



James A. Gale

Co-Chair, Intellectual Property Litigation

Miami

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Practice Areas

- Intellectual Property
- Intellectual Property Litigation
- Patents
- Trade Secrets, Restrictive Covenants, and Computer Abuse

Education

- University of Florida School of Law, J.D., 1983
- University of Florida, B.S., 1980

Bar Admissions

- Florida
- United States Patent and Trademark Office

Court Admissions

- Supreme Court of Florida
- U.S. Supreme Court
- U.S. Court of Appeals for the Federal Circuit
- U.S. Court of Appeals for the Eleventh Circuit
- U.S. Court of Appeals for the Ninth Circuit
- U.S. Court of Appeals for the Sixth Circuit
- U.S. Court of Appeals for the Third Circuit
- U.S. Court of International Trade
- U.S. District Court -- Southern District of Florida
- U.S. District Court -- Middle District of Florida
- U.S. District Court -- Eastern District of Michigan
- U.S. District Court -- Western District of Michigan
- U.S. District Court -- Southern District of Alabama
- U.S. District Court -- Central District of Illinois
- U.S. District Court -- Eastern District of Wisconsin
- U.S. District Court -- Eastern District of Texas
- U.S. District Court -- Colorado

Affiliations

Chair, Inaugural Committee for Intellectual Property Law Certification, The Florida Bar, 2007 to 2010

Former Chairman, Intellectual Property Committee, The Florida Bar, 2003 to 2005

Board member, Florida Bar Board of Legal

James A. (Jim) Gale focuses his practice in the area of intellectual property counseling and litigation. He is a registered patent attorney with over 36 years of experience and is Chambers Band 1 ranked in Florida, Martindale AV Preeminent[®] rated, Board Certified in Intellectual Property by the Florida Bar, an AAA Arbitrator and the former inaugural chair of the IP Board Certification Committee. Jim has handled hundreds of cases involving patents, theft of trade secrets, restrictive covenants, trademarks, unfair competition, and internet disputes. He has appeared in over 400 federal cases in more than 48 federal district and circuit courts, as well as handled hundreds of injunctions in over 35 different states around the nation.

Jim's work and work ethic have always told a lot about his character. In 1989 his story was featured in *The American Lawyer*. An accomplished intellectual property litigator, Jim's client list includes national and international high-technology manufacturers, as well as traditional brick-and-mortar clients. He was awarded the title of Patent Law Lawyer of the Year in Miami for 2016, 2017, and 2018 by *Best Lawyers in America*[®]. Jim was also appointed to the 11th Circuit Jury Instruction Panel to assist in drafting jury instructions for the recently enacted Federal Defend Trade Secrets Act. Jim has also served as an adjunct professor of trade secret and restrictive covenant law at the University of Miami School of Law, and was also an adjunct professor of patent and trade secret law at Florida International School of Law.

Experience

Medical Device/Biotech Patent Litigation

- Defended Awarepoint, a provider of real-time location system (RTLS) tracking solutions in the health care industry, in a patent infringement action involving position location using radio-frequency identification technology. Filed for Reexamination of the patents at issue with the USPTO and a motion to stay the case with the court. The stay was granted and the case was dismissed soon thereafter.
- Defended Awarepoint, a provider of RF tracking solutions and real-time location systems (RTLS) for medical inventory, in a patent infringement action involving four patents covering the use of RF identification technology. The matter settled on favorable terms for our client.
- Represented plaintiffs, exclusive licensees of a patented method of monitoring compliance with medications and prescriptions, in litigation involving patent infringement, Florida Deceptive and Unfair Trade Practices Act violations, tortious interference, fraudulent misrepresentation and false marking. The matter settled on favorable terms for our client.
- Assisted in defending Blue Belt Technologies, a developer of robotics-assisted surgery, in a patent infringement action regarding a method and system for high-precision removal of material or tissue in surgery to allow for the insertion of implants. Defendant was accused of direct and indirect infringement. Filed counter-claims and IPR in the USPTO, which the USPTO accepted. Case stayed pending IPR.

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Specialization & Education Committee, 2010 to Present

Member, Preliminary Relief Subcommittee of the Enforcement Committee, INTA, 2001 to 2012

Member, Trade Secret Committee, AIPLA

Co-Chair Litigation Subcommittee of the AIPLA Trade Secrets Committee, 2018 to Present

Fellow, Litigation Counsel of America

Awards & Honors

- AV Preeminent Rated, Martindale-Hubbell
- Best Lawyers In America®, Patent Law Lawyer of the Year – Miami, 2018
- Best Lawyers In America®, Litigation – Intellectual Property, Patent Law, 2006-2022
- Chambers USA, 2020-2021
- United States Lawyer Rankings, Top 10 Intellectual Property Lawyers in the United States, 2006 to Present
- Member, The Million Dollar Advocates Forum
- Florida Super Lawyers®, Top Attorneys in Florida, Intellectual Property Law, 2006 to Present
- South Florida Legal Guide, Top Lawyers and Law Firms in South Florida, 2003 to Present
- Top 100 Florida Super Lawyers®, 2008
- Florida Trend Magazine's Legal Elite, Top Lawyers in Florida, Intellectual Property
- Top Attorneys In Florida, The Miami Herald, Tampa Bay Magazine and Orlando Life, 2014
- International Intellectual Property Award, Acquisition International Magazine, 2014
- Leaders in Law Award in Intellectual Property Rights, South Florida Business & Wealth, 2015
- Marquis Who's Who in America, 68th Edition to Present Edition
- The International Who's Who of Patent Lawyers, 2008 to Present
- The International Who's Who of Business Lawyers, 2009
- Board Certified as a Specialist in Intellectual Property Law as Accredited by the Florida Bar, 2007 to Present
- Appointed to the 11th Circuit Defend Trade Secret Jury Instruction Panel
- Leaders in Intellectual Property & Patent Law, Business Leaders & Professionals Magazine, 2017
- IP Star and Patent and Trademark Star by *Managing IP*
- Listed in the 2020 Global Law Experts

- Represented Diabetic Care RX, a health care company specializing in pharmacy services, in a patent infringement action involving intradialytic parenteral nutrition, which is prescribed by physicians to malnourished hemodialysis patients. A rival manufacturer had alleged Diabetic Care Rx was offering an identical formulation of its intradialytic nutritional supplement. Invalidity analysis was performed and provided to the patentee, and the case was favorably resolved thereafter.
- Assisted in representing Cargill, a provider of food, agricultural, risk management, financial and industrial products and services, in a patent infringement action involving a product and method for feeding crustaceans and fish. Opposition filed for summary judgment, which was defeated in all aspects. The case proceeded to jury trial. After a two week trial, the jury found the defendant to have willfully infringed and we obtained a permanent injunction and a final judgment of \$1.3 million.
- Defended Farmanatural, Inc., a manufacturer of chromium picolinate, a dietary supplement, in a patent infringement suit brought by a rival manufacturer that was the exclusive licensee of the U.S. government, which owns the patent for chromium picolinate. Defeated plaintiff's argument for a preliminary injunction and the case was favorably settled thereafter.
- Defended Heartware, Inc., a global medical device company, in a patent infringement suit involving a ventricular assist device. Filed counterclaims, including the assertion that the plaintiff was not an owner of either of the patents-in-suit and the case was resolved favorably thereafter.
- Represented LD Technology, a provider of sudomotor function monitoring systems based on the galvanic skin response, in a case that involved issues of patent and trademark infringement, breach of contract and misappropriation of trade secrets. After gaining access to confidential information, two former employees left LD Technology to start a competing company, which then filed patents on the stolen technology and thereafter sued LD Technology on those patents. After extensive litigation, the matter settled on favorable terms for our client.
- Represented Pacesetter, Inc., an implantable pacemaker and defibrillator manufacturer, in a dispute over royalty payments for chemical coatings on implantable leads connected to the heart. After the expiration of a cross-license agreement, SurModics claimed substantial additional royalties were owed. Pacesetter filed for declaratory relief, USDC for CD Ca. agreed and granted summary judgment, which was then upheld on appeal by the 9th Circuit Court of Appeals.
- Defended Palco Labs, a manufacturer of reusable and disposable diabetes devices for collecting blood samples, in a patent infringement suit involving the design of a glucose meter. The matter settled on favorable terms for our client.
- Defended Ivax Pharmaceuticals, a manufacturer of generic drugs, in a patent infringement suit involving cough and cold liquid gels. The case was dismissed with minimal litigation involved.
- Represented IVX Animal Health, a manufacturer of pharmaceutical and nutraceutical products used to treat animals, in a patent infringement action involving dietary supplements to promote joint health and mobility. IVX filed for declaratory judgment, arguing the patent was invalid because the inventor had acknowledged in his patent that the formula it described had already been invented and was the subject of older clinical trials. Counter-Plaintiff/Patentee filed a Covenant Not to Sue as to the alleged infringing products, thereby mooting the case.
- Represented Viragen, Inc., a biopharmaceutical company engaged in the clinical development and manufacture of immunomodulatory therapeutic products such as Interferon and Multiferon, and the Roslin Institute, a Scottish charity and world leader in the research of farm animal biotechnology, mammalian cloning and avian transgenesis, in a patent infringement action involving a new in vitro avian embryo culture technique. During cross-examination in a preliminary injunction hearing,

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the defendant's Chief Scientific Officer admitted to utilizing Viragen's patented process to promote the commercial ventures of the Defendant. The matter settled on favorable terms for our client.

- Represented Althin CD Medical, a manufacturer of dialysis equipment, in a patent infringement action against a competitor. The matter settled on favorable terms for our client.

Computer Software/Hardware/Wireless Technology Patent Litigation

- Defended Blu Products, the largest seller of unlocked smartphones, against claims brought by Blackberry involving 15 patents and over 184 claims relating to the Android operating system and smartphones. After taking the case over, we obtained a continuance, and then filed a Motion to Stay based upon 4 pending IPRs, while working on 11 others. After the court granted a stay, the case settled favorably.
- Defended Blu Products, the largest seller of unlocked smartphones, in ITC proceeding on 5 SEP patents relating to smartphones. Filed suit in the Eastern District of Texas against LG claiming that it breached its obligations under ETSI to provide reasonable license under the patents and sought injunctive relief to prevent enforcement of the ITC exclusion order. The case settled one week prior to our Motion for Preliminary Injunction in Texas.
- Defended Blu Products, the largest seller of unlocked smartphones, against injunction claims brought by Ericsson in Brazil. Negotiated favorable worldwide license.
- Defended Sensus, USA, a technology provider for the electric, gas and water industries, against NPE relating to wireless mesh networking patents in the water utility industry. We reached a quick settlement to client's satisfaction.
- Took over the defense of the case and then defended Sensus USA, a technology provider for the electric, gas and water industries, against a subsidiary of Walker Innovation that asserted multiple patents relating to "Secure Measurement Confirmation" in the water utility industry. Case successfully resolved after filing Motion to Dismiss under 35 USC Section 101, and the filing of IPRs.
- Defended Araneus, a manufacturer of RF-Link products, in a patent infringement action involving wireless cloud-based infrared remote control systems.
- Defended Gexa Energy, a Texas electric utility company, in a patent infringement suit brought by an NPE regarding the use of encrypted data transmission systems.
- Represented Florida Power & Light (FP&L), a major electric utility, in a dispute involving the refusal to assign rights to the invention of an x-ray machine capable of examining the interior of a boom arm to FP&L. The matter settled on favorable terms for our client.
- Defended Florida Power & Light (FP&L), a major electric utility, in a patent infringement suit brought by an NPE involving wireless-mesh network technology relating to meter-reading. The matter settled on favorable terms for our client.
- Defended Tropos Networks, a wireless mesh networking company, in a patent infringement suit involving wireless communication network technology for remote monitoring of devices. Moved to bifurcate the ownership claims and stay the patent infringement claims, which was granted and the case was later dismissed.
- Represented Tropos Networks, a wireless mesh networking company, in patent infringement cases that also included issues of tortious interference and unfair competition. Patentee asserted infringement of three patents related to wireless mesh network products. IPRs filed on patents after

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which the case was favorably resolved.

- Defended Motorola in a patent infringement suit involving a Ph.D. student and professor of the university who claimed to have invented a method and system to test various mobile network configurations and who alleged that Motorola had misappropriated their patented technology.
- Defended OpenTable, a real-time online reservation network for fine dining, against an NPE in a patent infringement action involving four patents relating to internet content display. The matter settled on favorable terms for our client.
- Defended Hitachi America in a patent infringement suit involving telephone communication switchboard systems.
- Defended Laser Fantasy International, a manufacturer of a laser projection system, in a patent infringement action involving a system for projecting an image onto a geometric viewing surface, specifically in a planetarium. After providing evidence that the patent in suit was potentially invalid and that the inventors named in the patent did not invent the subject matter of the patent, Plaintiff dismissed the suit with prejudice.
- Defended Ashtech, Inc., a manufacturer of GPS surveying products, in a breach of contract case alleging Ashtech's products had failed to produce survey measurements within the specifications warranted. Filed counterclaims and the case was ordered to mediation, which resulted in a resolution of the matter.
- Defended Strike Logistics, a freight brokerage service, in a patent infringement action brought by an NPE. Six patents describing aspects of tracking and messaging technology were alleged to be infringed by Strike.

Electro-Mechanical Patent Cases

- Represented Bennett Marine, a manufacturer of automatic hydraulic trim tabs for powerboats, in a patent infringement suit. Obtained a judgment for infringement, inducement to infringe, and willful infringement and attorneys' fees. The matter was reversed on appeal due to improper claim construction by the lower court.
- Represented Chase Boards, an electrically powered skateboard manufacturer, in a patent infringement action against a rival manufacturer. The matter settled on favorable terms for our client.
- Represented Chase Boards, an electrically powered skateboard manufacturer, in a patent infringement action against a rival manufacturer. Defendant was permanently enjoined from marketing or selling any of its products that fell within the scope of the Chase Boards patents.
- Defended Consumer Engineering Inc., a manufacturer of spa controls, in a patent infringement action alleging the company had willfully infringed three patents of a rival manufacturer.
- Defended Deangelo Marine Exhaust, a production fabricator of marine exhaust systems, in a patent infringement action involving two patents detailing water jacketed exhaust pipes. The case proceeded to a jury trial, and damages held to \$97,000.
- Represented Faux Effects, a manufacturer of decorative finishes, in a case involving issues of patent infringement, unfair competition, misappropriation of trade secrets and breach of confidential relationship. The court granted permanent injunctive and declaratory relief against the defendant.
- Represented Gulf Manufacturing, a manufacturer of fishing supplies, in a patent infringement suit involving traps used to catch Florida stone crabs. Filed for declaratory judgment and the defendant

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signed a covenant prohibiting any further lawsuits.

- Represented Life Systems Intl., a manufacturer of machinery for making dumplings, in a patent infringement case against a rival manufacturer
- Defended Mad Catz, Inc., a manufacturer of gaming accessories, in a patent infringement action involving a game screen for computer video game platforms.
- Defended Pylon Manufacturing, an automotive aftermarket supplier, in a patent dispute involving reclosable packaging for wiper blades. Filed counterclaim asserting that the plaintiff had infringed Pylon's patent. Defeated plaintiff's motion for preliminary injunction and the case was settled after the final pretrial conference.
- Represented plaintiffs, which offered services relating to mine construction, excavation, gunite, and other concrete services, in a patent infringement action arising out of a distributorship agreement and tortious interference by a third party. Secured a permanent injunction against one defendant that began using products, provided by another defendant, which infringed the clients' patented mine ventilation technology.
- Represented Star Envirotech, a manufacturer of custom diagnostic smoke technology that diagnoses leaks, in a patent infringement action against a rival manufacturer. Defendant pursued an IPR, but the PTAB affirmed the patent's validity and the case proceeded to discovery and claim construction. Ten terms were under dispute and the Court agreed with Envirotech's construction on all ten. Further, Envirotech successfully argued for sanctions as a result of defendant's spoliation of evidence and other discovery misconduct.
- Represented Techno Tools, a manufacturer of handheld electronic test instrumentation, in a patent infringement action involving the design of a detachable UV LED light that may be clipped onto leak detectors. Filed for declaratory judgment after a rival manufacturer alleged infringement and the case was settled favorably.
- Defended an inventor in a determination of inventorship and correction of a patent regarding a magazine bullet loading device. The defendant, who was engaged to manufacture the device, named himself as the sole inventor on the patent. Plaintiff alleged that he conceived the design of the invention. The case was settled in mediation with minimal litigation.
- Represented the plaintiff in a Declaratory Judgment action against a former business associate who fraudulently reassigned a patent and created an unauthorized corporate entity to commercialize the invention, liners for petroleum storage tanks. The case proceeded to claim construction, and the court ruled in favor of our interpretation of the term under dispute. The case was thereafter settled.

Covenants Not to Compete, Theft of Trade Secrets and Unfair Competition

- Egnyte hired seven employees from Citrix in North Carolina to work remotely and filed suit in state court in California both for declaratory relief and damages under California Bus. and Prof. Code 17200. Citrix then filed for injunctive relief in Florida state court against Egnyte and the seven former employees. We successfully moved to stay/abate the second filed Florida case. After the stay was lifted, we moved to dismiss the Florida case for lack of jurisdiction. The lower court denied the motion, but was reversed by the appellate court. After 11 months of no injunction, the case settled favorably for our clients.
- Mediware brought suit for breach of restrictive covenants and theft of trade secrets against four of its former employees who left after selling Mediware a blood collection software program and then starting their own company. After taking the case over from a top-25 law firm, we successfully

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defeated an evidentiary injunction and then successfully resolved this matter.

- Represented St. Jude Medical in a series of 16 cases involving over 50 sales representatives from Intermedics in over a dozen different jurisdictions, when that company's assets were acquired by Guidant Corp. Guidant tried to enforce the covenants and confidentiality provisions. After successfully obtaining an anti-suit injunction against Guidant, the cases settled favorably, resulting in hundreds of millions of dollars in new sales for the plaintiffs.
- Won a five-day jury trial in federal court regarding an alleged breach of covenant not to compete, theft of trade secrets, and breach of term-of-years contracts and counterclaims for breach of contract, tortious interference and theft of confidential information. With a verdict entitling our clients to up to \$2.5 million in attorneys' fees and costs, the case settled for an undisclosed amount.
- Represented St. Jude Medical in a theft of trade secret case involving a former employee who downloaded the client's server and fled to China to set up a competing medical device company with the assistance of a Chinese government-backed company. Jury verdict of more than \$2.3 billion.
- Competing actions filed in both Florida and NJ to enforce a covenant not to compete and claims of theft of trade secrets brought by Biosense Webster against St. Jude and its new employee in its Atrial Fibrillation division. After the case was transferred to NJ, the covenant was substantially narrowed and a settlement agreeable to the clients was reached.
- Represented a former engineer from Medtronic and his new employer in competing cases filed in Minnesota and California. We filed a first-filed action and enjoined the continuance of a second-filed Minnesota action. The trial and appellate court upheld the injunction and the California Supreme Court reversed on appeal on basis of comity.
- Invalidated a covenant of a medical device sales representative who moved from Texas to California. Summary Judgment upheld for employee and new employer by the appellate court and California Supreme Court.
- Represented St. Jude Medical against a sales representative, his wife, and her new employer, Medtronic. The sales representative was funneling sales from St. Jude to Medtronic through his wife. The suit was brought by St. Jude in Florida, and thereafter by Medtronic in Minnesota. After the Florida court issued an injunction preventing the second-filed Minnesota action from proceeding, the parties entered into private binding arbitration. After a 4-week trial before a three-judge panel, the client was awarded a confidential multimillion-dollar verdict plus more than \$1.5 million in fees.
- Secured a favorable result in a matter in which Boston Scientific sought to enforce a term of years agreement and non-compete/non-disclosure provisions to prevent a former employee for working for our client, St. Jude Medical Center SC, Inc. St. Jude Medical filed a motion for preliminary injunction in the U.S. District Court for the Northern District of California. Boston Scientific filed a second action in Minnesota seeking to move the case to the U.S. District Court for the District of Minnesota pursuant to a forum selection clause. After the Northern District of California refused to dismiss the first-filed case, and the District of Minnesota stayed the second-filed action, the case settled favorably and the employee was released from his agreements.
- Defended St. Jude Medical S.C. and five of their sales representatives who formerly worked for rival manufacturer Biosense Webster, Inc. Biosense alleged that the former employees could not sell electrophysiology biomedical devices to its clients for St. Jude, regardless of whether or not they were competing devices. After two injunction hearings, the court declined to enter an injunction and counterclaims were filed. The case thereafter settled and the employees were permitted to work for

St. Jude.

- Represented St. Jude Medical and one of its new sales representatives in a declaratory relief action against her former employer, Boston Scientific, who had forced her to sign an agreement containing restrictive covenants after she signed her employee contract. Furthermore, the non-compete provision in the agreement was overly broad under North Carolina law.
- Successfully defeated a challenge to a forum selection clause from a former St. Jude Medical sales representative who had taken employment at a rival company in California and sought to declare the covenant invalid under California law. The case was successfully transferred to Minnesota and the covenant was enforced.
- Secured judgment in excess of \$15 million on counterclaims our client, Inmuno Vital, Inc., filed against Nutrivida, Inc. for violations of N.Y. Laws 50 and 51 and the Lanham Act, among others. Additionally, we won summary judgment as to Nutrivida's claims against our client, which were brought under the Lanham Act and state statutes for, inter alia, false advertising and deceptive and unfair trade practices relating to the termination of a distribution agreement. Nutrivida's owner subsequently filed for bankruptcy.
- Defended St. Jude Medical and its new employee against claims of contempt of a previously issued injunction in favor of Boston Scientific. After an evidentiary hearing, the court held that no violation of the Injunction existed and no contempt was warranted.
- Brought in to dissolve an injunction against five sales representatives in Maryland who were given large bonuses to join St. Jude. The injunction was dissolved after an evidentiary hearing and the case thereafter settled favorably.
- Filed for declaratory and injunctive relief on behalf of St. Jude Medical S.C. and one of its new employees who left a rival company. The competitor forced him to sign an overly broad secrecy, intellectual property, non-competition and non-solicitation agreement under North Carolina law. The defendant agreed to release the plaintiff from his non-compete.
- Obtained a temporary restraining order on behalf of St. Jude Medical against two former sales representatives, both of whom left St. Jude to join a competitor. The temporary restraining order was upheld and converted to a preliminary injunction by the court and a favorable settlement was negotiated thereafter.
- Represented two former sales representatives from Biotronik when they sued to void their non-competes. Biotronik counterclaimed and sued them and their new employer, St. Jude, for breach of contract, tortious interference, and theft of confidential information. After a five-day jury trial in federal court, our clients prevailed, entitling them to up to \$2.5 million in attorneys' fees and costs. The case settled thereafter for an undisclosed amount.
- Defended a sales representative of St. Jude Medical, who relocated to California from Texas, from a competing manufacturer's attempt to enforce a non-compete agreement. Trial and appellate court found the agreement void and that its use violated California law.
- Represented Telectronics Pacing Systems, a cardiac pacemaker manufacturer, in a breach of distribution agreement and non-compete. Jury verdict in favor of our client.
- Represented Alliant Insurance Services, a commercial insurance brokerage, and three of its new employees, who were previously employed by Wells Fargo, in multiple actions in Georgia and Florida to invalidate non-disclosure and non-compete covenants. We sued to invalidate the covenants in Georgia and Wells Fargo sued in Florida to enforce the covenants. The matter settled on favorable

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terms for our clients.

- Represented a manufacturer of vascular brachytherapy products against a former sales employee who violated non-compete, non-solicitation, and trade secret covenants. The case settled favorably prior to an injunction hearing.
- Represented the plaintiff in an action seeking a declaratory judgment and injunctive relief on behalf of an employee who had been forced to sign non-compete and non-solicitation agreements under duress by his prior employer. The court granted our motion for partial summary judgment and later ruled that both agreements were unenforceable.

Lanham Act/Trademark Litigation

- This was a very complicated and lengthy case brought by Nutrivada against defendant/client and its spokesperson, Andres Garcia, relating to the herbal supplement, Cat's Claw. Plaintiff brought claims seeking in excess of \$1 million under the Lanham Act and state statutes for, inter alia, false advertising, deceptive and unfair trade practices relating to the termination of a distribution agreement for Cat's Claw. We counterclaimed for, inter alia, violations of N.Y. Laws 50 and 51 and the Lanham Act. After obtaining an order of summary judgment as to plaintiff's claims, and succeeding on our claims on summary judgment, plaintiff's owner filed for bankruptcy. We then were able to strike the plaintiff's pleadings and proceeded to obtain a judgment in excess of \$15 million against the plaintiff.
- Secured a favorable settlement on behalf of Inmuno Vital, Inc. in a case against Telemundo for airing Nutrivada commercials that violated Inmuno Vital's trademark for VIDA VITAL Cat's Claw. Despite repeated notices and demands, Telemundo refused to stop airing the Nutrivada commercials. After defense counsel violated the rules of mediation, the court struck the defendants' pleadings on the morning of trial, leading to the settlement.
- Represented a plaintiff in connection with its massive nationwide advertising campaign for its anti-wrinkle cream, wherein it ran advertisements "BETTER THAN BOTOX?". The client sought declaratory relief that its advertisements did not violate the Lanham Act and other statutes and threatened to cancel the defendant's mark for BOTOX on the grounds that it had been advertising its product as a general anti-wrinkle cream when the FDA had only approved it for limited purposes that did not include anti-wrinkle purposes. The case settled favorably, and the client was able to continue its marketing campaign.
- Secured dismissal of an action filed against our client, Robinson May Department Stores, seeking preliminary injunctive relief to prevent its sale of Strivectin and prevent the use of the phrase "BETTER THAN BOTOX?" in connection with said sales. In response, our client filed a motion to dismiss, stay, or transfer the action to the District of Utah, where we had filed the main declaratory judgment action described above. The case was dismissed.
- Represented Advanced Estimating Systems, Inc., a provider of construction estimating software, in a trademark and copyright infringement action involving copying of said software and logos. After a jury verdict of \$860 thousand, the court entered a permanent injunction on behalf of the plaintiff.
- Brought in by insurance company to try the case after the close of discovery to replace prior insurance counsel. Defended the former distributor of soft drink ZING which began selling a similar soft drink to former customers under the name TING. After a week-long trial, the jury rendered a "\$0" verdict.
- Successfully represented The Proctor & Gamble Co. in a case in which the plaintiff, a doctor and

holder of the mark SIGNATURE SKIN, sued Proctor & Gamble for its adoption and use of the mark SKIN SIGNATURE. Despite seeking more than \$2 million in damages and cessation of use of the mark, the plaintiff ultimately dismissed his claims as a result of his lack of ability to show secondary meaning prior to the client's use or registration of its own mark.

- Represented Cosmetic Dermatology, founded by celebrity dermatologist Dr. Brandt, in defense of a trademark infringement action wherein plaintiff was seeking to prevent our client from using the mark "Microdermabrasion in a Jar." After Philosophy filed suit in Arizona, we filed a motion to dismiss for lack of jurisdiction. We then sued Philosophy in the Southern District of Florida as a result of defendant's use of the mark "DEEP CREASE RELEASE," which infringed our client's "CREASE RELEASE" mark. The matter settled on favorable terms for our client.
- Represented CDI, Inc., founded by celebrity dermatologist Dr. Brandt and a provider of high-quality skin care products and dermatological services, in a trademark infringement suit involving the DR. BRANDT mark, against its competitor, Murad, that adopted and improperly used the mark THE DOCTOR BRAND. After mediation ended at an impasse, the defendant filed for summary judgment. After successfully opposing defendant's motion for summary judgment, the case was favorably settled and the Defendant stopped using its infringing mark.
- Represented Cosmetic Dermatology, founded by celebrity dermatologist Dr. Brandt, in a trademark infringement and unfair competition action to prevent one of its competitors, Kiehl's, from using its PORES NO MORE mark. The matter settled on favorable terms for our client.
- Defended Cosmetic Dermatology, Inc. in a trademark infringement action brought by a rival cosmetics manufacturer over the company's use of the marks "Microdermabrasion in a Jar" and "Laser in a Bottle." The plaintiff developed a line of products using the formatives "...in a jar," and "in a bottle." After filing a motion to dismiss the matter was settled favorably thereafter.
- Won summary judgment involving the mark "VIDA VITAL" against a prior senior user of the mark. Our client was able to establish priority in 49 of the 50 states, despite being the junior user. The matter settled on favorable terms for our client.
- Defended claims of trademark and trade dress infringement claims by one fast food restaurant against another fast food restaurant. Claims were made that defendant stole the "look and feel" of the plaintiff's restaurants. After multiple depositions over a 2 year period, the case settled when the principal of our client purchased a controlling interest in the shares of the plaintiff, and then shut down the lawsuit.
- Represented CircleOne Holdings (n/k/a Prosper Marketplace), an online, peer-to-peer, community-oriented marketplace that connects lenders and borrowers using an auction-style underwriting and pricing system. Plaintiff was threatened by defendant/counter-claimant with infringement for its use of the mark, "CircleOne," by a financial services company that used the mark "CircleLending." Plaintiff agreed to change its name as a result of a confidential payment by the defendant.
- Represented E-Loan, Inc., an online lending provider, in a trademark infringement, false advertisement and unfair competition claim against the defendant and its owner. Defendant improperly filed and used the domain name www.eloans.com to divert business away from plaintiff. After contentious litigation, and defendant's failure to provide discovery, we filed an application for, inter alia, terminating sanctions based on defendants' willful violation of the court's discovery order. Thereafter the case was resolved and defendant turned over the domain name to plaintiff.
- Represented E-Loan, Inc., an online lending provider, in a trademark infringement dispute against Eloans Incorporated. Defendant counterclaimed and tried to cancel our client's mark on the basis

that it was generic because client's prior counsel had erroneously disclaimed the word "Loan." The case was favorably resolved in mediation and Defendant stopped using our client's mark.

- Represented E-Loan, an online lending provider, in a, inter alia, false advertising and theft of trade secret information action against a direct competitor in the mortgage refinancing industry. After the defendant's president wrote a defamatory letter to a significant investor of the plaintiff, plaintiff filed an amended complaint and sued the plaintiff's president individually for, among other things, tortious interference and punitive damages. Qfund thereafter submitted to a consent final judgment and order of permanent injunction barring it from imitating the "E-Loan" trademark, and from obtaining, or attempting to obtain, customer information from E-Loan or E-Loan's employees.
- Represented Aeroplan Partners Co., which uses the AEROPLAN mark to provide brokerage services for the purchase and sale of aircraft, aircraft leasing services and services relating to the arranging of aircraft financing. Defendant used the AEROPLAN mark in relation to a frequent flyer program associated with its airline services and argued the mark was likely to be confused. Filed for declaratory relief, and the case was favorably settled with minimal litigation.
- Represented Allied Home Mortgage Capital, a mortgage banking and mortgage brokerage service, against the website www.alliedleads.com, which was using Allied's federally registered trademark and falsely claiming the website was an approved and/or authorized Allied vendor. We filed Lanham Act claims and the court imposed a permanent injunction on the defendant.
- Represented Becca's Closet, a non-profit organization that donates free prom dresses to underprivileged high school girls, in a trademark dispute over the use of the name, "Becca's Closet." The defendant was selling women's clothing under the name of BECCA. Filed for declaratory relief and the case was settled, name intact.
- Defended Credit.com, a credit score reporting service, in a dispute over contract terms governing the sale of an internet domain name to the plaintiff. Plaintiff filed declaratory judgment and breach of contract claims, disputing its agreed fee schedule with Credit.Com for loan applications completed by visitors on the Credit.Com website, and also alleging Credit.Com had not met contractual marketing obligations. Filed counterclaims asserting the plaintiff had frustrated the performance of the contract, withholding marketing fees and violating the exclusivity provisions in the domain agreement. The case was settled and jointly dismissed.
- Represented DVM Pharmaceuticals, a subsidiary of IVAX Pharmaceuticals and a manufacturer of products for veterinary medicine, in a trademark infringement dispute against a competing manufacturer using a DVM trademark for its new product. Defendant counterclaimed to cancel plaintiff's marks. After motion practice and abbreviated discovery, defendant changed its mark and entered into a permanent consent order of injunction recognizing plaintiff's exclusive ownership of the DVM marks.

Class III Medical Product Defense

- Defended Teletronics Pacing Systems from product liability claims relating to allegedly defective Class III implantable defibrillator that was implanted pursuant to an IDE. We obtained summary judgment in district court based upon federal preemption of IDE products. The Judgment of dismissal with prejudice upheld by 6th Circuit on appeal. The plaintiff then took a writ of certiorari to the U.S. Supreme Court, which was accepted. SCOTUS remanded to the 6th Circuit in light of the decision in Lohr v. Medtronic. 518 U.S. 1030. On remand, the 6th Circuit again upheld the dismissal of the lower court based on preemption. 105 F.3d 1090
- Defended the manufacturer of Class III defibrillators and leads against, inter alia, product liability

claims relating to allegedly defective defibrillators and leads. Removed case to federal court and the defendants filed a motion to dismiss an amended complaint based on federal preemption. The magistrate judge only granted dismissal in part. We filed objections to the district court judge who sustained objections and dismissed the entire case with prejudice. 193 F. Supp. 3d 218

- Defended manufacturer of pacemakers against, inter alia, product liability claims relating to an allegedly defective Class III active fixation pacemaker lead that perforated the heart causing a tamponade. The court granted summary judgment in favor of the defendant manufacturer based on the plaintiffs' inability to prove liability on any claim. 259 F. Supp. 2d 27; 270 F. Supp. 2d 9
- Defended Pacesetter, the manufacturer of Class III defibrillators, against, inter alia, product liability claims relating to allegedly defective products. We filed a motion to dismiss or alternative motion for summary judgment based on the doctrine of federal preemption. The court dismissed the complaint and all claims and judgment in favor of Pacesetter was entered. 2008 WL 2637417
- Defended St. Jude Medical, a manufacturer of leads, against, inter alia, product liability claims relating to allegedly defective Class III pacemaker leads. Defendant filed a motion to dismiss the complaint for failure to state a claim upon which relief can be granted. The court granted a motion to dismiss for failure to state a claim and judgment in favor of the defendant was entered and the case was dismissed. 2012 WL 667814
- Defended the manufacturer of allegedly defective Class III cochlear device implanted in child against, inter alia, product liability claims. The manufacturer was the subject of numerous FDA violations, thereby preventing the action from being entirely dismissed on the basis of federal preemption. The court dismissed all claims except those arising as a result of violations of federal law. The case was settled on favorable terms for our client. 2008 WL 3874713
- Defended the manufacturer of allegedly defective Class III defibrillator leads from allegations of negligence, strict liability, etc. The court dismissed the original complaint based on federal preemption and then granted dismissal of the amended complaint, which was again dismissed based on federal preemption, this time with prejudice.
- Defended the manufacturer of Class III defibrillator leads in product liability action. The court dismissed the complaint and then dismissed the amended complaint based on federal preemption grounds. Thereafter, plaintiff voluntarily dismissed the action.
- Defended the manufacturer and sales representative of allegedly defective Class III defibrillator and leads from claims of negligence, strict liability, etc. after the patient had three surgeries resulting from three allegedly defective leads. The court dismissed the original complaint based on federal preemption and then granted dismissal of the amended complaint, which was again dismissed based on federal preemption, this time with prejudice. 2014 WL 2863087
- Defended manufacturer in a wrongful death case relating to a Class III pacemaker whose battery allegedly prematurely failed. We obtained summary judgment at the lower court which was then affirmed by the Washington State Court of Appeals.
- Defended the manufacturer of Class III pacemaker and battery in the wrongful death of a four-year-old girl involving, inter alia, product liability claims relating to the alleged premature failure of the pacemaker battery. The case was removed to federal court and filed a motion to dismiss based upon federal preemption. The district court issued an order granting St. Jude's motion to dismiss, with prejudice (2013 WL 1104427). Thereafter, the plaintiff filed a second-filed action in Baltimore Circuit Court. St. Jude then filed a motion for temporary restraining order in federal court to enforce the federal court's order. While the temporary restraining order was denied, without prejudice, the court

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indicated that it believed that the state circuit court would and should respect the federal court's order and judgment, thereby making an injunction unnecessary (2017 WL 3085693). Thereafter, a motion to dismiss the state court action was filed based on res judicata. The state court agreed and dismissed the state court complaint.

- Defended the manufacturer of Class III defibrillators against, inter alia, product liability claims relating to allegedly defective defibrillators. St. Jude Medical's third motion and memorandum in support to dismiss, or for summary judgment was granted. The plaintiffs' complaint was dismissed with prejudice.
- Defended the manufacturer of Class III pacemakers against, inter alia, product liability claims relating to an allegedly defective pacemaker. We moved for summary judgment based on the doctrine of federal preemption and unavoidably unsafe product. The plaintiff voluntarily dismissed the case after reading the defendant's summary judgment motion.
- Defended the manufacturer of Class III pacemakers against, inter alia, product liability claims relating to an allegedly defective pacemaker. The case was removed to federal court and moved for summary judgment based on, inter alia, federal preemption. The court granted the motion and the case was dismissed.
- Defended the manufacturer of Class III pacemakers against, inter alia, product liability claims relating to an allegedly defective pacemaker. A motion to dismiss was filed based on federal preemption and the case was dismissed with prejudice.
- Defended the manufacturer of pacemakers against, inter alia, product liability claims relating to allegedly defective pacemaker leads. After filing a motion for summary judgment, the matter settled on favorable terms for our client.
- Defended the manufacturer of Class III pacemakers against, inter alia, product liability claims relating to an allegedly defective pacemaker. The case was transferred from the Southern District of New York to the Southern District of Florida. The plaintiff thereafter filed a notice of voluntary dismissal. 1994 WL 361488
- Defended the manufacturer of Class III defibrillators against, inter alia, product liability claims relating to allegedly defective defibrillators. The case was removed to federal court and the defendant moved to dismiss. The court converted the motion to dismiss to a motion for summary judgment and granted same. Judgment was entered in favor of the defendant.