Release*, August 19, 2022

Hodgson Russ Receives Top Tier National and Metropolitan Rankings in 2022 Best Law Firms Listings  
*Hodgson Russ Press Release*, November 15, 2021

Hodgson Russ Earns Five National-Level Rankings in *U.S. News & World Report/Best Lawyers 'Best Law Firms' Report*  
*Press Release*, November 18, 2015

### **Publications**

Supreme Court Resolves Split Among The Circuits: No Time Limits on Monetary Recovery for any Timely Copyright Infringement Claim  
*Hodgson Russ Intellectual Property Litigation Alert*, May 15, 2024

The Battle After *Warhol*: Tattoos as Artwork or Infringement?  
*Hodgson Russ Intellectual Property Litigation Alert*, April 24, 2024

## INTELLECTUAL PROPERTY LITIGATION

AI Lawsuit May Eclipse Claims of Fair Use

*Hodgson Russ Intellectual Property Litigation Alert*, April 5, 2024

Music Copyrights on a Roll – Read and Listen to Hear the Latest

*Hodgson Russ Intellectual Property Litigation Alert*, October 6, 2023

Taco Bell Throws Its Hat in the Ring to Free “Taco Tuesday” from Trademark Protection

*Hodgson Russ Intellectual Property Litigation Alert*, May 30, 2023

Copyright Claims of Cosmetic Company Continue to Trial

*Hodgson Russ Intellectual Property Litigation Alert*, March 23, 2023

Luxury Fashion Designer Earns Its Stripes In Trademark Victory Against adidas

*Hodgson Russ Intellectual Property Litigation Alert*, January 27, 2023

Court Ruling Simplifies Service Upon Foreign Trademark Infringers

*Hodgson Russ Intellectual Property Litigation Alert*, December 20, 2022

Fortnite Crushes Choreographer’s Copyright Claims

*Hodgson Russ Intellectual Property Alert*, November 28, 2022

Professional Sports Leagues Filing Lawsuits for Improper Use of Trademarks

*Hodgson Russ Intellectual Property Litigation Alert* , October 31, 2022

## **Presentations & Events**

What Nordic Companies Need to Know to Protect Their Intellectual Property Interests in the U.S.

November 8, 2018

Let Your Assets Shine: Diamonds, Jewelry, Patents, Trademarks™, and Copyrights ©

New York Diamond Dealers Club, 580 5th Ave, New York, NY, March 16, 2016

Avoiding (and Surviving!) Contract Disputes – Common Pitfalls of Contract Drafting That Land You in Court

February 11, 2016

New York Intellectual Property Law Association CLE: Patent Damages

Buffalo, NY, October 12, 2015

In-House Counsel Update on Intellectual Property Litigation 2012

Buffalo, NY, March 29, 2012

In-House Counsel Update on Intellectual Property Litigation 2011

Buffalo, NY, October 6, 2011

In-House Counsel Update on Intellectual Property Litigation 2010

November 18, 2010

*In re Bilski’s* Impact on Patent Protection



INTELLECTUAL PROPERTY LITIGATION

Buffalo, NY, September 2, 2010

