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## Senior Principal

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## Overview

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### About Mark

Mark J. Hebert is a senior principal in the Boston office of Fish & Richardson P.C. His practice emphasizes intellectual property litigation and client counseling, with a particular concentration on medical device patent litigation, and appellate work. He has extensive experience in competitor-to-competitor cases representing the plaintiff-patentee in U.S. district courts, and in reexaminations, reissue proceedings, and *inter partes* reviews at the U.S. Patent and Trademark Office.

His concentration on medical device patent litigation has included work in the following technology areas: orthopedic suture anchors, spinal implants, artificial knee and hip prostheses, dialysis machines, videoarthroscopes, suture handling instruments, orthopedic RF electro-surgery probes, transchest pacemakers, and orthopedic casting material. He has also litigated within other technological areas including computer-based music systems, video compression algorithms, perfume spray pumps, large-format cameras, voice-operated switches, computer voice recognition, memory-foam earplugs, and removable tape strips.

Mr. Hebert joined Fish & Richardson in 1987. Before entering the practice of law, Mr. Hebert worked as an engineer in the nuclear industry (1979-1985).?

### Focus Areas

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### Services

- Litigation

- Appellate
- Patent Litigation

## Industries

- Manufacturing
- Medical Devices

## Education

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J.D. *cum laude*, Suffolk University Law School (1985)

M.S. *Pi Tau Sigma*, Mechanical Engineering, Worcester Polytechnic Institute (1980)

B.S., Mechanical and Nuclear Engineering, Worcester Polytechnic Institute (1978)

## Experience

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*Smith & Nephew, Inc. v. Arthrex, Inc.* – Represented Smith & Nephew in two cases and related Patent Office proceedings asserting a patent on orthopedic suture anchors against its competitor Arthrex over the span of 13 years. The first case involved three jury trials, five Federal Circuit appeals, two petitions for certiorari, and resulted in an injunction against Arthrex and a payment to Smith & Nephew of \$99 M. The second case resulted in a favorable settlement on the eve of trial following a finding of partial summary judgment of infringement by the district court. Cases reported at 597 Fed. Appx. 646; 603 Fed. Appx. 981; 502 Fed. Appx. 945; 355 Fed. Appx. 384; 2016 WL 3406232; 2013 WL 5206244; 2010 WL 3467454; 629 F.Supp.2d 1176; 511 F.Supp.2d 1046.

*Bose Corp. v. SDI Technologies, Inc.* – Represented Bose in asserting a patent on a computer-based music systems against a group of competitors and in related Patent Office proceedings. Obtained partial reversal of adverse summary judgment decision on appeal. Case reported at 558 Fed. Appx. 1012.

*Intelligent Implant Systems, LLC v. Blackstone Medical, Inc. d/b/a Orthofix Spinal Implants* – Represented Intelligent Implant Systems in successful AAA arbitration relating to spinal implants in which the arbitration award required Orthofix to assign certain patent rights to Intelligent Implant Systems.

*Smith & Nephew, Inc. v. Biomet, Inc.* – Represented Smith & Nephew in patent infringement case

against its competitor Biomet asserting a patent on meniscal repair devices. Obtained preliminary injunction against Biomet. Case reported at 2005 WL 3132313.

*Baxter International, Inc. v. Fresenius Medical Care Holdings, Inc.* – Represented Fresenius in defending patent infringement cases brought by its competitor Baxter on patents for dialysis machines. All asserted Baxter patents successfully invalidated in *ex parte* and *inter partes* reexaminations.

*Smith & Nephew, Inc. v. Ethicon, Inc.* – Represented Smith & Nephew in asserting a patent on orthopedic suture anchors against its competitor Ethicon. Case settled favorably after a successful appeal to the Federal Circuit reversing an adverse summary judgment decision. Case reported at: 276 F.3d 1304, 54 USPQ2d 1889.

*Valois of America, Inc. v. Risdon/AMS (USA), Inc.* – Represented the accused infringer, Valois, in a patent case on a bottle fixation mechanism for perfume spray pumps. Case settled favorably. Case reported at: 183 F.R.D. 344.

*ArthroCare Corp. v. Smith & Nephew, Inc.* – Represented the accused infringer, Smith & Nephew, in a patent case on RF electrosurgery instruments used in arthroscopic surgery. Obtained favorable Federal Circuit ruling following adverse jury verdict. Case reported at 406 F.3d 1365.

*Howmedica Osteonics Corp. v. Wright Medical Technology, Inc.* – Defended the accused infringer, Wright Medical, in a patent case on an orthopedic knee prosthesis.

*Vos Systems, Inc. v. Voice Signal Technologies, Inc.* – Defended the accused infringer, Voice Signal, in a patent case on voice-activated light switches.

*Articulate Systems, Inc. v. Confidential* – Represented a local software company, Articulate Systems, in asserting a patent on computer voice recognition against a confidential opponent. Successfully defended four summary judgment motions brought by opponent. Case reported at: 66 F.Supp.2d 105; 53 F.Supp.2d 78; 53 F.Supp.2d 62.

*Prenovitz v. Smith & Nephew Dyonics, Inc.* – Defended the accused infringer, Smith & Nephew Dyonics, in a patent case on a videoarthroscope used to visualize the inside of a joint during arthroscopic surgery. Won case on motion to dismiss. Also won award of 100% of the attorneys' fees paid by Smith & Nephew. (Non-published decision).

*Hoffman v. Wisner Classic Mfg. Co., Inc.* – Defended the accused infringer, Wisner Classic, in a patent case on a tilting mechanism used in large format cameras. Won case on motion to dismiss. Also brought successful motion to join plaintiff's counsel as a defendant to Wisner's RICO counterclaim. Settled counterclaim favorably to Wisner. Case reported at: 40 USPQ2d 1241.

*Mitek Surgical Products, Inc. v. Wright Medical Technology, Inc.* – Defended the accused infringer,

Wright Medical, in a patent case on orthopedic suture anchors. Won case on summary judgment. (Non-published decision).

*Stryker Corp. v. Wright Medical Technology, Inc.* – Defended the accused infringer, Wright Medical, in a patent case on an instrument used in orthopedic knee replacement surgery. Won case on trial. Affirmed on appeal to Federal Circuit. Case reported at: 38 USPQ2d 1732.

*Wright Medical Technology, Inc. v. Osteonics Corp.* – Represented Wright Medical in asserting a patent on an instrument system used in orthopedic knee replacement surgery. Settled case favorably after trial and two appeals to Federal Circuit. Case reported at: 122 F.3d 1440; 939 F. Supp. 65.

*Citron v. 3M* – Defended the accused infringer, 3M, in a patent case asserted against 3M's Post-It Flags. Won case on summary judgment. Affirmed on appeal to Federal Circuit. (Non-published decision).

*3M v. Johnson & Johnson Orthopedics, Inc.* – Represented 3M in asserting four patents and trade secret violations relating to fiberglass orthopedic casting tape against J&J. Won case on trial, including finding of willful infringement by J&J. The damages award amounted to \$129 million, including \$53 million in punitive damages. Affirmed on appeal to Federal Circuit. Case reported at: 976 F.2d 1559; 22 USPQ2d 1401.

*Linvatec Corp. v. Smith & Nephew Dyonics, Inc.* – Defended the accused infringer, Smith & Nephew Dyonics, in a patent case on a magnet-coding system for cutting blades used in arthroscopic surgery. Settled case favorably during mediation.

*AFC Cable Systems, Inc. v. Alflex Corp.* – Represented AFC Cable in asserting patent and trademark/ trade dress claims relating to armored electrical cable. Settled case favorably.

*Atlas Travel Int'l v. Uniglobe Travel (Northeast States), Inc.* – Represented local travel agency in a declaratory judgment trademark and franchise case against franchiser. Settled case favorably during mediation.

## Insights

### Presentations

- “Enforcement of Surgical Methods/Techniques,” *Boston Patent Law Association Conference* (January 2018)

# Recognition

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- *Best Lawyers in America* (2022)
- Best Lawyers in New England – *The Wall Street Journal* (2017, 2018)
- *Best Lawyers in America*, IP Litigation (2016, 2018-2021)
- 500 Leading Lawyers in America – *Lawdragon* (2012)
- Top Attorneys in Massachusetts – *Boston Magazine* (2013, 2014)
- Massachusetts *Super Lawyer* (2004, 2013-2014)
- Top Rated Lawyers, *Boston Globe* (2015)
- Top Rated Lawyer, Litigation, Appellate and Intellectual Property, Martindale-Hubbell (2015)
- AV rated by Martindale-Hubbell for 18 years