

Douglas R. Nemec

Skadden

Partner, New York

Intellectual Property Litigation



T: 212.735.2419
douglas.nemec@skadden.com

Education

J.D., University of Minnesota
Law School, 1996

B.S.E., Bioengineering,
University of Pennsylvania, 1993

Bar Admissions

New York

U.S. Supreme Court

U.S. Patent and Trademark Office

U.S. Courts of Appeals for the Second,
Third and Federal Circuits

U.S. District Courts for the Eastern
District of Michigan, Eastern District
of Wisconsin, and Southern and
Eastern Districts of New York

Associations

Board of Directors, New York
Intellectual Property Law Association

Board of Directors, Volunteer Lawyers
for the Arts

Douglas R. Nemec is head of Skadden's Intellectual Property Litigation Group, concentrating his practice on litigating complex cases involving intellectual property and technology. He approaches every case with the philosophy that good advocacy transcends geography, technology space and substantive area of the law. In the diverse range of matters Mr. Nemec has led in state and federal courts from coast to coast, he has obtained positive results for clients in matters ranging from patent infringement to trade secrets to high-stakes licensing disputes. The technologies involved have been equally wide-ranging. With a background in bioengineering, Mr. Nemec has a particular fondness for life sciences matters, but has equal aptitude helping judges and juries to understand technological matters involving computers, electronics, industrial chemicals and mechanical structures.

Working alongside Skadden's corporate practice, Mr. Nemec has significant experience beyond litigation, including advising on mergers and acquisitions, licensing, and general IP counseling. As a registered patent attorney, he also represents clients in matters before the U.S. Patent and Trademark Office, which has become an important complement to the firm's IP litigation practice. Additionally, in life sciences matters, Mr. Nemec has advised on defense of patent infringement claims, enforcement of patent and other IP rights, and *inter partes* reviews related to the treatment of a variety of ailments and diseases.

The Skadden IP Litigation Group that has been named a Powerhouse in *BTI Litigation Outlook*; a leading firm in the trademark field by *World Trademark Review*; 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. Mr. Nemec also has repeatedly been named to *Chambers USA* and *The Best Lawyers in America*, in addition to previously being named to *Intellectual Asset Management's* IAM Patent 1000 and as a BTI Client Service All-Star by BTI Consulting Group. He also has been recognized as an IP Star by *Managing IP* and a leader in the field by *LMG Life Sciences*.

Selected engagements in which Mr. Nemec has served a lead role include:

- representing JP Morgan Chase as lead counsel in multiple patent infringement matters, including securing findings of non-infringement and patent invalidity at the trial and appellate court levels in Delaware, California and the Federal Circuit;
- pursuing claims for breach of contract and breach of fiduciary duties on behalf of Cellectar Biosciences, Inc. in Wisconsin federal court, relating to the wrongful assignment of cancer drug delivery mechanisms;
- defending Dell in a software copyright, Lanham Act and breach of contract action in Massachusetts federal court brought by a former software and services provider;
- securing a complete defense verdict in Wisconsin state court on behalf of a subsidiary of food services technology company Middleby in a case alleging unfair competition and violation of state patent notification laws;
- defending Caterpillar against patent infringement claims asserted by an after-market parts supplier and pursuing counterclaims, including copyright infringement, false advertising and unfair competition, in the same matter in Chicago federal court;
- asserting claims of patent infringement on behalf of network security company Fortinet and defending reciprocal counterclaims of patent infringement and tortious interference in San Francisco federal court; and
- defending a group of refined coal technology companies in Delaware federal court against claims of patent infringement concerning mercury emission reduction techniques.

Selected Publications

Co-Author, “In *Arthrex*, Supreme Court To Review Constitutionality of Patent Board’s Structure,” *Skadden, Arps, Slate, Meagher & Flom LLP*, December 22, 2020

Co-Author, “Supreme Court: Parties Cannot Appeal PTAB Decision To Institute *Inter Partes* Review of Allegedly Time-Barred Claims,” *Skadden, Arps, Slate, Meagher & Flom LLP*, April 21, 2020

Co-Author, “Rethinking Patent Assignment Agreements: A Look At ‘*Lone Star v. United Microelectronics*,’” *The Recorder*, July 2, 2019

Co-Author, “Trade Secrets Take Center Stage, and Contracts Play a Lead Role,” *Skadden’s 2019 Insights*, January 17, 2019

Co-Author, “Supreme Court Rulings Signal Significant Changes to Post-Issuance Patent Reviews,” *Skadden, Arps, Slate, Meagher & Flom LLP*, April 30, 2018

Co-Author, “Protecting Trade Secrets Disclosed To The FDA,” *Law360*, February 13, 2018

Co-Author, “The Rise of Trade Secret Litigation in the Digital Age,” *Skadden’s 2018 Insights*, January 23, 2018

Co-Author, “Supreme Court Limits Venue in Patent Litigation,” *Skadden, Arps, Slate, Meagher & Flom LLP*, May 24, 2017

Co-Author, “Strategies for Litigants in Patent Infringement Cases Using Motions to Dismiss Post-Alice,” *Skadden, Arps, Slate, Meagher & Flom LLP*, April 19, 2017

Co-Author, “In *SCA Hygiene*, Supreme Court Rules Laches Not a Defense to Damages Within Statutory Period in Patent Cases,” *Skadden, Arps, Slate, Meagher & Flom LLP*, March 21, 2017

Co-Author, “US Supreme Court Holds That Exporting One Component of Invention Abroad Does Not Suffice for Patent Infringement,” *Skadden, Arps, Slate, Meagher & Flom LLP*, February 23, 2017

Author, “Supreme Court, in *Halo*, Balances the Value of Patents and Innovation,” *Forbes*, June 27, 2016

Co-Author, “New US Patent Challenge Procedures Promote Global Harmonisation, But Casualties Run High,” *Corporate Disputes Magazine*, April-June 2016

Co-Author, “Examining the Boundaries of API Supplier Liability in ANDA Cases in Light of Recent Federal Circuit Decisions,” *Bloomberg BNA Pharmaceutical Law & Industry Report*, March 18, 2016

Author, “Patent Review Decision Brings Some Certainty To A Fast-Changing World,” *Forbes*, February 11, 2015

Co-Author, “Functional Patent Claims May Face More Vigorous Review,” *The National Law Journal*, February 9, 2015

Presentations (2016-Present)

Co-Chair, PLI Patent Law Institute 2006-2021, New York and San Francisco

Speaker, Nevada State Bar Association Annual Meeting, Keynote Speaker on Ethics, 2016-2021, Las Vegas

Panelist, “The Supreme Court’s Decision in *Oil States*,” 35th Annual Joint Patent Practice Seminar, May 2, 2019, New York

Panelist, “Trade Secrets Protection, Enforcement & Litigation,” Sandpiper Partners, February 26, 2019, New York

Co-Presenter, “When Employee and Collaborative Business Relationships Dissolve,” IP Law and Management Institute, November 5, 2018, Pasadena, California

Co-Presenter, “Think Tank Session: IP Litigation — Best Practices for IP Counsel,” International Performance Management Institute, IP Law and Management Institute, November 5, 2017, Austin, Texas

Co-Presenter, “There Are Two Sides to Every Story: Thematic Considerations of Proving and Defending Trade Secrets Claims,” Managing Intellectual Property Trade Secrets Forum 2017, September 26, 2017, Palo Alto, California

Moderator, PTAB Trials: Tips and Strategies, New York Intellectual Property Law Association, June 8, 2016