

PATENT REEXAMINATION, PROSECUTION
& ADVISORY PRACTICE

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PATENT REEXAMINATION, PROSECUTION & ADVISORY PRACTICE

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COVINGTON'S PATENT PRACTICE

Covington's patent lawyers provide comprehensive advice over the full range of patent issues that include formulating strategies for the effective procurement and enforcement of patent rights, developing and managing patent portfolios, licensing and exploiting patent rights, and asserting and defending against patent challenges. Our patent attorneys are experienced in a wide range of technologies and industries, including biomedical, biotechnology, chemical, computer, electrical, human and animal health, mechanical and electro-mechanical, pharmaceuticals, telecommunications, and a host of related disciplines, providing patent advice fully sensitive and responsive to particular business and regulatory contexts. Many of the firm's patent attorneys have advanced technical degrees or have previously held positions as engineers or scientists – backgrounds that facilitate appreciation and understanding of technology and communication with inventors.

PATENT REEXAMINATION

Our patent lawyers have substantial experience in patent litigation and transactional matters, and our patent prosecution work is often a key component of a larger litigation or business strategy. One focus of this practice area is reexamination proceedings in the U.S. Patent and Trademark Office (PTO). Covington patent attorneys have handled both *ex parte* and *inter partes* reexamination proceedings, both as requester and as patentee. We work closely with our litigation colleagues to develop offensive and defensive strategies that involve reexamination proceedings, and then execute the strategy in the PTO, and in the courts. A key to our success has been the close interaction and coordination between the reexamination and litigation teams at Covington.

REPRESENTATIVE MATTERS

- Representation of **Alkermes, Inc.**, the top patent owner of Orange Book listed patents in reexamination, in the *ex parte* reexamination proceedings and worldwide opposition proceedings initiated by competitors. Six of the seven patents successfully emerged from reexamination and remain listable for the VIVITROL® and RISPERDAL® CONSTA® products. We also represent Alkermes in worldwide prosecution of patents directed to the BYDUREON™ product (exenatide for extended-release injectable suspension), a new drug formulation for the treatment of Type 2 diabetes.
- Representation of **Trend Micro Incorporated** as patent owner before the U.S. Patent and Trademark Office in *ex parte* reexamination proceedings relating to two patents directed to anti-virus technology. On August 23, 2011, the reexamination certificate for one patent issued. The second proceeding remains pending, with numerous claims confirmed as patentable. Trend Micro and third-party requester Fortinet recently settled state court litigation in which the validity of the patents was at issue.
- Representation of **Verizon Communications Inc.** as patent owner in four *ex parte* reexamination proceedings initiated by TiVo. The claims in two of the patents have already been confirmed as patentable without amendment, and the other two proceedings remain pending.

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- Representation of **Fujitsu Limited** as patent owner in *ex parte* reexamination proceeding for a patent related to card type input/output interface devices. The patent is the subject of co-pending patent litigation, in which Covington represents Fujitsu Limited.
- Representation of the **New York Times, CBS Interactive**, and others as third party requester in *ex parte* and *inter partes* reexamination proceedings for three patents owned by Helderich Patent Licensing, LLC. Rejections have led to claim amendments in all three proceedings.
- Representation of **Fougera Pharmaceuticals** (formerly known as Nycomed US Inc.) as third party requester in *ex parte* and *inter partes* reexamination proceedings for patents owned by GlycoBiosciences, Inc. The patents, directed to topical gel compositions, are the subject of co-pending patent litigation, in which Covington represents Fougera. The litigation has been stayed pending the reexamination proceedings.
- Representation of **Verizon Services Corp.** as third party requester in *inter partes* reexamination proceedings for two patents owned by TiVo. All claims subject to reexamination stand rejected on multiple grounds.
- Representation of **Samsung Electronics Co., Ltd.** ("Samsung") in *inter partes* reexamination proceedings for a patent related to LCD color technology. Genoa Color Technologies Ltd. ("Genoa"), the original owner of the patent, sued Samsung for infringement. Samsung requested *inter partes* reexamination of the patent, and the Right of Appeal notice upheld the final rejection of all claims of the patent on a plethora of grounds. Subsequent to the Right of Appeal Notice, the parties settled the litigation.
- Representation of **Verizon Long Distance LLC** as a third-party requester before the U.S. Patent and Trademark Office in *inter partes* reexamination proceedings relating to two patents directed to Voice over Internet Protocol ("VoIP") technology. Shortly after a Right of Appeal Notice issued in one of the proceedings, the corresponding district court litigation against Verizon was dismissed with prejudice, resulting in a favorable settlement for Verizon.
- Advising a digital camera manufacturer regarding reexamination proceedings in the context of a district court litigation and an International Trade Commission investigation.
- Advising a large television manufacturer regarding *inter partes* reexamination proceedings in the context of a multi-defendant district court litigation.
- Advising a large software company regarding reexamination proceedings in the context of a district court litigation.

PATENT PROSECUTION

The firm prosecutes patent applications worldwide, in a broad range of industries and technologies. Applications are handled in a proactive manner that recognizes the significance of the technology at research and product development stages and that is consistent with client business objectives that may range from protecting existing and planned future products, markets and operations to generating new sources of revenue.

We craft patent applications that look beyond patentability, with an eye toward meaningful enforceability when tested in litigation or in other contexts. Headquartered near the U.S. Patent and Trademark Office, we are able to work closely with patent examiners to help guide

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patent applications through the prosecution process. In addition to obtaining patents, our expertise encompasses advising clients on post-issuance activities, such as patent reissue and reexamination proceedings, and applications for patent term restoration. Our patent lawyers also have experience in patent litigation matters and transactional work, and our patent prosecution work takes into consideration the reality of how patents operate and may be tested in the real world.

PATENT ADVISORY

We apply our technical and industry expertise and our knowledge of patent law to provide infringement, validity, and freedom-to-operate opinions. This advice is provided in a variety of contexts, including anticipated patent litigation, or licensing of intellectual property. We regularly provide patent analysis as part of IP due diligence to assess the patent assets and liabilities of target companies in connection with an acquisition or merger. The breadth of the firm's corporate securities practice, and the teaming of intellectual property and corporate lawyers on such matters, helps to ensure that we provide comprehensive due diligence to clients.

REPRESENTATIVE MATTERS

- For **Alkermes, Inc.**, reexamination proceedings for patents covering RISPERDAL®CONSTA®, the first injectable, long-acting atypical antipsychotic indicated for the treatment of schizophrenia.
- Patent due diligence of behalf of **Procter & Gamble** in the \$3.1B sale of the global pharmaceuticals business to Warner Chilcott.
- Patent due diligence on behalf of **Procter & Gamble** in a transaction with Inverness Medical Innovations to form the joint venture company, SPD Swiss Precision Diagnostics GmbH, a leading provider of home diagnostic and monitoring products.
- For **Samsung**, reexamination proceedings for patents relating to color display technology.
- For **Schering-Plough**, patent prosecution relating to a new generation of the drug CLARINEX®.
- For **Thomson Reuters**, prosecution of patent applications directed to digital image processing and various financial software technologies.
- For **Verizon**, reexamination proceedings for patents relating VoIP technology.
- On behalf of a large pharmaceutical company, prosecution of a portfolio of applications directed to an anti-HIV drug.

SENIOR ATTORNEY BIOGRAPHIES



ANDREA G. REISTER

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Andrea Reister chairs the firm's Patent Reexamination, Prosecution, and Advisory Practice, and regularly advises clients on patentability, validity, and infringement issues, as well as on patent due diligence issues for acquisitions and transactions. Her advisory practice encompasses Hatch-Waxman pre-litigation audits, worldwide portfolio development and management, including strategic advice for offensive and defensive patent procurement, and competitor landscape evaluation. She has successfully briefed and argued numerous appeals before the Board of Patent Appeals and Interferences in the U.S. Patent and Trademark Office. As leader of the firm's patent reexamination practice, she has handled both *ex parte* and *inter partes* proceedings, the latter often in conjunction with multi-party district court litigation. Ms. Reister has represented clients in litigation matters involving computer and communications technologies, including Voice over Internet Protocol (VoIP), wireless and ADSL, pharmaceutical formulations, hydrostatic transaxles, and footwear. She has represented clients in district court jury trials, Hatch-Waxman ANDA litigation, and in ITC proceedings. In addition to being registered to practice before the U.S. Patent & Trademark Office, Ms. Reister is admitted to the Supreme Court of the United States, the Court of Appeals for the Federal Circuit, and the District Court for the District of Columbia. Prior to attending law school, Ms. Reister was the Chief Engineer at the Naval Undersea Warfare Engineering Station, responsible for undersea weapons testing. During this time, she developed a remote-controlled submarine target, worked on robotic systems for torpedo recovery, and earned the Meritorious Civilian Service Medal. Ms. Reister served as a Lieutenant Commander in the United States Naval Reserve, and qualified as an Engineering Duty Officer.

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Einar Stole specializes in complex pharmaceutical and chemical patent litigation in the US district courts, including numerous cases involving generic drug approvals and the Hatch-Waxman Act. Dr. Stole's litigation and counseling experience has focused on matters involving pharmaceuticals, chemicals, chemical processes, and biotechnology such as genetically-engineered enzymes and DNA-based diagnostic methods. He counsels clients on a range of intellectual property and litigation matters, including patent infringement, validity, and enforceability. Dr. Stole also has experience prosecuting chemical and biotechnology patent applications in the U.S. Patent and Trademark Office, including appeals and interferences before the Board of Patent Appeals and Interferences. Dr. Stole received his Ph.D. in Biochemistry from Cornell University.



GREGORY DISCHER

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Greg Discher practices in the areas of patent litigation, patent prosecution, and client counseling on a wide variety of intellectual property matters. His patent litigation experience in both district courts and the International Trade Commission has involved technologies including wireless communications, semiconductors, and global positioning systems. Recently, he was a key member of a litigation team representing a major semiconductor manufacturer before the ITC. As a registered patent attorney, a significant component of Greg's practice is inter partes reexamination proceedings in the U.S. Patent and Trademark Office. Greg's experience includes representation of Verizon as a third party requester in inter partes proceedings relating to patents concerning Voice over Internet Protocol technology. He has also advised a large television manufacturer relating to reexamination of patents involved in district court litigation, and a large software company regarding reexamination of patents involved in district court litigation. Prior to his career in law, Greg worked as an engineer for thirteen years with various government and private sector organizations, and is a licensed professional engineer in the Commonwealth of Virginia. He received a B.S. from the University of Michigan in 1985, a M.S. from George Mason University in 1992, and a J.D. from the George Mason University School of Law in 1996.

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Sinan Utku's practice includes patent litigation, the drafting of original patent applications, patent prosecution, drafting patent opinions, technology transfers and U.S. export controls, and client counseling, especially in the area of U.S. patent law. He has had significant experience in the technology areas of telecommunications, fiber optics, cryptography, computer software, business methods, and the electrical arts generally. Sinan is registered to practice before the U.S. Patent and Trademark Office, and has worked on several *inter partes* reexamination proceedings in the areas of color display technology and VoIP telephony. He received a J.D. from Columbia University Law School, where he was a Stone Scholar. He also received a Ph.D. in Physics from Yale University and a B.S. degree in Physics from Duke University, *summa cum laude*, with Phi Beta Kappa honors. Sinan is an author or co-author of a number of scientific papers in his area of proficiency and has published numerous articles on patent issues, nuclear physics, and high technology subjects. He is proficient in Russian and fluent in Turkish.