

Martin A. Bruehs

Partner



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Overview

Martin Bruehs is a member of Dentons' Intellectual Property and Technology practice. He serves as head of the Firm's Chemical Patent practice.

Martin's practice focuses on US and international patent matters involving a range of technologies, including chemistry, pharmaceuticals, biotechnology, medical/cosmetic products and nanotechnology. He is frequently engaged by clients around the world to develop and implement patent procurement and enforcement strategies to support clients' global business initiatives across multiple different countries and regions. His practice also includes patent litigation, client counseling, patentability, validity and infringement opinions, *inter partes* and post-grant review, patent reissue and reexamination matters, patent interferences and intellectual property licensing. In these areas, Martin frequently works with qualified patent prosecution and litigation counsel in many different countries within and outside of Dentons' global platform to efficiently coordinate management of client matters.

In litigation matters, Martin has served as counsel in evidentiary hearings, Markman hearings, bench trials and jury trials in various federal district courts and before the US Court of Appeals for the Federal Circuit. He has also served as designated counsel in multiple declared patent interference proceedings and *inter partes* reviews (IPRs), which have proceeded to final hearing proceedings, before the US Board of Patent Appeals and Interferences (BPAI) and Patent Trial and Appeal Board (PTAB), respectively

Martin speaks French and German.

Experience

- **Bodor Laboratories, Inc.:** Obtained a highly-favorable multimillion dollar settlement in two patent litigation cases, and a related arbitration proceeding, against a U.S. licensee and Japanese sub-licensee involving a breach of license agreement concerning a high-value global pharmaceutical patent portfolio. With this settlement, our client will receive multiple 7-figure payments of cash and stock to address unpaid royalties and milestones, additional royalties from sales in the Asian territories and substantially-improved terms under an amended and restated license agreement. The licensed patents at issue are directed to a novel drug for treating an indication that impacts more than 15 million patients in the U.S. and an even greater number of patients in other licensed countries/regions.

- Coordinating (with qualified Chinese patent counsel) challenge of a competitor patent claims in China related to specialty chemical technology.
- Representation of Israeli pharmaceutical company in strategic patent matters, new drug applications (NDAs) and Orange Book Patent listing for innovative pharmaceutical products.
- Representation of leading biotech company as lead counsel in dispute involving breach of a US\$700 million commercialization and patent license agreement resulting in favorable multi-million dollar settlement following mediation.
- Representation of London-based cell therapy company in patent legal matters related to treating human diseases, including cancer, using proprietary cellular immunotherapy techniques. To date, company has raised over US\$200 million in various rounds of funding.
- Representation of European specialty chemicals and advanced materials company in high-value (multimillion-dollar), cross-border product launch and due diligence matters in the U.S., European and Asian markets.
- Representation of European investment bank in the patent due diligence and negotiations for a US\$38.5 million series B funding of progressive multiple sclerosis drug.
- Representation of biotechnology company specializing in drug delivery and food/beverage technologies, as lead counsel in an appeal to the US Court of Appeals for the Federal Circuit following reexamination of a patent directed to nanoemulsion concentrates for dispersing non-polar actives into polar solvents.
- Representation of a European patent client (with qualified Chinese counsel) in a Chinese antitrust investigation initiated by the Shanghai Pricing Bureau involving a multimillion-dollar patent licensing effort across China.
- Representation of a world-renowned medicinal chemist in preparing and prosecuting global patent portfolio directed to pharmaceutical compounds and methods of treatment including soft anticholinergic analogs and related licensing of the same in the US, and to a major Asian pharmaceutical company.
- Representation of privately held clinical-stage pharmaceutical development company in patent prosecution, counseling and diligence concerning ophthalmic drugs and novel drug delivery to the eye, including a successful phase II cyclodextrin nanoparticle eye drop product to treat diabetic macular edema (DME).
- Representation of a global branded pharmaceutical company in patent prosecution, counseling and enforcement efforts, including Orange Book listing of patents and related counseling, including analysis of paragraph IV certifications and participation in related litigation.
- Representation of a New York-based client in a patent due diligence and freedom-to-operate investigation of food industry technology valued at US\$150 million.
- Representation of a patent holder (with qualified French counsel) in product seizure operations in France and related patent infringement litigation proceedings in the High Court of Paris.
- Representation (with qualified foreign counsel) of a major European patent holder in a product import monitoring and patent enforcement campaign covering the US, Canada, France and the United Kingdom.
- Representation of a large international chemical company in patent due diligence matters concerning construction of a multimillion-dollar biofuel plant in South America.
- Representation (with qualified German counsel) of a large international chemical company in legal matters pertaining to joint research efforts in Germany.
- Representation of an early-stage biotechnology company in global patent legal matters directed to biocatalytic technologies in the water, energy and chemical industries.
- Representation of a global financial services company in patent due diligence issues arising in connection with high-value pharmaceutical investments.

- Representation of a specialty prescription pharmaceutical company on patent legal aspects of its acquisition of a specialty pharmaceutical company, focused on development of products for female and male hormone deficiencies.
- Representation of one of the largest manufacturers of specialty chemicals in connection with arbitration proceedings in Switzerland concerning inventorship rights to a US patent directed to the synthesis of compounds having nitrile functions.
- Representation of an intellectual property development company, co-founded by a distinguished professor and recent recipient of the Nobel Prize in Medicine, in connection with the licensing, procurement and commercialization of intellectual property directed to life sciences technologies.
- Representation of a startup biotechnology company in connection with the procurement of intellectual property directed to therapeutic vaccine technologies.
- Conducted a due diligence investigation for a global biopharmaceutical company in advance of clinical trials to assess the safety and effectiveness of novel compounds and prodrugs for the treatment of viral infections.
- Representation of a subsidiary of a major international health care products manufacturer in patent interference matters concerning implantable medical device technology.
- Conducted a due diligence investigation for the acquisition of a multimillion-dollar patent portfolio directed to medical device technology.
- Conducted a freedom-to-operate investigation for the construction of a US\$50 million chemical manufacturing facility.
- Representation of one of the largest global manufacturers of security products in a patent interference matter concerning automotive technology.
- Conducted a due diligence investigation for a US\$30 million acquisition and commercialization of a patent portfolio directed to medical technology.
- *Agere Systems Guardian Corp. v. Proxim, Inc.*, United States District Court for the District of Delaware. Representation of the defendant in a patent infringement action concerning wireless communications technology.
- *Akzenta Paneele + Profile GmbH and W. Classen GmbH & Co., KG v. Brown-West, L.L.C. d/b/a Carpet One Floor & Home, Shaw Industries Group, Inc. and Valinge Innovation AB (f/k/a Valinge Aluminium AB)*, United States District Court for the Eastern District of Texas. Representation of the defendant in a patent infringement action concerning mechanical locking systems for floor panels.
- *Anthurium Solutions, Inc. v. MedQuist Inc., et al.*, United States District Court for the Eastern District of Texas. Representation of the defendant in a patent infringement action concerning a system for automatic electronic document processing.
- *APBI Holdings, Inc. v. Hon. David Kappos*, United States District Court for the District of Columbia. Representation of the patentee in an action seeking recalculation of patent term adjustment for a patent directed to methods of using rapid-onset selective serotonin reuptake inhibitors.
- *Avocet Sports Technology, Inc. v. Implus Footcare, LLC, et al.*, United States District Court for the Northern District of California. Representation of a defendant accused of infringing a United States patent covering pressure measurement devices with a selective pressure threshold crossing accumulator.
- *A.R. Arena Products, Inc. v. Grayling Industries, Inc.*, United States District Court for the Northern District of Ohio. Representation of plaintiff and counterclaim defendant in patent infringement action and multiple, related *inter partes* and *ex parte* patent reexaminations concerning apparatuses and methods for enhancing evacuation of materials from liners used inside intermediate bulk containers, and related antitrust claims.
- *Dropbox, Inc. v. Synchronos Technologies, Inc.*, PTAB-IPR2016-00850. Representation of patent owner in

IPR concerning patent directed to data transfer and synchronization system.

- *Dropbox, Inc. v Synchronos Technologies, Inc.*, PTAB-IPR2016-00851. Representation of patent owner in IPR concerning patent directed to data transfer and synchronization system
- *Cargill, Inc. v Ajinomoto Co., Inc.*, United States Board of Patent Appeals and Interferences. Representation of a senior party in a patent interference concerning processes for the production of glutamic acid compounds.
- *DuPont/CSIRO v. Rhodia Chimie*, United States Board of Patent Appeals and Interferences. Representation of Rhodia in a patent interference concerning a radical polymerization process for the synthesis of block polymers.
- *Embrex, Inc. v. Breuil S.A. and New Tech Solutions, Inc.*, United States District Court for the Eastern District of North Carolina. Representation of the defendants in a patent infringement action concerning poultry egg candling and vaccination technology.
- *Galderma Research & Development v. Hon. David Kappos*, United States District Court for the District of Columbia. Representation of the patentee in an action seeking recalculation of patent term adjustment for a patent directed to the treatment of dermatological disorders.
- *General Components, Inc. v. Micron Technology, Inc., et al*, United States District Court for the Eastern District of Virginia. Representation of the defendant in a patent infringement action concerning minimum dead volume fittings.
- *Georgetown University v. Hon. David Kappos*, United States District Court for the District of Columbia. Representation of the patentee in an action seeking recalculation of patent term adjustment for a patent directed to peripheral-type benzodiazepine receptor expression level as an index of organ damage and regeneration.
- *Golden Hour Data Systems, Inc. v. emsCharts, Inc. et al.*, United States Court of Appeals for the Federal Circuit. Representation of the appellee in an appeal of the decision in a patent infringement action concerning integrated emergency medical transportation database system.
- *Golden Hour Data Systems, Inc. v. emsCharts, Inc., et al.*, United States District Court for the Eastern District of Texas. Representation of the defendant in a patent infringement action concerning an integrated emergency medical transportation database system.
- *IP Cleaning S.p.A. and FAIP North America, Inc. v. Annovi Reverberri, S.p.A.*, United States District Court for the Western District of Wisconsin. Representation of the defendant in a patent infringement action concerning a vertical shaft pressure washer coupling assembly.
- *Penguin Brands, Inc. v. Implus Footcare, LLC*, United States District Court for the Southern District of New York. Representation of the defendant in a patent infringement action concerning universal cleat products.
- *Rhodia Chimie and Rhodia, Inc. v. PPG Industries, Inc.*, United States District Court for the District of Delaware. Representation of the plaintiff in a patent infringement action concerning silica particulates.
- *Schindler Elevator Corp. and Inventio AG v. Otis Elevator Co.*, United States District Court for the Southern District of New York. Representation of the plaintiffs in a patent infringement action concerning elevator installation technology at the new World Trade Center buildings.
- *SecureInfo Corp. v. Telos Corp.*, United States District Court for the Eastern District of Virginia. Representation of the defendant and counterclaimant, in a patent infringement action concerning computer-assisted methods for assessing risk to a target computer system.
- *Välinge Innovation AB v. Pergo AG, Pergo AB, and Pergo LLC*, United States District Court for the District of Delaware. Representation of the plaintiff in a patent infringement action concerning mechanical locking systems for floor panels.
- *Välinge Innovation AB v. Halstead New England Corp. et al.*, United States District Court for the District of

Delaware. Representation of the plaintiff in a patent infringement action involving nine asserted patents directed to mechanical locking systems for and material properties of LVT and WPC flooring panels.

- *Yeda Research and Development Co., Ltd. v. Abbott GmbH & Co. KG*, United States District Court for the District of Columbia. Representation of a major pharmaceutical manufacturer in opposing an appeal of a patent interference decision concerning tumor necrosis factor binding protein II (TBP-II).

Recognition

- Named in the 27th Edition of *The Best Lawyers in America*, 2021 (Awarded for work in Patent Law.)
- Named in the 26th Edition of *The Best Lawyers in America*, 2020 (Awarded for work in Patent Law.)
- Recommended, *Intellectual Asset Management* (IAM) Magazine's Patent 1000 Guide to the World's Leading Patent Professionals, 2019 "best in class in terms of legal and technical prowess, but moreover someone with an exceptional understanding of business."
- Recommended, *Intellectual Asset Management* (IAM) Magazine's Patent 1000 in the area of Patent Prosecution, 2018 "A whiz at coordinating both non-contentious and contentious international affairs ... seen by clients not just as external counsel but as a business partner and confidant."
- IAM Patent 1000 – 2017 Guide to The World's Leading Patent Professionals Named Top Patent Professional (contentious and non-contentious) expert in the DC Metro Area. "He is great at client relations, and understands what you need and how you need it - he speaks your language and can bring inventive solutions to the table which are adapted to your business."
- Recognized as an "IP Star," *Managing IP's Guide*, *Euromoney Legal Guide*, 2013 – 2019
- Recognized as a Top Attorney - Washington, DC Metro Area's Outstanding Young Lawyers, 2013

Honors and Awards

- Recognized in *The Best Lawyers in America* for Patent Law, 2020 – 2021
- Recognized, "IP Star", *Managing IP's Guide*, *Euromoney Legal Guide*, 2013 – 2020
- Recognized, "Washington, DC Rising Stars," *Intellectual Property*, Thomson Reuters, 2013
- Recognized, "Washington, DC, Super Lawyer," *Super Lawyers* magazine, 2013, 2020 (Intellectual Property and Intellectual property Litigation)
- Voted Virginia Super Lawyer, *Super Lawyers* magazine, 2008

Insights

- Co-author, "Welcome to federally-funded research & development... please watch your step" Dentons Client Alert, October 26, 2020
- Co-author, "US Patent Office refuses to apply doctrine of tribal immunity as a defense in inter partes review proceedings," March 1, 2018
- Co-author, "Federal Circuit rules distribution agreement may be invalidating 'offer for sale'," February 20, 2018
- "Virtual patent marking — an underutilized tool" Dentons client alert, December 17, 2014
- "Recent Rulings May Increase Available Patent Term," Dentons client alert, January 29, 2014
- "False Patent Making: No Competitive Injury Is Currently Required," *Intellectual Property Litigation*, 2011

- "Willful Infringement Remains Issue in Patent Cases," *The National Law Journal*, 2009
- "Settlement of Patent Interferences," Patent Interferences Rules & Practice Conference, 2006
- "Judicial Administrative Decisions Subcommittee Report: Recent Chemical, Biotechnological, and Medical Device Decisions," American Intellectual Property Law Association Chemical Practice Committee, May 2004, October 2003, October 2001, May 2001

Activities and Affiliations

Presentations

- "Recent Developments in Chemical Patent Practice," May 2018
- "U.S. Post-Grant Review Procedures," May 2018
- "Virtual Patent Marking," May 2018
- "Recent Developments in Trade Secrets," European Industrial Research Management Association, Rome, Italy, November 2017
- "IP Strategies for Innovative Companies in the U.S.," October 2017
- "Recent Developments in Chemical Patent Practice," September 2017
- "Overview of Key Patent Prosecution Procedures Before the U.S. Patent and Trademark Office," April 2017
- "Recent Developments in Chemical, Pharmaceutical and Biotech Patent Practice," April, 2017
- "US Post-Grant Review Procedures," April 2017
- Presentation on US post-grant practice and recent developments in chemical and pharmaceutical patent law, Chinese Patent Reexamination Board, Beijing, China; March 2016
- "Upgrades Regarding US Post-Grant Practice Before the Patent Trial and Appeal Board," May 2016
- "Amendments to the Rules of Practice Before the PTAB," May 2016
- "Practice Points for Terminal Disclaimers and Double-Patenting Rejections," March 2014
- "Recent Notable Decisions and Trends in Post-Grant Proceedings," March 2014
- "Recent Notable Decisions of the Court of Appeals for the Federal Circuit," November 2014
- "Inter Partes Review; Basics and Strategic Considerations," November 2013
- "The Law of Willful Patent Infringement Continues to Evolve," November 2013

Memberships

- Intellectual Property Law Section, American Bar Association Section of International Law
- Licensing Executives Society
- Patent, Trademark and Copyright Section, The Bar Association of the District of Columbia
- Licensing Subcommittee, Pharmaceutical Issues Committee, Intellectual Property Owners Association
- Intellectual Property Section, New York Bar Association
- Chemical Practice Committee, American Intellectual Property Law Association

Prior and Present Employment

Prior to joining Dentons, Martin was associated with Burns, Doane, Swecker & Mathis, one of the oldest and largest law firms in the US focusing exclusively on intellectual property, until its lawyers and other professionals joined a national general practice law firm in 2005. Martin subsequently became a shareholder and served as chair of the Chemical, Pharmaceutical & Biotech Patent Practice until he joined Dentons.

As an engineering student at Pennsylvania State University, Martin worked as an undergraduate research assistant in the Department of Chemical Engineering, where he conducted research concerning physical, transport and thermodynamic properties of industrial chemicals for the Design Institute for Physical Property Data (DIPPR®). He was a New York State Merit Scholar.

Areas of focus

Practices

- Arbitration
- Competition and Antitrust
- Environment and Natural Resources
- Intellectual Property and Technology
- Litigation and Dispute Resolution
- Mergers and Acquisitions
- Trade, WTO and Customs
- Venture Technology and Emerging Growth Companies
- International Trade
- Patent Litigation

Industry sectors

- Automotive
- Defense and Space
- Energy
- Forest Products and Agribusiness
- Health Care
- Life Sciences
- Life Sciences and Health Care
- Manufacturing
- Private Equity
- Technology

Education

- Albany Law School, 1998, JD, *cum laude*
- The Pennsylvania State University, 1995, BSChE, Chemical Engineering

Admissions and qualifications

- District of Columbia
- New York
- US Court of Appeals for the Federal Circuit
- US District Court for the District of Columbia
- US District Court for the Northern District of New York
- US District Court for the Western District of New York
- US Patent and Trademark Office

Languages

- English
- French
- German