

Deepro R. Mukerjee

Partner and Chair, Intellectual Property Department

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Practices

FOCUS: Intellectual Property
Intellectual Property Litigation
Patent Litigation and Patents
Pharmaceutical and Life Sciences Litigation

Industries

Pharmaceutical and Life Sciences

Education

JD, Fordham University School of Law
BS, Fordham University, *summa cum laude*
BA, University of Oxford

Bar Admissions

New York

Court Admissions

US Court of Appeals, Federal Circuit
US District Court, Southern District of New York
US District Court, Eastern District of New York
US Patent & Trademark Office

Community Involvements

American Intellectual Property Law Association
New York Intellectual Property Law Association

Deepro R. Mukerjee is chair of Katten's global Intellectual Property practice and is a member of the firm's Board of Directors. Multi-billion dollar corporations, a major academic institution and some of the largest generic pharmaceutical companies in the world call on Deepro for their respective IP needs – particularly when it comes to complex or high-stakes litigations. Deepro is a first chair litigator, having tried numerous patent trials over his 20-year career. His cases are often featured by media outlets throughout the country.

Intellectual Property Litigation and IP Corporate Transactions

Deepro has been lead trial counsel in dozens of cases, often taking them to trial and subsequent appeals. He is also experienced at managing *inter partes* review proceedings before the Patent Trial and Appeal Board. While he is often noted for his successes in Hatch-Waxman litigations, Deepro's litigation experience is far more expansive and covers matters related to product manufacturing, biotechnology, botanicals, business methods, web-related services and voice recognition software.

In addition to his substantial litigation experience, Deepro often provides patent-centric due diligence and other intellectual property counsel to multinational clients in connection with transactions such as public offerings and venture capital financings. He also advises companies on how to best leverage their IP portfolios in connection with spin outs and exit strategies. A recognized industry leader, Deepro had been named to the *IAM 1000* leading world-wide patent practitioners list for eight years in a row and was designated an "IP Star" by *Managing Intellectual Property* for the second consecutive year in 2021.

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"Deepro is really solution-oriented; he comes up with multiple solutions for you and whichever you select, he helps you execute." "He is a natural leader, a strategic thinker, and an all-around extremely talented litigator." "Deepro is a fantastic attorney, brilliant strategist and a formidable adversary."

*- Chambers USA 2022
(New York, Intellectual Property: Patent) survey response*

Representative Experience

- Lead trial counsel for some of the world's largest generic pharmaceutical companies in over a dozen currently pending Hatch-Waxman litigations throughout the country.
- Counsel for a multi-billion dollar global provider of blood and plasma supplies and services, including patent portfolio development and strategy.
- Counsel for an international world leader in voice software, and specifically voice capture for leading organizations across financial, contact center, government and public safety sectors. We have served as lead trial counsel in litigation and also provide patent development support and strategy.
- Counsel for one of the world's largest career service providers linking job seekers to employers and vice versa. We have served as lead trial counsel in multiple litigations and routinely handle cross-border transactional IP and corporate matters.
- Counsel for not-for-profit multi-type library consortium on all legal matters, including licensing, contracting, and IP protection.
- Lead trial counsel in an infringement dispute regarding multiple patents for topical foam acne treatment Evoclin®. Defendant Glenmark Pharmaceuticals filed antitrust counterclaims in response. Successfully dismissed all such counterclaims.
- Co-counsel in US District Court for New Jersey involving multiple patents directed to a dipeptidyl peptidase-4 inhibitor and its use for treatment of Type II diabetes. Obtained favorable judgment at the district court level followed by an affirmance of invalidity of two patents as lead counsel on appeal.
- Lead trial counsel for premier processor and distributor of amniotic surgical tissue grafts in breach of contract and tortious interference case in the US District Court for the District of Maryland.

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- Lead trial counsel for one of the world's largest fresh produce distributors in a plant patent litigation in the US District Court for the Southern District of Florida. Obtained an apology from plaintiff for bringing the suit in the first place and a dismissal of all claims brought against the client. Also obtained acknowledgment that a client had an unrestricted right to practice the invention claimed in the plant patent all along.
- Lead trial counsel in the District of Delaware involving a patent associated with the treatment of the pain of osteoarthritis of the knees. Obtained summary judgment that our client had a license to the asserted patent within six months of the complaint being filed.
- Lead trial counsel in the US District Court for the District of Delaware involving multiple patents associated with pre-colonoscopy cleansing using sodium picosulfate, magnesium oxide and anhydrous citric acid. Obtained Judgment of Non-infringement on both asserted Orange Book patents and attorneys' fees with respect to a third patent.
- Lead trial counsel in the US District Court for the District of Delaware involving a patent related to chronic lymphocytic leukemia using bendamustine. Obtained non-infringement judgment after trial before the district court.
- Lead trial counsel in US District Court for the District of Delaware involving patent that purports to be related to treatment of deep vein thrombosis using rivaroxaban.
- Lead trial counsel in US District Court for the District of Delaware involving multiple patents associated with treatment of early-stage idiopathic Parkinson's disease and moderate-to-severe restless legs syndrome using rotigotine.
- Lead trial counsel for one of the world's largest fresh produce distributors in a breach of contract, trade dress infringement and fraud on a US Patent and Trademark Office case in the US District Court for the Central District of California. Obtained a favorable settlement, with defendant assigning the US Registration and EU Registration for the mark MANGO PRO to our client.

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- Lead trial counsel in US District Court for the District of Delaware involving multiple patents associated with treatment of irritable bowel syndrome with constipation, and chronic idiopathic constipation using linaclotide.
- Lead trial counsel in US District Court for the District of Delaware involving multiple patents associated with the treatment of major depressive disorder using vortioxetine hydrobromide.
- Lead trial counsel in US District Court for the District of Delaware involving a patent associated with the treatment of HIV-1 infection in adults and pediatric patients weighing at least 40 kg using dolutegravir or abacavir, dolutegravir and lamivudine.
- Lead trial counsel for leading online provider of employment-related services in patent infringement action in the US District Court for the Southern District of California. Successfully argued a case-dispositive *Markman* hearing which led to favorable settlement.
- Lead trial counsel for sponsorship-driven, social-media marketer in patent litigation in the US District Court for the Eastern District of Texas. Obtained a stay by petitioning the USPTO to accept a covered business method petition on several of the asserted patents.*

*Experience prior to Katten

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Recognitions

Recognized or listed in the following:

- *ANDA Litigation Intelligence Report*
 - Best Performing ANDA Attorneys overall (representing Plaintiffs or Defendants), 2020–2021
 - Best Performing ANDA Attorneys representing Defendants, 2020–2022
 - Top 100 Most Active ANDA Attorneys overall (representing Plaintiffs and Defendants), 2020–2022
 - Top 100 Most Active ANDA Attorneys representing Defendants, 2020–2022
- *BTI Client Service All-Stars*
 - 2020 and 2021
 - 2022, Elite MVP All-Stars
- *Chambers USA*
 - Intellectual Property: Patent, 2022
- *IAM Patent 1000*
 - Recognized Individual, 2014–2021
 - Silver – Individual: Litigation, New York, 2022
- *Managing Intellectual Property*
 - IP Star – Patent, 2019–2022
 - IP Stars Handbook, 2019–2021
 - Litigator of the Year, New York – Finalist, 2022
- *The American Lawyer*
 - Northeast Trailblazer, 2022
- *The Legal 500 United States*

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- Recommended Attorney, 2022

News

- Katten Intellectual Property Team Secures Significant Victory for Apotex in Hatch-Waxman Litigation (November 1, 2022)
- Katten Intellectual Property Group Grows With Advertising Litigator (October 26, 2022)
- *Law.com* Profiles Deepro Mukerjee's Path to Intellectual Property Department Chair (August 25, 2022)
- Katten Ranks Among Top Three Most Active Law Firms in ANDA Litigation (August 22, 2022)
- Katten Lauded in *IAM Patent 1000 2022* (June 29, 2022)
- Katten Awarded Top Ranking in Structured Finance: Securitization in The Legal 500 United States 2022 (June 8, 2022)
- Deepro Mukerjee Honored as a 2022 "Northeast Trailblazer" by *The American Lawyer* (June 3, 2022)
- Katten Ranked Leading Law Firm by *Chambers USA 2022* (June 1, 2022)
- *Managing Intellectual Property* Recognizes Seven Katten Attorneys as 2022 IP Stars (May 27, 2022)
- Katten's Deepro Mukerjee Named a 2022 BTI Client Service All-Star (February 10, 2022)
- High Court Delays Mulling Apple, Mylan Fintiv Challenges | *Law360* (November 24, 2021)
- Report: The Best Hatch-Waxman Law Firms of 2021 | *IP Watchdog* (October 18, 2021)
- Generics Group, Intel Back Mylan's Fintiv Fight At High Court | *Law360* (September 14, 2021)

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- Katten Ranked in Top Five Most Active Law Firms for ANDA Litigation (August 23, 2021)
- Katten Appoints New Practice Heads, Building on Stellar Leadership (July 15, 2021)
- Katten Ranked Best in Intellectual Property by Managing IP Stars 2021 (July 7, 2021)
- Katten Attorneys Named Leaders in Patent Law by *IAM Patent 1000* (July 6, 2021)
- Katten Client Mylan Wins Patent Infringement Case Regarding Parkinson's Drug Treatment (June 11, 2021)
- Deepro Mukerjee Talks to *Law360* on the Federal Circuit Court's Increasing Diversity (April 26, 2021)
- Katten Partners Praised for Outstanding Client Service (December 10, 2020)
- Deepro Mukerjee Talks to *Bloomberg Law* About His IP Practice and How the COVID-19 Pandemic Has Altered Litigation and the Industry (November 20, 2020)
- Katten Named Among Top Three Best Performing Law Firms for ANDA Litigation (August 19, 2020)
- Katten Attorneys Named Leaders in Patent Law by *IAM Patent 1000* (June 22, 2020)
- Generics' 2nd Challenge To Acne Drug IP Succeeds At PTAB (June 2, 2020)
- MDL Won't Stop PTAB From Reviewing Merck Diabetes Patent (May 13, 2020)
- Katten Ranked Best in Intellectual Property by Managing IP Stars 2020 (May 1, 2020)
- Fed. Circ. Revives Boehringer Diabetes Drug Patent (March 16, 2020)
- Katten Intellectual Property Partner Featured in Patent Industry Report (August 29, 2019)

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- Katten Attorneys Win Dismissal of Avocado Patent Lawsuit (June 12, 2019)
- Deepro Mukerjee Quoted in *Law360* Regarding Plant Patent Infringement Win (June 11, 2019)
- Katten Attorneys Recognized as 2019 Managing IP Stars (May 30, 2019)
- Katten Draws Top IP Litigation Talent with Broad Pharma Experience (May 7, 2018)
- Noah Heller Comments on Addition of New IP Litigator and 29 Lateral Partners in 2018 (April 18, 2018)

Publications

- Pre-ANDA Litigation: Strategies and Tactics for Developing a Drug Product and Patent Portfolio, Third Edition (July 15, 2022)
- Whether Obviousness Type Double Patenting Can Be Used to Invalidate Patents That Expire Later Because of Patent Term Adjustment (July 12, 2021)
- Don't Fear IP-Antitrust 'Turducken' in Reverse-Payment Cases (November 24, 2020)
- The Balance Between Obviousness and Written Description — Lessons Learned from Recent Decisions (August 5, 2020)
- California Enacts "Reverse-Payment" Law Aimed at Patent Settlements — An Initial Look ... Assuming It Is Upheld (May 19, 2020)
- Supreme Court Declines To Disturb Pre-AIA Interpretation of "On Sale" Bar (January 25, 2019)

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Presentations and Events

- 17th Annual Paragraph IV Disputes Conference (April 26–27, 2022) | *Speaker* | *The Business of PIV Disputes — Cross-Border Business Considerations in a Hatch-Waxman Scenario: Masterfully Managing Global Litigation*
- 15th Annual Paragraph IV Disputes (April 26–27, 2021) | *Panelist* | *The Economics and Economy of Drug Patents with ACI's Hatch-Waxman Series Advisory Board Members: Optimizing Product Selection, Identifying Targets for Litigation and Monetizing IP Portfolios*
- 14th Annual Paragraph IV Disputes (October 6–7, 2020) | *Panelist* | *In-House Perspectives on The Future of IP Teams and Working with Outside Counsel*