

IP LITIGATION EXPERIENCE REPORT

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IP LITIGATION EXPERIENCE

Trials

Altana Pharma AG and Wyeth v. Teva Pharmaceuticals USA, Inc. et al

WilmerHale represented Wyeth and Altana Pharma AG in a patent infringement suit against three generic pharmaceutical companies, Teva, Sun and KUDCo, alleging that the defendants were infringing a patent covering the active ingredient PROTONIX, a drug used to treat gastrointestinal disorders. After a three-week trial in the District of New Jersey, the jury returned a verdict in favor of the Plaintiffs, finding that the patent in suit was valid. Infringement had previously been admitted. Judge Jose Linares subsequently issued written opinions finding in Plaintiffs' favor on the patent validity issue. Certain enforceability defenses asserted by the defendants, as well as Plaintiffs' damages claims, were bifurcated and discovery on those issues is proceeding.

Smith & Nephew, Inc. v. Arthrex, Inc.

WilmerHale secured an important victory in the Eastern District of Texas for its client Smith & Nephew, one of the world's largest medical device manufacturers. Smith & Nephew's EndoButton product is a revolutionary device for the treatment of one of the most common sports injuries, a torn anterior cruciate ligament. In 2006, Arthrex introduced a product to compete with the EndoButton, and Smith & Nephew sought to protect its patented technology. Notwithstanding a very narrow claim construction, WilmerHale defeated motions for summary judgment and judgment as a matter of law. After a five-day trial, the jury found in favor of Smith & Nephew, concluding that Arthrex had directly infringed the patent and had induced infringement by surgeons. The jury further found that the patent was valid over on-sale and public use invalidity challenges, and that Smith & Nephew was entitled to lost profits damages of 100% of Arthrex's infringing U.S. sales

In the Matter of Certain Mobile Telephones and Wireless Communication Devices Featuring Digital Cameras and Components Thereof, Inv. No. 337-TA-663; In the Matter of Certain Digital Cameras, Inv. No. 337-TA-671; In the Matter of Certain Electronic Devices Having Image Capture or Display Functionality and Components Thereof, Inv. No. 337-TA-672.

WilmerHale represented Kodak in three US International Trade Commission actions against Samsung and LG. In the first, Kodak asserted that Samsung and LG infringed two digital camera patents. In the second and third, respectively, Samsung and LG charged Kodak with infringement. In December 2009, Administrative Law Judge Charneski ruled in favor of Kodak in its offensive action finding both of Kodak's patents valid, enforceable and infringed. Samsung and LG's actions against Kodak were subsequently settled and terminated.

Procter & Gamble Company v. Teva Pharmaceuticals USA, Inc.

On February 28, 2008, WilmerHale obtained an important victory for its client The Procter & Gamble Company ("P&G") in an ANDA patent infringement suit against Teva Pharmaceuticals involving P&G's blockbuster osteoporosis drug Actonel®. Teva had



submitted an Abbreviated New Drug Application to the FDA seeking approval to market a generic version of Actonel. P&G, in turn, filed suit in the District of Delaware for infringement of P&G's patent covering Actonel's active ingredient, risedronate, and its use in treating metabolic bone disorders, most notably osteoporosis. Teva stipulated to infringement but challenged the validity of P&G's patent on the basis of obviousness and obviousness-type double patenting in light of an earlier-filed P&G patent disclosing a positional isomer of risedronate and claiming pulse dosing methods for bisphosphonates. In a 50-page opinion, Judge Farnan found that Teva failed to meet its burden of proving invalidity by clear and convincing evidence. Judge Farnan ruled that Teva did not make a *prima facie* case of obviousness under the legal standards set forth following the Supreme Court's landmark decision in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), and that P&G's evidence of unexpected results and fulfillment of a long-felt, unmet need would rebut any *prima facie* case. Similarly, Judge Farnan rejected Teva's double patenting claims, where the prior art patent claimed methods of dosing with bisphosphonates generally, not a particular composition and its use in treatment.

On May 13, 2009, the Federal Circuit unanimously affirmed the district court decision. The Federal Circuit agreed with district court that Teva failed to make a *prima facie* case of obviousness under standards fully articulated by the Federal Circuit following *KSR*. The Court ruled that Teva failed to identify a reasoned basis that would have led a chemist to modify the prior art compound in the particular manner required to achieve risedronate with any reasonable expectation that it would be successful. Similarly, on obviousness-type double patenting, the Court found that Teva failed to prove overlap between the asserted patent claims directed to risedronate and the prior art patent claims directed to an intermittent dosing method.

566 F.3d 989 (Fed. Cir. 2009)

In the Matter of Certain GPS Devices, Associated Software and Systems, and Products Containing the Same, Inv. No. 337-TA-602

WilmerHale successfully represented Broadcom Corporation and Global Locate, Inc. in a patent infringement investigation against SiRF Technology, Inc., MITAC International Corp., Mio Technology Ltd., USA, E-TEN Corporation, and Pharos Science & Applications in the US International Trade Commission. The investigation alleged infringement of six patents covering aspects of global positioning system (GPS) technology. Global Locate initiated the investigation after SiRF brought an action in the ITC accusing Global Locate of infringing four SiRF patents, U.S.I.T.C. Inv. No. 337-TA-596. While SiRF lost the 596 investigation, Global Locate prevailed in the 602. Administrative Law Judge Carl Charneski ruled that SiRF and the other respondents infringed all asserted claims of all six patents and that all six patents were valid and enforceable. The Commission affirmed the ALJ's Initial Determination in favor of Global Locate and Broadcom and issued limited exclusion and cease and desist orders directed toward respondents' infringing products.

Becton Dickinson and Company v. Tyco Healthcare Group LP

WilmerHale obtain a permanent injunction and significant damages on behalf of its client Becton Dickinson ("BD") in a patent infringement suit against Tyco Healthcare in the District of Delaware. BD accused Tyco of infringing its patents on technology concerning safety needles. Following an initial trial handled by another firm, Judge Sleet ordered a new trial. WilmerHale retried the case and obtained a jury verdict that Tyco's Magellan

safety needles and blood collectors infringed BD's patents. Tyco filed post-trial motions for judgment as a matter of law and for a new trial, both of which were denied. The court upheld the jury's verdict, awarded BD damages of approximately \$58 million through October 2007, ordered an accounting of post-October 2007 damages, and substantially granted BD's motion for a permanent injunction.

Medtronic Sofamor Danek USA, Inc., et al v. Globus Medical, Inc.

WilmerHale represented Medtronic in this case claiming infringement of two patents relating to instruments for use in minimally invasive spinal surgeries. After a four-week trial in the Eastern District of Pennsylvania, we won a jury verdict that each of the asserted patent claims was infringed and valid.

In the Matter of Certain GPS Devices, Associated Software and Systems, and Products Containing the Same, Inv. No. 337-TA-5996

WilmerHale successfully represented Broadcom Corporation and Global Locate, Inc. in an action brought by SiRF Technology, Inc. before the US International Trade Commission. SiRF alleged infringement of more than 100 claims of four patents related to global positioning system (GPS) technology. Following a six-day trial, Administrative Law Judge Paul Luckern found that Broadcom and Global Locate did not infringe SiRF's patents and that all asserted claims of one patent were also invalid. The Commission affirmed the Initial Determination in favor of WilmerHale's clients.

Powertrain, Inc., et al v. American Honda Motor Co., Inc.

WilmerHale successfully represented American Honda in a six-day jury trial before Judge Mills in the Northern District of Mississippi. The case involved the trade dress of American Honda's GX series engines, which American Honda claimed was being copied by several Mississippi-based distributors and retailers of Chinese-manufactured copy engines. At the conclusion of trial, the jury returned a verdict that American Honda's trade dress constituted a valid trademark and that the defendants were infringing that mark. The district court subsequently entered a permanent injunction against the defendants. The district court also entered judgment in favor of American Honda for damages in excess of \$58 million.

In related litigation in the Central District of California, WilmerHale subsequently reached favorable settlements for American Honda with several other Chinese manufacturers of copy engines, along with their U.S.-based distributors and retailers, resulting in agreements by these companies to cease selling the copy engines in the United States and to change the design of their products.

Qualcomm Incorporated v. Broadcom Corporation and Broadcom Corporation (Counter-claimant) v. Qualcomm Incorporated (Counter-defendant)

WilmerHale successfully defended Broadcom Corporation in a three-week patent infringement trial in the Southern District of California, which had major implications for keeping the mobile multi-media and high-definition video markets open to continued innovation and competition.



Plaintiff Qualcomm Incorporated accused Broadcom of infringing two patents, both of which relate to video compression technology. All of Broadcom's semi-conductor chips that implement the international "H.264" video compression standard were accused of infringement, including the Broadcom video chip in the Apple Video iPod. Broadcom asserted affirmative defenses of patent invalidity, inequitable conduct by Qualcomm before the US Patent and Trademark Office, and waiver as a result of Qualcomm's conduct relating to the standard-setting organization that developed the H.264 standard.

After approximately six hours of deliberations, the jury returned a verdict of non-infringement on all asserted claims of the two Qualcomm patents, which the jury found were valid. The jury also delivered an advisory verdict that Qualcomm had waived its rights to enforce both patents because of its conduct in connection with the development of the H.264 standard. The district court affirmed the jury's advisory verdict, finding that Broadcom had proven by clear and convincing evidence that Qualcomm had waived its right to enforce the two patents asserted against Broadcom by its conduct before the standards setting organization that developed the H.264 standard.

Subsequently, the district court ruled that, as a remedy for Qualcomm's waiver of the enforceability of the patents-in-suit, those patents and any dependent or derivative patents are unenforceable. Additionally, because of Qualcomm's standards and litigation misconduct, including its failure to produce thousands of directly relevant emails, 21 of which were discovered during cross-examination at trial, the district court awarded Broadcom its attorneys fees, expert witness fees, and all other reasonable costs in connection with the litigation.

On appeal, the Federal Circuit affirmed the finding that Qualcomm had breached its duty to the standard setting organization, and that this conduct constituted an implied waiver of its right to enforce the patents-in-suit. It further found this conduct and the subsequent litigation misconduct were proper bases for the district court's exceptional case determination, and affirmed the award of Broadcom's attorneys fees. The Federal Circuit remanded with instructions to hold the patents unenforceable against products that comply with the H.264 standard.

548 F.3d 1004 (Fed. Cir. 2008)

Broadcom Corporation v. Qualcomm Incorporated

WilmerHale also represented Broadcom in its affirmative case for patent infringement against Qualcomm in the Central District of California. Broadcom claimed that key features offered on certain Qualcomm wireless-communications computer chips -- features including advanced video processing, the ability to participate simultaneously on multiple communications networks, and the ability to select between networks for particular communications -- infringed three Broadcom patents. After a four-week trial, the jury agreed that Qualcomm had infringed each of the three patents and that the patents were not invalid. The presiding judge later issued a permanent injunction that, when it takes full effect, will prevent Qualcomm from making, selling, and using infringing products. Qualcomm appealed.

On September 24, 2008, the Federal Circuit affirmed the judgment of infringement of two of the patents at issue. It further found that the permanent injunction against Qualcomm

was justified, and that the injunction's "sunset provision " allowing a period of limited sales of certain infringing products (with this sunset period expiring at the end of January 2009) adequately mitigated any potential market-disruption harm to the public.

543 F.3d 683 (Fed. Cir. 2008)

Certain Baseband Processor Chips and Chipsets, Transmission and Receiver (Radio) Chips, and Products Containing Same Including Cellular Telephone Handsets, Inv. No. No. 337-TA-543

WilmerHale represented Broadcom Corporation in an action against Qualcomm, Incorporated before the US International Trade Commission - one of a series of disputes between the parties involving numerous patents relating to computer chips for use in cellular telephones. The ITC case involved seven months of intense discovery, including more than 100 depositions and the exchange of several million documents, and a three-week trial before Administrative Law Judge Charles Bullock. In his Initial Determination, ALJ Bullock found that Qualcomm had infringed a Broadcom patent relating to an important power-saving mode used in cell phones. The Commission affirmed this finding. In a subsequent remedy proceeding by co-counsel, Broadcom obtained an exclusion order barring the importation of all new models of cellular telephones using Qualcomm's infringing chips.

GlaxoSmithKline v. Teva Pharmaceuticals USA, Inc.

After a three-day trial, Judge Gregory Sleet of the District of Delaware ruled in favor of WilmerHale's client, GlaxoSmithKline (GSK). The case involved a challenge to one of GSK's patents claiming a method of treatment for Parkinson's Disease. Judge Sleet found that defendant Teva Pharmaceuticals, which had already stipulated that the filing of its Abbreviated New Drug Application (ANDA) infringed GSK's patent, failed to carry its burden of proving by clear and convincing evidence that the subject matter claimed in the patent was obvious or anticipated. Although Teva also challenged the enforceability of GSK's patent based on alleged inequitable conduct, Teva abandoned that challenge after trial, bringing an end to the litigation.

CBS Broadcasting Inc. v. EchoStar Communications Corporation (2003)

On behalf of ABC, CBS, FOX, and NBC stations, WilmerHale obtained a landmark victory against EchoStar, the second largest US satellite company, in a case involving the retransmission of out-of-town broadcasts to thousands of ineligible subscribers. We had obtained a judgment below, after a ten-day bench trial in the Southern District of Florida, that EchoStar had willfully infringed the broadcasters' copyrights. The Eleventh Circuit affirmed the victory on that issue, and also agreed with our cross-appeal seeking a special, exceptionally broad remedy for EchoStar's misconduct. The Eleventh Circuit held that EchoStar had violated the Satellite Home Viewers Act "in every way imaginable," and ordered the first-ever national "pattern or practice" injunction, stripping EchoStar entirely of the right to retransmit distant network stations to subscribers under the Act's compulsory license.

450 F.3d 505 (11th Cir. 2006)

*In the Matter of NOR and NAND Flash Memory Devices and Products
Containing Same, Inv. No. 337-TA-560*

WilmerHale obtained a second major victory for its client, STMicroelectronics, against SanDisk in the US International Trade Commission. Shortly after termination of an earlier ITC proceeding, SanDisk initiated another ITC proceeding, this time claiming that STMicro infringed three additional SanDisk patents. SanDisk subsequently dropped one of the three patents from the investigation, and through pre-hearing motions, WilmerHale obtained a summary determination that none of ST Micro's next generation chips infringed either of the two remaining patents. Following a two-week hearing, Administrative Law Judge Charles Bullock issued an Initial Determination finding that one patent was invalid, and that SanDisk's efforts to show a domestic industry in the second patent (a prerequisite to an exclusion order) were so thoroughly disproven that SanDisk had "wast[ed] both public and private resources." At SanDisk's request, the parties agreed not to seek review of Judge Bullock's Initial Determination.

Hyperion Solutions Corp. v. Outlooksoft Corp.

WilmerHale obtained the first jury verdict of patent invalidity in the Eastern District of Texas, as well as verdicts of noninfringement, in a case involving two patents relating to financial software where we defended Outlooksoft Corporation against claims made by Hyperion Solutions. The jury in Marshall, Texas held that no asserted claims were infringed, and that all asserted claims were valid.

AGFA Corporation v. Creo Products Inc.

Creo, a manufacturer of computer-based printing machines, was sued by Agfa Corporation, claiming that Creo infringed six Agfa patents. WilmerHale asserted that the patents had been obtained as a result of inequitable conduct before the Patent Office. After a 17-day trial in the District of Massachusetts, the court agreed, held all six patents invalid, and awarded us \$2,740,000 in attorneys' fees. The Federal Circuit affirmed the district court judgment, holding that the court properly tried the issue of inequitable conduct prior to, and separately from, the issues of infringement and validity.

451 F.3d 1366 (Fed. Cir. 2006)

FiberMark, Inc. v. Brownville Specialty Paper Products, Inc.

WilmerHale prevailed in an eight-day jury trial on behalf of our publicly held client Fibermark, Inc., a Brattleboro, Vermont-based paper company. The case involved the copying of a mottled/marbled pattern used by Fibermark for over 100 years on high-quality dense paper for notebook covers, binders and similar products. After trial in the Northern District of New York, the jury returned a verdict that Fibermark's trade dress constituted a valid trademark and that the defendant—a competing paper company (whose mill was located three miles from the courthouse)—engaged in deceptive and misleading conduct by printing Fibermark's pattern on lower-quality paper. WilmerHale subsequently also prevailed on a claim of trademark dilution decided separately by the court, and obtained a permanent injunction prohibiting the infringing conduct. The other side then appealed but dropped the appeal and agreed to change their product.

*In the Matter of Certain NAND Flash Memory Circuits and Products
Containing Same, Inv. No. 337-TA-526*

STMicroelectronics (ST) retained WilmerHale to represent it in litigation brought by Sandisk Corporation before the US International Trade Commission and the Northern District of California alleging infringement of a patent relating to NAND flash memory circuits. In an earlier ITC case, SanDisk (represented by the same counsel) had successfully obtained an exclusion order from the ITC on the same patent, preventing Samsung Corporation from importing its NAND flash memory products into the United States. SanDisk also had put the patent through a successful reexamination proceeding, during which the PTO rejected Samsung's best claim construction and invalidity arguments and allowed new dependent claims tailored to avoid Samsung's defenses. Against ST, SanDisk argued that the ST NAND flash memory circuits were substantially identical to those of Samsung, and infringed the patent for the same reasons. Following a seven-day hearing, Administrative Law Judge Paul Luckern issued an Initial Determination finding that ST's NAND flash memory circuits do not infringe the SanDisk patent, that they lacked multiple required elements of each asserted claim, and that ST had not violated 19 U.S.C. Section 1337. ALJ Luckern's Initial Determination of no violation was adopted by the Commission.

Cirrus Logic, Inc. v. Wolfson Microelectronics

Wolfson Microelectronics retained WilmerHale to represent it in litigation brought by Cirrus Logic before the US International Trade Commission alleging infringement of two patents relating to digital-to-analog circuits. After a nearly two-week trial, the ITC agreed with Wolfson that the key patent at issue was unenforceable because the inventors failed to disclose highly material prior art to the Patent Office, with the intent of deceiving the PTO. Prior to the trial, Wolfson had obsoleted two of the three products accused of infringing the second patent due to lack of market demand, and modified the third to remove the disputed feature. Related litigation in the Southern District of California was subsequently settled on mutually agreeable terms.

EMC Corporation v. Hewlett-Packard Company, Inc.

WilmerHale represented EMC in this case claiming infringement of three patents relating to computer storage technology. During the course of the litigation, Hewlett-Packard acquired the original defendant—whose primary product was accused of infringement—for \$350 million. After a two-week trial, we won a jury verdict finding that each of the asserted claims had been infringed by Hewlett-Packard and was valid. The damages portion of the case subsequently settled.

*Leon Stambler v. RSA Security, Inc., VeriSign, Inc. First Data Corporation,
Open Waves Systems, Inc. Certicom, Inc. and Ommnisky Corp.*

RSA Security turned to WilmerHale for representation in this case alleging infringement of three patents. The plaintiff, a 74-year-old individual, claimed that his patents covered all secure communications over the Internet, and sought damages in excess of \$20 million. After a two-week trial in the District of Delaware, a jury found that RSA had not infringed any of the asserted claims. The Federal Circuit affirmed. The case was closely followed in the press due to the implications an adverse verdict would have had on all Internet commerce.

123 Fed. Appx. 982, 2005 WL 352606

Genzyme Corporation v. Atrium Medical Corp.

Atrium Medical retained WilmerHale to defend it in this lawsuit alleging infringement of five patents relating to thoracic drainage devices. Genzyme and Atrium are the two dominant companies in the market. Genzyme issued a press release shortly before trial stating that there was "no doubt" it would establish infringement. After a two-week trial in the District of Delaware, we won a jury verdict finding that each of the asserted patent claims was not infringed, invalid or both. The Federal Circuit affirmed.

212 F.Supp. 2d 292 (D. Del. 2002); 108 Fed. Appx. 619 (Fed. Cir. 2004)

United States Trust Company v. United States Trust Company of NY

WilmerHale represented United States Trust Co., a Boston bank, in this case challenging its use of the "US Trust" family of marks. After a 12-day bench trial in the District of Massachusetts, the court concluded that our client could continue to use the marks as it had throughout the country and issued an injunction precluding the opposing party, United States Trust Co. of New York, from using the marks in Massachusetts.

210 F. Supp. 2d 9 (D. Mass. 2002)

Nikon v. ASML Holding N.V.

WilmerHale represented ASML Holding in this case initiated by its chief rival, Nikon Corporation, in the US International Trade Commission and the Northern District of California. After a five-week trial, an administrative law judge ruled that each of the 15 patent claims Nikon had asserted was not infringed, invalid and/or unenforceable due to inequitable conduct. The ITC adopted the Administrative Law Judge's decision. At issue was approximately \$1.8 billion in annual sales in the market for photolithographic equipment. Related litigation in the Northern District of California involving five additional patents subsequently settled.

Fusion Lighting, Inc. v. Northrop Grumman

WilmerHale represented Fusion Lighting in this case against Northrop Grumman alleging misappropriation of trade secrets and patent rights. After a three-week trial in Maryland State Court, the jury found that Northrop had wrongfully obtained patents on Fusion's intellectual property and awarded \$32.7 million in damages.

Datapoint Corporation v. PictureTel Corporation

PictureTel retained WilmerHale to defend it in this litigation alleging infringement of two patents in the area of multi-point video conferencing. Datapoint sought damages exceeding \$600 million and a permanent injunction. After a four-week trial in the Northern District of Texas, a jury found that the asserted claims were not infringed and were invalid. The Federal Circuit upheld the jury's verdict of invalidity. The *National Law Journal* named this one of the top defense verdicts of the year.

215 F.3d 1344 (Fed. Cir. 1999); 1999 U.S. App. LEXIS 15786 (July 15, 1999)

Summit Technology v. Nidek Co., Ltd.

WilmerHale represented Summit in a patent infringement action against Nidek in the District of Massachusetts. The litigation involved two patents owned by Summit relating to



laser technology used to alter the curvature of the cornea and thereby correct refractive vision problems. After a two-and-a-half week jury trial, the jury found that Nidek willfully infringed both patents, that both patents were valid and awarded Alcon Summit Autonomous over \$17.2 million in compensatory damages. The district court later overturned the jury verdict for a lack of evidence, which the Federal Circuit affirmed.

363 F.3d 1219 (Fed. Cir. 2004)

Nitor Corp. v. CoreTeck, Inc.

WilmerHale successfully defended Nortel Networks in a California arbitration in which Nitor claimed rights to key patents relating to tunable vertical cavity surface emitting lasers and tunable filters—technology at the forefront of the optical telecommunications field. Nitor claimed a license to the technology based on work that a Nortel subsidiary had done on an unrelated contract for visual displays. A three-arbitrator panel unanimously decided that Nitor had failed to establish any rights to those key patents—or even to a broader provisional patent application—and that this technology was not part of any development efforts for Nitor.

American Superconductor Corporation v. Massachusetts Institute of Technology

WilmerHale represented American Superconductor in this “patent interference” proceeding in the District of Massachusetts. American Superconductor exclusively licenses an important patent in the field of high-temperature superconductors and is the owner of a patent application in the same field. The Patent Office found that the patent and application “interfered.” American Superconductor appealed this decision to the District of Massachusetts and, in a highly unusual move, the Patent Office intervened to defend its decision. After a bench trial, we obtained a judgment finding that the patent and application claimed separate inventions, thus entitling our client to both, and according a very broad construction to the patent.

Enzo Biochem v. Calgene

WilmerHale represented Calgene, the company which researched, developed and brought to market the genetically engineered tomato, in four litigations against Enzo Biochem involving four patents related to genetic antisense technology. After a three-week trial in the District of Delaware, the court found for Calgene on all claims. The Federal Circuit affirmed that the patents were invalid.

14 F. Supp. 2d 536 (D. Del. 1998); 188 F.3d 1362 (Fed. Cir. 1999)

Sextant Avionique, S.A. v. Analog Devices, Inc.

WilmerHale represented Analog Devices in this litigation commenced by Sextant Avionique in the Northern District of California. Sextant claimed that Analog’s accelerometer products infringed certain patents owned by Sextant Avionique. After a two-week trial, the court determined that Analog did not infringe the Sextant patents. The Federal Circuit affirmed, applying for the first time the presumption barring application of the doctrine of equivalents set forth in the Supreme Court’s *Hilton Davis* opinion.

172 F. 3d 817 (Fed. Cir. 1999)



Candela Laser Corporation v. Cynosure, Inc.

WilmerHale represented Cynosure, Inc. and Horace Furumoto in this patent infringement action commenced by Candela. Dr. Furumoto was the founder of the plaintiff, Candela Laser Corporation, the named inventor on the patents involved in the litigation and the founder of Cynosure. Candela alleged that the medical laser system manufactured and marketed by Cynosure infringed two patents issued to Candela. After a three-week trial, the court found that Cynosure did not infringe one of the Candela patents and held the other Candela patent invalid. The Federal Circuit affirmed on both grounds.

862 F. Supp. 632 (D. Mass. 1994); *aff'd* 56 F. 3d 82 (Fed. Cir. 1995)

VLТ, Inc. (Vicor Corp.) v. Unitrode Corporation

WilmerHale represented Unitrode in an action brought by Vicor accusing Unitrode of inducing infringement of its patents relating to power supply delivery circuits. Vicor sought injunctive relief and damages of hundreds of millions of dollars. After a two-week trial, the jury found for Unitrode, rejecting the assertion that it had induced infringement and denying Vicor any damages. Vicor later sought, but then abandoned, an appeal of that decision.

Amgen, Inc. v. Genetics Institute, Inc.

WilmerHale represented Genetics Institute, Inc. (GI) in two related lawsuits in the Districts of Massachusetts and California. These cases involved patent claims relating to erythropoietin (EPO). At issue was the right to produce recombinant EPO, a genetically engineered protein which stimulates the production of red blood cells. GI claimed that Amgen infringed its patent, which covers a homogeneous form of the protein, and Amgen asserted that GI infringed its patent, which covered various components of the process used to produce the drug recombinantly. We tried a three-month jury-waived case involving the patents, and argued the appeal to the Federal Circuit. We also have represented GI in various foreign proceedings concerning foreign counterparts of those patents.

927 F.2d 1200 (Fed. Cir 1991)

Clinipad Corporation v. Aplicare

WilmerHale represented Aplicare in this trade secret case in Connecticut Superior Court. The alleged trade secrets related to wet packs containing anti-bacterial solutions and certain applicators. Much of the litigation concentrated on whether certain items were trade secrets and on whether they were used by the defendants. In addition, a substantial issue existed as to whether a prior published patent would prevent the allegedly secret process from becoming a trade secret. The trial judge ruled in Aplicare's favor, holding that no trade secrets were misappropriated, and awarded attorneys fees to Aplicare.

PerSeptive Biosystems, Inc. v. Pharmacia and Sepracor, Inc.

WilmerHale represented Sepracor, Inc. in this patent infringement action commenced by PerSeptive in the District of Massachusetts. After deciding on summary judgment that inventorship was improper, the court held a ten-day trial. After trial, the court declared the patents unenforceable as a result of PerSeptive's inequitable conduct. The Federal Circuit upheld the court's declaration that the patents were unenforceable.

225 F.3d 1315 (Fed. Cir. 2000)

Deknatel Technology Corporation v. Atrium Medical Corporation

WilmerHale represented Atrium Medical Corporation in this patent infringement action commenced by Deknatel involving patents issued to Deknatel covering various aspects of chest drainage devices. Before trial, the court entered summary judgment of noninfringement of one Deknatel patent. After a two-week jury trial, the jury found the remaining Deknatel patent not infringed and invalid. The *National Law Journal* named this one of the top defense verdicts of the year.

Yellow Springs Instruments, Inc. v. Nova Biomedical Corporation

WilmerHale represented Nova Biomedical Corporation, a manufacturer and distributor of blood analyzers, in the defense of claims made under a patent license agreement and, in the alternative, as an infringement action under patents owned by Yellow Springs Instruments, Inc. After a two-week bench trial in the District of Ohio, the court ruled that Nova had no further obligation to make royalty payments; that Yellow Springs' attempt to obtain royalty payments beyond the terms of the patents was unlawful; that both Yellow Springs patents were invalid as obvious and for inequitable conduct in failing to disclose highly material prior art to the Patent Office; but that Nova could not recover for its several years of mistaken royalty payments.

Dymax Corporation v. Hoffrel

WilmerHale represented Dymax Corporation, the holder of a patent relating to medical ultrasound transducers, in cases involving patent infringement and breach of contract claims against an exclusive licensee, sub-licensees and other third parties. The Hoffrel litigation involved an exclusive licensee who failed to meet sales quotas and ignored a notice of termination. In this case filed in the District of Connecticut, WilmerHale obtained a directed finding for Dymax after a trial on the breach of contract issue. During post-trial discovery on the patent issues, the matter settled.

Federal Circuit and Supreme Court Appeals

Centocor Ortho Biotech, Inc., et al v. Abbott Laboratories, et al

WilmerHale obtained a major victory for its client Abbott Laboratories when the Federal Circuit overturned a \$1.67 billion patent-infringement verdict in favor of Johnson & Johnson related to patents on Abbott's bestselling drug Humira®.

In 2007, Centocor, a subsidiary of Johnson & Johnson, sued Abbott in the Eastern District of Texas, contending that its patents covered human antibodies such as Humira. WilmerHale was successful in two separate arbitrations in establishing that a portion of Humira sales were free from suit. In the summer of 2009, the case proceeded to trial before a Texas jury with respect to the remaining Humira sales. After five days of trial, the jury found for Centocor and awarded it \$1.67 billion in damages, the largest verdict in patent history. Abbott appealed.

On February 23, 2011, almost four years after WilmerHale was first retained, the Federal Circuit issued its opinion, agreeing with Abbott and ruling that Centocor's patent was invalid.

_ F.3rd _; 2011 WL 635291 (Fed. Cir., Feb. 23, 2011)

Medtronic Navigation, Inc., et al v. BrainLAB Medizinische Computersysteme GmbH, et al

WilmerHale secured a victory for its client Medtronic Navigation, Inc. in the Federal Circuit. Medtronic, represented by another firm at the time, sued BrainLAB for patent infringement a decade ago. A jury found for Medtronic, but the district court granted judgment as a matter of law to BrainLAB in a decision subsequently upheld by the Federal Circuit. BrainLAB then sought an award of attorney's fees, which the district court granted holding that Medtronic had pursued baseless claims and engaged in litigation misconduct. The court ordered Medtronic and its trial counsel to pay fees and costs -- a total of almost \$5 million.

WilmerHale was engaged by Medtronic to appeal the award of attorney's fees. We challenged the district court's decision on the ground that the court improperly applied the standard for awarding fees, and further argued that Medtronic's success at trial showed that its claims were not objectively baseless. The Federal Circuit agreed and reversed the fee award in full.

603 F.3d 943 (Fed. Cir. 2010)

SiRF Technology, Inc. et al v. International Trade Commission and Broadcom Corporation and Global Locate, Inc.

WilmerHale successfully defended on appeal exclusion and cease and desist orders entered by the US International Trade Commission in favor of its clients Broadcom Corporation and Global Locate, Inc. WilmerHale represented Broadcom and Global Locate in a patent infringement investigation against SiRF Technology, Inc., MiTAC International Corp., Mio Technology Ltd., USA, E-TEN Corporation, and Pharos Science & Applications in the US International Trade Commission. Administrative Law Judge Carl Charneski ruled in that investigation that SiRF and the other respondents infringed all asserted claims of all six patents and that all six patents were valid and enforceable. The Commission affirmed the ALJ's Initial Determination in favor of Global Locate and Broadcom and issued limited exclusion and cease and desist orders directed toward respondents' infringing products. In April 2010, the Federal Circuit affirmed the ITC's decision, finding it had correctly banned the importation of the chips and products containing them.

601 F.3d 1319 (Fed. Cir. 2010)

TiVo, Inc. v. EchoStar Communications Corp.

WilmerHale secured two important Federal Circuit victories for its client, TiVo Inc. In 2008 the Court affirmed a jury's finding that digital video recorders supplied to customers by EchoStar Communications Corporation (which includes DISH Network, one of the nation's two satellite-television providers) infringe TiVo's "multimedia time warping" patent, and upheld a \$74 million damages award and a permanent injunction requiring EchoStar to disable the DVR functions in most of the devices found to infringe.

Notwithstanding the injunction, EchoStar did not disable the DVRs, claiming that it had downloaded new non-infringing software. Following a two-day hearing, in June of 2009 the district court found EchoStar in contempt of both the infringement and disablement provisions of the injunction, and awarded TiVo approximately \$200 million in damages and

sanctions for the contempt period, in addition to \$103 million in infringement damages for the period while the injunction was stayed. It also amended the injunction to require EchoStar to obtain pre-clearance of any purported redesigns. On March 4, 2010, the Federal Circuit affirmed both the district court's contempt order and the redesign pre-approval requirement.

516 F.3d 1290 (Fed. Cir. 2008); 597 F.3d 1247 (Fed. Cir. 2010)

DePuy Spine, Inc. v. Medtronic Sofamore Danek, Inc., et al

WilmerHale was engaged by Medtronic to handle the appeal of an adverse jury verdict and multi-million dollar damages award in a patent infringement case brought by DePuy Spine in the District of Massachusetts. Also on appeal was the district court's imposition of a substantial attorney's fee award and a \$10 million penalty for allegedly "flouting the governing claim construction." Although the Federal Circuit upheld the infringement verdict, it reduced the damages against Medtronic by \$77 million, accepting our argument that lost profits were not available on so-called "pull-through" products that neither competed nor functioned with the patented invention. The Court also reversed the attorney's fee award and sanctions and rejected DePuy's cross-appeal regarding reasonable royalty and willfulness that (if successful) could have imposed significant additional liability.

567 F.3d 1314 (Fed. Cir. 2009)

Procter & Gamble Company v. Teva Pharmaceuticals USA, Inc.

On February 28, 2008, WilmerHale obtained an important victory for its client The Procter & Gamble Company ("P&G") in an ANDA patent infringement suit against Teva Pharmaceuticals involving P&G's blockbuster osteoporosis drug Actonel®. Teva had submitted an Abbreviated New Drug Application to the FDA seeking approval to market a generic version of Actonel. P&G, in turn, filed suit in the District of Delaware for infringement of P&G's patent covering Actonel's active ingredient, risedronate, and its use in treating metabolic bone disorders, most notably osteoporosis. Teva stipulated to infringement but challenged the validity of P&G's patent on the basis of obviousness and obviousness-type double patenting in light of an earlier-filed P&G patent disclosing a positional isomer of risedronate and claiming pulse dosing methods for bisphosphonates. In a 50-page opinion, Judge Farnan found that Teva failed to meet its burden of proving invalidity by clear and convincing evidence. Judge Farnan ruled that Teva did not make a *prima facie* case of obviousness under the legal standards set forth following the Supreme Court's landmark decision in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), and that P&G's evidence of unexpected results and fulfillment of a long-felt, unmet need would rebut any *prima facie* case. Similarly, Judge Farnan rejected Teva's double patenting claims, where the prior art patent claimed methods of dosing with bisphosphonates generally, not a particular composition and its use in treatment.

On May 13, 2009, the Federal Circuit unanimously affirmed the district court decision. The Federal Circuit agreed with district court that Teva failed to make a *prima facie* case of obviousness under standards fully articulated by the Federal Circuit following *KSR*. The Court ruled that Teva failed to identify a reasoned basis that would have led a chemist to modify the prior art compound in the particular manner required to achieve risedronate

with any reasonable expectation that it would be successful. Similarly, on obviousness-type double patenting, the Court found that Teva failed to prove overlap between the asserted patent claims directed to risedronate and the prior art patent claims directed to an intermittent dosing method.

566 F.3d 989 (Fed. Cir. 2009)

Qualcomm Incorporated v. Broadcom Corporation

WilmerHale successfully defended a trial victory in favor of its client Broadcom Corporation in this case involving patents related to video compression technology. Following a three-week jury trial and a verdict of non-infringement, the District Court for the Southern District of California found that Qualcomm's failure to disclose its patents to the standard-setting group developing the standard practiced by the patents constituted an implied waiver of the right to enforce the patents. The court concluded that this conduct, and Qualcomm's subsequent litigation misconduct, supported an exceptional case determination and awarded Broadcom its attorneys fees.

On December 1, 2008, the Federal Circuit affirmed the district court's finding that Qualcomm had breached its duty to the standard setting organization, and thereby impliedly waived its right to enforce the patents-in-suit. It further upheld the exceptional case determination and award of attorneys fees to Broadcom. The Court remanded with instructions to hold the patents unenforceable against products that comply with the relevant standard.

548 F.3d 1004 (Fed. Cir. 2008)

In Re Bilski

In this closely watched case, the Federal Circuit clarified the applicable standard for determining whether a claimed method constitutes a statutory process under 35 U.S.C. Section 101. The patent application at issue claimed a "method for managing the consumption risk costs of a commodity." Following rejection of the application by the PTO examiner and affirmance by the Board of Patent Appeals and Interferences, the applicant sought review by the Federal Circuit. After a panel heard argument, but before decision, the Court *sua sponte* ordered *en banc* review. Over 30 *amici curiae* filed briefs, including a group of financial services industry clients represented by WilmerHale. WilmerHale's Co-Managing Partner William F. Lee was selected as one of only two *amici* to present argument. The Court clarified the Supreme Court's test for patent-eligible subject matter, explaining that a process claim satisfies Section 101 either if the claim is tied to a particular machine or if the claim transforms an article into a different state or thing. Applying this standard, the Court concluded that the PTO had properly rejected the applicant's claim as not directed to patent-eligible subject matter.

545 F.3d 943 (Fed. Cir. 2008) (*en banc*)

Broadcom Corporation v. Qualcomm Incorporated

WilmerHale successfully defended core elements of a jury verdict in favor of its client Broadcom Corporation in this case involving computer chip technology used in advanced cell phones. After a four-week trial in the Central District of California, the jury found that Qualcomm infringed Broadcom's patents and that the patents were not invalid. The

presiding judge subsequently ordered a permanent injunction against Qualcomm. On appeal by Qualcomm, the Federal Circuit affirmed the judgment of infringement of two of the patents at issue. It further found that the permanent injunction against Qualcomm was justified, and that the injunction's sunset provision allowing a period of limited sales of certain infringing products (with this sunset period expiring at the end of January 2009) adequately mitigated any potential market disruption harm to the public.

543 F.3d 683 (Fed. Cir. 2008)

800 Adept, Inc. v. Murex Securities, Ltd, et al

Following an adverse \$49 million judgment in a patent infringement action, Murex Securities, Ltd., Murex Licensing Corp., Targus Information Corporation., and West Corp. (collectively "Targus") turned to WilmerHale to represent them in an appeal.

In a suit in the Middle District of Florida, 800 Adept alleged that Targus infringed its patents related to technology used to route calls to toll-free numbers, and engaged in tortious interference by asserting its own patents against the plaintiff's customers. After a mid-trial change in claim construction by the district judge, the jury found that Targus willfully infringed 800 Adept's patents and engaged in tortious interference. The court issued a permanent injunction and awarded enhanced damages of \$49 million.

On appeal WilmerHale argued that the district court had erred in its construction of a critical claim, and the Federal Circuit agreed. The Federal Circuit held that Targus was entitled to judgment of non-infringement as a matter of law under the correct claim construction, and was not guilty of tortious interference. The Court vacated the injunction and the entire \$49 million damages award.

539 F.3d 1354 (Fed. Cir.2008)

Pellegrini v. Analog Devices, Inc.

WilmerHale obtained summary judgment of patent noninfringement on behalf of Analog Devices, Inc. with respect to patents involving motor control electronics and a claim that a US patent could reach the foreign activities of a US company. The Federal Circuit affirmed on this issue of first impression. The district court then entered Rule 11 sanctions (including dismissal and an award of attorney fees) against the plaintiff for continuing to pursue his claims, which the Federal Circuit affirmed as well.

375 F.3d 1113 (Fed.Cir. 2004); *aff'd* 312 Fed. Appx. 304 (Fed. Cir., June 5, 2008)

PowerOasis Inc. v. T-Mobile USA, Inc.; PowerOasis Inc. v. Wayport, Inc.

WilmerHale won two separate but related Federal Circuit appeals involving power and telecommunications access vending machines. PowerOasis had brought suit against T-Mobile in the District of New Hampshire, asserting that T-Mobile's HotSpot Network, available at retail locations, infringed two PowerOasis patents. PowerOasis brought a second infringement action involving the same patents against Wayport in the District of Massachusetts. At the heart of both cases was whether the claimed invention is limited to a stand-alone vending machine - the position of WilmerHale's clients - or also covers distributed networks with geographically dispersed components located throughout the United States, as argued by PowerOasis. The two district courts adopted different claim constructions, with Judge Barbadoro of New Hampshire issuing a construction that



covered a distributed network, and Judge Zobel in Massachusetts adopting a narrow construction that excluded distributed networks. Notwithstanding these divergent constructions, WilmerHale successfully obtained summary judgment for both of its clients. Judge Barbadoro held that T-Mobile had demonstrated, by clear and convincing evidence, that the PowerOasis patents were invalid; and Judge Zobel concluded that Wayport had not infringed the PowerOasis patents. The Federal Circuit, agreeing with Judge Barbadoro, affirmed the judgment of invalidity in favor of T-Mobile. In light of this ruling, it vacated and remanded the Wayport case with instructions to the district court to enter judgment consistent with the holding of invalidity. The Federal Circuit also appears to have clarified an unsettled area of patent law, agreeing with WilmerHale that the presumption of validity does not extend to the question of priority, when the Patent Office has not made a priority determination with respect to continuation-in-part claims.

522 F.3d 1299 (Fed. Cir. 2008); 273 Fed. Appx. 964 (Fed. Cir., April 11, 2008)

Ampex Corp. v. Eastman Kodak Company and Altek Corporation

Ampex filed this lawsuit against WilmerHale's clients Kodak and Altek in the District of Delaware, asserting that Kodak's digital cameras infringed an Ampex patent relating to the generation and storage of reduced size images. Ampex asserted that it was entitled to treble damages for willful infringement, totaling over \$80 million. We convinced the court that the claims were not infringed because a key claim limitation was not met. The court accordingly granted summary judgment dismissing the case. The Federal Circuit summarily affirmed the finding of non-infringement.

263 Fed. Appx. 885 (Fed. Cir., Feb. 7, 2008)

Prism Technologies LLC v. Verisign, Inc.

WilmerHale obtained a favorable decision for RSA Security, a division of EMC Corporation, in a multi-defendant action involving a patent directed to a security system for computer networks. The Federal Circuit summarily affirmed a judgment of non-infringement.

263 Fed. Appx. 878 (Fed. Cir., Feb. 6, 2008)

Monsanto Co. v. David

WilmerHale obtained a victory for its client Monsanto Co. in a case involving patents claiming gene sequence for herbicide-resistant plants. The Federal Circuit upheld the Eastern District of Missouri's judgment of patent infringement, and affirmed an award of enhanced damages and attorney's fees. The case was remanded for determination of a reasonable royalty.

516 F.3d 1009 (Fed. Cir. 2008)

Monsanto v. McFarling (McFarling I, II and III)

WilmerHale won important victories for our client Monsanto in three groundbreaking appeals relating to infringement of Monsanto's patents on genetically modified cotton and soybean seed. The Federal Circuit rejected the defendant's defenses based on alleged illegal tying, patent exhaustion, first sale and the Plant Variety Protection Act. After the district court granted summary judgment to Monsanto on its patent infringement claims, the defendant again appealed to the Federal Circuit, and the court once again ruled in our client's favor. Following the district court's determination of damages, the Defendant



appealed a third time, and the Federal Circuit upheld the jury's damages award of \$40 per bag of saved seed, notwithstanding McFarling's argument that the \$6.50 technology fee charged to farmers who legally acquire Monsanto's patented seed was an established royalty and that, in any event, damages should be no higher than Monsanto's lost profits.

302 F.3d 1291 (Fed. Cir. 2002); 363 F.3d 1336 (Fed. Cir. 2004); 488 F.3d 973 (Fed. Cir. 2007)

CBS Broadcasting Inc. v. EchoStar Communications Corporation (2003)

On behalf of ABC, CBS, FOX, and NBC stations, WilmerHale obtained a landmark victory against EchoStar, the second largest US satellite company, in a case involving the retransmission of out-of-town broadcasts to thousands of ineligible subscribers. We had obtained a judgment below, after a ten-day bench trial in the Southern District of Florida, that EchoStar had willfully infringed the broadcasters' copyrights. The Eleventh Circuit affirmed the victory on that issue, and also agreed with our cross-appeal seeking a special, exceptionally broad remedy for EchoStar's misconduct. The Eleventh Circuit held that EchoStar had violated the Satellite Home Viewers Act "in every way imaginable," and ordered the first-ever national "pattern or practice" injunction, stripping EchoStar entirely of the right to retransmit distant network stations to subscribers under the Act's compulsory license.

450 F.3d 505 (11th Cir. 2006)

Monsanto Company v. Scruggs

WilmerHale has represented Monsanto Company in several cases concerning Monsanto's patents in genetic modifications that allow plants such as soybeans and cotton to express tolerance to herbicides and resistance to pests. In this case, a grower saved and replanted seed containing Monsanto's patented technology, thereby infringing Monsanto's patents. The grower contended that Monsanto's patents were invalid on several grounds and that Monsanto's licensing practices violated federal and state antitrust laws. The Federal Circuit affirmed a decision granting Monsanto summary judgment on all grounds.

459 F.3d 1328 (Fed. Cir. 2006)

AGFA Corporation v. Creo Products Inc.

Creo, a manufacturer of computer-based printing machines, was sued by Agfa Corporation, claiming that Creo infringed six Agfa patents. WilmerHale asserted that the patents had been obtained as a result of inequitable conduct before the Patent Office. After a 17-day trial in the District of Massachusetts, the court agreed, held all six patents invalid, and awarded us \$2,740,000 in attorneys' fees. The Federal Circuit affirmed the district court judgment, holding that the court properly tried the issue of inequitable conduct prior to, and separately from, the issues of infringement and validity.

451 F.3d 1366 (Fed. Cir. 2006)

Xerox Corporation v. U.S. Robotics Corp. et al

Palm Computing retained WilmerHale to represent it in this appeal, after Xerox prevailed on claims that Palm had infringed a patent relating to handwriting recognition and that the patent was valid. Xerox claimed that its patent covered the "graffiti software" used in millions of Palm's popular "Palm Pilot" products. WilmerHale obtained a Federal Circuit

decision reversing the district court's ruling that the patent was valid. The Western District of New York subsequently issued a summary judgment finding that the patent was not valid. Following a second appeal, remanding the case for further consideration of the validity issue, the case settled.

66 USPQ 2d 1216; 61 Fed.Appx. 680 (Fed. Cir. 2003); 458 F.3d 1310 (Fed. Cir. 2006)

eBay Inc. v. MercExchange LLC

WilmerHale represented MercExchange before the United States Supreme Court in a case involving online marketing technology. eBay sought to reverse the Federal Circuit's decision granting MercExchange a permanent injunction. In its opinion, the Supreme Court clarified the standards for granting permanent injunctive relief in patent cases and remanded the case.

126 S.Ct. 1837 (2006)

Enzo Biochem, Inc. v. Gen-Probe, Inc.

WilmerHale represented Gen-Probe, Inc., defending a claim of infringement of a patent related to nucleic acid probes. The Federal Circuit initially affirmed a summary judgment of patent invalidity for lack of written description. On rehearing, summary judgment was reversed because of a change in the law regarding deposits of biological materials. The denial of a petition for rehearing *en banc* involved five concurring and five dissenting opinions. Subsequently, WilmerHale again obtained summary judgment of invalidity and the Federal Circuit affirmed that the patent was invalid under the on-sale bar. The Court held that a contract between Enzo and another company obligating Enzo to provide a percentage of its requirements for gonorrhea-specific DNA assays constituted a "commercial offer for sale" under the relevant statute, and that Enzo's DNA assay was "ready for patenting" more than one year before it filed its patent application.

285 F.3d 1013 (Fed. Cir. 2002); *vacated by* 323 F.3d 956 (Fed. Cir. 2002); 424 F.3d 1276 (Fed. Cir. 2005)

U.S. Philips Corporation v. International Trade Commission

U.S. Philips Corporation turned to WilmerHale to handle its appeal after the International Trade Commission held that Philips' patents for CD-R and CD-RW discs were unenforceable because of patent misuse. The Federal Circuit reversed the ITC's decision, holding that Philips' package licenses did not involve improper "tying" of patents under either the *per se* or the rule-of-reason analysis used by the Commission.

424 F.3d 1179 (Fed. Cir. 2005)

Merck & Co. v. Teva Pharmaceuticals USA, Inc.

WilmerHale represented the Pharmaceutical Research and Manufacturers of America (PhRMA) in its filing of an amicus curiae brief in the Federal Circuit. PhRMA's brief supported Merck & Co.'s petition for a rehearing or a rehearing *en banc* on the ground that a Federal Circuit panel had failed to give proper weight to "commercial success" as evidence of nonobviousness. The Federal Circuit denied Merck's requests for rehearing, but three judges joined in a dissenting opinion agreeing with PhRMA that the panel had mishandled evidence of "commercial success."

395 F.3d 1364 (Fed. Cir. 2005); *Rehearing denied by* 2005 U.S. App. LEXIS 6814 (Fed.

Cir., April 21, 2005)

Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd. (a/k/a SMC Corp.) and SMC Pneumatics, Inc.

WilmerHale has represented Shoketsu Kinzoku Kogyo Kabushiki Co, Ltd. (SMC Corp.) in its ongoing litigation with Festo Corporation since 1988. This landmark case on the interplay between the doctrine of equivalents and prosecution history estoppel has involved two grants of certiorari by the United States Supreme Court, four Federal Circuit hearings (two of which were *en banc*), and three trials.

72 F.3d 857 (Fed. Cir. 1995); 520 U.S. 1111 (1997); 172 F.3d 1361 (Fed. Cir. 1999); 234 F.3d 558 (Fed. Cir. 2000); 535 U.S. 722 (2002); 344 F.3d 1359 (Fed. Cir.) 2003; 541 U.S. 988 (2004)

Monsanto Company v. Ralph

Monsanto brought an action in the Eastern District of Missouri against Kem Ralph and Ralph Brothers Farms for misappropriation and infringement of its patented plant biotechnologies by saving, replanting and selling seeds in violation of a binding license agreement. The jury awarded Monsanto more than \$2 million in damages, and the defendants appealed. Monsanto engaged WilmerHale to represent it before the Federal Circuit, which upheld the jury award, agreeing that the district court had not abused its discretion in striking Ralph's defenses as a sanction for repeated discovery abuses. Subsequently, the defendants filed a motion to reopen the district court judgment, asserting that the trial judge should have recused himself. Following a denial of the motion, the defendant again appealed to the Federal Circuit, which affirmed the district court's decision in a *per curiam* summary order less than a week after oral argument.

382 F.3d 1374 (Fed. Cir. 2004)

Housey Pharmaceuticals, Inc. v. AstraZeneca UK LTD

WilmerHale argued this appeal of the district court's claim construction on behalf of our client Wyeth and co-defendants AstraZeneca, Aventis, Merck and Bristol-Myers. The Federal Circuit affirmed the district court's claim construction, concluding that it had correctly construed patent claims relating to methods of screening for protein inhibitors and activators. Based on the claim construction, the plaintiff had stipulated the patents-in-suit to be not infringed and invalid.

366 F.3d 1348 (Fed. Cir. 2004)

Superguide Corp v. Direct TV Enterprises

Gemstar retained WilmerHale to represent it in two appeals after Direct TV, Echostar, Scientific-Atlanta, Pioneer, and others convinced the district court and the US International Trade Commission that they had not infringed patents relating to online television programming guides. We obtained Federal Circuit decisions reversing the district court's and ITC's claim constructions and remanding for reconsideration of the infringement issues. Gemstar subsequently licensed the patents (along with related intellectual property) to three of the defendants, including a license to Echostar for \$190 million.

358 F.3d 870 (Fed. Cir. 2004); 383 F.3d 1352 (Fed. Cir. 2004)

Schreiber Foods, Inc. v. Beatrice Cheese, Inc. and Kustner Industries,

WilmerHale undertook representation of Kustner Industries, S.A. following the entry of a \$26 million dollar adverse jury verdict subject to trebling. On a post-trial motion, the district court set aside the verdict, finding that no reasonable jury could have found infringement. That decision was reversed by the Federal Circuit on appeal and, following the denial of certiorari by the United States Supreme Court, judgment against our client was entered. One month later, WilmerHale discovered that the plaintiff had transferred the patents prior to trial in pursuit of a strategy to reduce state taxes, and moved for relief under Rules 60(b)(2) (misrepresentation) and 60(b)(4) (void judgment). After limited discovery granted by the district court demonstrated that a witness who had testified that the plaintiff owned the patent was aware of the transfer, and that trial counsel had known of the transfer during the period of the post-trial motions, the district court vacated the judgment and dismissed the case holding that it lacked jurisdiction and, in the alternative, granting the motions on the grounds of misrepresentation and void judgment. On appeal, the Federal Circuit reversed the district court's decision of lack of jurisdiction but, in a strongly worded opinion, affirmed the district court's grant of a new trial based on misconduct, and held the plaintiff to a waiver of damages it had made during the appeal.

402 F.3d 1198 (Fed. Cir. 2005)

Leon Stambler v. RSA Security, Inc., VeriSign, Inc. First Data Corporation, Open Waves Systems, Inc. Certicom, Inc. and Ommnisky Corp.

RSA Security turned to WilmerHale for representation in this case alleging infringement of three patents. The plaintiff, a 74-year-old individual, claimed that his patents covered all secure communications over the Internet, and sought damages in excess of \$20 million. After a two-week trial in the District of Delaware, a jury found that RSA had not infringed any of the asserted claims. The Federal Circuit affirmed. The case was closely followed in the press due to the implications an adverse verdict would have had on all Internet commerce.

243 F. Supp. 2d 70 (D. Del. 2003); 212 FRD 470; 243 F. Supp. 2d 74 (D. Del. 2003); 123 Fed. Appx. 982, 2005 WL 352606

Genzyme Corporation v. Atrium Medical Corp.

Atrium Medical retained WilmerHale to defend it in this lawsuit alleging infringement of five patents relating to thoracic drainage devices. Genzyme and Atrium are the two dominant companies in the market. Genzyme issued a press release shortly before trial stating that there was "no doubt" it would establish infringement. After a two-week trial in the District of Delaware, we won a jury verdict finding that each of the asserted patent claims was not infringed, invalid or both. The Federal Circuit affirmed.

212 F.Supp. 2d 292 (D. Del. 2002); 108 Fed. Appx. 619 (Fed. Cir. 2004)

Eli Lilly & Co. v. Board of Regents of the University of Washington

WilmerHale prevailed on behalf of its client, ZymoGenetics, Inc., the exclusive licensee of a University of Washington patent in an appeal brought by Eli Lilly & Co. in the Federal Circuit. The court upheld the dismissal of an interference proceeding concerning patent claims to DNA sequences coding for human protein C, which plays a role in the regulation of blood coagulation. The decision affirmed the United States Patent and Trademark Office's right to promulgate and interpret its own regulations governing patent interferences.

334 F.3d 1264 (Fed. Cir. 2003)

Berlex Laboratories, Inc. v. Biogen, Inc.

WilmerHale represented Biogen in a patent infringement case in the District of Massachusetts. Berlex accused Biogen's Avonex® product, used in the treatment of multiple sclerosis, of infringing two patents directed to the production of the human interferon protein in Chinese hamster ovary cells. We obtained summary judgment of noninfringement for Biogen. The Federal Circuit affirmed the district court's claim construction and judgment of no literal infringement.

318 F.3d 1132 (Fed. Cir. 2003)

Cincinnati Microwave, Inc. v. Whistler Corporation and Dynatech Corporation

WilmerHale represented both Whistler Corporation and Dynatech Corporation (now known as Acterna Corporation) in litigation commenced by Cincinnati Microwave. Cincinnati Microwave claimed that certain radar detectors manufactured and sold by the defendants infringe a patent directed to a "mute" feature. After extensive discovery, we obtained summary judgment in favor of our clients. Cincinnati Microwave appealed that decision to the Federal Circuit, where we obtained a summary affirmance of the district court's grant of summary judgment.

2001 WL 1631834; 25 Fed.Appx. 830 (Fed. Cir. 2001)

Southwest Software, Inc. v. ECRM, Inc.

In this action, WilmerHale defended ECRM against patent infringement claims brought in the Western District of Texas against it and two UK companies by Southwest Software, Inc. The technology at issue concerned calibration methods for electronic publishing software. After trial, the jury rejected the primary claims against ECRM, which then obtained full indemnification from its co-defendant for a small verdict and all litigation expenses. On appeal, the Federal Circuit vacated the monetary verdict, ruled that Southwest Software's certificate of correction to its central patent was applicable only prospectively, and remanded the case for a determination regarding patent invalidity and the reasons why the district court granted JMOL to the defendants on several claims of the patents.

226 F.3d 1280 (Fed. Cir. 2000)

Nova Biomedical Corporation v. i-STAT Corporation

WilmerHale represented Nova Biomedical in this patent infringement action against i-STAT Corporation, a manufacturer of blood analyzer instruments. The patent concerned a

method for calculating the hematocrit value in whole blood. The Federal Circuit, at Nova's request, reversed a grant of summary judgment of noninfringement and remanded the case to the district court. Nova prevailed on three other summary judgment motions. Shortly before trial, I-STAT agreed to pay Nova \$10 million for past damages and took a 4% nonexclusive license for future US sales.

215 F.3d 1351 (Fed. Cir. 1999)

Datapoint Corporation v. PictureTel Corporation

PictureTel retained WilmerHale to defend it in this litigation alleging infringement of two patents in the area of multi-point video conferencing. Datapoint sought damages exceeding \$600 million and a permanent injunction. After a four-week trial in the Northern District of Texas, a jury found that the asserted claims were not infringed and were invalid. The Federal Circuit upheld the jury's verdict of invalidity. The *National Law Journal* named this one of the top defense verdicts of the year.

215 F.3d 1344 (Fed. Cir. 1999); 1999 U.S. App. LEXIS 15786 (July 15, 1999)

Mehl Biophile v. Palomar Medical Technologies

WilmerHale represented Palomar in this patent infringement action in the District of New Jersey. The plaintiffs accused Palomar of infringing patents relating to the use of lasers for hair removal. Palomar moved for summary judgment of invalidity, asserting that the patents were anticipated by certain published prior art. The court granted the motion and invalidated the patents. The Federal Circuit affirmed.

192 F.3d 1362 (Fed. Cir. 1999)

Enzo Biochem v. Calgene

WilmerHale represented Calgene, the company which researched, developed and brought to market the genetically engineered tomato, in four litigations against Enzo Biochem involving four patents related to genetic antisense technology. After a three-week trial in the District of Delaware, the court found for Calgene on all claims. The Federal Circuit affirmed that the patents were invalid.

14 F. Supp. 2d 536 (D. Del. 1998); 188 F.3d 1362 (Fed. Cir. 1999)

Sextant Avionique, S.A. v. Analog Devices, Inc.

WilmerHale represented Analog Devices in this litigation commenced by Sextant Avionique in the Northern District of California. Sextant claimed that Analog's accelerometer products infringed certain patents owned by Sextant Avionique. After a two-week trial, the court determined that Analog did not infringe the Sextant patents. The Federal Circuit affirmed, applying for the first time the presumption barring application of the doctrine of equivalents set forth in the Supreme Court's *Hilton Davis* opinion.

172 F. 3d 817 (Fed. Cir. 1999)

Candela Laser Corporation v. Cynosure, Inc.

WilmerHale represented Cynosure, Inc. and Horace Furumoto in this patent infringement action commenced by Candela. Dr. Furumoto was the founder of the plaintiff, Candela Laser Corporation, the named inventor on the patents involved in the litigation and the founder of Cynosure. Candela alleged that the medical laser system manufactured and

marketed by Cynosure infringed two patents issued to Candela. After a three-week trial, the court found that Cynosure did not infringe one of the Candela patents and held the other Candela patent invalid. The Federal Circuit affirmed on both grounds.

862 F. Supp. 632 (D. Mass. 1994); *aff'd* 56 F. 3d 82 (Fed. Cir. 1995)

Ortho Pharmaceutical Corp. v. Genetics Institute, Inc.

WilmerHale represented Genetics Institute, Inc. in a proceeding commenced by Ortho Pharmaceutical and 11 of its affiliates. Ortho, the patent licensee, asserted its right to recover damages for Genetics Institute's infringement of a patent covering the intermediate product used to produce recombinant erythropoietin. Genetics Institute obtained summary judgment from the District of Massachusetts dismissing Ortho's claims. The Federal Circuit affirmed the district court dismissal, holding that because the license was non-exclusive and the license agreement did not confer a right to sue, the plaintiffs lack standing to sue for patent infringement.

808 F. Supp. 894 (D. Mass. 1992); 52 F.3d 1026 (Fed. Cir. 1995), cert. denied 116 S. Ct. 274 (1995); See also "*When An Exclusive License Is Not An Exclusive License: The Standing of 'Exclusive' Patent Licensees to Sue After Ortho Pharmaceutical Corp. v. Genetics Institute, Inc.*", 7 Fed. Bar. J. 1 (1997)

Genentech, Inc. v. The Wellcome Foundation Ltd. and Genetics Institute, Inc.

WilmerHale represented Genetics Institute, Inc. in an action brought against GI, The Wellcome Foundation, WelGen (a manufacturing joint venture between GI and Wellcome), and various other parties in two consolidated civil actions in the District of Delaware. This litigation involved alleged infringement of three patents which claim a tissue plasminogen activator marketed by Genentech. GI was represented by other counsel in the trial on these claims, which concluded in April of 1990. We assumed representation of GI after an unfavorable jury verdict, and briefed and argued the appeal to the Federal Circuit. The Federal Circuit reversed the jury verdict and entered judgment for GI.

29 F.3d 1555, 31 U.S.P.Q.2d 1161 (Fed. Cir. 1994)

Amgen, Inc. v. Genetics Institute, Inc.

WilmerHale represented Genetics Institute, Inc. (GI) in two related lawsuits in the Districts of Massachusetts and California. These cases involved patent claims relating to erythropoietin (EPO). At issue was the right to produce recombinant EPO, a genetically engineered protein which stimulates the production of red blood cells. GI claimed that Amgen infringed its patent, which covers a homogeneous form of the protein, and Amgen asserted that GI infringed its patent, which covered various components of the process used to produce the drug recombinantly. We tried a three-month jury-waived case involving the patents, and argued the appeal to the Federal Circuit. We also have represented GI in various foreign proceedings concerning foreign counterparts of those

927 F.2d 1200 (Fed. Cir 1991)

Specialty Composites v. Cabot Corp.

WilmerHale represented Cabot Corporation in an action brought by Specialty Composites in the District of Massachusetts seeking a declaratory judgment that Cabot's patent



claiming plastic foam earplugs was invalid, unenforceable and not infringed by Specialty. Cabot counterclaimed for patent infringement. The district court ruled that the plaintiff had failed to establish invalidity or unenforceability, but held that the patent had not been infringed. Cabot appealed. The Federal Circuit found that the district court had misinterpreted the patent claims and reversed the decision of noninfringement.

845 F.2d 981 (Fed. Cir. 1988)

Pharmacia v. MedChem Products, Inc.

WilmerHale represented MedChem Products, Inc. in an action over patent rights relating to hyaluronic acid, a substance with wide application in the ophthalmic and veterinary fields. Pharmacia A.B., a large Swedish pharmaceutical company, sued MedChem. We assumed representation after MedChem lost a phased trial which considered issues relating to the on-sale bar. We opposed a request for a preliminary injunction and prosecuted an appeal to the Federal Circuit, during which the case was settled.

Significant International Trade Commission Litigation

In the Matter of Certain Semiconductor Integrated Circuits Using Tungsten Metallization and Products Containing Same, Inv. No. 337-TA-648

WilmerHale obtained a significant victory in the US International Trade Commission on behalf of its clients Integrated Device Technology, Inc. and Grace Semiconductor Manufacturing Corporation in a patent infringement action relating to the manufacture of semiconductor wafers. The investigation, instituted in May 2008, was based on a complaint filed by LSI Corporation and Agere Systems Inc. The complaint alleged violations of section 337 in the importation into the US, the sale for importation, and the sale within the US after importation of certain semiconductor integrated circuits using tungsten metallization. The ITC ruled that the asserted claims of the patent-in-suit were invalid, that there was no Section 337 violation, and terminated the investigation.

In the Matter of Certain Mobile Telephones and Wireless Communication Devices Featuring Digital Cameras and Components Thereof, Inv. No. 337-TA-663; In the Matter of Certain Digital Cameras, Inv. No. 337-TA-671; In the Matter of Certain Electronic Devices Having Image Capture or Display Functionality and Components Thereof, Inv. No. 337-TA-672.

WilmerHale represented Kodak in three US International Trade Commission actions against Samsung and LG. In the first, Kodak asserted that Samsung and LG infringed two digital camera patents. In the second and third, respectively, Samsung and LG charged Kodak with infringement. In December 2009, Administrative Law Judge Charneski ruled in favor of Kodak in its offensive action finding both of Kodak's patents valid, enforceable and infringed. Samsung and LG's actions against Kodak were subsequently settled and terminated.

In the Matter of Certain Semiconductor Integrated Circuits Using Tungsten Metallization and Products Containing the Same, Inv. No. 337-

WilmerHale achieved a victory in the US International Trade Commission for its client STMicroelectronics N.V. ("ST"). LSI Corporation asserted that the products of 23 respondents, including ST, infringed one of its U.S. patents. ST maintained that all of its

products sold for importation and imported into the United States were done so through its U.S.-based subsidiary under a portfolio license granted by the patent's prior owner.

After LSI refused to dismiss ST from the ITC investigation, ST sued LSI in Delaware Superior Court for breach of contract and abuse of process. This strategic move forced LSI to squarely confront the license, and resulted in a number of concessions and stipulations on the issue favorable to ST. In addition, because LSI faced liability in Delaware for ST's costs in defending the ITC action, it did not push ST to respond to expensive ITC discovery.

ST filed a motion with the ITC for summary determination of no violation of Section 337. On June 26, 2009, Administrative Law Judge Charneski granted ST's motion, finding that LSI had not offered any strategy to prove infringement against ST, and dismissing ST from the investigation.

This represented WilmerHale's third ITC victory for ST, and the firm's eleventh consecutive ITC win overall.

In the Matter of Certain GPS Devices, Associated Software and Systems, and Products Containing the Same, Inv. No. 337-TA-602

WilmerHale successfully represented Broadcom Corporation and Global Locate, Inc. in a patent infringement investigation against SiRF Technology, Inc., MiTAC International Corp., Mio Technology Ltd., USA, E-TEN Corporation, and Pharos Science & Applications in the US International Trade Commission. The investigation alleged infringement of six patents covering aspects of global positioning system (GPS) technology. Global Locate initiated the investigation after SiRF brought an action in the ITC accusing Global Locate of infringing four SiRF patents, U.S.I.T.C. Inv. No. 337-TA-596. While SiRF lost the 596 investigation, Global Locate prevailed in the 602. Administrative Law Judge Carl Charneski ruled that SiRF and the other respondents infringed all asserted claims of all six patents and that all six patents were valid and enforceable. The Commission affirmed the ALJ's Initial Determination in favor of Global Locate and Broadcom and issued limited exclusion and cease and desist orders directed toward respondents' infringing products.

The Federal Circuit affirmed the ITC's decision, finding it had correctly banned the importation of the chips and products containing them.

In the Matter of Certain GPS Devices, Associated Software and Systems, and Products Containing the Same, Inv. No. 337-TA-5996

WilmerHale successfully represented Broadcom Corporation and Global Locate, Inc. in an action brought by SiRF Technology, Inc. before the US International Trade Commission. SiRF alleged infringement of more than 100 claims of four patents related to global positioning system (GPS) technology. Following a six-day trial, Administrative Law Judge Paul Luckern found that Broadcom and Global Locate did not infringe SiRF's patents and that all asserted claims of one patent were also invalid. The Commission affirmed the Initial Determination in favor of WilmerHale's clients.

In the Matter of Certain Recordable Compact Discs and Rewritable Compact Discs, Inv. No. 337-TA-474

WilmerHale secured an important victory for US Philips Corporation in the US International Trade Commission after remand from the Federal Circuit. The Commission issued a 108-page opinion, agreeing that Philips' package licensing of its patents for recordable and rewritable compact disc technology, including joint licensing with two other companies, did not constitute patent misuse on any of various theories put forward by unlicensed manufacturers, a Commission administrative law judge, and the Commission's staff. As a result, the Commission issued a general exclusion order barring infringing discs from entering the United States and cease and desist orders against the Taiwanese manufacturers and US importers that were the named respondents (whose discs had previously been held to infringe Philips' patents).

Certain Baseband Processor Chips and Chipsets, Transmission and Receiver (Radio) Chips, and Products Containing Same Including Cellular Telephone Handsets, Inv. No. No. 337-TA-543

WilmerHale represented Broadcom Corporation in an action against Qualcomm, Incorporated before the US International Trade Commission - one of a series of disputes between the parties involving numerous patents relating to computer chips for use in cellular telephones. The ITC case involved seven months of intense discovery, including more than 100 depositions and the exchange of several million documents, and a three-week trial before Administrative Law Judge Charles Bullock. In his Initial Determination, ALJ Bullock found that Qualcomm had infringed a Broadcom patent relating to an important power-saving mode used in cell phones. The Commission affirmed this finding. In a subsequent remedy proceeding by co-counsel, Broadcom obtained an exclusion order barring the importation of all new models of cellular telephones using Qualcomm's infringing chips.

In the Matter of NOR and NAND Flash Memory Devices and Products Containing Same, Inv. No. 337-TA-560

WilmerHale obtained a second major victory for its client, STMicroelectronics, against SanDisk in the US International Trade Commission. Shortly after termination of an earlier ITC proceeding, SanDisk initiated another ITC proceeding, this time claiming that STMicro infringed three additional SanDisk patents. SanDisk subsequently dropped one of the three patents from the investigation, and through pre-hearing motions, WilmerHale obtained a summary determination that none of ST Micro's next generation chips infringed either of the two remaining patents. Following a two-week hearing, Administrative Law Judge Charles Bullock issued an Initial Determination finding that one patent was invalid, and that SanDisk's efforts to show a domestic industry in the second patent (a prerequisite to an exclusion order) were so thoroughly disproven that SanDisk had "wast[ed] both public and private resources." At SanDisk's request, the parties agreed not to seek review of Judge Bullock's Initial Determination.

In the Matter of Certain Chemical Mechanical Planarization Slurries and Precursors to Same, Inv. No. 337-TA-566

WilmerHale initiated this US International Trade Commission investigation on behalf of Cabot Microelectronics, asserting infringement of three patents relating to planarizing

semiconductor chips in the fabrication process. Shortly thereafter, Cheil agreed to a Consent Order barring further importation of the accused products into the United States, thus protecting \$50 million of Cabot's annual U.S. sales. The White House recognized the victory during a visit by President Bush to Cabot's facility in Chicago.

In the Matter of Certain NAND Flash Memory Circuits and Products Containing Same, Inv. No. 337-TA-526

STMicroelectronics (ST) retained WilmerHale to represent it in litigation brought by Sandisk Corporation before the US International Trade Commission and the Northern District of California alleging infringement of a patent relating to NAND flash memory circuits. In an earlier ITC case, SanDisk (represented by the same counsel) had successfully obtained an exclusion order from the ITC on the same patent, preventing Samsung Corporation from importing its NAND flash memory products into the United States. SanDisk also had put the patent through a successful reexamination proceeding, during which the PTO rejected Samsung's best claim construction and invalidity arguments and allowed new dependent claims tailored to avoid Samsung's defenses. Against ST, SanDisk argued that the ST NAND flash memory circuits were substantially identical to those of Samsung, and infringed the patent for the same reasons. Following a seven-day hearing, Administrative Law Judge Paul Luckern issued an Initial Determination finding that ST's NAND flash memory circuits do not infringe the SanDisk patent, that they lacked multiple required elements of each asserted claim, and that ST had not violated 19 U.S.C. Section 1337. ALJ Luckern's Initial Determination of no violation was adopted by the Commission.

In the Matter of Certain Digital Image Storage and Retrieval Devices, Inv. No. 337-TA-527

WilmerHale successfully represented Eastman Kodak Company and Altek Corporation in this patent infringement action brought by Ampex in the US International Trade Commission. Early in the case, Kodak/Altek moved to disqualify Ampex's invalidity expert based on prior consulting work he had performed on behalf of Kodak. After losing the initial motion, Kodak/Altek conducted discovery and then filed a motion for reconsideration. Finding a "clear conflict of interest" and that Ampex had not been "candid and forthright" with respect to the expert's background, the Administrative Law Judge granted Kodak/Altek's motion and disqualified the expert shortly before trial. Faced with the prospect of trial without an invalidity expert, and after Kodak/Altek's filing of substantive written submissions on noninfringement and invalidity, Ampex moved to dismiss its complaint.

Cirrus Logic, Inc. v. Wolfson Microelectronics, Inc. (2004)

Wolfson Microelectronics retained WilmerHale to represent it in litigation brought by Cirrus Logic before the US International Trade Commission alleging infringement of two patents relating to digital-to-analog circuits. After a nearly two-week trial, the ITC agreed with Wolfson that the key patent at issue was unenforceable because the inventors failed to disclose highly material prior art to the Patent Office, with the intent of deceiving the PTO. Prior to the trial, Wolfson had obsoleted two of the three products accused of infringing the second patent due to lack of market demand, and modified the third to remove the disputed feature. Related litigation in the Southern District of California was subsequently settled on mutually agreeable terms.



In re Certain Tool Handles, Tool Holders, Tool Sets and Components, Inv. No. 337-TA-483

WilmerHale served as co-counsel for respondent Danaher in this Section 337 action before the US International Trade Commission initiated by Allen-Pal. The case terminated after we successfully obtained a summary determination of non-infringement.

In re Certain Microlithographic Machines, Inv. No. 337-TA-463

WilmerHale represented ASML Holding in this case initiated by its chief rival, Nikon Corporation, in the US International Trade Commission and the Northern District of California. After a five-week trial, an Administrative Law Judge ruled that each of the 15 patent claims Nikon had asserted was not infringed, invalid and/or unenforceable due to inequitable conduct. The ITC adopted the ALJ's decision. At issue was approximately \$1.8 billion in annual sales in the market for photolithographic equipment. Related litigation in the Northern District of California, involving an additional five patents, subsequently settled.

In re Certain Set Top Boxes, Inv. No. 337-TA-451

Gemstar retained WilmerHale to represent it in two appeals after Direct TV, Echostar, Scientific-Atlanta, Pioneer and others convinced the district court and the US International Trade Commission that they had not infringed patents relating to online television programming guides. We obtained Federal Circuit decisions reversing the district court's and ITC's claim constructions and remanding for reconsideration of the infringement issues. Gemstar subsequently licensed the patents (along with related intellectual property) to three of the defendants, including a license to Echostar for \$190 million.

In re Certain Monolithic Microwave Integrated Circuit Downconverters, Inv. No. 337-TA-384

WilmerHale represented Raytheon in this action commenced by Anadigics in the US International Trade Commission and the Southern District of New York. Anadigics asserted claims against Raytheon under the Semiconductor Chip Protection Act. The case settled shortly before commencement of the ITC hearing.

In the Matter of Certain Acid-Washed Denim Garments and Accessories, Including Jeans, Jackets, Bags and Skirts, Investigation No. 337-TA-324

WilmerHale represented Francesco Ricci, the inventor of the process for creating acid washed denim products, and the exclusive licensee of his US patent, Greater Texas Finishing Corporation, in a proceeding before the US International Trade Commission. After a trial before an administrative law judge and a Commission hearing, the Commission found in favor of Greater Texas and issued a general exclusion order barring the import of acid washed denim products into the United States.

In re Certain Plastic Encapsulated Circuits, Inv. No. 337-TA-315

WilmerHale successfully represented integrated circuit maker Analog Devices, Inc. in an enforcement proceeding before the US International Trade Commission. Analog prevailed both before the ITC Administrative Law Judge and the full Commission in having the enforcement claims and request for substantial penalties dismissed, over the objection of the ITC's own Office of Unfair Import Investigations.

In re Certain Removable Hard Disk Cartridges, Inv. No. 337-TA-351

WilmerHale represented respondent Nomai, S.A. in this Section 337 trade secret case before the US International Trade Commission. The case ultimately settled.

Significant Patent Litigation

Ethicon Endo-Surgery, Inc. v. Hologic, Inc., et al

WilmerHale defended its client Hologic, Inc. in a patent infringement action in the Southern District of Ohio. Ethicon Endo-Surgery asserted that Hologic's ATEC breast biopsy device infringed four Ethicon patents. The case settled during trial.

SoundBite Communications, Inc. v. Universal Recovery Systems, Inc. et al

WilmerHale represented SoundBite Communications, Inc. in a suit against Universal Recovery Systems, Inc., and its CEO stemming from URS's interference with SoundBite's initial public stock offering (IPO). On the day the IPO shares were to be priced, URS accused SoundBite of infringing several of its patents and a pending patent application, causing a delay of the IPO. SoundBite filed suit in the District of Massachusetts for a declaratory judgment of non-infringement and patent invalidity, as well as tortious interference. Within days, URS covenanted not to sue SoundBite under its patents, but not the patent application. SoundBite amended its complaint to withdraw the declaratory judgment claims, and added a claim for unfair or deceptive business practices. WilmerHale successfully opposed URS's motion to dismiss and motion for summary judgment, and obtained an expedited trial schedule. Before trial was to begin, the case settled on terms very favorable to WilmerHale's client, with URS making a payment of \$4.6 million to SoundBite, as well as granting a worldwide, paid-up, royalty-free license covering all of SoundBite's past and current automated voice messaging solutions.

Pellegrini v. Analog Devices, Inc.

WilmerHale obtained summary judgment of patent noninfringement on behalf of Analog Devices, Inc. with respect to patents involving motor control electronics and a claim that a US patent could reach the foreign activities of a US company. The Federal Circuit affirmed on this issue of first impression. The district court then entered Rule 11 sanctions (including dismissal and an award of attorney fees) against the plaintiff for continuing to pursue his claims, which the Federal Circuit affirmed as well.

375 F.3d 1113 (Fed.Cir. 2004); *aff'd* 312 Fed. Appx. 304 (Fed. Cir., June 5, 2008)

PowerOasis Inc., et al v. T-Mobile USA, Inc.

WilmerHale represented T-Mobile USA in a patent infringement lawsuit, in the District of New Hampshire, based on two patents relating to power and telecommunications access to vending machines. PowerOasis claimed that T-Mobile's Hot Spot Network, available in locations such as Starbucks, infringed the patents. WilmerHale obtained summary judgment in favor of T-Mobile, on the ground that the asserted claims were anticipated by a prior T-Mobile system. The Federal Circuit agreed with the district court on all counts, and affirmed the finding of invalidity.

522 F.3d 1299 (Fed. Cir 2008)

PowerOasis, Inc et al v. Wayport, Inc.

WilmerHale represented Wayport, Inc. in a patent infringement action by PowerOasis in the District of Massachusetts. PowerOasis asserted that Wayport's high-speed Internet access services, offered in airports and hotels, infringed two patents relating to power and telecommunications access vending machines. WilmerHale defeated PowerOasis' motion for a preliminary injunction, and ultimately obtained a Markman ruling limiting the claims to a particular type of machine for vending telecommunications access. Subsequently WilmerHale convinced the court that none of the many claims asserted against Wayport was infringed, and obtained summary judgment dismissing the case. PowerOasis appealed, resulting in an outcome even more favorable to WilmerHale's client. The Federal Circuit vacated the judgment of non-infringement, and remanded the case with instructions to the district court to enter a judgment consistent with a holding of patent invalidity in a related case against T-Mobile involving the same patents, also defended by WilmerHale.

Slip Op., 2008 WL 1712318 (Fed. Cir., April 11, 2008)

Ampex Corp. v. Eastman Kodak Company and Altek Corporation

Ampex filed this lawsuit against WilmerHale's clients Kodak and Altek in the District of Delaware, asserting that Kodak's digital cameras infringed an Ampex patent relating to the generation and storage of reduced size images. Ampex asserted that it was entitled to treble damages for willful infringement, totaling over \$80 million. We convinced the court that the claims were not infringed because a key claim limitation was not met. The court accordingly granted summary judgment dismissing the case. The Federal Circuit summarily affirmed the finding of non-infringement.

263 Fed. Appx. 885 (Fed. Cir., Feb. 7, 2008)

Cytec Corporation v. Tripath Imaging, Inc.

WilmerHale's client Cytec Corporation is the leading manufacturer of state-of-the-art Pap test equipment. Cytec sued TriPath in the District of Massachusetts for declaratory judgment that Cytec's ThinPrep Imaging System, a device used to facilitate the screening of Cytec's liquid-based Pap tests, did not infringe four TriPath patents and that the patents were invalid. After claim construction briefing and a Markman hearing, the court construed most of the important claim terms favorably to Cytec. After the Markman ruling, TriPath conceded that there was no literal infringement of one of the four patents in suit. Cytec filed motions for summary judgment on all four patents based on the Markman ruling. The case settled shortly after the court issued its summary judgment rulings.

Broadcom Corporation v. Qualcomm Incorporated

Qualcomm filed this case against WilmerHale's client Broadcom, after Broadcom initiated litigation on its own patents in the US International Trade Commission and the Central District of California. Qualcomm claimed that Broadcom was infringing seven patents, all of which it had previously declared essential to wireless standards. According to Qualcomm, its declarations meant that the wireless standard could not be practiced without infringing the Qualcomm patents. After multiple-day Markman hearings on each patent, the Southern District of California issued Markman rulings favorable to Broadcom. Following the Markman rulings, Qualcomm dismissed four of the patents from the case with prejudice. On the day before trial, Qualcomm dismissed the remaining three patents. The terms of the settlement are confidential.

Xerox Corporation v. U.S. Robotics Corp. et al

Palm Computing retained WilmerHale to represent it in this appeal, after Xerox prevailed on claims that Palm had infringed a patent relating to handwriting recognition and that the patent was valid. Xerox claimed that its patent covered the "graffiti software" used in millions of Palm's popular "Palm Pilot" products. WilmerHale obtained a Federal Circuit decision reversing the district court's ruling that the patent was valid. The Western District of New York subsequently issued a summary judgment finding that the patent was not valid. Following a second appeal, remanding the case for further consideration of the validity issue, the case settled.

66 USPQ 2d 1216; 61 Fed.Appx. 680 (Fed. Cir. 2003); 458 F.3d 1310 (Fed. Cir. 2006)

Palomar Medical Technologies, Inc., et al v. Cutera, Inc.

WilmerHale represented Palomar Medical Technologies and Massachusetts General Hospital in a patent infringement action against Cutera in the District of Massachusetts, on a patent related to laser hair removal. After we successfully opposed summary judgment, Cutera agreed to a consent judgment that our clients' patent was infringed, valid, and enforceable; paid \$22 million including our past damages claim, an additional payment of 1% of sales, and \$4 million to cover our clients' attorney fees; and signed a license going forward at the full 7.5% royalty rate.

EMC Corporation v. Hewlett-Packard Company, Inc.

WilmerHale represented EMC in this case claiming infringement of three patents relating to computer storage technology. During the course of the litigation, Hewlett-Packard acquired the original defendant—whose primary product was accused of infringement—for \$350 million. After a two-week trial, we won a jury verdict finding that each of the asserted claims had been infringed by Hewlett-Packard and was valid. The damages portion of the case subsequently settled.

Schreiber Foods, Inc. v. Beatrice Cheese, Inc. and Kustner Industries,

WilmerHale undertook representation of Kustner Industries, S.A. following the entry of a \$26 million dollar adverse jury verdict subject to trebling. On a post-trial motion, the district court set aside the verdict, finding that no reasonable jury could have found infringement. That decision was reversed by the Federal Circuit on appeal and, following the denial of certiorari by the United States Supreme Court, judgment against our client was entered. One month later, WilmerHale discovered that the plaintiff had transferred the patents prior

to trial in pursuit of a strategy to reduce state taxes, and moved for relief under Rules 60(b)(2) (misrepresentation) and 60(b)(4) (void judgment). After limited discovery granted by the district court demonstrated that a witness who had testified that the plaintiff owned the patent was aware of the transfer, and that trial counsel had known of the transfer during the period of the post-trial motions, the district court vacated the judgment and dismissed the case holding that it lacked jurisdiction and, in the alternative, granting the motions on the grounds of misrepresentation and void judgment. On appeal, the Federal Circuit reversed the district court's decision of lack of jurisdiction but, in a strongly worded opinion, affirmed the district court's grant of a new trial based on misconduct, and held the plaintiff to a waiver of damages it had made during the appeal.

402 F.3d 1198 (Fed. Cir. 2005)

Summit Technology, Inc., v. Garabet

WilmerHale represented Summit Technology, Inc. in pursuing patent infringement claims against a variety of defendants in multi-district antitrust litigation in the District of Arizona. The patents relate to laser photorefractive keratectomy of the eye. The case settled.

Curtis International v. Douglas Dynamics

WilmerHale represented Douglas Dynamics, Western Products and J.C. Madigan, Inc. in a patent infringement action brought by Curtis International. The patents-in-suit were directed to vehicle hitch mount assemblies for snow plows. After a period of discovery, the matter settled.

Townshend Intellectual Property, LLC v. Analog Devices, Inc.

WilmerHale represented Analog Devices in multi-party litigation with Townshend involving seven patents related to modem technology, which was resolved by settlement.

Northrop Grumman Corporation v. Intel Corporation

Intel retained WilmerHale to represent it in a patent infringement action commenced by Northrop Grumman in the Eastern District of Texas. Northrop asserted that it held a patent that covered all Ethernet bus connections and sought hundreds of millions of dollars in damages. We conducted extensive briefing for a Markman hearing. The claims and case were ultimately and quickly resolved in the manner Intel had proposed.

ICN Photonics v. Cynosure Inc.

WilmerHale represented Cynosure in an action filed against it by one of its competitors, ICN Photonics, in the District of Massachusetts. We obtained a summary judgment that invalidated ICN's patent on "Wrinkle Removal" using a laser, for failing to comply with the "written description" requirement of 35 U.S.C. 112. The Federal Circuit vacated, after which the case settled.

Baker Hughes Incorporated v. C.J.Hensley v. U.S. Filter

WilmerHale represented United States Filter Corporation in an action for patent infringement and breach of a licensing agreement. United States Filter prevailed in an early motion to dismiss and the action was dismissed.



lomega Corporation v. SyQuest Technology Corporation

WilmerHale represented Utah-based lomega Corporation in a case involving both design and utility patents relating to technology used in lomega's well-known ZIP and JAZ drives. This case, which was filed in the District of Delaware, concluded when lomega's chief competitor, SyQuest, filed for bankruptcy. lomega subsequently purchased certain of SyQuest's intellectual property assets.

American Superconductor Corporation v. Massachusetts Institute of Technology

WilmerHale represented American Superconductor in this "patent interference" proceeding in the District of Massachusetts. American Superconductor exclusively licenses an important patent in the field of high-temperature superconductors and is the owner of a patent application in the same field. The Patent Office found that the patent and application "interfered." American Superconductor appealed this decision to the District of Massachusetts and, in a highly unusual move, the Patent Office intervened to defend its decision. After a bench trial, we obtained a judgment finding that the patent and application claimed separate inventions, thus entitling our client to both, and according a very broad construction to the patent.

Valitek, Inc. v. lomega Corporation

WilmerHale represented lomega in defense of a patent infringement claim relating to communication between computers and peripheral devices through the computer's parallel port, in the District of Utah. After Markman and summary judgment briefing, the case was settled.

Digital Equipment Corporation v. Intel Corporation

WilmerHale represented Intel in two cases involving the assertion of more than 20 patents owned by DEC and Intel against each other in the Districts of Massachusetts and Oregon. The patents at issue involved microprocessor architecture, cache memory, flash memory, heat dissipation for laptop computers, video compression and other subjects. The cases ultimately settled.

Aprisma Management Technologies v. System Management Arts, Inc.

WilmerHale defended Systems Management Arts, Inc. against a claim of patent infringement involving its systems management product. SMARTS counterclaimed for a declaratory judgment of invalidity and unenforceability of the patents-in-suit, and for copyright infringement and misappropriation of trade secrets by Aprisma. Following a period of discovery, the case settled.

Ezenia! Inc. v. Accord Telecommunications

WilmerHale represented Ezenia! Inc. in a patent litigation against Accord Telecommunication for infringement of three patents relating to multipoint control units used in video conferencing. After initial deposition discovery, the matter settled.

Elan Pharmaceuticals v. Eli Lilly

WilmerHale represented AHPC (strategic partner to Elan) in a breach of contract, trade secret and inventorship dispute. The dispute occurred as a result of the winding-down of Lilly's 10-year relationship with Elan in the area of Alzheimer's disease research. Elan's invention is considered publicly to be the leading treatment of Alzheimer's. After months of litigation, the case was eventually settled after court ordered mediation.

TM Patents, L.P. v. EMC Corporation

WilmerHale represented EMC in a patent litigation commenced by TM Patents in the District of Massachusetts. The patent was directed to certain disk storage systems and RAID technology. The case settled after a one-week Markman hearing and two weeks of trial before a jury.

Comverse Network Systems, Inc. v. Priority Call Management, Inc.

WilmerHale represented Comverse in this patent infringement and trade secret action against Priority Call Management in the District of Massachusetts. The technology at issue involved large scale, distributed architecture voice mail and messaging systems. The case settled at the close of discovery.

SCIMED Life Systems, Inc. v. Cordis Corporation

WilmerHale represented SCIMED in a patent infringement action brought against Cordis in the District of Minnesota in which SCIMED claimed that Cordis infringed patents relating to angioplasty catheters and catheter balloons. The case was dismissed in conjunction with the dismissal of a case brought by Cordis against SciMed.

Cordis Corporation v. SCIMED Life Systems, Inc.

WilmerHale represented SCIMED Life Systems in a patent infringement action commenced by Cordis Corporation in the District of Minnesota. The litigation involved claims that SCIMED's catheter balloon infringed certain patents owned by Cordis Corporation. Following a Markman hearing, the case was administratively dismissed.

Linear Technology v. Impala Linear Corp.

WilmerHale represented Analog Devices in a patent infringement action commenced by Linear Technology in the Northern District of California. The patent relates to synchronous switching regulators. Analog was dismissed from the case with no payment of money.

Lemelson v. Analog Devices, Inc.

WilmerHale represented Analog Devices in litigation involving 16 patents and numerous parties in the District of Arizona. The patents allegedly relate to various semiconductor manufacturing processes. After initial discovery, the case settled.

Broadvision, Inc. v. Art Technology Group, Inc.

WilmerHale represented Art Technology Group in a patent infringement action commenced by Broadvision in the District of California. The patent relates to e-commerce systems that provide personalized shopping experiences. The case settled after claim construction and discovery, during the summary judgment phase.

Rodel, Inc., v. Cabot Corporation

WilmerHale represented Cabot Corporation in two patent litigations commenced by Rodel, Inc. in the District of Delaware. The patents relate to chemical-mechanical polishing compositions and methods. The case was successfully settled.

Analog Devices, Inc. v. Standard Microsystems Corporation

WilmerHale represented Analog Devices in a case in the District of Massachusetts against Standard Microsystems involving three patents related to thermal management in electronic devices. The case settled, with a multi-million dollar payment to Analog.

Eastman Kodak Co. v. FileNet Corporation

WilmerHale represented Kodak in an action to enforce against FileNet Corporation five patents that Kodak acquired from Wang Laboratories. The technology concerned the storage and distribution of large volumes of electronic documents, including for work flow purposes. Kodak successfully defeated FileNet's motions for summary judgment of noninfringement and invalidity on the key patent. Shortly thereafter, FileNet took a nonexclusive license and paid a substantial settlement to Kodak.

Datapoint Corporation v. Madge Networks

WilmerHale represented Madge Networks in this patent infringement action commenced by Datapoint in the District of New Jersey. The patents relate to multi-point videoconferencing. The case was dismissed after we invalidated Datapoint's patents in *Datapoint Corp. v. Picturitel Corp.*

Taboada v. Summit Technology, Inc.

WilmerHale represented Summit Technology and, certain of its affiliates in this litigation, commenced in the Western District of Texas against Summit and other companies. The plaintiff alleged ownership and infringement of a basic patent relating to laser refractive surgery. The district court entered summary judgment dismissing all claims against the Summit entities. Before the entry of summary judgment, the plaintiff's most recent settlement demand had been several million dollars.

Analog Devices, Inc. v. Texas Instruments Incorporated

WilmerHale represented Analog in two cases in which Analog and Texas Instruments asserted various patents relating to integrated circuits and digital signal processing against each other in proceedings in the Eastern District of Texas and the District of Massachusetts. The cases were settled in a global resolution of all disputes between Analog and Texas Instruments.

GFI, Inc. v. Palliser Furniture Industries, Inc.

WilmerHale represented Palliser Furniture in a litigation brought by GFI against various defendants, asserting infringement of the same patent that had been at issue in *Gentry Gallery, Inc. v. Berklinc Corp.*, 134 F.3d 1473 (Fed. Cir. 1998). The patent was found unenforceable.

Moll v. Netrix Corp.

WilmerHale represented Netrix Corporation in this patent infringement action involving voice compression software. After receiving an adverse ruling on claim interpretation in a related case, the plaintiff dismissed his claims against Netrix.

United States Filter Corp. v. Ionics, Inc.

WilmerHale represented United States Filter Corporation in two separate patent litigations in the District of Massachusetts. United States Filter claimed infringement of multiple patents involving a liquid purification technology known as electrodeionization. After United States Filter had successfully defeated several motions for summary judgment, the case settled. 68 F. Supp. 2d 48 (D. Mass. 1999); 128 F. Supp. 2d 56 (D. Mass. 1999)

Phonetel Communications, Inc. v. AT&T Corp.

WilmerHale defended Arch Communications Group against patent infringement claims brought by Phonetel, a licensing company, against numerous telephone, computer and paging companies in the Northern District of Texas. The case settled with a modest payment by Arch's paging equipment supplier, and Arch was fully indemnified and reimbursed for all of its expenses by the supplier.

Digcom Inc. v. Analog Devices, Inc.

WilmerHale represented Analog in a patent infringement case brought by Digcom in the Northern District of California. The patent involves claims to cross-correlation of communications signals in quadrature phase shift keying modems, commonly used in radio systems. The case settled.

Motorola, Inc. v. U.S. Robotics Corporation

WilmerHale represented U.S. Robotics in this action brought by Motorola in the District of Massachusetts. Motorola sued on eight patents relating to high speed modems and U.S. Robotics counterclaimed on two of its patents. The case settled while in pretrial discovery.

AltaRex Company v. Biomira Inc.

WilmerHale represented AltaRex, a biotechnology company developing products for the treatment of ovarian cancer, and certain AltaRex employees in connection with litigation against Biomira in the Canadian courts involving issues such as patent ownership, inventorship and scope of a license agreement covering certain antibodies and information used in anti-idiotypic induction therapy. The case settled early in the litigation.

Analog Devices Inc. v. Linear Technology Group

WilmerHale represented Analog Devices in patent litigation with Linear Technology Corp. involving integrated circuit technology. The case was settled.

Washington Research Foundation v. Osteometer A/S

WilmerHale represented the Washington Research Foundation and Ostex International in a patent infringement suit against Osteometer A/S of Rodovre, Denmark. The patent at issue was directed to the measurement of C-terminal telopeptides as in vivo markers of bone degradation. The suit was filed in the District of Washington and, following discovery, was settled.

Arch Communications v. MetroCast

This action in the District of Massachusetts related to telephone paging technology and the networks that facilitate such paging. WilmerHale's client, Arch Communications Group, Inc., was the owner of the patents being asserted against the defendant, MetroCast. The matter ultimately settled on terms highly favorable to Arch Communications.

ECC International Corp. v. Deutsche Wurlitzer, GmbH

WilmerHale represented ECC in a patent infringement and trade secret action involving vending machines. The suit was pending in the Southern District of New York until it settled.

SBC Technology Resources, Inc. v. Eclipsys Corp.

WilmerHale represented Eclipsys in this lawsuit in the Northern District of Texas alleging infringement of a patent that SBC claimed to cover storage area networks. We secured a favorable settlement shortly after taking over the case.

Wang Laboratories, Inc. v. Microsoft Corporation

WilmerHale represented Wang Laboratories in its assertion of two software patents against Microsoft Corporation in the District of Massachusetts. The technology at issue primarily concerned the object linking and embedding feature present in Windows 95. The case settled after nearly two years of litigation with a creative approach that included the investment by Microsoft of more than \$80 million in Wang, along with a license by Wang to Microsoft of Wang's patent portfolio and the inclusion of Wang software in Microsoft's Windows products.

Litton Systems Inc. v. Fibersense Technology

WilmerHale represented FiberSense Technology in a patent litigation commenced by Litton in the Central District of California involving six patents related to fiber optic gyroscopes. The case was settled with a strategic alliance between Litton and Fibersense.

Millipore Corp. v. Mott Metallurgical Corp.

WilmerHale represented Mott Metallurgical Corp. in a declaratory judgment action commenced by Millipore. Mott counterclaimed for infringement of its patent covering high efficiency metal filters. The action, pending in the District of Massachusetts, settled.

Summit Technology, Inc. v. VISX, Inc.

WilmerHale represented Summit Technology in a patent infringement action in the District of Delaware. Summit owns certain patents relating to the use of lasers for the use in photorefractive keratectomy. Summit alleged that VISX infringes one of those patents. The case has been settled.

Unitrode Corporation v. Burr-Brown

WilmerHale represented Unitrode in an action against Burr-Brown alleging infringement of two of Unitrode's patents related to SCSI bus terminators. The case settled.

Selvac Acquisitions v. Milgram

WilmerHale represented Palomar in this patent infringement action pending in the District of New Jersey. The plaintiffs accused Palomar of infringing patents relating to the use of lasers for hair removal. Palomar moved for summary judgment of invalidity, asserting that the patents were anticipated by certain published prior art. The court granted the motion and invalidated the patents.

8 F. Supp. 2d 434 (D. N.J. 1998)

Nova Biomedical Corporation v. Mallinckrodt Sensor Systems, Inc.

WilmerHale represented Nova Biomedical against Mallinckrodt Sensor Systems, Inc. Nova asserted a patent regarding the measurement of hematocrit in blood analyzers. The case settled favorably after Nova obtained summary judgment dismissing the defendant's counterclaim and affirmative defense of inequitable conduct.

997 F. Supp. 187 (D. Mass. 1998)

Bose Corporation v. Matsushita Electric Industrial Company, Ltd.

WilmerHale represented Bose Corporation in this patent infringement action against the Japanese parent corporation and the American subsidiary of Matsushita Electric, also known as Panasonic, and one of its OEM distributors, ViewSonic Corporation. The technology at issue was Bose's Acoustic Wave technique for reproducing a full range of sound in high quality loudspeakers for home and commercial use. The case, which was brought in the District of Massachusetts, settled shortly after it was filed.

Thorn EMI v. NMB Technology

WilmerHale represented Thorn EMI, the patent owner, in a suit against NMB Technology of Japan. The three asserted patents related to D-RAM semiconductors. A week-long evidentiary hearing on a preliminary injunction was held in the District of Massachusetts. While the injunction motion was under advisement, the case settled with a substantial payment to Thorn EMI.

Volt Information Sciences, Inc. v. Cascade Systems, Inc.

WilmerHale represented Cascade, which was sued for patent infringement by Volt. The workflow systems patent at issue relates to a trade advertisement management system in which a large number of advertisements are assembled from textual and graphical components. The particular dispute was over a system that Cascade developed for the yellow pages market. The case settled.

Hologic, Inc. v. Lunar Corporation

WilmerHale represented Hologic, Inc., a manufacturer of x-ray and ultrasound densitometers used in the diagnosis of bone diseases, against Lunar Corporation, a competitor in the same business. These competing patent infringement actions, pending in the Districts of Wisconsin and Massachusetts, were settled with a cross-license agreement.

Avia Group International, Inc. v. Nike Inc.

WilmerHale represented Avia Group International, Inc., a subsidiary of Reebok International Ltd., in an action against Nike, Inc. in the District of Oregon. Avia alleged that Nike's highly publicized Air 180 running and basketball shoes infringed the patents covering Avia's cantilever technology. Nike asserted certain counterclaims against Avia. The case was settled shortly after the conclusion of discovery.

Gloucester Engineering Co. v. Addex, Inc.

WilmerHale represented Addex, Inc. in an action commenced by Gloucester Engineering Co. for infringement of its patent covering an ultrasonic device used to control the diameter of extruded plastic film, commonly used in the manufacture of plastic trash bags. The case settled.

Tropix Inc. v. Lumigen, Inc.

WilmerHale represented Lumigen, Inc. in this patent infringement litigation brought by Tropix in the District of Massachusetts. Tropix sued Lumigen on product-by-process claims directed to dioxetanes purified by a particular process. The dioxetane compounds—which generate light when triggered—are used as labels in various diagnostic applications. Lumigen maintained that it did not use the purification process described in the product-by-process claims. We successfully obtained summary judgment of noninfringement.

851 F. Supp. 25, 32 U.S.P.Q.2d 1638 (D. Mass. 1994)

Repligen, Inc. v. Aaston, Inc.

WilmerHale represented Repligen, Inc. in this patent infringement action against a British company, Aaston, Inc. in the District of Massachusetts. The case settled shortly after it was filed when the defendant entered into a consent decree enjoining it from any further infringement of Repligen's patent.

Digital Equipment Corp. v. System Industries, Inc.

WilmerHale represented Systems Industries, Inc. in this litigation brought in the District of Massachusetts by Digital Equipment Corporation. DEC alleged that a number of its patents had been infringed by products of Systems Industries which communicate with

DEC's standard disc/tape interconnect controller products and input/output servers. Systems Industries' defenses included non-infringement, implied license, obviousness, patent misuse and other statutory bars. The case settled after discovery.

Columbia University v. Genetics Institute

WilmerHale represented Genetics Institute, Inc. in this action brought by Columbia University in the District of Delaware. Columbia alleged that GI's production of EPO infringed a patent covering a process for inserting genes into host cells and for amplifying the genetically modified host cells. GI claimed that it did not infringe Columbia's patent and that Columbia's patent was invalid. This case settled in the early stages of discovery.

Cetus v. DuPont

WilmerHale represented Cetus in this matter against DuPont for infringement of its patent covering purified and isolated Taq, the enzyme used to drive the polymerase chain reaction. Shortly before litigation was to commence, DuPont withdrew its Taq product from the market. We assisted Cetus in negotiating patent licenses with several licensees for the use of this enzyme.

Porter v. Tamfelt, Inc.

WilmerHale represented Tamfelt in an action by Porter concerning a patent covering a machine for producing paper. Porter sought to be named an inventor of the patent. After extensive discovery, the District of Massachusetts granted Tamfelt summary judgment dismissing Porter's claims.

Dymax Corporation v. Hoffrel/Phillips/Elscint

WilmerHale represented Dymax Corporation, the holder of a patent relating to medical ultrasound transducers, in cases involving patent infringement and breach of contract claims against an exclusive licensee, sub-licensees and other third parties. The Hoffrel litigation involved an exclusive licensee who failed to meet sales quotas and ignored a notice of termination. We filed this case in the District of Connecticut and obtained a directed finding for Dymax after a trial on the breach of contract issue. During post-trial discovery on the patent issues, the matter settled.

The Phillips case was a follow-up to the Hoffrel litigation. As a result of the favorable finding against Hoffrel, Dymax was able to obtain a lump sum paid-up license from Phillips Ultrasound, a division of North American Phillips Corporation, without any litigation.

The Elscint case was an infringement action brought by Dymax against Elscint, an Israeli high technology company, for infringement of the same ultrasound patent involved in the Hoffrel and Phillips matters. The case settled after extensive discovery.

Bose Corporation v. Contraves-Goerz

WilmerHale represented Bose Corporation in this patent infringement action involving a Bose patent that has wide application in the loudspeaker, robotics and automatic tool control areas. Bose brought the action against a former licensee and—following extensive discovery—the case settled.

Information International Inc. v. CompuGraphic Corp.

WilmerHale represented CompuGraphic in a patent lawsuit brought by Information International Inc. The patent was directed to computer-generated characters that produced type fonts. After completion of discovery, the case settled.

BioPolymers v. Genex Corporation

WilmerHale represented Genex in a patent infringement action brought by BioPolymers in the District of Connecticut. The patent was directed to certain decapeptides derived from mollusks that could be used as a biomedical glue. After a period of discovery, the case settled.

Bernard Taylor v. Computervision Corporation

Bernard Taylor asserted Computervision infringed his patent covering the method for depicting three-dimensional objects in perspective on a two-dimensional surface. WilmerHale conducted discovery and began a jury trial. The case settled during trial.

Acushnet Co. v. Spalding

WilmerHale represented Acushnet and its Titelist Division in four patent infringement actions against Spalding in the District of Massachusetts. All four suits were patent infringement actions involving technology used in the production and design of golf balls. The first cases involved a Spalding patent relating to polymer chemistry and the composition of covers used on premium golf balls. Significant issues at trial included the on-sale bar and whether Spalding had complied with the best mode requirement. This case settled after appellate argument before the Federal Circuit.

The other three cases involved Acushnet patents relating to the technology of using optical brighteners in golf ball covers, the number and layout of dimples on a golf ball cover and the process of using hobs to make golf ball molds. Those cases, which were in the discovery phase, settled with the first case.

Plasma Physics Corporation v. Analog Devices Inc.

WilmerHale represented Analog Devices in a case involving two patents related to semiconductor processing in the Eastern District of New York. The case settled.

Motorola, Inc. v. Analog Devices, Inc.

WilmerHale represented Analog Devices in patent litigation with Motorola in the Eastern District of Texas involving eleven patents related to integrated circuits and semiconductors. The case settled.

Lumenis Ltd v. Palomar Medical Technologies, Inc.

WilmerHale represented Palomar in litigation with Lumenis involving two patents related to lasers. The case settled.

Significant Trademark / Trade Dress Litigation

Powertrain, Inc., et al v. American Honda Motor Co., Inc.

WilmerHale successfully represented American Honda in a six-day jury trial before Judge Mills in the Northern District of Mississippi. The case involved the trade dress of American Honda's GX series engines, which American Honda claimed was being copied by several Mississippi-based distributors and retailers of Chinese-manufactured copy engines. At the conclusion of trial, the jury returned a verdict that American Honda's trade dress constituted a valid trademark and that the defendants were infringing that mark. The district court subsequently entered a permanent injunction against the defendants. The district court also entered judgment in favor of American Honda for damages in excess of \$58 million.

In related litigation in the Central District of California, WilmerHale subsequently reached favorable settlements for American Honda with several other Chinese manufacturers of copy engines, along with their U.S.-based distributors and retailers, resulting in agreements by these companies to cease selling the copy engines in the United States and to change the design of their products.

FiberMark, Inc. v. Brownville Specialty Paper Products, Inc.

WilmerHale prevailed in an eight-day jury trial on behalf of our publicly held client Fibermark, Inc., a Brattleboro, Vermont-based paper company. The case involved the copying of a mottled/marbled pattern used by Fibermark for over 100 years on high-quality dense paper for notebook covers, binders and similar products. After trial in the Northern District of New York, the jury returned a verdict that Fibermark's trade dress constituted a valid trademark and that the defendant—a competing paper company (whose mill was located three miles from the courthouse)—engaged in deceptive and misleading conduct by printing Fibermark's pattern on lower-quality paper. WilmerHale subsequently also prevailed on a claim of trademark dilution decided separately by the court, and obtained a permanent injunction prohibiting the infringing conduct. The other side then appealed but dropped the appeal and agreed to change their product.

The Morningside Group Ltd. v. Morningside Capital Group LLC

WilmerHale successfully represented Morningside Group, an affiliate of the Chan family of Hong Kong, in an appeal to the United States Court of Appeals for the Second Circuit. The appeal involved trademark infringement, dilution and unfair competition claims in the investment and financial services industry. We obtained a reversal of the district court decision finding the existence of a valid and enforceable trademark.

182 F.3d 133 (2d. Cir. 1999)

Toys R Us, Inc. v. Step Two, S.A. and Imaginarium Net, S.L.

WilmerHale represented the Spanish toy retailer Step Two S.A. and Imaginarium Net S.L. in defense of a trademark infringement claim brought by Toys "R" Us in the District of New Jersey involving competing claims to the Imaginarium mark, owned by our client in Spain and Toys "R" Us in the United States. The claims against our client were dismissed by the district court for lack of personal jurisdiction. On appeal, the Third Circuit upheld the legal

analysis of the lower court, but remanded the case for jurisdictional discovery. The case was ultimately resolved by mediation.

318 F.3d 446 (3rd Cir. 2003)

Pfizer Inc. v. Y2K Shipping & Trading, Inc.

WilmerHale represented Pfizer in obtaining a temporary restraining order followed by a preliminary injunction and, ultimately, a permanent injunction prohibiting the defendants from advertising and selling an herbal supplement under the name TRIAGRA. The court granted summary judgment in Pfizer's favor that the defendants' product name and marketing materials infringed and diluted Pfizer's VIAGRA trademark and constituted unfair competition and false advertising.

70 USPQ 2d. 1592 (E.D.N.Y. 2004)

United States Trust Company v. United States Trust Company of NY (2003)

WilmerHale represented United States Trust Co., a Boston bank, in this case challenging its use of the "US Trust" family of marks. After a 12-day bench trial in the District of Massachusetts, the court concluded that our client could continue to use the marks as it had throughout the country and issued an injunction precluding the opposing party, United States Trust Co. of New York, from using the marks in Massachusetts.

210 F.Supp.2d 9 (D. Mass. 2002)

Cashmere & Camel Hair Manufacturers Institute v. Saks Fifth Avenue

WilmerHale represented Harve Benard, Ltd. in a Lanham Act action commenced by CCMI. CCMI alleged that Harve Benard's labeling of its cashmere blend products was false and misleading. CCMI sought a preliminary and permanent injunction against the continued marketing of Harve Benard's cashmere blend products. After an eight-day trial, the District of Massachusetts denied CCMI's request for preliminary injunctive relief. The judge ultimately issued judgment in favor of Harve Benard on CCMI's underlying claims.

Coca-Cola Co. v. Purdy

WilmerHale represented Coca-Cola, Pepsi, the Washington Post, and McDonald's in obtaining quick injunctive relief against the defendant's use of domain names (such as "mymcdonalds.com") that appeared to belong to the trademark owners but that in fact were linked to the defendant's own advocacy websites.

Calvert Group, Ltd. v. FMR Corp.

Fidelity Investments hired WilmerHale to defend it in this trademark litigation in the District of Massachusetts challenging a national advertising campaign. The campaign featured Peter Lynch and his investment principle "know what you own and know why you own it." The Court denied Calvert's motion for preliminary injunction, concluding that Fidelity's use of the words "know what you own" constituted a "fair use," and that Calvert's mark was not distinctive and lacked any secondary meaning. The case subsequently settled.

Philips v. Remington

WilmerHale is representing Philips in the second of two high profile UK trademark cases against Remington. Both cases concern a trademark in the shape of the head of the well-known Philip's rotary shaver (sold in the United States under the name "Norelco"). The first case was referred to the European Court of Justice and is a leading authority on shape trademarks. The second case is currently pending before the United Kingdom Court of Appeal and may lead to a further reference to the European Court.

Unex.com, LLC v. Learnsoft Corp.

WilmerHale successfully defended Learnsoft's use of the "Unexus" mark for online education programs in a motion for preliminary injunction by Unex, a competing online education service supported by numerous well-known educational institutions. When the motion was denied, the case settled.

Johnson & Johnson v. IGI, Inc.

WilmerHale successfully represented IGI in a preliminary injunction involving trademark infringement and dilution claims made by Johnson & Johnson relating to J&J's "Renova" prescription anti-wrinkle cream. This case, filed in the District of New Jersey, was settled when the court denied Johnson & Johnson's requested injunction.

U-Haul International v. WhenU.com, Inc.

WilmerHale was retained by WhenU to defend it against claims that WhenU's software that delivered pop-up advertisements to computer users constituted trademark infringement and dilution, unfair competition and copyright infringement. We successfully defended each of those claims by summary judgment.

Charles Square Cambridge LLC v. The Inn at Copley Square, LLC d/b/a Charlesmark Hotel

WilmerHale represented Charles Square Associates, the owner of the well-known Charles Hotel in Cambridge, Massachusetts, in a trademark infringement action against a boutique hotel using "Charles" in its name. The case was settled by an agreement limiting the opposing party's use of the mark.

Commonwealth Plywood Co. Ltd v. Lumber Liquidators, Inc.

WilmerHale represented Canadian manufacturer Commonwealth Plywood Co., Ltd seeking to enforce its "Husky" trademarks against Lumber Liquidators, Inc. The case settled when the defendant agreed to phase out all use of the "Husky" trademarks.

Report Footwear, Inc. v. Saucony, Inc.

WilmerHale represented Saucony, Inc. in trademark infringement litigation in the Western District of Washington against Seattle-based Report Footwear. The case settled when the infringer agreed to stop selling the infringing shoe and to refrain from future infringement.

Stratford Foundation Inc. v. Lindamood-Bell Learning Processes, Inc.

WilmerHale represented California-based Lindamood-Bell, a pioneer in educating learning disabled children, in claims relating to infringement of numerous trademarks and copyrighted material by Commonwealth Learning Centers, a competing company. The case settled after discovery and mediation.

Polaris Venture Partners v. Polaris Venture Capital

WilmerHale represented Polaris Venture Partners in a trademark infringement action involving a competing Israeli venture capital company. The case was settled by assignment of the trademark to our client.

Commonwealth Plywood Ltd / Husky Log Structures, Inc.

WilmerHale represented Commonwealth Plywood in a dispute with Husky Log Structures involving Commonwealth Plywood's "Husky" trademarks. After a cease and desist letter, the opposing party ceased use of the marks.

Arrow Electronics, Inc. v. ArrowPoint Communications, Inc.

WilmerHale represented ArrowPoint, a developer of Internet web switches sold to e-commerce and web hosting sites against a trademark infringement claim brought by Arrow Electronics, a large electronics equipment distributor. The case was settled.

Iomega Corporation v. Castlewood Systems, Inc.

WilmerHale represented computer peripheral maker Iomega in a case in the District of Utah which included trademark claims against a competing manufacturer. The claims involved the improper use of Iomega's trademarks as metatags on Castlewood's internet web site. Castlewood removed the metatags, and the case was later settled.

Iomega Corporation v. SyQuest Technology Corporation

WilmerHale represented Iomega in the District of Delaware in connection with SyQuest's infringement of Iomega's JET trademark. The case was concluded after SyQuest filed for protection under the Bankruptcy Code.

Gateway 2000 v. Government Technology Services, Inc.

WilmerHale represented GTSI, a leading supplier of computer products to the federal government, in an unfair competition and dilution case based on the alleged disparagement of Gateway's "cow spots" trademark in comparative advertising by GTSI. The case was resolved after the advertising run was completed.

Sparc International, Inc. v. Analog Devices, Inc.

WilmerHale represented Analog in this trademark infringement suit in the District of Massachusetts by Sparc (the licensing company for the various uses by Sun Microsystems of the mark "Sparc") over Analog's use of the trademark "Sharc." The case was resolved by agreement which preserved Analog's ability to continue to use the key "Sharc" trademark, which identify some of Analog's most important products.

Rubbermaid v. Sterilite Corporation

WilmerHale represented Sterilite Corporation in this trade dress and design patent infringement case in the District of Massachusetts. Rubbermaid owned several design patents covering food storage containers and charged Sterilite with infringement. The case settled shortly before trial.

Alliant Computer Systems Corporation v. Alliant Techsystems Corporation

WilmerHale represented the trademark owner in a case alleging infringement. The case settled after extensive discovery and shortly before an expedited trial was scheduled to occur.

SR Holdings, Inc. v. Timberland Company

WilmerHale represented Timberland in a trademark infringement action in the District of Massachusetts. The case involved Timberland's use of the Keds "blue label" trademark. We obtained a quick settlement of the case.

Pfizer Inc. v. Soft Gel Technologies, Inc.

WilmerHale represented Pfizer Inc. in opposing the registration by Soft Gel Technologies of the mark "Glucosol" as confusingly similar to Pfizer's mark "Glucotrol." After discovery, briefing and final hearing, the Trademark Trial and Appeal Board sustained the opposition and denied registration.

The Morningside Group Ltd. v. Morningside Ventures

WilmerHale represented Morningside Group, Ltd., a financial services and investment company, against an internet education venture sponsored by Columbia University. The matter was resolved with Columbia agreeing to change the name of its company.

Analog Devices, Inc. v. Alpha Industries, Inc.

WilmerHale represented Analog in a dispute over Alpha's use of the Analog "AD" trademark to identify certain products. The dispute was resolved without litigation, recognizing and protecting Analog's trademark rights.

Major League Baseball Properties v. Fidelity Investments

WilmerHale represented Fidelity Investments in a dispute with Major League Baseball Properties concerning the mark "World Series" used in Fidelity advertisements immediately before the opening day of the 1999 baseball season. The dispute was quickly resolved.

Nike, Inc. / Acushnet

WilmerHale was retained by Oregon-based Nike to defend unfair competition claims asserted by Acushnet (Titleist) involving well-known, nationwide Tiger Woods television advertisements for Nike. The case was resolved.

Analog Devices, Inc. v. Stanford Microdevices

WilmerHale represented Analog in a dispute with Stanford Microdevices over its use of Analog's "X-AMP" trademark to identify products, and Stanford's use of the Internet Web domain www.x-amps.com. The dispute was resolved without litigation upon agreement by Stanford promptly to phase out use of Analog's mark and to discontinue use of the mark as an Internet domain name by Stanford.

Significant Copyright Litigation

CBS Broadcasting Inc. v. EchoStar Communications Corporation (2003)

On behalf of ABC, CBS, FOX, and NBC stations, WilmerHale obtained a landmark victory against EchoStar, the second largest US satellite company, in a case involving the retransmission of out-of-town broadcasts to thousands of ineligible subscribers. We had obtained a judgment below, after a ten-day bench trial in the Southern District of Florida, that EchoStar had willfully infringed the broadcasters' copyrights. The Eleventh Circuit affirmed the victory on that issue, and also agreed with our cross-appeal seeking a special, exceptionally broad remedy for EchoStar's misconduct. The Eleventh Circuit held that EchoStar had violated the Satellite Home Viewers Act "in every way imaginable," and ordered the first-ever national "pattern or practice" injunction, stripping EchoStar entirely of the right to retransmit distant network stations to subscribers under the Act's compulsory license.

450 F.3d 505 (11th Cir. 2006)

Pannonia Farms, Inc. v. Lellenberg

WilmerHale represented Jon Lellenberg, a member of the Bakers Street Irregulars and the U.S. representative of the Estate of Dame Jean Conan Doyle, rightful owner of the works of Sir Arthur Conan Doyle, in the successful defense of a copyright and trademark infringement action brought against him by Pannonia Farms, Inc., a New York corporation that asserted an interest in Sir Arthur's Sherlock Holmes stories. The court rejected Pannonia Farms' claims and required Pannonia to pay a portion of Mr. Lellenberg's attorney's fees.

On-Site Insight, Inc. v. Federal National Mortgage Association

WilmerHale represented the Federal National Mortgage Association in a copyright infringement suit by On-Site, alleging that Fannie Mae had distributed an On-Site publication beyond the scope permitted by its license. The case settled after Fannie Mae established that the work was jointly authored by Fannie Mae and On-Site, and that the copyright registration was erroneous.

Harcourt General v. Intellistudy Corporation

WilmerHale represented Harcourt General, the owner of BAR/BRI bar review materials. Intellistudy copied BAR/BRI lectures and published them in substantially similar form. Harcourt sued Intellistudy for copyright infringement, seeking injunctive relief and statutory damages. We obtained an injunction against Intellistudy by consent judgment.

Metacorp Strategies, Int'l v. Wang Laboratories, Inc.

WilmerHale represented Wang Laboratories in litigation commenced by Metacorp in the District of Massachusetts. Metacorp claimed that Wang's Open Workflow product infringed a registered copyright on certain computer source code. The case settled.

Inso Corporation v. Watkins

WilmerHale represented Inso, the owner of copyrighted computer software source code relating to an Internet meta-search product, in litigation in the District of Massachusetts against a former employee and other defendants who posted a competing product on the Internet. The posted product duplicated many unique bugs and other aspects of Inso's copyrighted code. After we conducted expedited discovery and obtained a trial date less than two weeks after filing the complaint, the case was settled by entry of an agreed injunction prohibiting the defendants from infringing Inso's copyright and from working on a similar product for two years, as well as partial payment of Inso's attorneys' fees.

Remanco International, Inc. v. ExecuTechs Services, Inc.

After replacing counsel who had filed a state law trade secret action and conducted extensive discovery, WilmerHale represented the owner of diagnostic repair software in bringing a copyright action against unlicensed service providers, and in an antitrust action brought by the service providers against the copyright owner. After entry of a preliminary injunction preventing use of the software by the unlicensed providers, the parties settled the case by entering into a license agreement.

ProCD, Inc. v. Zeidenberg

WilmerHale represented ProCD, Inc. in the landmark Seventh Circuit decision which upheld the validity and enforceability of shrink wrap (or end user) licenses, contracts and warranties for protecting computer software and electronic data in consumer products. The Court of Appeals also ruled that such protections are not preempted by the United States Copyright Act.

86 F.3d 1447 (7th Cir. 1996)

Jonnette Jewelry v. Bonetti Co.

WilmerHale represented Jonnette Jewelry, a manufacturer of women's jewelry, in copyright actions against various Korean companies accused of making and selling cheap knockoffs. Each defendant entered into a consent decree enjoining further infringement shortly after the case was filed in the District of Rhode Island.

Acknowledge, Inc. v. Digital Interfaces Limited, GigaTape GmbH, and GigaTrend, Inc.

WilmerHale represented the defendants in a copyright infringement action brought by Acknowledge, Inc., a manufacturer of peripheral interface devices, in the District of Massachusetts. The plaintiff claimed that defendants misappropriated and infringed its copyright on certain aspects of the software which allowed non-IBM peripheral devices to interface with an IBM CPU. The software in dispute involved a "lock" which precluded an IBM CPU from interacting with any non-IBM peripheral device unless the peripheral device returns the "key" recognizable by the IBM CPU. After discovery, the plaintiff agreed to dismiss the case with prejudice.

Significant Trade Secret Litigation

Analog Devices, Inc. v. Michalski, et al

WilmerHale represented Analog Devices, Inc. in a suit for trade secret theft against certain former Analog employees, one of whom had printed out numerous confidential schematics on the night before he left Analog to start a directly competing design center for another firm. After six years of litigation in North Carolina state court, including an interlocutory appeal and extensive fact and expert discovery, the case settled several days before the start of trial. The settlement included everything Analog would have sought at trial, including payment to Analog of its attorneys' fees (in full), disgorgement of the profits from sales of accused products, substantial additional compensation, and a prohibition on further development of certain products relating to the trade secrets.

Elan Pharmaceuticals v. Eli Lilly

WilmerHale represented AHPC (strategic partner to Elan) in a breach of contract, trade secret and inventorship dispute. The dispute occurred as a result of the winding-down of Lilly's 10-year relationship with Elan in the area of Alzheimer's disease research. Elan's invention is considered publicly to be the leading treatment of Alzheimer's. After months of litigation, the case was eventually settled after court ordered mediation.

Comverse Network Systems, Inc. v. Priority Call Management, Inc.

WilmerHale represented Comverse in this patent infringement and trade secret action against Priority Call Management in the District of Massachusetts. The technology at issue involved large scale, distributed architecture voice mail and messaging systems. The case settled at the close of discovery.

DuPont Merck Pharmaceutical Co. v. Cilag AG

WilmerHale represented DuPont Merck in the District of Delaware against a Swiss subsidiary of Johnson & Johnson in litigation involving misappropriation of DuPont Merck trade secrets regarding an important aspect of the well-known drug Coumadin. During preliminary injunction briefing, the parties reached a resolution of the dispute that protected DuPont Merck from future misuse of its trade secret.



Clinipad Corporation v. Aplicare

WilmerHale represented Aplicare in this trade secret case in Connecticut Superior Court. The alleged trade secrets related to wet packs containing anti-bacterial solutions and certain applicators. Much of the litigation concentrated on whether certain items were trade secrets and on whether they were used by the defendants. In addition, a substantial issue existed as to whether a prior published patent would prevent the allegedly secret process from becoming a trade secret. The trial judge ruled in Aplicare's favor, holding that no trade secrets were misappropriated, and awarded attorneys fees to Aplicare.

Defensive Technologies, Inc. v. Jet Security Systems

WilmerHale represented Defensive Technologies, Inc. in a trade secret case litigated in the Massachusetts Superior Court, involving the use of electronic sensor and computer technology as an automatic system for detecting intrusion into aircraft parked on an airfield. The litigation focused on whether a trade secret existed and the extent of similarity between the parties' products.

MultiLink, Inc. and PictureTel Corp. v. Octave Communications, Inc.

WilmerHale represented MultiLink and PictureTel in this trade secret action against several of MultiLink's former employees and their company. The technology at issue involved high capacity audio conferencing systems. The case was settled.

Pfizer, Inc. v. Allen Gould

WilmerHale represented United Agriseeds and one of its prospective employees, Dr. Allen Gould, who were sued by Pfizer, Inc. (Gould's former employer) in the District of Connecticut. Pfizer claimed that the defendants violated and interfered with Gould's non-competition agreement and misappropriated Pfizer's trade secrets related to gene splicing in agricultural products. Following extensive expedited discovery, the case was settled.

Significant Patent License Litigation

Samsung Electronics Co., Ltd. v. InterDigital Communications Corporation, et al

WilmerHale represented InterDigital in this significant patent license dispute in the hotly-contested field of wireless communications intellectual property. InterDigital initiated an arbitration in the International Court of Arbitration against Samsung after a dispute arose about a "most favored licensee" provision of the parties' license agreement. WilmerHale prevailed in convincing the arbitrators that Samsung's obligation to pay royalties had indeed been triggered. The Tribunal awarded InterDigital approximately \$134 million in past royalties plus interest on Samsung's sale of GSM cell phones through 2005. The Tribunal also established the royalty rates to be applied to Samsung's sales of covered products in 2006, imposing significantly higher rates than Samsung had urged. Separate from the royalty issues on GSM phones, the Tribunal also concluded that Samsung was not entitled to the broader CDMA and 3G patent license rights that InterDigital had granted to Nokia, notwithstanding Samsung's most favored licensee election of the Nokia agreement.

Nitor Corp. v. CoreTeck, Inc.

WilmerHale successfully defended Nortel Networks in a California arbitration in which Nitor claimed rights to key patents relating to tunable vertical cavity surface emitting lasers and tunable filters—technology at the forefront of the optical telecommunications field. Nitor claimed a license to the technology based on work that a Nortel subsidiary had done on an unrelated contract for visual displays. A three-arbitrator panel unanimously decided that Nitor had failed to establish any rights to those key patents—or even to a broader provisional patent application—and that this technology was not part of any development efforts for Nitor.

Anderson v. ReSound

WilmerHale represented GN ReSound, a subsidiary of GN Great Nordic of Denmark, in a patent inventorship and licensing dispute. The case settled shortly after discovery.

Inso Corporation v. Countkey Limited

WilmerHale represented Inso in a proceeding brought in the District of Massachusetts relating to breach of a license agreement concerning computer database licenses used for the manufacture of electronic devices by Hong Kong-based Countkey. After Countkey's motion to dismiss was denied, the case settled.

VISX, Inc. v. Summit Technology, Inc.

WilmerHale represented Summit Technology, in three lawsuits commenced by VISX concerning the parties' patent licenses and the Pillar Point Partners, formed by the parties to hold their patent rights related to ultraviolet laser surgery of the cornea. The cases were settled with VISX paying Summit a significant amount of money.

Moore v. The Regents of the University of California

WilmerHale represented Genetics Institute in an action brought by Moore in California Superior Court. The case concerned a patent assigned to the University of California which covers a cell line and a chemical derived from the cell line. The chemical is useful in the manufacture of a synthetic protein which stimulates the production of white blood cells. The plaintiff claimed that he was entitled to a portion of the income generated by the patent because the cell line was derived from his diseased spleen, which had been removed during an operation at UCLA. The defendants were successful in obtaining a dismissal of this action, but an appellate court reversed the superior court's ruling. WilmerHale argued the case before the California Supreme Court, which reinstated the dismissal as to GI.

51 Cal. 3d 120, 793 P. 2d 479, 271 Cal. Rptr. 146 (1990)

Other Intellectual Property Litigation

Analog Devices, Inc. v. Belling and Silan

On behalf of chipmaker Analog Devices Inc., WilmerHale prepared and supervised two of the earliest cases brought in China under the new Semiconductor Mask Works Law. The cases were brought against two Chinese companies who copied Analog's mask works for the design of chips used for electric metering. We coordinated purchases of the defendants' chips, analyzed them for infringement, and prepared materials in support of the filing of Analog's cases by local counsel in China.

Various Yahoo! Chat Room and Email Litigations

WilmerHale successfully represented a series of clients in lawsuits that, among other things, sought to identify individuals who had "anonymously" posted confidential company information on website "chat rooms" and/or had sent harassing (or otherwise actionable) email to fellow employees. We were ultimately able to successfully identify the poster of the offending information in each case, either through information obtained in response to third party subpoenas or through a negotiated settlement.

Brinker International v. Infinium Software, Inc.

WilmerHale represented Infinium, a developer of high-end business software, in a Year 2000-related dispute in the Northern District of Texas. The case was settled early in litigation in a way which repaired the parties relationship and retained the plaintiff as an Infinium customer.

Young Chang v. Kurzweil Music

WilmerHale represented Kurzweil Music in a breach of contract and declaratory judgment action against Young Chang, a Korean musical instrument company. The primary issue was whether Young Chang was using an algorithm in the semiconductors of its electronic keyboards that was "substantially similar" to the algorithms that had been purchased from Kurzweil Music. The case was tried for one week in the United States Bankruptcy Court for the District of Massachusetts, and then settled favorably to Kurzweil Music.

Perkin-Elmer Corporation v. Computervision Corporation

WilmerHale represented Computervision in portions of a patent infringement lawsuit brought by Perkin-Elmer. Perkin-Elmer sued Computervision for patent infringement of a patent covering an apparatus for fabricating semiconductor chips. WilmerHale was asked to assume the defense after a liability and damages trial and represented Computervision in an effort to have the damages reduced. We also brought suit for malpractice against the patent lawyer who had represented Computervision in the conduct of the damages trial. The malpractice claim was tried to a jury for a week before the case was settled.

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