

# Professional Biography

**JAMES B. COUGHLAN | PARTNER***Firmwide Co-Chair, ITC Section 337 Actions*

WASHINGTON, D.C.  
700 13th Street, NW, Suite 600  
Washington, DC  
+1.202.434.1670  
JCoughlan@perkinscoie.com

CHICAGO  
131 South Dearborn Street, Suite 1700  
Chicago, IL  
+1.312.324.8537  
JCoughlan@perkinscoie.com

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Jim has extensive patent litigation experience before the U.S. International Trade Commission both as a partner in private practice and in his former position as a lead staff attorney at the ITC's Office of Unfair Import Investigations. Jim has served as lead ITC counsel in over 40 ITC investigations, has litigated 14 actions through to trial at the ITC and has also litigated 4 ITC actions on appeal before the U.S. Court of Appeals for the Federal Circuit. Jim served as lead ITC counsel in a major dispute involving two well-known, competing smart phone operating systems, and represented two cell phone manufacturers in one of the largest and most significant ITC actions on record which resulted in the Federal Circuit's Kyocera decision. He has represented clients before the U.S. Department of Customs and Border Protection and the Office of the U.S. Trade Representative after the conclusion of the ITC proceedings to obtain approval for design around devices and a delay in the imposition of ITC remedial orders.

Jim's representations have involved patents relating to various technologies including wireless communication devices, 4G communication technologies, streaming video software, portable digital media players, integrated circuits, jet engines, hardware logic emulation devices, adhesives, biotechnology methods for producing growth hormones, smoke suppressants and welding wire. Jim belongs to the ITC Trial Lawyers Association.

In addition to his experience before the ITC, Jim served as legal counsel for U.S. Senator Carl Levin and as judicial law clerk for the Hon. Marion T. Bennett, U.S. Court of Appeals for the Federal Circuit.

**PROFESSIONAL RECOGNITION**

- Recommended in *Intellectual Asset Management Patent 1000*, 2016

**PROFESSIONAL LEADERSHIP**

- ITC Trial Lawyers Association

**RELATED EMPLOYMENT**

- Paul Hastings, Chicago, IL, Of Counsel, 2007 - 2009
- Kirkland & Ellis, Chicago, IL, Of Counsel, 2003; Partner, 2004 - 2007
- Senior Staff Attorney, U.S. International Trade Commission, Office of Unfair Import Investigations
- United States Senator Carl Levin, Office Legal Counsel

## CLERKSHIPS

- Hon. Marion Bennett, U.S. Court of Appeals for the Federal Circuit

## EXPERIENCE

### ITC MATTERS

#### ELECTRONICS AND COMPUTER SOFTWARE LITIGATION

##### **IN THE MATTER OF CERTAIN TOUCHSCREEN CONTROLLERS AND PRODUCTS CONTAINING THE SAME, U.S. INTERNATIONAL TRADE COMMISSION INVESTIGATION NO. 337-TA-957**

Lead counsel for Respondents Shenzhen Huiding Technology Co., Ltd. (d.b.a. Goodix) and Goodix Technology Inc. in a four-patent investigation before ALJ Essex (later transferred to ALJ McNamara) concerning touchscreen controllers used in smartphones; settled favorably after the hearing. At the time of the hearing the Office of Unfair Import Investigations recommended a finding of no violation.

##### **IN RE CERTAIN POINT-TO POINT NETWORK COMMUNICATION DEVICES AND PRODUCTS CONTAINING SAME, INV. NO. 337-TA-892**

Represented Netflix and AmTRAN in patent litigation before ALJ Shaw brought by a patent assertion entity against accused smart TVs, Blu-ray players, tablets and the Netflix software used to stream video content on those devices. Just prior to trial, patent owner Straight Path IP Group, Inc. withdrew its complaint to pursue its claims in district court, where we obtained an order of sanctions based on improper discovery abuses, and the matter was settled.

##### **IN RE CERTAIN DIGITAL MEDIA DEVICES, INCLUDING TELEVISIONS, BLU-RAY DISC PLAYERS, HOME THEATER SYSTEMS, TABLETS AND MOBILE PHONES, COMPONENTS THEREOF AND ASSOCIATED SOFTWARE, INV. NO. 337-TA-882**

Represented Netflix in a patent litigation before ALJ Shaw brought by patent assertion entity Black Hills Media against accused smart TVs, Blu-ray players, tablets and the Netflix software used to stream video content on those devices. The judge found and the Commission affirmed a finding of no infringement.

##### **IN RE CERTAIN ELECTRONIC IMAGING DEVICES, NO. 337-TA-850**

Defended HTC in a four-patent investigation before ALJ Essex relating to smartphones, including the chipsets, user interface and software used in those smartphones. The patents at issue were owned by FlashPoint Technology, Inc., a non-practicing entity founded in 1996 as a spinoff of Apple Computer, Inc. In the ITC's final ruling, HTC was cleared of all patent infringement allegations, and FlashPoint chose not to appeal the decision.

##### **IN RE CERTAIN PRODUCTS CONTAINING INTERACTIVE PROGRAM GUIDE AND PARENTAL CONTROL TECHNOLOGY, NO. 337-TA-845**

U.S. International Trade Commission

Defended Netflix and Roku in a seven-patent investigation before ALJ Shaw relating to software used to stream video content into customers' homes for display on televisions and computers. Netflix and Roku were each cleared of patent infringement claims brought by Rovi Corp. and its subsidiaries by the ALJ, and the Commission largely affirmed that determination.

##### **IN RE CERTAIN CONSUMER ELECTRONICS, INCLUDING MOBILE PHONES AND TABLETS, NO. 337-TA-839**

U.S. International Trade Commission

Defended ASUS in a five-patent investigation before ALJ Gildea, brought by patent assertion entity Pragmatius, directed to smartphones, televisions and tablets. The investigation was terminated as a result of settlement.

##### **IN RE CERTAIN CONSUMER ELECTRONICS AND DISPLAY DEVICES AND PRODUCTS, NO. 337-TA-836**

U.S. International Trade Commission

Defended HTC in a four-patent investigation before ALJ Essex, brought by patent assertion entity against Graphic Properties Inc., directed to smartphones, including the CPU architecture, floating point rasterization and framebuffering in graphics processing units, and large-area, wide aspect ratio, flat-panel technologies. The effective use of statements

made by the patent owner during IPR proceedings helped to limit the scope of the claims. The matter was terminated as a result of settlement.

**IN RE CERTAIN MOBILE ELECTRONIC DEVICES INCORPORATING HAPTICS, INV. NO. 337-TA-834**

Defended HTC in a six-patent investigation before ALJ Gildea relating to mobile devices incorporating haptics technologies. The patent owner, Immersion Corporation, voluntarily withdrew its complaint just weeks before trial.

**IN RE CERTAIN ELECTRONIC IMAGING DEVICES, INV. NO. 337-TA-726**

U.S. International Trade Commission

Defended HTC in an investigation before CALJ Luckern in which FlashPoint Technology, Inc., a spinoff from Apple, asserted that all of HTC's (and most of the rest of the smartphone market's) Android and Windows-based phones infringed three patents, relating primarily to digital imaging functionality and device capability querying technologies. Almost all respondents, including Nokia and RIM, settled before the trial. CALJ Luckern found that none of the asserted patents were infringed, FlashPoint failed to prove a domestic industry for its patents, and one of Flashpoint's patents was invalid. The Commission and Federal Circuit affirmed.

**IN RE CERTAIN PERSONAL DATA AND MOBILE COMMUNICATION DEVICES AND RELATED SOFTWARE, INV. NO. 337-TA-710**

U.S. International Trade Commission

Obtained the first ever delay in the imposition of an ITC exclusion order for our client, HTC, which allowed time for HTC to obtain approval to import design around devices. Defended HTC in an investigation before ALJ Charneski, in which Apple asserted that HTC smartphones infringed 10 patents relating to operating systems software and software and techniques by which a user interacts with a touch-screen. Obtained a favorable outcome when Apple was forced to withdraw its claims as to six patents before trial. Of the remaining four patents, the ALJ found two not infringed (and the Commission affirmed) and two infringed (the Commission affirmed for one and reversed for the other). Matter was terminated on appeal under terms of global settlement.

**IN RE CERTAIN WIRELESS COMMUNICATION DEVICES, COMPONENTS THEREOF, AND PRODUCTS CONTAINING SAME, NO. 337-TA-583\***

Represented patent owner in a nine-patent investigation before ALJ Bullock relating to wireless communication devices, including cell phones and base stations. The patents concerned hardware and software for UMTS (i.e., 3G or WCDMA) wireless telecommunication devices, including wireless infrastructure equipment, cellular telephones and error-control coding. The investigation was terminated as a result of settlement.

**IN RE CERTAIN WIRELESS COMMUNICATION EQUIPMENT, ARTICLES THEREIN, AND PRODUCTS CONTAINING THE SAME, NO. 337-TA-577\***

Defended a client in multipatent investigation before ALJ Luckern relating to wireless communication devices, including cell phones and base stations. The patents concerned hardware and software for UMTS (3G or WCDMA) wireless telecommunication devices including wireless infrastructure equipment, cellular telephones and error-control coding. The investigation was terminated as a result of settlement.

**IN RE CERTAIN PORTABLE DIGITAL MEDIA PLAYERS, NO. 337-TA-576\***

Represented a client in "slap back" litigation before ALJ Barton against Creative Labs, Inc. and Creative Technology Ltd. involving the same technologies as related ITC action (No. 337-TA-573). The investigation was terminated as a result of settlement.

**IN RE CERTAIN PORTABLE DIGITAL MEDIA PLAYERS, NO. 337-TA-573\***

Defended a client in litigation before ALJ Luckern brought by Creative Labs, Inc. and Creative Technology Ltd., relating to portable digital media (music) players. The investigation was terminated as a result of settlement.

**IN RE CERTAIN ZERO-MERCURY-ADDED ALKALINE BATTERIES, NO. 337-TA-493\***

Defended Chinese company in a one-patent investigation before ALJ Bullock relating to zero-mercury-added alkaline batteries.

**SEMICONDUCTORS LITIGATION**

**IN RE CERTAIN DYNAMIC RANDOM ACCESS MEMORY AND NAND FLASH MEMORY DEVICES AND PRODUCTS CONTAINING THE SAME, 337-TA-803**

Represented third-party "domestic industry licensee" Micron in an investigation before ALJ Gildea involving semiconductor devices.

**IN RE CERTAIN SEMICONDUCTOR CHIPS AND PRODUCTS CONTAINING SAME, NO. 337-TA-753**

Defended Broadcom in a six-patent investigation before ALJ Essex relating to DDRx memory controller products and peripheral interface products. The investigation was terminated as a result of the settlement shortly after the hearing.

**IN RE CERTAIN BASEBAND PROCESSOR CHIPS AND CHIPSETS, TRANSMITTER AND RECEIVER (RADIO) CHIPS, POWER CONTROL CHIPS, AND PRODUCTS CONTAINING SAME, INCLUDING CELLULAR TELEPHONE HANDSETS, NO. 337-TA-543\***

Represented Motorola in the remedy phase of five-patent investigation before ALJ Bullock relating to systems and chipsets for wireless communications. This investigation was recognized as one of the largest in the history of the ITC and resulted in the Federal Circuit's Kyocera decision, which precluded the ITC from issuing remedies directed to unnamed downstream product manufacturers and importers.

**IN RE CERTAIN AUDIO PROCESSING INTEGRATED CIRCUITS, NO. 337-TA-538\***

Represented patent owner SigmaTel in a two-patent investigation against Actions Semiconductor Co. before ALJ Luckern relating to audio processing integrated circuits and products containing the same, such as MP3 players.

**CONSUMER PRODUCTS LITIGATION**

**IN THE MATTER OF CERTAIN PASSENGER VEHICLE AUTOMOTIVE WHEELS, U.S. INTERNATIONAL TRADE COMMISSION INVESTIGATION NO. 337-TA-1006**

Counsel for Respondent Amazon.com, Inc. in an investigation involving two design patents and one trademark before ALJ Pender concerning automobile tires; the investigation was terminated after the complainant withdrew its complaint as to Amazon.

**IN RE CERTAIN MULTIPLE MODE OUTDOOR GRILLS AND PARTS THEREOF, INV. NO. 337-TA-895**

Represented respondents Academy Ltd. and Ningbo Huige Outdoor Products Co., Ltd. in a one-patent, two-design patent investigation before ALJ Shaw concerning multiple mode barbeque grills.

**IN RE PRODUCTS HAVING LAMINATED PACKAGING, LAMINATED PACKAGING AND COMPONENTS THEREOF, NO. 337-TA-874**

U.S. International Trade Commission

Represented Hasbro in a two-patent investigation before ALJ Essex in the first investigation in which the ITC used its new pilot program and held an early hearing on whether a domestic industry exists. The ALJ held that there was no domestic industry, and the full Commission affirmed and terminated the action. The matter settled on appeal.

**IN RE CERTAIN SINTERED RARE EARTH MAGNETS, METHODS OF MAKING SAME AND PRODUCTS CONTAINING SAME, INV. NO. 337-TA-855**

U.S. International Trade Commission

Defended Allstar Magnetics in a four-patent investigation before ALJ Bullock relating to magnets used in consumer electronics devices. The investigation was terminated as a result of settlement.

**IN RE CERTAIN DRILL BITS AND PRODUCTS CONTAINING THE SAME, NO. 337-TA-844**

U.S. International Trade Commission

Represented Complainant Boart Longyear in a three-patent investigation before ALJ Rogers relating to drill bits used in core drilling applications. The investigation was terminated when the respondent affirmed that it was no longer importing the patented drill bits into the United States.

**IN RE CERTAIN MOTION-SENSITIVE SOUND EFFECTS DEVICES AND IMAGE DISPLAY DEVICES AND COMPONENTS AND PRODUCTS CONTAINING SAME II, NO. 337-TA-787**

Defended Respondent Planar in an action brought by patent assertion entity Agility IP Law directed to digital display devices. The investigation was terminated based on settlement.

**IN RE CERTAIN TURBOMACHINERY BLADES, ENGINES, AND COMPONENTS THEREOF, NO. 337-TA-751**

U.S. International Trade Commission

Represented third-party The Boeing Company in a one-patent investigation before ALJ Bullock covering commercial jet engine technology in which it was argued that any remedy imposed on the respondent would be void as contrary to the public interest due to its impact on the public, including third-party Boeing. The investigation was terminated based on settlement.

**IN RE CERTAIN WELDING WIRE CONTAINERS AND WELDING WIRE, NO. 337-TA-686**

U.S. International Trade Commission  
Represented Lincoln Global, Inc. and The Lincoln Electric Company in a seven-patent investigation before ALJ Rogers relating to welding wire containers and welding wire.

**IN RE CERTAIN RUBBER ANTIDEGRADANTS, COMPONENTS THEREOF, AND PRODUCTS CONTAINING SAME I, INV. NO. 337-TA-652\***

U.S. International Trade Commission  
Represented Complainant Flexsys America, L.P. in a two-patent investigation before CALJ Luckern relating to rubber antidegradant additives for such products as vehicle tires.

**IN RE CERTAIN RUBBER ANTIDEGRADANTS, COMPONENTS THEREOF, AND PRODUCTS CONTAINING SAME II, INV. NO. 337-TA-533\***

Represented Complainant Flexsys America, L.P. in a two-patent investigation before CALJ Luckern relating to rubber antidegradant additives for products such as vehicle tires.

**ITC STAFF ATTORNEY MATTERS**

**IN RE AMMONIUM OCTAMOLYBDATE ISOMERS, INV. NO. 337-TA-477\***

U.S. International Trade Commission  
Served as ITC staff attorney for an investigation involving smoke inhibiting additives for home construction materials.

**IN RE ENHANCED DRAM DEVICES CONTAINING EMBEDDED CACHE MEMORY REGISTERS, INV. NO. 337-TA-421\***

U.S. International Trade Commission  
Served as ITC staff attorney for an investigation involving programmable integrated circuits.

**IN RE POWER SAVING INTEGRATED CIRCUITS, INV. NO. 337-TA-463\***

U.S. International Trade Commission  
Served as ITC staff attorney for an investigation involving power saving technologies used with integrated circuits.

**IN RE FLOORING PRODUCTS, INV. NO. 337-TA-443\***

U.S. International Trade Commission  
Served as ITC staff attorney in multiparty investigation involving patents covering snap-together flooring products.

**IN RE HARDWARE LOGIC EMULATION SYSTEMS, INV. NO. 337-TA-383\***

U.S. International Trade Commission  
Served as ITC staff attorney in an advisory opinion proceeding involving devices for integrated remote emulation of integrated circuit technologies.

**IN RE INK JET PRINT CARTRIDGES AND COMPONENTS THEREOF, INV. NO. 337-TA-446\***

U.S. International Trade Commission  
Served as ITC staff attorney for an investigation involving patents covering ink jet cartridges for printer devices.

**IN RE MAGNETIC RESONANCE INJECTION SYSTEMS, INV. NO. 337-TA-434\***

U.S. International Trade Commission  
Served as ITC staff attorney for an investigation involving patents covering MRI technologies.

**IN RE SEMICONDUCTOR TIMING SIGNAL GENERATOR DEVICES, INV. NO. 337-TA-465\***

U.S. International Trade Commission  
Served as ITC staff attorney for an investigation involving timing signal generator devices.

**IN RE MICROSPHERE ADHESIVES AND PROCESS FOR MAKING SAME, INV. NO. 337-TA-366\***

U.S. International Trade Commission  
Served as ITC staff attorney for an investigation involving the process for manufacturing adhesives used in repositionable notes.

**IN RE RECOMBINANTLY PRODUCED HUMAN GROWTH HORMONES, INV. NO. 337-TA-358\***

U.S. International Trade Commission  
Served as ITC staff attorney for an investigation involving the process for genetically manufacturing human growth hormone.

## DISTRICT COURT MATTERS

### PATENT LITIGATION

#### **SENARIO, LLC V. MEGA BRANDS, INC.**

U.S. District Court for the Northern District of Illinois  
Represented defendant Mega Brands in patent infringement action involving portable desk technology.

#### **GRECIA V. DIRECTV, LLC**

U.S. District Court for the Northern District of Illinois  
Represented defendant DirecTV in patent infringement action involving video streaming.

#### **INTELLECT WIRELESS, INC. V. HTC CORPORATION ET AL.**

U.S. District Court for the Northern District of Illinois  
Represented defendant HTC in patent infringement action involving wireless communication devices.

#### **QURIO HOLDINGS, INC. V. DIRECTV, LLC**

U.S. District Court for the Northern District of Illinois  
Defended client DirecTV, LLC in a two-patent litigation relating generally to wireless networks and wireless media devices.

#### **ADVANCED AUDIO DEVICES V. HTC AMERICA**

U.S. District Court for the Northern District of Illinois  
Defended client HTC in litigation in a multipatent litigation relating generally to a “jukebox” for storing digital music.

#### **HONEYWELL INTERNATIONAL INC. AND HONEYWELL INTELLECTUAL PROPERTIES INC. V. APPLE COMPUTER INC., ET AL.\***

U.S. District Court for the Central District of California  
Defended patent infringement litigation involving computer laptop screen technologies.

#### **DIAGNOSTICS SYS. CORPORATION V. SYMANTEC CORPORATION, ET AL.\***

U.S. District Court for the Central District of California  
Defended multipatent litigation involving computer software patents.

#### **BRAUN GMBH V. RAYOVAC CORPORATION\***

U.S. District Court for the District of Massachusetts  
Defended Rayovac in patent litigation covering electric shaver automatic cleaning functionalities.

#### **AGERE SYS. INC. V. BROADCOM, CORPORATION\***

Litigated audio coding/software patents as part of multipatent litigation.

### HATCH-WAXMAN LITIGATION

#### **APOTEX INC. V. DAIICHI SANKYO, INC. ET AL.**

U.S. District Court for the Northern District of Illinois  
Represented Mylan in declaratory judgement action involving antihypertension drug.

#### **APOTEX INC V. DAIICHI SANKYO, INC. ET AL.**

U.S. District Court for the Northern District of Illinois  
Represented Mylan in declaratory judgement action involving antihypertension drug.

#### **TORRENT PHARMACEUTICALS LIMITED ET AL V. DAIICHI SANKYO, INC. ET AL.**

Represented Mylan in declaratory judgement action involving antihypertension drug.

#### **ALEMBIC PHARMACEUTICALS LIMITED V. DAIICHI SANKYO CO., LTD.**

U.S. District Court for the Northern District of Illinois  
Represented Mylan in declaratory judgement action involving antihypertension drug.

#### **AUROBINDO PHARMACEUTICALS LIMITED ET AL V. DAIICHI SANKYO, INC. ET AL.**

U.S. District Court for the Northern District of Illinois  
Represented Mylan in declaratory judgement action involving antihypertension drug.

**THE MEDICINES COMPANY V. MYLAN, INC.**

U.S. District Court for the Eastern District of Pennsylvania  
Represented Defendant Mylan, Inc. in matter concerning a blood thinning drug product.

**NYCOMED GMBH, ET AL. V. APOTEX, ET AL.\***

U.S. District Court for the Northern District of Illinois  
Represented patent owner Nycomed in litigation involving patents concerning anti-ulcer medications.

**NYCOMED GMBH, ET AL. V. SANDOZ\***

U.S. District Court for the Northern District of Illinois  
Represented patent owner Nycomed in litigation involving patents concerning anti-ulcer medications.

\* Prior Experience

**NEWS**

11.09.2017

***Perkins Coie Presents Seminar on Patent Law Issues Affecting Chinese Companies***

Press Releases

On November 9, 2017, Perkins Coie LLP hosted a patent law seminar program at the Senmao Conference Center in Shanghai. The seminar addressed a variety of pressing intellectual property (IP) issues facing Chinese companies with business interests in the United States.

11.07.2017

***Perkins Coie Presents Seminar on Key U.S. IP Legal Issues Affecting Chinese Companies***

Press Releases

On November 7, 2017, Perkins Coie LLP hosted a patent law seminar at the Oriental Bay International Hotel in Beijing. The seminar addressed current intellectual property (IP) legal issues facing Chinese companies and enterprises whose products are sold in the United States.

11.02.2017

***Perkins Coie Partners with SZPA on Manufacturing Law Seminar for Chinese Companies***

Press Releases

On November 2, 2017, Perkins Coie LLP, along with the Shenzhen Patent Association (SZPA), presented a seminar on timely and critical legal issues impacting international manufacturers who export or sell products and do business in the United States.

10.31.2017

***Perkins Coie Partners with CNFI on Manufacturing Law Seminar for Taiwanese Companies***

Press Releases

On October 31, 2017, Perkins Coie LLP, along with the Chinese National Federation of Industries (CNFI), presented a thoughtful and timely discussion of key legal issues impacting international manufacturers who sell products and do business in the United States.

05.02.2017

***Perkins Coie Co-hosts Patent Litigation Seminar on International Trade Commission Issues***

Press Releases

Perkins Coie co-hosted a seminar presenting and discussing updates on intellectual property (IP) litigation at the United States International Trade Commission (ITC).

07.2015

***General Counsel Features Perkins Coie article on the Fast Pace of IPRs and its Strategic Advantage***

*Today's General Counsel*

The America Invents Act created new administrative trials for litigating patent invalidity issues before the USPTO's Patent Trial and Appeal Board by inter partes review. IPR trials can be initiated by any person who is not the patent owner and not otherwise barred from filing an IPR petition on a given patent. [View full article.](#)

01.06.2012

***Perkins Coie Announces New Partner and Of Counsel Promotions for 2012***

Press Releases

Perkins Coie announced that 12 attorneys have been named Partner and five have been named Of Counsel effective January 1, 2012.

**PUBLICATIONS**

12.2017/01.2018

***Patent Hurdles***

Articles

***Intellectual Property Magazine***

James Coughlan and Kevin Patariu look at some of the benefits and disadvantages of running concurrent challenges with the PTAB and the ITC.

10.2017

***Inter Partes Review Proceedings: A Fifth Anniversary Report***

IPR@5

***An In-Depth Look at Factors Affecting Your IPR Strategy***

Fifth anniversaries are milestone occasions. Following our prior reports marking the passage of three and four years of *inter partes* review practice, we proudly offer this year's report, *Inter Partes Review Proceedings: A Fifth Anniversary Report*.

07.01.2015

***Perkins Coie Attorneys Publish Article on the Strategic Use of Inter Partes Review (IPR) Proceedings Against Patents Asserted at the U.S. International Trade Commission (ITC)***

General Publications

***Today's General Counsel***

Jim Coughlan, Bing Ai, Kevin Patariu, and John Schnurer published an article in the June/July 2015 issue of *Today's General Counsel* on the strategic use of *inter partes* review (IPR) proceedings against patents asserted at the U.S. International Trade Commission (ITC).

June/July 2015

***Inter Partes Review is Fast Paced, Often Strategically Advantageous***

Articles

***Today's General Counsel***

The article outlines the strategic use of *inter partes* review (IPR) proceedings against patents asserted at the U.S. International Trade Commission (ITC). There is a misconception that IPR proceedings are not useful to parties sued for patent infringement at the ITC, perhaps because of the fast pace that is typical of ITC investigations. While it may not be possible to obtain a stay of an ITC investigation during the pendency of an IPR proceeding, a party accused of infringement in an ITC investigation should consider filing an IPR petition relatively early in the life cycle of an ITC investigation as a cost effective and beneficial part of an overall strategy for defending against an action at the ITC.

05.20.2009

***Protecting Domestic Industries***

Articles

***Los Angeles Daily Journal***

2007

***Resolving Intellectual Property Disputes at the U.S. International Trade Commission***

Articles

***BNA International***

2004

***U.S. Intellectual Property Litigation and the ITC***

Articles

***IP Value***

**PRESENTATIONS**

12.06.2017

## *How ITC Investigations Affect Stability of IP Rights of Chinese/U.S. Companies*

### Speaking Engagements

Perkins Attorney Provides ITC Law Update to SIPO Members at the Sixth Annual Chinese Intellectual Property Forum Sponsored by The John Marshall Law School and the China Intellectual Property Training Center of SIPO.

11.09.2017 / 2017年11月9日

### *Intellectual Property Law Seminar 专利法律研讨会*

#### Seminars

Shanghai, China

Participated on a panel discussion highlighting some of the legal issues facing companies or enterprises whose tangible or intangible products sold in the United States, including practical advice on intellectual property issues and post-grant petitions before the USPTO.

11.08.2017 | 2017年11月8日

### *Sino - U.S. Trade & Investment: New Regulations, Policies and Practices 中美贸易投资研讨会 : 最新法规、政策和实务*

#### Seminars

Beijing, China

Participated on a panel discussion highlighting the current state of some of the key regulatory, legal and practical issues of Sino-U.S. trade and investment.

11.07.2017 / 2017年11月7日

### *Patent Law Seminar 专利法律研讨会*

#### Seminars

Beijing, China

Participated on a panel discussion highlighting some of the legal issues facing companies or enterprises whose tangible or intangible products sold in the United States, including criminal trade secret law, protecting company secrets at the U.S. border and practical advice on intellectual property issues.

11.02.2017 | 2017年11月2日

### *China Legal Seminar | 中国法律研讨会*

#### Seminars

Shenzhen Patent Association & Perkins Coie / Shenzhen, China

Presented on a panel discussion of key legal issues facing international manufacturers, including criminal trade secrets law, protecting company secrets at the U.S. border, legal liability for defective products in the U.S. and updates on U.S. intellectual property law.

10.31.2017 | 2017年10月31日

### *Taiwan Legal Seminar | 台湾法律研讨会*

#### Seminars

Chinese National Federation of Industries (CNFI) & Perkins Coie / Taipei, Taiwan

Presented on a panel discussion of key legal issues facing international manufacturers, including criminal trade secrets law, protecting company secrets at the U.S. border, legal liability for defective products in the U.S. and updates on U.S. intellectual property law.

10.26.2017

### *IP Issues Affecting U.S. Corporations*

#### Speaking Engagements

Perkins Coie / Chicago, IL

Patent Litigation practice lunch and learn addressing key patent litigation issues and developments faced by in-house counsel. The program included a sit down with the Honorable Virginia Kendall, who provided a unique view of IP litigation from behind the bench, and panels made up of in-house counsel and our own patent litigation authorities.

04.27.2017

### *Update on Intellectual Property Litigation at the U.S. International Trade Commission*

Moderator and Host: ITC Trial Lawyers Association Legal Seminar

John Marshall Law School / Chicago, IL

Legal seminar comparing IP litigation at the ITC and U.S. district courts; speakers include ITC Commissioner Kieff, ALJ McNamara, Customs & Border Protection officials, and in-house counsel from Amazon.com, SanDisk, Google, Technicolor, and Baxter Healthcare; April 2017.

04.2015

### *Patent Litigation Seminar in Beijing, China*

Patent Litigation Seminar sponsored by Tsinghua University School of Law; Beijing, China. Speakers include ITC Commissioner Johanson and U.S. Patent Office and Trade Officials discussing U.S. District Court and administrative proceedings before the U.S. International Trade Commission (ITC) and USPTO Patent Trial and Appeal Board (PTAB). The seminar was moderated by Di Zhang in both English and Chinese.

04.2015

***Patent Litigation Seminar in Shenzhen, China***

Patent Litigation Seminar Sponsored by the Shenzhen Patent Law Association; Shenzhen, China. Speakers include ITC Commissioner Johanson and U.S. Patent Office Officials discussing U.S. District Court and administrative proceedings before the U.S. International Trade Commission (ITC) and USPTO Patent Trial and Appeal Board. The seminar was moderated by Di Zhang in both English and Chinese.

10.23.2014

***ITC Officials Featured at Successful Palo Alto Office Event***

General Events

Silicon Valley Intellectual Property Law Association Seminar on ITC litigation procedure with ITC Commissioner Johanson and Margaret MacDonald, Director of the ITC's Office of Unfair Import Investigations

02.2007

***U.S. Patent Litigation***

Guest Professor

Tokai University School of Law / Tokyo, Japan

Assisted in teaching ITC procedure and practice portion of course.

02.2004

***Recent Developments in ITC Practice***

Panel Presentation

48th Annual Conference on Developments in Intellectual Property Law

John Marshall Law School Center for Intellectual Property Law / Chicago, IL

2004

***ITC Practice and Procedure***

Speaking Engagements

Spring Meeting

Center for International Legal Studies / Kitzbuhel, Austria

## **AREAS OF FOCUS**

### **PRACTICES**

- [Litigation](#)
- [Patent Litigation](#)
- [Intellectual Property Law](#)
- [ITC Litigation](#)
- [Taiwan Practice](#)

### **INDUSTRIES**

- [Semiconductor](#)
- [Communications](#)
- [Blockchain Technology & Digital Currency](#)
- [Biotechnology & Pharmaceutical](#)

## **BAR AND COURT ADMISSIONS**

- District of Columbia
- Illinois

- U.S. Court of Appeals for the Federal Circuit
- U.S. District Court for the Northern District of Illinois

## **EDUCATION**

- The John Marshall Law School, LL.M., 1991
- DePaul University College of Law, J.D., 1989
- Bradley University, B.S., M.E., 1986