

# Patent Litigation and Patents

## Overview

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Creating and implementing a patent strategy can be daunting. Patents often provide a company's most powerful competitive advantage, protecting current and future revenue streams. However, innovative companies do face competitors and nonpracticing entities with their own patents, which are often of dubious validity or scope. Whether you are inventing or facing patent risk, Katten's counsel covers both patent offense and patent defense.

### Protecting the business value of patents

We have protected clients' innovations and investments in scores of trials and complex transactions, and have even shaped patent law. We also navigate clients through the "patent minefield," assessing risk and challenging patents in court or at the US Patent and Trademark Office when necessary.

Patent owners don't enter litigation lightly, nor do we. To mitigate the uncertainty of lawsuits, we help clients understand what to expect. Our strategies begin with evaluating your business case for protecting disputed patents. We represent multinational and midsize companies, startups, research institutions, and universities with patent and IP protections covering:

- Biotechnology
- Consumer electronics
- Financial services
- Mechanical devices
- Pharmaceuticals and life sciences
- Software and technology
- Telecommunications

### Navigating the patent landscape

Helping clients approach major initiatives strategically is a value-add focus. At the early stage of a project — prior to their commitment to a significant investment — clients often ask for guidance. We answer questions on what type of IP could support the investment. We assess potential risks for the short and long term, and we suggest solutions to mitigate areas of exposure. Katten's experience shapes the practical answers we provide to these informal "what if" questions as we protect you across the complex patent landscape.

## Making your best case from the start

Katten's mastery of technical subjects and trial arts helps your competitive edge endure. Our patent litigators pinpoint the right legal issues. We develop narratives that persuade judges, juries and adjudicators nationwide and internationally.

Building credibility before the court is critical. To make your best case, we may bring in expert witnesses early on, and include nontechnical team members. Their diverse perspectives crystallize arguments and elevate defenses. When multidendant and concurrent patent challenges arise, we leverage the advantages of domestic and international forums to assert clients' rights in issues involving:

- Hatch-Waxman Act
- *Inter partes* and post-grant reviews
- Markman hearings
- Patent infringement and invalidity

## Reducing litigation risks

Experience in trial and appellate courts nationwide, including Illinois, New Jersey and Delaware, and before the Patent Trial and Appeal Board and International Trade Commission, allow us to anticipate budgets at every stage of litigation. To address the impact of litigation on your operations and culture, we communicate clearly and frequently to allay concerns throughout your organization. Katten patent attorneys also add value to transactional due diligence, portfolio valuation and development, and litigation assessments.

## Our Experience

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### ***Pharmaceutical and life sciences***

- Represented research-based pharmaceutical manufacturer in challenging a patent related to an anti-inflammatory medication that often treats acne. Obtained favorable pre-trial *Markman* decision and favorable settlement on the eve of trial.
- Represented global pharmaceutical company Apotex in US District Court for the District of New Jersey and Federal Circuit. Successfully challenged patent covering the use of ofloxacin for ear infections. Invalidated all asserted claims, then recovered several million dollars from a posted bond for an improvidently issued preliminary injunction.
- Represented global pharmaceutical company Apotex in US District Court for the Northern District of Illinois and Federal Circuit. Successfully challenged the patent covering a drug used to treat high blood pressure and angina.

- Litigation in US District Court for the Middle District of Florida involving a patent directed to a controlled release of mesalamine. Obtained Rule 36 affirmance from the US Court of Appeals for the Federal Circuit regarding original trial court victory. Affirmance was entered less than 24 hours after oral argument.
- Co-counsel in US District Court for the District of New Jersey involving multiple patents associated with an adjunct to diet and exercise in type 2 diabetes mellitus. After multi-week trial, received decision in our client's favor invalidating all asserted claims of two separate patents.
- Represented pharmaceutical company in patent litigation regarding an over-the-counter versions of a GERD drug. We took the case over from another firm for trial. After our cross-examination of the inventor and primary expert witness, the brand consented to entry of a final judgment of non-infringement.
- Represented global pharmaceutical company Apotex regarding patent claims—including *Walker Process* fraud, the *Therasense* standard for inequitable conduct and reverse-payment liability theories—in relation to being illegally excluded from the billion-dollar-a-year market for a narcolepsy drug. We established that the relevant patent was invalid, not infringed and procured by fraud. The decision was affirmed on appeal. We then brought the antitrust claims through a four-week jury trial before securing a favorable settlement with the last defendant just before jury deliberations.
- Litigation 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 for both Orange Book patents.
- Represented Mylan in infringement dispute regarding multiple patents for topical foam acne treatment Evoclin®. Defendant Glenmark Pharmaceuticals alleged the filings were "sham litigation" to delay approval of a generic. We persuaded the US District Court for the District of Delaware to dismiss the antitrust counterclaim.
- Represented pharmaceutical company in damages portion of a patent litigation. In district court, successfully held plaintiff to limited damages. Appellate court reversed award of pre-judgment interest.
- Represented pharmaceutical company in US District Court for the Northern District of Illinois and Federal Circuit regarding patent covering competitor's blockbuster blood pressure medication. Successful patent challenge allowed our client to enter the market without being blocked by the brand's PED period.

### ***Software, electronics and technology***

- Represent bank and financial services company in successful PTAB post-grant review defense (and subsequent appeal) regarding covered business methods.
- Represent developer of vascular medical products in patent infringement action regarding stents.
- Represent multinational consumer electronics company in patent infringement action involving navigation systems.
- Represent group of chemical manufacturing companies in patent infringement action against competitor chemical company.
- Represent world leader in shape-adaptive structures in patent infringement and ITC actions involving chemical process.

- Successfully represented multinational electronics manufacturer Kyocera in defense of a patent infringement lawsuit and in *inter partes* review proceedings before the PTAB.
- Represented MedTorque in patent litigation surrounding a medical device. Secured dismissal of one of three asserted patents in a motion to dismiss. Convinced plaintiff to voluntarily drop a second patent. Secured recommendation of summary judgment of non-infringement from magistrate before settling entire matter on favorable terms.
- Lead trial counsel to a provider of online authentication services before the US District Court for the Eastern District of Virginia involving alleged patent infringement of technology for authentication of users on a network. Favorable confidential settlement reached just before trial.
- Defended sportswear company against alleged infringement of fitness-tracking app patents. We convinced a Delaware federal court to dismiss all patent infringement allegations.

## Key Contacts

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## Recognitions

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*Recognized or listed in the following:*

- *ANDA Litigation Intelligence Report*
  - Best Performing Law Firms overall (Representing Defendants or Plaintiffs), 2020-2022
  - Best Performing Law Firms representing Defendants, 2020-2022
  - Top 100 Most Active Law Firms overall (representing Defendants or Plaintiffs), 2020-2022
  - Top 100 Most Active Law Firms representing Defendants, 2020-2022
- *BTI Litigation Outlook*
  - IP Litigation Honor Roll, 2018
- *Chambers USA*
  - Intellectual Property
    - Illinois, 2006–2022
  - Intellectual Property: Trademark, Copyright & Trade Secrets
    - Illinois, 2021-2022
  - Intellectual Property: Litigation
    - District of Columbia, 2021-2022
- *IAM Patent 1000*
  - Patent Litigation, 2017
  - Patent Litigation, Charlotte, 2022
  - Patent Litigation, New York, 2022
  - Patent Litigation, Illinois, 2022

- IPR Intelligence Report
  - Top 100 Most Active Law Firms representing Petitioners, 2022
- *Managing Intellectual Property* IP Stars
  - Copyright & Related Rights
    - United States 2017, 2020
  - Patent Contentious
    - United States, 2017, 2020–2021
  - Trademark Contentious
    - United States, 2017, 2020–2021
  - Trademark Prosecution
    - United States, 2017, 2020–2021
- *U.S. News Best Lawyers – "Best Law Firms"*
  - Litigation – Intellectual Property
    - National, 2012–2023
    - Chicago, 2012–2023
  - Litigation – Patent
    - National, 2012–2018
    - Chicago, 2012–2018
  - Patent Law
    - Chicago, 2022–2023