

Intellectual Property & Technology Litigation

The Intellectual Property and Technology Litigation Group advises clients on a broad range of intellectual property (IP) and technology issues confronting today's businesses. The Group combines trial experience with a background in handling complex intellectual property disputes, including those that raise antitrust and competition law issues. The Group's litigation work includes enforcing patents, trademarks and other IP rights and defending against claims of infringement.

The Group skillfully and clearly communicates the most complex technical issues to judges and juries. Lawyers in the IP and Technology Litigation Group have substantial experience representing clients in both bench and jury trials, and regularly appear in the Court of Appeals for the Federal Circuit.

In addition to litigation and transactional work, S&C's IP and Technology Group regularly counsel clients on a wide range of strategic and day-to-day issues associated with the development, acquisition and maintenance of intellectual property portfolios. We routinely consult on trademark clearance, brand strategy, patent pools and joint licensing programs, website policies, trade secret protection, tax planning and monetization strategies. We also assist companies in the interpretation and application of various licensing arrangements.

SELECTED REPRESENTATIONS

The Intellectual Property & Technology Group's recent litigation experience includes representing:

- **Audio MPEG, U.S. Philips Corporation, TDF SAS and IRT**, which license MP3 patents, in patent infringement actions against HP and Dell Inc., for selling unlicensed computers capable of playing MP3 audio files. After settlement of the HP claims, Dell continued to litigate and filed multiple motions regarding patentability, equitable estoppel, willful infringement, Plaintiffs' expert witnesses and many other topics – all of which the court denied. Ultimately, the action settled on extremely favorable terms for the patent owners three days before trial.
- **BlackBerry Limited**, in
 - obtaining a \$940 million award in a binding arbitration against Qualcomm Incorporated. The award represents royalty payments made to Qualcomm in excess of those required under Qualcomm's royalty cap program.
 - litigation against Nokia of America Corp., including a patent infringement action in the U.S. District Court for the District of Delaware in which BlackBerry accused Nokia of infringing eleven BlackBerry patents, an administrative procedure before the U.S. Patent and Trademark Office defending the validity of BlackBerry's patents, and an arbitration in Sweden regarding licensing.
- **Genesis Advanced Technology Inc. and Genesis Robotics LLP** in a breach of contract, patent ownership and infringement suit brought by Douglas Machine, Inc. claiming under a "Development Consulting Agreement" entered into by the parties in 2013, it owned 49 trademarks, patents and patent applications belonging to Genesis. The case settled on favorable terms for Genesis before

PRACTICES & CAPABILITIES

Litigation
Antitrust
Arbitration
Bankruptcy Litigation
Commodities, Futures & Derivatives
Congressional Investigations
Corporate Culture, Workplace Investigations & Whistleblower Litigation
Corporate Governance Litigation
Criminal Defense & Investigations
Environmental Litigation
European Competition
FCPA & Anti-Corruption
Financial Services Investigations & Litigation
Intellectual Property & Technology Litigation
Labor & Employment
Products Liability & Mass Torts
Securities & Commodities Investigations & Enforcement Practice
Securities Litigation
Supreme Court and Appellate

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motion to dismiss oral argument.

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- **Micro Systems Engineering (MSEI)**, in a 2017 trial victory against Universal Instruments Corp. in a case alleging copyright, trade secret and contractual claims. Following a six-day jury trial, the court granted MSEI's motion for judgment as a matter of law. S&C obtained an affirmance of that ruling from the Second Circuit in May 2019.
- **Stryker Corporation**, a Fortune 500 medical technologies firm, before the Supreme Court in a case that addressed the standard to be used for awarding enhanced damages in patent infringement actions. S&C persuaded the Supreme Court to set aside the Federal Circuit's strict standard as "unduly rigid." By striking down the standard used by the Federal Circuit, the holding provides greater discretion to district judges in determining when enhanced damages are appropriate. The Supreme Court also held that patent holders need only establish the appropriateness of enhanced damages by a "preponderance of the evidence" rather than "clear and convincing evidence." Lastly, the Court held that the Federal Circuit should review district courts' enhancement decisions for abuse of discretion.

Other selected litigation matters include representing:

- **The Clearing House Payments Company**, the operator of some of the country's major payments systems, in a successful patent litigation in the U.S. District Court for the Eastern District of Texas brought by DataTreasury, asserting violation of patents involving electronic check imaging activities.
- **Cuozzo Speed Technologies LLC** before the U.S. Supreme Court, challenging the U.S. Patent and Trademark Office's implementation of the America Invents Act's (AIA) new post-grant proceedings.
- **Dolby International**, the Swedish subsidiary of Dolby Laboratories, in
 - a successful patent infringement action brought against Research in Motion, the maker of the BlackBerry smartphone, regarding patents covering an advanced method of audio compression.
 - a breach of license case in the Northern District of California by Technicolor. The matter was settled with Technicolor making payments to Dolby and agreeing to interpret the license in ways Dolby had claimed were proper.
 - an infringement case in the Southern District of Florida against BLU Products. After infringement and patent validity was determined in Dolby's favor, BLU agreed to accept a license and make payments for back royalties due.
- Four DVD6C members (**Mitsubishi Electric, Panasonic, SANYO Electric and Warner Bros. Home Entertainment**) in a patent infringement action involving eight U.S. patents relating to DVD-ROM and DVD-Video Disc technology against World Media Group (WMG) in the U.S. District Court for the Northern District of Texas. In the settlement, WMG agreed to enter into a patent license agreement with DVD6C and pay damages for its past infringement.
- **Dyson** in
 - achieving a favorable settlement following summary judgment briefing and court-ordered mediation in a litigation brought by BISSELL Homecare against Dyson in the Western District of Michigan related to patents covering cyclonic vacuum cleaner technology.

- a patent infringement action in which the U.S. Court of Appeals for the Federal Circuit affirmed the district court's decision granting Dyson's motion for summary judgment, holding that Dyson did not infringe a vacuum cleaner patent for which an inventor sought substantial damages.
- **Ferrosan**, a Danish manufacturer of hemostatic devices that are sold by a Johnson & Johnson subsidiary, in a patent infringement case before the U.S. International Trade Commission. After trial, during which S&C cross-examined the claimant's expert witnesses and others, Ferrosan settled the matter for approximately the cost of further litigation.
- **Financial Accounting Standards Board**—the principal private sector organization for establishing financial accounting standards in the United States—and its governing body, in an action brought by Silicon Economics (SEI) relating to SEI's patented method of financial accounting.
- **General Electric, LG Electronics, Mitsubishi Electric, Samsung Electronics, Thomson Licensing, the Trustees of Columbia University in the City of New York, U.S. Philips and Victor Co. of Japan**, in an action filed in the U.S. District Court for the Southern District of New York against Hong Kong-based Lenovo Group and its U.S. subsidiary, Lenovo (United States) for willfully infringing the plaintiffs' patents that are essential to the MPEG-2 digital video compression standard. The action was favorably settled.
- **J.P. Boden**, in defending infringement claims brought by a nonpracticing entity, based on a patent claiming a method of tracking package deliveries. The plaintiff voluntarily dismissed the claims with prejudice.
- **j2 Global Communications**, in a number of patent actions, asserting Lanham Act trademark infringement, patent infringement and false advertising claims in the U.S. District Court for the Central District of California and the Northern District of Georgia, including a dismissal of claims brought against j2 by an individual who alleged she was the inventor of many of the patents owned by j2. The dismissal was affirmed by the Federal Circuit.
- **MPEG-LA**, a patent pool administrator, in various successful patent actions. The Am Law Litigation Daily named the partner in charge of MPEG-LA "Litigator of the Week" in 2010 for his successful role in its settlement during trial of an action pertaining to its MPEG-2 patent portfolio licensing program.
- **MPEG-2 and ATSC patent owners**, in an action that was among the first patent infringement cases in the United States concerning the technology for digital television mandated by Congress. The Firm also successfully advised multiple patent owners in various patent infringement actions brought in Germany involving MPEG-2 digital video compression patents.
- **Novo Nordisk AS and Novo Nordisk Inc.** in
 - an International Trade Commission investigation commenced by Baxter Healthcare concerning seeking the exclusion of Novo Nordisk's product Novoeight®, a drug that is used to treat hemophilia A. Baxter, which sells two other hemophilia A drugs, alleges that the manufacturing process used by Novo Nordisk to produce Novoeight® in Denmark infringes three of its patents on the production of recombinant proteins through the use of mammalian cell culturing.

- successfully obtaining a dismissal in two consolidated patent infringement actions brought by Novo's competitor Sanofi-Aventis, as well as a highly favorable settlement in a separate patent infringement action brought by Novo against Sanofi-Aventis.
 - a decision denying a preliminary injunction motion made by Sanofi-Aventis. The court rejected every claim in Sanofi-Aventis's motion alleging Novo made false statements under the Lanham Act.
- **U.S. Philips Corporation, Orange, S.A., TDF SAS and Institut Fur Rundfunktechnik, GmbH**, in defeating three petitions filed before the U.S. Patent Trial and Appeal Board seeking inter parts review of patents related to the MP3 technology.
- **VeriFone Holdings**, in defending false advertising claims brought by Heartland Payment Systems. S&C successfully obtained denial of a motion for preliminary injunction sought by Heartland. The Court determined that Heartland had failed to demonstrate either a likelihood of success on the merits on its federal Lanham Act claims or a threat of irreparable harm. In March 2011, all of the litigation between VeriFone and Heartland was settled.
- **Via Licensing**, in separate breach of contract actions brought against Compal Electronics and Pegatron Corporation. Both Compal and Pegatron had licensed patented audio compression technology from Via, and Via alleged that each failed to abide by contractual obligations related to the use of the technology. S&C obtained swift settlements with both Compal and Pegatron.