

Skilled in the Art: Morgan Lewis Duo Getting Into the Mix at CAFC

By Scott Graham

Julie Goldemberg argued her first appeal to the **Federal Circuit** in October 2018 in *Telefonaktiebolaget LM Ericsson v. TCL Communications*. The court issued its decision 13 months later, just as the Morgan Lewis associate was back in the courthouse to argue her second appeal.

On their way out of the courtroom, as the attorneys were turning on their smartphones, a client asked Goldemberg about the status of *TCL*. “She won it,” said partner **Jason White**, who’d just found the news in his email.

“And I said, ‘Well, we *hope* we won it. That’s a lot of enthusiasm,’” Goldemberg recalls telling him. “And then Jason said, ‘No, no, you won it. The decision just came down while you were arguing.’”

TCL is one of six wins Goldemberg and **Morgan Lewis partner Will Peterson**, each shy of their 40th birthdays, have notched together at the Federal Circuit since August.

Goldemberg is a registered patent attorney who clerked for **Federal Circuit Chief Judge Sharon Prost**, while Peterson is an appellate lawyer who clerked for **Supreme Court Justice Clarence Thomas**. They work across departments at the firm and are quick to credit colleagues for developing the substance of their cases, but it’s hard not to notice their names turning up on CAFC opinions.

Their streak started with a Section 101 win in *iNO Therapeutics v. Praxair Distribution*, in which the appellate court found a method of treating infants with nitric oxide gas ineligible for patent protection. Across the lectern from Peterson in that case was former Solicitor General **Seth Waxman of Wilmer Cutler Pickering Hale and Dorr**. Peterson and the Morgan Lewis team eked out a 2-1 decision that opened the door to generic competition.

Peterson and Goldemberg have also teamed up with White on a series of Federal Circuit wins for **Techtronic Industries** involving the **Ryobi Garage Door Opener**. They include a decision in August knocking out most of a \$22 million district court judgment and injunction on eligibility grounds; a decision last week reversing a finding of infringement and an exclusion order from the **International Trade Commission**; and a decision Tuesday affirming a **PTAB** decision that invalidated another patent.

Peterson says the Techtronic cases would make a great exam question on administrative procedure and federal courts. “Sometimes you have a lot of different decisions in different forums, occurring at different times, and trying to figure out how they interact, how they impact each other, is not always straightforward,” he said.



Morgan Lewis partner Will Peterson and associate Julie Goldemberg.

He and Goldemberg credit White, who argued the Techtronic cases and managed the overall strategy. “Jason was very much the general, directing different armies on multiple battlefields,” Goldemberg said.

And finally, there was the *TCL* decision in November. The Federal Circuit ruled that a 1996 article in a German technical journal was publicly available prior art that could invalidate a wireless communications patent. Morgan Lewis attorneys tracked down a former librarian from the **Technical University of Darmstadt** willing to fly to the U.S. to testify that the article would have been on the library’s shelves by June 1996, just over a year before the Ericsson patent had been filed.

Goldemberg said the case will always be special because it was her first argument to the Federal Circuit—and because her mentor, Peterson, “was right there beside me.”

Peterson called it “probably one of the best days I’ve had in a courtroom.”