



Marc A. Sockol

Partner

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PRACTICE AREAS

- Intellectual Property

INDUSTRIES

- Digital Business
- Entertainment, Media and Technology
- Video Game

OVERVIEW

Marc A. Sockol is a partner in the Intellectual Property Practice Group in the firm's Palo Alto office. He is also the Administrative Partner of the office.

Areas of Practice

Mr. Sockol specializes in intellectual property rights. Mr. Sockol applies his technical and legal skills to client counseling, portfolio analysis and development, preparation and prosecution of patent applications, preparation of patentability, invalidity and noninfringement opinions, and the assertion and defense of patent litigation claims. He also has experience in trademarks, copyrights, trade secrets, open source and technology licensing.

Many patents that he has drafted have been litigated and have brought licensing revenue to his clients. Recent examples include three patents for a software company involving data synchronization and three patents for a network security company.

Mr. Sockol has drafted, prosecuted and defended more than 750 patent applications across a broad spectrum of technological areas, including:

- Computer hardware (including memory systems, microprocessors, bus communication, video displays, disk drives, and scanners)
- Computer software (including application software, computer games, operating systems, and system drivers)
- Semiconductor design and fabrication
- Internet
- Networking
- Wireless systems (including WiFi and WiMax)
- Satellites
- QAM
- RFID
- Multimedia distribution systems
- E-commerce
- Business methods
- POS hardware and software
- Network and computer security systems

- Database structures
- Application development tools
- Storage management systems (including RAID systems)
- Fault tolerant systems
- QOS monitoring
- Biometrics
- Set-top boxes
- Digital and analog circuitry
- Medical devices
- Solar power
- Optics
- Thin films
- HVAC

EDUCATION

- J.D., University of San Francisco School of Law, 1992
- B.S., Electrical Engineering, University of California, Davis, 1989

ADMISSIONS

- California
- U.S. Patent & Trademark Office

EXPERIENCE**Representative Matters**

Prepared and prosecuted patent applications involving data synchronization software on behalf of a software company that is currently managing a successful enforcement program. The company recently asserted a patent infringement claim based on patents that he drafted and achieved a multimillion-dollar jury award and increased revenue;

Prepared and prosecuted patent applications involving network security software on behalf of a venture-backed provider of secure Web gateway solutions. The company recently asserted a patent infringement claim based on patents that he drafted and achieved a multimillion-dollar jury award and increased revenue;

Prepared and prosecuted patent applications involving wireless technology (IEEE 802.11a, b, g and e) on behalf of a multinational company;

Prepared and prosecuted patent applications involving search engines and document classification technology on behalf of a multinational internet company;

Prepared and prosecuted patent applications involving behavior monitoring and targeted advertisements on behalf of an internet startup company;

Handled several Examiner interviews and patent office appeals on behalf of companies having difficulty obtaining business method patents;

Developed and managed a patent capitalization program (including invitations to license

and direct negotiations) on behalf of a data and network security company;

Defended a group of multinational companies at both district court level and appellate level for patent infringement involving Intel chipsets and Microsoft NetMeeting (the case has recently been publicized for its influence on the rules for patent exhaustion, *Quanta v. LG Electronics*, 453 F.3d 1364, 79 USPQ.2d (BNA) 1443 (Fed. Cir. 2006), rev'd, 553 U.S. ____ (2008);

Defended a startup company in patent infringement litigation for using arrival notification systems;

Defended a multinational company in patent infringement litigation for semiconductor fabrication;

Defended a multinational company in settlement negotiations based on a claim of patent infringement of Gilbert Hyatt patents for manufacturing and selling disk drives;

Conducted a freedom-to-operate analysis of a system involving GPS technology on behalf of a multinational company;

Conducted US and foreign IP due diligence reviews for a multinational company in a multinational joint development project involving GPS technology;

Conducted US and foreign IP due diligence reviews for investors and VCs considering investment in startup companies;

Testified as technical expert on GBICs in a federal district court trial

HONORS

- Top 25 Portfolio Managers, Prosecutors & License Specialists, *Daily Journal*

MEMBERSHIPS

- State Bar of California Intellectual Property Section
- American Bar Association Intellectual Property Section

ARTICLES

- Avoiding Or Living With Patent Exhaustion, *Law360*, June 22, 2009
- Gaming Industry Keeps IP Lawyer On His Toes, *Silicon Valley/San Jose Business Journal*, September 19, 2008
- Sheppard Takes Thelen's Valley Office, *The Recorder*, April 3, 2008

SPEECHES

- Faculty Member, "Fundamentals of Patent Prosecution, A Boot Camp for Claim Drafting and Amendment Writing," Practising Law Institute, 2005–2010