

DAILY REPORT

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FisherBroyles Hit With Legal Mal Suit Over Missed Filings for Foreign Medical Patents

The complaint said FisherBroyles and contractor used to docket patent applications miscalculated the filing deadlines for multiple foreign applications by a year.

BY GREG LAND

Atlanta-based law firm FisherBroyles and a contractor it retained to help docket patents are accused in a new lawsuit of missing a deadline by a full year, costing a surgical products inventor millions of dollars in disallowed patents pending in Europe, Japan, Mexico, South Korea, Australia and Brazil.

The complaint filed Monday in Fulton County Superior Court said FisherBroyles partner Anthony DeVale, who oversees the firm's intellectual property practice, contracted with intellectual property consultant service CPA Global to "provide FisherBroyles with docketing services" in which CPA calculated the deadlines necessary for filing patent

applications on behalf of the firm's clients.

CPA "advertises that it is the world's leading intellectual property management and technology company" whose "highly skilled intellectual property docketing expert specialists keep on top of your business and processes to reduce the risks of costly errors and missed deadlines," the complaint said.

"What's interesting to me is that a law firm would contract out to someone else the responsibility for notifying its attorneys of their filing deadlines," said Edwin Schklar, who filed the suit with Schklar & Heim LLC partner, Maggie Heim.

Schklar said he did not know who is representing the defendants yet.



Edwin Schklar



Maggie Heim

"I should also say that this was an honest mistake," he said.

There was no immediate response Tuesday afternoon to email inquiries sent to FisherBroyles' managing partners Kevin Broyles and James Fisher, or to CPA's vice president for global industry and corporate affairs, Michael Golding.

According to the complaint, FisherBroyles had handled earlier patents for neurosurgeon and inventor James Robinson, who has patented multiple

devices and methods dealing with spinal surgery.

Among them was an interbody fusion device to be used in spinal surgeries.

In 2013, FisherBroyles and DoVale filed a provisional patent for the invention, allowing the process to proceed under a “patent pending designation.”

They also filed for a patent under the Patent Cooperation Treaty, an international treaty that allows for the filing of a patent application in more than 150 cooperating countries.

“The international patent application must be filed before the expiration of 12 months from the date of filing the provisional patent application,” the complaint said.

After filing a PCT application, the applicant has a certain amount of time to file for a patent in each individual country, usually within 30 or 31 months.

Robinson instructed DoVale to apply for patents in Europe, Canada, Mexico, China, Japan, South Korea and Brazil, with relevant deadlines in September and October of 2015.

But CPA “erroneously and negligently represented to FisherBroyles and DoVale that the deadline to enter the national phase for the Invention in most

of the designated countries was September 15, 2016, one year too late,” the complaint said.

On Sept. 14, 2016, DoVale sent Robinson an email saying they “ran into an issue today when attempting to file the above referenced matter in Japan, China, and Europe. We filed the PCT application in March of 2014, which claimed priority to a provisional application that was filed the previous March. Our docketing service provider at the time was CPA Global. They incorrectly entered the Priority date as 3/15/14, instead of 3/15/13. This means that the National Phase filing was due 9/15/2015 and not 9/15/2016.”

DoVale wrote that he had tried to “salvage the filings” but was unable to do so.

“FisherBroyles and DoVale ultimately informed Plaintiffs that Plaintiffs were not legally able to enter the national phase for the Invention in any country outside the United States,” the complaint said.

The U.S. patent process proceeded smoothly and it was granted in 2018.

As a result of the error, Robinson and his company, Spectrum Spine IP Holdings, lost “several million dollars” in royalties and revenues, along with

its intellectual property rights, it said.

The complaint includes claims for legal malpractice, breach of contract, breach of fiduciary duty, breach of legal duty, breach of private duty, unjust enrichment and damages, and seeks the disgorgement of all the funds Robinson’s company paid the firm for its work on the device.

Schklar said there had been discussions about trying to settle the dispute before he filed the complaint, but they had not borne fruit. There have not been any mediations thus far, he said.

“All I can tell you is that the parties have spent a good deal of time trying to resolve this and have been unable to do so,” he said.

Greg Land covers topics including verdicts and settlements and insurance-related litigation for the Daily Report in Atlanta.