



John M. Guaragna

Partner
CO-MANAGING PARTNER, AUSTIN OFFICE

TEXAS CHAIR, INTELLECTUAL PROPERTY AND TECHNOLOGY PRACTICE

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John Guaragna focuses on patent litigation and other technology and intellectual property disputes.

John has successfully represented clients at trial in patent, trademark and antitrust cases in district courts throughout the United States, as well as in the International Trade Commission and the Federal Trade Commission. John's recent experience includes the representation of Dell, Home Depot, HP, Itron, KLA-Tencor, lululemon, Medtronic, Microsoft, Samsung, Silicon Labs, and others in various intellectual property matters.

John has significant experience handling patent cases in Texas district courts, including in the Western District of Texas and the Eastern District of Texas where he is admitted to practice and has handled over 250 patent cases.

Additionally, John has extensive experience relating to the intersection between patent law and antitrust law, including a three-month antitrust trial before the Federal Trade Commission. He also has handled various trademark, trade secret, copyright and indemnity disputes.

RELATED SERVICES

- Patent Litigation
- Intellectual Property and Technology
- Litigation, Arbitration and Investigations

EXPERIENCE

REPRESENTATIVE MATTERS

- **SaveltSafe v. Oracle.** Defending Oracle in patent infringement action relating to computer security technology pending before Judge Albright in the W.D. Tex
- **Q2 Software v. Lighthouse Technology.** Representing Q2 in a Declaratory Judgment action relating to check imaging technology pending before Judge Albright in the W.D. Tex
- **Neodron v. Dell, HP and Microsoft.** Defending Dell, HP and Microsoft in patent infringement actions relating to computer technology pending before Judge Albright in the W.D. Tex
- **BCS Software v. Itron and Landis and Gyr.** Defending Itron and L+G in patent infringement actions relating to computer network technology pending before Judge Albright in the W.D. Tex
- **Impulse Downhole v. Rubicon.** Representing Impulse in patent infringement action relating to downhole drilling technology

pending before Judge Albright in the W.D. Tex

- **Acorn Semi v. Samsung.** Defending Samsung in patent infringement action relating to semiconductor technology pending before Judge Gilstrap in the E.D. Tex
- **Ameranth v. Starwood and Hilton.** Defending Starwood and Hilton in patent infringement action relating to Internet software. The case is pending in the S.D. Cal. before Judge Sabraw, but is stayed pending resolution of the appeal in a related case where the asserted patent was held invalid
- **Xitronix v. KLA-Tencor.** Successfully defended KLA in a Walker Process antitrust matter relating to allegations of fraud in the prosecution of a KLA patent. The case was pending in the W.D. Tex. before Judge Sam Sparks, who granted summary judgment in favor of KLA in August 2016, finding no fraud on the patent office. After initially transferring the appeal to the Fifth Circuit (which concluded it did not have jurisdiction and transferred the case back), the Federal Circuit affirmed summary judgment in favor of KLA in 2019. The Supreme Court subsequently denied cert in 2019
- **Click-to-Call v. Oracle et al.** Defended Oracle and others in patent infringement action relating to call-center technology. The case was pending before Judge Sam Sparks in the W.D. Tex., but was stayed pending IPR. The USPTO found all asserted claims invalid in the IPRs. The case settled favorably while on appeal in 2018
- **Blackbird v. lululemon.** Defended lululemon in patent infringement action relating to sports attire. The case was pending in the D. Del. before Judge Richard G. Andrews who granted summary judgment of non-infringement as to all asserted claims in June of 2017. The case settled favorably shortly after the summary judgment was affirmed on appeal
- **Snyders Heart Valve v. Medtronic.** Defended Medtronic in patent infringement action relating to heart valve technology pending in the E.D. Tex. before Judge Mazzant. The case settled in May of 2017
- **A PTY LTD v. HomeAway.** Defended HomeAway in a patent infringement matter relating to email software. The case was pending in the W.D. Tex. before Judge Robert L. Pitman, who granted judgment on the pleadings in March 2016, finding the patent invalid under section 101
- **St. Isidore v. Southside Bank and Texas Capital Bank.** Defended Southside and Texas Capital in patent infringement action relating to computer security. The case was pending in the E.D. Tex. before Judge Rodney Gilstrap, but settled following institution of CBMs on all asserted claims in July 2016
- **TMS v. Overhaul Group.** Defended Overhaul in trade secret misappropriation action in Travis County, Texas. The case settled favorably following mediation in April 2016
- **GroupChatter v. Itron.** Defended Itron in patent infringement action relating to electronic metering technology. After successfully moving to transfer Itron from the E.D. Tex. to the N.D. of Ga., the case settled soon after transfer in 2016
- **In the Matter or Certain Television Tuners et al.** 337-TA-910 Defended Silicon Labs in International Trade Commission action by Complainant CrestaTech alleging infringement of patents relating to TV tuners. The case was pending before ALJ Lord who issued an Initial Determination of no violation by Silicon Labs. The Commission Final Determination, in September 2015, similarly found no violation by Silicon Labs
- **Enzo Life Sciences v. Luminex.** Defended Luminex in patent infringement action relating to clinical diagnostic technology pending before Judge Stark in the D. Del. The case settled after the *Markman* hearing in July 2015
- **In the Matter of Certain Integrated Circuits, Chipsets and Products Containing Same, including Televisions.** Defended Zoran in International Trade Commission action by Freescale relating to memory interface technology. The case was pending before ALJ Robert K. Rogers and resulted in a Commission finding of no violation in September 2012
- **Acqis LLC v. Oracle America et al.** Defended Oracle America (formerly Sun Microsystems) in a multi-defendant patent infringement case pending before Judge Leonard Davis in the E.D. Tex. The case involved allegations of infringement of numerous patents asserted against blade server technology. The case proceeded through a Markman hearing and expert discovery with Oracle settling shortly before the pretrial conference in late 2010
- **Blackboard v. Desire2Learn.** Led the defense of Desire2Learn against allegations of patent infringement relating to eLearning software in the E.D. Tex., D. Md., and in the International Trade Commission. The cases settled in late 2009 after Desire2Learn prevailed on a rare motion to stay the ITC proceeding in its early stages
- **Horizon Radiology v. McKesson.** Successfully defended McKesson at trial in a multi-billion dollar trademark infringement case before Judge David Hittner in federal court in Houston. Selected to replace existing counsel in the months leading up to trial in early 2009, we prevailed in establishing no likelihood of confusion before a Houston jury
- **Broadcom v. QUALCOMM.** Defended QUALCOMM against allegations of misconduct arising out of standard setting activity involving QUALCOMM's patented technology. The case settled during the week before trial in early 2008

- **Crossroads v. Dot Hill Systems.** Led the trial team representing Crossroads in a patent infringement relating to Crossroads storage route pending before Judge Sam Sparks in the W.D. Tex. On the first day of trial in late 2006, Dot Hill agreed to pay Crossroads US\$10.5 million in past damages and a 2.5 percent running royalty
- **In the Matter of Rambus Inc.** Defended Rambus at trial before the Federal Trade Commission in a matter alleging antitrust and unfair competition arising out of standard setting activity involving Rambus's patented technology. After a three month trial in the summer of 2004, Rambus won a complete victory before the FTC Administrative Law Judge – a result that was later affirmed on appeal to the D.C. Circuit

CREDENTIALS

Admissions

- Texas
- California

Clerk Experience

- Judicial Extern for the Honorable Ruben B. Brooks, United States Magistrate Judge, Southern District of California

Civic and Charitable

- Trustee, Zach Theatre, Austin, Texas

Recognitions

The respected English publisher Chambers & Partners has recognized John in *Chambers USA* in the area of intellectual property law every year since 2007 and has called him a "phenomenal lawyer who looks out for clients' best interests." He "is praised by clients for his 'ability to translate complex problems into business speak.'" One *Chambers* source noted that he "showed a level of care and concern for the client that was very impressive," while another source highlighted John's "good practical business understanding of how we need to manage our litigation."

The Legal 500 United States has recognized him in the area of patent litigation and described him as "knowledgeable, responsive, efficient, practical, and aware of client goals." John "provides outstanding service and results" and "seeks out client input every step of the way." *IAM Magazine* has noted that John receives "outstanding reviews" and that "mere words cannot express the level of confidence he instills."

Education

- J.D., University of San Diego 1998
Order of the Coif, *cum laude*
- B.A., Villanova University 1990

Courts

- United States Court of Appeals for the Federal Circuit
- United States Court of Appeals for the Fifth Circuit
- United States District Court for the Eastern District of Texas
- United States District Court for the Western District of Texas
- United States District Court for the Southern District of Texas
- United States District Court for the Southern District of California
- United States District Court for the Central District of California
- United States District Court for the Eastern District of California

- United States District Court for the Northern District of California

Memberships

- Austin Intellectual Property Law (Yeakel) Inn of Court
- Federal Bar Association

Military Service

Before he began practicing law, John spent seven years on active duty as a surface line officer in the United States Navy. His Navy assignments included a tour as the Operations Officer aboard USS Chancellorsville, an Aegis guided missile cruiser deployed to the Arabian Gulf in support of Operation Southern Watch.

INSIGHTS

Publications

- "Stays pending inter partes review: the first year," *Intellectual Property and Technology News*, 26 Mar 2014
- "America Invents Act: will the joinder provisions save time and money?," *Intellectual Property and Technology News*, 30 Mar 2012
- "EDTX closely scrutinizes nuisance value settlement strategy," *Intellectual Property and Technology News*, 28 Jun 2011
- "A New Deal in Venue Transfers," April 2009
- "Rambus Decision Sheds Light On Intellectual Property Issues in Industry Standard Setting," February 5, 2003
- "Your Customers, Your Trademark . . . Their Website: Trademark Infringement Through Metatags," Summer 2000

Events

- "Economic Domestic Industry at the ITC: Challenges for Practicing and Non-Practicing Entities," San Diego, CA, May 2015
- "Examining the New Joinder Provisions of the Leahy-Smith America Invents Act," IPLAC Patent Symposium, November 4, 2011
- "KSR v. *Teleflex*: Examining the Obviousness Inquiry in Patent Law," Intellectual Property Assets in Oil & Gas, October 24, 2007

NEWS

MEDIA MENTIONS

- "34 DLA Piper lawyers in nine countries ranked among The World's Leading Patent Professionals," *DLA Piper*, October 30, 2019