



New Jersey Intellectual Property Law Association 26th Annual Pharmaceutical / Chemical Patent Practice Update

ON JUDICIAL REVIEW OF PTO ACTIONS



- RIGHTS OF ACTION
 - Administrative Procedure Act
 - Patent Act Review Provisions
 - Infringement Remedial Provisions
- ARTICLE III STANDARDS
 - Supreme Court 3-Part Test: Injury in Fact; Causation; Redressability
 - Federal Circuit 2-Part Test: Apprehension; Steps Taken
 - Standing Versus Mootness Standards
 - Already v. Nike
- TWO TYPES OF "INJURY IN FACT"
 - Apprehension
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James W. Dabney is a litigation partner and head of the Firm's Intellectual Property and Technology practice group. He has successfully handled jury and non-jury trials; arbitrations; preliminary injunction proceedings; PTO administrative proceedings, and appeals involving patents, trademarks, and other intellectual property rights. Mr. Dabney is also an Adjunct Professor at Cornell Law School. Prior to joining Fried Frank, Mr. Dabney was a partner at Pennie & Edmonds LLP between 1989 and 2003.

Mr. Dabney's litigation career highlights include:

- *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) (arguing counsel for the prevailing defendant/petitioner in the Supreme Court and in both lower courts; winning reversal of Federal Circuit and judgment of patent invalidity)
- *Holmes Group Inc. v. Vornado Air Circulation Sys., Inc.*, 535 U.S. 826 (2002) (arguing counsel for the prevailing plaintiff/petitioner in the Supreme Court and in both lower courts; winning reversal of Federal Circuit judgment and eventual reinstatement of summary judgment of trade dress invalidity)
- *Rosenruist-Gestao e Servicos LDA v. Virgin Enters. Ltd.*, 511 F.3d 437 (4th Cir. 2007), *cert. denied*, 553 U.S. 1065 (2008) (counsel for prevailing defendant/respondent in the Supreme Court and both lower courts; winning reversal of trial court decision interpreting 35 U.S.C. § 24 and eventual judgment sustaining opposition to registration)
- *Pregis Corp. v. Doll and Free-Flow Packaging Int'l, Inc.*, No. 1:09CV467 (E.D. Va. Apr. 27, 2010) (won patent jury trial; all 23 asserted claims held invalid for obviousness, not infringed, or both).
- *eSpeed, Inc. v. BrokerTec USA, LLC*; 404 F. Supp. 2d 575 (D. Del. 2005), *aff'd*, 480 F.3d 1129 (Fed. Cir. 2007) (won patent jury trial; all 4 asserted claims held invalid for insufficient written description)

Mr. Dabney was appointed to the faculty of Cornell Law School in 2011 and teaches an advanced patent law seminar there. Mr. Dabney has also lectured on patent law to professional audiences throughout the United States and in Europe including three invited lectures to European Patent Office examiners and directors in The Hague (2006, 2010) and in Munich (2007).

Mr. Dabney was elected to membership in the American Law Institute at the age of 38. He holds an AV Preeminent 5 out of 5 ranking in *Martindale-Hubbell*. He is recognized in *U.S. News/Best Lawyers* as a leading individual in the field of intellectual property law; he is recognized in *Chambers USA* as a leading individual in the field of patent law; he is recognized in *Benchmark: Litigation* as a New York Litigation Star; and he is recognized in *SuperLawyers* as a leading individual in the fields of intellectual property litigation and business litigation.

Mr. Dabney served as a law clerk to the Hon. James C. Hill, United States Court of Appeals for the Fifth Circuit in Atlanta, Georgia. He received his JD, *magna cum laude*, in 1979 from Cornell Law School, where he was a member of the Order of the Coif and the Board of Editors of the *Cornell Law Review*. Mr. Dabney received his AB, *magna cum laude*, from Harvard College in 1976. He is admitted to the bar in New York (1980) and New Jersey (1981) and to practice before the Supreme Court of the United States (1987) and numerous Circuit and federal district courts throughout the country.