



## Marc J. Pernick

Attorney at Law • Partner

### let's connect

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San Francisco

### education

- J.D., NYU School of Law
- B.S.E., Computer Engineering & Mathematics, Cooper Union School of Engineering

### expertise

Technology Litigation • Patent Litigation • Commercial Litigation  
• Trademark Litigation • Commercial Arbitration

Marc's legal practice focuses on complex commercial litigation, with particular expertise in intellectual property litigation. He has over 25 years of experience working on technology and commercial matters.

Marc's experience spans a broad spectrum of technologies and industries. He has represented clients in patent litigation concerning smartphones and tablet computers, computer graphic chips, semiconductors, DVRs, e-commerce, document fraud detection, wireless communication, transit system technology, ultrasound contrast agents, DNA microarrays, and water filtration.

Marc's expertise extends beyond patent litigation. He has successfully represented clients in several commercial cases as well as trade secret, trademark, trade dress, patent licensing, and copyright disputes. He has also developed winning strategies for proceedings in the PTO.

Marc has led teams in federal courts throughout the United States, such as the Northern District of California, the Central District of California, the Eastern District of Texas, and the District of Delaware, and in the Superior Courts of San Mateo and Santa Clara. He has achieved success for his clients in all phases of litigation, including trial, pre- and post-trial motions, summary judgment motions and arguments, Markman briefing and hearings, technology tutorials, expert reports and depositions, pre-suit analysis, depositions, and discovery strategy, and mediation and settlement. Marc has also argued before the Federal Circuit.

Aside from his work representing clients in court, Marc is also a frequent writer and speaker on patent litigation topics, including patentability for business methods, claim construction, infringement, damages, inequitable conduct, attorneys' fees, and demand letters.

### my focus

Arbitration & Mediation	Complex Business Litigation	Computers & Databases	Consumer Goods & Services
Financial Services & eCommerce	Networking & Wireless Technology	Patent Litigation	Semiconductor
Software	Trade Secret & Unfair Competition Enforcement & Litigation	Trademark & Trade Dress Infringement Enforcement & Litigation	

### professional admissions & associations

- California State Bar

## publications & presentations

### Publications

- Did The United States Supreme Court Make Litigation More Dangerous for Defendants in IP Cases? Probably Not..... (*Patent Lawyer Magazine*, May/June 2024)
- Now That the Supreme Court Has Spoken, Has the Momentum Swung in Favor of Eligibility? (BNA's Patent, Trademark & Copyright Journal, March 4, 2011)
- A Closer Look At Supreme Court Arguments In *Bilski* (Law 360, January 6, 2010)
- '*Phillips*': Resolving (Most) Issues on Construing Patent Claims (New York Law Journal, July 28, 2005)
- The Federal Circuit's *En Banc* Consideration of Claim Construction In *Phillips v. AWH Corp* (ALM Patent Strategy & Management, March 1, 2005)

### Presentations

- Panelist at SFIPLA's webinar "*Alice Corp v. CLS Bank*: Impact and Strategies in Prosecution and Litigation" (August 13, 2014)
- Panelist at PLI's "What Hath *Bilski* Wrought? Fallout in the Courts and the PTO" (March 21, 2011)
- Panelist at Stanford Law Review Symposium, "The Future of Patents – Software and Business Method Patents" (Jan. 29, 2011)