

Patent Litigation and Counseling

As one of a company's most valuable assets, patents are frequently the subject of high-stakes disputes. With creativity, strong technical credentials, and unparalleled trial experience, Jenner & Block's Patent Litigation and Counseling team asserts and defends patents against both competitors and non-practicing entities in courts across the United States.

Outside the courtroom, clients seek our counsel on infringement risks, and we provide opinions on patent rights involving issues of infringement, patent validity, and freedom-to-operate. In the context of transactions, we conduct patent due diligence, and negotiate and prepare patent licenses and other transaction agreements.

A Powerhouse Litigation Team

With a combination of creativity, strong technical credentials, and exceptional trial experience, we have favorably resolved bench and jury trials, appeals, ITC and PTAB trials, and arbitrations. While not every dispute goes to trial, we bring a courtroom-ready orientation to analyzing claims and creating narratives. Partners in the practice average over 10 cases each tried before juries, courts, or arbitrators, and consider trial strategies right from the start. This approach often helps us create opportunities for early, favorable outcomes through summary judgment or negotiation.

When disputes do go to trial, our experienced and highly regarded appellate team weighs in at an early stage to help set a strong record for any necessary appeals.

Client-Focused Strategies

We partner with clients to create litigation and patent protection strategies based on their best interests, business aspirations, risks, and opportunities presented. We work toward efficient resolutions and define a win as an outcome that achieves our client's business goals.

We are often asked to provide pre-dispute counsel, working with clients to identify potential pitfalls in portfolio development, avoid liability, and prevent infringement in the first instance. If a client's patent may have been infringed, we help assess the patent's value and the strength of the client's position to determine whether to assert the patents in litigation. We also advise on the potential interplay of IP assets with trade secrets, trademarks, and antitrust issues.

Deep Technology Knowledge

We have advised on, protected, and enforced patents involving wide-ranging innovations in the fields of life sciences, automotive, telecommunications, emerging technologies, biosimilars, semiconductors, portable devices, and many others. Many of our lawyers bring advanced technical backgrounds and industry experience that inform our strategic counsel and trial preparation.

Legal and Judicial Trends Monitoring

Innovations shape the future and require a nuanced understanding of technology, innovation, and legal and judicial trends. Our lawyers are at the forefront in all these areas, closely monitoring legislative and judicial developments, to ensure our clients are positioned for success now and in the future.

Experience

- Represented a leading developer of biosimilar therapeutics on several matters regarding a PEGylated G-CSF drug product, patent portfolio analysis, and preparation of abbreviated biologic license applications. This work included district court litigation under the Biologics Price Competition and Innovation Act (BPCIA), appeal, and numerous *inter partes* reviews at the PTAB.
- Represented a global pharmaceutical client in multiple Hatch-Waxman patent infringement suits against ANDA filers regarding a ready-to-use formulation for Precedex (dexmedetomidine hydrochloride) drug product.
- Represented a manufacturer of endoscopic surgical instruments in an arbitration brought by an inventor.
- Represented a multinational consumer electronics and software company in a patent infringement lawsuit in the Eastern District of Texas. Our client was accused of infringing dozens of patents. After successful transfer to the Northern District of California, our client filed a motion for judgment on the pleadings based on a double patenting defense and filed a motion to stay the case in view of an *inter partes* review proceeding that our client joined. The case subsequently settled on favorable terms for our client.
- Represented an automobile manufacturer against patent infringement claims from a not-for-profit institute. The plaintiff asserted that nearly all the manufacturers' vehicles infringed three patents relating to piston configurations in combination with a solid film lubricant coating and a solid film lubricant coating composition for pistons. After a decisive *Markman* ruling, plaintiff stipulated to a dismissal of all claims with prejudice.
- Successfully secured summary judgment for a client in a design patent infringement case filed by a manufacturer of electrical chargers. The suit alleged that the USB charger for our client's popular

e-reader infringed a design patent. Arguing that our client's charger was not sufficiently similar to the patented design to permit a finding of infringement, our team moved for summary judgment even before any substantial discovery took place. We successfully defended it upon appeal.

- Defended a security and surveillance technologies company in a patent license arbitration. The case settled highly favorably after the close of testimony, including cross examination of the plaintiff's fact and expert witnesses.
- Defended global electronics and services provider in significant ITC and district court litigation. Obtained an early favorable settlement for our client where other defendants ultimately were found to infringe in the ITC and the district court, including an eight figure damages award.
- Represented an automobile manufacturer in a patent infringement suit. In its initial complaint, the plaintiff alleged that our client infringed four different patents related to hard carbon film coatings for reducing friction and wear on metal components. Through extensive claim construction, discovery, and attacks on the asserted patents' validity in *inter partes* review proceedings before the USPTO, Jenner & Block successfully narrowed the case down to two patents. We won dismissal without prejudice on a standing issue that was affirmed on appeal. The remaining two patents were determined invalid in *inter partes*.
- Representation of one of the world's largest hotel chains in a patent infringement lawsuit related to its reservation system and mobile application concerning real-time synchronization of data. Achieved invalidity of three asserted patents in the USPTO and achieved summary judgement of unpatentability for the one remaining asserted patent in the district court.

Co-Chairs



Amr O. Aly

Co-Chair
aaly@jenner.com
+1 212 407 1774



Reggie Hill

Co-Chair
rhill@jenner.com
+1 312 923 2606



Benjamin Bradford

Co-Chair
bbradford@jenner.com
+1 312 840 7224

Related Capabilities

Aerospace and Defense

Appellate and Supreme Court

Business Litigation

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Life Sciences

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Technology

Trade Secrets and Restrictive Covenants