

TOP INTELLECTUAL PROPERTY LAWYERS 2019

Mark D. Selwyn

FIRM

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CITY

Palo Alto

SPECIALTY

Patent litigation

Selwyn doesn't think one has to go back far in time to believe the types of cases he's taken could only be considered science fiction.

"Just go back 10 or 20 years," he said. "The practice has changed so much in that amount of time."

In recent years, his biggest intellectual property clients have included the likes of Apple Inc., Broadcom Corp., HP Inc. and Intel Corp., each with their own unique issues Selwyn has to effectively break down.

"We have to take these fantastically complex devices and complex technologies and be able to explain them to a jury that's going to be coming from different backgrounds, different degrees of education ... and explain to them in a way that's going to resonate," Selwyn said.

Last year, his explanations won over U.S. District Judge Edward M. Chen of San Francisco in an infringement case involving two of the biggest names in the online world of genetic ancestry testing.

The website 23andme Inc. was tak-



ing on Selwyn's client, Ancestry.com Inc. The former was claiming Selwyn's client was infringing its purpose as a tool for people to look up their genealogy.

But Chen ruled in August the matter was governed by a federal law that prohibited the patenting of abstract ideas. *23andMe Inc. v. Ancestry.com*

Inc., 18-02791 (N.D. Cal., filed May 11, 2018).

"In other words, the essence of the claimed invention is the abstract idea of determining a relative relationship by comparing similarities between DNA sequences," Chen wrote. "The independent claims do not recite any specific steps for how DNA sequence information is analyzed to derive predictions on relatedness."

Selwyn didn't want to discuss the matter because it's still on appeal.

"We prevailed on the 101 issue in the district court," he said. "It's now on appeal, we're briefing to the [U.S. Court of Appeals for the] Federal Circuit."

But whether it's defending a case against a business adversary or a non-practicing entity, Selwyn said his approach doesn't change.

"You have to marshal the best legal authority and marshal the best facts ... you still have to come forward with the facts that support your position," he said.

— Arin Mikailian