

Intellectual Property Litigation

pillsbury

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“Victory at any cost” is not the only choice.

When your company is facing an intellectual property challenge that puts brands or product lines at risk, you select the legal team most likely to achieve the results you seek: victory, on your terms. Pillsbury’s Intellectual Property Litigation team does more than just win—we resolve disputes rapidly and cost-effectively.

Working with Pillsbury means working with litigators whose practices are focused on IP, and who are selected for your case because they know your industry, your technology and the courts. The team you hire is the team that will handle your case from the first meeting to the final disposition.

A seasoned, dedicated legal team focused on early victory. It is a winning approach.

The following cases represent just some of the many recent successes Pillsbury’s IP Litigation team has achieved for our clients.

“The Court reemphasizes the fact that Plaintiff initiated this suit pursuing an inflated claim for damages which required a vigorous defense. The Court also notes that Defendant was completely successful, and Defendant’s counsel could not have achieved a better result for their client...”

U.S. District Court Judge Kenneth A. Marra, in his award of more than \$1 million in attorneys’ fees to Pillsbury’s client Atlas Copco

Atlas Copco: Securing Attorneys' Fees for the Client and Praise from the Judge



Company:	Atlas Copco
Industry:	Tools and machinery
Areas of Law:	Patent infringement, breach of contract, appellate
Venues:	U.S. District Court for the Southern District of Florida, U.S. Court of Appeals for the Federal Circuit
Result:	Capped a successful defense with a seven-figure attorneys' fees award

Pillsbury IP attorneys have been representing Atlas Copco, a global tool and equipment company, for nearly a decade in one case with more than \$200 million in damages at stake. Over the years, Pillsbury's lawyers have led Atlas Copco to repeated victories, defeating claims on summary judgment, in a jury trial and in a subsequent appeal to the U.S. Court of Appeals for the Federal Circuit.

Atlas Copco then sought to recover its costs and attorneys' fees. The company's original contract awarded "legal costs and expenses" to the victor in any breach-of-contract litigation. A district court awarded the company expenses that excluded attorneys' fees, but Pillsbury helped Atlas Copco win the attorneys' fees issue on appeal at the Federal Circuit.

When the case returned to that district court, the judge noted Pillsbury's efficiency and effectiveness as he awarded \$1 million in attorneys' fees to Atlas Copco. The company's General Counsel of Operations and Vice President commented, "Very rarely have we been able to get any legal fees and costs back in litigation in the U.S., and we see this as almost ground-breaking."

“After a trial, the Court of Chancery ruled substantially in favor of CA, awarded CA \$2.25 million in fees and costs, and enjoined Ingres from prosecuting the California Action...”

“We find no merit to Ingres’ appeal and affirm on the basis of and for the reasons assigned by the Court...”

Justice Henry duPont Ridgely, Delaware Supreme Court

CA Technologies: Victory at Trial and on Appeal in \$60+ Million Licensing Dispute



Company:	CA Technologies (formerly CA Inc.)
Industry:	Enterprise software
Areas of Law:	Software license, open-source software litigation
Venues:	Delaware Supreme Court, Delaware Chancery Court
Result:	Affirmed a lower court decision that rejected a \$60 million claim against CA and instead awarded \$2 million in fees and costs to our client

At stake in *CA Inc. v. Ingres Corp.* were substantial contractual, financial and customer relationships—both for CA, a \$4.3 billion public company, and Ingres, a software company to which CA spun off its open-source Ingres database in 2005. License and support issues arose when Ingres failed to honor obligations to support CA customers who were using the database. Ingres also claimed that its license with CA did not cover certain instances where its database was embedded in CA products. Ingres sued CA in California before CA's Pillsbury-led litigation team filed suit in Delaware seeking an expedited trial.

Pillsbury maneuvered through a series of motions on both coasts, large-scale e-discovery (an expedited review of a 700,000-document production), source code review, and 23 depositions (most compressed into two weeks), taking the case from complaint to trial in just six months.

By trial, Ingres had upped its initial demand from \$30 million to more than \$60 million. But after hearing Pillsbury's cross-examinations of Ingres' witnesses, including a key witness whom Pillsbury had to cross-examine without deposing beforehand, the Delaware Chancery Court's 123-page opinion gave a definitive victory to CA, awarding nothing to Ingres and instead ordering the plaintiff to pay CA's attorneys' fees and costs on one of the license issues. The Delaware Supreme Court affirmed the decision in full on appeal.

“[Pillsbury] lawyers for Sirius used Spansion’s evidence against it, pointing out that documents in the motion to amend showed that the products were available before the company filed its complaint...”

Law360, October 11, 2010

SiriusXM Radio: Speedily Disposing of a Multimillion-Dollar Infringement Allegation



Company:	SiriusXM Radio
Industry:	Satellite media
Area of Law:	Patent 337 Action
Venue:	U.S. International Trade Commission (ITC)
Result:	Protected the client from potential liability as a downstream user of an allegedly infringing memory chip by getting SiriusXM dismissed before they answered the complaint

Apple, Nokia and RIM were each targeted by flash-memory-component-maker Spansion Inc. in a patent infringement case before the ITC involving Samsung flash memory chips. Spansion claimed that Samsung's infringing chips represented hundreds of millions of dollars in lost revenue. The company's strategy was to pursue redress from not only Samsung, but consumer electronics companies that used Samsung flash memory.

But when Spansion tried to include Sirius in its list of infringing downstream users, Pillsbury identified significant defects in the request for investigation and a later motion to amend. Responding to Pillsbury's early motion, the ITC administrative law judge ruled that Spansion failed to show the good cause necessary to amend its initial complaint. The ruling effectively ended the case against Sirius.

“It was a wise use of resources. And now you can head to the Federal Circuit directly...Well done.”

Magistrate Judge Elizabeth D. Laporte, U.S. District Court

Stanley Black & Decker: Protecting Success



Company:	Stanley Black & Decker (formerly The Stanley Works)
Industry:	Tools and construction equipment
Area of Law:	Patent litigation
Venues:	U.S. District Court for Arizona, U.S. Court of Appeals for the Federal Circuit, Northern District of California
Result:	Pillsbury helmed two significant patent litigation wins for longtime client Stanley Black & Decker

Richardson v. The Stanley Works

As the manufacturer of hundreds of popular products, and the leading brand name in its field, longtime Pillsbury client Stanley Black & Decker sees more patent challenges than most companies. Pillsbury represented the company in district court and appellate victories in *Richardson v. The Stanley Works*.

The appellate review came after Pillsbury successfully defended Stanley at trial against claims that the company's FuBar®—a popular 4-in-1 utility bar for prying, splitting, board-bending and striking jobs—infringed the design patent on the plaintiff's "Stepclaw" multi-function tool. The lower court found that any common features between the tools were purely functional, and thus could not sustain a finding of infringement under a design patent.

The U.S. Court of Appeals for the Federal Circuit affirmed the lower court decision, marking a fundamental shift in how functional aspects of design patents are evaluated in infringement claims. For IP-sensitive companies in a host of industries, Stanley's victory points to the importance of carefully analyzing the functional and ornamental aspects of design patents as part of IP portfolio management.

Zircon Corp. v. The Stanley Works

In a dispute over software algorithms powering competing stud finder products, Stanley rival Zircon sought an injunction and damages for alleged infringement of a Zircon patent. At issue was the method each company's device uses to compute numeric ratios, which the devices process to detect stud beams.

The Pillsbury team quickly identified a critical gap between the Zircon patent and the separate, specific mathematical process Stanley's stud finders employ. The team then filed for summary judgment of non-infringement, asking the court to construe a single, but critical, patent claim term with the aim of (1) negating the infringement claim, (2) avoiding a jury trial, and (3) efficiently sparing Stanley from the burden of further time and unnecessary legal expenses.

The judgment was granted, effectively undercutting Zircon's arguments. Pillsbury's successful strategy amounted to what the court called "a wise use of resources."

“The appeals court said the U.S. International Trade Commission had overstepped its bounds when it issued the ban against handset makers....”

CIO/IDG News Service, October 14, 2008

AT&T Mobility, T-Mobile, RIM: Sparing a Trillion-Dollar Industry from a Single Supplier's Dispute



Companies:	AT&T Mobility, T-Mobile and RIM
Industry:	Telecommunications
Area of Law:	Patent 337 Action
Venue:	U.S. Court of Appeals for the Federal Circuit
Result:	Successfully appealed an ITC decision, establishing a new legal standard for downstream companies caught in patent disputes

At issue in *In re Kyocera Wireless v. International Trade Commission* was a decision by the ITC that Bloomberg News predicted could “cripple the entire mobile-phone industry.” Acting on alleged patent infringement by the microchip manufacturer Qualcomm, the ITC banned not only the import of Qualcomm chips, but also all “downstream products” that incorporated the offending microchips.

The proposed ban would have impacted nearly all new mobile phones with 3G technology, hurting device manufacturers and wireless service providers alike. Indeed, given the importance of the issues and the havoc a ban would have caused, the exclusion order was stayed while the ITC’s decision was appealed to the Federal Circuit.

Pillsbury’s oral arguments on behalf of AT&T Mobility, T-Mobile and RIM noted the fundamental unfairness of the ITC’s decision to these companies, which had not been allowed to participate in any proceedings or present evidence to the ITC about how the ban would affect them. Pillsbury also argued that the ITC had exceeded its authority. The Federal Circuit agreed, effectively setting a new legal standard for downstream companies caught in patent disputes.

“Our Pillsbury attorneys assessed the challenge Fellowes was facing from a Chinese competitor’s patent lawsuit and were confident that we could turn the tables and win in court. And they did exactly that.”

Steve Carson, General Counsel of Fellowes, Inc.

Fellowes, Inc.: Turning the Tables in a High-Stakes Battle



Company:	Fellowes, Inc.
Industry:	Personal paper shredders
Area of Law:	Patent infringement
Venues:	U.S. District Courts for the District of Columbia and Eastern District of Virginia
Result:	Won summary judgment of non-infringement by our client and two patent infringement claims against the competitor, including a jury verdict of validity

Fellowes is the inventor of the personal shredder—and a global market leader in their manufacture. The company was surprised, then, to be sued for infringement by a Taiwanese competitor that was using Fellowes’ technology in its own shredders. The company turned to Pillsbury to defend it from the competitor’s patent claims, and to file its own patent infringement suit against the competitor and its U.S. partner.

Pillsbury won an early summary judgment on behalf of Fellowes in the suit the competitor filed. This decision followed a Markman hearing in U.S. District Court for the District of Columbia, a jurisdiction that rarely hears patent infringement disputes. Though Fellowes’ motion for summary judgment of non-infringement had been denied twice, Pillsbury persuaded the court to vacate and reverse its own prior rulings.

While winning at defense, Fellowes filed a separate patent infringement action in the Eastern District of Virginia, known as the “rocket docket.” There, Pillsbury proved the validity of two key Fellowes patents in a jury trial that found the Taiwanese company guilty of infringement. The competition conceded infringement of one patent and the judge held the other patent was infringed. With this victory, the competitor settled the cases and Fellowes got back to inventing new features for personal shredders.

“With limited time to prepare and in the context of an aggressive adversary, Pillsbury was able to achieve an excellent result for Clearwire at the preliminary injunction phase of the litigation.”

Chuck Lobsenz, Senior Corporate Counsel/Director of Intellectual Property, Clearwire

Clearwire: Free and CLEAR in Trademark Dispute



Company:	Clearwire
Industry:	Wireless broadband
Area of Law:	Trademark infringement
Venue:	U.S. District Court for the Eastern District of Virginia
Result:	Clearwire defeated Sony Ericsson's request for a preliminary injunction



After several months of use and having spent tens of millions of dollars to promote its CLEAR C trademark, Clearwire was sued by Sony Ericsson in the U.S. District Court for the Eastern District of Virginia claiming the logo for the CLEAR broadband product was confusingly similar to Sony Ericsson's own logo. Given that it had been preparing to file a complaint for several months, Sony Ericsson filed the complaint and immediately moved for a preliminary injunction prohibiting Clearwire from using its CLEAR C mark anywhere in America—an injunction that would cost Clearwire over \$8 million to comply with. The Pillsbury team had 11 days to get up to speed on the case and file all of Clearwire's papers.

Though the court recognized that there was some similarity between the marks, it rejected the speculative nature of Sony Ericsson's argument and instead accepted Clearwire's argument that the best proof of whether the marks were confusingly similar was the real-world marketplace. Thus, Clearwire successfully argued that the lack of any real-world confusion was determinative of whether there existed a likelihood of confusion between the two marks. The court also accepted Clearwire's argument that the harm to it in being enjoined was greater than any demonstrable harm to Sony Ericsson by Clearwire's use of its mark.

Based upon the evidence as established by Clearwire, the court denied Sony Ericsson's request in its totality, allowing Clearwire to use its CLEAR C mark on any and all of its products anywhere in America.

“With Pillsbury’s strategic approach to this litigation, we were able to turn the tables, create downside risk for the Plaintiff and swiftly get these baseless accusations dismissed.”

Laurence D. Hurwitz, General Counsel, Environmental Systems Products Holdings Inc.

Environmental Systems Products Holdings Inc.: How to Beat a “Patent Troll”



Company:	Environmental Systems Products Holdings Inc. (ESP)
Industry:	Vehicle emissions testing equipment and service
Area of Law:	Patent litigation
Venue:	U.S. District Court, Northern District of California
Result:	Pillsbury obtained a dismissal with prejudice in a “patent troll” case—before the initial case management conference

Even baseless claims of patent infringement by a patent troll typically take more than a year and hundreds of thousands of dollars or more to dispose of. Pillsbury client Environmental Systems Products Holdings Inc. faced such a suit brought by a “business accelerator” called inBAC that had acquired rights to a patent originally granted to a research arm of the Finnish government, VTT. While the patent being asserted against ESP referenced ESP’s own patents in the background, the company nonetheless faced proceedings that often take a year or more and generate six- or seven-figure expenses.

After verifying that the claim was indeed spurious, Pillsbury focused on pressing inBAC on all fronts, with an eye toward creating leverage to secure a quick dismissal. Pillsbury employed a three-pronged strategy: bringing VTT into the case, raising Rule 11 issues against inBAC’s counsel over the baseless suit and then using inBAC’s own evidence to support a counterclaim against the inBAC CEO.

In the face of this aggressive response to the suit (and no doubt some pressure from the Finnish government), inBAC’s counsel offered to dismiss the claims, with prejudice, provided that ESP drop all counterclaims and other claims (*e.g.*, request for sanctions) that were made or could have been made—all before the initial case management conference.

“We turned to a trusted advisor in Pillsbury for its expertise and quality in helping execute on CSR’s strategy...and they delivered.”

Adam R. Dolinko, Executive Vice President and General Counsel, Cambridge Silicon Radio plc

Cambridge Silicon Radio: Pillsbury Helps Execute New GC's Complex Litigation Strategy



Company:	SiRF Technology, a subsidiary of Cambridge Silicon Radio plc (CSR)
Industry:	GPS semiconductors
Areas of Law:	Patent litigation, patent reexamination
Venue:	U.S. Patent and Trademark Office (USPTO)
Result:	Pillsbury prepared and filed reexaminations, including on patents previously held valid at the ITC, and assisted in patent litigation. These efforts were successful and assisted in positioning the client for settling the overall dispute between CSR and Broadcom.

In 2009, Cambridge, UK-based CSR plc acquired U.S.-based SiRF Technology, a leading global supplier of semiconductor chips that detect GPS satellite signals in smart phones, automobiles and stand-alone navigation devices. At the time of the acquisition, SiRF and its litigation counsel were defending against patent infringement allegations raised by Global Locate, then a subsidiary of Broadcom, both at the U.S. International Trade Commission (ITC) and in federal district court, which had suffered numerous patent litigation losses against Broadcom, which risked a shutdown of the GPS business.

As part of CSR's new General Counsel's strategy to diffuse the results of a prior legal team's efforts, Pillsbury was called on to file Inter Partes Reexamination requests on most of the six Global Locate patents that had been found valid at the ITC.

These Inter Partes Reexamination requests were filed in 2010, along with CSR asserting multiple patents in a variety of jurisdictions, with Pillsbury having assisted on that front as well. All of the Inter Partes Reexamination requests filed by Pillsbury were granted, and the USPTO continued to reject all of the claims that had been previously found valid at the ITC, which along with the other ongoing lawsuits set the stage for a global settlement that was entered into in early 2011.

As a result of CSR's new legal strategy as executed, and the settlement as negotiated by CSR, CSR's enterprise value increased more than 25 percent and its shares climbed 15 percent, or more than \$150,000,000, on the day of the announcement of the global settlement.

“I know that it is rare to have a product recalled from the market. The Pillsbury team did an excellent job in gathering and presenting the facts to secure such a result.”

Francesco Bellifemine, President, Technimed Srl.

Tecnimed: Winning the Recall of a Competitor's Infringing Thermometer



Company:	Tecnimed
Industry:	Medical electronics
Area of Law:	Trademark infringement
Venue:	U.S. District Court for the Southern District of New York
Result:	In a rare outcome for a trademark case, Pillsbury secured a complete recall of a competitor's infringing product

Italian electronics manufacturer Tecnimed distributed its Thermofocus non-contact thermometer in the U.S. through a distribution deal with U.S.-based Kidz-Med. Soon after that arrangement ended in a dispute and settlement, Kidz-Med launched a competing product using what the U.S. District Court for the Southern District of New York would later call “confusingly similar packaging.”

Tecnimed selected Pillsbury to lead an aggressive response to Kidz-Med's infringement. The IP Litigation team identified what amounted to deliberate infringement by Kidz-Med, including copying promotional language and a physician's endorsement of the Tecnimed product, and using “Thermofocus” metatags on the Kidz-Med site.

After oral argument, the Pillsbury team secured not only an injunction on the infringing packaging, but a complete recall of the competitor's product from more than 1,000 retail outlets. In his decision, U.S. District Judge Paul G. Gardephe noted that a recall is an “extreme remedy” but one that was supported by Pillsbury's convincing presentation of the defendant's bad faith, as well as Kidz-Med's inability to pay damages because of insolvency.

Awards, Rankings and Recognition

- First Band in Intellectual Property, *Chambers USA*, 2010
- Top Listed in Intellectual Property, *Best Lawyers/U.S. News & World Report* survey, 2010
- Top 25 in Patent Prosecution, *Managing Intellectual Property*, 2010
- Tier 4 in Patent Prosecution Utility & Design Patents, *Legal 500*, 2010
- #1 Band—Intellectual Property Group—Northern Virginia, *Chambers USA*, 2009
- Top 7 among all AmLaw 100 firms for filing the most patents on behalf of the 300 largest corporate patent holders, *PatentBuddy*, 2009
- #1 Regionally Ranked—IP Law—Northern Virginia, *Best Lawyers in America*, 2009
- #1 First Band Intellectual Property Group—Northern Virginia, *Chambers USA*, 2008
- #26 Top Patent Firms, *Intellectual Property Today*, 2009
- #18 Top Trademark Firms, *Intellectual Property Today*, 2009
- #10 Top Trademark Firms in Washington, DC, *CTCorsearch*, 2008
- #9 Top 200 Trademark Law Firms, *Trademark Insider Annual Report*, 2008
- #11 Top 100 Trademark Firms (based on number of USPTO applications submitted during the fourth quarter of 2008), *Trademark Insider*, 2008
- 2009 *Best Lawyers in America* named two Pillsbury IP partners (one with Special Honors for being ranked 25 years) and ranked Pillsbury #1 in the Northern Virginia region. Only approximately 2.4 percent of practicing U.S. attorneys are selected for this list
- In the 2008 *Corporate Counsel* survey of in-house counsel of the Fortune 500, Pillsbury was designated as a “Go-To Firm” for Intellectual Property
- 2008 *PLC Which Lawyer?* ranked our Los Angeles and San Francisco/Silicon Valley offices as well as one IP: Life Sciences partner as “Recommended”
- 2008 *Chambers USA* ranked our Northern Virginia office’s IP practice and five lawyers, including one “Senior Statesman.” One California partner was ranked for Life Sciences: IP/Patent Litigation
- June 2007 *Guide to the World’s Leading Patent Law Practitioners* named a Pillsbury partner as one of the pre-eminent patent law practitioners
- In 2007, *CTCorsearch* data showed that a Pillsbury IP lawyer filed more trademark applications for clients than any other lawyer in Washington, DC
- 2006 *IP Law & Business’* annual survey of in-house counsel listed Pillsbury among the “Top IP Firms” corporate America calls on for IP help

Representative IP Practice Clients

Accuride International Inc.

Activision Blizzard, Inc.

AOL Inc.

Aquaria, Inc.

Arysta LifeScience Corporation

ASML

AT&T Mobility LLC

Atlas Copco USA

Bank of New York Mellon

Bass Pro Shops

Bell Helicopter

Biogen Idec, Inc.

Bridgestone Corporation

CA Technologies

Camp Scandinavia AB

Capcom Co., Ltd.

Chevron Corporation

Clearwire Corporation

Comarco Wireless Technologies, Inc.

Del Monte Foods

Environmental Systems Products
Holdings Inc.

Evonik Degussa GmbH

Fellowes, Inc.

Fred Meyer, Inc.

IBM

In-N-Out Burger

Intel Corporation

Invenda Corp.

Juicy Couture

Kate Spade LLC

The Kroger Co.

La Jolla Institute for Allergy &
Immunology

Liz Claiborne Inc.

Magna International Inc.

Medtronic, Inc.

MicroStrategy, Inc.

Mitsubishi Heavy Industries, Ltd.

Morgan Stanley

NIKE, Inc.

Novell, Inc.

Open Text Corporation

Philips Electronics

Playdom, Inc.

Pressure Products Medical
Supplies Inc.

Raytheon Company

Saint-Gobain S.A.

SiriusXM Radio

Stanley Black & Decker

Sunrise R&D Holdings, LLC

Suzuye & Suzuye

Time Warner Cable

Toray Industries, Inc.

Toshiba Corporation

UBS AG

University of Kansas

The Walt Disney Company

Warner Bros. Entertainment, Inc.

Xerox Corporation

Pillsbury has handled patent and trademark litigation since 1893. Now, with more than 90 IP practitioners firmwide, Pillsbury advises clients on developing successful and comprehensive IP strategies by protecting, managing, asserting, defending and leveraging their IP assets. The IP team spans a number of offices and countries, with team members in Northern Virginia, San Francisco, Silicon Valley, Los Angeles, Houston, Washington, DC, New York, San Diego, Sacramento, Tokyo and London. Domestically, Pillsbury has advocated for clients in 77 of the 94 U.S. district courts, as well as before the ITC in Section 337 cases, the International Chamber of Commerce and the World Intellectual Property Organization. Pillsbury's IP lawyers have a wide range of advanced scientific and technical degrees in areas including electrical and mechanical engineering, chemistry, biology, physics and a number of other technical disciplines.

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