



Contact

James H. Shalek

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James H. Shalek is a partner in the Litigation Department and head of the Patent Law Group.

Jim has extensive experience litigating patent, trademark, trade secret and contractual matters in federal and state courts, and before the International Trade Commission and before arbitration tribunals. He has a gift for explaining complex technology in simple terms, and a record of success in patent cases involving a broad range of technologies that include: immunoassays, antibodies, genetic engineering, wireless communications and voice-over Internet protocols, computer hardware, software, transaction processing and graphical user interfaces, financial services, semiconductor electronics, medical device technology, bar code scanning, lasers, three-dimensional modeling, photopolymers, and optical coatings.

Jim currently is representing, or recently has represented, British Telecommunications plc, Church & Dwight, Hospital for Special Surgery, ConMed Endoscopic Technologies, Datalogic Scanning, Depository Trust & Clearance Corp., ImClone, Maidenform, Maytronics, Mitel Networks, NYSE and Shoretel in patent infringement litigation. He has represented numerous other well-known companies in patent infringement litigation, including American Honda, American Hospital Supply, Bay Networks, Genentech, Mitsubishi Electric, Raychem and Spectra-Physics. He has been involved in numerous matters in foreign courts and foreign

patent offices, and frequently addresses his clients' intellectual property needs on a global basis.

Jim spent many years counseling Silicon Valley start-ups in relation to all their patent concerns. During that time, he represented Kleiner, Perkins, Caulfield & Byer, among other venture capitalists, and also represented a number of now well-known companies, such as Genentech and Cisco Systems, in their very early stages. He continues to provide strategic counseling on the development and maintenance of patent portfolios, market position, and transactions in which intellectual property issues are of central concern.

Jim also regularly handles opinion work regarding patentability and infringement, licensing matters and issues before the United States Patent & Trademark Office, where he has been involved in numerous reexaminations, reissues, interferences, oppositions and cancellation proceedings.

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Matters

Representative Patent Litigation Matters:

- *British Telecommunications PLC v. Valve Corp.* (D. Del.) Representing British Telecommunications (BT) in a patent infringement action filed against Valve, an American video game developer and digital distribution company, for infringement of four U.S. patents owned by BT.
- *Hospital for Special Surgery v. Wright Medical Technology, Inc., et al* (S.D.N.Y.) Represented Hospital for Special Surgery (HSS) in obtaining summary judgment of liability against two medical device manufacturers with whom HSS had entered a product development, patent and know-how license agreement related to prosthetic knee technology developed by HSS.
- *British Telecommunications PLC v. Google, Inc., C.A.* (D. Del.) Represented British Telecommunications in a patent infringement action directed against

Google's pervasive infringement of British Telecommunications patents relating to navigation (Google Maps), location-based services, bandwidth management, and access to personalized services and content.

- *British Telecommunications PLC v. Texas Instruments* (D. Del.); *British Telecommunications PLC v. Freescale Semiconductor, Inc.* (D. Del.); *British Telecommunications PLC v. Broadcom Corp* (D. N.J.); *British Telecommunications PLC v. MediaTek Wireless* (D. MA.); and *British Telecommunications PLC v. STM Microelectronics* (D. MA.) Represented British Telecommunications in a series of patent infringement actions involving patented technology directed to an improved Liv Zempel compression algorithm.
- *Church & Dwight Co., Inc. v. Abbott* (D.N.J.) Represented Church & Dwight in obtaining a \$14.6 million jury verdict in a patent infringement action against Abbott. The jury also found wilful infringement which subsequently resulted in enhancement of that award to \$29.2 million. The court subsequently awarded in excess of \$8.8 million in pre- and post-judgment interest, to bring the total award to more than \$38 million.
- *Portfolio Technologies, Inc. v. Church & Dwight Co., Inc.* (ITC) Successfully defended C&D's particular condom design marketed under the Trojan brand name in the United States in the U.S. International Trade Commission (ITC). The ITC ruled in favor of C&D on a patent challenge mounted by Portfolio Technologies, Inc. (PTI), which alleged that C&D and other condom manufacturers had infringed a patent of Dr. Alla Reddy. The decision of the ITC was summarily affirmed by the Court of Appeals for the Federal Circuit on June 10, 2008.
- *Church & Dwight Co., Inc. v. Pfizer*; *Church & Dwight v. Quidel Corporation*; *Inverness Medical Switzerland GmbH, Unipath Diagnostics, Inc., and Church & Dwight Co., Inc. v. Acon Laboratories, Inc*; and *Inverness Medical Innovations, Inc., Inverness Medical Switzerland GmbH, and Church & Dwight Co., Inc. v. Orasure Technologies, Inc.* (D. N.J., S.D. CA, D. M.) Represented C&D in four additional litigations involving patents relating to a lateral flow test strip used in home pregnancy tests. Orasure remains pending. The other actions were settled successfully, one for a publicly reported settlement of \$18 million. Another settled following summary judgment of infringement

followed by a jury verdict of validity.

- *Inverness Medical Innovations et al. v. Church & Dwight Co., Inc.* (D.M.)
Currently representing Church & Dwight Co., Inc. in a patent infringement action brought by Inverness Medical Switzerland GmbH, Inverness Medical Innovations, Inc. and SPD Swiss Precision Diagnostics. The suit involves features of immunoassays having digital readouts, as allegedly used in pregnancy tests. Also representing Church & Dwight Co., Inc. in a false marking case pending in the E.D. of Texas, *Heathcote Holdings Corp v. Church & Dwight*, and a patent infringement styled as *Webvention v. Church & Dwight*, which also is pending in the E.D. of Texas.
- *Pfizer, Inc., Warner-Lambert Co. and Warner-Lambert Co, LLC v. Ajix, Inc. (d/b/a Farmacapsulas S.A.)* (D. Ct.) Defeated Pfizer while representing Ajix, the U.S. distributor of a South American manufacturer of hard gelatin capsules of the type commonly used in pharmaceuticals and dietary supplements. Pfizer sued Ajix, Inc., alleging that its gelatin capsule infringed a Pfizer patent related to intricate locking mechanisms present on the capsules. Obtained a summary judgment of noninfringement of Pfizer's patent, which was just summarily affirmed by the Federal Circuit, per curiam, the day following oral argument.
- *Abbott Laboratories v. ImClone Systems, Inc.* (D. M.) Represented ImClone in a patent infringement action directed to technology allegedly used to produce Erbitux®. The asserted patent was directed to the insertion of a vector into a cell to enhance production of an antibody of interest. The case was settled successfully shortly before hearings on motions for summary judgment.
- *Conexant Systems, Inc. v. British Telecommunications PLC et al.* (S.D. Cal.) Represented British Telecommunications (BT) against Conexant Systems, Inc. in a patent infringement action in San Diego on a BT patent directed to a data compression algorithm used in transmitting data by fax modem, leading to a successful settlement. Subsequently represented British Telecommunications in three actions enforcing the same patent directed to data compression: *British Telecommunications v. Texas Instruments* (D. Del.), *British Telecommunications v. Freescale* (D. Del.) and *British Telecommunications v. Broadcom* (D.N.J.).

- *Arris v. British Telecommunications* (D. Ga.) Obtained dismissal of a declaratory judgment complaint filed by Arris against British Telecommunications upon a motion brought on alternative grounds, the first of which was granted and reversed on appeal, following which the second was granted.
- *Papyrus Technology Corporation v. New York Stock Exchange LLC* (S.D. N.Y.) Co-defended the New York Stock Exchange in a patent infringement action asserted by Papyrus Technology Corporation. A *Markman* hearing was conducted in December of 2007, which resulted in a favorable *Markman* ruling in September of 2008. Subsequently obtained summary judgment of invalidity of the last two patents remaining before the district court in the aftermath of the *Markman* ruling, which was affirmed by the Federal Circuit.
- *Realtime Data LLC D/B/A/ IXO v. CME Group et al.* (S.D. N.Y.) Representing NYSE Euronext, NYSE Arca, Inc., NYSE Amex, LLC, Securities Industry Automation Corporation, and the Options Price Reporting Authority in three related patent infringement suits in the Southern District of New York, which are directed to data compression. The court granted summary judgment in our clients' favor in September 2012, finding non-infringement of our clients' products on every claim.
- *Three Times Clothier v. Maidenform* (S.D.N.Y.) Represented Maidenform in a declaratory judgment action filed by Maidenform upon one design patent and counterclaims by Three Times Clothier under that same patent, and three additional design patents in the same family
- *Vraston v. Depository Trust & Clearing Corporation* (S.D.N.Y.) Represented Depository Trust & Clearing Corp. in a patent infringement lawsuit related to Exchange Traded Funds. The matter was dismissed for failure to state a claim following the Supreme Court's affirmance of the *Bilksi* decision.
- *Maytronics v. Aqua Vac* (S.D. Fla.) Obtained a jury verdict in favor of Maytronics, an industry leader in pool cleaning technology, in a breach of contract action against Aqua Vac involving a covenant not to compete. The verdict and a seven-figure award to Maytronics was affirmed on appeal by the Eleventh Circuit.
- *Aqua Products, Inc. v. Smartpool, Inc. and Richard Holstein v. Maytronics*

(Third Party Defendant) (D.N.J.) Represented Maytronics in a patent infringement claim brought against Maytronics and a distributor in which robotic swimming pool cleaners manufactured by Maytronics were accused of infringement. The matter ended in a favorable settlement.

- *Medtech Products, Inc. v. Ranir, LLC et al.* (S.D. N.Y.) Currently representing DenTek Oral Care, Inc. in a patent, trademark, copyright and unfair competition case brought by Medtech Products, Inc. over a device used to treat bruxism.
- *Ossur North America, et al. v. Freedom Innovations, et al.* (C.D. Cal.) Obtained a favorable settlement in representing Ossur North America, et al., a leading manufacturer of prosthetic devices, in separately filed patent infringement and unfair competition actions respecting prosthetic feet.
- *Molnlycke Health Care AB et al. v. Medline Industries, Inc., Ossur N. Am. Inc.* (N.D. G.) Defended Ossur in a patent litigation brought by Molnlycke Health Care AB, involving a silicone-foam wound care product which Molnlycke alleged to constitute an infringement of its patent. Following a Markman ruling and the filing of summary judgment motions, the case was settled.
- *Datalogic Scanning, Inc. v. Metrologic Instruments, Inc.* (D. Ore.) Representing Datalogic Scanning, Inc., one of two leading manufacturers of bar code scanners of the type commonly seen at checkouts, in a patent infringement action and a trade secret action, each filed against Metrologic, Inc. in Eugene, Oregon. Previously represented Datalogic Scanning's predecessor-in-interest, PSC Scanning, in patent infringement brought by Metrologic in New Jersey on seven patents, which was settled in 2005, following a favorable result at a Markman hearing.
- *Symbol Technologies, Inc. v. PSC Scanning Systems* (W.D. N.Y. and E.D. N.Y.) Successfully represented PSC Scanning, Inc. in two patent infringement actions filed, one involving a preliminary injunction and Markman hearing leading to settlement.
- *Rates Technology Inc. et al. v. Mitel Networks* (E.D. N.Y.) Successfully represented Mitel Networks, a provider of Internet protocol telecommunications systems, in this patent infringement action. The case was settled.

- *Rates Technology, Inc. v. Shoretel, Inc.* (N.D. Cal.) Successfully represented Shoretel, Inc., a provider of Internet protocol telecommunications systems, in this patent infringement case, which was settled
- *United States Endoscopy Group, Inc. v. Conmed Endoscopic Technologies, Inc. et al.* (N.D. O.) Successfully defended ConMed, a Nasdaq-listed medical device company, in a patent infringement case relating to patents on endoscopic retrieval devices. This action was settled.

Practices

False Advertising & Trademark, Patent Law, Non-Compete & Trade Secrets, Antitrust

Industries

Financial Services, Life Sciences, Health Care

Education

Boston University School of Law, J.D., 1978
cum laude

University of Pennsylvania, B.A., 1975
magna cum laude

Admissions & Qualifications

U.S. Patent and Trademark Office
California
New York

Court Admissions

U.S. Court of Appeals, Ninth Circuit
U.S. District Court, California, Central District
U.S. District Court, California, Eastern District
U.S. District Court, New York, Eastern District
U.S. District Court, California, Northern District

U.S. District Court, New York, Northern District
U.S. District Court, California, Southern District
U.S. District Court, New York, Southern District
U.S. District Court, New York, Western District
U.S. Court of Appeals, Federal Circuit

Memberships

American Bar Association
Los Angeles County Bar Association
New York Bar Association
American Intellectual Property Law Association
Los Angeles Intellectual Property Law Association
New York Intellectual Property Law Association
Licensing Executive Society
New York Biotechnology Association

Awards & Recognition

Institutional Investor, Benchmark Litigation Guide
Litigation Star - New York 2014-2017, 2019
Local Litigation Star - New York 2014-2017
Martindale Hubbell: AV-Rated
New York Super Lawyers 2013-2020
IAM Patent 1000 – The World’s Leading Patent Practitioners 2012-2018
“500 Leading Lawyers in America,” Lawdragon