



Robert A. McFarlane

Partner

Rob is a registered patent attorney who chairs Hanson Bridgett's Technology Practice and co-chairs its Intellectual Property Practice. His litigation practice focuses on patent infringement matters, intellectual property disputes, and technology-related commercial disputes. He also provides his clients with counseling on a wide range of intellectual property matters relating to licensing negotiations, data breaches, trademark and copyright, unfair competition, and trade secrets. He advocates on behalf of clients ranging from individuals to multi-national corporations, often in cases involving the threat of injunctive relief with potential damages of tens or hundreds of millions of dollars.

He has argued cases before the Federal Circuit and the California Courts of Appeals, and represents his clients in courts throughout the United States, including significant patent litigation jurisdictions such as the Eastern District of Texas, the Eastern District of Virginia, the Northern District of Illinois, the District of Delaware, and the Northern and Central Districts of California. He has been designated as an expert in U.S. patent law in a matter before the High Court of England and Wales, is experienced with inter partes review before the Patent Trial and Appeal Board (PTAB) within the United States Patent and Trademark Office (USPTO), patent infringement matters filed in the International Trade Commission (ITC), and with trademark appeals filed in the Trademark Trial and Appeal Board (TTAB).

Rob has successfully represented his clients in patent infringement matters involving a wide range of technologies including solar mounting technology, laser processing, medical imaging, semiconductor fabrication processes, semiconductor power technologies, digital signal processing, microprocessor design, software, computer hardware, FLASH and DRAM devices, business methods and financial transactions, the internet, optics and optoelectronics, circuits, textile chemistry, oil exploration, optical character recognition, agricultural and manufacturing equipment, transportation and consumer products.

In addition to patent litigation matters, Rob litigates software development and performance disputes and trade secret trademark, trade dress, unfair competition matters, and complex commercial disputes. He has litigated cases involving tortious interference and other business tort claims relating to the acquisition, assertion and use of intellectual property; multi-million dollar software performance matters that include misrepresentation, breach of contract, fraudulent inducement and negligence claims; a major antitrust matter in the magazine distribution industry; and breach of contract cases involving technology companies.

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Firm Leadership

Chair, Technology Practice Group
Co-Chair, Intellectual Property Practice Group
Partner Compensation Committee

Practices/Industries

Technology
Litigation & Dispute Resolution
Intellectual Property
Business Litigation

Rob is a recognized leader in the San Francisco intellectual property law community. He teaches patent law as an adjunct professor at the University of California Hastings College of the Law and previously taught patent litigation and intellectual property courses at Golden Gate University School of Law. He has been a guest lecturer in intellectual property at the University of San Francisco, and served as an instructor of copyright law in an LLM program offered jointly by Santa Clara University and Korea's Seoul National University. He is an officer in the San Francisco Intellectual Property Law Association, currently serving as treasurer.

Publications

"New and Improved Strategies to Combat Patent Trolls," co-author, *Technology Law Alert* (December 2015)

"A Bitcoin Primer on Jurisdiction," *Bitcoin Foundation* (August 2014)

"Supreme Court Doubles Down on Patents and Addresses Standards for Both Definiteness and Inducement On the Same Day," co-author, *Technology Law Alert* (June 2014)

"The House Passes Substantive Patent Reform Aimed at So-Called Patent Trolls; Action in the Senate Awaits," co-author, *Technology Law Alert* (January 2014)

"The Supreme Court's Decision That Human DNA Cannot Be Patented Preserves Significant Protections for Genetic Research," *The Marin Lawyer* (September 2013)

"E-Discovery: Computer-assisted coding is a powerful tool to control complex case e-discovery costs," co-author, *InsideCounsel* (May 2012)

"E-discovery: Popular patent venue in Texas adopts model order to rein in e-discovery costs," co-author, *InsideCounsel* (April 2012)

"Supreme Court: New Ruling On Patentable Subject Matter," co-author, *Hanson Bridgett IP Alert* (March 2012) featured in Bar Association of San Francisco's *iCounsel Newsletter* (May 2012)

"Five Custodians and Five Search Terms: A step toward the responsible and targeted use of e-discovery," co-author, *Hanson Bridgett Litigation Alert* (November 2011), featured in the Bar Association of San Francisco's *iCounsel Newsletter* (March 2012)

"E-Discovery: 5 custodians and 5 search terms," co-author, *InsideCounsel* (December 2011)

"Getting Out of the Eastern District of Texas," co-author, *IP LAW360* (April 2011)

"*Stauffer v. Brooks Brothers*: False Patent Marking Cases to Proceed," *CBM Intellectual Property Update Newsletter* (September 2010)

"*Bilski v. Kappos*: Supreme Court Permits Business Method Patents That Do Not Seek Protection on 'Abstract Ideas'," *CBM Intellectual Property Update Newsletter* (August 2010)

"Software Patents Under 35 U.S.C. § 271(f): Should Congress Amend § 271 to Harmonize Protection Between Tangible and Intangible Inventions?," co-author, *Hastings Science and Technology Law Journal* (June 2010)

"Business Methods and Patentable Subject Matter Following In re Bilski: Is 'Anything Under the Sun Made by Man'?"

Really Patentable?," co-author, *Santa Clara Computer & High Technology Law Journal* (February 2010)

"Eastern District of Texas Denies Transfer of Patent Infringement Case Filed Against Geographically Diverse Defendants," *IP Update, Lexology* (August 2009)

"Uncertainty Regarding Business Method Patents Continues Pending Supreme Court review of Bilski," *IP Update, Lexology* (August 2009)

"The Supreme Court Grants Certiorari in Bilski and Stands Ready to Answer the Question: 'What is Patentable?'," *Association of Corporate Counsel, San Francisco Chapter* (Summer 2009)

"The Ninth Circuit Lands a 'Perfect 10' Applying Copyright Law to the Internet," *Golden Gate University Law Review* (2008)

"Attorney-Client Privilege Strengthened in Patent Cases," *Executive Counsel* (May/June 2008)

"The Effect of International Comity on the Application of the Attorney-Client Privilege and Foreign Privilege Laws in U.S. Patent Litigation," *Santa Clara Computer & High Technology Law Journal* (2007)

"Scope of Attorney-Client and Work-Product Waivers When Relying on an Opinion of Counsel," *IP Law 360* (May 2006)

Presentations

"17th Annual Golden Gate University School of Law Conference on Recent Developments in IP Law and Policy," moderator, Golden Gate University School of Law 17th Annual Conference on Recent Developments in IP Law (October 2018)

"Patent Protection in 2018: How Did We Get Here, Where Are We Going?," Moderator, Golden Gate University School of Law 17th Annual Conference on Recent Developments in IP Law (October 2018)

"Essential Developments in Patent Subject Matter Eligibility: What Lies Ahead in 2017?," The Knowledge Group (June 2017)

"From the Heartland to Wonderland: How Developments in Patent Litigation are Impacting Your Clients," State Bar of California, Litigation Section (March 2017)

"Climbing Out of the Rabbit Hole: Patent Protection in the United States Following *Alice v. CLS Bank*," IBLA Annual General Meeting, Cardiff, Wales (September 2016)

"Escaping Wonderland: Businesses are Turning to Trade Secrets Protections in the Post-Alice World," co-speaker, USLAW Network Exchange (June 2016)

"Sweeping Developments in Patent Reform Agenda: The Innovation Act and the PATENT Act – A 2016 Perspective," panelist, Knowledge Group Webinar (May 2016)

"How to Protect Your Company By Protecting Your Intellectual Property," co-speaker, sf.citi (November 2015)

"Protecting Intellectual Property on the Internet of Things," co-speaker, US Taiwan High Tech Forum 2015, North

America Taiwanese Engineering & Science Association, Santa Clara, California (November 2015)

"Intellectual Property Strategies in the Wake of Alice," co-speaker, The McCarthy Institute for Intellectual Property and Technology Law (May 2015)

"Laches from Copyright Ruling – What You Need to Know in 2015," Knowledge Group Webinar (May 2015)

"Claim Construction after Teva Pharmaceuticals," co-speaker, The San Francisco Intellectual Property Law Association (April 2015)

"District Court Claim Construction After Teva Pharmaceuticals v. Sandoz," co-speaker, San Francisco Bay Area Intellectual Property American Inn of Court (February 2015)

"New Paradigms in Patent Monetization and Damages," moderator, The McCarthy Institute for Intellectual Property and Technology Law, San Francisco, California (January 2015)

"Updates in Intellectual Property Damages," Golden Gate University School of Accounting, San Francisco, California (January 2015)

"Chasing Trolls Back Under the Bridge: Legislative Responses to Patent Infringement Litigation by Non-Practicing Entities," San Francisco Intellectual Property Law Association (February 2014)

"Practicing Law and Serving Business in San Francisco and the Silicon Valley," Instituto Empresa (May 2013)

"Markman and Claim Construction Hearing in Patent Litigation: What You Need to Know," Knowledge Congress Webinar (May 2013)

"Protecting Intellectual Property," Keiretsu Forum Entrepreneur Academy, San Francisco and Walnut Creek, California (August and November 2012, April and June 2013, February 2014)

"Topics in Intellectual Property: Litigation with Non-Practicing Entities," APTA Legal Affairs Seminar, Austin, Texas (February 2013)

"Update on Intellectual Property Damages," co-presenter, California Society of CPAs, Oakland, California (October 2012)

"Legal Implications for International Companies in the US: Financing and IP Issues," co-speaker, Plug and Play Tech Center (March and April 2012)

"Whose IP Is This? An Overview of the America Invents Act of 2011 for Early Stage Corporations," co-presenter, Plug and Play Technology Center, Sunnyvale, California (February 2012)

"What Passes for 'Typical' in the Life of a Patent Litigator," University of San Francisco School of Law (February 2010 and March 2011)

"Escape from Marshall: The Future of Venue in the Eastern District of Texas for Patent Infringement Cases," San Francisco Intellectual Property Law Association (November 2009)

"Intellectual Property Damages," American Institute of Certified Public Accountants (October 2009)

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Partner



"Trade Secrets: Cost Effective Protection for Valuable Business Information," Association of Corporate Counsel, Palo Alto, Ca (June 2009), San Francisco, Ca (June 2009), Seattle, Wa (June 2009)

"IP Legal Ethics Q+A," Golden Gate University, 7th Annual Conference on Recent Developments in IP Law (April 2009)

"Recent Federal Circuit and Supreme Court Developments in Patent Litigation," Palo Alto, California (August 2007)

"Ethical Considerations in International IP Practice," Santa Clara University Computer and High Technology Law Journal Symposium, Cross Border Legal Challenges in High Tech Law (January 2007)

"The Attorney-Client Privilege and the Attorney Work Product Doctrine In Patent Practice," Palo Alto, California (August 2006)

Press

"A Newcomer's Guide to Litigating Patent Cases in California," *Law360* (September 2017)

"Patent Prosecutors Alarmed by Inequitable Conduct Ruling" *Law360* (July 2017)

"What Constitutes as 'Regular and Established' Business in TC Heartland Ruling?" *Inside Counsel* (July 2017)

"Supreme Court Limits Patent Owners' Post-Sale Authority" *Inside Counsel* (July 2017)

"Can the Patent System Keep Up with Digital Tech?" *Inside Counsel* (July 2016)

"Amazon Digs In Against ECommerce NPE" *The Recorder* (February 2015)

Community Involvement

Golden Gate University School of Law Intellectual Property Law Center Advisory Board

Lawyers' Committee for Civil Rights

Professional Affiliations

San Francisco Intellectual Property Law Association, Treasurer (2017-); Monthly Meetings co-chair (2015-); Patent Co-Chair (2012-14)

American Intellectual Property Law Association

San Francisco Bay Area Intellectual Property American Inn of Court

Federal Circuit Bar Association

Bar Association of San Francisco

American Bar Association

Judicial Clerkships

Judicial Extern Clerk to the Honorable Eugene F. Lynch, Judge of the United States District Court for the Northern District of California (1994)

Education

J.D., University of California, Hastings College of the Law (1994)

B.A.S., with departmental honors, Industrial Engineering and Political Science, Stanford University (1990)

Admissions and Courts

California

Supreme Court of the United States

U.S. Patent and Trademark Office

U.S. Court of Federal Claims

U.S. Court of Appeals for the Federal Circuit

U.S. Court of Appeals for the Ninth Circuit

U.S. District Court for the Northern District of California

U.S. District Court for the Central District of California

U.S. District Court for the Southern District of California

U.S. District Court for the Eastern District of Texas