



## Intellectual Property Counseling and Prosecution

WilmerHale provides comprehensive solutions to the intellectual property and business challenges companies face at all stages of growth involving the acquisition, enforcement or protection of intellectual property. We offer full-service IP coverage across industries, from electronics, semiconductors and consumer goods, to pharmaceuticals, biotechnology, chemical engineering, medical devices, media and publishing. Our lawyers understand how intellectual property relates to a client's business and utilize that knowledge to help our clients realize the value of their intellectual property.

### PRACTICE AT A GLANCE

- WilmerHale's IP practice counsels clients on patent drafting and prosecution, post-grant proceedings including *inter partes* review, trademark, copyright and trade secret protection, as well as strategic IP portfolio development.
- We help clients with IP challenges around the globe. Our lawyers include IP litigators and international trade lawyers with global experience in navigating complex international IP issues.
- WilmerHale is among the top three full-service law firms for Patent Trial and Appeal Board (PTAB) work according to a *Law360* report published in 2021.
- With interdisciplinary experience in technology transfer and licensing, litigation, patent prosecution, and due diligence, WilmerHale is uniquely positioned to counsel clients on business and legal IP strategies, analyzing the value of existing IP portfolios and tailoring them to match the client's needs.
- Our experience and expertise sets WilmerHale apart from other firms' core IP offerings because we are able to advocate for clients not only before the USPTO and courts, but also in the administrative realm, on Capitol Hill, through IP associations and in international forums.

2,400+

US and foreign patent applications filed in the past two years

700+

trademark applications filed in the past two years

590+

IPRs handled by WilmerHale attorneys

125+

lawyers and technology specialists holding degrees in technological and scientific fields

70+

lawyers and agents registered to practice before the USPTO



### IPR INSTITUTION RATE BY CLAIM

Unified Patents applauded WilmerHale for a higher institution rate by claim than any other firm in the United States.

## PATENT PROSECUTION

Assisting **Columbia University** with strategic patent advice and the worldwide prosecution of about 2,300 patent applications for the Morningside and Medical Center campuses. We prosecute applications in a wide variety of high-tech, medical device and pharmaceutical areas, including small molecule and biologic therapies to treat an extensive spectrum of medical conditions.

## POST GRANT PROCEEDINGS

Achieved a significant victory on behalf of client **PNC Bank N.A.** (PNC) when the PTAB invalidated all challenged claims in three mobile-banking patents owned by United Services Automobile Association (USAA), including all asserted claims in one of USAA's patents behind a recent \$218.5 million jury verdict of infringement against PNC's mobile banking app.

Achieved a victory for **Intel** when the Federal Circuit reversed the PTAB's decision and held that all challenged claims of US Patent No. 9,154,356 were unpatentable for obviousness. The patent was part of a multi-year battle between Intel and Qualcomm, with Qualcomm initially accusing Apple of infringing the patent through the sale of smartphones containing Intel chips and seeking to bar the import of Intel-based iPhones.

## TRADEMARK, TRADE SECRET AND COPYRIGHT PROTECTION

Our team was named *Litigation Daily's* "Litigators of the Week" in recognition of this trademark victory for **T-Mobile** in its high-stakes dispute with Simply Wireless in which T-Mobile was awarded summary judgment against Simply Wireless's claims that T-Mobile's use of the "Simply Prepaid" name infringed on its common law ownership of the phrase.

Secured major victory for **Reckitt Benckiser** following a jury trial in the District of New Jersey when claims brought by Absorption Pharmaceuticals, which sought \$454 million in damages for alleged fraud and trade secret misappropriation, were rejected.

## STRATEGIC ANALYSIS/PORTFOLIO DEVELOPMENT

Managing the entire worldwide intellectual property portfolio of **Crocs** and its subsidiaries, including patent, design, trademark, opposition and support of enforcement actions. We routinely advise on new product IP clearance matters, IP risk assessment, as well as the ongoing core protection strategy for its most iconic Classic Clog footwear style.

Serving as a key counselor for **TransMedics** for intellectual property for nearly 20 years. In addition to developing the current portfolio of nearly 100 US patents that cover organ preservation/care systems, we regularly advise TransMedics on IP aspects of corporate disclosures required by the SEC, on risk mitigation of IP rights of others and provide guidance on IP aspects of their next generation products.

For more information, please contact:

**Emily R. Whelan** — Chair, Intellectual Property Practice | +1 617 526 6567 | emily.whelan@wilmerhale.com

**Joseph F. Haag** — Vice Chair, Intellectual Property Practice | +1 650 858 6032 | joseph.haag@wilmerhale.com

## RECOGNITION

- **The Legal 500 United States** has ranked WilmerHale's intellectual property practice in the "Top Tier" since 2011.
- **LMG Life Sciences** has continuously ranked WilmerHale on a national level among leading firms for patent strategy and management since 2015.
- **Chambers USA** has continuously ranked WilmerHale's national IP practice in band one since 2011.
- **U.S. News & World Report** named us the 2022 and 2021 Patent Law Firm of the Year and the 2020 Biotechnology Law Firm of the Year.

**Clients note that WilmerHale is an "excellent firm with a deep bench of highly skilled attorneys... thoughtful, proactive and strategic."**

**"One of the biggest and strongest IP practices in the nation."**

— Chambers USA