



→ Jesse A. Salen

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

Areas of Practice

Jesse creates value for bleeding edge technology and life sciences companies by protecting and defending their inventions, ideas, and brands through the development of sophisticated intellectual property portfolios and strategic intellectual property enforcement and defense. He offers a unique perspective that combines over a decade of intellectual property litigation and prosecution experience with more than sixteen years of non-legal industry experience, during which time he led a venture-backed telemedicine startup and developed innovative products and services for GE Healthcare, Hitachi Data Systems, Memorial Sloan Kettering Cancer Center, and Micrion Corporation. With a degree in Physics and a Masters of Business Administration (MBA), Jesse understands both the business and science behind the innovations he defends.

Clients turn to Jesse for assistance developing, protecting, and enforcing valuable intellectual property rights in the following areas:

Patent Litigation: A seasoned trial attorney, Jesse successfully resolves complex intellectual property disputes through successful settlements and trial victories. He represents clients in developing and executing domestic and international patent enforcement and defense strategies covering technologies ranging from medical devices and pharmaceuticals to wireless communications and high-technology. He also has substantial experience litigating Hatch-Waxman (ANDA) enforcement cases, *Inter Partes* Review (IPR) proceedings in the Patent Trial and Appeal Board (PTAB), and design patent cases. He has resolved numerous disputes for his clients by executing motions-to-dismiss strategies based on unpatentable subject matter under 35 U.S.C. § 101 ("*Alice*" motions).

Patent Counseling and Prosecution: Jesse is admitted to the U.S. Patent and Trademark Office (USPTO) and routinely leverages his Physics and engineering background to advise clients on the development of sophisticated life sciences, medical device, and high-technology patent portfolios. He also advises clients on freedom-to-operate and transactions involving intellectual property.

Trademark and Copyright: Brand protection is an important part of Jesse's practice. He protects his clients' brands, goodwill, and valuable content by advising on trademark and copyright rights, and licensing and litigating those rights. Jesse routinely litigates trademark infringement, opposition, and cancellation matters in district court and the Trademark Trial and Appeal Board (TTAB).

Appeals: Jesse also routinely represents clients in briefing and arguing appeals of district court decisions involving patents and trademarks to the Federal Circuit and Ninth Circuit courts of appeals.

Dedicated to his community, Jesse proudly serves on the firm's pro bono committee and routinely advocates for underrepresented individuals seeking asylum.

Experience

Patent Litigation (Representative Cases):

American Well Corporation v. Teladoc, Inc., Case No. 1-15-cv-12274 (D. Mass.): Successfully achieved dismissal of lawsuit with prejudice for Teledoc and invalidated American Well's asserted patents because they are directed towards abstract ideas under 35 U.S.C. § 101 (*Alice*).

H. Lundbeck A/S et al v. Apotex Inc. et al, Case No. 1-18-cv-00088 (D. Del.): Attained complete non-infringement trial verdict for Alembic Pharmaceuticals in Hatch-Waxman dispute over four patents covering the generic form of vortioxetine hydrobromide, an anti-depressant which is marketed by Takeda as Trintellix®.

Sanderling Management Ltd. v. Snap Inc., Case No. 21-cv-02324 (C.D. Cal.): Successfully achieved dismissal of lawsuit with prejudice for Snap Inc. and invalidated all of Sanderling's asserted patents because they are directed towards abstract ideas under 35 U.S.C. § 101 (*Alice*). Successfully attained affirmance on appeal to the Federal Circuit Court of Appeals (Case No. 21-2173).

SkimDevil Pure LLC d/b/a Skimdevil v. Skimbot, LLC et al, Case No. 6-21-cv-00954 (W.D.T.X.): Achieved favorable resolution for SkimDevil in patent and copyright enforcement action involving robotic pool skimmer technology.

TCL Communication Technology Holdings, Ltd. et al. v. Telefonaktiebolaget LM Ericsson et al., Case No. 8:14-cv-341 (C.D. Cal): Trial team attained verdict setting highly favorable FRAND royalty rates for TCL on wireless cellular communication patents in one of the largest Standard Essential Patent (SEP) disputes brought in the Central District of California.

Inter Partes Review (Representative Cases):

Gridco, Inc. v. Varentec, Inc., Nos. IPR2017-01134, IPR2017-01135. Successfully defeated institution of IPR petitions asserted against Varentec's patents by Gridco.

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. Successfully invalidated all asserted claims from four patents asserted against TCL in eight different *Inter Partes* Review proceedings relating 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.

Trademark and Other Litigation (Representative Cases):

Atara Biotherapeutics, Inc. v. Allogene Therapeutics, Inc., Opposition Nos. 91247175, 91247177 (TTAB): Attained completed trial victory for Atara in an TTAB opinion that refused trademark registration to Allogene for the terms ALLOCAR T and AUTOCAR T and protecting Atara's ability to freely use those terms.

Jayden Star LLC v. Ken Craft, Inc., No. 16-cv-00064 (ED Tex). Achieved favorable resolution for Jayden Star in an action protecting Jayden Star's trade dress, trademark, copyrights.

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.

RamSoft, Inc. v. Imaging Advantage, LLC et al., No. 14-cv-335 (CD Cal). Achieved favorable resolution for 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.

San Diego County Credit Union v. Citizens Equity First Credit Union, Case No. 18-cv-00967-GPC-MSB (S.D. Cal.): Attained complete non-infringement decision for San Diego County Credit Union at summary judgement and a trial verdict invalidating one of the asserted trademarks.

Representative Patent and Trademark Prosecution Clients:

Chevron, Caltech, ChromaCode, Inc., Esperto Medical, Inc., Next Orthopedic, DICOM Systems, RamSoft, Piper Networks, Yobe, Bosa Development, Council for Affordable Quality Healthcare, Clover Health, Concorde Battery, and San Diego County Credit Union.

Articles

- IP Practice Group Launches Quarterly Review of Key Federal Circuit Decisions
Sheppard Mullin, Spring 2023
- 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

- "2023 Federal Circuit Case Summaries," April 24, 2023
- "Takeaways From the U.S. Patent and Trademark Office's Artificial Intelligence and Emerging Technologies Partnership Series – Part Two of Three," October 4, 2022
- "Takeaways From the U.S. Patent and Trademark Office's Artificial Intelligence and Emerging Technologies Partnership Series – Part One of Three," September 29, 2022
- "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

Snapchat Keeps Calif. Alice Win At Fed. Circ. In Patent Row
Law360, 04.12.2023

Generic Co. Asks Fed. Circ. To Undo Loss In Takeda IP Fight
Law360, 06.17.2022

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

Southern District of California

Central District of California

Northern District of California

Federal Circuit Court of Appeals

Ninth Circuit Court of Appeals

U.S. Patent and Trademark Office