



STEVEN E. FELDMAN

PARTNER



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Steven E. Feldman is the head of Hahn Loeser's Intellectual Property Practice Area and the Partner-in-Charge of the firm's Chicago office. He focuses his practice on complex intellectual property litigation, prosecution and counseling involving patents, trade secrets, trademarks and unfair competition, copyrights and associated licensing and due diligence, both domestically and internationally. A seasoned trial lawyer and patent attorney, Steve has taken a lead role in trials, Markman hearings and appeals. Steve also regularly supports clients on corporate transactions and due diligence and helps clients to build and manage strategic patent and trademark portfolios worldwide.

A licensed patent attorney with a background in materials science and engineering, Steve's practice encompasses litigating, prosecuting and licensing matters across a wide variety of pharmaceutical, medical, chemical and materials related technologies. These technologies include steel, aluminum alloys with nano-particulate additives, NiCoCrALY based coatings and superalloys, heat treatments, rare earth magnets, and polymer materials and additives; printing and color pigments, color management software, and hardware high brightness LEDs and other lighting technologies; semiconductor lasers; automotive and aerospace parts and systems; receivers and transmission devices, computer hard-disk drives and brushless direct current motors, computer source code and call center/e-commerce technology; alternative energy technologies including clean coal, biofuels, ethanol processing and solar cells; and medical diagnostic and analytical devices.

Steve has extensive experience litigating chemical and pharmaceutical cases at the trial and appellate levels, including cases involving Hatch-Waxman patent infringement litigation pertaining to prescription pharmaceuticals. He has taken a lead role in cases involving a number of major drugs, including invalidating patents relating to Norvasc, Boniva and Actonel. Other cases of note include the drugs Floxin Otic (which resulted in a \$5 million award to a generic client), Actonel®, Antara®, Aripiprazole OLSO®, Boniva®, Uroxatral®, Eloxatin®, Ultracet®, Omnaris®, Benicar®, Lotrel®, Zometa®, Reclast®, Treanda® and Plavix.

In addition, Steve provides strategic counseling regarding Food and Drug Administration marketing exclusivities arising out of Abbreviated New Drug Application (ANDA) patent infringement litigation and has litigated such matters in the U.S. District Court, District of Columbia, and the U.S. Court of Appeals, District of Columbia Circuit. He has overseen large-scale patent licensing



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programs in the pharmaceutical and biotechnology areas and has experience with related FTC and antitrust issues arising out of pharmaceutical settlements.

Steve also regularly advises medical and analytic instrument manufacturers, research medical centers, certification boards and doctors concerning a variety of intellectual property issues, and has served on the faculty of the American Congress of Neurological Surgeons (2009-10). Steve's experience encompasses a wide range of medical and diagnostic device technologies, including cancer and other diagnostic assays, surgical tools, dialysis machines, radio frequency (RF) steering mechanisms and locating systems, surgical robots, MRI, CAT scan and PET imaging devices, ultrasonic imaging systems, healthcare management tools, and dental implants and devices.

Steve's practice also includes representing clients in matters involving the protection and enforcement of trade secrets. He has assisted clients in implementing trade secrets audit and protection programs, negotiating joint venture agreements and preparing effective confidentiality/nondisclosure arrangements.

A nationally recognized leader in intellectual property matters, Steve is a frequent lecturer and is also a member of the George Washington University Intellectual Property Advisory Board and the Northwestern University Institute for Sustainable Energy Executive Counsel.

Representative Experience

- Lead counsel for Apotex in a significant jurisdictional case where the Court of Appeals for the Federal Circuit held that Apotex has standing as a subsequent ANDA filer to challenge one of Daiichi's Orange Book listed patents for the drug Omnisar® (olmesartan medoxomil), despite the patent having been disclaimed by Daiichi.
- Lead counsel for Apotex in successfully obtaining summary judgment of patent invalidity in the U.S. District Court for the District of Delaware in a case involving a generic version of Warner Chilcott's osteoporosis drug Actonel (risedronate). The decision was affirmed on appeal by the Court of Appeals for the Federal Circuit.
- Lead counsel for Apotex in defeating Hoffman Roche's motion for preliminary injunction to prevent the launch by Apotex of a generic version of the osteoporosis drug, Boniva (ibandronate), which enabled client to launch as a first filer. Subsequently, the district court granted motion for summary judgment finding that Hoffman La Roche's patents were invalid for obviousness. *Hoffmann-La Roche Inc. v. Apotex Inc., et al.* (D.N.J. 2012). The decision was affirmed on appeal by the Court of Appeals for the Federal Circuit.
- Lead counsel for Apotex, which obtained summary judgment of noninfringement on patents relating to the drug Antara, and avoided prolonged discovery while demonstrating that client's formulation did not infringe. *In re Fenofibrate Patent Litigation* (S.D.N.Y. 2012).
- Extensive experience at both the trial and appellate level litigating Hatch-Waxman/abbreviated new drug application (ANDA) disputes. Pharmaceutical litigations of note include Norvasc (amlodipine) – *Pfizer Inc. v. Apotex Inc.*, 480 F.3d 1348 (Fed. Cir. 2007); Floxin Otic (ofloxacin) (*Daiichi Sankyo Co. Ltd. v. Apotex Inc., et al.*, 501 F.3d 1254 (Fed. Cir. 2007); Actonel (risedronate), Uroxatral (alfuzosin), Eloxatin (oxaliplatin), Ultracet (tramadol and acetaminophen), Omnisar (ciclesonide nasal spray), Benicar (olmesartan medoxomil), Lotrel (amlodipine and benazepril) and Plavix (clopidogrel).
- Lead counsel for Illinois Tool Works in patent infringement case involving enforcement of company patent on its innovative polyester/polyolefin packaging technology. Case ultimately settled. *Illinois Tool Works Inc. v. Samuel Son & Co. Ltd. and Samuel Strapping Systems Inc.* (N.D. Illinois 2012).
- Secured favorable outcome in defending against \$500 million claim involving issues of patent misuse, patent exhaustion, implied license, breach of license agreement, and unjust enrichment. *Minebea Co. v. Papst Licensing*, 444 F.Supp.2d 68 (D.D.C. 2006).
- Counsel for Rockwell International Corp. in numerous patent infringement lawsuits and in worldwide licensing programs involving metalorganic chemical vapour deposition (MOCVD) semiconductor processing technology pertaining to high brightness LEDs, semiconductor lasers, solar cells and other semiconductor devices.
- Counsel for Rockwell Electronic Commerce Corp. in action for trade secret misappropriation relating to technologies involved in call center solutions.
- Counsel for Heico Corp. in obtaining summary judgments dismissing patent infringement and trade secret claims in a case involving jet engine parts in litigation with United Technologies Corp.



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Publications & Speaking Engagements

- Speaker, “How Recent Court Decisions on Patent Exhaustion, Exceptional Case and Patentable Subject Matter, are Changing the Face of Patent Licensing,” Cleveland Intellectual Property Law Association, March 2016.
- Speaker, “Shedding Light on the Changing Face of Intellectual Property Enforcement, Protection and Defense: Who’s Alice? What the Heck are IPRs and PGRs, and Why Should I Care? When’s Congress Finally Going to Do Something About Those Pesky Patent Trolls?,” Portable Lights American Trade Association, January 2016.
- Panelist, “Evaluating the Merits of Bringing a Declaratory Judgement Action in Paragraph IV: Duplication or Necessity?,” American Conference Institute 3rd Annual Paragraph IV Disputes Master Symposium, October 2015.
- Co-author, “How to Keep your Patent Portfolio Off Life Support and Out of the Morgue in View of *Bilski*, *Mayo*, *Myriad*, *Alice* and Other Recent Court Decisions,” Intellectual Property Licensing Strategies, Inside the Minds, January 2015.
- Speaker, “*Limelight v. Akamai*: Assessing Its Impact on Method of Treatment Patents and Section viii Label Carve Outs,” American Conference Institute’s 9th Annual Paragraph IV Disputes Conference, New York, April 2015.
- Speaker, “Paragraph IV Patent Challenges: Are You Prepared for Product Targeting?” Knowledge Group Webcast, March 2015.
- Co-author, “Don’t Tell Mom, My Patent Portfolio Might Be Dead,” LES Insights, October 2013.
- Co-author, “A Fresh Look at Non-Disclosure Agreements: Think Before You Boilerplate,” ExecSense, 2013.
- Co-author, “Emerging Energy and Intellectual Property: The Often Unappreciated Risks and Hurdles of Government Regulations and Standard Setting Organizations,” The National Law Review, May 2012.
- Speaker, “Intellectual Property Issues with Emerging Energy Technology,” Young Professionals in Energy International Summit, Las Vegas, NV, April 2012.
- Speaker, “Extraterritorial Protection of Trade Secret Rights in China: Do Section 337 Actions at the ITC Really Prevent Trade Secret Theft Abroad?” The John Marshall Review of Intellectual Property Law Symposium: Applications of Intellectual Property Law in China, April 2012.
- Co-author, “Extraterritorial Protection of Trade Secret Rights in China: Do Section 337 Actions at the ITC Really Prevent Trade Secret Theft Abroad?” The John Marshall Review of Intellectual Property Law, January 2012.
- Speaker, “Entrepreneurship In Neurosurgery: Strategies for Creating and Protecting Intellectual Assets,” Congress of Neurological Surgeons Annual Meeting, 2010.

- Speaker, “Entrepreneurship in Neurosurgery: What Doctors and Other Medical Professionals Need to Know About Obtaining and Extracting Value from Innovations,” Congress of Neurological Surgeons Annual Meeting, 2009.
- Speaker, “Enforcing Trade Secrets and Restrictive Covenants in a Down Economy—Strategies for Avoiding Pratfalls and Pitfalls While Downsizing,” IPLAC trade secrets seminar, 2009.
- Speaker, “Patents & Industry Standards: What are the Practical (and Some Unexpected) Ramifications of Qualcomm?” IICLE Intellectual Property Institute, 2008.
- Speaker, “Legal Issues in Licensing,” Licensing Executives Society Spring Meeting, 2008.
- Contributing author, “Intellectual Property,” Illinois Institute for Continuing Legal Education (IICLE), 2008.

Professional History

- Partner, Hahn Loeser & Parks, 2015-present.
- Partner, Husch Blackwell LLP, 2008-15.
- Partner, Welsh & Katz, Ltd., 2001-08.

Admissions

- State of Illinois, 1995.
- District of Colorado, 2021.
- U.S. Supreme Court, 2007.
- U.S. Courts of Appeals for the District of Columbia Circuit, 2007 and the Federal Circuit, 1997.
- U.S. Patent and Trademark Office, 1995.
- U.S. District Courts for the Northern District of Illinois (Trial Bar), 2005, Eastern District of Wisconsin, 1997, Northern District of Illinois, 1995.

Education

- George Washington University Law School, J.D., with honors, 1995.
- Northwestern University, B.S., Materials Science and Engineering, 1992.

Memberships & Affiliations

- American Bar Association, Member.
- American Intellectual Property Bar Association, Member.
- George Washington University Law School Intellectual Property, Member, Advisory Board.
- Intellectual Property Law Association of Chicago, Member.
- Licensing Executives Society, Member.
- Northwestern University Institute for Sustainability and Energy, Member, Executive Counsel.

Awards & Distinctions

- *Illinois Super Lawyers*®, Intellectual Property, 2020-21.
- IP Star, *Managing IP*, 2014.