

IP Group Of The Year: Goodwin Procter

By **Kevin Penton**

Law360, New York (January 28, 2016, 6:32 PM ET) -- Goodwin Procter LLP scored two U.S. Supreme Court victories on cases related to patents and trademarks and prompted the Federal Circuit to rewrite precedent last year, earning a spot among Law360's 2015 Intellectual Property Groups of the Year.

Securing the spot for the second year in a row, Goodwin Procter swayed the Supreme Court to discard a rule set by the Federal Circuit in 1998 that district court claim construction rulings must be reviewed afresh on appeal. It also convinced the justices that federal court decisions on "likelihood of confusion" can be precluded by earlier findings from the Trademark Trial and Appeal Board.

The firm also successfully represented International Business Machines Corp. as the Federal Circuit reversed its precedent for how defendants can challenge "means-plus-function" claims for patents.



Goodwin Procter achieved the successes in its IP practice in 2015 by having a talented and experienced set of attorneys who are knowledgeable about the law and who keep their clients' needs front and center, said the group's chair, Doug Kline. The firm added two IP partners to the practice to bring its number to 52 in 2015, according to the firm.

"We're pretty well balanced between pharma and non-pharma," said Kline, who anticipates that in the near future the practice will continue to explore opportunities with its client base in the West Coast's technology sector.

In a Supreme Court victory considered to be one of the biggest patent cases of 2015, Goodwin Procter represented Teva Pharmaceuticals USA Inc. in a patent infringement case against Sandoz Inc. involving Teva's multiple sclerosis drug Copaxone.

In a 7-2 decision, the Supreme Court held that district court claim construction rulings involving factual findings should be reviewed on appeal for clear error, rather than de novo, because they depend so much on familiarity with specific scientific principles.

Willy Jay, co-chair of Goodwin Procter's appellate group, said the firm had felt fairly confident about its petition, in part because the lower court had done such a thorough job in its review of the patents at

issue. Goodwin Procter convinced the Supreme Court to review the case, after the justices in previous years had rejected other petitions raising the question.

“It definitely had been brewing for some time,” said Jay, who led the team.

Jay also served on the team in the other major Supreme Court case, as Goodwin Procter scored a victory in March for B&B Hardware Inc. in a long-standing trademark battle with Hargis Industries Inc.

At play before the justices was the fact that federal courts and the TTAB both issue decisions on whether consumers are “likely to be confused” by similar marks, but for quite different purposes. The board decides whether a federal trademark registration should be issued, while courts generally decide whether someone is infringing a mark.

B&B had won a TTAB decision that rival Hargis’ proposed mark “Sealtite” was likely to be confused with B&B’s registered mark for “Sealtight.” A district court in subsequent litigation refused to give that finding preclusive effect or even include it in trial evidence, and eventually held that Hargis had not infringed the mark, regardless of what the TTAB had said.

The Eighth Circuit affirmed that ruling in 2013, but the Supreme Court reversed it, finding that “when the usages adjudicated by the TTAB are materially the same as those before a district court, issue preclusion should apply.”

Goodwin Procter represented defendant IBM in *Williamson v. Citrix Online LLC et al.*, as the full Federal Circuit overruled its own precedent that had permitted some patents to claim only their function without having to describe how they achieved it.

The appeals court examined “means-plus-function” claims, which describe a means for performing a certain function. Section 112(6) of the Patent Act deems such claims invalid as indefinite if they do not include a “corresponding structure” for performing the function.

The Federal Circuit had held for years that if a patent does not include the word “means,” there is a strong presumption that the requirements of Section 112(6) don’t apply, but in *Williamson* the court eliminated that presumption.

Kline expects that as a result of the decision and the work by Goodwin Procter, there will be more challenges to means-plus-function claims, particularly for computer-related patents such as the one IBM had been accused of infringing.

“You’re going to see a lot of that,” Kline said.

Goodwin Procter has 900 attorneys in nine offices in the U.S., Europe and Asia, according to the firm.

--Additional reporting by Ryan Davis and Bill Donahue.
