

Naikang Tsao

Partner

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Naikang Tsao has handled a wide range of matters, including patent, unfair trade practices, false advertising, copyright, and commercial disputes. He represents clients in diverse industries, including banking, electronics, and consumer products. Naikang is a partner in the firm's Intellectual Property Litigation and Business Litigation & Dispute Resolution Practices and is the Professional Responsibility Partner and former head of the Litigation Department for the Madison office.

Naikang's experience includes representing clients in patent infringement actions involving financial business transactions, computer software and hardware, industrial machines, and consumer products, and defending class action lawsuits brought against consumer product manufacturers and retailers.

Before joining Foley, Naikang was a trial attorney for five years at the U.S. Department of Justice, during which he was awarded the U.S. Environmental Protection Agency's Gold Medal for Exceptional Service and the U.S. Department of Justice Environment and Natural Resource Division's Special Commendation for Outstanding Service. He also clerked for a federal district judge in the Northern District of Ohio.

Naikang Tsao's trial experience includes patent, false advertising and copyright infringement actions. In February 2023, for example, he led a multi-office Foley team in a six-day, plaintiff-side copyright infringement jury trial in federal court in San Angelo, Texas. The subject of the case was plaintiff Mueller Supply Co.'s online steel building configuration tool, which defendants copied and used on a competitor website without permission. The jury resolved all issues in Mueller's favor and awarded over \$2.1 million in damages. After the verdict, Naikang dictated the terms of a stipulated order to defendants, under which they paid the verdict amount in full, plus interest, and agreed to the entry of a permanent injunction. A number of the client's officers attended the trial and were pleased with the result.

Representative Experience

- In 2023, represented plaintiff steel building manufacturer as lead counsel in six-day copyright infringement trial in West Texas. Jury awarded client over US\$2.1m in defendant's indirect profits. Defendant paid the judgment amount and stipulated to a court-ordered permanent injunction.
- In 2022, two weeks after serving defendant client's final invalidity contentions, plaintiff dismissed all patent infringement claims with prejudice and dismissed client's counterclaims without prejudice in District of Delaware.
- In 2021, represented defendant insurance company in Lanham Act trademark infringement action. Obtained transfer of action from the Western District of Texas to the Eastern District of Wisconsin. Attended early mediation and secured dismissal of action at the pleading stage.
- In 2020, represented major financial institution in patent infringement action involving mobile check deposit technology in the Western District of Texas. Obtained dismissal of action at the pleading stage.
- In 2020, co-represented defendant in trade secret misappropriation action in the Western District of Wisconsin. After district court granted client's motion for summary judgment, barring plaintiff from pursuing a claim for actual damages at trial, plaintiff dismissed its remaining claims and agreed not to appeal the summary judgment decision.
- In 2019, represented defendant manufacturing company in patent infringement action involving appliance automation in the Southern District of Ohio. Obtained favorable settlement.
- In 2017 and 2018, represented defendant manufacturing company in eight patent, 71 claim infringement action brought by a Fortune 100 company in the Western District of Wisconsin. Obtained reduction in number of asserted claims to 16. Filed motion for summary judgment as to non-infringement on all eight asserted patents. Case settled on favorable terms during summary judgment briefing.
- In 2018, represented petitioner in two inter partes review (IPR) proceedings involving insect detection devices and methods. Argued both cases at trial. PTAB invalidated all challenged claims in device patent. Obtained favorable settlement of district court action based on outcome in IPRs.
- Represented defendant as lead counsel in patent infringement action brought by competitor in the District of Minnesota, involving patents directed at methods for assessing the cleanliness of rooms. Case settled on the eve of trial.
- Lead counsel for major financial institution in patent infringement multidistrict litigation, *In re Maxim Integrated Products, Inc.*, MDL No. 2345 (W.D. Pa.), involving four patents directed at mobile banking methods and applications. Co-argued at Markman claim construction hearing on behalf of 25 defendant joint defense group. Obtained favorable post-mediation settlement.
- Represented defendant in copyright infringement action brought by photographer Argued appeal and obtained affirmance of summary judgment decision in client's favor. *Kienitz v. Sconnie Nation LLC*, 766 F.3d 756 (7th Cir. 2014).
- Obtained global victory for apparel manufacturer and national retailers as lead counsel in nine consumer class action lawsuits, which challenged defendants' advertising under California, Florida, Illinois, Indiana, Maryland, Michigan, Minnesota and Wisconsin law. *Buetow v. A.L.S. Enters., Inc.*, 650 F.3d 1178 (8th Cir. 2011); *Buetow*, 2012 U.S. Dist. LEXIS 116041 (D. Minn. Aug. 17, 2012).

- Represented plaintiff healthcare system in patent litigation brought by client's patent licensee against a competitor in the Western District of Wisconsin. Case resulted in favorable jury verdict.
- Represented audio/video technology company as lead counsel in patent infringement lawsuit in the Western District of Wisconsin. Obtained favorable settlement.
- Represented major appliance manufacturer as lead counsel in patent litigation involving patent directed at internet advertising methods. At the summary judgment stage, the action settled on favorable terms.
- Represented major financial institution as lead counsel in multidefendant patent infringement action involving patents directed to online methods for applying for credit cards. Case settled on favorable terms.
- Represented plaintiff licensee in a patent license dispute with patent inventor and patent licensee, who alleged that plaintiff's license was terminated. On cross-motions for summary judgment, the district court ruled that plaintiff had underpaid royalties and was in breach of the license, but that defendants waived the right to terminate the license. After defendants appealed, plaintiff cross-appealed. The Seventh Circuit agreed with plaintiff and reversed the district court's ruling on the contract interpretation issue, and remanded for further fact-finding to determine whether the termination of the license was wrongful. *See EraGen Biosciences Inc. v. Nucleic Acids Licensing LLC*, 540 F.3d 694 (7th Cir. 2008). On remand, the case settled, and plaintiff remained licensed under the patents.
- Represented defendant apparel manufacturer in patent license dispute brought by its patent licensee. The licensee failed to make a royalty payment due defendant, and then filed an action in the Western District of Michigan seeking a declaratory judgment that defendant's patents were invalid. Briefed and argued defendant's motion for a preliminary injunction to enforce the license and to enjoin the former licensee from selling licensed products. The district court granted defendant's motion and preliminarily enjoined the former licensee from manufacturing, selling or using the licensed products. Negotiated a favorable resolution of the action, under which the licensee paid all outstanding royalties, paid all of defendant's attorney's fees and stipulated to the validity and enforceability of defendant's patents, as well as a permanent injunction.
- Represented plaintiff in this patent infringement action involving paper trimmer technology. After the jury returned a verdict in plaintiff's favor, defendant sought to vacate the damages award, arguing that plaintiff was not entitled to lost profits damages because post-judgment sales data established that defendant's new product was a non-infringing alternative. The district court denied the motion and defendant appealed. Argued appeal and obtained affirmance.

Awards and Recognition

- Selected by his peers for inclusion in *The Best Lawyers in America*® in the fields of Appellate Practice (2007 – 2010; 2013 – 2024), Intellectual Property Law (2007 – 2011), Commercial Litigation (2013 – 2024), Litigation – Intellectual Property (2014 – 2024) and Litigation – Patent (2011 – 2024)
- Named Madison's "Lawyer of the Year" in the fields of Litigation – Intellectual Property (2015), Litigation – Patent (2017, 2020, 2024) and Appellate Practice (2016, 2019 and 2021) by Best Lawyers®
- Included in the 2006 to 2016 and the 2023 Wisconsin Super Lawyers® lists for his intellectual property litigation work

- Recognized twice by the Western District of Wisconsin Bar Association for his *pro bono* work
- Serves on the Board of the Wisconsin Equal Justice Fund

Sectors

- [Health Care & Life Sciences](#)
- [Payor Provider Convergence](#)
- [Racial Justice & Equity](#)

Practice Areas

- [Business Litigation & Dispute Resolution](#)
- [Financial Institutions](#)
- [IP Litigation](#)
- [Litigation](#)
- [Patent Litigation](#)
- [Trademark, Copyright & Advertising Litigation](#)

Education

- New York University School of Law (J.D.)
 - Articles Editor, *New York University Law Review*
 - Root-Tilden-Snow Scholar
- Northwestern University (B.A., with honors)

Admissions

- Wisconsin
- California
- U.S. Supreme Court
- U.S. Court of Appeals for the 7th, 8th, 9th, 10th, 11th, D.C. and Federal Circuits
- Western and Eastern Districts of Wisconsin
- Northern, Central, and Southern Districts of California
- Eastern District of Texas