



→ Jesse A. Salen

Associate

12275 El Camino Real
Suite 100
San Diego, CA 92130

T: +1.858.720.8964

F: +1.858.523.6722

jsalen@sheppardmullin.com

Jesse Salen is an associate in the Intellectual Property Practice Group in the firm's San Diego (Del Mar) office.

Areas of Practice

Jesse focuses his practice on intellectual property litigation, trademark prosecution, copyright prosecution, patent prosecution and intellectual property licensing in the areas of healthcare information technology, software, medical devices, optics, nanotechnology, computer devices and data storage. He litigates patent, trademark, copyright and trade secret cases in federal district court as well as in front of the Patent and Trademark Office's (USPTO's) Patent Trial and Appeal Board (PTAB) and Trademark Trial and Appeal Board (TTAB).

Jesse brings 16 years of business and technology experience to the firm, in both the healthcare and data storage industries. Previously, he was the Chief Technology Officer at ONRAD, Inc., a product manager at GE Healthcare, a manager of the customer care program at Hitachi Data Systems, a systems engineer at Memorial Sloan-Kettering Cancer Center and a research and development engineer in the field of optics and nanotechnology at Micron Corporation. He has published multiple peer-reviewed articles in the optics and nanotechnology fields, as well as multiple healthcare business journal articles.

Jesse represents clients in the following areas of practice:

- *Patent Litigation:* Jesse represents several clients in patent litigation and prosecution matters, including clients in the medical device, healthcare, wireless communications, jewelry and electronics industries.
- *Patent Prosecution:* Jesse is admitted to the USPTO and files or prosecutes patents directed towards software, electronics, medical devices, fashion and jewelry, including submitting patent applications, responding to office actions and litigating post grant review proceedings.
- *Trademark and Copyright:* Jesse represents clients in prosecuting, licensing, and litigating their trademarks and copyrights, both domestically and internationally. He represents clients from the electronics; medical device; nutrition; biotech; foods and service; and apparel, fashion and jewelry industries.
- *Other Intellectual Property:* Jesse represents several clients in licensing and/or litigating "soft" intellectual property matters that include claims of misappropriation of trade secrets, breach of contract, unfair competition and interference with an economic advantage, among others. He represents clients from the medical device, healthcare, apparel and wireless communications industries, among others.
- *Pro Bono:* Jesse recently represented a client in a complex asylum case. The client, a Bangladeshi national, was detained without bond for four years after crossing the U.S.-Mexico border without documentation. He

immediately petitioned for asylum because of persecution in Bangladesh based on his political affiliation. After a successful appeal from the Ninth Circuit, Jesse and the team obtained a favorable ruling on bond and are now waiting to re-litigate his asylum petition. Jesse also serves on the firm's Pro Bono Committee.

Experience

Patent Prosecution Clients

- Recent clients include California Institute of Technology, ChromaCode, Chevron, ACT, DICOM Systems, Disney, Jayden Star, MasterCard, MEMS Start, Nanomedical Diagnostics, RamSoft, San Diego Gas and Electric, Varentec, Piper Networks and Yobe.

Trademark Prosecution Clients

- Recent clients include Allomind, Benchmark Electronics, Bosa Development, CAQH, Clover Health, Concorde Battery, DICOM Systems, Essentra, HomeFed Corporation, Jayden Star, Nanomedical Diagnostics, Le Raisin Imports, San Diego County Credit Union, Titan Health and Security Technologies, Virtuosol and the USS Midway Museum.

Patent Litigation Matters

- *Lundbeck A/S et al v. Apotex Inc., et al*, No. 1:18-cv-00088-LPS (D. Del.). Represents generic drug manufacturer, Alembic Pharmaceuticals, in an ANDA dispute against Lundbeck and Takeda involving the drug Trintellix.
- *Wyeth LLC et al. v. Alembic Pharmaceuticals et al.*, No. 1:16-cv-01305-RGA (D. Del.). Represented generic drug manufacturer, Alembic Pharmaceuticals, in an ANDA dispute against Wyeth and Pfizer involving the drug Bosulif.
- *Blueprint Studios Trends v. Theoni*, No. 3:17-cv-05050-JSC (N.D. Cal.). Represents Plaintiff, Blueprint Studios, in a design patent infringement case involving furniture designs.
- *TCL Communication Technology Holdings, Ltd. et al. v. Telefonaktiebolaget LM Ericsson et al.*, No. 8:14-cv-341 (CD Cal). Represents TCL in breach-of-contract and declaratory-judgment action relating to FRAND and the IPR policies of ETSI and 3GPP for 2G GSM/GPRS/EDGE, 3G UMTS and 4G LTE technology.
- *Ericsson Inc. et al. v. TCL Communication Technology Holdings, Ltd. et al.*, No. 2:15-cv-11 (ED Tex). Represents TCL in a five-patent infringement action relating to patents Ericsson alleged cover aspects of cellular phone hardware and the Android OS. TCL counter-sued on two patents relating to LTE cellular network infrastructure and base stations.
- *Ericsson Inc. et al. v. TCL Communication Technology Holdings, Ltd. et al.*, No. 2:14-cv-667 (ED Tex). Represents TCL in a two-patent infringement action relating to patents Ericsson alleged cover the 2G, 3G and 4G standards. TCL counter-sued on two patents related to LTE cellular networks and communications.
- *Nature's Wing Fin Design, LLC v. Aqua-Lung America, Inc. et al.*, No. 8:17-cv-00048 (C.D. Cal.). Represented Aqua-Lung in a patent licensing and trade secret dispute against Nature's Wing Fin Design involving swim fin technology.
- *Vstream v. PLR IP Holdings LLC et al*, No. 15-cv-00974 (ED Tex). Represented Ricoh in an action patent infringement action relating to image processing technology and digital cameras.
- *Rosetta-Wireless Corp. v. High Tech Computer Corp. et al*, No. 15-cv-10603 (N.D. Ill). Represents HTC in an action patent infringement action relating to wireless device technology.

- *Prestige Flag Mfg. Co., Inc. v. Par Aide Products Co.*, No. 14-cv-2711 (SD Cal). Represented Prestige in an action for design patent and trade dress infringement, and state and federal unfair competition.
- *Prestige Flag Mfg. Co., Inc. v. Standard Golf Co. et al.*, No. 14-cv-1574 (SD Cal). Represented Prestige in an action for design patent infringement.
- *LendingTree, LLC v. Zillow, Inc. et al.*, No. 3:10-cv-439 (W.D.N.C.). Represented LendingTree in an antitrust and patent infringement lawsuit involving a method and computer network for coordinating a loan over the Internet.

Inter Partes Review Matters

- *Gridco, Inc. v. Varentec, Inc.*, Nos. IPR2017-01134, IPR2017-01135. Represented Patent Owner, Varentec, in successfully overcoming all asserted grounds in *inter partes* review challenges of two Varentec patents.
- *Prime Focus Creative Services Canada Inc. v. Legend3D, Inc.*, No. IPR2016-01491. Represents Legend3D in multiple *inter partes* review proceedings involving image processing technology.
- *KSP Co. LTD v. Guala Pack S.P.A.*, No. IPR2016-01065. Represented Petitioner KSP in an *inter partes* review proceeding challenging a patent directed to tamper proof packaging.
- *TCL Corporation et al. v. Telefonaktiebolaget LM Ericsson*, Nos. IPR2015-1602, IPR2015-1637, IPR2015-1641, IPR2015-1646, IPR2015-1674, IPR2015-1676, IPR2015-1761, and IPR2015-1806. Represented Petitioner TCL in eight different *inter partes* review proceedings challenging a patent directed to touchscreen technology as used in wireless handsets.
- *Teladoc, Inc. v. American Well Corp*, Nos. IPR2015-00924, IPR2016-00100, IPR2016-00101, IPR2016-01167. Represented Petitioner Teladoc in four different *inter partes* review proceedings challenging two patents directed to telemedicine software.

IP and Other Litigation Matters

- *Progressive Fastening Systems, Inc. v. VeloBond, Inc. et al.*, Case No. 5:19-cv-02255-VAP-SP (C.D. Cal.). Represents Progressive Fastening Systems, Inc. in a trade secret misappropriation dispute against a former employee and his new company involving concrete repair products.
- *Javo Beverage Co., Inc. v. California Extraction Ventures, Inc. et al.*, Case No. 3:19-cv-01859-CAB-WVG (S.D. Cal.). Represents California Extraction Ventures in a trade secret misappropriation and patent infringement dispute with Javo Beverage Co. involving coffee extraction technology.
- *San Diego County Credit Union v. Citizens Equity First Credit Union*, Case No. 3:18-cv-00967-GPC-MSB (S.D. Cal.). Represents San Diego County Credit Union in a trademark dispute against Citizens Equity First Credit Union involving the parties' taglines for IT'S NOT BIG BANK BANKING. IT'S BETTER. and CEFCU. NOT A BANK. BETTER.
- *Atara Biotherapeutics, Inc. v. Allogene Therapeutics, Inc.*, Opposition Nos. 91247175 and 91247177 (T.T.A.B.). Represents Atara Biotherapeutics in trademark oppositions against Allogene Therapeutics involving whether the terms AUTOCAR T and ALLOCAR T are protectable as trademarks.
- *Citizens Equity First Credit Union v. San Diego County Credit Union*, Cancellation No. 92066165 (TTAB). Represents San Diego County Credit Union in defending a petition to cancel the trademark "IT'S NOT BIG BANK BANKING. IT'S BETTER."
- *HomeFed Corporation v. Ascaya, Inc. c/o CTF Development Inc.*, Cancellation No. 3588854 (TTAB). Represented HomeFed in a petition to cancel the trademark ASCAYA.

- *Vox Media, Inc. v. Virtuasol Software, Inc.*, Opposition No. 91234558 (TTAB). Represented Virtuasol in defending an opposition of its trademark PLAYGON.
- *Jayden Star LLC v. Ken Craft, Inc.*, No. 16-cv-00064 (ED Tex). Represented Jayden Star in an action for trade dress, trademark, copyright infringement, state and federal unfair competition and intentional interference with a contract involving jewelry products.
- *Prestige Flag Mfg. Co., Inc. v. Golf Solutions I, LLC et al.*, No. 3:14-cv-2945 (SD Cal). Represented Prestige in an action for breach of contract.
- *Golf Solutions I, LLC v. Prestige Flag Mfg. Co., Inc. et al.*, No. 14-cv-869 (WD Wis). Represented Prestige in an action for breach of contract.
- *RamSoft, Inc. v. Imaging Advantage, LLC et al.*, No. 14-cv-335 (CD Cal). Represented RamSoft in an action for breach of contract, copyright infringement, copyright management information removal/alteration, trade secret misappropriation and intentional interference with contract involving medical imaging software.
- *Private Label Nutraceuticals v. Vox Nutrition et al*, No. 14-cv-00037 (Utah). Represented Private Label Nutraceuticals in an action for trademark infringement and unfair competition.
- *Cobra Systems, Inc. v. Accuform Manufacturing, Inc.*, No. 13-cv-5932 (CD Cal). Represented Cobra in an action for copyright infringement, copyright management information removal/alteration, trademark infringement, state and federal unfair competition and breach of contract involving industrial printers.
- *Angioscore, Inc. v. Konstantino, et al.*, No. RG14725578 (Cal. Superior Court). Represented Angioscore in a patent infringement lawsuit, and related indemnification lawsuit, involving medical device technology.

IP Counseling and Transactions

- Provided strategic counseling regarding a competitor's patent portfolio, including formulating non-infringement and invalidity analyses that provided significant leverage for the client's licensing negotiations with the competitor.
- Provide counseling on intellectual property provisions in business agreements, mergers and acquisitions, financing agreements and other intellectual property related diligence.

Articles

- Federal DTSA Versus California UTSA
Potential Pros and Cons
California Business Law Practitioner, Vol.32, No. 2, Spring 2017

Trade Secrets Law Blog Posts

- "Healthcare Res. Mgmt. Grp., LLC v. Econatura All Healthy World, LLC – A Cautionary Tale: Meticulous or Careless Strategy Required to Prove Your Trade Secret Claim," January 3, 2022

Life Sciences Law Blog Posts

- "Extending the Patentable Life of 3D Printers: A Lesson From the Pharmaceutical Industry," January 19, 2016

Intellectual Property Law Blog Posts

- "Federal Circuit Agrees to Reconsider Ruling in GSK v. Teva Drug Patent Case," February 10, 2021

- "UPDATE: The Federal Defend Trade Secrets Act vs. The California Uniform Trade Secrets Act," March 26, 2018
- "The Federal Defend Trade Secrets Act vs. The California Uniform Trade Secrets Act," July 21, 2016
- "U.S. Patent and Trademark Office Clarifies "Patent Eligible Subject" Matter in its Recent Guidance in Light of Alice," December 23, 2014

Healthcare Law Blog Posts

- "Patient Empowerment Through Technology is Focus of ENGAGE Conference," December 7, 2018

Media Mentions

An Absolutely Stacked Week of Litigator of the Week Runners-up and Shout Outs
American Lawyer, 10.08.2021

Practices

Intellectual Property

Copyrights

Patent Litigation

Patent Prosecution and Counseling

Trade Secrets

Trademarks and Trade Dress

Healthcare

Digital Health

Post-Grant Proceedings

Industries

Healthcare

Life Sciences

Education

J.D., University of San Diego, 2013, *magna cum laude*, *Order of the Coif*, *Appellate Clinic Outstanding Legal Intern*

M.B.A., University of California, Irvine, 2006, *Dean's Scholar*, *Beta Gamma Sigma Honor Society*

B.A., Physics, Boston University, 1997, *cum laude*

Admissions

California

U.S. District Court for the Southern District of California

U.S. District Court for the Central District of California

U.S. District Court for the Northern District of California

U.S. Court of Appeals for the Federal Circuit

U.S. Patent and Trademark Office