

J. Daniel Harkins

Member

San Antonio

Weston Centre
112 E. Pecan Street
Suite 1800
San Antonio, TX 78205



T: 210-554-5285 F: 210-226-8395 dharkins@dykema.com

Areas Of Practice

Intellectual Property
Intellectual Property Litigation
Litigation
Biotechnology and Life Science
Trademark
Privacy and Data Security

Bar Admissions

Texas, 1987

Court Admissions

U.S. Supreme Court
U.S. Court of Appeals, Fifth Circuit
U.S. District Court, Northern,
Southern, Western and Eastern
Districts of Texas

Education

St. Mary's University School of
Law, J.D., *with honors*, 1987
University of Dallas, B.A., Political
Philosophy, *cum laude*, 1981

Dan Harkins is the Intellectual Property and IP Litigation Department Director of Dykema. For more than 30 years, Mr. Harkins has advised clients on how best to protect and enhance their intellectual property assets. He litigates patent, trademark, domain name, copyright, and trade secret disputes, as well as technology and commercial disputes. Recognized nationally for his trademark litigation experience, Dan is frequently asked to speak and write about trade secrets and intellectual property issues.

Experience

Dan has worked on behalf of a wide range of clients in evaluating, defending and resolving commercial and intellectual property disputes. His experience includes:

Patent Litigation

- Lead counsel in obtaining summary judgment dismissing all claims in a legal malpractice, negligence, fraud and breach of fiduciary duty case arising out of the prosecution of a patent, and successfully argued on appeal to the Fifth and Federal Circuits. *USPPS, Ltd. v. Avery Dennison Corp.*, 647 F.3d 274 (5th Cir. 2011) and 676 F.3d 1341 (Fed. Cir. 2012).
- Lead counsel in defending refinery client against allegations of patent infringement relating to a patent directed to particle fluidization in a fluid catalytic cracking unit of the refinery. Case settled very favorably after a successful Markman Hearing. *Shell Global Solutions v. RMS Eng'g*, 782 F. Supp. 2d 317 (S.D. Tex. 2011).
- Lead counsel in a patent infringement case representing inventor against major electronics manufacturer on patent directed to ergonomically designed wireless headsets.
- Lead counsel for pharmaceutical company in defending patent owner's rights in patent direct to treatment of kidney stones and enjoining introduction of infringing generic drug.
- Lead counsel in defending manufacturer of microwave processing equipment, used to process fly ash from coal burning power plants, in a patent infringement and antitrust lawsuit.
- Defense counsel in various patent infringement litigation brought by non-practicing entities, also referred to as "patent trolls," including the following:

J. Daniel Harkins (Cont.)

- Acacia-Paul Ware (N.D. Ga.)
- Blue Spike (E.D. Tx)
- DataTreasury Corp. (E.D. Tx)
- GeoTag, Inc. (E.D. Tx)
- Landmark Technology (E.D. Tx)
- Parts River/Kelora (W.D. Wis. & N.D. Cal.)
- Traffic Information Systems (E.D. Tx)
- Webvention (E.D. Tx)
- Wolf Run (E.D. Tx)

Trademark and Unfair Competition Litigation

- Lead counsel representing national jewelry manufacturer and enforcing trademarks against various infringers throughout the United States, and preventing the importation and distribution of infringing products from China and other foreign countries.
- Lead counsel representing automotive protective film manufacturer enforcing trademarks, obtaining Permanent Injunction and Damages Order against Chinese manufacturers, importers and distributors.
- Lead counsel representing international construction company in an Opposition proceeding before the Trademark Trial and Appeal Board.
- Lead counsel of a regional grocery store in connection with a series of Cancellation proceedings against competitor before the Trademark Trial and Appeal Board.
- Lead counsel representing national retail optical company relating to alleged infringement of trademarks on eyeglass frames and accessories.
- Lead counsel representing national professional fundraiser in connection with alleged use of trademarks in Google ad word campaigns.
- Representation of national optical retailer defending against claims of trademark infringement and deceptive advertising resulting from alleged use of trademarks in Google ad word campaigns, and resulting representation of retailer in FTC investigation.
- Lead counsel representing national medical device company in connection with enforcement of trademarks and intellectual property rights against competing medical device distributor.
- Lead counsel representing hospital system enforcing trademarks against infringing institutions using confusingly similar marks.
- Lead counsel representing university enforcing trademarks by obtaining temporary restraining order and permanent injunction against infringing institutions of higher learning and online educational institutions using confusingly similar marks.
- Co-lead counsel representing national performing artists in various trademark infringement matters enforcing trademarks by obtaining temporary restraining and seizure order, enabling US Marshall's to seize counterfeit merchandise.
- Lead counsel representing national retailer in domain name and trademark infringement lawsuits and Internet Corporation for Assigned Names and Numbers (ICANN) proceedings, including assertion of claims under the Anti-Cybersquatting Act.

Copyright Litigation

- Lead counsel representing national jewelry manufacturer in numerous copyright infringement matters enforcing copyrights in jewelry designs. In several cases, have obtained temporary restraining and seizure order, enabling U.S. marshalls to seize counterfeit jewelry.
- Co-lead counsel representing the American Academy of Orthopedic Surgeons against claims of copyright infringement and joint authorship of leading book on training of emergency medical service personnel, obtaining summary judgment dismissing all claims. *Clogston v. American Academy of Orthopedic Surgeons*, 930 F. Supp. 1156 (W.D. Tex 1996).

J. Daniel Harkins (Cont.)

Trade Secret Litigation

- Lead counsel representing manufacturer of recycling equipment in action for misappropriation of trade secrets, breach of covenants not to compete and tortious interference with contractual relations.

Software Failure Litigation

- Lead counsel representing national retailer against a software developer for breach of contract relating to failure of licensed software.

Franchise and Distributor Litigation

- Lead counsel representing national telecommunications and wireless service provider in various actions by agents alleging breach of agency/distributorship agreements.
- Co-lead counsel representing pneumatic parts manufacturer in action concerning alleged breach of distributorship agreement.

General Commercial Litigation

- Lead counsel representing national retailer in various disputes with regulatory boards.
- Lead counsel representing Mexican mining corporation in breach of contract, tortious interference, fraudulent inducement and breach of duty of good faith and fair dealing relating to a \$2.8 million letter of credit and contract on futures market.

Seminars & Speeches

Trends In Health Care Fraud Enforcement Seminar
January 25, 2017

San Antonio Business Journal, 2014 Healthcare Heroes
May 7, 2014

Daughters of Charity Services -- 2012 St. Vincent DePaul Service Leadership Awards Luncheon
June 27, 2012

Catholic Charities – 9th Annual Lifetime of Faith and Service Award Dinner
April 11, 2012

Prevent Blindness Texas – Person of Vision Dinner
March 29, 2012

San Antonio River Foundation – ‘Your River is Your Legacy’ Luncheon
November 3, 2011

YWCA – Women of Influence Awards Luncheon honoring Kim Bowers (Valero)
October 25, 2011

News

New Department Head Dan Harkins Spotlited in *IP Pro Patents*
June 27, 2018

Dan Harkins Weighs in on Cox Verdict in *Westlaw Journal: Intellectual Property*
February 14, 2018

Memberships & Involvement

- State Bar of Texas

J. Daniel Harkins (Cont.)

- American Bar Association
- San Antonio Bar Association
- Bar Association of the Fifth Circuit
- Texas Association of Defense Counsel
- Defense Research Institute
- American Intellectual Property Law Association
- San Antonio Intellectual Property Law Association
- American Inn of Court, William S. Sessions Chapter
- College of the State Bar of Texas
- San Antonio Bar Foundation
- Dykema Management Advisory Committee

Community/Civic Activities

- North Chamber of Commerce, Member of Board of Directors (2004-2007)
- Assumption Seminary, Member of Board of Directors (2008-present)
- Legatus, President of San Antonio Chapter (2010-present)
- Catholic Charities of San Antonio, Member of Board of Directors (2009-present)

Awards & Recognition

- Recognized in *The Best Lawyers in America*® for Copyright, Trademark and Patent Law and Intellectual Property and Patent Litigation, 2011-Present. Copyright 2015 by Woodward/White, Inc., Aiken, SC
- Martindale-Hubbell® AV® Preeminent™ Peer Review Rating
- Named by *The Best Lawyers in America*® as San Antonio Intellectual Property Litigation "Lawyer of the Year," (2013, 2016 and 2018) and Litigation (Patent) "Lawyer of the Year" (2015)
- S.A. Scene, "San Antonio's Best Lawyers," 2016, 2018