

Curriculum Vitae of

ROY H. WEPNER

LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK, LLP

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EDUCATION

UNIVERSITY OF PENNSYLVANIA LAW SCHOOL,

Philadelphia, Pennsylvania

Juris Doctor (1974)

Awarded Amram Prize for Best Paper in Civil Procedure

RENSSELAER POLYTECHNIC INSTITUTE, Troy, New York

Bachelor of Science in Mechanical Engineering (1968)

Master of Engineering in Mechanical Engineering (1969)

Honorarys: Tau Beta Pi; Pi Tau Sigma (President)

LEGAL EXPERIENCE

Partner:

1984-Present;

Associate:

1981-1983

LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK, LLP

Westfield, New Jersey

Broad experience in intellectual property litigation. Successful matters have included:

- *New York University v. Pfizer, Inc.*, 151 A.D.3d 42, 53 N.Y.S.3d 284 (First Dept. 2017) (reversing dismissal of action brought by NYU asserting breach of a technology licensing agreement involving targeted cancer therapies).
- *Ezaki Glico Kabushiki Kaisha v. Lotte Int'l Am. Corp.* (trade dress infringement case; co-counsel with Hogan Lovells), 2016 U.S. Dist. LEXIS 185577 (D.N.J. 2016) (dismissing counterclaim); 2017 U.S. Dist. LEXIS 12246, *aff'd*, 2017 U.S. Dist. LEXIS 157424 (D.N.J. 2017) (denying motion to transfer); 2017 U.S. Dist. LEXIS 164222 (D.N.J. 2017) (granting motion to add party).
- *High Point SARL v. T-Mobile USA, Inc.*, 640 F. App'x 917 (Fed. Cir. 2016) (affirming grant of summary judgment of patent exhaustion on behalf of Ericsson Inc. and its customer T-Mobile in case involving cellular telephone network infrastructure equipment)

- *Content Extraction and Transmission LLC v. Wells Fargo Bank*, 776 F.3d 1343 (Fed. Cir. 2014) (on behalf of ATM maker Diebold, Inc., successfully defended on appeal (with aligned parties) the district court's invalidation of 242 claims of four patents under 35 U.S.C. §101)
- *In re Glatt Air Techniques, Inc.*, 630 F.3d 1026 (Fed. Cir. 2011) (reversing obviousness rejection in reexamination of patent on fluidized bed coaters)
- *Waddington North America, Inc. v. Sabert Corp.*, 2010 WL 3907036 (D.N.J. 2010) (dismissing inequitable conduct defenses and counterclaims in case involving metalized cutlery); 2010 WL 4363137 (D.N.J. 2010) (construing claims); 2011 WL 1098998 (D.N.J. 2011) (granting summary judgment of literal infringement); 2011 WL 1098996 (D.N.J. 2011) (granting summary judgment on written description defense); and 2011 WL 3444150 (D.N.J. 2011) (granting partial JMOL and new trial based on adversary's misconduct)
- *The Johns Hopkins University v. Datascope Corp.*, 543 F.3d 1342 (Fed. Cir. 2008) (overturning jury verdict of infringement in case involving fragmentation catheters)
- *Howmedica Osteonics Corp. v. Wright Medical Tech., Inc.*, 540 F.3d 1337 (Fed. Cir. 2008) (reversing claim construction ruling and vacating judgment of noninfringement in case involving knee prostheses)
- *Howmedica Osteonics Corp. v. Tranquil Prospects, Ltd.*, 260 F. App'x 297 (Fed. Cir. 2008) (*per curiam* affirmance of summary judgment of noninfringement regarding intramedullary prostheses)
- *Everett Labs., Inc. v. Vertical Pharms., Inc.*, 227 F. App'x 124 (3d Cir. 2007) (affirming denial of preliminary injunction in trademark action involving vitamin supplements)
- *Medi-Flex, Inc. v. Nice-Pak Products, Inc.*, 422 F. Supp. 2d 1242 (D. Kan. 2006) (denying preliminary injunction based on alleged trademark infringement in case involving topical antiseptics)
- *CollaGenex Pharms., Inc. v. IVAX Corp.*, 375 F. Supp. 2d 120 (E.D.N.Y. 2005) (denying preliminary injunction based on alleged patent infringement in case involving drugs for periodontitis)
- *MedPointe Healthcare Inc. v. Hi-Tech Pharmacal Co., Inc.*, 115 Fed. App'x 76 (Fed. Cir. 2004) (vacating preliminary injunction in case involving cough medications)

- *Commerce Bancorp, Inc. v. BankAtlantic*, 285 F. Supp. 2d 475 (D.N.J. 2003) (granting summary judgment of no enforceable trademark rights and no likelihood of confusion between AMERICA'S MOST CONVENIENT BANK and FLORIDA'S MOST CONVENIENT BANK)
- *SmithKline Beecham Corp. v. Geneva Pharms., Inc.*, 210 F.R.D. 547 (E.D. Pa. 2002), *aff'd per curiam*, 2003 WL 21911238 (Fed. Cir. 2003) (denying intervention in Hatch-Waxman patent infringement action)
- *Sealmaster LLC v. Silver Line Building Prods. Corp.*, 32 F. App'x 587 (Fed. Cir. 2002) (*per curiam* affirmance of summary judgment of invalidity of patent directed to window frame)
- *American Bioscience, Inc. v. Baker Norton Pharm., Inc.*, 2002 WL 54627 (C.D. Cal. 2002) (holding all asserted claims of cancer treatment drug invalid), *reconsideration denied*, 2002 WL 655272 (C.D. Cal. 2002)
- *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.2d 1368 (Fed. Cir. 2001) (affirming summary judgment of invalidity on all but two claims of cancer treatment drug)
- *Datascope Corp. v. Arrow Int'l, Inc.*, 62 U.S.P.Q.2d 1101 (D.N.J. 2001) (granting summary judgment of invalidity for recapture of reissue patent on intra-aortic balloon devices)
- *SDS USA, Inc. v. Ken Specialties, Inc.*, 107 F. Supp. 2d 574 (D.N.J. 2000) and 122 F. Supp. 2d 533 (D.N.J. 2000) (construing contested claims of patent on mass production of cardboard boxes and thereafter granting summary judgment of infringement)
- *Newell Window Furnishings, Inc. v. Springs Window Fashions Division, Inc.*, 53 U.S.P.Q.2d 1302 (N.D. Ill. 1999) (holding patents on cellular window shades invalid), *aff'd as to invalidity*, 2001 WL 744460 (Fed. Cir. 2001)
- *Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277 (7th Cir. 1997) (reversing summary judgment in product configuration trade dress case involving cable ties)
- *Marion Merrell Dow, Inc. v. Baker Norton Pharmaceuticals, Inc.*, 948 F. Supp. 1050 (S.D. Fla. 1996) (granting summary judgment that generic version of SELDANE[®] did not infringe patent-in-suit)
- *M&R Marking Systems, Inc. v. Top Stamp, Inc.*, 926 F. Supp. 466 (D.N.J. 1996) (granting preliminary injunction on patent on hand stamp)

- *Eli Lilly & Co. v. American Cyanamid Co.*, 896 F. Supp. 851 (S.D. Ind. 1995), *aff'd*, 82 F.3d 1568 (Fed. Cir. 1996) (denying preliminary injunction regarding the drug cefaclor under Process Patent Act)
- *Wright Medical Tech., Inc. v. Osteonics Corp.*, 914 F. Supp. 1524 (W.D. Tenn. 1995) (dismissing declaratory judgment action involving hip implant patent)
- *Gilley v. Project Strategies Corp.*, 38 U.S.P.Q.2d 1491 (D.N.J. 1995) (denying patentee's motion for summary judgment on inequitable conduct and fraud in case involving frame guide valances)
- *Abbott Laboratories v. Zenith Laboratories, Inc.*, 35 U.S.P.Q.2d 1161 (N.D. Ill. 1995) and 934 F. Supp. 925 (N.D. Ill. 1995) (dismissing two actions for patent infringement purportedly brought under Hatch-Waxman Act regarding the drug HYTRIN[®])
- *American Ceramicraft Inc. v. Eisenbraun Reiss, Inc.*, 28 U.S.P.Q.2d 1241 (D.N.J. 1993) (obtaining summary judgment that all claims of adversary's patent on light illuminating kit are invalid)
- *Specialty Measurement, Inc. v. Measurement Systems, Inc.*, 763 F. Supp. 91 (D.N.J. 1991) (obtaining preliminary injunction against use of mark MSI as confusingly similar with SMI)
- *Acoustical Design Inc. v. Control Electronics Co.*, 932 F.2d 939 (Fed. Cir. 1991) (affirmance of judgment for patentee including treble damages and attorneys' fees in case involving sound masking devices)
- *Refac International, Inc. v. IBM Corporation*, 710 F. Supp. 569 (D.N.J. 1989) (obtaining attorneys' fee award for defendant Diebold, after patent asserted against ATMs held invalid)
- *Transfer Print Foils, Inc. v. Transfer Print America, Inc.*, 720 F. Supp. 425 (D.N.J. 1989) (obtaining preliminary injunction against infringement of client's unregistered trade name TRANSFER PRINT)
- *Apollo Distributing Co. v. Jerry Kurtz Carpet Co.*, 696 F. Supp. 140 (D.N.J. 1988) (obtaining summary judgment of trademark infringement)
- *Fitzgerald v. J.R. Chicken & Ribs, Inc.*, 11 U.S.P.Q.2d 1384 (D.N.J. 1989) (obtaining dismissal of claim against client for lack of subject matter jurisdiction)
- *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522 (Fed. Cir. 1987) (affirming grant of summary judgment allowing issuance of nationwide federal registration for DAFFY DAN'S)

- *Trans-World Manufacturing Corp. v. Al Nyman & Sons, Inc.*, 750 F.2d 1552 (Fed. Cir. 1984), *on remand*, 633 F. Supp. 1047 (D. Del. 1986) (holding design patents on eyeglass displays valid and infringed and awarding damages)

In earlier years, responsibilities included all aspects of the procurement, enforcement and defense of patents relating to basic laser technology owned by Gordon Gould and Patlex Corporation. Some of this work was documented in Nick Taylor, “LASER: The Inventor, The Nobel Laureate, And The Thirty-Year Patent War,” pp. 234, 236, 243-49, 257, 284 (Simon & Schuster, 2000). Successes included:

- *Gould v. Mossinghoff*, 711 F.2d 396 (D.C. Cir. 1983) (overturning adverse ruling based on collateral estoppel), *on remand*, 229 U.S.P.Q. 1 (D.D.C. 1985), *modified*, 822 F.2d 1074 (Fed. Cir. 1987) (resulting in issuance of U.S. Patent No. 4,704,583 relating to gas discharge laser amplifiers)
- *Ex parte Gould*, 231 U.S.P.Q. 943 (Bd. Pat. App. Intf. 1986) (sustaining on reexamination U.S. Patent No. 4,053,845 relating to optically pumped laser amplifiers)
- *Patlex Corp. v. Quigg*, 680 F. Supp. 33 (D.D.C. 1988) (granting summary judgment sustaining on reexamination U.S. Patent No. 4,161,436 involving method of energizing a material utilizing laser amplification)
- *Ex parte Gould*, 6 U.S.P.Q.2d 1680 (Bd. Pat. App. & Intf. 1987) (obtaining allowance of patent application directed to polarizing apparatus employing optical element inclined at Brewster’s Angle)
- *Gould v. General Photonics Corp.*, 534 F. Supp. 399 (N.D. Cal. 1982) (holding U.S. Patent No. 4,053,845 valid and infringed) and 230 U.S.P.Q. 707 (N.D. Cal. 1986) (enjoining defendant after it defaulted in royalty payments)

Prepared *amicus* briefs in *Teva Pharmaceuticals USA, Inc. v. Pfizer, Inc.*, 395 F.3d 1324 (Fed. Cir.), *reh’g denied*, 405 F.3d 990 (Fed. Cir. 2005), and *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995).

Associate:
1976-1981

AMSTER, ROTHSTEIN & ENGELBERG
(now AMSTER, ROTHSTEIN & EBENSTEIN)
New York, New York

Patent, trademark and copyright practice including prosecution and litigation. Successful matters included:

- *Polo Fashions Inc. v. Extra Special Products, Inc.*, 451 F. Supp. 555 (S.D.N.Y. 1978) (granting preliminary injunction and sustaining validity

for the first time of the trademark POLO); 208 U.S.P.Q. (BNA) 421 (S.D.N.Y. 1980) (awarding profits and attorney fees)

- *DCA Food Industries Inc. v. Hawthorn Melody Inc.*, 470 F. Supp. 574 (S.D.N.Y. 1979) (denying motion to dismiss and piercing corporate veil)

Associate: FISH & NEAVE (now ROPES & GRAY)
1974-1976 New York, New York

Assisted in various phases of preparation of complex patent infringement cases for trial, including validity and infringement studies, legal research, drafting briefs and all phases of discovery.

MEDIATION

Successfully mediated trademark infringement action: *Grey Matter Medical Products, LLC v. Schreiner Group Limited Partnership*, Case No. 3:13-cv-05861 (W.D. Wash.) (March 17, 2015)

Successfully mediated action involving alleged utility patent, design patent, and trade dress infringement action: *The Eastern Company v. Phoenix USA, Inc.*, Case No. 1:15-cv-00327 (N.D. Ohio) (November 4, 2015)

Appointed to the Panel of Mediators for the United States District Court for the District of New Jersey (October 25, 2018)

PUBLICATIONS

Law Review
Articles “The Federal Circuit’s Presumptively Erroneous Presumption of Irreparable Harm,” 6 *Tulane Journal of Technology & Intellectual Property* 147 (2004) (co-author)

“The Patent Invalidity/Infringement Parallel: Symmetry or Semantics?,” 93 *Dickinson Law Review* 67 (1988), 71 *Journal of the Patent and Trademark Office Society* 895 (1989) (cited in *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1579 n.32 (Fed. Cir. 1995) (en banc))

“Determining Where The Claim Arose Under 28 U.S.C. § 1391(b) In Multi-State Trademark Infringement Actions,” 12 *Seton Hall Law Review* 767, 72 *Trademark Reporter* 358 (1982) (cited in *McCarthy on Trademarks and Unfair Competition* § 32:65 and district court decisions from Delaware, Massachusetts, and Illinois)

“Appellate Review of Patentability,” 56 *Journal of the Patent Office Society* 216, 288 (1974)

Other Articles

“Inventions: Here Today, Gone Yesterday?,” *New Jersey Law Journal*, April 17, 2018 (co-author)

“‘Waive’ Goodbye: Developments in Patent Litigation,” *New Jersey Law Journal*, August 21, 2017

“Goods or Services? Why It Matters,” *New Jersey Law Journal*, January 2, 2017

“Is Competition Required for a Patent Injunction?” *New Jersey Law Journal*, November 10, 2014

“Joinder Of Unrelated Defendants In Patent Cases,” *New Jersey Law Journal*, June 20, 2011

“Patent Forum Shopping May Be Curtailed,” *New Jersey Law Journal*, February 11, 2008

“Supreme Court Ends Automatic Injunctions,” *New Jersey Law Journal*, June 5, 2006

“Patent Wars: Nothing New Under The Technological Sun,” *New Jersey Lawyer*, June 28, 2004

“Are Federal Appellate Practitioners Free At Last?,” *New Jersey Law Journal*, January 26, 2004

“We’ll Miss You, Mr. Rogers,” *New York Law Journal*, March 6, 2003, and *New Jersey Law Journal*, July 21, 2003

“Court Places Limits On The Doctrine of Equivalent,” *New Jersey Law Journal*, January 13, 2003

“Things Your Mentor Never Taught You About Briefs,” *New Jersey Law Journal*, September 24, 2001

“Patent Lawyers Beware: Submarine Patents Are Still Lurking,” *New Jersey Law Journal*, July 15, 1996

“Patent Venue: Down And Out In Beverly Hills,” *New Jersey Law Journal*, July 25, 1994

“‘Intent To Use’ (or Consequences),” *New Jersey Law Journal*, August 17, 1992

“New Approaches Are Needed To Ensure Privacy,” *New Jersey Law Journal*, September 26, 1991

“Declaratory Judgments: Lifting the Cloud,” *New Jersey Law Journal*, December 22, 1988

“Patent Reexamination Is Reexamined,” *New Jersey Law Journal*, December 26, 1985

“Time Of Transition For Federal Trademark Registrations,” *New Jersey Law Journal*, February 7, 1985

“Verdict On New Federal Circuit: Innovation Is Winner,” *New Jersey Law Journal*, May 31, 1984

**TEACHING
AND EXPERT
TESTIMONY**

Expert declaration in *Nite Glow Indus., Inc. v. Central Garden & Pet Co.*, Civil Action No. 12-4047 (D.N.J. Oct. 9, 2018)

Testified as trademark expert in arbitration entitled *J. Strober & Sons, LLC v. Strober Roofing, Inc.* (Newark, NJ 2009)

Adjunct Professor Of Law, Rutgers University School of Law, Newark, New Jersey. Taught “Patent Law,” 1997 - 2000

Adjunct Professor of Law, Seton Hall University Law School, Newark, New Jersey. Taught “Trademarks and Unfair Competition,” 1993 - 1996

Testified as patent expert on behalf of prevailing plaintiff in *Surgical Laser Technologies, Inc. v. Laser Industries, Inc.*, 29 U.S.P.Q.2d 1533 (E.D. Pa. 1993), *aff’d in relevant part*, 32 U.S.P.Q.2d 1798 (Fed. Cir. 1994)

**ORAL
PRESENTATIONS**

New Jersey Intellectual Property Law Association Litigation Seminar, March 5, 1996 (lectured on recent developments in product configuration trade dress)

Ninth Annual Joint Patent Seminar, New York, Connecticut, Philadelphia and New Jersey Patent Law Associations, April 20, 1993 (lecture and paper on venue in patent cases)

Seventh Annual Joint Patent Seminar, Connecticut, New Jersey, New York and Philadelphia Patent Law Associations, April 6, 1991 (lecture and paper on assignor estoppel)

New Jersey Institute for Continuing Legal Education, “Copyright, Trademark and Trade Secret Protection,” October 7, 1987 (lecture on trademark law)

Center for Professional Advancement, “International Licensing and Negotiation for the Technology Manager,” 1985-87 (lectures on patent law)

**BAR
ADMISSIONS**

New York; New Jersey; Pennsylvania; United States Supreme Court; United States Patent and Trademark Office (Registration No. 28,350); United States Court of Appeals for the Second, Third, Fifth, Federal and District of Columbia Circuits; United States District Courts for the District of New Jersey, the Southern District of New York, the Eastern District of New York, and the Western District of Wisconsin

RECOGNITION

Selected by Thomson Reuters for their 2012-2019 “New Jersey Super Lawyer” lists for intellectual property litigation
Recommended as “brief-writer extraordinaire,” “admired appellate specialist,” and as an “enforcement heavyweight who writes masterful briefs that convey complex concepts with crystal clarity,” in “The World’s Leading Patent Practitioners” by International Asset Management (2013-2018)
Selected by American Law Media and Martindale-Hubbell for inclusion in “New Jersey’s Top Rated Lawyers” (2013-2015)

PERSONAL

Born August 10, 1947; married; twin daughters; four grandchildren.