



## Thomas P. Heneghan

### SENIOR COUNSEL

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### OVERVIEW

A seasoned litigator, Tom admires and advocates for the fervor of inventors and the commitment of business leaders.

As a trial lawyer, Tom assists clients facing complex intellectual property and business litigation. He focuses on patent litigation but also represents clients in trademark, copyright and trade secret matters. He helps clients across technical fields, including pharmacology, chemistry, animal reproduction, polymer processing and metallurgy. He also has extensive experience in Hatch-Waxman litigation on behalf of generic pharmaceutical companies.

Tom defends and prosecutes all aspects of intellectual property and commercial claims, including investigation, examination and defense of expert witnesses. He is also highly skilled in settlement negotiation, discovery management, jury and bench trials, and appellate practice. Tom recognizes that oftentimes the best result for a client is reached by avoiding the fight and finding a resolution that allows for everyone to return to the job they do best: innovating and creating opportunity.

He has extensive experience handling patent litigation matters in the Western District of Wisconsin rocket docket. Because patent litigation often crosses state boundaries, Tom's practice is national in scope. Clients have trusted Tom to represent them in state and federal courts in California, Delaware, Illinois, North Carolina, Indiana, Florida, Kentucky, Colorado, Mississippi, New York, Texas, Washington, Minnesota and Wisconsin. He also has argued before the U.S. Court of Appeals for the Federal Circuit, the U.S.

### Industries

Healthcare  
Life Sciences  
Education

### Services

Intellectual Property Litigation  
Trade Secrets & Business  
Information Protection  
Litigation & Alternative Dispute  
Resolution  
Trademarks  
Generic Drug / ANDA Litigation  
Animal Health & Production  
Section 337  
Commercial Litigation  
Copyrights

Court of Appeals for the Seventh Circuit and the Courts of Appeals of Wisconsin and Illinois.

## Experience

- Represented financial institution accused of infringing copyright of computer software related to the operation of Automated Teller Machines. The case involved two different computer languages and two different natural languages and was a complete victory for our client, including an award of all attorneys' fees.
- Represented a computer retailer selling compatible replacement parts directly to consumers who was accused of trademark infringement. The case was resolved by settlement during post-trial motions.
- Represented a national aggregator of large animal veterinary practices against a claim of tortious interference by individuals who were unsuccessful in joining a premier equine veterinary practice. Also represents this client on a national basis in relation to its many subsidiaries and partners.
- Represented three of 29 joint defendants, consolidated in Maryland District Court, in patent litigation related to a pre-press printing process. Also chosen to act as defense liaison counsel.
- Represented Ashland County, Wisconsin, in CERCLA contribution action seeking to establish accountability for massive cleanup of coal tar pollution in Chequamegon Bay in Lake Superior. After a lengthy bench trial, the client was found not to be a covered person under CERCLA, and a judgment of no liability was entered in favor of the client. An appeal was withdrawn shortly thereafter without contribution from the client.
- Represented plaintiff, a supplier of animal reproduction technologies, in patent and trademark litigation related to agricultural products. The matter also involved simultaneous patent disputes between the same parties in Canada and Germany and trademark disputes in Mexico and China. After favorable summary judgment ruling, the matter settled in all jurisdictions worldwide on terms favorable to the client.

## Experience

- Represented plaintiff, a manufacturer of toys and nursery products, in a patent infringement action over patents related to infant drink containers. Settled on terms favorable to the client shortly after the lawsuit was filed.
- Counseled plaintiff in copyright infringement and trade secret misappropriation claim over the design of a turf management machine. After formal mediation, settled on terms favorable to the client.
- Advised plaintiff, a manufacturer of automotive and heavy-duty products, in patent infringement litigation related to vehicle backup viewing systems. Negotiated a business solution for the client.
- Defended a manufacturer of stainless steel, multi-ply and cast aluminum cookware in a false patent marking case both before and after changes to false marking remedies under the Smith-Leahy America Invents Act. Matter settled on terms favorable to the client after trial and the passage of the Smith-Leahy America Invents Act.
- Defended national hardware store cooperative in patent infringement litigation related to a secure website for the creation of advertising. Settled on terms favorable to the client.
- Represented generic pharmaceutical manufacturer in patent litigation under the Hatch-Waxman Act. Settled on terms favorable to the client.
- Represented generic pharmaceutical manufacturer in patent infringement litigation under the Hatch-Waxman Act. The case was tried to verdict in Delaware District Court.
- Defended client in a trade secret action claiming disclosure of an allegedly confidential process for manufacturing soy flour in a patent application. Settled on terms favorable to the client.
- Represented plaintiff in a patent infringement action over a patent related to heat treatment of rotary cutting blades. After favorable claim construction ruling, settled on terms favorable to the client.

## Experience

- Defended a manufacturer of container handling systems in an infringement action over patent for liquid container filling apparatus. After favorable summary judgment ruling, settled on terms favorable to the client.
- Served as trial and appellate counsel representing active pharmaceutical ingredient manufacturer in a judicial patent interference matter. Trial court judgment in favor of the client, affirmed on appeal.
- Defended a food manufacturer against a preliminary injunction seeking to shut down client's business based on an alleged misappropriation of trade secrets. After extended injunction hearing, the court ruled in favor of the client.
- Represented a golf course developer against a claim of trademark infringement and false advertising. Negotiated a business solution for the client.
- Secured victory in federal district court on behalf of a transgender female inmate in Wisconsin, protecting her constitutional right to necessary medical care while incarcerated.
- Secured judgment of noninfringement on behalf of a generic pharmaceutical manufacturer in Delaware District Court. The ruling was not appealed.

## Recognition

- *The Best Lawyers in America*®, Commercial Litigation, 2024
- Wisconsin Access to Justice Commission, Wisconsin Pro Bono Honor Society, 2020

## Education

- J.D., DePaul University College of Law
  - with honors
- B.S., University of Wisconsin-Oshkosh

## Admissions

- Wisconsin
- Illinois
- Minnesota
- U.S. District Court, Eastern District of Wisconsin
- U.S. District Court, Western District of Wisconsin
- U.S. District Court, Northern District of Illinois (Trial Bar)
- U.S. District Court, District of Minnesota
- U.S. Court of Appeals, Seventh Circuit
- U.S. Court of Appeals, Federal Circuit

## Community Leadership

He first got involved with West Madison Little League when his son and daughters played baseball and softball, and he is now serving his second term as president of the Board of Directors.

Tom also is a longtime member of the Wisconsin Chamber Orchestra's Advisory Board of Directors.



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