

## Intellectual Property Litigation



Lathrop GPM's Intellectual Property Litigation team has expertise in a wide range of complex intellectual property issues. The team approaches IP litigation with a creative eye, focusing on efficient and effective ways of meeting clients' needs. The strong reputation of Lathrop GPM's IP litigation attorneys gives clients a solid negotiating position throughout the entire litigation process—and whether a victory for the client means going to trial or negotiating an advantageous agreement, the team finds cost-effective solutions to resolve disputes and secure their clients' business interests.

Lathrop GPM's intellectual property litigators have ample experience in:

- Trademark Litigation
- Trade Secret Litigation
- Patent Litigation
- Copyright Litigation

### **Trademark Litigation**

The Trademark Litigation team is dedicated to protecting clients' trademarks and minimizing the risk of infringement. The team has litigated trademark claims in federal and state courts across the U.S., as well as before the USPTO and the Trademark Trial and Appeals Board in opposition and cancellation proceedings. Whether the client is a small business or a Fortune 500 company, the trademark litigation team aims to win in a cost-effective manner.

Lathrop GPM's Trademark Litigation team has experience in areas including:

- Trademark and trade dress infringement
- Deceptive trade practice litigation
- False advertising litigation

- Unfair competition litigation
- Rights of publicity and defamation litigation
- Counterfeiting
- Trademark Trial and Appeal Board proceedings
- Uniform Domain Name Dispute proceedings national and internationally
- False labeling

### **Trade Secret Litigation**

Lathrop GPM's Trade Secret Litigation team is made up of both intellectual property and employment law attorneys, allowing them to speak to the many intersecting issues that arise from trade secret disputes. With access to this cross-disciplinary expertise, backed up by experienced and respected trial attorneys, Lathrop GPM's trade secret litigators ensure a comprehensive approach to protecting their clients' competitive advantage. Our team has litigated numerous cases involving trade secret misappropriation (including the federal Defend Trade Secrets Act of 2016.)

### **Patent Litigation**

Lathrop GPM's Patent Litigation team has represented patent-holders and accused infringers across the United States. The team has litigated patents spanning a number of different industries and business sectors, and clients trust Lathrop GPM patent litigators to navigate the complex legal and technical questions that can arise from patent disputes.

### **Copyright Litigation**

The Lathrop GPM Copyright Litigation team has represented clients in copyright litigation relating to both traditional works and new technologies. The team works zealously to enforce its clients' copyrights, while also advising on strategies to minimize the risk of infringement. The team's reputation in the courtroom gives it significant leverage to resolve copyright disputes before a case goes to trial, and the team's extensive litigation experience ensures that clients are well positioned to prevail if and when a trial cannot be avoided.

## Select Representative Experience

### *Trademark Litigation*

- Represented health care provider and health insurance company in declaratory judgment action against world's largest retailer seeking declaration that logo marks do not infringe trademarks; case successfully resolved prior to trial, and client continues to use its mark. *HealthPartners v. Wal-Mart and Sam's Club*
- Won summary judgment for plaintiff's British Broadcasting Corporation and affiliated entities in two lawsuits involving trademark infringement and dilution of the famous Dancing With The Stars trademarks and breach of and interference with BBC's contracts with its professional dancers by defendants' competing live dance shows. Won partial summary judgment for Plaintiffs, including a complete dismissal of defendants' contract interference and trademark cancellation counterclaims and dismissal of defendants' affirmative defenses of trademark genericism and abandonment. Her gutting of defendants' claims and defenses on summary judgment led to the matter being resolved with a Consent Judgment and Permanent Injunction against defendants.
- Obtained complete defense verdict following two week jury trial in U.S. District Court for the Central District of California on allegations of false advertising related to one of client's best-selling products. In the same trial, obtained eight-figure verdict in our client's favor on affirmative counter-claims brought against other party's competing product.
- Won defense victory for defendant Nike in its landmark trademark case against Adidas over Nike's right to use two stripes on athletic apparel; Adidas filed a broad "covenant not to sue" releasing Nike from all past trademark claims and its own infringement counterclaims, and committing not to sue Nike over any two-striped athletic apparel or shoes throughout the United States.
- Successfully obtained preliminary injunction in order to keep defendant from using our client's name as a motion picture title; film ultimately released under another title.
- Won a targeted summary judgment of non-willfulness for defendant VIZIO against plaintiff Razor USA, LLC in a trademark infringement and dilution matter. The summary judgment victory propelled the case to settle on the eve of trial, with plaintiff dropping its damages claim and agreeing to buy VIZIO's trademarks.

- Successfully defended a false advertising Lanham Act case in the U.S. District Court for the Southern District of N.Y. on one of our client's most important products. Obtained favorable summary judgment ruling that resulted in plaintiffs dropping all claims with prejudice.
- Successfully enforced Harley-Davidson's famous Bar & Shield trademarks against competitors in the insurance industry.
- Successfully represented franchisor in obtaining restraining order and preliminary injunction based on trademark law against franchisee whose restaurant was poorly maintained in violation of company standards.
- Successfully defended Canadian company accused of trademark infringement; upon our contested motion, magistrate judge recommended dismissal for lack of jurisdiction; complaint dismissed with prejudice by plaintiff. *Mitzi International Handbags & Accessories, Ltd. v. Alliance Sales and Distribution, Inc.*
- Achieved injunction and substantial compensation on the eve of trial against competitor in the plush toy industry for violating the trade dress of client's core product line.
- Successfully defended medical device maker, Genii, in dispute with trademark owner over alleged use mark in use on a surgical generator. The case was settled on favorable terms. *ERBE Elektromedizin GmbH, et al v. Genii, Inc.*
- Successfully represented KLN and Nut Heads in opposition proceedings before the TTAB and brought a Declaratory Judgment action in federal court to protect the clients' rights. The matters settled on favorable terms. *KLN Enterprises, Inc., and Nut Heads Chocolate Factory, Inc., v. Ferrara Pan Candy Co., Inc.*
- Affirmed summary judgment granted in client's favor in domain name dispute involving trademark infringement and cybersquatting claims. *Southern Grouts & Mortars, Inc. v. 3M Company*
- Granted summary judgment in client's favor, dismissing trademark infringement claims by producer of Lord of the Rings films, where client had used its mark HOBBITT TRAVEL for three decades. *Saul Zaentz Co. v. Wozniak Travel, Inc.*
- Successfully represented client in opposing trade dress infringement claim based on the plaintiff's registration of a color blue for ice fishing shelters. *Clam Corp., Inc. v. Innovative Outdoor Solutions, Inc.*

### ***Trade Secret Litigation***

- Obtained complete defense verdict—no liability—in jury trial for misappropriation of trade secret and confidential information case. *Nu-Look Exteriors, Inc. v. 4-Corner Architectural Sheet Metal, Inc.*
- Successfully obtained permanent injunction via arbitration, preventing the manufacture of material infringing upon client's proprietary stain-resistant fabric. *Higher Dimension Materials, Inc. v. Performance Fabrics, Inc.*
- Represented Korean mobile device developer in dispute over misappropriation of trade secrets. *M Seven System v. Leap Wireless, et al.*
- Successfully represented client in a multi-claim suit against client, a flameless heater manufacturer and one of its suppliers, for patent infringement and trade secret misappropriation. *Warp Speed Torque Drive, LLC v. M.A.C., Inc.*
- Obtained \$22.7 million jury verdict in misappropriation of trade secret and confidential information case. *Relco, LLC v. Custom Fabricating & Repair*
- Successfully acted to get claims for patent infringement and trade secret misappropriation against client, a flameless heater manufacturer and one of its suppliers, dismissed. *Brookins Hybrid Drive Sys. v. M.A.C., Inc.*
- Obtained judgment for over \$1.5 million dollars for client in trade secret misappropriation action. *Analog Tech. Corp. v. Dimation, Inc., et al.*

### ***Patent Litigation***

- Won \$400 million verdict in jury trial representing a university-based licensing entity in a patent-assertion action over FinFET technology. *KAIST IP US LLC v. Samsung Electronics Co., LTD., et al.*
- Secured vacatur of multi-million dollar judgment against Korean marine electronics company and dismissal of infringement claims involving marine GPS technologies. *Condatis v. Arcturus, et al.*
- Won summary judgment for defendant Roche invalidating three Stanford HIV test patents for obviousness, ending Stanford's multi million dollar patent infringement suit. Won the case on appeal to the Federal Circuit and before the en banc Court on rehearing, and won decisive victory in favor of Roche in the U.S. Supreme Court.

- Obtained favorable settlement and disposition on behalf of Korean manufacturer of x-ray devices in patent declaratory judgment action. *Dexcowin Global, Inc. v. Aribex, Inc.*
- Defended several banks and financial institutions against claims of infringement involving various checking imaging patents. *Datatresury v. Remitco, et al and Datatresury v. Wells Fargo, et al.*
- Successfully defeated an International Trade Commission investigation and related case in the District of Connecticut regarding patent infringement on one of our client's highest selling products. Adverse party withdrew the ITC Complaint and dropped the district court case following our filing of an innovative IPR.
- Obtained first-ever invalidation of a design patent through an IPR. Decision was subsequently affirmed by the Federal Circuit, followed by successfully defeating patent holder's petition for certiorari at U.S. Supreme Court.
- Won summary judgment of noninfringement for a Korean manufacturer of outdoor activity equipment and supplies against three patents directed to clip-lights. *Foundton, Co. Ltd v. Naschem Co., Ltd., et al.*
- Defended client against claims of infringement over patent for visual aid device. *Freedom Scientific v. HIMS*
- Won summary judgment for defendant Nero against JVC Kenwood, finding nine JVC optical disc patents noninfringed due to patent exhaustion and express release. The Federal Circuit affirmed the summary judgment in Nero's favor. *JVC Kenwood Corp. v. ArcSoft Inc., et al.*
- Obtained a Judgment on the Pleadings invalidating all five asserted patents as directed to ineligible subject matter. *Concaten, Inc. v. AmeriTrak Fleet Solutions*
- Represented a global supplier of automotive systems in four federal district court cases, two International Trade Commission cases, and 60-plus inter partes review matters. Matter was ultimately settled on favorable terms for our client.
- Successfully defended outdoor equipment manufacturer against claims of design patent infringement, utility patent infringement, and trade dress infringement. *Beavertail Products, LLC, et al. v. YETI Coolers, LLC*
- Represented manufacturer of MRI safety devices in dispute over ferromagnetic detection technology. *Mednovus Inc. et al v. Qinetiq Ltd, et al.*

- Obtained a ruling in favor of our pharmacy automation systems client before the U.S. Court of Appeals for the Federal Circuit in a matter involving an automated prescription-filling machine. The ruling reversed the prior patent interpretation/invalidity decision of the U.S. District Court for the District of Kansas. Our client develops, provides and supports robotics-based management, workflow, and telepharmacy systems for pharmacies.
- Defended Smoothie King in a patent litigation brought by a non-practicing entity; case resolved early on favorable terms. *Traffic Information, LLC v. Smoothie King Co., Inc.*
- Obtained a complete win for a client in two separate IPR challenges of U.S. Patent. 8,381,573 assigned to Soberlink Inc., which relates to a portable sobriety monitoring device that wirelessly transmits a test taker's image and breathe test data to a server.
- Successfully represented client in a multi-claim suit against client, a flameless heater manufacturer and one of its suppliers, for patent infringement and trade secret misappropriation. *Warp Speed Torque Drive, LLC v. M.A.C., Inc., et al.*
- Serve as intellectual property counsel to a global heavy-duty equipment manufacturing company. Representation includes multiple matters resulting in favorable judgment or settlement. One example was a granted summary judgment affirmed on appeal in the U.S. Federal Circuit case, *New Railhead Mfg. Co. v. Vermeer Mfg. Co. & Earth Tool Co.*
- Successfully defended a Fortune 500 national retailer and manufacturer, in a massive patent case in the U.S. District Court for the District of New Hampshire. The plaintiff sought \$650 million in damages. Litigation resulted in multiple favorable Markman rulings, and ultimately, summary judgment on all claims.
- Recently represented a leading supplier distilled spirits, MGP Ingredients in a high stakes patent infringement and trade secret case in the District of Kansas against its competitors Penford Corporation and Ingredion. MGP sued Penford Corporation and Ingredion Incorporated asserting that one of their low calorie products infringed an MGPI patent, and that defendants had misappropriated MGPI's trade secrets, committed unfair competition and violated Kansas restraint of trade statutes. The case was successfully settled and subsequently dismissed on July 14, 2016, with substantial compensation to MGPI and a new, ongoing "win-win" business relationship between the parties.
- Represented Korean MP3 company in defense of infringement claims involving MP3 technologies. *Tsera, LLC v. Apple, Inc., et al.*

- Represented licensing entity in its assertion of core WiFi standard-essential patents. *Wiav Networks v. 3Com, et al.*
- Represented licensing entity in its assertion of 3G and GSM standard-essential patents. *WiAV Solutions, LLC v. Motorola, Inc., et al.* and *WiAV Solutions, LLC v. RIM, Ltd., et al.*
- Defended multiple Fortune 500 companies in patent troll cases around the country, including the Eastern District of Texas, District of Delaware, Eastern District of Virginia and the Northern District of Illinois.
- Successfully acted to get claims for patent infringement and trade secret misappropriation against client, a flameless heater manufacturer and one of its suppliers, dismissed. *Brookins Hybrid Drive Sys. v. M.A.C., Inc.*
- Represented Schlagel in enforcing one of its patents related to grain handling equipment against Schlagel's competitor, S-M Enterprises; following initial discovery, the case resolved on favorable terms in July of 2013; S-M Enterprises also redesigned its grain handling equipment. *Schlagel, Inc. v. S-M Enterprises, Inc.*
- Represented sporting goods manufacturer in declaratory judgment action to invalidate patent, and defending patent infringement claims, and in defending parallel patent false marking case; successfully resolved before trial. *Birchwood Laboratories v. Battenfeld Technologies*

### **Copyright Litigation**

- Won bench trial on the issue of copyright ownership for defendant Reuben Klamer, the author of the iconic board game, The Game of Life. The Court was persuaded that plaintiff's late husband's work on the prototype of the game was a work for hire for Mr. Klamer. The Court held unequivocally that Mr. Klamer was the author of the game and the owner of the copyright on it.
- Won partial summary judgment on behalf of defendants Conan O'Brien, his production company, head writer, and the TBS network, finding no copyright infringement as to certain monologue jokes used on the Conan O'Brien show.
- Won summary judgment for plaintiff authors against executives of the Los Angeles Unified School District for copyright infringement and contributory copyright infringement.
- Served as lead counsel for defense of the Refinery in copyright infringement case through four-day jury trial; jury found in favor of statute of limitations defense and awarded plaintiff only two percent

of amount requested; court denied plaintiff's motion for attorneys' fees as prevailing party. *Energy Intelligence Group, Inc. v. CHS McPherson Refinery, Inc.*

- Won motion to dismiss, dismissing all defendants in copyright infringement action on the novel ground of forum non conveniens, due to the fact that plaintiff had entered into a prior agreement with defendants' affiliates containing a forum selection clause.
- Resolved copyright infringement disputes regarding posting of photographs on commercial website. *BWP Media USA, Inc. v. Leighton Enters., Inc.*
- Defended a copyright claim on behalf of production company involved with production of a television ad. *Lucky Break v. Sterling, et al.*
- Affirmed copyright infringement verdict regarding greeting card designs in client's favor. *Taylor Corp. v. Four Seasons Greetings, LLC*