



## → Darren M. Franklin

### Partner

333 South Hope Street  
Forty-Third Floor  
Los Angeles, CA 90071

T: +1.213.617.5498

F: +1.213.443.2736

dfranklin@sheppardmullin.com

Darren Franklin is a partner in the Intellectual Property Practice Group in the firm's Los Angeles office. He is a registered patent attorney with an active IP litigation and prosecution practice. He additionally serves on the firm's e-discovery, life sciences, and trade secrets teams.

### Areas of Practice

Darren represents both large and small companies, as well as individuals, who want to protect their innovations in the U.S. Patent and Trademark Office or who have been accused of infringing the intellectual property rights of others in the U.S. district courts. His clients are involved in diverse industries, including aerospace, consumer products, electronics, healthcare, laboratory equipment, life sciences, manufacturing, medical devices, transportation, and video games.

As both an intellectual property litigator and prosecutor, Darren is at home in both the U.S. district courts and the U.S. Patent and Trademark Office. Since 2003, Darren has represented Sheppard Mullin's clients in a broad range of intellectual property matters, including patent litigation, patent post-grant proceedings, patent prosecution, trademark litigation, and trade secret litigation. Before 2003, Darren practiced intellectual property law in Silicon Valley and served as a law clerk in the U.S. District Court for the Central District of California.

Over his career, Darren has appeared in more than seventy U.S. district court cases across the country and obtained countless U.S. and foreign patents for his clients. His experience includes representing clients before the Patent Trial and Appeal Board in adversarial "*inter partes* review" proceedings to invalidate patents. Additionally, Darren has personally argued five patent cases before the U.S. Court of Appeals for the Federal Circuit in Washington, D.C. Among these cases was one of the first appeals based upon the patent ineligibility of abstract ideas in the wake of a 2014 Supreme Court case. In addition to representing clients in intellectual property litigation and prosecution, Darren manages intellectual property portfolios, provides patent risk assessments for new products, and conducts intellectual property due diligence for corporate transactions.

Darren is a past president of the Los Angeles Intellectual Property Law Association, one of the nation's premier intellectual property law associations. He is also a Certified eDiscovery Master by the Arkfeld eDiscovery Education Center and a long-time member of Sheppard Mullin's E-discovery Team. Additionally, Darren has completed forty hours of mediator training through the Straus Institute for Dispute Resolution at Pepperdine Caruso School of Law. Darren is a graduate of Stanford Law School in 2000 and earned an undergraduate degree in physics and political science from the University of California, Berkeley.

Darren is committed to achieving the best results for his clients, and enjoys working with companies and businesses that are innovative and forward-thinking.

## Honors

- Lawyer of the Year for Intellectual Property Litigation in Los Angeles, *Best Lawyers*, 2023
- Best Lawyers in America, *Best Lawyers*, 2019-2023
- Southern California Super Lawyer, *Super Lawyers*, 2014-2023
- Elected President of the Los Angeles Intellectual Property Law Association (LAIPLA), 2014-2015
- 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 pursue invalidation of a patent asserted against client Frameless Hardware Company, a glass-industry supply company. *Frameless Hardware v. C.R. Laurence Co.*, No. IPR2022-00356.
- Obtained a favorable patent claim construction in the District of New Jersey in a patent infringement case filed against client Cochlear Ltd., a global leader in implantable hearing devices. Case ended with a favorable settlement. *Cochlear Ltd. v. Oticon AB*, No. 3:18-cv-06684 (D.N.J.).
- Argued as lead counsel before the Patent Trial and Appeal Board at the trial proceeding in an *inter partes* review of a telecommunications patent asserted against client HTC Corporation, a leading consumer electronics company. *HTC Corp. v. INVT SPE LLC*, No. IPR2018-01555 (USPTO).
- Represented Diodes, Inc. as lead counsel in a seven-patent case involving semiconductors in the U.S. District Court for the Eastern District of Texas. Case settled favorably after filing of a petition for *inter partes* North Plate Semiconductor *v. Diodes, Inc.*, No. 4:17-cv-00618 (E.D. Tex.).
- Argued and won judgment on the pleadings and the resulting Federal Circuit appeal based upon the patent ineligibility of abstract ideas on behalf of marketing company Clickbooth.com, LLC in a case involving affiliate systems. *Essocate, Inc. v. Clickbooth.com*, 641 Fed. Appx. 1006 (Fed. Cir. 2016).
- Represented Centrifly Corporation, a leading cybersecurity company, in a multi-defendant patent infringement case involving multi-factor authentication in the U.S. District Court for the District of New Jersey. *StrikeForce, Inc. v. Centrifly Corp.*, No. 2:16-cv-03574 (D.N.J.).
- Represented ZTE (USA) Inc., a smartphone manufacturer, in a five-patent, multi-defendant case involving smartphone cameras in the Eastern District of Te Case settled after the institution of *inter partes* review proceedings. *Papst Licensing GmbH v. Apple, Inc.*, No. 6:15-cv-01095 (E.D. Tex.).
- Represented a patent owner against AT&T Mobility at a patent infringement trial involving a patent pertaining to data security for location-based services on smartphones. *Enovsys LLC v. AT&T Mobility LLC*, 2015 U.S. Dist. LEXIS 179798 (C.D. Cal. 2015).
- Won summary judgment of patent non-infringement and the resulting Federal Circuit appeal on behalf of client MasterCard International in a case involving systems for connecting to a computer network. *SmartMetric, Inc. v. MasterCard Int'l Inc.*, 568 Fed. Appx. 897 (Fed. Cir. 2014).

- Represented LendingTree, Inc. at a patent infringement trial involving a patent pertaining to coordinating loans over the Internet. Led bench trial portion pertaining to issues of laches and equitable estoppel. *LendingTree, LLC v. Zillow, Inc.*, 2014 U.S. Dist. LEXIS 45450 (W.D.N.C. 2014).
- Represented Lotes Co., a manufacturer of electronic connectors, in a patent infringement and breach-of-contract case involving CPU connection sockets in the U.S. District Court for the Northern District of California. *Lotes Co. v. Hon Hai Precision Industry Co.*, No. 3:11-cv-01036 (N.D. Cal.).
- Argued and won summary judgment of patent non-infringement and the resulting Federal Circuit appeal on behalf of Maury Microwave, Inc. 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 a favorable patent claim construction in the Middle District of Florida in a patent case involving spinal facet-joint fusion surgery filed by client minSURG International, Inc., a spinal-fusion device company. *minSURG Int'l, Inc. v. Frontier Devices, Inc.*, 2011 WL 1336395 (M.D. Fla.).

## Articles

- Choosing Between Trade Secret and Patent Protection: A Primer for Businesses  
*Intellectual Property Strategist*, 05.2022
- Supreme Court Tackles Role of Administrative Judges on PTAB  
*Los Angeles Daily Journal*, 03.17.2021
- High Court Takes on Laches and Patents  
*Los Angeles 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  
*New Matter*, 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  
*Los Angeles Daily Journal*, 09.14.2005
- Is Your Patent Counsel's Work Privileged?  
*Los Angeles Metropolitan News*, 07.28.2004
- Contributing author to the Cloud Computing Legal Deskbook, chapter on "Litigation Considerations: E-Discovery" (Thomson Reuters, 2016-2021 editions)

- "Hanging a Shingle on the Information Superhighway: Legal Advice on the Internet," *Stanford Technology Law Review*, 2001
- "The Mass Tort Defendants Strike Back: Are Settlement Class Actions a Collusive Threat or Just a Phantom Menace?" *Stanford Law Review*, 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

Apple Gets Snippy Over Mobile Transmission Patent At PTAB  
*Law360*, 01.08.2020

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

## Memberships

- Los Angeles Intellectual Property Law Association (LAIPLA) – president (2014-2015), vice president (2013-2014), secretary (2012-2013), treasurer (2011-2012), board member (2009-2011), chair of the Law School Outreach Committee (2008). Currently an active member of the LAIPLA Mentorship Committee (2021-present).
- American Intellectual Property Law Association (AIPLA) – vice chair of the Inventor Issues Committee (2009-2011), co-chair of the Giles Rich Moot Court Competition Committee (2009), member of the 2009 Spring Meeting Planning Committee, member of the 2008 Annual Meeting Planning Committee.
- Los Angeles County Bar Association, member of the Professional Responsibility and Ethics Committee (2022).
- Association of Business Trial Lawyers
- Stanford Alumni Association
- California Alumni Association

## Practices

Intellectual Property

Patent Litigation

Patent Prosecution and Counseling

Post-Grant Proceedings

Trade Secrets

Trademarks and Trade Dress

## Industries

Aerospace & Defense

Entertainment, Technology and Advertising

Esports & Games

Healthcare

Life Sciences

Telecom

Transportation

## Education

J.D., Stanford Law School, 2000, executive editor, *Stanford Law Review*; member of the *Stanford Technology Law Review*

B.A., Physics and Political Science, University of California, Berkeley, 1997; member of *Phi Beta Kappa*

## Clerkships

Clerk for the Honorable Margaret M. Morrow, U.S. District Court for the Central District of California, 2000-2001

Judicial extern for the Honorable John G. Davies, U.S. District Court for the Central District of California, 1998

## Admissions

California state courts

United States District Court for the Central District of California

United States District Court for the Northern District of California

United States Court of Appeals for the Federal Circuit

United States Patent and Trademark Office

United States District Court for the Southern District of California

United States District Court for the Eastern District of Texas