



MARK H. REMUS **SHAREHOLDER**

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EDUCATION

J.D., cum laude
University of Illinois College of Law, 1997
B.S., with distinction, Chemical Engineering
University of Illinois, 1994

BAR ADMISSIONS

Supreme Court of the United States
U.S. Patent & Trademark Office
U.S. Dist. Court, N.D. Illinois
U.S. Court of Appeals, Fed. Cir.
U.S. Dist. Court, N.D. Illinois, Trial Bar

Clients trust Mark to solve their patent disputes quickly, efficiently, and strategically. He has served as lead counsel on numerous patent infringement litigation matters, and he has successfully represented clients in jury trials, bench trials, and appeals to the U.S. Court of Appeals for the Federal Circuit and the U.S. Supreme Court. *Intellectual Asset Management* (IAM) magazine writes that Mark is “[a]lways one of the best lawyers in the courtroom, he has an even temperament for litigation and is precise in everything he does,” calling him “quite a force to be reckoned with.” Clients recognize Mark for being “always well-prepared and conscientious” and “tough when the situation requires it.”

Mark has extensive experience with pharmaceutical litigation under the Hatch-Waxman Act. He has advised clients on a wide range of drug products and technologies, including new chemical entities, complex formulations, polymorphs, methods of treatment and extended release formulations. Mark is also experienced in FDA practice and strategy related to generic pharmaceutical products, including controlled correspondence, citizen petitions, suitability petitions and labeling carve-outs.

Mark also has experience with a wide range of technologies, including LCD panels, fiber optic networks, wind turbines, electrical connectors, medical devices, pharmaceutical products, oil drilling, and mechanical devices.

Mark consistently has been named by publications and in lists that honor attorney achievement, including the *IAM Patent 1000* (2020) and *Managing Intellectual Property's - Expert Guides: Guide to the World's Leading Patent Law Practitioners* (2020).

EXPERIENCE | OVERVIEW

- Mark led a trial team through a seven-week bench trial that resulted in the district court invalidating a patent on a \$1 billion per year drug. The district court's decision was affirmed on appeal.
- Mark successfully argued before the Federal Circuit to reverse a decision by the Patent Trial and Appeal Board that the target patent was valid. This was only the second time that the Federal Circuit reversed a validity finding by the PTAB in an inter partes reexamination.
- After a two-week jury trial, Mark's trial team achieved a complete victory for his patent owner-client on multiple counts of patent and trademark infringement. The district court subsequently found the infringer in contempt of a post-trial injunction and awarded attorney's fees for willful infringement. The total judgment was over \$12 million on just \$2 million in accused sales. In awarding attorney's fees, the district court noted

that the “high level of Plaintiffs’ attorneys’ trial practice skills was a significant factor in achieving a favorable result for the Plaintiffs.”

- In a case that reached the Supreme Court, Mark and his colleagues represented a worldwide offshore drilling contractor in a patent infringement case involving an offshore drilling apparatus. The case made two trips to the Federal Circuit Court of Appeals, and then settled on appeal to the Supreme Court after to the Court referred the case to the Solicitor General for review and comment.

PRACTICE GROUPS

Appellate

Litigation

Patent Prosecution

AREA OF FOCUS

Hatch-Waxman

Biotechnology & Pharmaceutical

FORWARD THINKING

Alerts

- Process Limitations Are Not Relevant to the Validity of Pharmaceutical Product Claims, February 05, 2016
- 5 Tips for Protecting Your Trade Secrets While Working from Home, May 15, 2020

Publications

- Marketing authorisation: Splitting the bill, May 20, 2019
- Secondary Considerations, Relief, and Inter Partes Reviews Further Complicate Patent Law, 2014
- The Long Arm of US Patent Laws , October 2014
- Two New Weapons for Defending Hatch-Waxman Litigation, September 03, 2018

Blog Posts

- Mark Remus Drafts Article for Life Sciences Intellectual Property Review, August 04, 2016

Presentations

- Panelist, "Defensive Strategy 2.0: Facing a Better Prepared Plaintiff," CenterForce IP Strategy Summit, Seattle, Washington, May 3, 2017
- Panelist, "Parallel Proceedings Moot Court: District Court and PTAB Mock Pharmaceutical Patent Invalidation Hearing," Brinks Sponsoring ACI Paragraph IV Disputes, New York, NY, April 25, 2016
- "2016 IP Developments," Brinks Webinar, January 28, 2016
- Presenter, Litigation Issues | Fundamentals of Patent Prosecution: A Boot Camp for Claim Drafting & Amendment Writing, Chicago, Illinois (2013-2018)
- Speaker, *Limelight v. Akamai*: Assessing Its Impact on Method of Treatment Patents and Section viii Label Carve Outs | Paragraph IV Disputes Conference, New York, New York (April 27–28, 2015)
- Panelist, Business Method Patents Following Alice v. CLS Bank | Tenth Annual JTIP Symposium, Chicago, Illinois (March 6, 2015)

HONORS

- Illinois Super Lawyers, Intellectual Property Litigation, 2013–2019
- *The Best Lawyers in America*, Litigation - Intellectual Property, 2016-2021, Litigation - Patent, 2019-2021
- Named, *Euromoney Expert Guide to the World's Leading Patent Law Practitioners*, 2017
- *Intellectual Asset Management*, IAM Patent 1000, 2015-2016; IAM Patent Litigation: Illinois, 2013–2014, 2020
- Forty Illinois Attorneys Under 40 to Watch, 2006

AFFILIATIONS

- American Bar Association
- American Intellectual Property Law Association
- Association Internationale pour la Protection de la Propriété Intellectuelle (AIPPI)

REPRESENTATIVE MATTERS

- Represented multinational electronics manufacturer in patent litigation relating to back-lit liquid crystal displays. *Delaware Display Group LLC et al v. LG Electronics Inc. et al* (D. Del. 2014).
- Representation of a medical laboratory in a patent infringement suit involving medical devices. *Advance DX, Inc. v. Healthpoint Diagnostix, Inc.* (N.D. Ill. 2013).
- Defended global heavy equipment manufacturer in patent litigation and bench trial directed to zero voltage ride through circuits for wind turbine generators. *General Electric Co. v. Mitsubishi Heavy Industries Ltd. et al* (N.D. Tex. 2011).
- Defended leading supplier of electronics readers in patent litigation directed to e-book readers. Case dismissed on summary judgment. *Technology Innovations LLC v. Amazon.Com Inc.* (D. Del. 2011).
- Defense of a drilling rig operator in patent litigation relating to patents for offshore drilling rigs and methods of drilling offshore oil wells. *Transocean Offshore Deepwater Drilling Inc. v. Maersk Contractors USA, Inc.* (S.D. Tex. 2007; Fed. Cir. 2010).
- Successful defense of a global supplier of generic pharmaceuticals against request for temporary restraining order and preliminary injunction by Abbott and Astellas over patents relating to the antibiotic Omnicef® and generic cefdinir. *Abbott Labs v. Sandoz Inc.* (N.D. Ill. 2007; Fed. Cir. 2008; S.Ct. 2009).
- Successful defense of a developer and manufacturer of aerosol drug delivery devices and asthma management products against motion for preliminary injunction in litigation relating to patent for valved holding chambers. *PRE Holding Inc. v. Monaghan Medical Corp.* (E.D. Va. 2009).
- Representation of an innovator of air-filled products in a two-week trial, in which a jury found in favor of client on all counts. The court entered a final judgment in excess of \$12.9 million. *Aero Products Int'l v. Intex Recreation Corp.* (N.D. Ill. 2001; Fed. Cir. 2005).
- Representation of a global leader in energy-management solutions in a two-week trial, in which a jury found in favor of client on all counts. The court entered a final judgment in excess of \$14.5 million. *Intermatic Inc. v. Lamson & Sessions Corp.* (N.D. Ill. 1999, Fed. Cir. 2000, S.Ct. 2003).
- Representation of a manufacturer of custom filtration and fluid control devices in a multi-year litigation over client's patent regarding needleless connectors for use in intravenous medical systems. Obtained a \$7.3 million settlement in favor of client. *Filtertek Inc. v. Alaris Medical Prods.* (N.D. Ill. 2002).