

Patent

Wiley's Patent Practice has built a 30-year record of obtaining successful outcomes for clients from a wide array of industries. We have considerable experience in representing both accused infringers and, in certain circumstances, patent holders in high-profile and high-stakes patent disputes. Our full-service Practice provides patent litigation, prosecution, and strategic counseling on IP licensing, due diligence, and portfolio development and valuation.

Our Practice garnered international attention following the historic settlement we secured for NTP, Inc., in a patent infringement case against the manufacturer of BlackBerry wireless devices. The settlement was one of the largest of its kind and resolved a fiercely contested case that, as noted by one media outlet, "captured the attention of Wall Street, the Supreme Court, and the governments of both Canada and the United States."

Our Team

Widely recognized for their ability to handle complex patent matters, our attorneys draw on an uncommon combination of legal knowledge, technical expertise, and litigation skill to assist clients in achieving their business objectives related to patent law matters. Our team members boast extensive and diverse academic and professional backgrounds that enable them to represent clients in virtually all applicable fields of science and engineering. Particularly, we possess strong expertise in technology related to the Internet, satellite and wireless communications, computer software and hardware, consumer electronics, semiconductors, biotechnology, pharmaceuticals, and medical devices.

Wiley advises clients from a diverse range of high-tech industries, including biotechnology, pharmaceuticals, telecommunications, and consumer electronics. Both domestic and international clients have said that they choose Wiley for our ability as a Washington, DC law firm to uniquely combine our knowledge of the U.S. court system with the legal and political landscape. As a DC-based firm, our experience and capabilities in the U.S. Court of Appeals for the Federal Circuit, U.S. District Court for the Eastern District of Virginia, U.S. Court of Federal Claims, and Patent Trial and Appeal Board (PTAB) are top-notch. However, our practice is national, and we have extensive experience in every district court in the United States known for patent litigation – including courts in Texas, Delaware, California, Florida, New York, and New Jersey.

Many of our attorneys clerked for judges in district courts or the Federal Circuit. All of our patent litigators hold engineering or science degrees, including many advanced degrees.

Our Approach

We are trial lawyers and counselors specializing in patent cases. Our approach is to prepare a case with the expectation that it will go to trial while also pursuing more efficient avenues to resolve the case, including strategic motions practice, the use of mediation or arbitration, and PTAB proceedings.

Our intensive preparation and dedication to staffing matters leanly and efficiently allows us to provide cost-effective representation to our clients. Unlike some of our highly leveraged peer firms, we staff cases with a small team of experienced attorneys who are fully immersed in the facts. With the full resources of our large firm behind us, we can increase staffing as needed, but the core team will handle the issues that we believe to be dispositive. This lean staffing model allows us to provide cost-effective representation to clients ranging from Fortune 500 corporations and segment-leading companies to startup and midcap ventures – usually at overall rates that are far more competitive than those of our peer firms.

Selected Experience

A sample of significant representations includes:

Technology/Software

- Representing a large nationwide telecommunications carrier in numerous multi-defendant patent infringement actions in the Eastern District of Texas, Northern District of California, District of Delaware, and Eastern District of Virginia in lawsuits pertaining to text messaging, wireless modems, and other cellular phone features. Notable cases include obtaining a jury verdict patent invalidity and non-infringement in the Eastern District of Virginia in a case in which the plaintiff sought \$140 million in damages.
- Representing ARM in numerous lawsuits where its customers have been sued for using ARM processor cores in their chipsets. Includes, for example, a victory in the Eastern District of Texas and affirmed by the Federal Circuit.
- Representing TomTom in numerous infringement lawsuits filed by non-practicing entities in courts across the country, including in the Northern District of Illinois, District of Delaware, Eastern District of Virginia, District of Nevada, and Eastern District of Texas. In one notable case, we obtained summary judgment of invalidity against a widely licensed patent involving touchscreen keyboards.
- Securing a victory for Atico International USA, Inc., and Target Corporation in defense of claims of patent infringement pertaining to digital picture frames filed by Digital Spectrum Solutions, Inc. (DSSI) in the Central District of California. The court construed the claims of the asserted patent and simultaneously granted Atico's motion for summary judgment of no literal infringement and no infringement under the doctrine of equivalents.
- Securing, on behalf of patent holder NTP Inc., a \$612.5 million patent infringement settlement with Research In Motion Limited (RIM), the maker of BlackBerry wireless email devices. The settlement, one of the largest ever of its kind, resolved a fiercely contested, high-profile patent case stemming from a

2002 jury trial in which the firm successfully argued that RIM's core BlackBerry line of wireless email products, software, and services willfully infringed NTP patents.

- Representing multiple financial institutions in patent infringement actions involving electronic imaging, transmission, and presentation of financial documents, bankcard processing systems, encrypting financial transactions, and other Internet and business methods.
- Securing a victory in the District of New Jersey for Molson Coors Brewing Company (MCBC) in defense of claims of patent infringement pertaining to computer-implemented methods and systems for investors to obtain mutual funds in a foreign currency by swapping rights with a willing co-investor in another country.

Pharmaceuticals

In the pharmaceutical patent infringement and Hatch-Waxman context, we have been involved in litigations concerning the following products:

- Acetaminophen IV (Ofirmev®)
- Allopurinol (Zyloprim®)
- Aripiprazole (Abilify®)
- Bendamustine (Treanda®)
- Bortezomib (Velcade®)
- Carbidopa/Levodopa (Sinemet® CR)
- Cetuximab (Erbix®)
- Cyclobenzaprine HCl (Amrix®)
- Dextromethorphan/Quinidine (Nuedexta®)
- Doxycycline Hyclate (Doryx®)
- Dutasteride (Avodart®)
- Erlotinib (Tarceva®)
- Fenofibrate (Antara®)
- Fesoterodine (Toviaz®)
- Gabapentin (Gralise®)
- Interferon (Roferon®-A)
- Levofloxacin (Levaquin®)
- Loratadine (Claritin®)
- Micronized Glyburide (Glynase®)
- Omeprazole (Prilosec®)

- Oxybutynin Chloride (Ditropan XL®)
- Romidepsin (Istodax®)
- Tamoxifen Citrate (Nolvadex®)
- Tolterodine Tartate (Detrol® LA)
- tPA (Activase®)

Representative successes include:

- Securing a victory at trial for clients Mylan and Esteve in their defense of a protracted patent infringement litigation brought by AstraZeneca in the Southern District of New York concerning Mylan/ Esteve's generic omeprazole product equivalent to Astra's Prilosec® product.
- Representation of Impax Pharmaceuticals in the District of New Jersey in *Warner Chilcott v. Impax*, where the district court decided that the patent-in-suit was not infringed by Impax's generic Doryx product and the Federal Circuit summarily affirmed in 2012.
- Securing a victory at trial and subsequent appeal in *Alza v. Mylan*, a rare obviousness invalidation of a patent protecting the blockbuster drug oxybutynin chloride (Ditropan XL®) in a matter that the Federal Circuit used as a template for explaining its obviousness law.
- Representing a major U.S. biopharmaceutical company in patent actions before the District of Massachusetts and Federal Circuit involving a major cancer treatment drug.
- *Schering Corp. v. Zenith Goldline Pharms. Inc.*: Successfully represented Zenith Goldline in an infringement action brought by Schering in the District of New Jersey. This was a multi-defendant consolidated case involving the antihistamine drug Claritin® (loratadine). Wiley, in cooperation with co-defendants, obtained summary judgment of invalidity for Zenith, which was affirmed on appeal.

Licensing, Due Diligence and Intellectual Property Valuation

The firm assists clients in the licensing, sale, and purchase of patents and technology related thereto. Also, in connection with clients' purchase of assets, the firm evaluates the intellectual property portfolio, including the validity of the patents being acquired, whether or not others are currently infringing the technology, and the clients' vulnerability to others' patented technology, and analyzes potential litigation outcomes.

Patent Trial and Appeal Board

The Patent Trial and Appeal Board (PTAB), formed in 2012 as a part of the America Invents Act, decides important issues of patentability. The PTAB provides several ways to contest patents, including *inter partes* reviews (IPRs), post-grant reviews (PGRs), covered business method reviews (CBMs) and derivation proceedings.

These proceedings give parties cost-effective methods of challenging an issued patent based on prior art patents and printed publications. These are intended to be a less expensive and faster option for post-grant patent challenges, with initial determinations within six months of filing and a final decision within 12 months.

Wiley attorneys and advisors work with clients on a comprehensive patent strategy that spans from inception to well beyond grant. Our attorneys have been deeply involved in the PTAB – and previously the Board of Patent Appeals and Interferences (BPAI) – and have assisted clients in numerous IPRs, PGRs, and CBMs, and have one of the best-known teams available to assist clients in future PTAB matters.

Additionally, we have experience filing requests for *ex parte* reexamination. These proceedings can be a valuable strategic tool, allowing companies to challenge competitors' patents with relative anonymity and without risk of estoppel that accompanies *inter partes* proceedings. Patent owners contemplating litigation or licensing may also use *ex parte* reexamination as a tool to refine claims and avoid prior art.

IPR Experience

Since the introduction of IPRs in 2012, Wiley has assisted with more than 30 IPR proceedings, involving telecommunications hardware and software, semiconductors and microprocessors, and pharmaceutical formulations and compounds. Our experience includes advising clients on IPR strategies as part of our comprehensive, business-focused patent strategy.

Our representative IPR experience includes:

- Assisted a major U.S. financial institution in preparing and filing IPR petitions related to data security patents used in connection with online banking.
- Assisted a major U.S. corporation in preparing and filing IPR petitions related to wireless cell phone technologies.
- Assisted our client in preparing and filing IPR petitions related to virtual memory for a processor.
- Assisted our client and co-counsel in preparing and filing IPR petitions related to LED lighting technologies.

CBM Reviews

Our representative CBM experience includes:

- Drafted and filed, on behalf of a major U.S. bank, the first-ever CBM review filed at the PTAB by a financial institution. The PTAB found the patent-at-issue unpatentable.
- Assisted a major U.S. financial institution in preparing and filing CBM petitions related to data security patents used in connection with online banking.

Patent Prosecution

The firm files and prosecutes patent applications in the United States and around the world. Our Patent attorneys have working experience in a wide variety of high-tech industries, including electrical, chemical, biotechnology, pharmaceutical, software, bioinformatics, Internet, and mechanical, as well as e-commerce and other business methodologies.

International Trade Commission Section 337 Proceedings

Our attorneys are experienced in representing clients in patent infringement proceedings before the U.S. International Trade Commission (USITC) under Section 337 of the Tariff Act, which is designed to prevent the entry of infringing goods into the United States and to provide a resolution on an expedited schedule – typically within 12 months. We regularly serve clients in these specialized proceedings by successfully combining our expertise in international trade, intellectual property, and other fields, becoming especially active in bringing 337 actions against parties engaged in selling infringing pharmaceuticals over the Internet. Among our additional successes was a prominent victory in a case involving novel microwave filters on satellites that, based upon their light weight, enabled increased satellite life.

The firm’s capabilities in representing clients during these accelerated proceedings are extensive and widely recognized, with John R. Shane being rated as a “Leading Lawyer” by *Chambers USA*.

In this arena, we have:

- Represented Lilly ICOS LLC as a complainant in an investigation involving Cialis® (*In the Matter of Certain Tadalafil of Salts and Solvates Thereof, and Products Containing Same*). Our firm obtained a general exclusion order against infringing importation of the chemical in Cialis®.
- Represented Pfizer Inc. as a complainant in an investigation involving Viagra® (*In re Matter of Sildenafil or any Pharmaceutically Acceptable Salt thereof, and Products Containing Same*). Our firm obtained a general exclusion order prohibiting all infringing imports, regardless of source, the most favorable outcome possible for a complainant in a Section 337 investigation.
- Represented Atico International USA, Inc., as a respondent, in an investigation involving batteries (*In re Matter of Certain Zero-Mercury Added Alkaline Batteries*). The case was favorably settled before trial.
- Represented Space Systems/Loral in a patent infringement action before the USITC and obtained the equivalent of a preliminary injunction against Com Dev involving novel dual-mode dielectric microwave filters on satellites that, based upon their light weight, enabled increased channel capacity and/or fuel storage on the satellites.
- Successfully defended Berwick Industries in a patent infringement proceeding brought by 3M regarding gift-package bows that are shipped in flat packages to avoid damage and blossom into perfect bows on arrival when their strings are pulled (*In re Pull-String Bows*).
- Prepared a 337 complaint for a company owning a food-related patent, which was instrumental in resolving the dispute before an investigation was declared (resolution involved the sale of a product division to the accused infringer).
- Represented a European chemical company that was accused of infringing multiple patents and misappropriating trade secrets relating to plastic food casings; presented antitrust defenses; and subsequently settled the case on a favorable basis.
- Represented a Japanese semiconductor company accused of importing infringing memory devices. After investigation, the complaint was dismissed and refiled as a patent infringement case in U.S.

District Court, where our client prevailed on the basis of an antitrust defense.

- Represented respondents accused of infringing design patents covering aspects of the Ford F-150. Resulted in the introduction of the Access To Repair Parts Act (H.R. 3059), which sought to exempt repaired components from design patent infringement. *In the Matter of Certain Automotive Parts.*
- Represented two respondents through trial in defending against allegations of patent infringement relating to three patents covering computer forensic devices. Prevailed on an Initial Determination finding no domestic industry. *In the Matter of Certain Computer Forensic Devices and Products.*
- Represented complainant in a patent infringement action relating to baby strollers and playards. Case settled favorably while summary determination motions were pending. *In the Matter of Certain Strollers and Playards.*
- Represented complainant as lead counsel in a USITC patent infringement action relating to handheld underground cable and pipe locators. The parties reached a global settlement during the investigation. *In the Matter of Certain Underground Cable and Pipe Locators.*

Contact Us

Neal Seth

202.719.4179 | nseth@wiley.law