

# DOUGLAS A. ROBINSON

PRINCIPAL / ST. LOUIS METRO OFFICE

Doug's practice is focused on intellectual property contested matters in the areas of patents, trade secrets and trademarks. His experience includes all aspects of federal IP litigation, in numerous district courts and across the country.

A precise advocate and experienced negotiator, Doug's expertise spans every phase of the dispute resolution process, from pre-suit investigation through appeal. A large portion of Doug's practice is devoted to *Inter Partes* Review and other proceedings before the USPTO, where he is admitted as a Patent Attorney. He has also served as litigation counsel in numerous cases under the Hatch-Waxman Act and on behalf of various generic pharmaceutical companies. In addition, Doug counsels his clients on legal opinions, including freedom-to-practice, validity and infringement opinions.

## PRACTICE AREAS

IP Litigation; PTAB Proceedings

## INDUSTRIES

Automotive, Aerospace & Transportation; Chemistry & Materials Science; Consumer Electronics; Electrical, Computer & Internet; Manufacturing; Mechanical & Electromechanical; Medical Devices; Pharmaceutical & Biotechnology; Telecommunications & Wireless Technology

## KEY MATTERS

- *Thermapure, Inc. v. RxHeat™, LLC and Cambridge Engineering, Inc.* (N.D. Ill.) Ongoing representation of RxHeat and Cambridge Engineering in defense of patent infringement allegations regarding Thermapure's patent regarding heat-based pest remediation devices and methods; obtained favorable summary judgment ruling of non-infringement and successful *Daubert* challenge of patentee's expert. Cite: F. Supp. 2d 2014 WL 1304036 (N.D.ILL).
- *Sunless, Inc. v. Heartland Tanning, Inc.* (W.D. Mo. and PTAB) Defended Heartland Tanning against patent infringement lawsuit brought by Sunless concerning spray tanning booths. The case ended with a favorable settlement following institution of *Inter Partes* Review on petition filed for Heartland Tanning and successful



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motion to transfer venue from the Eastern District of Texas to Heartland Tanning's home forum.

- *Interactive Fitness Holdings, LLC v. ICON Health & Fitness, Inc.* (D. Utah) Representation of Interactive Fitness in defense against ICON's assertion of patent infringement; obtained favorable summary judgment rulings of patent non-infringement and patent invalidity. Cite: 2013 WL 687126.
- *MT. Derm v. Bomtech Electronics Co., Ltd.* (E.D.N.Y. and PTAB) Lead counsel representation of Bomtech in patent infringement litigation concerning tattoo and permanent make-up devices. The case ended with a favorable settlement following institution of an *Inter Partes* Review proceeding filed for Bomtech.
- *MT. Derm v. CONNECT, Inc.* (D. Nevada) Ongoing lead counsel representation of CONNECT in patent infringement litigation concerning tattoo and permanent make-up devices.
- *Hansen Manufacturing Corp. v. Enduro Systems, Inc.* (D. South Dakota) Ongoing representation of Hansen regarding Enduro's accused infringement of Hansen's patent covering an enclosed conveyor belt system. Doug's representation of Hansen also includes successful defense of ex parte patent reexamination proceeding instituted by Enduro.
- *Microwave Vision, S.A., et al. v. ETS-Lindgren Inc. & ESCO Techs. Inc.* (N.D. Ga) Ongoing representation of ETS-Lindgren and ESCO in patent infringement litigation concerning antenna testing technology.
- *Laird Techs., Inc. v. GrafTech Int'l Holdings Inc.* (PTAB) Ongoing representation of Laird in multiple *Inter Partes* Review proceedings concerning heat dissipation technology.
- *Athena Automation Ltd. v. Husky Injection Molding Sys. Ltd.* (PTAB) Defense of *Inter Partes* Review proceedings concerning injection molding machines.
- *Clearlamp, LLC v. LKQ Corp.* (N.D. Ill.) Ongoing representation of Clearlamp regarding LKQ's accused infringement of Clearlamp's patented vehicle light refurbishing process. Also included successful defense of patent-in-issue in an *Inter Partes* Review proceeding instituted by LKQ.
- *Gibson Guitar Corp. v. '745, LLC*: Defended '745 against patent infringement lawsuit brought by Gibson Guitar Corp. regarding a virtual music reality system. After a two-day Markman hearing, '745 secured a claim construction ruling construing four terms in '745's favor. Gibson filed a dismissal with prejudice following the ruling. Cite: 2012 WL 90445 (M.D. TN).
- *Propex Operating Company, LLC v. Western Excelsior Corporation*: Propex sued Western Excelsior for patent infringement for trade dress infringement based on Western Excelsior's soil erosion fabrics. Propex also sought a preliminary injunction. Harness Dickey successfully represented Western Excelsior, defeating the Motion for Preliminary Injunction. Following the Markman hearing, Western Excelsior prevailed on all three claim terms in dispute. Propex dismissed its lawsuit with prejudice. Cite: 2011 WL 310195 (E.D.

TN).

- *Snap On v. Hunter Engineering*: Under an arbitration agreement, Snap On initiated arbitration claims against Hunter for infringement of U.S. Patent No. 7,953,247. Harness Dickey assisted Hunter in developing defenses to the allegations. Following a day-long meeting between the parties, Snap On withdrew its allegations, with preclusive effect of asserting the patent against Hunter in the future.
- *Hunter Engineering v. Snap-On*: Representation of Hunter in patent arbitration regarding Hunter's revolutionary balancer technology. Following a week-long trial, the arbitrator awarded Hunter seven figure compensation based on an above industry average 7% royalty rate, and further ordered Snap-On to pay attorneys' fees and all arbitration costs.
- *Discus Dental, LLC v. Triumph Pharmaceuticals Inc. (C.D. CA)*: Representation of Triumph. Obtained partial grant of summary judgment in a false advertising case regarding claims that its mouthwash prevented bad breath 12 times longer than any other mouthwash. The favorable ruling gave Triumph a significant advantage in the litigation, resulting in a favorable settlement shortly after the ruling.

## NEWS/EVENTS

Doug is regularly asked to comment on pending Hatch-Waxman litigation for industry publications. Articles in which Doug has been quoted include the following:

- Otuska/BMS's Abilify: Strong inequitable conduct challenge presented by generics at trial faces uphill battle
- Somaxon's patents for newly launched insomnia drug Silenor seen as unlikely to survive potential generic ANDA challenge
- Shire's Patents for ADD drug Intuniv may be vulnerable to generic design-around in ongoing ANDA litigations
- Roche/Genentech seen as likely to prevail in proving that Herceptin does not infringe GSK's patents in ongoing litigation

## IN THE NEWS

- Doug Robinson Discusses Importance of Real Parties-in-Interest with Law360
- Harness Dickey Principal Doug Robinson Talks Patent "Shootouts" with Law360
- "Fed. Circ. Highlights Peril Of Using 'Common Sense' At PTAB," Law360, August 15, 2016
- Harness Dickey Elects Six New Principals, January 8, 2013

## EVENTS

- Doug Robinson to Lead CLE Presentation on New Issues in Inter Partes Reviews

## PUBLICATIONS

### ARTICLES

- Doug Robinson Discusses Pharma Distribution After Lexmark Case
- “Deposition In Inter Partes Review Is A Different Animal,” *Law360*, December 15, 2014

### BLOGS

- District Court Orders Petitioner to Seek Termination of IPR based on Forum Selection Clause
- The Ever-Shrinking IPR Estoppel
- Federal Circuit Reverses PTAB for Refusing to Allow Supplementation of Record to Add Later Inconsistent Deposition Testimony from an Expert
- News Alert: Precedential Patent and Trademark Order by the Federal Circuit
- Supreme Court to Decide Constitutionality of AIA Reviews
- Supreme Court Affirms Strength of First Sale Doctrine

## BACKGROUND

Doug is dedicated to understanding his client’s broader objectives. Doug’s clients appreciate that he *knows the law, inside and out*, and as a result, is able to deliver immediate and understandable answers. His *attention to detail* and *responsiveness* is the result of more than a decade of practical experience. He consistently maintains perspective on how the law fits into the larger commercial strategy.

Doug’s technological experience is broad, and includes pharmaceuticals, chemicals, biologics, satellite communications equipment, exercise equipment, medical devices, pest and mold remediation technology, automated meter reading systems, injection molding machines, vehicle parts refurbishing, spray tanning booths, heatsinks for electronics, and antenna testing equipment.

Prior to joining Harness Dickey, Doug worked in the Chicago office of a large IP firm.

## **AWARDS & DISTINCTIONS**

- *Best Lawyers*, Litigation — Patent, 2017-2018
- *Missouri Lawyers Weekly*, “Up and Coming Lawyer,” 2013
- *Kansas Super Lawyers* “Rising Star,” 2013
- *Missouri Super Lawyers* “Rising Star,” 2013-2014
- Order of the Coif, Washington University School of Law, awarded to Top 10% of graduating class
- *Washington University Law Quarterly* (now *Washington University Law Review*), Executive Articles Editor
- Mary Collier Hitchcock Prize for best Note in *Washington University Law Quarterly*, 2004
- Awards for Excellence in Intellectual Property Law, Insurance and American Legal History

## **EDUCATION**

J.D., Washington University in St. Louis, 2004

- Order of the Coif, Top 7%

B.S., Biochemistry and Chemistry minor, *cum laude*, University of Missouri, 2000

## **BAR & COURT ADMISSIONS**

Missouri

Illinois

U.S. Patent and Trademark Office