



Archetype IPSM

IP Litigation Experience

My involvement in these cases spanned the full range of litigation activities including development of legal strategy, risk assessment, close supervision of in-house and outside litigation attorneys, negotiation and drafting of settlement agreements, and lots of hands-on litigation activity – e.g., draft, review, and revise pleadings, motion briefs, discovery requests, motions *in limine*, jury instructions, *voir dire*, trial briefs, appeals and amicus briefs; develop positions and arguments regarding substantive issues such as infringement, non-infringement, validity, invalidity, damages, injunction, equitable estoppel, laches; meet and confer on discovery and case management issues and handle associated motions; take and defend depositions; claim construction strategy, briefing, and hearings; summary judgment strategy, briefing, and hearings; prepare witnesses for trial testimony; identify and develop JMOL and appeal issues.

I was involved in some cases from their inception and in others became involved only later in the proceedings (and occasionally had to “pick up the pieces” of poorly thought-out or poorly executed litigation strategies and decisions). All of these cases provided great experience.

- *Enzo Life Sciences, v. Agilent Technologies* (D-Del): Patent infringement case relating to oligonucleotide “bound” to solid supports.
- *Genetic Technologies Ltd. v. Agilent Technologies* (D-Col): Patent infringement case relating to genetic analysis of non-coding genome regions.
- *Perkin Elmer Health Sciences v. Agilent Technologies* (D-Mass): Patent infringement and breach of contract case relating to mass spectrometry systems and methods.
- *Waters Technologies Corp. v. Aurora SFC Systems & Agilent Technologies* (D-Del): Patent infringement case relating to super-critical fluid chromatography systems.
- *Dako v. Lieca Microsystems* (D-Del): Patent infringement case relating to automated pathology slide staining systems.
- *Unisone Strategic IP v. Life Technologies* (SD-Cal): Patent infringement case relating to inventory management systems and software.
- *Mahavisno v. Compendia Biosciences & Life Technologies* (ED-Mich): Copyright infringement case relating to bioinformatics software.
- *Esoterix Genetic Laboratories (LabCorp) v. Life Technologies, Applied Biosystems LLC, & Ion Torrent* (MD-NC): Patent infringement case relating to detecting clonal subpopulations of transformed cells and multiplexed detection/amplification methods and primers.



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- Ex Parte Reexamination Nos. 90/012,806, 90/012,837 & 90/012,838 (U.S. Patent & Trademark Office): Ex parte reexaminations of asserted patent in this case.
- *Esoterix Genetic Laboratories & The Johns Hopkins University v. Life Technologies, Applied Biosystems LLC, & Ion Torrent* (MD-NC): Patent infringement case relating to methods for determining the ratio of two genetic sequences methods for determining an "allelic imbalance" in a biological sample.
 - Ex Parte Reexamination Nos. 90/012,894, 90/012,895 & 90/012,896 (U.S. Patent & Trademark Office): Ex parte reexaminations of asserted patent in this case.
- *Life Technologies v. Kappos* (ED-Va) & *Life Technologies v. Rea* (ED-Va): Suits against the PTO for recalculation of Patent Term Adjustments.
- *Invitrogen IP Holdings (Life Technologies) v. Promega* (Arbitration): Dispute relating to scope of retained rights to specific technology fields under a license agreement.
- *Life Technologies v. Promega* (SD-Cal): Twin declaratory judgment actions for declaration of non-infringement of multiple patents owned or controlled by Promega.
- *Life Technologies v. Pacific Biosciences* (ND-Cal): Section 146 action for district court review of interference decisions by U.S. Patent & Trademark Office regarding PacBio patent application and Life Technologies patent.
- *Helicos Biosciences v. Illumina, Life Technologies, and Pacific Biosciences* (D-Del): Patent infringement case relating to single molecule nucleic acid sequencing.
- *Promega v. Applied Biosystems, LLC, Life Technologies & Invitrogen IP Holdings* (WD-WI) & Appeal Nos. 2013-1011, -1029, -1376 (US Court of Appeals for the Federal Circuit): Patent infringement case relating to alleged sales of DNA fingerprinting (STR) products outside the scope of a cross-license agreement. Went to jury trial in early 2012; post-trial motions phase extended from March 2012 to April 2013; now on appeal.
- *Promega v. Applied Biosystems, LLC, Life Technologies & California Institute of Technology* (WD-WI/ND-III) & Appeal Nos. 2013-1454, -1484 (US Court of Appeals for the Federal Circuit): Declaratory judgment action regarding invalidity and non-infringement of patent relating to sets of oligonucleotides having multiple types of fluorescent labels. Now on appeal from summary judgment decisions.
- *Invitrogen IP Holdings (Life Technologies) v. Promega* (Arbitration): Contract dispute relating to royalty underpayment under a license agreement.



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- *Life Technologies v. AB Sciex & DH Technologies Development* (Arbitration): Contract dispute relating to use of trademarks and logos by successor company after divestiture of mass spectrometry business.
- *Illumina v. Life Technologies & Ion Torrent* (SD-Cal): Patent infringement case relating to loading of beads onto arrays.
 - Ex Parte Reexamination Nos. 90/012,213 & 90/013,003 (U.S. Patent & Trademark Office): Ex parte reexaminations of asserted patent in this case.
- *Enzo Life Sciences, v. Life Technologies* (D-Del): Patent infringement case relating to labeled oligonucleotides, solid supports with attached oligonucleotides, and Taqman and Dynabead products.
- *Enzo Biochem, Enzo Life Sciences, & Yale Univ. v. Applera & Tropix* (D-Conn): Patent infringement case relating to labeled oligonucleotides and Big Dye Terminator (nucleic acid sequencing) products.
 - Ex Parte Reexamination Nos. 90/012,061, 90/012,203, & 90/012,738 (U.S. Patent & Trademark Office): Consolidated ex parte reexaminations of asserted Enzo/Yale patent.
- *Enzo Biochem v. Amersham, Molecular Probes, et al.* (SDNY): Patent infringement case relating to labeled nucleotides and business torts (e.g., unfair competition) relating to alleged violations of and interference with distribution agreements.
 - Ex Parte Reexamination No. 90/012,361 (U.S. Patent & Trademark Office): Ex parte reexamination of asserted Enzo patent.
- *Cornell Univ. & Life Technologies et al. v. Illumina* (D-Del): Patent infringement case relating to genetic analysis using coupled ligase reactions and PCR (used by DNA array products) and contract issue relating to a covenant not to sue.
- *Celsis In Vitro v. CellzDirect and Invitrogen* (ND-III): Patent infringement case relating to twice-cryopreserved hepatocytes (used for metabolic studies, especially by pharmaceutical companies).
- *Catalyst Assets LLC v. Life Technologies* (ND-Cal): Patent infringement case relating to oligonucleotide libraries.
 - Ex Parte Reexamination No. 90/011,936 (U.S. Patent & Trademark Office): Ex parte reexamination of asserted Catalyst patent.
- Inter Partes Reexamination No. 95/001,643 (U.S. Patent & Trademark Office): Inter partes reexamination of Helicos patent relating to nucleic acid sequencing methods.

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- *Life Technologies v. Dharmacon* (Thermo-Fisher)(Dusseldorf Regional Court, Germany): Patent infringement case relating to siRNA (RNA oligonucleotides).
- Nullity Action v. DE 603 29 277.1-08 (Federal Patent Court, Germany): Nullity action by Fisher Scientific against asserted patent.
- “Protective Briefs” for multiple high-risk potential litigations in Germany (Various German Courts): Briefs filed in various German Courts to provide non-infringement positions and other reasons that any request for preliminary injunction in newly-filed patent infringement cases should be denied. In Germany there are procedures for obtaining preliminary, temporary relief that do not provide sufficient notice to allow a defendant to adequately present its positions to the Court, and these briefs are kept under seal until a case is filed and a preliminary injunction requested.
- Inter Partes Reexamination No. 95/001,765 (U.S. Patent & Trademark Office): Inter partes reexamination of 454 patent relating to nucleic acid amplification methods for next generation sequencing sample preparation.
- Opposition to EP 1 482 036 (EPO): Opposition to Medical Research Council/454/Roche patent relating to nucleic acid amplification methods for next generation sequencing sample preparation.
- *Life Technologies et al. v. Illumina et al.* (SD-Cal): Patent infringement case relating to next-generation sequencing systems (including patent counterclaims brought by Illumina).
- Inter Partes Reexamination Nos. 95/000,527, 95/000,528, 95/000,529, & 95/001,292 (U.S. Patent & Trademark Office): Inter partes reexamination of Illumina patents relating to aspects of next-generation sequencing sample preparation, optical imaging, and variant analysis.
- *KV Pharmaceuticals et al. v. Breckenridge Pharmaceutical* (ED-Missouri): Patent infringement case relating to iron amino acid chelates.
- *Digene v. F. Hoffman-La Roche & Roche Molecular Systems* (Arbitration) & *GenProbe v. Digene* (Cal. Sup. Ct.): Related disputes regarding cross-license rights to supply HPV-related materials to third party diagnostic company.
- *Digene v. Third Wave Technologies* (WD-WI): Patent infringement case relating to HPV nucleic acids and reagent products and antitrust counterclaims.
- *Digene v. Ventana Medical Systems & Beckman Coulter* (D-Del): Patent infringement case relating to HPV nucleic acids, and in-situ hybridization, including a complex license defense.



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- *Altana & Wyeth v. Schwarz Pharma & Kudco Ireland* (D-NJ): ANDA Paragraph IV patent litigation relating to Protonix (pantoprazole).
- *Schwarz Pharma & CIMA Labs v. Par Pharmaceutical* (D-NJ): ANDA Paragraph IV patent litigation relating to Niravam (alprazolam orally-disintegrating tablet).
- *Schwarz Pharma & Warner-Lambert v. Paddock Labs* (D-Minn): ANDA Paragraph IV patent litigation relating to Univasc (moexipril).
- *Schwarz Pharma et al. v. Mylan Labs* (ND-WV): ANDA Paragraph IV patent litigation relating to Verelan PM (verapamil chrono release).
- *Boston Scientific v. Micrus* (ND-Cal): Patent infringement case relating to embolic aneurysm devices and treatments.
- *Genentech v. Trustees of Columbia University* (ND-Cal): Declaratory judgment action for invalidity of patent relating to expression and production of exogenous DNA using mammalian cells.
- *Applera v. Roche Molecular Systems et al.* (Arbitration) & *Applera v. Roche Molecular Systems et al.* (Cal. Sup. Ct): Dispute regarding divisions of rights under polymerase chain reaction patents, trade secrets, and technology under a set of complex intellectual property acquisition and license agreements.
- *Symyx v. Applera* (CPR Arbitration): Dispute regarding joint development & licensing agreement relating to combinatorial chemistry and capillary electrophoresis polymers.
- *Applera v. Illumina* (CPR Arbitration) & *Illumina v. Applera Corporation* (Cal. Sup. Ct.): Dispute regarding marketing and patent license rights under joint development agreement relating to genotyping products and services.
- *Bio-Rad Laboratories v. Applera* (ND-Cal): Patent infringement case relating to capillary electrophoresis.
- *Applera v. Illumina* (ND-Cal): Patent infringement case relating to oligonucleotide ligation assays and genotyping.
- *Smith & Nephew v. ArthroCare* (WD-Tenn): Patent infringement case relating to minimally invasive intervertebral disc electrosurgery.
- *RITA Medical v. Radio Therapeutics* (ND-Cal): Patent case relating to electrosurgical tumor ablation.
- *ArthroCare v. Ethicon, et al.* (ND-Cal): Patent infringement case relating to electrosurgical minimally invasive arthroscopic surgery.