



Karen D. McDaniel

612.371.5305
kmcdaniel@merchantgould.com

Minneapolis Office
3200 IDS Center
80 S. 8th Street
Minneapolis, MN 55402 USA

612.332.5300 phone
612.332.9081 fax

Karen has spent the last two decades helping clients enforce and defend their intellectual property rights through litigation. A veteran of more than forty lawsuits involving IP, Karen has been entrusted with matters of significant economic impact to her clients. She has secured damages awards on behalf of clients totaling several hundred millions of dollars (in reported decisions), and has recovered or helped her clients to avoid paying many times that amount in confidential settlements and license agreements. Her practice is national in scope, and she has appeared in courtrooms across the country. Her areas of expertise include patent infringement trials, trademark infringement trials, and trade secret trials.

Karen has a background in chemistry, and while not exclusively focused in the life sciences area, Karen has significant experience in matters involving health and the human body. Her work includes the following technologies: synthetic casting tapes, hair enhancement formulas, stents (including self-expanding stents and drug-coated stents), stent-grafts used to treat aneurysms, nutrition formulas, cosmetics, glucose sensors, PFO occluders, vascular plugs, and spinal fixation devices, to name a few.

Karen served as in-house litigation counsel to one of the largest medical device manufacturers in the world. She has seen litigation from the client's point of view, and employs client-driven values in her practice today. Karen manages complex cases with small, well-informed trial teams, excellent communication to the client, and results that are delivered on time and within budget.

In addition to managing active lawsuits, Karen also works with clients to craft overall IP strategy, conducts pre-suit analyses to determine go/no go litigation decisions, and engages in litigation avoidance counseling.

Atlanta

Denver

Knoxville

Madison

Minneapolis

New York

Seattle

Washington DC

Karen D. McDaniel (Continued)

Education

BA, University of Wisconsin-Madison, 1983
J.D., University of Wisconsin, 1988 (cum laude)

Bar and Court Admission

United States Patent and Trademark Office, 1993
Minnesota, September, 1988
Wisconsin, June, 1988
District Court for the District of Minnesota
District Court for the Eastern District of Wisconsin
District Court for the Western District of Wisconsin
Court of Appeals for the Federal Circuit

Professional Affiliations

American Bar Association, nominated as Fellow
American Intellectual Property Lawyers Association
Minnesota State Bar Association

Representative Cases

Allergan v. Lifetech, et al. (Latisse litigation), Patent action involving patents related to method of use of prostaglandins. Represented Defendant Lifetech. Obtained stipulation of non-infringement in 2010 following favorable Markman ruling on behalf of client Lifetech.

Atlanta

Medtronic v. AGA Medical, Patent action involving 4 patents asserted against devices for heart defect and peripheral vascular repair. Obtained \$57 million jury award in July, 2009 on behalf of client Medtronic. Equitable issues tried in December, 2009. Settlement reached in March, 2010.

Denver

Medtronic v. W.L. Gore, Patent action involving 6 patents asserted against endovascular devices for treating abdominal aortic aneurysms. Confidential settlement agreement reached before trial in 2009.

Knoxville

Medtronic/JNJ Arbitrations, Series of 5 arbitrations related to multiple patent families of both Medtronic and Johnson & Johnson. Confidential settlement agreement entered into by parties resolving all arbitrable issues.

Madison

Talent Plus v. PDI, First-chaired bench trial in Eastern District of Virginia resulting in successful defense of all claims brought against client, Personnel Decisions International. Reported decision.

Minneapolis

HealthPartners v. HES, First-chaired case that HealthPartners brought against former software consultant relating to use of software code; issues of trade secrets and copyright presented.

Multimillion dollar settlement, Secured settlement on behalf of client against client's former law firm that failed to timely secure foreign patent rights. Developed settlement scenario and concluded favorable multimillion dollar malpractice settlement for client.

New York

Trademark Portfolio Enforcement, Engaged in first-chair work covering all aspects of trademark portfolio enforcement on behalf of clients in the health care industry, including district court litigation and multiple oppositions before the TTAB. Approximately half a dozen cases handled over multiple years.

Seattle

PDI v. Dobbs Temporary Services d/b/a Pro Staff, Represented PDI in trademark infringement case involving multiple trademarks.

Washington DC

Lockwood v. Volm Bag Company, Defended client Volm Bag Company against claims of antitrust and patent infringement.

Karen D. McDaniel (Continued)

3M v. Beautone, ITC proceeding relating to enforcement of patents covering Post It® Notes.

Toro v. Grizzle, Trade secret action relating to former employees who developed business in competition with Toro's irrigation business.

Toro v. White Consolidated Industries, Patent infringement action related to blower vacs.

Century v. Chevron, Patent infringement action related to wrecker technology, brought against client, Chevron.

Novartis v. Nutrition Medical, Represented Novartis in connection with patent infringement matter relating to a nutritional formula. Case presented issues of inventorship, claims of inequitable conduct, and reexamination proceedings before the Patent and Trademark Office.

Chasteen v. Arctic Cat, Represented Arctic Cat in trade secret case related to snowmobile industry.

Kay v. Ecolab, Represented Ecolab in patent infringement action related to industrial cleaning solutions.

Riverwood v. Mead, Represented Mead in patent infringement case related to beverage bottling industry.

CSA v. The Gap, Represented design company in case against The Gap relating to copyright infringement.

3M v. Norton, Represented 3M in enforcing certain patents relating to grinding wheel technology against Norton.

Atlanta

3M v. Johnson & Johnson, Patent infringement action involving seven patents relating to synthetic orthopedic casting tapes, \$129 million for 3M; verdict upheld by the Federal Circuit. Case was tried successfully in a 12-week bench trial before a Special Master. Verdict upheld on appeal before the Federal Circuit. Reported district court and appellate decisions.

Denver

3M v. Carapace, Follow on case to 3M v. Johnson & Johnson. 3M prosecuted the same patents against Carapace as it had against J&J.

Knoxville

3M v. Smith & Nephew, Follow on case to 3M v. Johnson & Johnson. 3M prosecuted the same patents against Smith & Nephew as it had against J&J. Reported decision.

IBM v. Seagate, Trade secret action involving magneto resistive computer heads and alleged misappropriation by former IBM employee. At issue was the doctrine of inevitable disclosure, among other things.

Madison

Haagen-Dazs multidistrict litigation, Successful resolution of multiple franchisee lawsuits against client Pillsbury.

Minneapolis

Pillsbury v. National Union, \$53 million jury verdict for Pillsbury on insurance coverage case.

New York

Publications and Awards

AV Peer Review Rating by Martindale-Hubbell

“Damages in the Post Rite-Hite Era: convoyed Sales Illustrate the Dichotomy in Current Damages Law,” Journal of the Patent and Trademark Office Society, Vo. 78, No. 7, July 1996.

Seattle

“Proving Damages in Patent Litigation,” Selected Legal Papers, American Intellectual Property Lawyers Association (AIPLA) 1993.

Washington DC

Who's Who in American Law, Who's Who Among Rising Young Americans, Madison's Who's Who

Karen D. McDaniel (Continued)

Editor, Wisconsin International Law Journal, 1988.

Team Member, National Moot Court Competition, University of Wisconsin Law School, 1987; advanced to regional-level competition.

Teaching and Lectures

Teaching:

Past Adjunct Professor at William Mitchell College of Law, teaching various intellectual property courses.

Lectures:

"Strategic IP Management: Reality or Myth?" 2011 Midwest Intellectual Property Institute, September, 2011.

"Positioning Your Case for Success – Early Case Strategies and Tactical Considerations," Medical Device Patent Litigation, American Conference Institute, New York City, January, 2011.

Intellectual Property for Employment Lawyers, Webcast, Minnesota CLE, May, 2010.

"Supersize Me: Damages Claims in Patent Litigation," Minnesota CLE, April, 2010.

Presenter of Intellectual Property Topics in Advanced Employment Issues Seminar, Minnesota CLE, January, 2010.

Atlanta

Moderator/Presenter in Intellectual Property Webcast Series: Wither the Business Method Patent? Bilski and Beyond, March, 2009.

"Making Sense of the Dollars and Cents: Damages in Patent Infringement Actions," The 2003 Midwest IP Institute, September, 2003.

Denver

"Use of Experts in Trade Secret Litigation: Ipse Dixit and the Court Will Nix It," Winning Trade Secret Cases, Minnesota CLE (MSBA), May, 2003

Knoxville

"Basics of IP Litigation," Introduction to IP Litigation, Minnesota CLE (MSBA), June, 2001

"Developing an Overall Plan and Realistic Budget for Corporate Discovery," Managing and Taking Corporate Discovery, Minnesota CLE (MSBA) October, 2000

Madison

"The Big Business of Patents: The Role of the Federal Circuit in Establishing Value," Patents, the Evolving Law, and the CAFC, Minnesota CLE (MSBA) October, 2000

Minneapolis

"Internet Remedies: How to Get the Bad Guys Off your Domain," Minnesota Institute of Legal Education, February, 2000.

Course Chair, Trade Secrets from a Business Point of View, Minnesota CLE (MSBA) December, 1999

New York

"Valuation and Assessment in Disputed Intellectual Property Matters," Litigation in Intellectual Property Cases Seminar, Minnesota CLE (MSBA), February, 1999

Seattle

Course Chair, Presenter, "Trade Secrets: Issues Surrounding Litigation," Minnesota CLE (MSBA), April, 1998

"Intellectual Property Issues in Employment Relationships," Minnesota Institute of Legal Education, July 1996.

Washington DC

"Patent Damages in the Post-Rite-Hite Era," William Mitchell College of Law seminar on Intellectual Property Law and Litigation, April, 1996.

Karen D. McDaniel (Continued)

"Jury Trials and the Art of Storytelling," Upper Midwest Civil Litigation Institute, December, 1993.

"Proving Damages in Patent Litigation," American Intellectual Property Lawyers Association (AIPLA), 1992 Annual Meeting.

Atlanta

Denver

Knoxville

Madison

Minneapolis

New York

Seattle

Washington DC