

# THE NATIONAL LAW JOURNAL

MAY 7, 2012

An **ALM** Publication

A SPECIAL REPORT

## INTELLECTUAL PROPERTY HOT LIST

**EDITOR'S NOTE:** In this issue, *The National Law Journal* launches its first Intellectual Property Hot List. These 20 firms excel in providing patent, copyright and trademark legal services. They have demonstrated creative strategies for litigation, patent prosecution, licensing and other transactional work. Each firm has shown itself to be an innovator in applying legal principles to fast-changing technology. —Ruth Singleton

# BANNER & WITCOFF

# INTELLECTUAL PROPERTY HOT LIST

## BANNER & WITCOFF

It was a banner year for intellectual property firm Banner & Witcoff, where lawyers racked up significant wins at the International Trade Commission and the U.S. Court of Appeals for the Federal Circuit, as well as continuing to dominate design patent prosecution at the U.S. Patent and Trademark Office.

Printer maker Lexmark International Inc. turned to the firm for help with an ITC dispute over knockoff toner cartridges. Even by ITC standards, the case was huge, involving 15 patents and 23 respondents. A team of Banner lawyers led by Timothy Meece in September won a rare prize—a general exclusion order banning the importation of all unlicensed toner cartridges (as opposed to a limited exclusion order directed at specific respondents).

“It was a huge win for our clients,” said Meece, who worked with Banner lawyers including V. Bryan Medlock Jr. on the case. “When you have counterfeit and cloned [products] and illegal manufacturing harming our American client, it was a big deal.”

Meece scored another victory for Lexmark in Florida federal court in December, with the dismissal of a \$500 million false patent marking suit brought by Advanced Cartridge Technologies.

Banner lawyers also had a notable win on behalf of shoemaker Nike Inc. last summer. Nike and other defendants were sued by patent troll Furnace Brook LLC (characterized as such by a Utah federal court), which alleged that the companies’ online ordering sites infringed its patent.

But Furnace Brook had already brought—and lost—similar litigation against Overstock.com Inc. Banner partner Christopher Renk said Furnace was aiming for “early and quick settlement money....We said no, based on what the patent covered in the first case. We were not going to throw money in the cup.”

Renk successfully argued that

Furnace was collaterally estopped from relitigating the same issue—and he was able to persuade the court to decide the case based on an early motion, before any discovery took place. “We provided the defendant with a strategy short of going full out and spending a lot of money when they know they didn’t do anything wrong,” Renk said.

Banner & Witcoff also continued its dominance in design patent prosecution, procuring more design patents than any other law firm for the ninth year in a row. Working on behalf of clients including Electrolux USA, Microsoft Corp., Nokia Corp., PepsiCo Inc. and Toshiba Corp., Banner lawyers obtained 543 U.S. design patents in 2011—more than the combined totals of the second- and third-place firms.

—JENNA GREENE