



## John Kappos

Partner

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John Kappos, a registered patent attorney for over 20 years, was lead or co-lead counsel in patent litigations in federal district courts throughout the nation, in the International Trade Commission, and in domestic and international arbitrations. John has also assisted companies in post grant review proceedings, *inter partes* review proceedings, and Board of Patent Appeals and Interferences proceedings.

### Experience

- *Genetics Institute, LLC v. Novartis Vaccines And Diagnostics, Inc.* After bench trial to Judge Robinson in Delaware, secured a ruling of no invalidity of Novartis's patents directed to synthetic, recombinant blood coagulation protein Factor VIII used in treatment of Hemophilia A. *Genetics Institute, LLC v. Novartis Vaccines and Diagnostics, Inc.*, 687 F. Supp. 2d 486 (2010). The Federal Circuit upheld that ruling in a majority 2-1 precedential opinion. *Genetics Institute, LLC v. Novartis Vaccines and Diagnostics, Inc.*, 655 F.3d 1291 (Fed. Cir. 2011), and the US Supreme Court denied certiorari, which resulted in a favorable resolution of underlying infringement litigation.

### Admissions

#### *Bar Admissions*

California

#### *Court Admissions*

US District Court, Southern, Northern, Eastern, and Central Districts of California

US Court of Appeals, Second, Ninth, and Federal Circuits

US Supreme Court

#### *Registered to Practice*

US Patent & Trademark Office

### Education

University of California at Los Angeles, J.D., 1994

Harvard University, Ph.D., Chemistry, 1991

University of California at Irvine, B.S., Chemistry, 1986

- In the Matter of *Certain Ceramic Capacitors and Products Containing Same*, Inv. No. 337-TA-692 (United States International Trade Commission) and parallel litigation in the Central District of California. This investigation involved 4,600 accused products and four patents asserted against a Samsung business unit that manufactures multilayer ceramic capacitors for the consumer electronics industry. After a full trial on the merits in 2010, the Administrative Law Judge issued a complete defense judgment in Samsung's favor on December 22, 2010.
- In the Matter of *Certain Optical Disc Drives, Components Thereof, and Products Containing the Same*, Inv. No. 337-TA-897 (United States International Trade Commission) and parallel litigation in the District of Delaware. Resolved Section 337 International Trade Commission (ITC) investigation asserting six patents against Samsung's optical disk drives, desktop computers, Blu-ray and DVD players/recorders, and laptop computers.
- *Novartis Vaccines and Diagnostics, Inc. et al. v. Medimmune, LLC, Biogen IDEC, Inc., and Alexion Pharmaceuticals, Inc.* (DED Civil Action No. 11-CV-84-SLR-MPT). Enforced a Novartis patent directed to cytomegalovirus expression systems and their use in manufacturing of biologics. All three actions filed against the manufacturers of biologics Synagis, Tysabri, and Soliris were successfully resolved.
- In the Matter of *Certain Electronic Devices With Graphic Video Processing Systems Components Thereof, And Products Containing Same*, Inv. No. 337-TA-813 (United States International Trade Commission) and parallel litigation in the District of Delaware. Defended a leading technology company in this investigation brought by S3 Graphics accusing several products, in combination with associated software. Resolved case on favorable terms when the parties reached a settlement as part of a highly-publicized, global settlement.
- *Affymetrix, Inc. v. Multilyte Ltd.* (N.D. Ca. Civil Action No. C-03-0379 WHA). Represented Affymetrix in declaratory judgment patent infringement action against Multilyte involving DNA microarray devices for RNA expression analysis. Obtained summary judgment of no liability in favor of Affymetrix.
- *Williams v. General Surgical Innovations Inc.*, 2002 U.S. Dist. LEXIS 25953 (E.D. Tex. 2002). Prevailed in defense of patent infringement action involving devices for cosmetic surgery. On summary judgment secured a determination of invalidity—one of the first successful invalidity defenses in the Eastern District of Texas on a motion for summary judgment.
- *General Surgical Innovations, Inc. v. Origin Medsystems, Inc.* (N.D. Ca. Civil Action No. 5:96-cv-2042-JW). Represented General Surgical Innovations (GSI) against Guidant and its subsidiary Origin Medsystems in a jury trial involving enforcement of patents directed to balloon dissection technology for minimally invasive hernia repair. Secured verdict of infringement, no invalidity, lost profits damages, willfulness, and a permanent injunction in favor of GSI.
- *Vicuron Pharmaceuticals Inc.* Represented Vicuron Pharmaceuticals, a company developing anti-infectives for hospital-based and community acquired MRSA infections, in its \$1.9 billion acquisition by Pfizer Inc.
- *Jostens, Inc. v. Southern California Youth Philharmonic* (Ca. Sup. Ct. Case No. 30-2013-00670533-CL-CL). Defended SCYP, a not-for-profit organization that provides young musicians with a distinguished orchestral experience, in contract litigation filed by Jostens. Secured dismissal of all claims on behalf of SCYP.

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## Professional Activities

### Member

- American Intellectual Property Law Association
- American Bar Association
- Los Angeles Intellectual Property Law Association
- Orange County Patent Law Association
- Federal Circuit Bar Association
- Orange County Bar Association

### Speaker

- “Is The Supreme Court Exhausted With Patents?,” O’Melveny Corporate Counsel Seminar (July 2008)
- “Complying With The Duty Of Care And Avoiding Willful Patent Infringement,” O’Melveny Corporate Counsel Seminar (August 2006)

### Co-Author

- “Patent Venue Reform: Forum Shopping In A Bear Market,” *The Recorder* (December 2020)
- “Supreme Court Back in the Patent Limelight,” *Orange County Business Journal* (August 2014)
- “Medical Treatment and Diagnostic Procedures - Patent Eligible?,” *Orange County Business Journal* (August 2010)
- “Changing Opinions on Willful Patent Infringement,” *Orange County Business Journal* (August 2009)
- “Redefining Obviousness After KSR Decision: Eisai Provides Some Greatly Needed Predictability for Biotech and Pharma,” *Genetic Engineering & Biotechnology News* (October 2008)
- “Is the Supreme Court Exhausted With Patents?” *Orange County Business Journal* (September 2008)

## Honors & Awards

- “Life Sciences Star” for General Patent Litigation by *LMG Life Sciences* (2018-2020)
- Repeatedly recognized as a Southern California “Super Lawyer” in a survey conducted by *Law & Politics Media Inc.* and published in *Los Angeles* magazine and the Southern California edition of *Super Lawyers*
- Named a “Rising Star” by the same organization