

Grace Pan

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Overview

Grace Pan focuses on patent, trade dress, trade secret, and other intellectual property litigation. A registered U.S. patent attorney, she represents manufacturers across a variety of disciplines, such as pharmaceuticals, vaccines, biomedical devices, herbicides, recombinant technology, material science, polymer chemistry, semiconductors, consumer electronics, mechanical devices, and the internet. In addition to U.S.-based companies, she has particular experience with Asian OEM, ODM companies as well as representing animal health companies, including the first blockbuster drug for pets.

A native speaker of Mandarin Chinese, Taiwanese, and Japanese, Grace has a deep understanding of cultural nuances and sensitivities and firsthand experience in various international forums. This enables her to effectively bridge the gap between American and Asian clients and provide tailored service to Asian clientele doing business in or hoping to enter U.S. markets, whether they are navigating regulatory hurdles or litigating IP or other issues.

In addition to litigating before various U.S. district courts and appellate courts, including the U.S. Court of Appeals for the Federal Circuit, she also has experience litigating before the ITC. Grace has represented both Asian and U.S. companies before the Tokyo District Court, the Intellectual Property High Court in Tokyo, the Taipei District Court, and the Beijing District People's Court. She also handles inter partes review proceedings before the U.S. Patent and Trademark Office's Patent Trial

and Appeal Board (PTAB).

Grace regularly prosecutes patent, trademark, and copyright applications before the U.S. Patent and Trademark Office, including writing applications, responding to office actions, and interviewing with examiners. Grace 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.

Grace's clients know they can always reach her. While she will never shy away from a courtroom battle, her ultimate goal is to strategically meet her client's objectives, which sometimes might mean settling or litigating as a tactical step toward an eventual joint venture.

Grace is admitted in both Japan (inactive due to residency requirement) and Taiwan and is a member of the Japan Federation of Bar Associations and the Taipei Bar Association. A lifelong animal advocate, Grace has for years served as pro bono counsel for the ASPCA.

Experience

- Represented a major U.S. brand pharmaceutical company in Hatch-Waxman litigation against generics challengers and successfully kept generics off the market beyond its first five-year exclusivity and most likely the earliest entry for generic entry of this blockbuster drug will be after the expiration of its patent.
- Represented a major U.S. brand pharmaceutical company in another Hatch-Waxman litigation involving reverse payment settlement.
- 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.
- Represented one of the world's largest veterinary pharmaceutical companies in successfully enforcing its patents against infringers in Japan for its small animal insect growth regulator product.
- Represented one of the world's largest veterinary pharmaceutical companies in successfully enforcing its vaccine patents for production animals against infringers in Japan.
- Represented a leading U.S. hospitality company in the 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, resulting 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 and 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 chains that sells home decor, furniture, textiles, accessories, and gifts in a trade dress claim in Eastern District of North Carolina.
- 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, and 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 ICC arbitration and obtained favorable settlement on behalf of the client.

Areas of Focus

Practices

- [Intellectual Property](#)

News

05.21.2024

Grace Pan Featured in Attorney at Law Magazine: “Leading Intellectual Property Litigator Grace Pan Joins Carlton Fields”

05.21.2024

Grace Pan Featured in Bloomberg Law “Wake Up Call” Newsletter

05.21.2024

Grace Pan Interviewed in Law360: “Carlton Fields Continues Growing IP Litigation Team In NY”

05.20.2024

Grace Pan Featured in Bloomberg Law: “Carlton Fields Signs IP Litigation Partner Grace Pan in New York”

05.20.2024

Leading Intellectual Property Litigator Grace Pan Joins Carlton Fields

Professional and Community Involvement

- American Bar Association
 - Section of Intellectual Property Law
- American Chemical Society
- American Intellectual Property Law Association
- Japan Federation of Bar Associations
- Los Angeles Intellectual Property Law Association
- National Asian Pacific American Bar Association
- New York Intellectual Property Law Association
- Southern California Chinese Lawyers Association

Speaking Engagements

- "Advanced Licensing Agreements: Navigating the Legal, Business and Cross-Cultural Complexities of International Licensing," Practising Law Institute (February 26, 2024)

- "Advanced Licensing Agreements: International Licensing," Practising Law Institute (February 27, 2023)
- "Advanced Licensing Agreements: International Licensing," Practising Law Institute (February 28, 2022)
- Joint Global Seminar, Chinese National Federation of Industries of Taiwan and Kilpatrick Townsend & Stockton LLP, Taiwan (2019)

Credentials

Education

- Northwestern School of Law of Lewis & Clark College (J.D.)
- Lewis & Clark College (B.S.)

Bar Admissions

- District of Columbia
- New Jersey
- New York
- Taiwan

Languages

- Japanese
- Mandarin Chinese
- Taiwanese

Court Admissions

- United States Patent and Trademark Office
- U.S. Court of Appeals, Federal Circuit
- U.S. Court of Appeals, Ninth Circuit
- U.S. District Court, Eastern District of New York
- U.S. District Court, Southern District of New York
- U.S. District Court, District of New Jersey
- U.S. District Court, District of Columbia
- Gaikokuho Jimu Bengoshi, Japan