



Abhishek Bapna

Counsel

abapna@pbwt.com

212.336.2617

Abhishek Bapna is Counsel in the firm's Litigation department. His practice focuses on patent litigation in federal district courts and the International Trade Commission (ITC), as well as post-grant proceedings in the U.S. Patent and Trademark Office. His experience encompasses a broad spectrum of technologies, including software, consumer electronics, networking devices, biomedical devices, and vehicular safety telematics systems, and multimedia systems.

Representative Matters

Represented global enterprise software company in landmark action for trade secret misappropriation against major competitor. (Va. Fairfax Cir.). Following seven-week trial, jury found that defendant misappropriated client's trade secrets and violated the Virginia Computer Crimes Act, and awarded client over \$2 billion in damages.

Represented leading medical device manufacturer in assertion of patent directed to ultrasonic surgical devices. (S.D. Ohio). Following favorable claim construction ruling, obtained grant of summary judgment of infringement and lack of available non-infringing alternatives, as well as denial of defendants' motion for summary judgment of invalidity. Case settled favorably on eve of trial with substantial payment to client.

Defended leading medical device manufacturer against allegations of infringement of numerous patents directed to advanced bipolar electrosurgical devices. (D. Mass.). Obtained stipulations of dismissal of several asserted patents prior to trial. All asserted claims of remaining patents were found not infringed after two-week bench trial, resulting in significant victory for our client.

Defended endodontic equipment manufacturer against allegations of infringement of patents directed to methods of making nickel titanium endodontic instruments. (E.D. Tenn./PTAB). In *inter partes* ("IPR") and post grant review ("PGR") proceedings initiated after district court action was filed, all challenged claims of two related patents were found unpatentable on multiple grounds. IPR unpatentability decision was affirmed by Federal Circuit. Patent Owner withdrew initial appeal of PGR unpatentability decision, resulting in final judgment that all challenged claims of second patent were also unpatentable.

Defended leading mobile device manufacturer against allegations of infringement of patents directed to smartphone operating systems and touchscreen hardware. (ITC). Obtained final determination of non-infringement and/or invalidity of each asserted patent.

Defended leading foreign automobile manufacturer against allegations of infringement of over 25 patents directed to safety, telematics, and multimedia systems. (E.D. Tex./PTAB). Obtained grant of writ of mandamus by Federal Circuit ordering E.D.

Tex. to transfer case to E.D. Mich. Filed multiple petitions for IPR, which resulted in over 100 patent claims being found unpatentable. Obtained dismissal of all claims thereafter.

Defended dental supply company against allegations of trade secret misappropriation. (Tenn. Wash. Circ.). Obtained dismissal of all claims.

Defended leading consumer electronics manufacturer against allegations of infringement of patents directed to semiconductor devices (W.D. Tex.). Case settled favorably prior to claim construction.

Admissions

- U.S. Patent and Trademark Office
- U.S. District Court, Southern District of New York
- U.S. Court of Appeals, Federal Circuit
- New York
- New Jersey

Languages

- Hindi

Professional Activities

Member: New York Intellectual Property Law Association, Asian American Bar Association of New York

Publications

- Co-Author, "Federal Circuit Affirms District Court's Decision That an Artificial Intelligence Software System Cannot Be Listed as an Inventor on a Patent Application" *Law Journal Newsletters, The Intellectual Property Strategist* (September 2022)
- Co-Author, "Federal Circuit Clarifies Pleading Requirements for Patent Cases and Affirms Grant of Summary Judgement of Invalidity Under 35 U.S.C. §101" *Law Journal Newsletters, The Intellectual Property Strategist*, (September 2021)
- Co-Author, "Federal Circuit: ITC Did Not Err in Denying Non-Respondent's Petition to Rescind Exclusion Order Based on Invalidity Grounds" *Law Journal Newsletters, The Intellectual Property Strategist*, (September 2020)
- Co-Author, "Federal Circuit Finds District Court Erred in Analysis of Motivation to Combine Prior Art References, Yet Affirms Ultimate Conclusion of Non-obviousness Due to the Lack of a Reasonable Expectation of Success" *Law Journal Newsletters, The Intellectual Property Strategist*, (July 2019)
- Co-Author, "Federal Circuit Remands for Further Proceedings to Determine Whether RPX's Petitions for IPR Were Time Barred For Failing to Identify Its Client As a 'Real Party in Interest'" *Law Journal Newsletters, The Intellectual Property Strategist*, (September 2018)
- "U.S. Patent and Trademark Office Strategic Objectives," A. Bapna, P. Thurlow; *The New York Intellectual Property Law Association Bulletin* (March 2010)
- "New Standard Contractual Clauses for Data Transfers Out of EU Raise Concerns," A. Bapna, G. Chen, M. Paez; Bloomberg BNA's *International World Communications Regulation Report* (August 1, 2010)

Education

- Columbia Law School (J.D.)
 - *The Columbia Science and Technology Law Review*, Editor
- Cornell University (B.S., Electrical and Computer Engineering)

Publications

September 9, 2021

Federal Circuit Clarifies Pleading Requirements for Patent Cases and Affirms Grant of Summary Judgment of Invalidity Under 35 U.S.C. §101

The Intellectual Property Strategist

September 14, 2020

Federal Circuit: ITC Did Not Err in Denying Non-Respondent's Petition to Rescind Exclusion Order Based on Invalidity Grounds (September 2020)

The Intellectual Property Strategist