

Lance A. Soderstrom

Partner and Co-Chair, Patent Litigation

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Practices

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

Education

JD, University of Michigan Law School
MS, University of Michigan, Pharmaceutical Engineering
BSE, University of Michigan

Bar Admissions

New York

“Lance is an excellent patent litigator. His work is always of the highest quality, he is very responsive and is a pleasure to work with.”

- IAM Patent 1000 2023 (Patent Litigation) survey response

Lance A. Soderstrom is Co-Chair of Katten's Patent Litigation practice. Over his career, Lance has litigated hundreds of patents in jurisdictions across the country relating to a range of technologies, from pharmaceutical compounds to medical devices to computer software programs. Lance is a nationally recognized trial litigator and is sought out by clients for his efficiency, reliability, responsiveness, and ultimately, repeated success.

Litigation and regulatory counsel

Lance has substantial experience in the drug approval process, including the development of patent strategies to assist clients in marketing drug products and evaluating competitive patents. He is also often asked to provide intellectual property advice to multinational corporate clients in better leveraging existing and newly constituted IP portfolios.

Lance brings a decade of experience and a list of successes to future representations. Clients seek him out for his expertise in the pharmaceutical industry and patent litigation generally. Lance has earned successful results in Hatch-Waxman cases involving treatments for acne, pre-colonoscopy cleansing, ulcerative colitis and Type 2 diabetes, among others. Outside of the Hatch-Waxman space, he has obtained victories in patent infringement, copyright infringement and false advertising cases related to call-recording technology, online career services, prenatal folates and other innovations.

Lance has served as a guest lecturer at the University of Michigan's College of Engineering, lecturing on technology innovation, Hatch-Waxman litigations, personalized medicine and regulation. He has also lectured at Columbia Business School on topics including patent, trademark, copyright and trade secret protections.

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Representative Experience

- Lead trial counsel for some of the world's largest generic pharmaceutical companies in several Hatch-Waxman litigations throughout the country.
- Counsel for a global provider of blood and plasma supplies and services, including patent portfolio development and strategy.
- Counsel for a 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.
- Counsel for the implantable medical device business line of a global materials science company.

Notable Achievements

- Lead trial counsel in the Northern District of West Virginia involving two patents related to the treatment of severe pulmonary arterial hypertension. Obtained a reversal of an unfavorable claim construction decision before the Federal Circuit and then obtained a trial decision of non-infringement on remand.
- 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 from the bench before even presenting our invalidity defense. Obtained a Rule 36

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affirmance of that judgment on appeal days after oral argument was heard.

- 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 for Mylan in 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 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 our client. Also obtained acknowledgment that our client had an unrestricted right to practice the invention claimed in the plant patent all along.
- 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.

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- 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.
- 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.
- Counseled leading online provider of employment-related services in a patent infringement action in the US District Court for the Southern District of California.*
- Counseled leading producer of pharmaceutical and dietary ingredients in false advertising litigations in the US District Court for the Southern District of New York and the US Court of Appeals for the Second Circuit. Obtained judgment in our client's favor, were awarded attorneys' fees, and judgment was affirmed on appeal.*

*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, 2023
 - Best Performing ANDA Attorneys Representing Defendants, 2020–2021; Top 20, 2023
 - Most Active ANDA Attorneys Overall (Representing Plaintiffs and Defendants), Top 100, 2020–2022; Top 10, 2023
 - Most Active ANDA Attorneys Representing Defendants, Top 100, 2020–2021; Top 5, 2022; Top 1, 2023
- IAM Patent 1000
 - Bronze – Individual: Litigation, New York, 2022–2023
- *Managing Intellectual Property*
 - IP Star - Patent, 2022–2023

News

- Katten's IP Litigation Team Prevails at Trial, Securing Patent Win for Mylan Pharmaceuticals (March 15, 2024)
- Precedent-Setting Patent Win in Federal Circuit Creates Media Buzz From *Bloomberg Law*, *Reuters*, and More (November 7, 2023)
- Katten Ranked Top Three Firm in Hatch-Waxman Litigation (September 5, 2023)
- *Managing Intellectual Property* Recognizes Katten IP Stars (June 29, 2023)

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- Katten IP Practice Lauded in *IAM Patent 1000* (June 29, 2023)
- Fed. Circ. Won't Revive Parkinson's Drug Patent | *Law360* (April 12, 2023)
- Federal Court Awards Precedent-Setting Victory to Katten Client Apotex in Patent Infringement Dispute (November 9, 2022)
- Katten Intellectual Property Team Secures Significant Victory for Apotex in Hatch-Waxman Litigation (November 1, 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)
- *Managing Intellectual Property* Recognizes Seven Katten Attorneys as 2022 IP Stars (May 27, 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)
- Katten Ranked in Top Five Most Active Law Firms for ANDA Litigation (August 23, 2021)
- Katten Client Mylan Wins Patent Infringement Case Regarding Parkinson's Drug Treatment (June 11, 2021)
- Katten Named Among Top Three Best Performing Law Firms for ANDA Litigation (August 19, 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)
- Fed. Circ. Revives Boehringer Diabetes Drug Patent (March 16, 2020)

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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 Draws Top IP Litigation Talent with Broad Pharma Experience (May 7, 2018)

Publications

- Nonexistent Inventors: A Comparative Review of AI Inventorship Cases | *Intellectual Property & Technology Law Journal* (February 2023)
- 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)
- The Balance Between Obviousness and Written Description — Lessons Learned from Recent Decisions (August 5, 2020)
- Supreme Court Declines To Disturb Pre-AIA Interpretation of "On Sale" Bar (January 25, 2019)

Presentations and Events

- Hatch-Waxman and BPCIA Proficiency Series (October 11–27, 2022) | *Panelist*