

**Sanjay K. Murthy**

Attorney
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A nationally recognized trial attorney who has been involved in over 15 trials, Sanjay has deep experience representing leading life science and technology companies in federal district courts, before the Patent Trial and Appeal Board, and in Section 337 investigations in the U.S. International Trade Commission (ITC). He leverages his trial experience to assist his clients with freedom-to-operate matters, due diligence investigations, patent portfolio audits, and licensing and collaboration transactions.

Sanjay has been honored as a leading practitioner by a number of publications, including IAM Patent 1000, The Legal 500, and Managing Intellectual Property. He's also been recognized by The American Lawyer, LMG Life Sciences and Crain's Chicago Business for helping his clients secure trial victories.

Sanjay has experience working on a wide range of technologies, such as pharmaceuticals (e.g., small molecules and antibodies), medical devices (e.g., dialysis machines, drug infusion pumps, and stent grafts), methods for manufacturing recombinant proteins (e.g., Factor VIII and alpha-1 antitrypsin), cell-based therapeutics (CAR-T cells and stem cells), organic/polymer chemistry, power tools, oil drilling fluids, digital cameras, smart phones, and automotive components.

Sanjay has an active pro bono practice. He worked with teams to reunite children separated from their parents by Immigration Customs Enforcement (ICE), force the release of numerous families detained by ICE in facilities threatened by COVID-19, and obtain significant monetary settlements for prisoners in civil rights cases.

Education

Loyola University
1997, B.S., Biology

California Western School of Law
2000, J.D.

The George Washington University Law School
2003, L.L.M.

Admissions

Bar Admissions

Illinois
California

Court Admissions

U.S. Supreme Court
U.S. Patent and Trademark Office
U.S. Court of Appeals for the Federal Circuit
U.S. Court of Appeals for the Ninth Circuit
U.S. District Court for the Central District of California
U.S. District Court for the Northern District of California

U.S. District Court for the Southern District of California
U.S. District Court for the Northern District of Illinois, Trial Bar
U.S. District Court for the Eastern District of Michigan
U.S. District Court for the Eastern District of Texas

Practices

Appellate Litigation
Counseling, Opinions + Licensing
Jury Trials
Litigation
PTAB Litigation
Section 337/ITC Litigation

Industries

Chemistry + Chemical Engineering
Electrical + Computer Technologies
Life Sciences + Pharmaceuticals
Medical Devices

Accolades

- Recommended, Intellectual property: Patents: litigation (full coverage), The Legal 500 US (2020, 2021)
- Recognized, IAM Patent 1000: The World's Leading Patent Professionals (2020)
- Recognized, IP Patent Star – Illinois, Managing Intellectual Property (2020)
- Named, "Litigator of the Week," The American Lawyer (2019)
- Named, "Most Influential Minority Lawyers in Chicago," Crain's Chicago Business (2017)

Representative Matters

- Trial and appellate counsel for Praxair, Inc. in two-week ANDA case against Mallinckrodt Pharmaceuticals involving 11 patents related to pharmaceutical product (INOMAX) and associated delivery system, a product with revenue of over \$400 million. The district court ruled that five of the asserted patents were invalid and the other six asserted patents were not infringed, resulting in a complete victory. The judgment was affirmed on appeal in 2019 and Sanjay, and other team members, was recognized as a "Litigator of the Week" by The American Lawyer. The firm received "Hatch-Waxman Impact Case of the Year" for this victory at the 2020 LMG Life Sciences
- Leading patent portfolio audit team for global pharmaceutical company on its small molecule compound for preventing acquired resistance in cancers.
- Led patent portfolio audit team for one of the world's largest pharmaceutical companies on its blockbuster antibody treatment for lupus.
- Trial counsel for Milwaukee Electric Tool Corp. in a two-week jury trial regarding lithium-ion battery technology in the Eastern District of Wisconsin. The jury returned a verdict finding entirely in Milwaukee Tool's favor, awarding damages of \$27.8 million and finding defendant's infringement was willful. This was identified as one of the "Top 100 Verdicts of 2017" by ALM.
- Appellate counsel for Praxair, Inc. before the Federal Circuit in an appeal from an *inter partes* review proceeding involving an Orange Book listed patent on methods of use for INOMAX. In a precedential opinion, the Federal Circuit ruled entirely in Praxair's favor on its appeal and rejected Mallinckrodt's cross-appeal.
- Trial counsel representing Baxalta, Inc. (a Shire/Takeda subsidiary) in the ITC in dispute regarding method of manufacturing recombinant factor VIII (ADVATE), a billion dollar pharmaceutical product. Successfully obtained summary determination of infringement before the final hearing. The case settled favorably after the ITC ruled in client's favor on domestic industry on appeal.
- Lead trial counsel for Neuralstem, Inc. in a one-week bench trial on the issue of patent ownership and inventorship in a case involving six patents dealing with neural stem cells. The district court ruled in Neuralstem's favor on both issues, ordered that an unnamed inventor be added to the patents-in-suit, and dismissed the plaintiff's patent infringement complaint for lack of standing with prejudice. The plaintiff, StemCells, Inc., was seeking an injunction and \$60 million in damages and recovered nothing.
- Trial counsel for Sigma International (a Baxter Healthcare subsidiary) in a two-week jury trial in the Southern District of California resulting in a verdict of noninfringement of a patent relating to intravenous infusion pump technology. The plaintiff, CareFusion 303, Inc., was seeking more than \$170 million in damages and recovered nothing. During pretrial, successfully obtained summary judgment on CareFusion's damages theories based on the entire market value rule.

The case was named a 2012 top defense verdict in California by the Daily Journal.

Representative USPTO/European Experience

- IPR2019-00552-553—Lead counsel for Valeritas, Inc. against Roche Diabetes Care related to patent on insulin drug pump. Case settled favorably after Roche disclaimed asserted claims.
- IPR2015-00529—Lead counsel for petitioner Praxair, Inc. related to Orange Book listed patent on methods of use related to INOMAX (inhaled nitric oxide) and invalidated all claims on a product with \$400 million in annual sales revenue.
- IPR2015-01722—Lead counsel for Petitioner Endologix, Inc. related to a patent on abdominal aortic stent. Case settled favorably after trial was instituted.
- IPR2014-00899—Lead counsel for petitioners Kamada, Ltd. resulting in complete invalidation of patent covering PROLASTIN®-C (alpha1-proteinase inhibitor [human]), a product with \$500 million in sales. The patent owner chose not to pursue its appeal to the Federal Circuit.
- BTG International Ltd. v. Edwards Lifesciences Germany GmbH et al.—Advised the accused infringer in German nullity action obtaining complete cancellation of asserted patent claims.

*Sanjay handled some of these matters prior to joining Banner Witcoff.

Affiliations/Memberships

Member, American Intellectual Property Law Association
Member, Intellectual Property Law Association of Chicago
Member, PTAB Bar Association

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NEWS - 07.01.21

Nationally Recognized Trial Lawyer Sanjay Murthy Joins Banner Witcoff's Chicago Office