

IP Group Of The Year: Hughes Hubbard

By Tiffany Hu

Law360, New York (January 26, 2018, 3:19 PM EST) -- Hughes Hubbard & Reed LLP scored a win for TC Heartland LLC this year in a major patent case that overturned 30 years of established precedent and marked an integral landmark in patent litigation history, landing the firm a spot among Law360's 2017 Intellectual Property Groups of the Year.

In its May decision, the U.S. Supreme Court reversed a Federal Circuit rule that essentially allowed patent owners to file infringement suits anywhere a defendant does business, in a ruling that substantially narrowed the venues where a company can be required to defend against claims of infringement in the U.S.

TC Heartland challenged the rule after Kraft Foods Group LLC filed suit in Delaware in 2014, accusing the company of infringing patents for artificial sweeteners. TC Heartland had unsuccessfully tried to have the case moved to Indiana, where it is based.

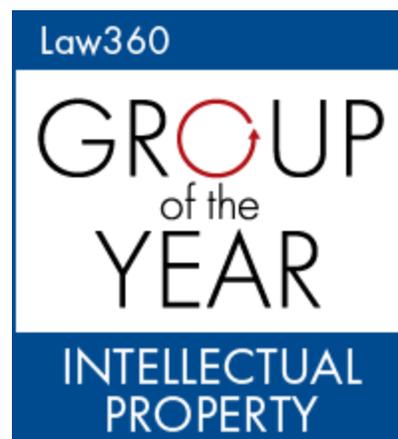
While the Supreme Court had previously held that a patent lawsuit may be filed at the defendant's place of incorporation or where it has a regular and established place of business, the Federal Circuit in 1990 vied for a broader interpretation, which expanded the rule on patent litigation venue. The justices rejected that Federal Circuit interpretation in May 2017, leading to a drop in cases filed post-decision in venues known to favor patent owners.

James Dabney, the lead counsel for TC Heartland, said the case was one that "distinguishes the Hughes Hubbard approach to the practice of patent law."

"We have schooled ourselves in [patent] law not only as it existed in the last 35 years, but as it existed in the last 200 years," Dabney told Law360. "That perspective comes with insights that can profitably be put in service, and I think the TC Heartland cases are just an example of that."

Notably, Hughes Hubbard represented TC Heartland not only before the Supreme Court, but in both lower courts and in parallel inter partes review proceedings before the U.S. Patent and Trademark Office.

"It takes a tremendous amount of work to become knowledgeable of the procedures and habits and bodies of law, and the principles prevalent in those three fora," Dabney said. "I honestly do think that



the trial practice is a great aid to being effective as an appellate advocate, and my academic work also contributes importantly to our ability to be effective in the court.”

Hughes Hubbard also secured a victory for Costco Wholesale Corp. this past year, in a case that Dabney called “noteworthy” in its outcome. Robert Bosch LLC had filed suits against multiple companies accusing them of infringing patents for a flat windshield apparatus originally issued to Robert Bosch GmbH, who had assigned the patents to the subsidiary and named plaintiff to the suit.

Prior litigants had unsuccessfully fought them off, Dabney said, adding that Costco was one of the last companies to be sued by Bosch. Dabney successfully persuaded the district court to impose sanctions after the subsidiary failed to timely produce discovery documents held in the name of its German parent. While the parties have entered into a settlement agreement and the infringement suit was dismissed with prejudice in June 2017, Bosch continues to appeal its losses in the inter partes review proceedings.

“It is not an easy thing to require an overseas entity to produce party discovery,” Dabney said, adding that he has often found himself dealing with abuses of the corporate forum. “It may seem like a mundane issue, but I see this over and over again.”

Hughes Hubbard’s IP group has 16 attorneys, a modest size in comparison to the numbers in other practice groups. But, as partner Stephen Rabinowitz told Law360, the firm’s victories in cases like TC Heartland “illustrate the innovative approach” the team takes to patent litigation.

--Editing by Alyssa Miller.