





Michael E. Florey

Senior Principal

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Overview

About Michael

Michael Florey is a senior principal in the Twin Cities office of Fish & Richardson P.C. A member of the award-winning intellectual property litigation group, his practice emphasizes complex intellectual property litigation. He has substantial trial experience including jury and bench trials, *Markman* and preliminary injunction hearings with live witnesses, and trial before the American Arbitration Association. Mr. Florey is a leading national expert in the area of patent damages. He has extensive experience in intellectual property and product liability cases involving products regulated by FDA. Mr. Florey is highly skilled at cases that rest in large part on expert analyses, testing, and testimony.

Mr. Florey was named a 2016 “IP Client Service All-Star” in BTI Consulting Group’s survey of general counsel from the world’s largest corporations. He was one of only 30 intellectual property (IP) attorneys selected nationwide for the list, which highlights lawyers who deliver superior dedication to client service. Mr. Florey was selected for inclusion in 2015 and 2016 editions of Chambers USA: America’s Leading Lawyers of Business as a leader in his practice area and has been named to the 2010-2016 and 2019-2021 lists of Best Lawyers® in America. He was selected as a Minnesota Lawyer “Attorney of the Year” in 2013 and “Lawyer of the Year” in 2021 by Best Lawyers® in America for patent litigation.

Mr. Florey is active in efforts to promote diversity in the legal profession. He is a member of the firm’s diversity committee and is the firm’s member representative for Twin Cities Diversity In Practice. Mr. Florey represented Fish & Richardson at the inaugural Women In Law Hackathon competition sponsored by Diversity Lab, Stanford Law School, and Bloomberg Law. He was a member of “Team 4,” whose proposal was awarded second place in this national competition designed to bring forward innovative solutions to increase retention and promotion of women in large law firms.

Focus Areas

Services

- Litigation
- Appellate
- Experts on Experts
- Patent Litigation
- Product Liability and Mass Torts

Industries

- Life Sciences
- Medical Devices

Education

J.D. *magna cum laude*, University of Illinois College of Law (1988)

B.A. *cum laude*, Economics, Carleton College (1985)

Experience

U.S. District Court Trials

Gilead Sciences, Inc. v. Merck & Co., Inc. – Trial counsel for Gilead Sciences in a patent case involving a revolutionary antiviral cure for Hepatitis C. Lead counsel for the damages phase of trial, securing a jury verdict awarding only 10% (\$200 million) of the damages sought by Merck (\$2 billion). Subsequently the Court conducted a bench trial on equitable issues, and declared the asserted patents unenforceable, resulting in no liability to Gilead.

Baxter Healthcare Corp. v. Fresenius Medical Care Holdings Inc. – Trial counsel for Fresenius in a patent case involving automated peritoneal dialysis cyclers. Only two of eight patents originally asserted by Baxter survived for trial. At trial, jury verdict of no infringement by Fresenius. Summarily affirmed on appeal pursuant to Rule 36.

Fresenius USA, Inc. v. Baxter International, Inc. – Trial counsel for Fresenius in a patent case involving hemodialysis machines. Jury returned a verdict of invalidity for all four asserted patents. Following adverse JMOL, three patents knocked out on first appeal. Remaining claims from fourth patent invalidated in *ex parte* reexamination while damages remand from appeal was pending. Obtained important precedential ruling from Federal Circuit on second appeal ending case based on USPTO's cancellation of the remaining claims in reexamination. *Fresenius USA, Inc. v. Baxter International, Inc.*, 721 F.3d 1330 (Fed. Cir. 2013).

Braun Medical, Inc. v. Terumo Medical Corp. – Trial counsel for Terumo in a patent case involving safety guards for needles. Presented the developer of the accused product – who spoke no English – at trial through an interpreter. Jury verdict declared 15 of 16 claims not infringed or invalid. Verdict paved the way for a design-around to avoid the sole remaining claim.

Mars, Inc. v. Coin Acceptors, Inc. – Trial counsel for Mars in a patent case involving vending machine coin sensors. Presented Mars' case at a bifurcated damages bench trial following affirmance of liability judgment on appeal, resulting in a damages and prejudgment interest award of \$27 million. Verdict affirmed: *Mars, Inc. v. Coin Acceptors, Inc.*, 527 F.3d 1359 (Fed. Cir. 2008).

Mayo Clinic v. Dr. Peter Elkin – Trial counsel for Mayo Clinic in trade secret case regarding natural language processing software. Conducted trial cross-examination of defendant Dr. Elkin, leading to a jury verdict of willful trade secret misappropriation in favor of Mayo, and an award of attorneys' fees to Mayo by the Court. Verdict affirmed at 2013 WL 4516191 (8th Cir. 2013).

Cargill, Inc. v. Canbra Foods Ltd and Dow Agrosciences LLC – Trial counsel for Cargill in a patent case relating to high stability canola oil. Jury verdict in favor of Cargill finding infringement, patent validity and damages.

St. Jude Pacesetter v. Cardiac Pacemakers, Inc. – Trial Counsel for St. Jude Pacesetter in a patent case involving pacemakers and defibrillators. Jury verdict in favor of St. Jude Pacesetter pursuant to the doctrine of equivalents, including a multi-million dollar damages award.

Federal Circuit Appeals

Group One Ltd v. Hallmark Cards, Inc., 407 F.3d 1297 (Fed. Cir. 2005) – Argued on behalf of Hallmark Cards. Established precedential standard for correction of errors in patent claims during litigation, resulting in invalidation of Group One patent.

Bruno Indep. Living Aids, Inc. v. Acorn Mobility Servs. Ltd., 394 F.3d 1348, 1354 (Fed. Cir. 2005) – Argued on behalf of Acorn Mobility. Established that in evaluating a claim of inequitable conduct, intent to deceive may be inferred from the lack of a credible explanation for non-disclosure of material prior art. As a result, the Court affirmed the judgment – including an award of substantial attorneyfees – in favor of Acorn.

Arbitration Trials

Mayo Clinic Jacksonville v. Alzheimer’s Institute of America – Trial counsel for Mayo Clinic in AAA arbitration relating to a license agreement to transgenic mice. Arbitrator found no breach of license by Mayo Clinic.

Immtech International, Inc. v. Neurochem, Inc. – Trial counsel for Immtech in AAA arbitration relating to a pharmaceutical license agreement. Panel (3 arbitrators) found breach of agreement by Neurochem and awarded attorneys’ fees.

Rochester Medical Corp. v. Mentor Corp. – Trial counsel for Rochester Medical in AAA arbitration over technology license agreement. Panel (3 arbitrators) decision in favor of RMC.

Patent Cases Resolved Without Trial

Gilead Sciences, Inc. v. AbbVie, Inc. – Litigation counsel for Gilead Sciences in a five patent case relating to a revolutionary antiviral cure for Hepatitis C. Resolved by settlement.

Baxter International, Inc. v. Fresenius Medical Care Holdings, Inc. — Litigation counsel for Fresenius in a patent case concerning automated peritoneal dialysis cyclers. Resolved by settlement.

Mayo Clinic Jacksonville v. Alzheimer’s Institute of America – Litigation counsel for Mayo Clinic in a patent case relating to the “Swedish Mutation,” an important genetic mutation linked to familial Alzheimer’s disease. Resolved when AIA’s patent held invalid in another proceeding.

Robinson Labs v. Walls Industries – Litigation counsel for Walls Industries in a patent case specialized fabric for hunting apparel; represented defendant and obtained summary judgment of patent invalidity based on both obviousness and derivation of invention.

Minnesota Mining & Manufacturing Co. v. North American Science Associates – Litigation counsel for 3M in a patent case involving rapid readout hospital sterilization indicators. Resolved by settlement following summary judgment of infringement entered against NAMSA.

Spectral Diagnostics, Inc. v. Biosite – Litigation counsel for Spectral Diagnostics in a patent case relating to rapid cardiac marker test panels. Resolved by settlement.

Minnesota Mining & Manufacturing Co. v. American Diagnostic Corp. – Litigation counsel for 3M in a

patent case regarding stethoscope eartips. Resolved by settlement, including an agreed injunction against ADC.

Marshfield Clinic v. Cargill, Inc. – Litigation counsel for Cargill in a patent case relating to micro-satellite repeat assays. Resolved by settlement.

Trade Secret Cases Resolved Without Trial

Pioneer Hybrid Int'l v. Cargill, Inc. – Litigation counsel for Cargill in a trade secret case involving allegations of worldwide misappropriation of corn germplasm, and patent infringement. Leader of team that conducted investigation and remediation in two dozen U.S. locations and in over twenty countries outside the U.S. Resolved by settlement with Pioneer clearing substantial portion of Cargill's germplasm, allowing client to complete sale of business unit.

Medtronic, Inc. v. Joseph Chaudoin — Litigation counsel for Kyphon, Inc. and a prospective employee in non-compete suit brought by Medtronic. Resolved by settlement/corporate acquisition.

Trademark/Trade Dress Cases

Amazon Bookstore v. Amazon.com – Litigation counsel for Amazon Bookstore in trademark case relating to use of the mark “Amazon” with book sales. Resolved by settlement.

eYield Solutions, Inc. v. Crows Hybrid – Litigation counsel for eYield Solutions to clear use of “Rooster.com” website and marks. Resolved by settlement with client obtaining clearance.

RAVE Sports v. Overtons – Litigation counsel for RAVE Sports in a Lanham Act unfair competition action relating to water trampolines. Resolved by settlement.

Copyright Cases

Bird Brain, Inc. v. Menard, Inc. – Litigation counsel for Menard in copyright case regarding decorative copper garden sprinklers. Resolved by settlement.

Technology Agreements

CSM/Purac v. Cargill, Inc. v. Dow Chemical Co. – Counsel for Cargill in complex dissolution of two joint ventures relating to lactic acid technology and production.

Woodcraft Industries v. JBA International, Inc. – Counsel for Woodcraft in a dispute over ERP software contract. Resolved by settlement.

Recognition

- Named to the *Best Lawyers® in America* lists (2022)
- Named “Lawyer of the Year” by *Best Lawyers® in America* for Litigation – Patent (2021)
- Recognized as a notable practitioner in Intellectual Property, *Chambers USA: Minnesota* (2015-2021)
- Graduate of the National Institute for Trial Advocacy Intensive Trial Skills Program (1994)

Clerkships

U.S. District Court for the District of Minnesota, The Honorable Robert G. Renner, 1988 - 1990