

## Alan B. Clement

Partner

New York

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Alan's more than 25 years of hands-on experience in intellectual property litigation, including significant lead counsel roles in complex multipatent trials, makes him a trusted advocate for handling high-stakes disputes.

### OVERVIEW

Alan is a first-chair intellectual property litigator who represents clients in the life sciences, pharmaceutical, and biotechnology sectors. He has more than 25 years of experience in courts throughout the U.S., including the jurisdictions that have extensive patent litigation dockets. Alan is particularly experienced with Hatch-Waxman litigation, including cases involving multiple parties and patents.

Alan's ability to explain highly complex technologies into easy-to-understand concepts to judges and juries has helped his clients obtain optimal results at the trial and appellate levels. His diverse practice also spans trademark and trade dress litigations, where he has served as lead counsel on matters and achieved favorable settlements and early dismissals. Alan's wealth of litigation experience provides him with unique insight in helping clients navigate and strategize on protecting and defending their intellectual property rights.

Alan's comprehensive practice includes patent and trademark prosecution and opinion work in areas such as petrochemicals, hydrocarbon cracking processes, pharmaceuticals, and lubricants. He assists clients in the U.S. and around the world, and also offers clients experience in chemical patent interferences.

### REPRESENTATIVE MATTERS

- *Rhone Poulenc v. Andrx* (Dilacor). Counsel in litigation relating to sustained release diltiazem Geomatrix patents, resulting in a settlement for Andrx.
- *Hoechst-Marion-Roussel v. Andrx* (Cardizem CD). Counsel in litigation relating to stair-step sustained release diltiazem patents, resulting in a settlement for Andrx.
- *Biovail v. Andrx* (Tiazac). Trial counsel in litigation relating to a surface-active agent sustained release diltiazem patent, securing a verdict of noninfringement at trial (verdict was upheld on appeal). Decisions reported at 158 F.Supp. 2d 1318 (S.D. Fla. 2000) and 239 F. 3d 1297 (Fed. Cir. 2001).
- *Glaxo v. Andrx* (Wellbutrin SR). Secured a judgment of noninfringement from the trial court on summary judgment regarding sustained release hydrogel matrix and dissolution bupropion patents. This summary judgment decision later was overturned by the appeal court; however, the case was later settled and did not proceed to trial. Decisions reported at 190 F.Supp. 2d 1354 (S.D. Fla. 2002) and 344 F. 3d 1226 (Fed. Cir.

2003).

- *Pfizer v. Andrx* (Glucotrol XL). Counsel in litigation regarding four osmotic push-pull sustained release glipizide patents through the summary judgment stage and obtained a settlement on behalf of Andrx.
- *Bristol-Myers v. Andrx* (Monopril). Trial counsel in litigation relating to a fosinopril formulation patent and secured a verdict of noninfringement. Bristol-Myers did not appeal the decision of the trial court. Decision reported at 343 F.Supp. 2d 1124 (S.D. Fla. 2004).
- *Astra v. Andrx* (Toprol XL). Counsel in litigation regarding a salt selection sustained release metoprolol technology two patent action through the summary judgment stage, securing summary judgment of invalidity for double patenting and summary judgment of unenforceability for inequitable conduct. The double patenting invalidity ruling was upheld on appeal. Decisions reported at 2006 WL 120343 (E.D. Mo. 2006) and 494 F. 3d 1011 (Fed. Cir. 2007).
- *Abbott v. Andrx* (Biaxin XL). Counsel in litigation relating to three extended-release clarithromycin pharmacokinetic and side effect patents to the trial stage through the preliminary injunction phase, including appeal, fact, and expert discovery, and preparation of pretrial stipulation; settled case prior to trial. Decision reported at 473 F. 3d 1196 (Fed. Cir. 2007).
- *McNeil v. Andrx* (Concerta). Counsel in litigation regarding a sustained release methylphenidate dissolution and pharmacokinetic two patent case up to trial. The court found invalidity and noninfringement, and the invalidity ruling was upheld on appeal. Decisions reported at 607 F.Supp. 2d 614 (D. Del. 2007) and 603 F. 3d 935 (Fed. Cir. 2010).
- *Eli Lilly v. Apotex* (Strattera). Lead trial counsel in a method of treating ADHD with atomoxetine patent, obtaining invalidity ruling from the district court. Decision reported at 676 F.Supp. 2d 352 (D. N.J. 2009). The case was reversed on appeal.
- *Senju v. Apotex* (Zymar). Trial counsel in obtaining an invalidity ruling on gatifloxacin eye drop solution patents from the district court. Decisions reported at 717 F.Supp. 2d 404 (D. Del. 2010) and 836 F.Supp. 2d 196 (D. Del. 2011). The invalidity ruling was upheld on appeal.
- *Senju v. Apotex* (Zymar). Counsel in litigation regarding a gatifloxacin eye drop solution reexamination patent case, obtaining summary judgment of invalidity based on res judicata. Decision reported at 2012 WL 4062325 (D. Del. 2012).
- *Acorda v. Apotex* (Zanaflex Capsules). Lead trial counsel in obtaining noninfringement and invalidity rulings on a patent regarding the food effect of tizanidine capsule formulation from the district court. Decision reported at 2011 WL 4074116 (D. N.J. 2011); both noninfringement and invalidity rulings were upheld on appeal.
- *Endo v. Roxane* (Opana ER). Lead counsel for Roxane in three litigations in NJ, NY, and Delaware regarding sustained release, pharmacokinetic, renal failure, and impurity oxymorphone patents.
- *Jazz v. Roxane* (Xyrem). Lead counsel in litigation involving 15 patents on sodium oxybate solution, method of making, method of treatment, drug-drug interaction, pharmaceutical kit, and exclusive computerized distribution system; resulting in settlement.
- *Meda v. Sun* (Astelin). Counsel in litigation regarding an azelastine nasal formulation patent, leading to a settlement for the client regarding azelastine formulation.
- *Shire v. Roxane* (Vyvanse). Lead counsel in a case regarding 18 lisdexamfetamine prodrug, x-ray crystallography, pharmacokinetics, methods of preventing abuse, and formulation patents.
- *Senju v. Apotex* (Zymaxid). Counsel in litigation regarding a follow on gatifloxacin eye drop solution reexamination patent.
- *Merck v. Roxane* (Noxafil Suspension). Lead counsel in litigation regarding three posaconazole patents on chemical composition, polymorph, and formulation; case settled.
- *Takeda v. Roxane* (Uloric). Lead counsel in litigation regarding febuxostat patents covering polymorph and particle size, resulting in settlement.
- *Amarin v. West-ward* (Vascepa). Lead counsel in litigation regarding 15 patents covering methods of treatment with icosapent.
- *Gilead Sciences, Inc. v. Sunshine Lake Pharma Co.* (Vemlidy). Lead counsel for Sunshine Lake in a multidefendant, multipatent litigation involving tenofovir alafenamide anti-viral medication; case settled.
- *In re Entresto* (Sacubitril/Valsartan) patent litigation. Lead counsel for Novugen Pharma in multidistrict patent

litigation regarding sacubitril/valsartan heart medication; case settled.

- *In re Jublia*. Lead counsel for Alembic Pharmaceuticals in multidefendant, multipatent litigation involving efinaconazole toenail medication; case settled.
- *Curia IP Holdings v. Salix Pharmaceuticals* (Xifaxan). Lead counsel in currently pending patent infringement litigation involving rifaximin polymorphic mixtures.

#### Other Intellectual Property Litigation

- *XRiver Corp. v. Gillis*. Lead counsel in art law litigation.
- *Pado v. SG Trademark Holding Co.* (handheld percussion massager). Counsel in patent, trademark, and copyright infringement litigation.
- *NineStars Group v. Factory Direct Wholesalers* (induction activated containers). Lead counsel in securing summary judgment of invalidity on asserted patents.
- *Sears v. MLI Associates* (Deicing chemicals). Lead trial counsel in securing jury trial verdict of noninfringement regarding two deicing formulation patents.
- *In re Gartside* (Hydrocarbon cracking quench technology). Lead counsel in an interference proceeding through appeal to the Court of Appeals for the Federal Circuit. decision reported at 203 F. 3d 1305 (Fed. Cir. 2000).
- *Spectrum v. Sterilite* (Crate technology). Lead counsel for patentee in a patent infringement proceeding through appeal to the Court of Appeals for Federal Circuit regarding a crate stacking patent. Decision reported at 164 F. 3d 1372 (Fed. Cir. 1998).
- *Seaco v. MLI Associates* (Deicing chemicals). Lead counsel in a patent interference proceeding through appeal to the district court. Decision reported at 652 F.Supp. 2d 244 (N.D.N.Y. 2009).
- *The Original Creatine Patent Company v. Optimum Nutrition*. Handled a patent infringement action involving a creatine formulation nutraceutical patent; secured settlement for client.
- *Forsythe v. The Body Shop* (Colorings trademark). Lead counsel in trademark action, securing a settlement for the client.
- *Innovative USA v. Sterling* (Book technology). Lead counsel in patent infringement action regarding a magnetic book patent, secured settlement for client.
- *Versa Valve v. Bifold* (Valve technology). Counsel in trade dress infringement action on oil platform blow-off valve design, and secured settlement for client.
- *Innovative USA v. Innovative Education* (Trademark). Lead counsel in securing a settlement for client in a trademark infringement action.
- *Innovative USA v. Firefly* (Book technology). Lead counsel in securing a settlement in a patent infringement action.

#### AWARDS

- *IAM Patent 1000* (2015-2025)

#### TOP AREAS OF FOCUS

- Health Care + Life Sciences Intellectual Property
- Intellectual Property
- Patent Prosecution, Counseling + Portfolio Management
- Trademark + Copyright

#### ALL AREAS OF FOCUS

- Health Care + Life Sciences

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- [Patent Prosecution, Counseling + Portfolio Management](#)
- [Trademark + Copyright](#)

## **PROFESSIONAL EXPERIENCE**

- Process engineer, Precision Valve Corporation, 1984-1988

## **EDUCATION AND CERTIFICATIONS**

### **EDUCATION**

- Pace University, J.D., 1990, Dean's List
- University of Massachusetts Amherst, B.S., 1984

### **BAR ADMISSIONS**

- New York

### **COURT ADMISSIONS**

- U.S. District Court, Southern District of New York
- U.S. District Court, Eastern District of New York
- U.S. District Court, Northern District of New York
- U.S. Court of Appeals, Federal Circuit

## **SPEAKING ENGAGEMENTS**

- Speaker, "[Charting the Evolving Boundaries of the Safe Harbor 35 USC § 271 in View of Recent Case Law](#)," ACI 21st Annual Paragraph IV Disputes 2025, April 29, 2025.
- Speaker, "Appreciating the Magistrate's Role in Settlement Discussions," 14 Annual Paragraph IV Disputes Conference, October 6, 2020.
- Panelist, "Preparing for the Future: Calling Attention to Products Coming Off-Patent and Devising Forward-Thinking Portfolio Strategies," ACI Biosimilars Conference, September 2020.
- Speaker, "Preparing for the Future: Calling Attention to Biological Products Coming Off-Patent and Devising Forward-Thinking Portfolio Strategies," 11 ACI Summit on Biosimilar & Innovator Biologics, September 24, 2020.
- Speaker, "ANDA Filing and Litigation," 9 Annual Pharma IP Conference, March 4-6, 2020.

## **PUBLICATIONS**

- Co-author, "Back to Basics: Despite Winning the Appeal, Failure to Appeal a Preliminary Injunction Bond Constituted Waiver of Damages," Locke Lord QuickStudy, July 31, 2024.
- Co-author, "How Much Claim Construction Significance? – Extrinsic Evidence and Significant Figures," Locke

Lord QuickStudy, November 14, 2023.

- Co-author, “Impact of US v. Arthrex,” Locke Lord QuickStudy, July 29, 2021.
- Co-author, “*Bayer v. Baxalta*: Meeting the Large Molecule Enablement Bar,” Locke Lord QuickStudy, March 23, 2021.
- Co-author, “Functional Antibody Claims: Setting the Bar for Enablement,” Locke Lord QuickStudy, February 12, 2021.