
Success at the Federal Circuit: WilmerHale Earns Five Victories in One Week

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WilmerHale has just completed an extremely successful week at the Federal Circuit, receiving favorable decisions in five out of six patent cases concerning various legal issues. These results can be credited to many WilmerHale lawyers, ranging from experienced veterans to lawyers working on their first appeal. The six cases are outlined below.

- On May 9, the firm earned a complete victory for Monsanto when the Federal Circuit affirmed a sanctions award against DuPont. The appeal arose from a patent infringement suit in which Monsanto secured a judgment of more than \$1 billion against DuPont. The issue remaining on appeal was DuPont's challenge to the order sanctioning it for making false representations to the district court in support of its argument that the parties' license should be reformed to reflect DuPont's alleged subjective understanding of the terms. The Federal Circuit affirmed the sanctions award, holding that "DuPont exceeded the bounds of appropriate conduct and stretched its advocacy beyond what was reasonably justified" and "abused the judicial process and acted in bad faith." Partner Seth Waxman argued the case before the Federal Circuit and was assisted by Partners [Paul Wolfson](#) and [Tom Saunders](#), and Senior Associates Carolyn Chachkin and Daniel Aguilar.
- Also on May 9, the Federal Circuit affirmed a judgment that WilmerHale client VGo Communications does not infringe three patents owned by its competitor InTouch Technologies, Inc. A jury had found that VGo's remote telepresence robot systems do not infringe and also invalidated two of InTouch's patents. InTouch challenged every aspect of the district court's judgment on appeal. The Federal Circuit affirmed the district court's claim constructions, the jury's non-infringement findings and the district court's denial of a new trial based on various evidentiary rulings. The court, however, reversed the invalidity judgment based on obviousness for two patents. Partner [Lauren Fletcher](#) argued the case before the Federal Circuit and was assisted by Partner [Bill Lee](#) and Associate [Sarah Frazier](#).
- The firm helped General Electric receive a favorable ruling on May 8 in its inventorship dispute with former GE employee Thomas Wilkins. In this ruling, the Federal Circuit affirmed the [district court's decision](#) that Mr. Wilkins had not proven that he is an inventor of a GE wind turbine patent. The Federal Circuit's affirmance resolves the last remaining

piece of a broader dispute between GE and Mitsubishi Heavy Industries. The WilmerHale team on appeal included Partners [Bill Lee](#), [Chip O'Neill](#), [Beth Reilly](#), [Andrea Jeffries](#), [Monica Grewal](#) and [Louis Tompros](#); Counsel [Sandy Alexander](#); Senior Associates [Andrew Danford](#) and [Alex Boudreau](#); and former Senior Associates Adam Gershenson and Nimit Patel.

- The firm earned another victory on May 8, this time for its client Hologic. This success came when the Federal Circuit affirmed the decision of the Patent Trial and Appeal Board (PTAB) that Appellant Jeffrey Schwindt was not entitled to be named as a co-inventor on Hologic's patent to a biopsy device. The team contributing to the victory in the Federal Circuit and at the Patent Office included WilmerHale Partners [Dave Cavanaugh](#), [Lisa Pirozzolo](#) and [Mark Fleming](#); Counsel [Owen Allen](#); and former Senior Associate Adam Romero.
- On May 6, the Federal Circuit issued its decision in *In re Packard*, which addressed what the court itself called "an important question: what standard for indefiniteness should the US Patent and Trademark Office (USPTO) apply to pre-issuance claims?" On behalf of inventor Thomas Packard, WilmerHale's Louis Tompros had argued that the USPTO was required to apply the same standard in pre-issuance claims as district courts apply in post-issuance claims. The USPTO argued that it was free to impose its own standard. In what was called a "long-awaited decision," the Federal Circuit ultimately resolved the case by adopting a new rule of patent prosecution. In a [27-page concurrence](#), Judge Plager offered a detailed analysis of what he described as the "significant issues" of the law of indefiniteness raised by Tompros' arguments, including a history of the indefiniteness requirement tracing back to 1853. The WilmerHale team on appeal included Partners [Louis Tompros](#) and Senior Associates Proshanto Mukherji and [Caitlin Looby](#).
- Lastly, the firm earned a victory for Broadcom Corporation on May 5, when the Federal Circuit denied Ericsson's petition for mandamus on an issue of first impression in a closely watched area of *Inter Partes* Review practice: whether the PTAB's decision denying discovery into the potentially dispositive issue of "privity" between the petitioner and prior litigants should be reviewed through mandamus. The court held that the criteria for mandamus were not met and Ericsson must wait for an ordinary appeal. The WilmerHale team included Partners [Dom Massa](#) and [Daniel Volchok](#); Special Counsel [Kate Saxton](#); and Counsel [Sandy Alexander](#).