

# Intellectual Property Litigation

The nationally recognized attorneys in Skadden's Intellectual Property Litigation Group successfully represent clients in all stages of disputes and provide strategic business advice concerning all manner of intellectual property issues, including trade secrets, trademarks and trade dress, patents, license agreements and disputes, copyrights and misappropriation, and advertising and consumer claims. Whether it is winning high-profile multimillion-dollar jury verdicts, obtaining swift dismissals at the pleading stage, or providing practical advice about reducing legal risk in everyday operations, we emphasize a holistic, business-driven approach that considers our clients' needs both inside and outside the courtroom.

## Overview

As legislatures and courts around the world adapt to a constant stream of emerging technologies, and businesses of all kinds face unprecedented challenges posed by global events such as the COVID-19 pandemic, Skadden's IP Litigation Group draws on its deep knowledge and experience to empower clients with a complete understanding of the legal issues presented by potential IP disputes and deals.

Hallmarks of our practice include:

- **Experience Across Industries:** We routinely handle matters in a variety of fields such as consumer products and services, biotech, pharmaceuticals, sports, media and entertainment, gaming and gambling, communications, computer technology, video games, esports, food and beverage, consumer products, financial services, ecommerce, social media, semiconductors, medical devices and life sciences.
- **Creative and Cost-Effective Solutions:** Favorable jury verdicts and judicial opinions are not the only measures of success. We work with clients to find practical and business-centered resolutions to disputes, as well as provide strategic advice to anticipate and preempt disputes before they occur. When our clients are faced with litigation, we regularly dispose of matters quickly and efficiently. For example, in the past decade, our team has secured the dismissal of more than a dozen IP matters prior to any discovery being conducted.
- **Multidisciplinary Approach:** To ensure the best and most forward-looking outcomes, we work with clients to tailor our approach to each matter, and we seek the insights of our colleagues from a wide range of practices as needed, such as anti-trust, regulatory compliance, tax and corporate.
- **Global Reach and Resources:** Our ability to leverage Skadden's vast network and operations around the world ensures that we have the capacity to handle the largest, most complicated and highest-profile matters.
- **Thought Leadership:** We stay on the cutting edge of IP and related issues and keep our clients informed through client alerts, articles, presentations and seminars, and an exclusive monthly CLE-credit webinar that summarizes the biggest legal developments across all areas of IP law, and provides practical advice to in-house counsel for managing and protecting their IP. Since March 2020, for example, we have regularly presented and advised clients on a variety of issues arising out of the COVID-19 pandemic, ensuring that we are well-positioned to address the many novel challenges and potential disputes that businesses now face.

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## Recognition

We repeatedly have been recognized for our intellectual property litigation capabilities:

- Ranked as a nationwide Tier 1 firm for intellectual property litigation by *U.S. News — Best Lawyers Best Law Firms* and named to *The National Law Journal's* Intellectual Property Hot List for multiple years.
- Named *New York Law Journal's* 2021 Litigation Department of the Year. We were also named a finalist in the general litigation category of the *New York Law Journal's* 2023 and 2022 Litigation Department of the Year competitions and in *The American Lawyer's* 2021 Litigation Department of the Year competition.
- Recognized as a leading firm by *World IP Review* in the Contentious category for trademark work.
- By BTI Consulting Group:
  - Named as a member of BTI Consulting Group's Fearsome Foursome 2023 — the four elite law firm litigation practices that general counsel would “least want to face across the table in litigation.”
  - Among the top firms for delivering the best client service in BTI's 2021 A-Team report.
- Named a leading firm in the trademark field by *World Trademark Review*.

## Experience

### Recent Highlights

Some of our recent accomplishments on behalf of clients include:

- Successfully defeating a preliminary injunction motion brought against Sadler's Brewhouse Limited and Halewood Wines & Spirits by television producer Caryn Mandabach Productions Limited, asserting claims of trademark infringement, false advertising and unfair competition.
- Securing dismissal of a putative class action against Matthew Bender & Company asserting consumer deception, fraud and breach of warranty concerning the company's *Tanbook* publication, and obtaining affirmance of that dismissal on appeal, including victories on the merits in both the Appellate Division and the New York Court of Appeals.
- Successfully defending Fortinet Inc. against multiple Section 101 motions seeking to invalidate five unrelated patents.
- Securing a \$500 million jury verdict — the sixth-largest ever awarded for copyright, trademark and/or trade secret claims and the 12th-largest intellectual property verdict overall — on behalf

of ZeniMax Media Inc. and its subsidiary Id Software against Oculus VR Inc. and Facebook concerning the theft of proprietary information to develop the Rift virtual reality headset.

- Successfully bringing and resolving both a federal litigation and parallel international arbitration proceeding on behalf of the Ladies Professional Golf Association concerning a licensing dispute with its South Korean broadcasting partner.
- Securing a favorable *Markman* ruling in an International Trade Commission (ITC) action for a major roofing retailer, resulting in withdrawal of the ITC complaint.
- Securing a complete dismissal of Lanham Act and right of publicity claims brought against the PGA Tour on behalf of a putative class of Tour caddies.

### Trademarks and Trade Dress

We routinely are engaged by clients to provide counsel in connection with brands and source identifiers, including word marks, design marks and trade dress protection for product design and packaging. Our attorneys have extensive experience not only in connection with infringement and related litigation, but also day-to-day trademark enforcement matters, opposition and cancellation proceedings in the Trademark Trial and Appeal Board, consumer survey research, counterfeiting, and domain name and other internet-related disputes. Among several other industry representations, our team has secured numerous successful enforcement results for a variety of sports industry clients. We've also done extensive work on appellate matters and on behalf of the International Trademark Association. Recent representations have included:

- Metacapital Management, L.P. in a federal lawsuit filed against Facebook arising out of Facebook's purported acquisition and adoption of “Meta” trademarks in connection with financial services.
- A worldwide cryptocurrency payment infrastructure company in connection with enforcing and defending the company's U.S. trademark rights against competitors in the blockchain, charge card and other financial services industries.
- The National Hockey League in obtaining permanent injunctive and monetary relief in a federal litigation against an infringer of the league's trademark and trade dress rights for the Stanley Cup trophy.
- Telegram Messenger, Inc. in obtaining a preliminary injunction against use of the company's trademark by another party in connection with proposed cryptocurrency and securing affirmance of that injunction on appeal.

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- Pinduoduo Inc. and its affiliates in securing the dismissal, on jurisdictional grounds, of claims for contributory trademark infringement and unfair competition based on alleged unauthorized sales of products on its Chinese e-commerce platform. Skadden also won an award of nearly \$400,000 in attorneys' fees and costs and enforced that award through restraining notices.
- Halewood Artisanal Spirits in securing the denial of a preliminary injunction in a case involving Lanham Act and related California state law claims.
- Peet's Coffee, Inc. in providing strategic trademark advice and representing the company in a pending federal litigation against Nespresso USA, Inc. concerning alleged trade dress protection in the product design of single-serve espresso capsules and use of trademarks in connection with compatibility statements.
- Aspen MLT and Mythos Studios in favorably disposing of oppositions in the Trademark Trial and Appeal Board to trademark applications for comic book-related properties.
- O'Reilly Automotive Stores, Inc. in favorably resolving a trademark infringement dispute involving automotive parts in both federal court and the Trademark Trial and Appeal Board.
- The National Football League in numerous trademark and trade dress enforcement matters, including concerning the use of NFL Club names and color combinations on websites and social media, and the sale of counterfeit apparel by retailers.
- Citigroup Inc. in numerous federal lawsuits and opposition proceedings concerning protection and enforcement of the "Citi" family of marks.
- A major online coupon aggregator in providing strategic advice and risk analysis concerning trademark use and user terms of service.
- The PGA Tour in securing a complete dismissal of Lanham Act and right of publicity claims brought on behalf of a putative class of Tour caddies.
- The International Trademark Association in numerous amicus briefs to the U.S. Supreme Court and U.S. Circuit Courts of Appeals, including regarding topics such as:
  - the appropriate standard for establishing trademark tacking (*Hana Financial v. Hana Bank*);
  - the availability of attorneys' fees awards in certain Patent and Trademark Office proceedings (*Shammas v. Focarino* and *NantKwest v. Matal*); and
  - the (un)constitutionality of the bar against federal registration of "disparaging" trademarks (*Lee v. Tam*).

## Trade Secrets

With increasing employee mobility and the proliferation of available methods for viewing, sharing and storing data, trade secret disputes are on the rise. We combine our technical know-how and broad experience to assist clients in protecting their trade secrets and defending against misappropriation claims. Recent representations have included:

- Aspen Technology in securing a favorable verdict, including substantial actual and punitive damages for trade secret misappropriation and copyright infringement, following a three-week jury trial against M3 Technology.
- International Flavors and Fragrances Inc. in defeating a motion for a preliminary injunction and favorably settling claims for trade secret misappropriation and breach of contract related to a spray-drying technology.
- Rocket Software in defeating a motion for a preliminary injunction and favorably settling trade secret misappropriation and copyright infringement claims brought by a leading global software development firm.
- Universal Alloy Corporation in defense of trade secret misappropriation claims in the Northern District of Georgia concerning high-strength aluminum alloy aircraft components.
- Valeant Pharmaceuticals International in an arbitration with Anacor Pharmaceuticals concerning trade secret and contract claims related to a treatment for onychomycosis.
- Ottawa Heart Institute in connection with federal claims of trade secret misappropriation and breach of contract arising out of a failed collaboration on technology for powering implantable devices.
- Walmart, Inc. against a multibillion-dollar claim by Zest Labs, Inc. for breach of contract and misappropriation of trade secrets relating to technology for forecasting produce spoilage and reducing fresh food waste.

## Patents

Skadden's IP attorneys possess both the legal experience and technical training critical to developing creative, forceful strategies for companies embroiled in patent disputes. Many of our patent attorneys practice before the U.S. Patent & Trademark Office and hold technical or scientific degrees in areas such as electrical engineering, computer science, biology, chemistry and physics. Recent representations have included:

- Alkar-RapidPak, Inc. in multiple patent matters, including recently securing summary dismissal of patent notification and unfair competition claims in Wisconsin state court.

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- CERT Coal Holdings LLC and related entities in a District of Delaware patent infringement suit relating to reduced emissions coal refining processes.
  - Fortinet, Inc. in successfully moving to dismiss a patent infringement lawsuit brought by Realtime Data, LLC on the grounds that the asserted patents were directed to patent-ineligible subject matter.
  - GAF Materials LLC in multiple patent matters, including an investigation before the International Trade Commission regarding synthetic roofing underlayment products that was terminated in GAF's favor, a related patent infringement action in the District of New Jersey and a petition for *inter partes* review before the Patent Trial and Appeal Board.
  - Goldman Sachs, J.P. Morgan Chase and Morgan Stanley in securing a venue transfer, summary judgment and affirmance of summary judgment on appeal in a patent infringement case concerning data compression and decompression technology.
  - Johnson Matthey in multiple patent disputes relating to industrial chemicals, cancer treatment materials, active pharmaceutical ingredients and finished drug products.
  - Endurance Specialty Holdings, Ltd. in securing the dismissal of a federal patent infringement lawsuit brought by SnowCast Solutions LLC alleging infringement of two of its patents and claims for deceptive trade practices.
  - Endo Health Solutions in a range of pharmaceutical litigation matters, including a patent infringement suit pursuant to the Hatch-Waxman Act and infringement allegations brought by a non-practicing entity.
  - J.P. Morgan Chase in multiple litigations, including securing summary judgment dismissal of a patent infringement action brought by Pi-Net International, and securing affirmance of that decision at the Federal Circuit.
  - Mount Sinai School of Medicine in securing a global settlement of patent litigation against Shire Pharmaceuticals concerning patent rights for a biologic treatment for Fabry's disease.
  - Viewpointe Archive Services in obtaining a complete victory after a jury trial in patent litigation brought by DataTreasury Corporation involving remote capture, transmission and storage of check images.
  - Hexcel in a patent infringement suit in the District of Delaware concerning composite fiber material used in the manufacture of power generation windmill blades.
  - CookTek Induction Systems, LLC in a patent infringement litigation against Panda Restaurant Group, Panda Express and I/O Controls Corp involving induction technology in the food services industry.
  - Juno USA, LP in defense of patent infringement claims concerning its ride sharing technology.
  - FHE USA LLC as national trial counsel in a multidistrict patent enforcement campaign against competitors in the oil well pressure control equipment market.
  - Inside Secure Corp. in defense of patent infringement claims by Pace Anti-Piracy, Inc. concerning its anti-piracy and security software.

## License Agreements and Disputes

We regularly counsel clients in resolving disputes specifically arising out of patent, copyright and trademark licenses; settlements; distribution agreements; development agreements; sponsorship/endorsement agreements; broadcasting agreements; non-disclosure agreements; and other technology-related documents. Adjudicated in federal and state courts, as well as in arbitrations, these disputes can require a deep understanding of the underlying technical subject matter and nature of the businesses at hand. Recent representations have included:

- Cellectar Biosciences, Inc. in strategizing and filing a federal lawsuit seeking relief for misappropriation of the company's biopharmaceutical intellectual property and putative assignment of that intellectual property by former Cellectar personnel.
- JPMorgan Chase & Co. in securing a \$69 million judgment against DataTreasury for breach of contract involving a "most favored licensee" refund for a check-processing patent, and affirmance of that judgment on appeal.
- Fresh Del Monte Produce, Inc. in securing a favorable jury verdict and substantial monetary damages against Del Monte Corporation concerning the scope of Fresh Del Monte's contractual rights to use the DEL MONTE trademark on fruit, vegetable, and produce products.
- The Ladies Professional Golf Association in commencing and successfully resolving a federal litigation and parallel international arbitration proceeding concerning a licensing dispute with its South Korean broadcasting partner.
- The Pan American Health Organization — a regional office for the World Health Organization — in securing a favorable settlement of an arbitration brought against Uniting for Health Innovation asserting breach of an affiliation agreement between the parties.
- Professional golfer Rory McIlroy in successfully defending against a federal lawsuit by Oakley, Inc. alleging breach of a product endorsement agreement.

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- Mount Sinai School of Medicine in securing the successful resolution of a state breach of contract action relating to the alleged unauthorized use and sale of influenza vaccines.
  - INSIDE Secure in securing the dismissal of a breach of contract claim stemming from a license for anti-piracy and security software brought by Pace Anti-Piracy, Inc. in both state and federal court.
  - Fresh Del Monte Produce, Inc. in successfully defending an arbitration brought by Del Monte Corporation concerning Fresh Del Monte's use of its exclusive licensed rights to use the DEL MONTE trademark in connection with retail operations in the Middle East.
  - Inmoji Inc. in arbitrations concerning performance under the company's licensing contracts.
  - A bet-the-company arbitration concerning IP licensing for food services equipment, which resulted in a complete victory for the client.
  - Array Biopharma, Inc. in a New York state court action asserting that AstraZeneca breached a licensing agreement and underpaid Array in connection with AstraZeneca's sublicensing of intellectual property rights in compounds for treatment of neurofibromatosis.

## Copyrights and Misappropriation

Copyright law is changing rapidly and dramatically, particularly in connection with the use of works on the internet and in emerging technologies like artificial intelligence. We stay on top of new developments in the field and apply that knowledge not only to all phases of copyright disputes and litigations, but also when advising and representing our clients in connection with the creation, acquisition, enforcement and licensing of copyrighted materials. Recent representations have included:

- ZeniMax Media Inc. and its subsidiary Id Software in securing a \$500 million jury verdict against Oculus VR Inc. and Facebook following a three-week trial. The case involved claims of copyright infringement, trademark infringement, trade secret misappropriation and theft of proprietary information (hardware and source code) by Oculus in order to develop its Rift virtual reality headset.
- Dell Inc. and EMC Corporation in a copyright infringement and breach of software license case in the District of Massachusetts.
- Youku Tudou Inc. in securing the dismissal on jurisdictional grounds, and affirmance of that dismissal on appeal, of copyright infringement claims based on works uploaded to Youku's server.
- The National Football League in numerous copyright enforcement matters, as well as in resolving a federal litigation brought by

professional photographers alleging copyright infringement and antitrust violations.

- Major League Soccer, the National Hockey League, and other professional sports organizations and teams in a variety of copyright and trademark enforcement matters.
- Extreme Networks, Inc. in defending against a federal lawsuit concerning alleged source code infringement.
- Several video game developers in connection with strategic advice concerning foreign and domestic copyright and trademark issues.
- MGA Entertainment in victories in federal district and appeals courts defending against copyright infringement and related claims involving the company's "Bratz" dolls.
- The National Football League, the PGA Tour and the Office of the Commissioner of Baseball as *amici* in copyright infringement cases in multiple Circuit Courts of Appeals concerning the unauthorized retransmission of copyrighted content over the Internet in violation of the public performance right under the Copyright Act.
- Marina B in connection with motions to the U.S. Copyright Office for registration of jewelry designs.
- Houghton Mifflin Harcourt Publishing Company and RR Donnelley & Sons Co. in the dismissals of numerous copyright infringement claims.
- The Walt Disney Company in providing copyright analysis and advice in connection with the \$4 billion acquisition of LucasFilm, Ltd.

## Advertising and Consumer Claims

The IP Litigation Group regularly counsels clients regarding truth-in-advertising and claim-substantiation matters, both in the context of disputes and when companies are preparing their own marketing campaigns, including for nationally known businesses offering consumer products and services. We have considerable experience prosecuting and defending false/misleading advertising claims brought under Section 43(a) of the Lanham Act and related state laws; defending against Federal Trade Commission, Food and Drug Administration and other regulatory investigations; arguing matters before the National Advertising Division; defending consumer class actions regarding allegations of deceptive marketing and practices; and working in the field of consumer and marketing research. Recent representations have included:

- Intuitive Surgical, Inc. in devising counterclaims and pursuing relief in multiple federal lawsuits in connection with false advertising and unfair competition claims by companies that market so-called "repair" services for the company's robotic surgical instruments.
- MCS Advantage, Inc. and MCS Healthcare Holdings LLC in litigating claims and counterclaims arising out of a competitor's advertising regarding eligibility for new supplemental benefits available through Medicare.

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- Red Bull North America, Inc. and its corporate parent in defending and favorably settling multiple putative nationwide consumer class actions alleging consumer deception about the effectiveness of the company's beverages.
  - Matthew Bender & Company in securing dismissal of a putative consumer class action asserting consumer deception, fraud and breach of warranty concerning the company's "Tanbook" publication, and obtaining unanimous affirmance of that dismissal on appeal, including a victory on the merits in the New York Court of Appeals.
  - A major international pharmaceuticals company in providing legal and strategic advice concerning competitors' marketing and promotional claims for pharmaceutical products.
  - Fresh Del Monte Produce, Inc. in obtaining a multimillion-dollar jury verdict and injunctive relief in connection with willful false advertising of processed fruit products by Del Monte Corporation.
  - Estee Lauder Inc. and related entities in multiple consumer class action lawsuits involving advertising for skincare and cosmetic products.
  - Anheuser-Busch, Inc. in several National Advertising Division investigations involving MillerCoors.
  - Sirius XM in successfully defending state and federal putative consumer class actions pertaining to the company's auto-renewal policy.
  - A medical device manufacturer in pre-litigation counseling concerning allegations of false advertising.
  - A major insurance company in an arbitration against another major insurance company concerning claims and counterclaims for false advertising, unfair competition, and violation of rights of publicity.
  - Too Faced Cosmetics, LLC in National Advertising Division/ National Advertising Review Board proceedings against Benefit Cosmetics concerning advertising for mascara products.
  - Clinique Laboratories, LLC in securing dismissal of a consumer class action lawsuit challenging advertising claims for Repairwear collection anti-aging products and obtaining affirmance of that dismissal on appeal.
  - Jackson Hewitt Tax Service as plaintiff in a false advertising lawsuit against H&R Block that was favorably settled on the eve of trial.
  - Pfizer, Inc. in National Advertising Division challenges to promotional claims made by Bayer Corp. for nutritional supplements.
  - The International Trademark Association in an *amicus* brief to the U.S. Supreme Court regarding the appropriate standard for establishing standing to assert Lanham Act false advertising claims (*Lexmark International v. Static Control Components*).

## Thought Leadership

Skadden IP litigation attorneys are at the forefront of emerging trends and developments in IP law, as well as the intersection of IP and technology. We routinely present at industry and client-focused seminars; lecture at law schools; and author articles, client mailers and publications in the field of intellectual property. This includes the "Appeals" chapter in the recently published American Bar Association "Copyright Litigation Strategies" treatise and our periodic client mailer that focuses exclusively on legal issues of particular importance to the video game industry.

As leaders in the legal field, attorneys in our department have participated in and chaired numerous committees and professional organizations, including the PLI Patent Law Institute, the International Trademark Association, the American Intellectual Property Law Association, the New York Intellectual Property Law Association, and the New York City Bar Copyright and Literary Property Committee.

We also offer our clients interactive opportunities to keep up with the changes in intellectual property law, as well as specific issues that are of the most practical importance to their businesses. For example, we frequently work with clients to develop and present CLE programs that are specially tailored to address their business needs, and regularly issue mailers and other publications concerning hot topics, such as our monthly mailing "This Month in Intellectual Property," which focuses on new IP developments and key decisions, as well as our quarterly "Video Gaming/E-Gaming Law Update" newsletter on IP developments in the video game space. We also present a unique, CLE-credit half-hour webinar every month that tracks significant developments in intellectual property law, with a recent emphasis on legal actions and issues arising out of the COVID-19 pandemic.