



## → Darren M. Franklin

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Darren Franklin is a partner in the Intellectual Property Practice Group in the firm's Los Angeles office. He is a member of Sheppard Mullin's E-Discovery Team.

### Areas of Practice

Darren is a registered patent attorney with expertise in patent litigation, patent post-grant proceedings, patent prosecution and counseling, trademark litigation, unfair competition claims and IP due diligence. His clients are involved in diverse industries and technologies, including aerospace, computers, entertainment, gaming, lighting, medical devices, office products, pharmaceuticals, semiconductors, software, sports products, telecommunications and video games.

Since 2003, Darren has been privileged to represent Sheppard Mullin's clients in a broad range of intellectual property matters, including patent litigation, patent post-grant proceedings, patent prosecution, trademark litigation, unfair competition claims and IP due diligence. A graduate of Stanford Law School in 2000, Darren served as a law clerk to the Honorable Margaret M. Morrow in the U.S. District Court for the Central District of California and practiced intellectual property law in Silicon Valley for two years before joining Sheppard Mullin.

Now a partner in Sheppard Mullin's Los Angeles office, Darren has extensive experience representing clients in the federal courts and in the U.S. Patent and Trademark Office (USPTO), including before the Patent Trial and Appeal Board in *inter partes* review proceedings. His experience includes arguing (and winning) multiple patent infringement cases before the U.S. Court of Appeals for the Federal Circuit and dispositive motions in the U.S. District Courts. Among other cases, Darren argued and won a significant motion and Federal Circuit appeal based upon the patent ineligibility of abstract ideas in the wake of a 2014 Supreme Court case.

Using his physics degree, Darren also helps companies and individuals in diverse industries protect their innovations in the USPTO. Darren is a past president of the Los Angeles Intellectual Property Law Association, and was named as a Southern California "Super Lawyer" in 2014-2020 by *Super Lawyers*. He is committed to achieving the best results for his clients.

### Honors

- Lawyer of the Year, *Best Lawyers*, 2023
- Best Lawyers in America, *Best Lawyers*, 2019-2021, 2023
- Southern California Super Lawyer, *Super Lawyers*, 2014-2022

- Southern California Rising Star, *Super Lawyers*, 2009, 2010 and 2013
- Wiley W. Manuel Award for Pro Bono Legal Services, 2004

## Experience

### Representative Matters:

- Won institution of *inter partes* review proceedings in the U.S. Patent and Trademark Office (USPTO) to invalidate a telecommunications patent asserted against firm client HTC Corporation, a leading consumer electronics company. *HTC Corp. v. INVT SPE LLC*, No. IPR2018-01555 (USPTO).
- Won institution of *inter partes* review proceedings in the USPTO to invalidate computer technology patents asserted against firm client ZTE (USA) Inc., a smartphone manufacturer. *ZTE (USA) Inc. v. Papst Licensing GmbH & Co. KG*, Nos. IPR2017-00713, IPR2017-00714 (USPTO).
- Argued and won judgment on the pleadings and the resulting Federal Circuit appeal based upon the patent ineligibility of abstract ideas on behalf of internet marketing company Clickbooth.com, LLC in a case involving internet affiliate systems. *Essociate, Inc. v. Clickbooth.com, LLC*, 641 Fed. Appx. 1006 (Fed. Cir. 2016).
- Won summary judgment of patent non-infringement and the resulting Federal Circuit appeal on behalf of MasterCard International Incorporated in a case involving systems for connecting to a computer network. *SmartMetric, Inc. v. MasterCard International Incorporated*, 568 Fed. Appx. 897 (Fed. Cir. 2014).
- Invalidated key claims of a patent directed to a microwave load-pull tuner in a USPTO *inter partes* reexamination proceeding on behalf of Maury Microwave, Inc., a leading manufacturer of microwave and RF laboratory devices. *In re Tsironis*, No. 95/002,319 (USPTO).
- Argued and won summary judgment of patent non-infringement and the resulting Federal Circuit appeal in a case involving microwave tuners for testing electrical components. *Maury Microwave, Inc. v. Focus Microwaves*, 2012 U.S. Dist. LEXIS 189290 (C.D. Cal.).
- Obtained confirmation of the patentability of certain claims to an orthotic device in patent reexamination proceedings on behalf of Bio Cybernetics International, Inc., a leading supplier of orthotic and trauma products. *Ex Parte Bio Cybernetics Int'l, Inc.*, No. 90/010,605 (USPTO).
- Represented spinal-fusion device company minSURG International, Inc. in obtaining a claim for inequitable conduct dismissed and in receiving a favorable claim construction in a patent infringement case involving spinal facet-joint fusion surgery. *minSURG Int'l, Inc. v. Frontier Devices, Inc.*, 2011 WL 1336395 (M.D. Fla.).
- Represented a specialty pharmaceutical company in successfully obtaining a preliminary injunction against a generic competitor in a patent infringement case involving nutritional supplements.
- Represented global entertainment lighting company Electronic Theatre Controls in a patent infringement case involving incandescent illumination systems. Case ended with a favorable settlement.
- Represented a leading developer of micro-electromechanical systems in a patent infringement case involving microdevices. Case ended with a favorable settlement.
- Won appellate victory before the U.S. Court of Appeals for the Federal Circuit on behalf of the president of consumer products company Macke International Trade in a patent infringement case involving issues of personal liability and lost profits damages. *Wechsler v. Macke Int'l Trade, Inc.*, 486 F.3d 1286 (Fed. Cir. 2007).
- Argued and won patent infringement appeal before the U.S. Court of Appeals for the Federal Circuit on behalf manufacturer Unistar Plastics, LLC in a patent infringement case involving supermarket fixtures.

- Argued and won a patent claim construction hearing before the U.S. District Court for the Central District of California on behalf of motorcycle trailer importer Towblazer, Inc.
- Won summary judgment on behalf of consumer products company Dallas Manufacturing and wholesale club chain BJ's Wholesale Club in a patent infringement case involving pet products. *Flexi-Mat Corp. v. Dallas Mfg. Co.*, 2006 WL 962161, 2006 U.S. Dist. LEXIS 19528 (D. Mass. 2006).
- Represented leading biomedical company Beckman Coulter, Inc. in successfully opposing summary judgment motions filed in a patent infringement case involving DNA sequencing technology. Case ended with a favorable settlement.
- Represented worldwide office products company Avery Dennison Corporation in a trade secrets and breach of contract case involving pricing labels. Case ended with a favorable settlement.

## Articles

- Apple Gets Snippy Over Mobile Transmission Patent At PTAB  
*Law360*, 01.08.2020
- High Court Takes on Laches and Patents  
*Daily Journal*, 05.11.2016
- The US Federal Trade Commission Considers Issues in Patent Damages Awards  
*AsiaLaw*, 03.2009
- Implications of *Aristocrat v. IGT* for Software Patents  
*AsiaLaw*, 01.01.2009
- Patent Pools  
Legal Structures that Combine Rights Foster Development of New Technologies but Could Raise Competitive Concerns  
*New York Law Journal*, 04.21.2008
- Leadership Liability: Protecting Directors, Officers From Exposure to Patent Infringement Damages  
*San Diego Daily Transcript*, 01.31.2008
- The Supreme Court Opens the Door to More Patent Challenges  
*MedImmune, Inc. v. Genetech, Inc.*, 127 S. Ct. 764 166 L. Ed. 2d 604 (2007)  
07.02.2007
- The Federal Circuit Cracks Down on DNA Inventions of Uncertain Utility: *The Fisher Case*  
12.07.2005
- Patent-Reform Bill Promises Changes to Transform Law  
09.14.2005
- Is Your Patent Counsel's Work Privileged?  
07.28.2004
- "Hanging a Shingle on the Information Superhighway: Legal Advice on the Internet," *Stanford Technology Law Review* 2, 2001
- "The Mass Tort Defendants Strike Back: Are Settlement Class Actions a Collusive Threat or Just a Phantom Menace?" 53 *Stanford Law Review* 163, 2000

## Intellectual Property Law Blog Posts

- "Open COVID Pledge Seeks to Make IP Available for Use in Ending COVID-19," April 16, 2020
- "USPTO Permitting Patent Applicants to Extend Certain Deadlines Due to COVID-19," April 1, 2020
- "Limited Relief for Patent and Trademark Applicants Affected by COVID-19," March 24, 2020
- "High Court Takes on Laches and Patents," May 23, 2016
- "Supreme Court Rejects Bilski Claims, Overturns "Machine-or-Transformation" Requirement for Patent Eligibility of Processes," June 28, 2010
- "Federal Circuit Grants Patent Term Extensions", January 8, 2010
- "The US Federal Trade Commission Considers Issues In Patent Damages Awards", April 14, 2009
- "Muniauction, Inc. v. Thompson Corp.: The Federal Circuit Again Weighs In On Software Patents", October 7, 2008
- "Inducement of Patent Infringement", November 5, 2007
- "USPTO Proposes Changes to Disciplinary Rules", April 12, 2007
- "The Federal Circuit Cracks Down on DNA Inventions of Uncertain Utility: The Fisher Case", March 10, 2006

## Media Mentions

Fed. Cir. Affirms Axing Of Web Referral Patent Under Alice  
*Law360*, 03.11.2016

Fed. Circ. Skeptical Of Arguments To Restore Web Patent  
*Law360*, 03.09.2016

SmartMetric To Take MasterCard Fee Dispute To Fed. Circ  
*Law360*, 05.08.2015

E-Commerce Traffic Patent Invalid Under Alice, Judge Rules  
*Law360*, 02.11.2015

Fed. Circ. Won't Rehear \$13B IP Case Against Visa, MasterCard  
*Law360*, 10.20.2014

Fed. Circ. Upholds Visa, MasterCard Win In \$13B Patent Case  
*Law360*, 08.13.2014

MasterCard Should Face \$13B Patent Row, Fed. Circ. Told  
*Law360*, 08.08.2014

Visa, MasterCard Win Tentative Ruling In \$13B Patent Row  
*Law360*, 09.26.2013

## Speaking Engagements

- Panelist, "Trade Secrets and Patents: A Comprehensive Approach to Protecting Intellectual Property," *Stafford*, January 26, 2022

- Panelist, “Minimizing the Risk of Subject Matter Eligibility Rejections,” LAIPLA Washington in the West Conference, January 2017
- Speaker, “Standing to Petition Under the AIA,” Thomas Jefferson School of Law Intellectual Property Symposium, April 2016
- Speaker, “Responding to § 101 and § 112 Rejections,” AIPLA Patent Prosecution Boot Camp, April 2015
- Moderator, “How to Make Money with Your Intellectual Property,” Loyola Law School, July 2011
- Lecturer, International Copyright Law, University of Southern California Gould School of Law, October 2006
- Panelist, Los Angeles Intellectual Property Law Association law school roadshow

## Memberships

- President, 2014-2015; Vice President, 2013-2014; Secretary, 2012-2013; Treasurer, 2011-2012; Chair, Law School Outreach Committee, 2008; Los Angeles Intellectual Property Law Association
- Vice Chair, Inventor Issues Committee, 2009-2011; Co-Chair, Giles Rich Moot Court Competition Committee, 2009; Member, 2009 Spring Meeting Planning Committee; Member, 2008 Annual Meeting Planning Committee; American Intellectual Property Law Association
- Volunteer Attorney, Public Counsel Adoptions Project
- Member, Association of Business Trial Lawyers
- Member, Los Angeles County Bar Association
- Member, Stanford Alumni Association
- Member, California Alumni Association

## Practices

Intellectual Property

Patent Litigation

Patent Prosecution and Counseling

Trade Secrets

Trademarks and Trade Dress

Post-Grant Proceedings

## Industries

Entertainment, Technology and Advertising

Esports & Games

Life Sciences

## Education

J.D., Stanford Law School, 2000, Executive Editor, *Stanford Law Review*; Member, *Stanford Technology Law Review*  
B.A., Physics & Political Science, University of California, Berkeley, 1997; Member, *Phi Beta Kappa*

## Clerkships

Clerk, Honorable Margaret M. Morrow, U.S. District Court for the Central District of California, 2000-2001  
Extern, Honorable John G. Davies, U.S. District Court for the Central District of California, 1998

## Admissions

U.S. Patent and Trademark Office  
U.S. Court of Appeals for the Federal Circuit  
California federal courts  
California state courts