

# New Jersey Law Journal

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## LEGAL & LITIGATION DEPARTMENTS OF THE YEAR



SITTING, L TO R: Matthew Sklar and Jonathan Short. Standing, L to R: Kelly Garrone, Scott Christie, Steven Halpern, John "Jack" Flaherty, Olga Ugolev, Mark Anania, Michael Friscia, Irene Hurtado, Mark Nikolsky, and Ravin Patel.

## McCARTER & ENGLISH

WINNER, INTELLECTUAL  
PROPERTY

## DEPTH AND BREADTH OF RESOURCES

BY DAVID GIALANELLA

In McCarter & English's renewed efforts to pool resources as rain-makers, the intellectual property group—including its litigation attorneys—have made more progress than some other groups.

“We do much more of a team approach when it comes to business development,” said Scott Christie, a partner in the Newark-based firm’s intellectual property and information technology practice, crediting the group’s “leveraging [of] a client’s patent portfolio” and a “deep bench of technologists who pretty much cover all the scientific disciplines.”

Business development is vital, of course, but so is successfully handling matters—which McCarter’s IP litigation group was able to do last year.

In *Hayward Industries Inc. v. Pentair Water Pool and Spa Inc.*, for instance, McCarter’s IP team represented Hayward Industries Inc., which sought to use pool pump technology for which the defendant had asserted patent protection. In the March 2015 decision, the Patent Trial and Appeal Board upheld an examiner’s finding that the patent was invalid based on obviousness. The firm pegged the case’s value at \$7 million.

In another re-examination case—on behalf of a client the firm asked not to be named—the IP group put to rest a five-year-old case, valued at \$15 million, in a dispute over a pharmaceutical product. Because the patents at issue had been amended, the McCarter attorneys sought re-examination of the patents from the U.S. Patent & Trademark Office and had them invalidated—which the court found was grounds to dismiss the action. The matter was not appealed, according to McCarter.

Both cases involved patent re-examination requests before the U.S. Patent & Trademark Office. Christie noted the recent prevalence of such cases, because changes to patent law have dictated that amendments to patents could abbreviate the damages period, and other entities could exercise “intervening rights” to the technology.

“We’re doing more with attacking patents,” Christie said.

“We have a number of these cases we’re handling, and a number are ongoing,” he added, noting that appeals typically ensue, so the group’s lawyers are spending a good amount of time before the U.S. Court of Appeals for the Federal Circuit.

“We have significantly expanded our reach and our expertise in these types of cases,” he said.

Last year, the group also represented Verisk Inc. and two subsidiaries, Insurance Services Office Inc. and Xactware Solutions Inc., in defending their trademarks.

The group litigates matters from both the plaintiff and defense side, and coordinates well with the patent prosecution team, and with technical experts within the firm, according to Christie and fellow IP group partner Jonathan Short. In addition to handling matters in court and before the PTO, McCarter & English’s IP group also goes before the U.S. International Trade Commission in proceedings to determine whether a foreign product may be barred from importation on intellectual property grounds.

In one recent case before the commission, Short said, “we were able to utilize folks from Delaware; we were able to utilize folks from Boston,” including attorneys with science and accounting backgrounds. “We were able to bring a bunch of people together to make our case.”

In addition to disputes in which McCarter is lead counsel, the IP group also routinely serves as local counsel in the District of New Jersey, given its experience in the district, in connection with abbreviated new drug applications filed by generic drug makers, according to the firm.

The group also has a number of significant matters that have yet to be resolved, including representation of Feit Electric Co. Inc., an LED light manufacturer, in a case involving the defense of false advertising claims by a competitor; defense of 1,500 patent claims on footwear technology in a case representing ASICS America Corp.; and patent defense against Limestone Memory Systems in connection with flash memory products.

Christie said the IP group has “reached a critical mass.”

“We can convince clients that we can handle any IP matter that comes in the door,” he said.

According to Short, some clients come to McCarter for IP counsel, while others are referred by other practice areas in the firm.

“They can come to our firm either for IP, or for something else,” Short said. “In-house counsel tend to talk.” ■