





# Frank Porcelli

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## Overview

### About Frank

Frank Porcelli is a Senior Principal in the Boston and Delaware offices of Fish & Richardson P.C. His practice emphasizes patent and trade secret appellate work, and he is co-chair of Fish's appellate group (1996 – present). He joined the firm in 1971. Over the almost 40-year existence of the U.S. Court of Appeals for the Federal Circuit, Frank has successfully argued some of the highest-profile and most legally significant patent and copyright appeals in the Court, including *Minnesota Mining v. Johnson & Johnson Orthopedics*, 976 F.2d 1559, 61 USLW 2236 (1992) (\$129 million judgment for 3M was the highest district court patent infringement judgment upheld by the Federal Circuit over its first 25 years; case was featured in *Time* and *Business Week*), *Johnson & Johnston Assocs. v. R.E. Service Co.*, 285 F.3d 1046 (2002 *en banc*) (12-1 decision established the doctrine of dedication as a limitation on the patent doctrine of equivalents), *Bard Peripheral Vasc. v. W.L. Gore & Assocs.*, 2012 WL 2149764 (*en banc*), on remand to panel, 682 F.3d 1003 (2012) (*en banc* vacatur and remand to panel of \$206 million willfulness penalty against our client W.L. Gore; panel held that the objective prong of the *Seagate* willfulness test is a question of law for the district court, not the jury, and vacated and remanded to district court for reconsideration), and *Gaylord v. United States*, 678 F.3d 1339 (2012) (decision established reasonable royalty as a measure of federal copyright “damages” in the Federal Circuit). He also successfully argued a trade secret appeal in the Supreme Court of Connecticut that effectively established the right to jury trial in trade secret cases brought under the Uniform Trade Secrets Act. *Evans v. General Motors*, 277 Conn. 496, 893 A.2d 371 (2006).

## Focus Areas

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### Services

- Litigation
- Appellate
- Hatch-Waxman
- ITC Litigation
- Patent Litigation
- Trade Secret Litigation

### Industries

- Chemicals
- Life Sciences
- Medical Devices

## Education

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M.S., Chemistry, Northeastern University (1981)

J.D., Harvard Law School (1971)

A.B. *magna cum laude*, English Literature, Boston College (1968)

## Experience

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### Representative Appellate Experience

*Johnson & Johnston Assoc. v. R.E. Service Co* (Fed. Cir. 2002 *en banc*). Obtained complete reversal of a jury verdict against R.E. Service Co. after Fish was retained to take over the appeal from trial counsel. In its 12–1 *en banc* decision, the Federal Circuit established the doctrine of dedication as a limitation on the doctrine of equivalents.

*Bard Peripheral Vasc. v. W.L. Gore & Assocs.*(Fed. Cir. 2012 *en banc*) .After Fish was retained to take over the appeal after the panel decision, obtained *en banc* vacatur and remand to panel of \$206

million willfulness penalty against our client W.L. Gore. Panel then held that the objective prong of the *Seagate* willfulness test is a question of law for the district court, not the jury, and vacated and remanded to district court for reconsideration.

*3M v. Johnson & Johnson Orthopedics* (Fed. Cir. 1992). Represented 3M in the U.S. District Court for the District of Minnesota against Johnson & Johnson Orthopedics on four 3M patents covering polyurethane-impregnated fiberglass orthopedic casts for setting bone fractures. 3M also alleged a trade secret violation relating to the polyurethane impregnant. The Minnesota district court ruled in favor of 3M, finding all four patents valid and infringed, three of them willfully, and theft of 3M's trade secret, and doubled the patent damages award for willfulness, for a total award of \$129 million. Successfully defended the judgment on appeal before the Federal Circuit Court of Appeals in 1992. This case represented the largest willful infringement penalty on record (\$53 million) as of 1990. For the first 25 years of the Federal Circuit, it remained the largest known district court damages award in a patent case to be affirmed by the Federal Circuit. The case was featured in articles in *Time* and *Business Week*.

*Gaylord v. United States* (Fed. Cir.2012). Obtained favorable decision that established reasonable royalty as a measure of federal copyright "damages" in the U.S. Court of Federal Claims and the Federal Circuit.

*Becton, Dickinson v. Tyco Healthcare* (Fed. Cir.2010). Obtained outright reversal of a \$58 million jury verdict based on erroneous claim construction and lack of substantial evidence of infringement of patent on hypodermic needle guard.

*Evans v. General Motors* (Conn. 2006). In trade secret case, obtained 5-0 reversal in the Supreme Court of Connecticut of trial court's denial of clients' demand as plaintiffs for jury trial. Ruling effectively set a national precedent for the right to jury in cases under the Uniform Trade Secrets Act (UTSA) seeking damages. UTSA has been adopted in 48 states.

*Raytheon Company v. Roper Corporation* (Fed. Cir.1983). Defended Roper Corporation in the U.S. District Court for the District of Massachusetts in a patent declaratory judgment action brought by Raytheon involving a combination microwave and conventional range. Took appeal, and in a seminal decision the Federal Circuit reversed the lack of utility and lack of enablement (inoperativeness) invalidity judgment while upholding the lower court's finding of infringement. On remand, district court awarded \$2.5 million in damages to our client; case subsequently settled favorably.

*Alcide Corp. v. Ecolab and Advanced Bovine Sciences Global* (Fed. Cir. 2000). Represented Ecolab and Advanced Bovine Sciences Global (ABS Global) in a patent infringement suit brought by Alcide Corp. of Seattle in the Western District of Wisconsin. U.S. District Judge Barbara Crabb granted summary judgment of non-infringement under the doctrine of equivalents for Ecolab and ABS Global with respect to Alcide's U.S. patent on a gelled teat dip to prevent bovine mastitis in cow udders. This decision followed a favorable *Markman* construction of the patent claims and a grant of partial

summary judgment of no literal infringement shortly after the *Markman* hearing. Obtained affirmance of the judgment by the Federal Circuit for our client.

*Frink America, Inc. v. Champion Road Machinery Ltd* (2nd Cir. 2002). Represented Champion Road Machinery, Ltd., in a trade secrets and related tort action brought by Frink America, Inc., in the U.S. District Court for the Northern District of New York. The plaintiff had accused our client of stealing drawings and instructions for making snowplows. The court granted summary judgment in favor of Champion Road Machinery, Ltd. The Second Circuit affirmed in part, but remanded the sole issue of conversion for trial. After trial and a verdict in favor of Frink, the district judge granted JMOL on the sole remaining claim for our client, which was affirmed by the Second Circuit in 2002.

*Sunny Fresh Foods, Inc. v. Michael Foods, Inc.* (Fed. Cir. 2005). Secured full affirmance by the Federal Circuit of a jury verdict of noninfringement of liquid egg pasteurization process in the U.S. District Court for the District of Minnesota won by another firm in favor of client Sunny Fresh Foods (a Cargill company). The plaintiffs had sought over \$160 million in damages but ultimately obtained none.

### **Teaching Positions**

- Co-instructor for Patent Litigation Workshop at Harvard Law School, Spring 2013 – Spring 2015, with Bob Hillman and Larry Kolodney of Fish's Boston office, and Spring 2016 and Spring 2018 with Larry Kolodney and Chris Dillon of the Boston office.
- Instructor on Pharma and Biotechnology Litigation in Patent Resources Group Continuing Legal Education course "Pharma & Biotech Strategies" (2000 to 2010).
- The Harvard Law School John A. Reilly Visiting Professor from Practice in Intellectual Property Law (academic years 1998-99 and 2000-01) and Visiting Professor of Law from Practice (academic year 2001-02), teaching Patent Law

# Insights

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## Speaking Engagements

- “IP Jeopardy” *Honorable William C. Conner Inn of Court Meeting* (May 2017)

## Publications

- “Markman Hearings and Claim Construction – A Dialogue On The Sedona Conference Report on the Markman Process,” *AIPLA Public Forum* (April 2007)
- Author of numerous articles on patent damages and other patent litigation and patent law
- Co-author, with fellow principal John Dragseth, of “Patents — A Historical Perspective,” a casebook on patent law (in progress).

# Recognition

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- Frank was named to *The Best Lawyers in America*® for appellate practice from 2016–2023, and named to *Intellectual Asset Management’s (IAM’s) Patent 1000* as a “leading patent professional” (2014–2019). He was also recommended for the Court of Appeals for the Federal Circuit (2014–2019). IAM also named Frank in the Top 20 Federal Circuit Appellate Advocates (2011).
- Recognized as a Massachusetts Super Lawyer (2004-2021)
- Named a Top Rated Litigator by *The American Lawyer* (2019)
- Named to the Lawyer of the Year list of *The Best Lawyers in America*® (2018-2019)
- Named an “IP Star” by *Managing Intellectual Property* (2013-2018)
- Selected as a *Lawdragon 500* “Leading Lawyers in America” (2014-2015)
- Selected as a Lawyer of the Year by *Massachusetts Lawyers Weekly* (2013)
- Recognized as a Top Rated – AV® Preeminent™ Lawyers in *Intellectual Property Law* (2013)
- Recommended for Court of Appeals for the Federal Circuit (2014-2015)
- Selected as an *ALM* “Best Lawyer in America in Intellectual Property Law” (2011)
- Named in the *IAM* Top 20 Federal Circuit Appellate Advocates (2011)
- *IAM’s* The World’s Leading Patent Litigators (2011)
- Named one of the top 25 Patent Experts in the USA Legal Media Group (2008)
- Listed in *Boston Magazine* as one of Top 100 Super Lawyers in Massachusetts (November 2007)
- Named as a Leading Lawyer for Intellectual Property in *Chambers USA* (2005-2014)
- Named in the *International Who’s Who of Patent Lawyers* (2005-2008, 2010-2011)

- Named in *Euromoney's* Expert Guide as one of the "World's Leading Patent Law Experts" (2005)
- Named to *Intellectual Asset Management's (IAM's) Patent 1000*

In addition to the accolades listed above, Frank has frequently been selected as an ALM "Best Lawyer in America in Intellectual Property Law" in *The Best Lawyers in America®* and has been ranked by *Chambers USA* for Intellectual Property. Frank has received numerous recognitions from publications, including:

- *Chambers USA*: "Frank Porcelli is a 'lawyer's lawyer,' who deals with a case with the utmost "
- *IAM Patent 1000*: "Frank Porcelli ...[has] exceptional appellate "

## Memberships & Affiliations

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Active in the Linn Alliance Intellectual Property American Inns of Court, particularly in Boston (Alan D. Lourie Inn; member of Founders Committee, Executive Committee, and a Master of the Inn), New York City (Conner Inn), and Washington (Giles S. Rich Inn). In March of 2011 he was one of six members of the Linn Alliance to be awarded the first Distinguished Service Medal by Judge Linn of the U.S. Court of Appeals for the Federal Circuit, the founder and head of the Alliance.

Member of the Federal Circuit Bar Association (1996 to present) and the Federal Circuit Historical Society (since its founding in 1999 to present). In June 2009 he received the "Enduring Leader" award from the Federal Circuit Bar Association.

Was President of the Boston Patent Law Association (1990-91); Committee Chair, AIPLA Chemical Practice Subcommittee on Legislation (1987-89), Committee Chair, AIPLA Chemical Practice Subcommittee on Judicial and Administrative Decisions (1989-91), and Committee Chair, AIPLA Chemical Practice Committee (1991-92).