

# Robert M. Isackson

## Selected Cases & Matters

### Patent Litigation

- Road Widener LLC v. Robert Finke & Sons, Inc., Case 1:20-cv-00160 (N.D.N.Y) February 18, 2020. Representing defendant in ongoing patent infringement litigation regarding road construction machinery.
- Novaplast Corporation v. Inplant, LLC et al., Case 2:20-cv-07396 (D.N.J.) June 17, 2020. Representing defendant in ongoing patent infringement litigation regarding prosthetic implant delivery devices. Successfully moved to dismiss the complaint under Rule 12(b)(6). Case is pending.
- Ameziel, Inc. v. Wiesner Products, Inc., Case 1:20-cv-02095 (S.D.N.Y.) March 9, 2020. Represented design patent owner in a declaratory judgment action filed by a competitor and in response to the accused infringer's motion for judgment on the pleadings, persuaded the court sua sponte to dismiss the action. Case later settled on favorable terms.
- Soter Technologies, LLC v. IP Video Corporation et al., Case 1:20-cv-05007 (S.D.N.Y.) June 30, 2020. Successfully defended defendant in a patent and trademark infringement case. The day after suit was filed, with six hours notice, argued and defeated plaintiff's effort to obtain a temporary restraining order against further patent infringement, which argument led to plaintiff dismissing the patent infringement claims from the case. Case since settled on confidential terms.
- Soter Technologies, LLC v. IP Video Corporation et al., Case 2:20-cv-02989 (E.D.N.Y.) July 7, 2020. Representing defendant in ongoing patent infringement action relating to devices that detect vaping and bullying conditions in confined environments.
- EMED Technologies Corporation v. Repro-Med Systems, Inc. d/b/a RMS Medical Products, Case 1-18-cv-05880 (S.D.N.Y.) June 29, 2018. Took over defense of a single patent infringement case in May 2019, after transfer from EDTx. Patent is directed to a sharps protective device for subcutaneous infusion needle sets. Restrategized the case, handled and prevailed on claim construction, and then filed for and prevailed on summary judgment of non-infringement. Moved for declaration of exceptional case and recovery of certain attorney fees and expenses. The magistrate judge issued a Report and Recommendation to award client \$1.0 million in fees and expenses; Plaintiff appealed and we defended; EMED Technologies Corporation v. Repro-Med Systems, Inc., Case 19-2145 (Fed. Cir.) July 16, 2019. Case settled while on appeal



- EMED Technologies Corporation v. Repro-Med Systems, Inc. d/b/a RMS Medical Products, Case 2-15-cv-01167 (EDTX) June 25, 2015. Took over defense of single patent case in May 2019 after claim construction. Claims are directed to a sharps protective device for subcutaneous infusion needle sets. Moved for early summary judgment of non-infringement and prevailed during expert discovery. Motion for exceptional case and recovery of \$2.3 million in attorney fees and expenses was filed, but stayed pending appeal. Defended the appeal and the non-infringement judgment was affirmed in EMED Technologies Corporation v. Repro-Med Systems, Inc., Case 19-2375 (Fed.Cir.) September 9, 2019. Case settled after appeal decision and before the district court ruled on the fee motion.
- Town & Country Linen Corp. et al. v. Ingenious Design, LLC et al. (S.D.N.Y.) June 7, 2018. Lead counsel in action for design patent and copyright infringement, misappropriation of trade secrets (DTSA and NY Law), misappropriation of ideas, quantum meruit, unjust enrichment, breach of contract and tortious interference, regarding design, development, and supply of consumer products. In a rare reversal, the Court granted our motion for reconsideration and reinstated our client's misappropriation of ideas claim that had been improperly dismissed. We subsequently secured dismissal of a number of the defendants' counterclaims and defenses with prejudice and obtained sanctions against defendants to pay our client's attorneys' fees and costs relating to (i) any discovery on a belatedly asserted counterclaim for breach of contract, which counterclaim was then dismissed with prejudice, and (ii) a supplemental expert deposition. The case is pending.
- Midwest Athletics and Sports Alliance LLC v. Xerox Corp., Case 6:19-cv-06036 (W.D.N.Y.) January 11, 2019. Represented accused infringer Xerox in patent infringement case involving twenty (20) patents on copy machine and printing machine technology covering Xerox's commercial product line. Matter is ongoing.
- High Point Design LLC v. Buyer's Direct, Inc. (S.D.N.Y.; Fed. Cir.) Co-lead counsel in an action for design patent and trade dress infringement to help re-strategize the use after prior counsel's grant of summary judgment was reversed on appeal. Identified new dispositive issues, revised prior arguments, and obtained new summary judgments of patent invalidity and non-infringement and dismissal of the trade dress claim. Dismissal of the case was confirmed on appeal.
- Monsanto Company v. Mycogen Corporation (S.D. Cal.) Lead trial counsel in a five-day trial de novo in a patent interference case. Obtained a judgment sustaining Mycogen's patent rights as the first to invent a particular isolated Bt toxin gene.



- *Syngenta Seeds v. Dow AgroSciences, Monsanto and Pioneer Hi-Bred Int'l* (D. Del.) Obtained a complete defense verdict in a patent infringement jury trial case involving insect resistant transgenic corn. Two patents were dismissed as not infringed and the third patent was found invalid by the jury on multiple grounds. Affirmed on appeal.
- *Secured Mail Systems v. Microdynamics Corporation* (C.D. Cal., transferred to N.D. Ill.) Lead trial counsel for Microdynamics defending a patent infringement case involving postal bar code technology to expedite mail processing at lower cost. The California court consolidated several co-pending cases with more than 17 defendants. Successfully engineered a motion to sever the claims against Microdynamics and transfer them to N.D. Ill., leaving the defendants from two other cases behind in California. The case against Microdynamics thereafter promptly settled on confidential terms.
- *CSG Systems v. TOA Technologies* (E.D. Tex., transferred to N.D. Ohio). Lead trial counsel defending TOA in a patent infringement action on cloud-based mobile workforce management technology. Through early discovery, CSG was persuaded to drop one of its two asserted patents. After TOA moved to transfer the case to Ohio, the Texas court held an evidentiary hearing and denied TOA's motion. TOA then sought and obtained a writ of mandamus from the Federal Circuit ordering the case transferred to N.D. Ohio. Shortly after the transfer, the case settled on confidential terms.
- *Biax Corp. v. Intel Corp.* (E.D. Tex.) Represented Intel in a four patent infringement action concerning various microprocessor parallel processing technologies involving Intel's Pentium® 4, Xeon®, Itanium® and Itanium® 2 microprocessors. After winning several critical pretrial motions, including a court order that certain documents BIAx had withheld had to be produced, and just 30 minutes before the opening statements were scheduled to begin in a two-week jury trial, the case was settled.
- *StreamServe v. Exstream Software and Hewlett-Packard* (D. Del.) StreamServe, a Swedish company, pioneered and patented software for transforming input data streams having diverse formats into output data having a uniform file format for publishing. Served as lead trial counsel for StreamServe in a patent action against Exstream and HP on StreamServe's foundational patent. After fact discovery closed, and during expert discovery, the case was settled on confidential terms.
- *Johnson & Johnston Associates Inc. v. R.E. Service, Inc.* (N.D. Cal.) Lead trial counsel in a two-week jury trial, obtaining a jury verdict of willful infringement of a patent concerning copper foil laminate technology used in manufacturing multilayer printed circuit boards, a \$4.3 million judgment (treble damages, attorney fees and costs), and a permanent injunction. Prior to trial, the court

granted summary judgment striking RES's patent invalidity defenses and dismissing as not infringed the four RES patents asserted.

- *Medtronic Inc. v. Synthélabo, Ela Médical and L'Oréal* (D. Minn.) Led the patent team opposing twelve asserted U.S. patents. Settled after a favorable German court infringement ruling in a counter patent suit brought on an Ela patent against Medtronic in Germany.
- *Veritec v. I.D. Matrix* (M.D. Fla.) Lead trial counsel for RVSI/CiMatrix (f.k.a. International Data Matrix, Inc.) in a case involving cross-claims of patent infringement, misappropriation of trade secrets and unfair competition over the rights to the Data Matrix two-dimensional bar code. Quickly developed invalidity and unenforceability defenses to Veritec's patent, and filed summary judgment motions that led to stipulated dismissal of all claims and a favorable settlement.

### **Trade Secret and Technology Litigation**

- *Town & Country Linen Corp. et al. v. Ingenious Design, LLC et al.* (S.D.N.Y.) lead counsel in action for design patent and copyright infringement, misappropriation of trade secrets (DTSA and NY Law), misappropriation of ideas, quantum meruit, unjust enrichment, breach of contract and tortious interference, regarding design, development, and supply of consumer products. The case is pending.
- *Alenia Aermacchi v. Rohr Inc.* (American Arbitration Association) Led the IP team in arbitration over contract and IP disputes related to advanced composite material aircraft components. Settled on favorable terms prior to hearing.
- *Platt v. Bayer Corp.* (C.D. Cal.) Alleged misappropriation of trade secrets and breach of fiduciary duty regarding Bayer's Aleve Cold & Sinus® product. Obtained voluntary dismissal of trade secret claims and, following key deposition, a settlement on favorable terms.

### **Trademark Litigation**

- *Soter Technologies, LLC v. IP Video Corporation et al.*, Case 1:20-cv-05007 (S.D.N.Y.) June 30, 2020. In an action for cybersquatting, trademark infringement, unfair competition and product disparagement, successfully defended defendant in a patent and trademark infringement case. The day after suit was filed, with six hours notice, argued and defeated plaintiff's effort to obtain a broad temporary restraining order against further commercial activity, prevailed in part in subsequent motion practice to dismiss certain of plaintiff's trademark infringement and unfair competition claims, and filed a counterclaim for false advertising. The case since settled on confidential terms.



- Innerwear Basics LLC v. Arelia-Alpha International, TTAB Proceeding No.: 92071841, July 24, 2019. Representing applicant in a proceeding to cancel a trademark registration on BRA BAR. The matter is pending.
- Delta Funding, Inc. v. Delta Air Lines (S.D.N.Y) Represented Delta Air Lines, Inc. in a cybersquatting case over rights to the URL [www.delta.com](http://www.delta.com). Case settled on favorable terms during expert discovery.
- Represented Federation Internationale de l'Automobile (FIA) in connection with its efforts to protest its Formula 4 marks in light of FIA's announcement that it will commence a FIA sanctioned Formula 4 Championship Series for the United States in 2016. FIA's rights were protected without need for litigation.