



O'MELVENY & MYERS LLP

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Mark Davies is a counsel in O'Melveny's Washington, DC office where he works on appellate matters.

Prior to joining O'Melveny, Mark was on the Appellate Staff of the Civil Division at the US Department of Justice (DOJ), where he represented the US Patent and Trademark Office, the Librarian of Congress, and various other federal agencies before the US Court of Appeals for the Federal Circuit, other US Courts of Appeals, and the US Supreme Court. At DOJ, Mark argued more than 25 cases in nine different appellate circuits.

At O'Melveny, Mark works principally with the Firm's nationally recognized intellectual property practice. His recent book *Patent Appeals: The Elements of Effective Advocacy in the Federal Circuit* (Oxford University Press, February 2008), has been called "the user manual for Federal Circuit appeals."

Mark's appellate cases at O'Melveny have included:

- **Hynix Semiconductor Inc.** Mark currently represents Hynix—one of the world's largest semiconductor manufacturers—in various patent and antitrust appellate matters involving Dynamic Random Access Memory. Many of these disputes stem from an effort by a member of the industry standard setting body to claim patents on the industry's chosen technology. [Read the US Supreme Court Amicus Brief](#)
- **You Technology.** Mark recently won a significant victory on behalf of You Technology, a company that provides biometric financial and marketing services to the retail sector, by persuading the Federal Circuit to affirm the lower court's decision to grant summary judgment in a long-running patent infringement suit.
- **Central Admixture Pharmacy Services, Inc. v. Advanced Cardiac Solutions ("CAPS").** Mark recently helped CAPS prevail twice in the Federal Circuit in prosecuting patent infringement claims against Advanced Cardiac Solutions, P.C.
- **Moore v. Moen, Inc.** Mark helped a small-business owner who invented and patented a popular curved shower rod for use in hotels appeal his design patent infringement claim to the Federal Circuit.
- **Morgan Stanley Capital Group Inc. v. Public Utility District No. 1 of Snohomish County.** Representing Morgan Stanley Capital Group, Mark played a key role in convincing the Supreme Court to grant *certiorari* and then reject the Ninth Circuit's view that the Federal Energy Regulatory Commission had an obligation to review the validity of billions of dollars of long-term energy contracts entered into during the chaos in the California electricity markets eight years ago. [Read the US Supreme Court Brief](#); [Read the Reply Brief](#); [Read the Opinion](#)
- **Center for Advanced Study and Research on Intellectual Property.** Representing the Center for Advanced Study and Research on Intellectual Property (CASRIP) of the University of Washington School of Law -- a research and policy development institute focusing on problems in patents and other property ownership rights in technology -- filed an *amicus curiae* brief in the US Supreme Court in a patent case that presented the following question: "Whether an inventor who discovers the source of a problem may patent the solution even though the solution itself may be obvious once the source of the problem is discovered." [Read the US Supreme Court Amicus Brief](#)
- **Sperry v. Crompton Corp.** Representing Chemtura Corporation (formerly Crompton), Mark helped convince the New York Court of Appeals—New York's highest court—to hold that the state's antitrust law does not authorize class action law suits.
- **Uhm v. Humana, Inc.** Representing Humana Inc., Mark helped persuade the Ninth Circuit to dismiss a class action on the grounds that plaintiffs' claims were preempted by the Medicare Prescription Drug Improvement and Modernization Act of 2003.
- **Microsoft Corporation v. Frank Morrow.** Mark represented At Home estate in a Federal Circuit appeal addressing the question of the plaintiff's standing to bring suit based on license obtained through bankruptcy.

Mark also has an active pro bono appellate practice. For example, he played a key role in *Heller v. D.C.*, in which O'Melveny defended the District of Columbia's hand-gun ban before the Supreme Court; *Cuellar v. U.S.*, in which the Supreme Court reversed the conviction of O'Melveny's client for money laundering; and *Lemon v. Geren*, in which O'Melveny successfully represented two landowners who had sued to block the transfer of a historic former Army base, Fort Ritchie, Maryland, to a private developer. He also argued a criminal sentencing case to the en banc First Circuit (*U.S. v. Vega-Santiago*). He is currently representing a money laundering defendant in the Second Circuit (*U.S. v. Ness*).

While at DOJ, Mark argued several high-profile intellectual property appellate matters: *Festo Corp. v. SMC, Corp.* (en banc) (prosecution history estoppel); *Southco v. Kanebridge* (en banc) (copyright of short phrases); and *Progam Suppliers v. Librarian of Congress* (distribution of cable royalties). He also briefed other important intellectual property appellate cases, including *Enzo v. Gen-Probe* (written description); *Eli Lilly v. Washington* (interference proceeding); and *Kay Berry v. Taylor Gifts* (copyright registration). He also argued *Lawrence v. Educational Credit*

professional focus

Appellate
Intellectual Property and Technology

education

University of Chicago, J.D.,
1995: with honors; Articles Editor, *U Chicago Legal Forum*

Yale University, B.A., Ethics, Politics
& Economics, 1992: *cum laude*

admitted

District of Columbia

publications

Indirect Purchaser Standing in Federal Courts: Take 2

(*Competition Law 360*, October 12, 2009)

The Federal Circuit and the Supreme Court (Circa 2009)

(19 *The Federal Circuit Bar Journal* 1, 2009)

An Appealing Provision

(*Los Angeles Daily Journal*, April 22, 2009)

Breakdown on State Street: The Future of Business Method Patents

(ABA Section of Litigation, *Intellectual Property Newsletter*, Winter 2008)

Designing Around the Supreme Court? The Federal Circuit nods to the Court's design patent test and keeps going

(*Legal Times*, October 13, 2008)

Supreme Court Holds Oral Argument in *Bilski v. Kappos*

(O'Melveny Intellectual Property and Technology Law Alert, November 2009)

Federal Circuit Rules That Patent Dispute Filed In Eastern District of Texas Must Be Transferred

(O'Melveny Intellectual Property and Technology Law Alert, December 2008)

Federal Circuit Revises Test For Patenting Business Methods

(O'Melveny Intellectual Property and Technology Law Alert, October 2008)

Seeking Supreme Court Review In Patent Cases

(*IP Law 360*, April 2008)

Management Corporation, a Fourth Circuit case involving the discharge of student loans.

In addition, while at DOJ Mark played a key role in four Supreme Court merits matters that involved intellectual property: *Merck KG v. Integra Lifesciences* (safe harbor for drug testing); *Traffix Devices, Inc. v. Marketing Displays, Inc.* (trade dress infringement); *Moseley v. V Secret Catalogue* (trademark dilution); and *Dastar Corp. v. Twentieth Century Fox* (Lanham Act). Mark also helped prepare the Solicitor General's response to six requests for views by the Supreme Court in intellectual property matters: *Fin Control v. Surfco* (combination patents); *Honywell v. Hamilton* (doctrine of equivalents); *Micrel v. Linear Technology* (on-sale bar); *Monsanto v. Bayer* (bon fide purchaser sub-licensee); *SmithKline v. Apotex* (novelty); and *Jazz Photo v. Fuji* (representing International Trade Commission).

Professional Activities

Clerk, Honorable Karen LeCraft Henderson, US Court of Appeals for the DC Circuit

Admitted to Practice, Supreme Court of the United States; United States Court of Appeals, Federal, District of Columbia, Second, Fourth, Fifth, Ninth, and Tenth Circuits

Chair, American Intellectual Property Law Association, Litigation Subcommittee on *Ashcroft v. Iqbal*

Vice-Chair, Federal Circuit Bar Association, Patent and Trademark Office Committee

Member, Federal Circuit Bar Association; Edward Coke Appellate Inn of Court; Federal Circuit Bar Association Planning Committee for 2010 Bench & Bar Conference

Reviewer, Oxford University Press

Author, Patent Appeals: The Elements of Effective Advocacy in the Federal Circuit, Oxford University Press (February 2008); "Indirect Purchaser Standing in Federal Courts: Take 2," *Competition Law 360* (October 12, 2009); "The Federal Circuit and the Supreme Court (Circa 2009)," 19 *The Federal Circuit Bar Journal* 1 (The George Washington University Law School, 2009); "An Appealing Provision," *Los Angeles Daily Journal* (April 22, 2009); "Designing Around the Supreme Court," *Legal Times* (October 2008); "Seeking Supreme Court Review In Patent Cases," *IP Law 360* (April 2008); "Breakdown on State Street: The Future of Business Method Patents," ABA Section of Litigation, *Intellectual Property Litigation Committee Newsletter* (Winter 2008); "The Future of Patent Law: Understanding The Supreme Court's Renewed Interest in Patent Law," *Intellectual Property Today* (June 2007)

Supreme Court Decides That Patent "Exhaustion" Doctrine Applies To Products That Include "Inventive Aspect" Of Patent (*Quanta Computer, Inc. v. LG Electronics, Inc.*)

(O'Melveny Intellectual Property and Technology / Appellate Alert, June 2008)

Solicitor General Recommends Certiorari in *Quanta Computer, Inc. v. LG Electronics, Inc.*

(O'Melveny Intellectual Property and Technology Law Alert, August 2007)

Five Lessons from Today's Supreme Court Patent Law Rulings

(O'Melveny Intellectual Property and Technology / Appellate Alert, April 2007)