

DONALD M. FALK

PARTNER

Experience

Appellate litigation: oral arguments, briefs, and motions in the United States Supreme Court, many other federal and state appellate and trial courts ■ wide range of constitutional, statutory, patent, securities, administrative, criminal and common law issues. **Antitrust:** antitrust briefing, counseling and analysis in high technology, pharmaceutical, and other industries; presentations to federal executive and legislative personnel and state attorneys general ■ litigation in appellate and trial courts. **Additional areas of experience:** intellectual property ■ telecommunications ■ securities ■ health care ■ employment litigation.

Highlights: Don argued before the U.S. Supreme Court in *Jones v. United States*, 529 U.S. 848 (2000), winning a 9-0 judgment narrowing the scope of a federal statute in light of concerns about the scope of Congress's power under the Commerce Clause. He has also successfully briefed and argued cases before the highest courts of Texas and Maryland. *Miga v. Jensen*, 96 S.W.3d 207 (Tex. 2002) (options valuation); *NAACP v. Golding*, 679 A.2d 554 (Md. 1996).

His briefing before the California Supreme Court also has been successful, winning a unanimous decision in *Kingston Constructors, Inc. v. Washington Metropolitan Area Transit Authority*, 14 Cal. 4th 939 (1997). He has extensive experience with California's extraordinarily broad unfair competition law (Business & Professions Code § 17200). The California Supreme Court explicitly followed one of his amicus briefs in narrowing the remedial scope of that statute. *Kraus v. Trinity Management Services*, 23 Cal.4th 116 (2000).

Much of Don's work involves antitrust. Don has served as counsel for the Computer & Communications Industry Association and the Software and Information Industry Association in the Microsoft antitrust case. Don prepared the amicus brief that is described by Professor Calkins in the *Antitrust Law Journal* (Vol. 68, p. 625): "It's an excellent brief, by the way. * * * ' So observed Judge Thomas Penfield Jackson during the hearing on Microsoft remedies, about an amicus brief filed by two trade associations. Judge Jackson kicked off the afternoon session with a series of detailed questions about that brief. No one can say that antitrust amicus efforts are ignored." The same article concluded by examining an amicus brief that Don prepared for the NCAA, and credited that brief as a prime influence on the pro-defendant formulation of the legal standard in *California Dental Ass'n v. FTC*, 526 U.S. 756 (1999). Most recently, Don helped prepare the winning brief in *LePage's Inc. v. 3M*, 324 F.3d 141 (3d Cir. 2003) (en banc).

Don's work on patent issues includes extensive work on two cases helping patentees enforce their patents against imitators who produced insubstantial variants (i.e., "equivalents") of particular elements of claimed inventions. He was deeply involved in the merits briefing for the prevailing petitioner in the *Festo* case decided by the Supreme Court. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002). In the Federal Circuit, his briefing helped Caterpillar overturn a summary judgment of non-infringement of a tractor patent drafted in means-plus-function form. *Caterpillar Inc. v. Deere Co.*, 224 F.3d 1374 (Fed. Cir. 2000).

Don also prepares major motions at the trial level. His briefing for Oracle Corporation won dismissal of a securities case in 2003. He will defend that judgment at oral argument in the appeal in April 2004.

Employment

Mayer, Brown, Rowe & Maw, Palo Alto, CA, June 2001-present; Washington, D.C., 1991-2001; Partner, 1999 ■ Law Clerk to The Honorable Douglas H. Ginsburg, U.S. Court of Appeals for the District of Columbia Circuit, 1990-1991.

Education

University of California, Berkeley, J.D., 1990; Order of the Coif; Articles Editor, *Ecology Law Quarterly* ■ University of Chicago, M.A., 1977 ■ University of California, Berkeley, B.A. with highest departmental honors, 1976, Doctoral Study, English, 1977-1978.

Publications

Author: “Antitrust and Refusals to Deal After *Nynex v. Discon*,” *Practical Lawyer*, April 2000, at 25 ■ Note, “Lyng v. Northwest Indian Cemetery Protective Association: Bulldozing First Amendment Protection of Indian Sacred Lands,” 16 *Ecology L. Q.* 515, 1989. **Co-Author:** “Plus Ça Change? Anti-Trust Enforcement Under the Bush Administration,” *International Merger Focus* (UK), 2002 ■ “Settlement of Patent Disputes: Antitrust and Intellectual Property at the Crossroads,” *Antitrust Report*, Nov. 2001 ■ “Antitrust, Competition & Health Care Reform,” 13 *Health Aff.* 206, Spring 1994 ■ “The Court En Banc: 1981-1990,” 59 *George Washington Law Review* 1008, 1991.

Memberships

American Bar Association, Litigation, Antitrust, and Intellectual Property Sections ■ State Bar of California, Litigation, Antitrust, and Intellectual Property Sections.

Admitted

District of Columbia, 1993 ■ California, 1990 ■ U.S. District Court for the District of Columbia, 1993 ■ Northern District of California, 1997 ■ Central District of California, 1999 ■ Eastern District of California, 1999 ■ U.S. Court of Appeals for the Third, 1996, Fourth, 1991, Fifth, 1997, Sixth, 1993, Seventh, 1997, Eighth, 1996, Ninth, 1996, Tenth, 1997, District of Columbia, 1992, and Federal, 1997, Circuits ■ U.S. Supreme Court, 1994.

Further information and links to some examples of Don’s work appear at www.appellate.net/falk.