
Intellectual Property Counseling and Prosecution

Providing comprehensive solutions for the acquisition, enforcement and protection of IP.

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Clients depend on us to understand how intellectual property relates to their business, and to use that knowledge to help them fully realize the value of their intellectual property. We offer full-service IP coverage across industries, from technology, telecommunications, retail and media to pharmaceuticals and medical devices.

Clients come to WilmerHale for counseling on patent drafting and prosecution; post-grant proceedings; trademark, copyright and trade secret protection; and strategic IP portfolio development. But unlike many firms' core-IP practices, we also offer interdisciplinary experience in technology transfer and licensing, litigation, and due diligence. These comprehensive abilities make us uniquely positioned to counsel clients on business and legal IP strategies, analyzing the value of existing IP portfolios and tailoring them to match our clients' needs. WilmerHale is also positioned to help with IP challenges around the globe. Our lawyers include IP litigators and international trade lawyers with global experience in navigating complex international IP issues.

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Related Solutions

China Trade

China Transactions

Energy, Environment and
Natural Resources

FinTech

Intellectual Property Litigation

Life Sciences

Media and Entertainment

Technology

Technology Transactions and
Licensing

Areas of Focus

Patent Prosecution

Post-Grant Proceedings

Copyright and Trademark
Prosecution

Strategic Analysis

IP Due Diligence

Intersection of Antitrust and
P

Medical Devices

Trade Secrets

Experience

For Unified Patents, achieved a victory against American Vehicular Sciences when the Patent Trial and Appeal Board (PTAB) invalidated all challenged claims of US Patent No. 9,043,093. The '093 patent was asserted against Honda, Nissan, Hyundai and Toyota.

For a major financial institution, achieved a series of victories against Intellectual Ventures, which filed suit alleging infringement of patents related to online banking. The case ended following four successful covered business method proceedings before the US Patent and Trademark Office (USPTO) in which the PTAB invalidated 83 of IV's claims across the four patents as directed toward unpatentable abstract ideas.

For a technology company, provided representation in an international copyright infringement and trade secret misappropriation dispute in the United States and in parallel declaratory proceedings in the United Kingdom.

Numerous global companies, including a consumer electronics company, a sportswear and athletic goods company, and a car manufacturer, have relied on our representation in various trademark and trade dress matters.

Our copyright experience includes securing a major victory for Google in the Second Circuit in a copyright dispute with the Authors Guild over Google Books, representing an American toy and board game company against allegations of copyright infringement, and representing several major television networks in a copyright case.

For NitroMed, filed and obtained patents covering methods of treatment using the company's commercial drug product, BiDil—which is targeted to the treatment of heart failure in black patients—and worked with the company to implement strategies for product life cycle management.

For Wyeth and its licensee XCyte, prosecuted a large and complex family of US and foreign patents concerning an anti-cancer immunotherapy.

Represented Columbia University in the negotiation of several intellectual property licenses, and in patent prosecution relating to diverse fields such as software applications, integrated circuits, life sciences, chemistry and physical sciences.

Working closely with corporate colleagues, counseled clients in transactions that include:

- WebMD's \$160 million acquisition of VIPS
- Idenix Pharmaceuticals's \$156.8 million IPO and private placement to Novartis
- NitroMed's \$61.34 million IPO
- A \$49.4 million follow-on offering for Lexicon Genetics
- A \$69.7 million follow-on offering for EPIX Medical
- Predix Pharmaceuticals's merger with Physiome Sciences

A number of clients have relied on us to analyze their patent portfolios vis-a-vis their field of interest and the effect of targeted competitors' portfolios on their business, and to complete freedom to operate analyses concerning a variety of products and

technologies.

Recognition



Law Firm of the Year in Patent Law

*U.S. News - Best Lawyers® Best Law Firms
List*

2021, 2022



Best Law Firms—Band One: Intellectual Property

Chambers USA

SINCE 2011



Intellectual Property Firm of the Year

LMG Life Sciences

2022

- *BTI Intellectual Property Outlook* – Recognized as the Most-Favored IP Department in the nation and one of five Go To IP Firms for non-litigation IP work (2015).
- *Chambers USA: America's Leading Lawyers for Business* – Ranked nationally in band one (2011–2022); noted as “outstanding at all levels, combining first-rate technical and legal acumen and great trial skills.” Consistently recognized in the national International Trade: IP (section 337) category (2013–2021) and in regional IP tables for Massachusetts (2003–2021), California (2012–2021), Colorado (2016–2021), New York (2012–2022) and Washington DC (2012–2021).
- *Law360* – Consistently named IP or Technology Group of the Year since 2010.
- *The Legal 500 United States* – Named among the top law firms for intellectual property (2011–2023) and winner of the Best Law Firm for IP: Patent Litigation (2014).
- *LMG Life Sciences* – Recognized in the areas of patent strategy and management, general patent litigation, Hatch-Waxman patent litigation, corporate, licensing and collaboration, M&A, venture capital and white collar/government investigations (2012–2023).

- *LMG Life Sciences Awards* – Shortlisted for Life Cycle Firm of the Year – US, Hatch-Waxman Litigation Firm of the Year – Branded, General Patent Litigation Firm of the Year and Firm of the Year – Intellectual Property (2021– 2023); received the Impact Case of the Year Award for our work on *Enzo Life Sciences v. Roche Molecular Systems* (2020); named as the General Patent Litigation Firm of the Year and Intellectual Property Firm of the Year (2019); won the Hatch-Waxman Impact Case of the Year Award for our role in *Millennium Pharmaceuticals v. Sandoz* (2018).
- *Managing IP* – Named as Patent Contentious Firm of the Year for the Northeast region and recognized with the Impact Case of the Year Award for our role in *Intel v Qualcomm* (2022); named as Patent Contentious Firm of the Year for the Northeast region and recognized with the Impact Case of the Year Award for our role in *Mission Products Holdings Inc v. Tempnology LLC* (2020); named as the US Patent Contentious Firm of the Year or shortlisted for the recognition (2011–2021); ranked Tier 1 for PTAB Litigation (2020); listed among the top 10 “Law Firms for Petitioners and Patent Owners in PTAB Proceedings Filed in 2019” and the top 15 “Law Firms at the PTAB 2019 – Petitioners and Respondents Combined.”
- *U.S. News - Best Lawyers®* – Named Patent Firm of the Year (2021, 2022), Biotechnology Law Firm of the Year (2024, 2020) and IP Litigation Law Firm of the Year (2018). Honored with first-tier national “Best Law Firm” rankings in Patent Law, Biotechnology Law, IP Litigation and Patent Litigation; and first-tier metropolitan rankings in Washington DC and San Jose for IP Litigation; in Boston for Copyright Law, Patent Law, Patent Litigation, IP Litigation and Trademark Law; in Colorado for Patent Law; and in New York for Biotechnology Law (2013–2024).