



**Submission to the *New Jersey Law Journal* Specialty Practice Area Contest
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I. 5 TO 7 SUCCESSFUL LITIGATION RESULTS

**A. *High Point SARL v. T-Mobile USA, Inc.*,
640 F. App'x 917 (Fed. Cir. 2016)**

Lerner David was asked to represent Ericsson, Inc. (contact: Ryan Wirtz, Esq., 972.583.3732) as lead counsel in connection with a patent infringement suit brought by High Point against Ericsson's customer, T-Mobile, in the District of New Jersey. High Point was represented by a team from Dechert LLP including Martin Black (215.994.2664). T-Mobile was represented by a team including Asim Bhansali of Kecker & Van Nest (415.676.2235). High Point's infringement contentions were directed, in part, to cellular telephone network infrastructure equipment that T-Mobile had purchased from Ericsson.

The Lerner David team first succeeded in having Ericsson intervene as a defendant in the action. Lerner David then asserted defenses which included that Ericsson had been licensed by prior owners of the patents-in-suit and that, in light of those licenses, High Point's infringement claims against T-Mobile were barred by the doctrine of patent exhaustion. Central to this position was the fact that a 1996 license from High Point's predecessor to Ericsson's parent company expressly authorized retroactive sublicenses to subsidiaries. Such a retroactive license had been granted to Ericsson in 2013, after High Point's suit was filed and after the patents had expired.

Lerner David moved for summary judgment on that defense in conjunction with T-Mobile's motion for summary judgment on patent exhaustion. In one of his last decisions before his untimely death, U.S. District Judge Joseph Irenas granted Ericsson's and T-Mobile's motions in all respects. *High Point SARL v. T-Mobile USA, Inc.*, 53 F. Supp. 3d 797 (D.N.J. 2014).

We continued to represent Ericsson in High Point's appeal to the Federal Circuit, with an appellate team consisting of Lerner David partners William Mentlik and Roy Wepner and then-associate (now partner) Robert Hander. High Point contended on appeal that Section 1.02 of the 1996 license (which provided that "all licenses granted herein under any patent shall . . . continue for the entire unexpired term of such patent") implicitly cut off the right to grant retroactive sublicenses when the patents expired. Lerner David beat back that argument, prompting the Federal Circuit to state that: "High Point's proposed approach would twist section 1.02 like a pretzel, turning a provision intended to protect a licensee from infringement liability throughout the full terms of the licensed patents into a restriction on the licensee's explicit right . . . to grant retroactive sublicenses to its subsidiaries." That ruling was an essential building block in T-Mobile's appellate victory on the defense of patent exhaustion. High Point's petition for rehearing was subsequently denied.

Our efforts in this matter were gratifying, as it not only was a homerun for our client Ericsson, but it also helped our client support its important customer T-Mobile. Still further, it showcased our ability to successfully serve our client's needs from the very first filing at the district court to the successful conclusion of an appeal.

**B. *NorthPeak Wireless, LLC v. 3com Corp. et al.*,
F. App'x, 2016 U.S. App. LEXIS 23319 (Fed. Cir. Dec. 28, 2016)**

Lerner David was asked to represent Buffalo Americas, Inc. (contact: Hiroshi Katano, 050-5830-8864) as lead counsel in a suit originally brought by NorthPeak Wireless, LLC in the U.S. District Court for the Northern District of Alabama against Buffalo and several other defendants. The case asserted infringement of two patents based upon the marketing of wireless communication products supporting the IEEE 802.11 standard, commonly referred to as “WiFi.” After successfully having the case transferred to the Northern District of California, Buffalo and the other defendants instituted *ex parte* reexamination in the Patent and Trademark Office (“PTO”) against both patents and obtained a stay of the litigation pending reexamination.

As a result of the reexamination, the claims of one of NorthPeak’s patents were invalidated outright, while the claims of the other patent were significantly narrowed in light of a prior art reference that Andrew Zidel, a partner on the Lerner David team, had originally identified and advanced as a basis for invalidity. Lerner David then helped achieve a claim construction ruling favorable to Buffalo and the other defendants, which was based in part on arguments NorthPeak made to the PTO to avoid the prior art. Following that ruling, NorthPeak stipulated to a final judgment of noninfringement and pursued an appeal of the claim construction decision.

On December 28, 2016, in its last opinion of 2016, the Federal Circuit affirmed the judgment of noninfringement. While the district court had ruled against NorthPeak on four groups of claim terms which supported the judgment of noninfringement, the Federal Circuit needed to address only one of the claim terms in affirming the judgment of noninfringement, emphatically concluding that the district court’s ruling was correct.

Buffalo was represented on the appeal by Lerner David partner Russell W. Faegenburg, and NorthPeak was represented by Christian John Hurt of Nix, Patterson & Roach, L.L.P. (903-645-7333). The appeal was argued on behalf of all of the defendants-appellees by Chad S. Campbell of Perkins Coie LLP (602-351-8393).

Lerner David considers this to be a significant victory, having achieved our client's objectives. It also highlights our ability to successfully represent a client as lead counsel before two out-of-state U.S. District Courts (in Alabama and California) and the Court of Appeals for the Federal Circuit in a single matter. It also demonstrates Lerner David's ability to be a major player in patent infringement suits brought against multiple defendants, which in this instance included companies such as Intel, Sony, Toshiba, and Dell.

***C. Sony Corporation v. Imation Corporation,
IPR No. 2015-01156 (P.T.A.B. Dec. 27, 2016)***

In late 2016, Lerner David partners Gregory Gewirtz and Russell Faegenburg achieved a victory before the U.S. Patent and Trademark Office (“PTO”) Patent Trial and Appeal Board (“PTAB”). They obtained a final written decision invalidating the challenged claims of U.S. Patent No. 6,908,038 (“the ’038 Patent”) in the face of an earlier PTAB decision upholding a closely related patent over the same prior art which we successfully relied on in invalidating the ’038 Patent nine months later in this PTAB proceeding.

The dispute began in March 2014, when Imation sued Sony (contact: Ryan Pohlman, Esq., 201-930-7315) in the U.S. District Court for the District of Minnesota. Imation (represented by Devan Padmanabhan of Winthrop & Weinstine, 612-604-6400), alleged that Sony’s Smartphone USB flash drive infringed the ’038 Patent and Imation’s closely-related U.S. Patent No. 6,890,188 (“the ’188 Patent”).

On June 1, 2015, the district court stayed Imation’s lawsuit pending resolution of anticipated *Inter Partes* Review (IPR) proceedings to be initiated by Sony on both asserted patents. Then, on July 6, 2015, our team filed IPR petitions in the PTAB challenging the ’038 and ’188 Patents. The PTAB granted our petitions and initiated IPR proceedings, concluding that there was a reasonable likelihood that Sony would establish that the challenged claims of the ’038 and ’188 Patents were invalid.

Our team then faced an ominous development. Another entity, Kingston Technology Company, Inc. had initiated its own IPR proceeding as to the same ’188 Patent, and on March 24, 2016, the PTAB issued a final written decision holding that Kingston *had not* met its burden of proving that the challenged claims of the ’188 Patent were unpatentable. Kingston had

also cited the same prior art references that formed the basis for Sony's challenge of the '038 and '188 Patents.

Nonetheless, the Lerner David team pressed forward and was ultimately vindicated. Following a trial hearing, on December 27, 2016, the same PTAB panel (three Administrative Patent Judges) that had previously ruled against Kingston issued its unanimous final written decision as to the '038 Patent, effectively reversing its earlier decision and holding that the challenged claims were indeed invalid as anticipated under 35 U.S.C. § 102.¹

Achieving this result was important for Lerner David, as it should allow its client Sony to avoid a jury trial and to eliminate Imation's patent rights as a potential obstacle. It also demonstrated Lerner David's creativity and willingness to proceed — and succeed — where others have failed.

¹Although not occurring until January 3, 2017, in IPR2015-01557, the PTAB reached the same conclusion as to the challenged claims of the closely related '188 Patent.

**D. *Alstom Grid LLC, v. Certified Measurement, LLC*,
No. 15-72-LPS-CJB, 2016 U.S. Dist. LEXIS 101465 (D. Del. Aug. 3, 2016)**

Lerner David successfully represented Certified Measurement, LLC (“CM”) (contact: Ed Gomez, Esq., 203-461-7065) as lead counsel in a declaratory judgment action filed by Alstom Grid LLC (“AG”) in the U.S. District Court for the District of Delaware. AG was represented by Angel Mitchell of Shook Hardy & Bacon (816-559-2565). Lerner David partners Stephen Roth and Russell Faegenburg, and associate Aaron Eckenthal, handled the claim construction briefing. Aaron Eckenthal argued at the *Markman* hearing, which resulted in Magistrate Judge Christopher Burke’s 22-page Report and Recommendation which adopted all of CM’s claim construction positions verbatim and ultimately led to settlement.

CM’s dispute with AG began on January 6, 2015, when CM sent a charge of infringement letter to AG alleging that its supervisory control and data acquisition (“SCADA”) systems infringed the patents-in-suit. The patents-in-suit related to certifying physical measurements and ensuring that accurate measurements are taken in situations where false measurements have serious consequences, such as in accident detection or where security information is a concern. On January 22, 2015, AG commenced the lawsuit by seeking a declaratory judgment that its SCADA systems do not infringe and the asserted patents are invalid. Lerner David managed to gain a stay of significant substantive discovery until after claim construction.

At issue during the *Markman* hearing were two terms in the patents for the Court to construe: “certifiable measurement” and “certified measurement.” The parties both disputed the proper construction of these terms and disputed whether “certifiable measurement” and “certified measurement” both meant the same thing. On both issues, in its Report & Recommendation (“R&R”), the Court fully agreed with Lerner David’s positions. Namely, the Court determined

that the terms have different meanings (CM's position) and adopted CM's different definitions of both terms verbatim.

The R&R ultimately resulted in a settlement in the case and was an important win from the client's business perspective. Lerner David's successful maneuvering on discovery and claim construction allowed the client to avoid substantial expenses associated with substantive discovery and permitted the client to then move forward to further enforce its patents. This case highlights Lerner David's ability to achieve a swift result at the outset of a case leading to settlement while advancing the client's business objectives.

**E. *VIP ME Enterprises LLC v. Frank Ma/Vipshop (US) Inc.*
FORUM Claim No. FA1611001702016 (Dec. 20, 2016)**

In the important area of cyber law, in December 2016, partner Paul Kochanski and associate Aaron Eckenthal prevailed before a FORUM Panel² that presided over a domain name dispute brought by VIP ME Enterprises LLC (“VIP”) against Lerner David’s client, Vipshop (US) Inc. (“Vipshop”) (Milinda Mei, +86-20-2233-0019). The case was brought as an UDRP (Uniform Domain-Name Dispute-Resolution Policy) arbitration proceeding established by ICANN (the Internet Corporation for Assigned Names and Numbers) to preside over disputes regarding the registration of internet domain names. From this success, Vipshop was able to continue to use its VIPME.com domain name and did not have to transfer ownership to VIP.

VIP, which was represented by Steven J. Miller of The Miller Law Offices (305.803.5168) owned United States Service Mark Registration No. 4,612,288 for VIPME, covering advertising services on the Internet for others. VIP used its VIPME service mark in connection with a mobile app that provided deals on “VIP” bottle service in nightclubs. Vipshop, on the other hand, is an online retailer that offers flash sales on women’s clothing and fashion accessories and used the domain name VIPME.com.

In its complaint filed in November 2016, VIP alleged that Vipshop used its VIPME.com domain name to advertise third party goods, albeit women’s clothing and apparel, in violation of VIP’s registered VIPME service mark. It also alleged that Vipshop knew or should have known that VIP applied for the VIPME service mark before Vipshop chose the name of its company, Vipshop (US) Inc., and registered its VIPME.com domain name. As such, VIP asserted that Vipshop had no right or legitimate interests in the VIPME.com domain name and was using its

²Founded in 1986, FORUM provides dispute resolution through panels of over 200 former judges and seasoned lawyers, who apply the applicable FORUM rules and substantive law to resolve disputes. See <http://www.adrforum.com/AboutForum>.

domain name in bad faith. VIP requested that the Panel order that the domain name VIPME.com be transferred to VIP or cancelled.

In a success for Vipshop, the Panel agreed with Lerner David's arguments and found that VIP failed to show that Vipshop lacked rights and a legitimate interest in its VIPME.com domain name and also failed to establish that Vipshop acted in bad faith when it registered and used VIPME.com. Thus, the Panel concluded that VIP failed to establish two of the three elements required to succeed in the proceeding and denied the Complaint.

This decision was important to Lerner David's client Vipshop because a loss would have required a transfer of its successful VIPME.com domain name to VIP and a costly rebranding of its entire business. As such, Lerner David was able to save its client a considerable amount of time and money involved in such rebranding efforts. This decision highlights Lerner David's wide range of expertise in litigation and cyber law matters including domain name disputes and UDRP proceedings.

**F. *Iron Gate Sec., Inc. v. Lowe's Cos.*,
15-cv-8814, 2016 U.S. Dist. LEXIS 34061
(S.D.N.Y. Mar. 16, 2016), *reconsideration denied*,
2016 U.S. Dist. LEXIS 48610 (S.D.N.Y. Apr. 11, 2016) (“Iron Gate I”)**

Lerner David successfully defeated a Rule 12(b)(6) motion to dismiss a patent infringement complaint in this case at a time when many courts were demanding more and more specificity and plausibility under the Supreme Court's *Iqbal* decision and its progeny.

Lerner David's client Iron Gate (contact: Jason Charkow, 646-664-4302) had filed suit against Lowe's in 2015 in the Southern District of New York and asserted two patents against Lowe's "Iris" surveillance cameras systems used to remotely monitor locations such as the home. Iron Gate was represented by Lerner David partners Gregory S. Gewirtz and Jonathan A. David, and associate Alexander Solo. Lowe's (represented by Michael Oakes of Hunton & Williams, 202-955-1500) sought an early Rule 12(b)(6) dismissal for failure to state a claim upon which relief can be granted.

On March 16, 2016, Judge Shira A. Scheindlin, who was then presiding over the action, issued an opinion and order denying the motion as to all direct and indirect infringement claims. Judge Scheindlin considered all of Iron Gate's allegations as to direct infringement, induced infringement, and contributory infringement, and concluded that Iron Gate's pleading was sufficient as to each one of these claims. As to willful infringement, she concluded that the original allegation (raised only in the prayer for relief) did not include enough facts to rise to the level of objectively reckless risk of infringement, but gave Iron Gate leave to amend in that regard. Iron Gate then amended its complaint to include more specific allegations of willful infringement, and this aspect of the pleading was not challenged again.

Lowe's then filed a motion for reconsideration. In doing so, Lowe's sought to elicit a claim construction that it believed might render Iron Gate's pleading insufficient, which

Judge Scheindlin denied as “nothing but a rehash” of arguments previously made and rejected.

She added:

While defendant is understandably disappointed with this Court’s ruling, and while it may sincerely believe this Court reached its decision in error, its proper course of action is to appeal the March 16 Order at the appropriate time — not to seek reconsideration of an issue already fully considered by this Court.

Judge Scheindlin subsequently stepped down from the bench, and was replaced by Judge Katherine B. Forrest as discussed below in Part G in connection with *Iron Gate II*.

**G. *Iron Gate Sec., Inc. v. Lowe's Cos.*, 15-cv-8814, 2016
U.S. Dist. LEXIS 101796 (S.D.N.Y. Aug. 3, 2016) (“*Iron Gate II*”)**

In the same patent case as discussed in Part F above (“*Iron Gate I*”), Lerner David next defeated an “*Alice*” Rule 12(b)(6) motion to dismiss. Again, this occurred at a time when many courts were routinely granting such motions for failing to pass the two-part test for patent eligibility set forth by the Supreme Court in *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014) (“*Alice*”).

After losing its motion to dismiss based on insufficiency of the pleading under *Iqbal* and its progeny, Lowe’s then attempted to narrow the case by asking the district court to toss out one of the two patents, the ’693 Patent, which related to cross-indexing of multimedia data such as video data from surveillance cameras. Lowe’s thus filed a Rule 12(b)(6) motion to dismiss Iron Gate’s claim under the ’693 Patent, asserting that the patent was directed to an unpatentable abstract idea under 35 U.S.C. § 101 and *Alice*.

On August 3, 2016, Judge Katherine B. Forrest issued a detailed 31-page opinion in which where she agreed with Iron Gate that the ’693 Patent was not directed to an abstract concept (thereby satisfying step one of *Alice*) and also contained an inventive concept that transformed the claims into a patent-eligible invention (thereby satisfying step two of *Alice*).

Helpful to Judge Forrest was the oral argument presented on July 27, 2016, by Jonathan David on behalf of Iron Gate, in response to the Court’s unusual July 15, 2016 Order, which stated:

The Court . . . believes that oral argument would be beneficial on one particular issue — namely, each party’s explication of the ’693 patent (essentially, the Court would like to better understand the patent). In particular, the Court is interested in hearing: (1) how plaintiff explains the invention described in the ’693 patent, (2) where defendant disagrees with that explanation, and (3) to the extent that defendant disagrees, how its interpretation supports the conclusion that the claim should be dismissed under *Alice* . . . and its progeny.

The ruling favorable to Iron Gate led to settlement of the case. This case is also significant for having received considerable attention from the patent bar³ because Judge Forrest's opinion bucked the trend of routinely tossing out patent cases before they even begin by way of a Rule 12(b)(6) *Alice* motion to dismiss.

³See, e.g., "Judge Forrest Provides Litigants Guidance on Applying Alice" by Lewis V. Popovski on August 9, 2016: <https://www.pbwt.com/abhishek-bapna/ny-patent-decisions-blog-2/judge-forrest-provides-litigants-guidance-applying-alice/>, "Lowe's Can't Get Security-Cam Patents Killed Under Alice," Bonnie Eslinger on August 5, 2016: <https://www.law360.com/articles/825427/lowe-s-can-t-get-security-cam-patents-killed-under-alice>; "TiVo Patents Reinstated As New Judge Reapplies Alice Test" by Melissa Daniels on November 29, 2016, <https://www.law360.com/articles/866981/tivo-patents-reinstated-as-new-judge-reapplies-alice-test>.

II. ESSAY

OUR EVOLUTION

From the very beginning of the Lerner David firm in the late 1960s, when four young patent lawyers formed what would later be called an intellectual property “boutique” on Elm Street in Westfield, New Jersey, Lerner David has been involved in IP litigation. Since then, in countless ways, our firm’s IP litigation team has evolved into a perennial major player on IP litigation battlefields throughout the United States. Here is what makes us stand out in IP litigation law:

First, because so much of our practice involves technology, as new technologies emerge, our firm has evolved in terms of the breadth of our technological expertise. Our IP litigation team includes lawyers who are comfortable practicing in a dizzying array of technologies. Some of our lawyers are technical experts in their own right. Moreover, many of our attorneys who have science or engineering degrees in one technical area have evolved into litigating in other technical areas. We have been able to accomplish this in part because our fascination with technology that steered us to study science or engineering in the first place allows us to quickly learn concepts in new areas from our clients, our experts, and each other.

Second, the breadth of our practice has evolved as substantive IP law has evolved. For example, when our firm started to handle IP litigation, there was no Hatch-Waxman Act, and no such thing as an Abbreviated New Drug Application. But as pharmaceutical practice has burgeoned into a prominent aspect of IP litigation, our experience and expertise have kept pace in this area. Likewise, when the recent America Invents Act brought fundamental changes in patent proceedings and law, we were all over it.

Third, our firm has evolved in terms of where we fight our IP battles. When we started, virtually every IP dispute played out in a U.S. District Court, and occasionally escalated to a

regional Court of Appeals. From the time patent appeals were eventually consolidated in the Federal Circuit, we have made regular appearances at that court and have been on the winning side of more than two dozen Federal Circuit appeals.

Many patent disputes over the years have also migrated into administrative fora. We gave ourselves a continuing goal of mastering the rules of the road in new administrative procedures as they arose, and we have evolved to meet that goal. We began with a mastery of patent “interferences,” which are now essentially defunct. As the Patent and Trademark Office administrative procedures evolved through *ex parte* reexaminations into *inter partes* reexaminations, and then into post-grant reviews and *inter partes* reviews, we have evolved as well, as reflected by certain of our litigation successes in these fora as discussed above. In 2016, our evolution brought us to yet another forum: a state appellate court, in which we have briefed and argued an important appeal dealing with intellectual property licensing.

There also has been evolution by our firm in fora in which trademark and domain name disputes can be resolved. Witness our success in 2016 in a proceeding under the Uniform Domain Name Resolution Policy established by ICANN, discussed above among our recent litigation successes.

We have also had success in the alternate dispute resolution arena. Two of our partners have successfully served as mediators in IP litigations. In 2016, we also successfully represented a client in an IP-related arbitration — a virtually unknown forum in IP’s early years. The details are confidential, which prevents us from discussing it as a litigation success, but it suffices to note that after we took a lengthy and damaging deposition of the opposing party, the case settled quickly for a small fraction of what the opposing party had demanded.

Fourth, we have also evolved to meet the challenges of an IP litigation legal practice landscape that bears no resemblance to the one we were part of several decades ago. As virtually every large general practice firm in the United States began to offer IP litigation (when virtually *none* of these firms did so before the 1980s), we chose *not* to become just another firm that offers one-stop shopping to clients, and declined numerous offers to merge with such firms or practice in other areas of law outside of IP. Instead, we doubled down on our commitment to remain the best independent IP boutique we can be, which does one thing and — in our opinion — does it very well.

Finally, a challenge we faced over the past few years continues to surface when litigating against large general practice firms. Many of those firms attack a litigation by throwing a large number of bodies on a case. Our firm, on the other hand, does not have a comparable number of available people, and — in any event — we do not expect our clients to pay for a large number of lawyers on a given matter. Instead, we continue to staff our litigation matters with a lean core team that usually includes two partners who know the matter inside out, assisted by one or two associates, who are given significant substantive roles, and specialty lawyers judiciously brought in at various times as the need arises. But our “left hand” *always* knows what our “right hand” is doing and oftentimes those hands are connected to the same body. Unlike many large firms, we sometimes tactically leave some stones unturned, and opt to turn over stones “A” and “B” but not stone “C” that might be overkill and lead to a costly detour, or a dead end, or both. The trick — we have learned — is to have the experience and judgment to predict which stones are most promising, and which are not.

III. SIZE OF FIRM'S SPECIALTY LITIGATION DEPARTMENT

Lerner David's entire practice is limited to intellectual property law, such that all of its litigation is IP litigation.

Lerner David does not maintain a separate litigation department. None of its lawyers practices only in litigation. However, a number of its lawyers spend much if not most of their time on litigation, as follows:

Partners:	16
Associates and other attorneys:	12

IV. PERCENTAGES REPRESENTED BY SPECIALTY LITIGATION

The 28 Lerner David attorneys who devote much if not most of their time to litigation represent approximately 42% of the 66 total lawyers at the firm in December 2016.

In 2016, court litigation, *inter partes* administrative proceedings, and related matters accounted for approximately 27% of the firm's billing.

V. CLIENT REFERENCES

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VI. LITIGATION LOSS

Congoo, LLC d/b/a Adblade v. Revcontent LLC
Civil Action No. 16-401 (D.N.J.)

Lerner David represents Congoo, LLC d/b/a Adblade (“Adblade”) in this case involving a type of Internet advertising known as “native advertising,” which integrates online advertising in published content on various Internet news and information sites. On behalf of Adblade, Lerner David partners Charles P. Kenney and Gregory S. Gewirtz, and associate Alexander Solo, brought suit in the District of New Jersey against Revcontent for false advertising and false designation of origin under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) and also moved for a preliminary injunction. Adblade asserted that Revcontent’s ads and its websites redirected unsuspecting consumers, employing false and misleading advertising intended to deceive innocent consumers out of significant funds by charging their debit cards or credit cards.

Lerner David suffered a loss in this case when the district court denied Adblade’s motion for preliminary injunction. However, despite this loss, there remain considerable reasons for Adblade and Lerner David to be optimistic about the ultimate outcome.

Early in this action, when Adblade moved for a preliminary injunction, Revcontent countered with a motion to dismiss the complaint. On April 15, 2016, U.S. District Judge Michael A. Shipp denied Revcontent’s motion to dismiss. *Congoo, LLC v. Revcontent LLC*, 2016 U.S. Dist. LEXIS 50151 (D.N.J. Apr. 15, 2016). Judge Shipp first rejected Revcontent’s contention that it was not subject to personal jurisdiction in New Jersey, and that venue was improper in the District of New Jersey. On a more important substantive level, Judge Shipp agreed with Lerner David’s arguments that Adblade’s complaint stated a claim for relief under Section 43(a). Judge Shipp also rejected Revcontent’s contention that it was immune from suit

based on Section 230 of the Communications Decency Act (“CDA”), 47 U.S.C. § 230, concluding that Adblade’s allegations were sufficient to overcome this defense.

However, on September 8, 2016, following a three-day evidentiary hearing, Judge Shipp denied Adblade’s motion for a preliminary injunction. In an oral decision, Judge Shipp made clear that failure to prove irreparable injury was the only basis on which he was denying the preliminary injunction, in that any harm suffered by Adblade in the court’s opinion could be compensated for by money damages. Judge Shipp also largely ignored Revcontent’s primary argument on the merits that it was immune from liability under the CDA.

While the denial of the preliminary injunction was disappointing, the Court’s earlier substantive ruling on the sufficiency of Adblade’s complaint, coupled with the Court’s failure to impugn Adblade’s likelihood of success under the preliminary injunction motion, provide a bullish outlook for Lerner David taking this case to a jury trial. It is expected that the case will be tried in 2017, at which time Adblade will be seeking damages, profits, attorney fees, and a permanent injunction.

VII. UPCOMING MATTERS

A. *Amneal Pharmaceuticals, LLC v. Purdue Pharma L.P., Inter Partes Review of OxyContin[®] Patents, IPR Nos. 2016-01027, -01028, -01412, and -01413 (Patent Trial and Appeal Board)*

In a series of related decisions issued in favor of Lerner David client Amneal Pharmaceuticals, the Patent Trial and Appeal Board (“PTAB”) of the U.S. Patent and Trademark Office instituted *Inter Partes* Review in response to four petitions challenging the validity of two key patents listed in the Orange Book for OxyContin[®] (oxycodone HCl).

In a first set of institution decisions entered in IPR Nos. 2016-01027 and -01028 in November 2016, the PTAB agreed that Amneal had shown that there is a reasonable likelihood of success that it would prevail with respect to three different grounds for invalidity as to U.S. Patent No. 9,060,976. Subsequently, in a second set of decisions entered in IPR Nos. 2016-01412 and -01413 in January and February 2017, the PTAB again found in Amneal’s favor and instituted IPR on three different grounds of invalidity as to the challenged claims of U.S. Patent No. 9,034,376. Both patents are directed to pharmaceutical formulations containing a gelling agent to provide abuse deterrence and are among the patents currently listed by Purdue Pharma in the FDA’s Orange Book for OxyContin[®], a number of which have previously been held invalid in a series of ongoing litigations between the parties dating back to at least 2011.

Trials on the four IPRs are scheduled for August and October 2017.

B. *Freeman v. Delta Air Lines, Inc., Civil Action No. C 13-014179 JSW (N.D. Cal.)*

Lerner David is serving as lead counsel for Delta Air Lines in a case involving electronic boarding passes. In this case, the plaintiff sued Delta for patent infringement over Delta’s use of bar codes on its boarding passes. The issue relates to how these bar codes speed passenger check-in and save computer search time. To date, Lerner David has prevailed on a *Markman* claim construction hearing, *see Freeman v. Delta Air Lines*, 2015 U.S. Dist. LEXIS 128780

(N.D. Cal. Sept. 24, 2015), and succeeded in having the majority of plaintiff's claims withdrawn. Lerner David recently prevailed on a sanctions motion to stop plaintiff's counsel from contacting Delta's employees, resulting in a "strong reprimand" and an award of fees and costs.

In 2017, the case will complete discovery, expert witness exchanges, motion practice, as well as all pretrial proceedings. The pretrial conference is scheduled for December 2017, with trial to begin on January 3, 2018.

C. Luye Pharma Group Ltd. et al. v. Alkermes Controlled Therapeutics, Inc., IPR No. 2016-01096 (Patent Trial and Appeal Board)

On May 31, 2016, Lerner David filed a petition for *Inter Partes* Review of U.S. Patent No. 6,667,061 ("the '061 Patent") on behalf of Luye Pharma Group Ltd., Luye Pharma (USA) Ltd., Shandong Luye Pharmaceutical Co., Ltd., and Nanjing Luye Pharmaceutical Co., Ltd. The '061 Patent, owned by Alkermes Pharma Ireland Ltd., relates to increasing the viscosity of the fluid phase of an injectable suspension. The '061 Patent is listed in the Orange Book for Risperdal[®]CONSTA[®] (risperidone). Risperdal[®]CONSTA[®] is a long-acting injection of risperidone indicated for the treatment of schizophrenia and bipolar disorder and is marketed by Janssen (a unit of Johnson & Johnson) and Alkermes.

Lerner David's petition on behalf of Luye challenged 20 claims of the '061 Patent under two separate groups of prior art references. On November 30, 2016, the PTAB found a reasonable likelihood that all of the challenged claims were invalid for obviousness; and for several claims, it so concluded on both grounds asserted by Luye.

Trial of the IPR is scheduled for August 28, 2017.