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Whether commencing a lawsuit or planning for the defence of one, the potential for counterclaims is an important strategic consideration. US civil procedure rules permit, and sometimes require, that parties pursue counterclaims in response to being sued. Antitrust counterclaims can be pursued in a variety of types of cases, but are most prevalent in intellectual property litigation. The assertion of antitrust counterclaims can increase the cost of litigation, add risk for the party bringing the lawsuit, and alter the relative positions of the parties to the case. Given the possible impact on litigation, potential counterclaims should be given careful consideration.

**What are counterclaims?**

Counterclaims are simply demands for relief made by defendants in civil cases against plaintiffs that brought the lawsuits. Counterclaims are based on the rationale that dealing with all the issues that may come in the same case saves time, money, and effort for the parties involved, including the courts. Due to this perceived efficiency, courts tend to be flexible in permitting counterclaims whenever possible.

In practice, there are two forms of counterclaims: Compulsory or permissive. As a general rule, counterclaims that are related to the same event or transaction as the original claim in the lawsuit are considered ‘compulsory’, while all counterclaims that are not related to the original lawsuit’s claims are considered ‘permissive’. The distinction between the two is more than academic, as claims that are deemed compulsory but were not timely brought as counterclaims may be barred from being asserted in future lawsuits.

Courts have not uniformly determined whether antitrust counterclaims are compulsory or permissive. For example, the Fifth and Ninth Circuits hold that antitrust claims are not compulsory in patent infringement cases. But most other circuit courts hold the opposite. Absent uniform standards across the courts, each potential antitrust counterclaim should be scrutinised to determine whether it is compulsory under the civil rules, based on whether it ‘arises out of the transaction or occurrence that is the subject matter of the opposing party’s claim’ and ‘does not require adding another claim. Notwithstanding, a few types of counterclaims in response to certain categories of claims have developed in the courts. These counterclaims can be the starting point for parties considering commencement of a lawsuit or planning a response to litigation.

**Types of potential antitrust counterclaims**

The US antitrust laws are flexible by design, and an array of antitrust counterclaims may be possible in response to any given claim. Notwithstanding, a few types of counterclaims in response to certain categories of claims have developed in the courts. These counterclaims can be the starting point for parties considering commencement of a lawsuit or planning a response to litigation.

Any antitrust counterclaim must satisfy the usual elements for the underlying antitrust cause of action. This means counterclaims based on Sherman Act section 2 monopolisation generally must show ‘(1) the possession of monopoly power in the relevant market and (2) the willful acquisition or maintenance of that power as distinguished from growth or development as a consequence of a superior product, business acumen, or historic accident’. Similarly, counterclaims based on Sherman Act section 1 restraint of trade generally must show ‘(1) the existence of a contract, combination, or conspiracy among two or more separate entities that (2) unreasonably restrain trade and (3) affects interstate or foreign commerce. In addition to showing the usual elements, a counterclaim must
show antitrust injury, which is 'injury of the type the antitrust laws were intended to prevent and that flows from that which makes defendants' acts unlawful.'

Intellectual property claims
Intellectual property litigation, by its nature, invites antitrust counterclaims – and over 100 have been pursued through the courts in recent years. Intellectual property laws, and particularly US patent laws, give owners a limited ability to exclude others from making, using, or selling the protected property. This exclusion invariably leads to competitive issues that can be raised through antitrust counterclaims. While these counterclaims can take numerous forms, there are two general contexts in which they arise that parties should consider in connection with intellectual property litigation.

First, potential antitrust counterclaims often involve how intellectual property rights were obtained. Obtaining patents or copyrights through fraud or deceit can result in forfeiture of the right to enforce the intellectual property rights. And, in Walker Process Equipment, Inc v Food Machinery & Chemical Corp, the Supreme Court held that enforcement of fraudulently obtained intellectual property can provide the basis for a section 2 counterclaim of monopolisation or attempted monopolisation. Courts have explained that such counterclaims must show (1) the intellectual property was procured by intentional fraud and (2) all the usual elements necessary to establish a section 2 claim. Aspects of both prongs, however, can hinder the successful assertion of counterclaims. For example, for the fraud prong, some courts require clear and convincing evidence of an intentional misrepresentation of a material fact, which is a standard that can be difficult for counterclaimants to meet. Similarly, it can be difficult for counterclaims to satisfy the section 2 prong, as proof of relevant markets can be complicated by the presence of patented or copyrighted property in the marketplace, and a patent does not necessarily confer market power on its holder.

The second type of potential antitrust counterclaim concerns the means by which intellectual property rights are enforced. Although holders of intellectual property generally can enforce their rights without violating the antitrust laws, courts have identified certain conduct that can provide the basis for section 2 counterclaims. One such counterclaim, recognised in Handgarde, Inc v Ethicon, Inc, is asserting a section 2 violation against a patent holder that files a lawsuit to enforce a patent while knowing it was not infringed or not valid (even if the patent had been lawfully obtained). This counterclaim, however, can be difficult because, similar to the Walker Process claim, the counterclaimant has to establish the plaintiff’s state of mind as well as the usual section 2 elements. With its narrow factual predicate and challenging proofs, this appears to be a relatively rare counterclaim.

A more frequently asserted counterclaim based on conduct to enforce intellectual property is 'sham litigation.' This counterclaim typically involves alleged infringers responding with allegations that the litigation to enforce intellectual property rights constitutes a sham, ie, it is baseless and serves no purpose other than to interfere with a competitor. Such conduct, if established, can form the basis for a section 2 violation. These counterclaims, however, can face several hurdles in the courts. The allegedly sham litigation must be 'objectively baseless in the sense that no reasonable litigant could realistically expect success on the merits.' In addition, the challenged litigation must be shown to be motivated by a subjective intent to abuse the litigation process to interfere with the business of a competitor, rather than to obtain judicial relief. Any difficulty in making these showings has been increased by courts, including the Federal Circuit, also holding that claims of sham litigation are precluded as long as there is 'probable cause' for the challenged litigation, which is met when 'the law is unsettled, the action is arguably warranted by existing law, or there is an objectively good faith argument for extending existing law.'

In litigation that may involve sham litigation counterclaims, the Noerr-Pennington doctrine should be considered since it can provide a counter-defence. Noerr-Pennington generally immunises a party from antitrust liability based on its filing of a lawsuit, unless the lawsuit is 'sham litigation.' Proving that litigation is a 'sham' in the context of Noerr-Pennington results only in stripping a litigant of antitrust immunity. This means that ‘even a plaintiff who defeats the defendant's claim to Noerr immunity by demonstrating both the objective and subjective components of a sham must still prove a substantive antitrust violation.’

Hatch-Waxman claims
In the wake of the Supreme Court's recent ruling that certain 'reverse' payments to settle pharmaceutical litigation can be anticompetitive, Hatch-Waxman-related claims and counterclaims may receive increased interest. The Hatch-Waxman Act provides special procedures for patent disputes involving pharmaceuticals approved by the US Food and Drug Administration, including authorising pharmaceutical patent-holders to sue manufacturers for infringement when they propose to sell generic versions of the patented pharmaceuticals. As in other patent contexts, the manufacturers can respond with counterclaims that the infringement lawsuits constitute sham litigation that subjects the plaintiffs to liability for monopolisation under section 2. The Hatch-Waxman context, however, does not excuse the counterclaimant from showing alleged sham litigation falls outside the Noerr-Pennington immunity.

Distribution claims
Distribution agreements between manufacturers or suppliers and their distributors often include provisions that restrict or otherwise govern how goods or services are to be marketed. These agreements sometimes include exclusivity provisions that prohibit distributors from marketing products of competing manufacturers, territory provisions that preclude distributors from marketing outside assigned geographic areas, or customer provisions that limit distributors from marketing to certain categories of customers. Courts have recognised the pro-competitive benefits for such provisions, mainly based their ability to promote intra-brand competition, reduce marketing costs, and allow manufacturers or suppliers to better control product quality and service in the distribution chain. This does not eliminate the need to consider potential antitrust counterclaims in this context.

Antitrust counterclaims may arise in response to lawsuits claiming restrictive provisions in distribution agreements have been breached, or seeking to enforce compliance with these provisions. Counterclaims by distributors often are premised on the theory that enforcement of these restrictive provisions constitutes a form of monopolisation in violation of Sherman Act section 2, or an unreasonable restraint of trade in violation of section 1 if multiple parties allegedly agreed concerning the restrictive provisions. Such claims can be strengthened if the restrictive provisions are excessively broad in scope. These claims, however, may face obstacles in the courts. Applying the rule of reason analysis, which weighs the pro-competitive benefits against the anticompetitive consequences of a restraint to determine whether it unreasonably impacts the competitive conditions, courts often find restrictive provisions in...
distribution agreements to be pro-competitive on balance because of their potential to stimulate intra-brand competition and preclude other distributors from ‘free-riding’ on the effort and investment of others.40 Further, it can be difficult to show these provisions are detrimental to market-wide competition, rather than only the counter-claimant, as is required to show antitrust injury.41

The termination of distribution agreements also may result in antitrust claims that, like counterclaims, impact how the parties resolve their business relationships. Downstream distributors sometimes are terminated by manufacturers and replaced by other distributors. Typically, terminated parties that respond with antitrust claims allege that the manufacturers conspired with the replacement distributors, or other market participants, and effectuated the termination as part of an effort to monopolise or unreasonably restrain trade.42 These claims can be daunting. Courts may view these cases with the presumption that firms have considerable freedom to choose with whom they will do business.43 Proof of anticompetitive effect and antitrust injury also can be problematic, since changing distributors may have no adverse consequences in a market, and termination arguably may increase competition to the extent the replacement distributors provide better services or otherwise enable the realisation of efficiencies.44 The existence of legitimate business justifications, in a rule of reason analysis, makes an anticompetitive showing difficult in termination claims.

Franchise claims
Similar to distribution agreements, franchise agreements often include provisions that generally restrict how goods or services are to be marketed, but also often include permission for the franchisee to use the franchisor’s intellectual property and trademarks in exchange for allowing the franchisor some control and oversight of the franchise operations. Given the similarity, the antitrust considerations for distribution claims also apply to franchise claims. An additional consideration for franchise claims involves ‘tying’ – an agreement by a party to sell one product but only on the condition that the buyer also purchases a different (or tied) product, or at least agrees that he will not purchase that product from any other supplier.45 The competitive harm of tying includes sellers building power in the market for the tied product based on their power or leverage in another market rather than the tied product’s prices or product quality.46

Tying counterclaims can arise in response to franchisors suing to enforce agreements that require franchisees to purchase parts, supplies, or products from the franchisor or their affiliated entities. In this circumstance, counterclaims can allege that the franchisors have tied the purchase of parts, supplies, or products with the purchase and operation of the franchise itself in violation of section 1.47 While tying may be per se unlawful,48 courts have required that tying claimants establish a number of elements – including that the tying and tied products are two separate markets, sufficient economic power in the market for the tying product to restrain trade in the tied market, and anticompetitive effect in the market for the tied product.49 These elements can be onerous to establish. The parts, supplies, or products that franchisees may be required to purchase do not necessarily constitute a market separate from the franchise itself,50 franchisors often lack economic power, especially since courts generally do not recognise a single brand as a relevant market,51 and courts can be receptive to business justifications for the challenged arrangements, such as they benefit consumers, which can outweigh allegations of anticompetitive effects.52

Non-compete/restRICTIVE CovenANT claims
Covenants not to compete often appear in employment contracts, employee termination agreements, and agreements for the sale of businesses. Responses to lawsuits to enforce these provisions can include counterclaims based on Sherman Act sections 1 and 2. Specifically, counterclaims can assert that such provisions violate section 2, and are unenforceable, because they are unreasonably broad in terms of duration, territory, or product.53 Also, when covenants or agreements involve two or more competitors, such as industry non-compete arrangements, counterclaims could assert a violation of section 1 due to an unreasonable restraint of trade.54 As in the distribution context, these counterclaims can face obstacles because they generally are analysed under the rule of reason55 and the pro-competitive potential for non-compete or restrictive covenants, such as facilitating the transfer of property and businesses and preserving the goodwill value of firms, may outweigh the harm to competition.56

Frivolous litigation claims
While sham litigation usually appears in the context of intellectual property cases, antitrust counterclaims based on allegedly frivolous litigation conceivably can arise in a variety of factual and legal claims. Frivolous lawsuits generally have the potential to be anticompetitive because, for instance, defending litigation can be costly, litigation can deter firms targeted by litigation from competing with those pursuing the litigation, and litigation may persuade other market participants not to do business with the target firm so as to avoid provoking litigation.57 These concerns have prompted congressional hearings focused on ‘the strategic abuse of litigation system as an anticompetitive tactic’.58 Despite the anticompetitive potential, antitrust counterclaims based on frivolous litigation outside of the intellectual property context are infrequent. This may be due to courts tending to allow competitor litigation based on constitutional principles supporting the right to petition the government under Noerr-Pennington.59 This immunity has limits, however, and it could be advantageous for parties in circumstances with possible frivolous litigation to consider the potential for antitrust counterclaims.

Conclusion
The potential for use and abuse of antitrust counterclaims in the categories of litigation discussed in this article demonstrates the importance of considering counterclaims. Plaintiffs should consider the possibility of counterclaims in crafting their lawsuits, defendants should consider whether a counterclaim is required (or otherwise waived), and both parties should be mindful of any strategic advantages that may be gained with counterclaims, and at what cost.

Notes
1 See, e.g., Southern Constr. Co. v Pickard, 371 U.S. 57, 60 (1962) (explaining FED. R. CIV. PRO. 13(a) counterclaims were ‘designed to prevent multiplicity of actions and to achieve resolution in a single lawsuit of all disputes arising out of common matters’).
2 See, e.g., 3-13 Moore’s Federal Practice – Civil at section 13.10 (Matthew Bender 3d ed.).
3 See, e.g., id. at section 13.30.
4 See Baker v Gold Seal Liquors, Inc., 417 U.S. 467, 469 n.1 (1974) (‘A counterclaim which is compulsory but is not brought is thereafter barred’); see also 3-13 Moore’s Federal Practice, note 3, supra, at section 13.14.
5 See, e.g., Destiny Tool v SGS Tools Co., 344 F. App’x 320, 323 (9th Cir. 2009).
7 FED. R. CIV. PRO. 13(a).
11 748 F. 3d 160, 164 (4th Cir. 2014).
12 See, e.g., Leegin Creative Leather Prods. v PSKS, Inc., 127 S. Ct. 2705, 2724 (2007) (explaining that antitrust laws inherently are flexible so they can ‘evolv[ e] with new circumstances and new wisdom’).
16 See, e.g., Herbert Hovenkamp, et al., 1 IP and Antitrust at section 13.1, 11-2 (2006) (observing that there were over 100 reported decisions involving antitrust counterclaims during a seven-year period).
17 See 35 U.S.C. section 102, et seq.
18 See, e.g., Therasense, Inc. v Becton, Dickinson and Co., 649 F. 3d 1276, 1285 (Fed. Cir. 2011) (‘Inequitable conduct is an equitable defense to patent infringement that, if proved, bars enforcement of a patent.’).
19 382 U.S. 172 (1965) (considering fraudulently obtained patents); see also Knickerbocker Toy Co., Inc. v Winterbrook Corp., 544 F. Supp. 1309 (D.N.H. 1982) (considering fraudulently obtained copyrights); see also Ritz Camera & Image, LLC v SanDisk Corp., 700 F. 3d 503, 506 (Fed. Cir. 2012).
20 See Dippin’ Dots, Inc. v Mosey, 476 F. 3d 1337 (Fed. Cir. 2007).
21 See, e.g., IGT v Alliance Gaming Corp., 702 F. 3d 1338 (Fed. Cir. 2012).
23 601 F. 2d 986 (9th Cir. 1979).
24 See, e.g., C.R. Bard, Inc. v M3 Sys., Inc., 157 F. 3d 1340 (Fed. Cir. 1998).
25 This burden may be increased by the court applying a rebuttable presumption that the ‘patentee’s infringement suit is presumptively in good faith.’ Handgards, Inc. v Ethicon, Inc., 601 F. 2d 986, 996 (9th Cir. 1979).
27 Id. at 60-61.
28 958 Elektromedizin GmbH v Canady Tech. LLC, 629 F. 3d 1278, 1292 (Fed. Cir. 2010).
29 Prof’l Real Estate Investors, 508 U.S. at 56.
30 Id. at 61.
31 See FTC v Actavis, Inc., 133 S. Ct. 2223 (2013) (holding that ‘reverse payment’ settlements where a brand name drug manufacturer had provided a potential generic competitor with economic benefits in return for the generic applicant’s agreement to withhold competitive products for some time period prior to expiration of the patent may be anticompetitive).
37 See, e.g., Ezco’s Investments v Royal Beauty Supply, 243 F. 3d 980 (6th Cir. 2001).
40 See, e.g., Antitrust Law Devs., note 14, supra at 159 (stating that no court has territorial or customer restrictions unreasonable in the last 25 years).
41 See, e.g., Anheuser-Busch, 44 F. Supp. 2d at 174-75.
42 See, e.g., Crane & Shovel Sales Corp. v Bucyrus-Erie Co., 854 F. 2d 802 (6th Cir. 1988).
43 See, e.g., NYNEX Corp. v Discon, Inc., 525 U.S. 128, 137 (1998) (explaining that ‘[t]he freedom to switch suppliers lies close to the heart of the competitive process that the antitrust laws seek to encourage.’).
44 See Antitrust Law Devs., note 14 supra, at 167 (reviewing business rationales accepted by courts for finding termination was not anticompetitive).
46 See Ill. Tool Works, 547 U.S. at 33.
49 See, e.g., E & L Consulting v Doman Indus., 472 F. 3d 23, 32 (2d Cir. 2006); Princo Corp. v Int’l Trade Comm’n, 616 F. 3d 1318 (Fed. Cir. 2010).
50 See Rick-Mik Enters., Inc. v Equilon Enters., LLC, 532 F. 3d 963 (9th Cir. 2008).
52 See, e.g., Mozart Co. v Mercedes-Benz of N. Am., Inc., 833 F. 2d 1342 (9th Cir. 1987).
54 See, e.g., In re High-Tech Employee Antitrust Litig., Case No. 11-CV-02509-LHK (N.D. Cal.).
55 See, e.g., Nat’l Soc. of Prof’l Engineers, 435 U.S. at 688-89. An exception to the application of the rule of reason when non-compete agreements are between horizontal competitors can be reviewed as per se unlawful. See, e.g., Palmer v BRG of Ga., Inc., 485 U.S. 717 (1988).
56 See, e.g., Lektro-Vend Corp. v Vendo Co., 660 F. 2d 255, 265, n.12 (7th Cir. 1981).
57 See Prof’l Real Estate Investors, 508 U.S. at 68 (Stevens, J. concurring).
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