



## Philip D. Segrest, Jr.

**PARTNER**

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### OVERVIEW

Philip is an experienced litigator in patent and intellectual property matters in a wide variety of technologies and a registered patent attorney with a technical background in physics and computer related technologies.

He has particular depth of experience managing pharmaceutical patent litigation under Abbreviated New Drug Act (ANDA), helping generic manufacturers bring their products to market at affordable, competitive prices. Philip also has extensive litigation and patent prosecution experience in information and computer related technologies, including data compression, e-commerce systems, business methods and other technologies in electrical, mechanical and chemical technical arts.

Philip's litigation experience also includes all phases of patent, copyright, trademark and trade secret cases. He has prepared and prosecuted patent applications in diverse technologies, including markdown optimization, data mining, call centers, voice recognition and other areas. His litigation and counseling experience also includes general commercial litigation and government contracts. A former Federal Circuit law clerk, Philip has also briefed and/or argued dozens of appeals in federal and state courts.

### Industries

Life Sciences  
Manufacturing  
Technology  
Transportation

### Services

Appellate  
Commercial Contracting  
Copyrights  
Generic Drug / ANDA Litigation  
Intellectual Property  
Intellectual Property Counseling  
Intellectual Property Litigation  
Litigation & Alternative Dispute Resolution  
Patent Preparation & Prosecution  
Pharmaceutical Manufacturers  
Post-Issuance Proceedings  
Software Development & Licensing  
Trade Secrets & Business Information Protection  
Trademarks

## Experience

- Aided client FlatWing Pharmaceuticals in demonstrating that 39 claims in 4 patents filed by competitor were unpatentable.
- Aided Sigmapharm Laboratories in arguing for claim construction. Court adopted proposed construction verbatim.
- Represented Apotex Inc. and Apotex Corp. on their generic risedronate monthly product against patent infringement allegations by Warner-Chilcott Co. LLC, Hoffmann-La Roche Inc. and The Proctor & Gamble Co. Obtained summary judgment of non-infringement on U.S. Patent No. 6,165,513 and summary judgment of invalidity for obviousness on certain claims in U.S. Patents Nos. 7,192,938 and 7,718,634, *Warner Chilcott Co., LLC v. Teva Pharm. USA, Inc.*, 37 F. Supp. 3d 731 (D. Del. 2014), overcame motion for a temporary injunction and enabled timely product launch, and prevailed in upholding results at the Federal Circuit as counsel arguing appeal on behalf of multiple co-defendants, *Warner Chilcott Co., LLC v. Teva Pharm. USA, Inc.*, 594 F. App'x 630 (Fed. Cir. 2014)
- Represented Teh Seng Pharmaceutical Mfg. Co. Ltd. and TWi Pharmaceuticals Inc. in a patent infringement case alleging their generic version of Endo's Lidoderm transdermal patch infringed U.S. Patents Nos. 5,741,510, 6,096,334, and 5,827,529. The case was favorably settled on the eve of trial. *Endo and Teikoku Pharma v. TWi and Teh Seng*, Case No. 12-848 (D. Del. 2014)
- Represented Apotex Inc. and Apotex Corp on their generic ibandronate monthly product against patent infringement allegations by Hoffmann-La Roche Inc. Overcame preliminary injunction motion and enabled timely product launch, obtained summary judgment of invalidity for obviousness on U.S. Patents Nos. 7,410,957 and 7,718,634, and prevailed in upholding results at the Federal Circuit on appeal. *Hoffmann-La Roche Inc. v. Apotex Inc.*, 748 F.3d 1326 (Fed. Cir.), cert. denied, 135 S. Ct. 878, 190 L. Ed. 2d 704 (2014)

## Experience

- Represented BSN, Inc., on its nutritional supplement products against allegations by Iovate Health Science, Inc., and University of Florida Research Foundation, Inc., that it infringed U.S. Patent No. 6,100,287. Argued Federal Circuit appeal that prevailed in upholding judgment that the patent was invalid as anticipated by advertisements published in muscle magazines. *Iovate Health Sciences, Inc. v. Bio-Engineered Supplements & Nutrition, Inc.*, 586 F.3d 1376 (Fed. Cir. 2009)
- Represented Apotex, Inc., and Apotex Corp. on their generic ofloxacin otic ear drop product against allegations by Daiichi Sankyo, Inc., that it infringed U.S. Patent No. 5,401,741. Prevailed on appeal at the Federal Circuit in striking down the patent as invalid on grounds of obviousness. *Daiichi Sankyo v. Apotex*, 501 F.3d 1254 (Fed. Cir. 2007)
- Represented Apotex, Inc., and Apotex Corp. on appeal defending their generic amlodipine besylate product against allegations by Pfizer, Inc., that it infringed U.S. Patent No. 4,879,303. Prevailed on appeal at the Federal Circuit in striking down the patent as invalid on grounds of obviousness. *Pfizer v. Apotex*, 480 F.3d 1348 (Fed. Cir. 2007)
- Represented Rockwell International Corporation on appeal defending its heavy-duty truck transmissions against allegations by Eaton Corporation that it infringed U.S. Patent 4,850,236. Prevailed on appeal at the Federal Circuit (reversing a jury verdict) that the patent was not infringed because the preamble limited the claim. *Eaton Corp. v. Rockwell Int'l*; 323 F.3d 1332 (Fed. Cir. 2003)
- Represented Datalect Computer Services, Ltd., in obtaining an equitable adjustment (damages) for breach of a computer maintenance contract by the U.S. Army in Europe. *Datalect v. Computer Servs. Ltd., v. United States*, 56 Fed. Cl. 178 (2003)

## Experience

- Represented Conexant Systems, Inc., on their modems implementing the v.42bis data compression standard against allegations that the standard infringed U.S. Patent No. 4,366,551. Obtained summary judgment of laches (cutting off past damages), prevailed on summary judgment of non-infringement, and successfully defended result in the Federal Circuit on appeal. *Holtz v. Conexant Sys., Inc.*, 56 F. App'x 470 (Fed. Cir. 2002)
- Represented Somfy S.A. on their window blinds with a pull cord mechanism against allegations by Springs Windows Fashions Divisions, Inc., that it infringed U.S. Patent No. 5,328,113. Argued Federal Circuit appeal that reversed adverse claim construction and resulted in remand leading to a settlement on favorable terms. *Somfy, S.A. v. Springs Window Fashions Div., Inc.*, 6 F. App'x 895 (Fed. Cir. 2001)
- Represented General Electric co. on electric motors in air conditioners in suit naming multiple manufacturers throughout the industry. Prevailed on defense of laches for client in seminal case recognizing the duty of a patentee to monitor industry activity. *Wanlass v. General Electric Co.*, 148 F.3d 1334, 46 USPQ2d 1915 (Fed. Cir. 1998)
- Published cases in state court matters: *Watkins v. Harper*, 984 So. 2d 472 (Ala. Civ. App. 2007) (prevailed on client's right to seek declaration to quiet title); *Ex parte Verbena United Methodist Church*, 953 So. 2d 395 (Ala. 2006) (prevailed on mandamus seeking change of venue for client); *Scott v. Boykin*, 900 So. 2d 410 (Ala. 2004) (prevailed in protecting client's discharge as executor in probate proceedings); *McClellan v. Pennington*, 895 So. 2d 892 (Ala. 2004) (prevailed in protecting client's title against attempt to impose a purchase money resulting trust); *Noble v. Baker*, 892 So. 2d 936 (Ala. Civ. App. 2004) (prevailed in protecting holder in due course of negotiable instrument against claim disputing consideration)

## Recognition

- *The Best Lawyers in America*®, Patent Law, 2024
- Martindale-Hubbell AV Preeminent

## Education

- J.D., University of Alabama School of Law
- B.S., University of Alabama
  - Physics
- B.S., University of Alabama
  - Applied Mathematics

## Admissions

- U.S. Supreme Court
- U.S. Court of Appeals, Federal Circuit
- U.S. Court of Federal Claims
- U.S. Court of Appeals, Seventh Circuit
- U.S. District Court, Northern District of Illinois
- Illinois
- U.S. District Court, Middle District of Alabama
- Alabama
- U.S. Patent and Trademark Office

## Clerkships

- The Hon. Marion T. Bennett, U.S. Court of Appeals, Federal Circuit, 1994-1995
- The Hon. John P. Wiese, U.S. Court of Federal Claims, 1993-1994
- The Hon. Eric G. Bruggink, U.S. Court of Federal Claims, 1992-1993



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