

## Grace Pan

*Partner – New York*

Grace Pan focuses on patent, trademark, and other intellectual property litigation. Ms. Pan also prosecutes patent, trademark, trade dress applications before the U.S. Patent and Trademark Office, including as to writing applications, responding to office actions, and interviewing with examiners. She also handles appeals and inter partes review proceedings before the Patent Trial and Appeal Board. Ms. Pan also prepares, files, and defends copyright, trademark, trade dress, and domain name applications (including ICANN proceedings). Ms. Pan also has experience handling patent, trademark, and trade dress disputes before the International Trade Commission. She also has experience evaluating and accessing patent portfolios; and drafting freedom to operate, non-infringement and invalidity opinions.

Ms. Pan has experience with pharmaceuticals, vaccines, biomedical devices, herbicides, recombinant technology, material science, polymer chemistry, semiconductors, consumer electronics, mechanical devices, and the internet.

Ms. Pan is admitted in both Japan and Taiwan, and is a member of the Japan Federation of Bar Associations and the Taipei Bar Association. In addition to litigating before various U.S. district courts and U.S. Court of Appeals for the Federal Circuits, Ms. Pan has litigated before the Tokyo District Court, the Tokyo Intellectual Property High Court, the Taipei District Court, and the Beijing District People's Court. She has also prosecuted and defended foreign patent applications, particularly in Japan and Taiwan, and argued before trial examiners at the Japan Patent Office and the Taiwan Patent Office.



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**Languages:** Japanese, Mandarin, and Taiwanese

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### Education

**Northwestern School of Law at Lewis & Clark College**  
J.D.

**Lewis & Clark College**  
B.S.  
Major: Biology and Chemistry

### Bar Admissions

District of Columbia  
Japan (Inactive)  
New Jersey  
New York  
Taiwan

### Court Admissions

Supreme Court of New Jersey  
U.S. Court of Appeals – Federal Circuit  
U.S. District Court – S. District of NY  
U.S. District Court – E. District of NY  
U.S. District Court – D.C.  
U.S. District Court – District of New Jersey  
U.S. Patent and Trademark Office  
Gaikokuho Jimu Bengoshi, Japan

## Honors & Awards

- Chambers Global Ranking 2013 – IP Expert in US, Japan
- Chambers Global Ranking 2014 – IP Expert in US, Japan & Taiwan

## Notable Representations

- **Represented** a leading U.S. hospitality company in Southern District of New York asserting patent infringement claims involving collapsible hampers and obtained favorable judgment in favor of client.
- **Represented** a leading U.S. hospitality company in Delaware District Court asserting patent infringement claims involving shower curtain hooks and obtained a favorable claim construction which ultimately led to settlement in favor of client.
- **Represented** a national leader in animal rescue and protection asserting a FOIA claim against the government and prevailed.
- **Defended** a leading Asian unified business intelligence service provider against a claim of infringement in the Western District of Texas resulted in a settlement in favor of the client.
- **Defended** one of the two largest global semiconductor equipment manufacturers against claims of patent infringement in the Eastern District of Virginia, Court of Appeals for the Federal Circuit and ultimately prevailed with a judgment of non-infringement.
- **Represented** one of the two largest global semiconductor equipment manufacturers asserting a theft of trade secret claim against a U.S. company in the Eastern District of New York and prevailed with a large verdict against the defendant.
- **Defended and Defeated permanent Injunction** on behalf of one of America's largest retail chain that sells home decor, furniture, textiles, accessories, and gifts in a trade dress claim in Eastern District of North Carolina.
- **Represented** one of the largest generic pharmaceutical companies in an ANDA litigation for a blockbuster drug which resulted in being the first generic of the blockbuster drug on the market.
- **Defended** a leading Asian optical media original equipment manufacturer against a patent troll in a patent infringement claim in the Central District of California and settled favorably on behalf of the Asian company.
- **Defended** an American multinational information technology company against a patent troll in a claim of patent infringement in the Eastern District of Texas, forcing acceptance of a Rule 68 offer of compromise.
- **Defended** world's largest original equipment/design manufacturer against an American multinational technology company that develops, licenses, supports a range of software products and services devices in a breach of license claim and obtained a favorable settlement on behalf of the client.
- **Defended** one of the two largest global semiconductor equipment manufacturers against claims of breach of license agreement before the ICC arbitration and obtained favorable settlement on behalf of the client.
- **Represented** one of the largest veterinary pharmaceutical company in a patent infringement claim before the Tokyo District Court in Japan and obtained favorable decision on behalf of the client.

## Publications

- **Author**, "Getting the Deal through: Life Sciences: Taiwan" (December 1, 2017)

- **Author**, “International Licensing – Adia, in Advanced Licensing Agreements”, 2014 Ch. 20 “
- **Author**, “Getting the Deal through: Life Sciences: Taiwan” (December 1, 2016)
- **Author**, “Trolls Without Boundaries – IRP, a Newfound Application AIA did not Anticipate” (January 25, 2016)
- **Author**, “Tough Supreme Court Stance on Patent Eligibility Challenges, Software DNA – Related Inventions” (February 1, 2015)
- **Author**, “Asian Product Manufacturers, Beware: Ignore ITC 337”
- **Author**, “Complaints and Risk Un-Appealable Seizure at the Border”, Lexology (September 4, 2012)
- **Author**, “A Glimpse into The Crystal Ball – The Clinton Administration’s Policy with Regard to Intellectual Property” International Legal Strategy, 1993 (in Japanese) (Vol.2-5, pp. 11-13).
- **Co-author**, “Indirect Inhibition of Myocyte RNA and Protein Synthesis by Interleukin-1” Journal of Molecular and Cellular Cardiology, 1990 (Vol. 22,pp. 213-225)
- **Composer**, “Songs Without Words,” 2003, Piano Improvisation CD.

## Seminars

- **Organizer**, The joint global seminar between CNFi (Chinese National Federation of Industries) of Taiwan and Kilpatrick Townsend & Stockton LLP in Taiwan in 2019
- **Moderator**, The joint global seminar between CNFi (Chinese National Federation of Industries) of Taiwan and Kilpatrick Townsend & Stockton LLP in Taiwan in 2019
- **Speaker**, The joint global seminar between CNFi (Chinese National Federation of Industries) of Taiwan and Kilpatrick Townsend & Stockton LLP in Taiwan in 2019
- **Speaker**, International Licensing – Asia, presentation at the Practicing Law Institute’s seminar on Developments in Pharmaceutical and Biotech Patent Law 2013 (April 4, 2013)
- **Speaker**, International IP Litigation, presentation for the Intellectual Property Continuing Legal Education Seminar at DuPont/Widener University School of Law (October 11, 2012)
- **Speaker**, Section 103 and PTO KSR Guidelines, presentation at the Practicing Law Institute’s seminar on Prior Art, Obviousness, and the America Invents Act (June 4, 2012)
- **Speaker**, Bio 2006 Annual Convention on Japanese Appeal Practice and the PTO, EPO and JPO
- **Lecturer**, National Taiwan University, 2001.
- **Lecturer**, National Defense Medical Center, 2001
- **Speaker**, Yang Ming Medical College, 2001
- **Chair**, Bio 2007 Annual Convention on “Developments From the JPO, EPO,SIPO & USPTO

## Professional Affiliations

- American Bar Association.

- Intellectual Property Law Section of the American Bar Association.
- New York Intellectual Property Law Association.
- Los Angeles Intellectual Property Law Association.
- Japan Federation of Bar Associations.
- National Asian Pacific American Bar Association
- American Intellectual Property Law Association.
- Southern California Chinese Lawyers Association
- American Chemical Society.
- Committee on Patent, Trademark and Copyright Law of the American Bar Association