



→ Marc A. Sockol

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Marc Sockol is a partner in the Intellectual Property Practice Group and the former Office Managing Partner in the firm's Silicon Valley office.

Areas of Practice

Marc specializes in intellectual property rights. He 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.

Marc has drafted, prosecuted and defended more than 1000 patent applications across a broad spectrum of technological areas, including:

- Application development tools
- Artificial intelligence
- Biometrics
- Bitcoin and block chain
- Business methods
- 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)
- Database structures
- Digital and analog circuitry
- E-commerce
- Fault tolerant systems
- HVAC
- IoT and home automation

- Machine learning
- Medical devices
- Microware communication
- Multimedia distribution systems
- Networking
- Network and computer security systems
- Optics
- POS hardware and software
- QAM
- QOS monitoring
- RFID
- SAAS
- Satellites
- Semiconductor design and fabrication
- Set-top boxes
- Solar power
- Sound networking
- Storage management systems (including RAID systems)
- Thin films
- Tracking systems
- Video games
- Web analytics
- Wireless systems (including WiFi, WiMax and LTE)

Honors

World's Leading Patent Practitioner, 2015, *Expert Guides*

Top 25 Portfolio Managers, Prosecutors & License Specialists, 2011, *Daily Journal*

Top 25 Portfolio Managers, Prosecutors & License Specialists, 2009, *Daily Journal*

Experience

Representative Matters

Prepared and prosecuted four patent applications for Finjan, Inc., a provider of cybersecurity solutions (hardware and software) to the enterprise. The U.S. Court of Appeals for the Federal Circuit decided on January 10, 2018 that Blue Coat Systems, Inc., is liable for infringement of three of the four patents including the primary patent involved, the '844 patent, that Marc prosecuted through issuance and owned by Finjan; the court awarded approximately \$39.5 million in royalty damages;

Prepared and prosecuted patent applications involving data synchronization software on behalf of a software company that is currently managing a successful enforcement program. The enforcement program has earned the company close to a billion dollars. In fact, the company asserted a patent infringement litigation based on patents he drafted that achieved a \$267.5 million jury award;

Prepared and prosecuted patent applications involving network security software on behalf of a venture-backed provider of secure network gateway solutions. The company recently asserted a patent infringement claim based on patents he drafted that 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. 617 (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.

Articles

- Avoiding Or Living With Patent Exhaustion
Law360, 06.22.2009

Media Mentions

Gaming Industry Keeps IP Lawyer On His Toes
Silicon Valley/San Jose Business Journal, 09.19.2008

Sheppard Takes Thelen's Valley Office
The Recorder, 04.03.2008

Speaking Engagements

Faculty Member, "Fundamentals of Patent Prosecution, A Boot Camp for Claim Drafting and Amendment Writing," Practising Law Institute, 2005–2019

Memberships

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

Practices

Intellectual Property
Copyrights
IP Licensing, Technology and Commercial Transactions
Patent Litigation
Patent Prosecution and Counseling
Trade Secrets
Trademark Applications and Prosecution
Trademarks and Trade Dress
Israel
Post-Grant Proceedings

Industries

Entertainment, Technology and Advertising
Esports & Games

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