

# Daniel W. McDONALD



## Patent litigator secures big wins despite changes

Through changing opposition and changing procedures, Daniel W. McDonald won major victories for clients in patent cases in 2015.

McDonald, a partner in the Minneapolis office of intellectual property law firm Merchant & Gould, led a team that secured \$14.5 million in damages for Bloomington-based Rudolph Technologies Inc. and a permanent injunction against Camtek Ltd. for infringement of Rudolph's patent on a semiconductor inspection system.

The Rudolph case took a decade to resolve, during which the opposing party changed counsel nearly half a dozen times, McDonald said.

"Each one would try to attack things from a little different angle," said McDonald, who has been in private practice for three decades. "To withstand all these different, well-respected law firms coming in and getting this good decision, maybe that's a little unique aspect of the case. It's especially satisfying knowing that [Rudolph] has been rewarded for their patience."

McDonald also was the lead partner of the Merchant & Gould team that has won rulings on behalf of Medtronic Inc. that invalidated patents owned by Robert Bosch Healthcare Systems under different patent review procedures, the newer inter partes review system and the procedure it replaced.

"We had to stay on top of the changes in the law," McDonald said. "It was a bit of a leap of faith into this new inter partes review system because it was untested when we had the option to use that. But we thought it fit our situation and it turned out pretty good."

In 2015, the U.S. Patent Trial and Appeal Board ruled that four Bosch patents were invalid after McDonald initiated inter partes review proceedings, a new procedure that took effect in 2012 for attacking patents on the basis of prior art consisting of patents or publications. McDonald previously succeeded in having nearly a dozen Bosch patents deemed invalid under the previous patent verification procedure.

"We have had some great success with Dan McDonald," Jeff Hohenshell, senior patent attorney at Medtronic, said regarding what he looks for in outside counsel for inter partes reviews. "Dan went up against somebody who was not nearly as familiar with patent office procedures, and it wasn't a fair fight. Dan really shined."

Working with business owners and inventors is one of the best parts of his job, McDonald said. Those include Susan Maxwell, who invented and patented a system for attaching mated pairs of shoes and with whom he last year conducted a continuing legal education course about gender issues in intellectual property.

McDonald served as the trial counsel for the final jury trials and appeal for Maxwell, who triumphed over retailers that infringed on her patent, which expired in 2003.

McDonald, who has engineering and law degrees from the University of Minnesota, has been a member of the board of directors of University of Minnesota Alumni Association and is serving as board chair in 2016.

"I believe the University of Minnesota is the single-most important entity in Minnesota's success economically and otherwise," McDonald said. "I feel an obligation to give back because I've benefited so much from this wonderful career that I have more than anything else because of the education I got at the U."

— Todd Nelson

