



Benjamin Cappel

J.D.
partner

732.991.7285

benjamin@addyhart.com

practice areas

IP & Commercial Litigation
Inter Partes Reviews (PTAB)

Intellectual Asset Portfolio Mgmt.

Benjamin Cappel joined AddyHart LLC. in 2020 as counsel and became a partner in September 2020. His experience includes litigations in US district courts, appeals at the Federal Circuit, Sect. 337 investigations before the International Trade Commission, and *inter partes* reviews (IPR) and covered business method (CBM) reviews at the USPTO's Patent Trial and Appeal Board (PTAB).

Ben has extensive experience litigating matters in the semiconductor, information technology, pharmaceutical, social media, video-gaming, and cloud computing spaces. He has also developed litigation plans for clients, has established pre-litigation policies and procedures, and has worked with e-discovery vendors and opposing counsel to develop e-discovery plans.

Ben was formerly Senior Counsel to the YMCA of the USA in Chicago, where he managed the organization's intellectual property portfolio, obtaining, licensing, and enforcing its IP rights. During his tenure at the YMCA, he negotiated and structured agreements with professional sports leagues including the NBA and NFL, and was hired to guide and advise for a six-month period the organization's incoming general counsel in managing intellectual property issues.

From 2016 to 2018, Ben practiced intellectual property law as an associate at Sughrue Mion PLLC in Washington D.C., where he successfully litigated Hatch-Waxman matters, including *St. Regis Mohawk Tribe v. Mylan Pharmaceuticals, Inc.*—the so-called Restasis case, which was named one of the ten most influential cases of 2018 by *Law360*. Ben was a member of litigation teams working on matters involving several technologies, including

biotechnology and pharmaceuticals, computer software, automobiles, machines for applying body art, and recreational pools and tubs. His experience also includes litigating trademark and copyright disputes at the USPTO's Trademark Trial and Appeal Board (TTAB); litigating in the U.S. District Courts for a large software client; interviewing experts in advance of litigation including for Markman hearings; and helping prepare experts for testifying at trial. Ben also worked with joint defense groups to assist in managing complex matters.

Ben was formerly a Judicial Intern in U.S. District Court (D NJ) in Newark, where he assisted the Hon. Steven C. Mannion, U.S. Magistrate Judge, in managing his daily caseload, including composing legal memoranda including substantive analysis to prepare Judge Mannion for court. In 2014 he was a summer intern at Sterne, Kessler, Goldstein & Fox in Washington D.C., also receiving an offer from employment from that firm.

Ben earned his J.D. from the Seton Hall University School of Law and earned his B.A. *cum laude* from Rutgers – The State University of New Jersey. He works in our Chicago office.

representative cases: Federal Circuit and PTAB

- *Fintiv, Inc. v. PayPal Holdings, Inc.* (Fed. Cir.) Represent appellant patentee on appeal of an adverse decision from the W.D. Texas on a patent relating to digital wallet technology.
- *Mozido, Inc. v. Apple, Inc.* (Fed. Cir.) Represent appellant patentee on multiple appeals from PTAB decisions relating to patents on digital wallet technology.
- *PerDiemCo LLC v. NexTraq LLC* (Fed. Cir.) Represent appellant patentee on appeal from Rule 12 dismissal holding the 8 asserted patents, relating to geofencing and electronic logging technology, failed to satisfy 35 U.S.C §101.
- *Fintiv, Inc. v. Apple, Inc.* (Fed. Cir.) Represent appellant patentee on appeal from a PTAB decision relating to a patent on digital wallet technology.
- *Meta Platforms Inc. v. Thales Visionix, Inc.* Represent patentee Thales Visionix, Inc. in defense of eight *inter partes* reviews filed by Meta Platforms Technologies on Thales' portfolio of patents related to interactive gaming.

- *Cooperative Entertainment, Inc. v. Kollektive Technology, Inc.* (Fed. Cir. 2022). Successfully appealed an adverse decision from N.D. Cal. dismissing our client's patent relating to peer-to-peer content distribution as not satisfying 35 U.S.C. § 101. In a precedential opinion, the Federal Circuit vacated and remanded, holding that the pleadings satisfied FRCP 12(b).
- *Wildcat Licensing WI LLC v. Atlas Copco and Assembly Systems, LLC, General Motors, LLC, Faurecia Automotive Seating, LLC and Magna Int'l Inc.* (Fed. Cir. 2022). Represent appellant on appeal of a decision where the PTAB invalidated two Reissue patents related to automotive component manufacturing.
- *Mexichem Amanco Holding S.A. v. Honeywell Int'l. Inc.* (Fed. Cir. 2020). Represented appellant on appeal of a decision of the PTAB upholding a patent related to hydrofluorocarbons (HFO) refrigerants in automobile air-conditioning systems. Settled.
- *Honeywell Int'l. Inc. v. Mexichem Amanco Holding S.A.* (Fed. Cir. 2020). Represented appellee on two appeals of PTAB decisions invalidating patents related to HFO refrigerants used in air-conditioning systems. Settled.
- *Intel Corp., Cavium LLC, and Dell, Inc., v. Alacritech, Inc.* (Fed. Cir. 2019)
- *Cellspin Soft. V. GoPro, Inc.* (Fed. Cir. 2018)
- *Allergan, Inc. v. Teva Pharmaceuticals USA, Inc., et al.* (Fed. Cir. 2017)
- *Inter Partes* Review of U.S. Patent No. 8,633,162 IPR2017-00599 (and related IPRs)

representative litigation in US District Courts

- *Gentex Corporation, et al. v. Meta Platforms Technologies, LLC* 22-cv-08392 (N.D. Cal. 2022). Represent plaintiff Thales Visionix, Inc. in litigation against Meta for infringing five patents related to interactive gaming.
- *Rearden, LLC, v. The Walt Disney Company, et al.* (N.D. Cal. 2019)
- *Data Scape Ltd., v. Barracuda Networks, Inc.* (E.D. Cal. 2019)
- *Allergan, Inc. v. Teva Pharmaceuticals USA, Inc., et al.* (E.D. Tex. 2015)
- *Derm GmbH et al. v. Needlejig Tattoo Supply, Inc.* (D. Mass. 2017)

- *Derm GmbH et al. v. Joker Tattoo Supply LLC* (E.D. Cal. 2017)
- *Eli Lilly and Co., et al. v. Accord Healthcare, Inc., et al.* (S.D. Ind. 2014)
- *Kowa Company Ltd., et al. v. Sawai USA Inc. et al.* (S.D.N.Y. 2013)
- *Hospira, Inc. v. Amneal Pharm., LLC.* (D. Del. 2015)
- *Shire Pharm. Development Inc., et al. v. Amneal Pharm., LLC et al.* (D.N.J. 2015)
- *Forest Labs, Inc.. v. Amneal Pharm. LLC* (D. Del. 2015)

education

- J.D. Seton Hall University School of Law, 2016
- B.A., *cum laude*, Rutgers University, 2013

bar admissions

- New Jersey
- Illinois (*pending waiver*)
- U.S. District Court (D. NJ)
- U.S. Court of Appeals for the Federal Circuit

memberships

- AIPLA
- INTA
- IPLAC

publications & presentations

- "PTAB Denies Saint Regis Mohawk Tribe's Motion to Terminate based on Sovereign Immunity" (2018). *Patent Office Trials Blog*.

- “Additional discovery at the patent trial and appeal board: will requests for evidence of commercial success be a success?” (2018). *Financier Worldwide*, March 2018 Issue.
- With John M. Bird et al. *The Essential Case Law Guide to PTAB Trials*. American Bar Association.
- “Fundamental Issues in the Appellate Standard of Review of Patent Claim Construction and Why the Issue Is Moot in Practice” (2016). *Law School Student Scholarship*. 750.
- “Exploring the ITC as an Alternative Forum in ANDA Litigations” International Symposium on Pharmaceutical, Biotechnology, and Chemical Patent Mumbai, India.
- “Examining Uncertainties in the Boundaries of 271(e)(1) and the Scope of Divided and Induced Infringement: Understanding which Post-Approval Activities Fall Within the Scope of the Safe Harbor as per *Amphastar Pharmaceuticals, Inc. v. Momenta Pharmaceuticals, Inc.*” International Symposium on Pharmaceutical, Biotechnology, and Chemical Patent Laws. Mumbai, India.

media mentions

- “Standard Computer Equipment Can Support Inventive Concept under Alice Step 2.” *National Law Review* 6 Oct 2022. Addresses precedential ruling in AddyHart’s client’s favor in a case under § 101, *Cooperative Entertainment, Inc. v. Kollektive Technology, Inc.*, relating to peer-to-peer file-sharing for video and videogames.
- Karpan, Andrew. “Fed. Circ. Says Licensing Co.’s Software IP May Be Inventive.” *Law360* 28 Sep 2022. Addresses ruling in *Cooperative v. Kollektive*.
- Handler, Samantha. “Video Sharing Patent Infringement Case Revived by Appeals Court.” *Bloomberg Law* 28 Sep 2022. Addresses *Cooperative v. Kollektive*.
- Crouch, Dennis. “Eligibility: Patent’s Claims of Inventive Concept Overcome Eligibility Dismissal.” *PatentlyO* 28 Sep 2022. Addresses *Cooperative v. Kollektive*.