



John D. Luken

Partner
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John focuses his practice on patent infringement litigation and appeals, as well as complex commercial and other intellectual property litigation. He has handled patent infringement cases involving a variety of services and products, including commercial forms and related software, software-related business method patents in the printing and financial services industries, metal beverage cans and closures, surface coal mining blasting methods, liquid beverage concentrates and related packaging, automated barge refurbishing methods, service station petroleum equipment, and retail security products.

While his practice currently focuses largely on patent infringement matters, John has handled a wide variety of other types of complex litigation matters, ranging from securities, commodities, RICO and fraud claims arising out of complicated derivatives transactions to shareholder derivative litigation, environmental litigation, business and government contracts cases, and ERISA class action cases. Clients appreciate his ability to prioritize their needs and objectives and to approach matters flexibly and creatively - rather than in a one-size-fits-all manner. John's methods help complex matters be resolved favorably, expeditiously and cost-effectively.

He is also an active member of the influential Sedona Conference Working Group on Electronic Document Retention and Production (WG-1), participating in several Sedona drafting teams, including the Case for Cooperation (urging more rational, expeditious, and less expensive discovery processes).

John is the recipient of a number of community leadership awards from the United Way and from the Cincinnati Bar Association. For the last 10 years, he has taken up distance running and has completed 20 full marathons.

Services

- Intellectual Property
- Litigation
- Intellectual Property Litigation

Education

- Stanford Law School (J.D., 1981)

- Northwestern University (B.A., 1978)
 - Economics

Bar Admissions

- Ohio

Court Admissions

- U.S. Supreme Court
- Federal Circuit Court of Appeals
- U.S. Court of Appeals for the Sixth Circuit
- U.S. District Court for the Southern District of Ohio

Affiliations/Memberships

- Downtown Cincinnati, Inc.
 - Clean and Safe Committee
 - Past board member
 - Past Executive Committee member
- United Way of Greater Cincinnati
 - Counsel
 - Ohio Public Policy Committee chair
 - Board past vice-chair
- Hamilton County Office of Maternal and Infant Health and Infant Mortality Reduction
 - Board member
 - Past board chair
- Leadership Cincinnati, Class XXIV
- Northwestern University Alumni Admission Council
 - Member
 - Host of Annual Interview Sundays

Distinctions

- *Best Lawyers*® for Commercial, Intellectual Property and Patent Litigation
- *Ohio Super Lawyers*® for Intellectual Property Litigation (2008 - present)
- Peer Review Rated AV in *Martindale-Hubbell*
- Community Service Award from the Cincinnati Bar Association
- Geier Family Leadership Award for Community Service from the United Way of Greater Cincinnati

Experience

Patent Law – Alleged Infringement

John Luken served as lead appellate counsel to the appellees in a patent dispute concerning alleged infringement of two patents of directed beverage can ends and the methods of joining them to can bodies. Mr. Luken briefed and argued the case in the Federal Circuit, obtaining affirmance of a favorable ruling from the trial court.

Ohio Willow Wood v. Alps South

John Luken served as lead appellate counsel for The Ohio Willow Wood Company (OWW), a manufacturer of prosthetic products, which came to Dinsmore after it had lost an infringement trial against a competitor, been enjoined from selling new products, held in contempt of the injunction, and ordered to pay nearly \$20 million in damages to its chief competitor.

On behalf of OWW, Mr. Luken and the Dinsmore appellate team successfully obtained a stay of the contempt order from the Federal Circuit, which allowed OWW to begin selling its products again. After briefing and argument, the Federal Circuit reversed the lower court's judgment and dismissed the complaint for lack of standing, thereby overturning the judgment against OWW. Mr. Luken also successfully opposed a petition for rehearing and rehearing *en banc*.

NPE Experience

We have defended clients in challenges to their patents from a wide variety of NPEs. Several representative examples of patents we have defended are below:

- **Cascades Publishing Innovation, LLC:** U.S. Patent 8386484
- **Data Speed Technology LLC:** US Patent 5,867,686 – High speed real-time information storage system
- **eTagz:** US Patent 7,503,502 – Computer readable hang tag and product
- **eTagz:** US Patent 7,703,686 – Consumer computer-readable product label apparatus and method
- **eTagz:** US Patent 6,298,332 – CD-Rom product label apparatus and method
- **eWatch:** US Patent 6,970,183 – Multimedia surveillance and monitoring system including network configuration
- **Helfrich Patent Licensing:** Various US Patents related to mobile device technology
- **Honeywell International, Inc.:** Various US Patents related to bar code and QR code technology
- **Infinite Data, LLC:** US Patent 5,790,530 – Message passing multiprocessor system)
- **Innovatio IP Ventures:** Various US Patents related to local area network radio frequencies and multiple channel wireless access
- **Lemolson Foundation:** Various US Patents relating to bar code technologies
- **Lodsys:** US Patent 7,222,078 – Interactive applications (smartphone apps)
- **Mobile Logistics:** Various US Patents related to transportation yard management systems

- **MPHJ (formerly Project Paperless):** Various US Patents related to computer architecture and document management
- **Pragmatus Telecom, LLC:** US Patent 6,322,231 – Method and system for coordinating data and voice communications via customer contract channel changing system using voiceover IP)
- **Round Rock:** Various US Patents related to radio frequency identification
- **TPQ Development LLC:** US Patent 5,412,730 – Encrypted data transmission system employing means for randomly altering the encryption keys)
- **US Ethernet Innovations:** Various US Patents related to Ethernet connections and point of sale
- **Wireless Media:** Various US Patents related to transportation yard management systems
- **You Technology, Inc.:** Various US Patents related to biometric technology

Beneficial Franchise Company v. BankOne, et al.

We were lead counsel for defendants Republic Bank & Trust and River City Bank in patent infringement case involving business method patents purportedly covering systems and software relating to tax refund anticipation loan processing. We successfully settled the case after prevailing with respect to novel contractual third-party claims which we brought against an affiliate of the plaintiff patent owner. *Beneficial Franchise Company v. Bank One, et al.*, Civil No. 00 C 2441 (N.D. Ill. 2001).

Chemed Corporation v. PCI Holding Corp., et al.

We represented Chemed Corporation and its subsidiary Vitas Healthcare Corporation in litigation which we initiated on behalf of Chemed to collect disputed amounts owed as a result of a sale of a former Chemed home health care subsidiary. The defendant asserted numerous counterclaims for breach of contract and alleged fraud and misrepresentation in connection with the sale. After the filing of summary judgment and numerous other pretrial motions, the case was successfully settled shortly before trial.

Duramed Pharmaceuticals, Inc. v. Schein Pharmaceuticals

We were lead counsel for Schein Pharmaceutical in litigation brought by Duramed Pharmaceuticals concerning the conjugated estrogens drug sold as "Cenestin." After extensive discovery and motion practice, the case settled shortly before trial in 2000 with Duramed paying Schein \$15 million and agreeing to pay an additional \$15 million if certain profit milestones for Cenestin were met. *Duramed Pharmaceuticals, Inc. v. Schein Pharmaceuticals*, Case No. A9705498 (Hamilton County Court of Common Pleas)

Indian Coffee v. Procter & Gamble

Dinsmore & Shohl defended our client, Procter & Gamble, against a claim in excess of \$1 million in a suit alleging predatory pricing and Robinson-Patman price discrimination. The case resulted in a directed verdict for the defense, and later settlement.

Large Charitable Representation

Ongoing representation of several of the largest public charities in the Greater Cincinnati region. Representation includes advising on securing and maintaining tax-exempt status, compliance with state and federal tax statutes, and general corporate governance.

Microsoft Windows Antitrust Class Action Litigation (Ohio and Kentucky Cases)

We served as counsel for Microsoft Corporation in Ohio and Kentucky class action antitrust cases involving the Windows operating system. We obtained dismissal of the Kentucky class action suit against Microsoft (Jefferson Circuit Court, July 21, 2000), which was affirmed by the Kentucky Court of Appeals in the first Windows antitrust case to be decided by a state appellate court, *Arnold v. Microsoft Corp.* (Kentucky Court of Appeals, November 21, 2001), and the Kentucky Supreme Court declined to hear a further appeal. We obtained dismissal of a similar Ohio state court suit (Hamilton County Court of Common Pleas, August 6, 2002), which was affirmed by the First District Court of Appeals, *Johnson v. Microsoft Corp.*, 155 Ohio App. 3d 626 (2004), and by the Ohio Supreme Court, 106 Ohio St. 3d 278 (2005).

Nash Finch Company Litigation

We were lead counsel for grocery wholesaler Nash Finch Company and its subsidiary Super Food Services, Inc. in "Fleming" suit brought against Nash Finch/Super Food by grocery retailers alleging breach of contract, fraud and other claims arising out of prices charged retailers for goods and services. Summary judgment for Nash Finch and Super Food on all claims was affirmed on appeal. *Super Food Services v. Munafo, Inc.*, 2000 Ohio App. LEXIS 779. We have subsequently been lead counsel for Nash Finch and Super Food in numerous other cases from 2001 through the present in Ohio and Kentucky involving breach of contract, fraud, antitrust, consumer protection and related claims.

OPW Fueling Components/PISCES Underground Piping Patent Litigation and Related Cases

We are lead counsel for OPW Fueling Components and its PISCES subsidiary in numerous cases involving underground piping patents. Our victory in the initial case permitted OPW to enter into a substantial new product line. We defeated a preliminary injunction motion, obtained a very expedited discovery and trial schedule per OPW's need for prompt resolution, and prevailed at trial before the U.S. District Court in Philadelphia over contractual and patent challenges to OPW's right to purchase certain patents and to enter into this business. *Total Containment, Inc. v. Osborne, et al.*, No. 96 7241 (E.D. Pa. 1997). This led to further infringement and contract litigation in which we have represented PISCES (the OPW affiliate which purchased these patents) against several infringers and licensees, which have also been resolved favorably for PISCES. *PISCES By OPW v. Total Containment*, No. C-1-01-0063 (S.D. Oh. 2001); *Environ Products v. PISCES By OPW*, No. 02-865 (E.D. Pa. 2002-2003); *PISCES By OPW v. Environ Products*, No. C-1-02-292 (S.D. Oh. 2002-03); and *PISCES By OPW v. Total Containment*, No. CIV-02-0543 (S.D. Oh. 2002-04). This also led to currently pending infringement litigation involving these patents. *PISCES By OPW v. Advanced Polymer Technology*, No. C-1-04-178 (S.D. Oh. 2004-present).

Patent Infringement Litigation

On behalf of our client, we developed and implemented cost-effective strategies for defending a patent enforcement suit.

Patent Infringement Litigation

Under Section 337 of the Tariff Act of 1930, the ITC investigates claims of unfair trade practices occurring in import trade. An increasing number of intellectual property lawsuits are tried before the ITC because ITC cases proceed faster than cases litigated in federal district courts, where most IP litigation takes place. The ITC also offers a unique set of remedies to companies engaged in patent disputes. The ITC has become a global forum for high-stakes patent cases brought by both U.S. and foreign companies intent on protecting valuable U.S. based IP rights. Dinsmore & Shohl LLP has a great deal of experience successfully representing parties in 337

investigations. For example, on behalf of our client, a \$1 billion industrial machinery manufacturer, we reached successful settlements against multiple respondents importing industrial machinery from China, Germany, Italy and France.

Procter & Gamble v. Bankers Trust

We were counsel for Procter & Gamble in litigation in 1994-96 against Bankers Trust arising out of two substantial derivatives contracts entered into by P&G. The litigation raised numerous issues of first impression involving the application of contract, fraud, negligence and fiduciary duty, federal and state securities and commodities and RICO law to derivatives contracts, and led to Sixth Circuit and Supreme Court decisions on issues including the discoverability of materials relating to Federal Reserve Board examination of regulated banks and the power of District Courts to enjoin publication of materials filed under seal under protective orders. The case involved massive discovery of hundreds of thousands of pages of documents and thousands of audiotapes and computer files, and required extensive computerization for discovery management. The matter settled shortly before trial, resulting in a \$165 million recovery by P&G, the largest (in absolute or percentage terms) of any such publicly reported derivatives recovery.

Trademark Infringement Litigation

Enforcement of client trademark rights in U.S. Federal Courts in the food manufacturing and restaurant industries.

White Consolidated Industries, Inc. v. Westinghouse Electric Corporation

We were lead counsel for Westinghouse Electric Corporation in litigation involving contract, CERCLA and other claims against Westinghouse arising out of clean up of TCE contamination at a manufacturing facility sold by Westinghouse to plaintiff. We obtained summary judgment for Westinghouse on all claims, which was affirmed by the Sixth Circuit Court of Appeals. *White Consolidated Industries, Inc. v. Westinghouse Electric Corporation*, 179 F.3d 403 (6th Cir. 1999).

Publications

November 1, 2018

Recent Trends in Reasonable Royalty Damages in Patent Cases, in Remedies in Intellectual Property Cases (Defense Research Institute 2018)

October 31, 2012

TROLLS: Unlike Zombies, They Want Your Money Not Your Brains