

WHO'S WHO | in Litigation Law

CHARLES R. HOFFMANN *Hoffmann & Baron, LLP*



Charles R. Hoffmann is a founding partner of Hoffmann & Baron, LLP with offices in Syosset, NY and Parsippany, NJ.

Hoffmann is experienced in all aspects of ex parte and inter partes representation in intellectual property law with extensive patent and trademark litigation experience on the trial and appellate levels including proceedings before the International Trade Commission as both advocate and law expert.

"US patent litigation has been in the forefront of concern for the business community," Hoffmann said.

"One of the most significant cases in recent years concerns application of the doctrine of equivalents in interpreting the scope of patent claims to determine if

infringement has occurred," Hoffmann said.

On behalf of a client, Hoffmann filed suit against a company in 1988 in the US Federal Court, claiming that certain products manufactured and sold by the company infringed on his client's patents. "The case progressed through an extensive several week evidentiary hearing before a special patent master and then a jury trial where infringement was found under the doctrine of equivalents. Consequently, the jury awarded (my client) millions of dollars in damages."

On appeal, the US Court of Appeals for the Federal Circuit (CAFC) affirmed the decision in Hoffmann's client's favor. The company then filed a petition to be heard by the US Supreme Court, which held the case in abeyance until it decided another case concerning the doctrine of equivalents.

"The Supreme Court then remanded the case to the CAFC for consideration in view of this new US Supreme Court decision. The case was eventually considered en banc with all twelve judges participating at the CAFC," Hoffmann explained.

"The CAFC reversed its earlier decision and severely limited the scope of the doctrine of equivalents, contrary to US Supreme Court precedent," he said.

"We then appealed to the Supreme Court, and were successful in convincing the Supreme Court to reverse the CAFC in view of controlling Supreme Court precedent," he said. "This thereby

reestablished a legitimate scope for the doctrine of equivalents. On remand, the CAFC again interpreted the US Supreme Court's position on the law and remanded the case to the US District Court in Boston for another trial relating to the permissible scope of the interpretation of the doctrine of equivalents."

After trial, the case has been appealed again to the CAFC. "It is presently in condition for further appeal to the US Supreme Court, virtually 20 years after the case was originally filed," Hoffmann said.

Hoffmann earned a Bachelor of Engineering degree from Rensselaer Polytechnic Institute, majoring in Mechanical and Industrial Engineering with a minor in Electrical Engineering; and earned a Juris Doctorate from New York University School of Law. He is admitted to practice in the state and federal courts of NY, the US Court of Appeals for the Federal Circuit, and the US Supreme Court. He is also registered to practice before the US Patent and Trademark Office.

Hoffmann & Baron, LLP is a full service intellectual property law firm specializing in prosecution, counseling, licensing, and litigation of patent, trademark, and copyright-related issues worldwide. The firm's practice also includes trade secrets, technology transfer, and unfair competition.

Hoffmann & Baron serves clients throughout the US and internationally. Its clients include individuals, entrepreneurial firms, universities, national research laboratories, and multinational corporations.

**For additional information, please contact Charles Hoffmann
at choffmann@hoffmannbaron.com or visit www.hoffmannbaron.com**
