

# 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. He represents the world's largest generic pharmaceutical companies in Hatch-Waxman cases throughout the country. His work on these critical cases is part of a larger practice advising numerous multi-national companies (pharmaceutical and otherwise) on their respective IP needs – particularly when it comes to "bet the company" litigations. Deepro is a first chair litigator, and has tried bench and jury trials across the country.

## Hatch-Waxman litigation and more

Deepro has been lead trial counsel in dozens of Hatch-Waxman cases, often taking them to trial and subsequent appeals. He is also experienced at handling *inter partes* review proceedings before the Patent Trial and Appeal Board. While his focus is in the pharmaceutical and life sciences arena, Deepro's litigation experience is more expansive and covers matters related to biotechnology, botanicals, electrical circuit interrupting devices 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 seven 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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## Representative Experience

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- Lead trial counsel for some of the world's largest generic pharmaceutical companies in several Hatch-Waxman litigations throughout the country.
- 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 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. Co-counsel for same client in patent infringement action in the US District Court for the District of Alabama.
- 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 the US District Court for the District of New Jersey involving patents associated with the treatment of adults with multiple myeloma using lenalidomide.
- 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.

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- Lead trial counsel in the US District Court for the District of Delaware involving patents associated with the treatment of patients with metastatic colorectal cancer using regorafenib.
- Lead trial counsel in the US District Court for the District of Delaware involving patents associated with a high-dose conditioning treatment prior to hematopoietic progenitor (stem) cell transplantation in patients with multiple myeloma using melphalan for injection.
- 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 in US District Court for the Middle District of Florida involving patent directed to controlled release of mesalamine. Obtained Rule 36 affirmance from US Court of Appeals for the Federal Circuit affirming original trial court victory. Affirmance was entered less than 24 hours after oral argument.
- 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 a patent associated with the treatment of inflammatory and pruritic manifestations of corticosteroid-responsive dermatoses in patients aged 12 years or older using Olux-E®.

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- 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 *Mark man* hearing which led to favorable settlement.
- Lead trial counsel for high-end jewelry designer in copyright infringement matter involving novel questions of law relating to the availability of copyright protection for jewelry designs. Case settled.\*
- 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

## Recognitions

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*Recognized or listed in the following:*

- IAM Patent 1000
  - World's Leading Patent Practitioners, 2016–2021
- *Managing Intellectual Property*
  - IP Star – Patent, 2019–2021
  - IP Stars Handbook, 2019

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- *ANDA Litigation Intelligence Report*
  - Best Performing ANDA Attorneys overall (representing Plaintiffs or Defendants), 2020–2021
  - Top 20 Best Performing ANDA Attorneys representing Defendants, 2021
  - Top 25 Best Performing ANDA Attorneys representing Defendants, 2020
  - Top 100 Most Active ANDA Attorneys overall (representing Plaintiffs and Defendants), 2020–2021
  - Top 100 Most Active ANDA Attorneys representing Defendants, 2020–2021
- BTI Client Service All-Star
  - 2020

## News

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- 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 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)

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- 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)
- 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)

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## Publications

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- 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)

## Presentations and Events

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- 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*