



CHEN MALIN LLP

CHEN MALIN LLP is a boutique law firm founded on the belief that effective advocacy is never formulaic; that complex issues may be explained simply; and that clients deserve clear answers whenever they seek counsel.

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Introduction

FOUNDING PRINCIPLES

Our partners, Li Chen, Steve Malin, Dwayne Norton and Kristoffer Leftwich, see the practice of law as our calling; and the playbook approach to complex legal issues, a recipe for subpar results. We value integrity and collegiality. The lawyers at CHEN MALIN LLP see clients as our partners, and we prefer to be compensated based on the value that we bring rather than the traditional hourly model.

STRATEGIC INSIGHTS

We are leading negotiations on complex transactions for multiple Fortune 100 and Global Fortune 500 companies. For our clients, these contracts impact annual operating revenues in excess of \$100 billion. While these companies have access to and routinely work with AmLaw 100 firms, they entrust us with their high-value contracts because we have repeatedly secured key concessions on critical contracts. By way of example, one Fortune 50 company was so impressed with our results that it sought our counsel after negotiating against our lawyers.

Our success in transactions, in turn, is driven to a significant degree by our expertise in litigating and resolving complex business disputes. Because our lawyers are successful trial lawyers, we understand which terms matter in the event of a dispute. We make it our business to understand the business rationale that drives a particular transaction, and we ensure those objectives are protected in the legal documentation.

THE CHEN MALIN DIFFERENCE

We are currently leading negotiations to replace multiple IT systems responsible for generating approximately 12-figures in annual operating revenues; to address SAP's demands for indirect-access licensing fees in major ERP platforms; and to replace the IT backbone for a leading tollway authority—a system that processes every toll transaction on the tollways of several major U.S. cities. Our record in negotiating complex IT transactions have led multiple Fortune 100 and Global Fortune 500 companies to seek our counsel. In transactions and litigation, our lawyers have had success against teams from Kirkland, Orrick, Jones Day, Susman Godfrey, Cooley, and Wilson Sonsini, and in-house experts from Fortune 50 and major European electronics companies. Time after time, we secured favorable outcomes when convention expected otherwise.

We practice in the areas of COMPLEX IT TRANSACTIONS, INTELLECTUAL PROPERTY and TECHNOLOGY LICENSING, INTELLECTUAL PROPERTY LITIGATION, and COMMERCIAL LITIGATION.

Accolade Summary

Chambers USA has recognized every one of our founding partners as a leading intellectual property lawyer in Texas. *Best Lawyers in America*, *Benchmark Litigation*, *D Magazine*, *Super Lawyers*, *Martindale-Hubbell*, *Managing IP*, and *Legal 500* have similarly named our lawyers in their respective publications. These publications have variously noted our lawyers' practices in the areas of complex commercial litigation, IP litigation, and technology transactions. Our lawyers have been named Dallas's "**Patent Lawyer of the Year**" and shortlisted for the "**Outstanding IP Litigator Award**" (2016—TX). Indeed, in our first year of operation *U.S. News's Best Law Firms* recognized Chen Malin LLP as a **Tier 1 firm** in the areas of "**Litigation—Intellectual Property**," "**Litigation—Patent**," and "**Patent Law**," and *Managing IP* ranked the Firm alongside several international law firms.

Clients have said the following of our lawyers:

"one of the most effective and efficient counsel I have ever worked with"

"great understanding of business operation(s)"

"widely respected lead litigator and trial lawyer with strategic vision"

"strong trial lawyer ... admired for his ability to assimilate and simplify complex technological details in IP disputes of all kinds"

"persuasive to both judges and juries"



Practice Summary / Representative Matters

The lawyers at CHEN MALIN LLP practice in **COMPLEX INFORMATION TECHNOLOGY TRANSACTIONS**, in **INTELLECTUAL PROPERTY** and **TECHNOLOGY LICENSING**, and across the continental United States before both district courts and the International Trade Commission in the areas of **COMMERCIAL and INTELLECTUAL PROPERTY LITIGATION**. We eschew the playbook approach. Here are a few examples of our work.

COMPLEX IT TRANSACTIONS / IP & TECHNOLOGY LICENSING

- Lead counsel for clients in the metals, hardware, and automotive industries in multiple global enterprise resource planning (ERP) implementation transaction. In one transaction the concessions that our lawyer secured from the ERP implementer—one of the top 50 technology companies in the world—later led to multiple 8-figure concessions from the implementer without necessitating litigation. Indeed, after the execution of the master agreement the implementer later sought our advice on negotiation strategies.
- Advise multiple Fortune 100 and public-sector clients concerning attempts by major ERP vendors to assess additional license fees via allegations of non-compliance.
- Lead counsel for negotiating the replacement of software engine that transact over \$80 billion in annual revenues.
- Co-lead counsel to negotiate the replacement of an IT system that processes every toll transaction in several major U.S. cities. The Chen Malin team was brought-in by the client to supplement the advice of its standing law firm, which is ranked among the top 90 in AmLaw's 2014 Global 100 survey. The client has recently asked Chen Malin LLP to take the lead on several aspects of the master agreement, including budget, warranty, source code, IP ownership, and indemnity.
- Lead counsel for a Fortune 50 company to implement and refine the company's trade secret protection program.
- Lead counsel for an electronics company that faced royalty demands from a holder of patents that are essential to the implementation of MP3 technology. The patent holder has secured licenses from over 2 dozen international technology companies, including several

major U.S. electronics and software companies. But it has opted to stay proceedings against Chen Malin LLP's client while it litigates its claims against others.

- Lead counsel for a major U.S. electronics company that faced royalty demands from the holder of a standard essential portfolio (Innovatio). Innovatio is relying on the RAND rate set forth in a Northern District of Illinois opinion that found Innovatio's portfolio to be standard essential and highly valuable.
- Lead counsel for an overseas semiconductor company facing royalty demands from the holder of a standard essential portfolio (4G technology). The patent holder walked away without receiving any payment.
- When a U.S. semiconductor company discovered its customers were being targeted by the holder of a major standard essential patent portfolio (WiFi technology), it asked our lawyers to help lead and structure the negotiations.
- Lead counsel for semiconductor, electronics and financial clients in negotiations against operating companies such as Freescale, Nokia and Andrea Electronics, against non-practicing entities such as Innovatio, Washington Research Foundation, Vectis, Round Rock, Daniel Flamm, IPXI, and IPValue / Future Link Systems.
- Lead counsel in the investigation of trade secret misappropriation, conversion, and tortious interference by a former employee and related parties.
- Lead counsel for an electronics company in negotiating a high profile indemnity matter with its supplier.
- Lead IP counsel for publishing companies in asset transfer transactions.

LITIGATION (IP & COMMERCIAL LITIGATION)

We are one of a handful of legal teams in the country that have successfully taken a RAND case through jury verdict. Recently, our lawyers secured dismissals in N.D. Cal. and D. Colo. (without payment), and persuaded a well-known patent holder to walk away--even though their RAND portfolio has been blessed by a federal court. We have a decades-long record of crafting and executing creative strategies that help clients manage difficult cases and transactions, and, when the need arises, our clients turn to us to help them manage their outside law firms.

Over the past year we litigated in Washington D.C., the Eastern and Southern Districts of New York, the District of Colorado, the Northern District of California, the Western District of Virginia, the District of Massachusetts, and the Eastern, Northern, Southern, and Western Districts of Texas. Historically, our lawyers have also been called on to advance client interests in Pennsylvania, Delaware, Utah, Illinois, Missouri, Indiana, Michigan, and Idaho.

- Co-Lead trial counsel for Tellabs in *Fujitsu Ltd. v. Tellabs Operations, Inc.*, Civil Action No. 1:09-cv-04530 (N.D. Ill.). In this case of first impression our lawyers persuaded the jury that Fujitsu willfully breached its RAND obligations. Based on this finding the court issued a show-cause order to determine why Fujitsu's patent should not be declared unenforceable. The case settled on confidential terms prior to the hearing.
- Lead counsel for Realtek Semiconductor Corp. in *Commonwealth Scientific and Industrial Research Organisation v. MediaTek Inc.*, Civil Action No. 6:12-cv-578 (LED/RWS) (E.D. Tex.). By the time CSIRO targeted Realtek as a part of its campaign to monetize the '069 patent, CSIRO had successfully asserted the patent against numerous industry giants over 10 years of litigation. After taking a hard look at the record, our lawyers argued, over CSIRO's strenuous objections, that the Court should revisit and revise the construction of a claim term that had been stipulated by the industry for 10 years. The case settled on confidential terms after our proposed construction was adopted by the court.
- During a patent war between STMicroelectronics, Inc., and SanDisk Corp., our lawyers secured admissions that resulted in the court striking the opposing expert's report and, *sua sponte*, ordering a hearing to determine the propriety of further sanctions against the expert, the opposing party and opposing counsel. The case settled on confidential terms in advance of the hearing.
- Lead counsel for ASUSTeK in separate patent infringement matters before the Southern District of New York, the District of Colorado, the Northern District of California, and before the International Trade Commission. These matters have either been dismissed (without payment), or settled for a fraction of litigation fees.
- Our lawyers conceived, pursued, and developed Tellabs' trade secret misappropriation, tortious interference, unfair competition, and business disparagement claims against Fujitsu. The case settled on confidential terms.

- Lead trial counsel for minority shareholders in bringing a breach of fiduciary duty, shareholder oppression, and breach of contract suit against the majority shareholder of a closely-held corporation. After observing our lawyers present their case on the first day of trial, defendants agreed to pay a 150% premium to an offer they rejected just 2 weeks earlier in order to settle the case.
- Lead trial counsel for Respondent Realtek Semiconductor in Inv. No. 749(c). Unlike other respondents in the investigation, all of whom elected to argue the asserted patent was invalid, we focused Realtek's defense on non-infringement issues. In its final determination, the International Trade Commission found the asserted patent valid, but not infringed. The cornerstone of this finding was our lawyer's trial examination of the opposing expert, which persuaded the ITC that the contrary position urged by Complainant led to "absurd" results.
- Lead trial counsel for Respondents Realtek Semiconductor and ASUSTek in Inv. No. 949. In this multi-respondent investigation, computer giants such as HP, Dell, Lenovo, Toshiba, Acer and ASUSTek faced the prospect of having their laptops, tablets, motherboards, and smart phones barred from the U.S. market. Our lawyers led the development and implementation of defensive strategies in this Investigation, and our theories led the Commission to place the Investigation into the ITC pilot program. As a result of the pilot program, Complainant was forced to withdraw 2 of the 5 asserted patents. After the Markman hearing Complainant withdrew a third patent from the Investigation. Realtek has since settled its dispute with Complainant on confidential terms.
- Lead trial counsel for The British Museum after it was sued in a trademark action in Texas by an offshore "cybersquatter." Bringing counterclaims on behalf of the British Museum, our lawyers persuaded the Court that the museum was the truly wronged party. After a multi-day trial, which included the Frank Sinatra song Foggy Day, the cybersquatter restored the domain name at issue to the British Museum.

CREATIVE SETTLEMENT STRATEGIES

We routinely help clients resolve and settle difficult cases—on favorable terms—where other firms have failed. We are able to do so because we understand how of our opponents perceive risk, and we are adept at persuading those opponents that our proffered solutions is preferable to the alternative. In instances where our opponents refuse to behave reasonably, they are often persuaded to adjust course after reviewing our record.

- On behalf of clients such as ASUSTeK, Gateway, STMicroelectronics, and Tellabs (Coriant), we developed strategies that brought resource-draining litigations—some of which had been litigated for over 6 years—to conclusion on favorable terms. In each of these instances, our lawyers persuaded opponents to see their risks, which then paved the way for favorable resolutions. In multiple instances our clients recovered funds from these settlements, even though they were the defendants in these cases.
- When a major commodities supplier found itself embroiled in multiple 8-figure disputes with its IT vendor, it called on our lawyers to assist with the negotiations. After reviewing our pre-suit presentation, which included multiple counter-claims, the IT vendor, one of the largest in the world, relinquished its claims for 8-figures worth of unpaid fees.
- When Michigan Springs found its patent on the verge of being invalidated by its opponent, our lawyers persuaded the opposing party to transfer their patent portfolio to our client. The solution, which also involved an undisclosed payment from the defendant, allowed Michigan Springs to claim victory when its case had faltered.
- When Antor Media initiated a patent infringement suit against our client Macmillan, plaintiff had already amassed a war chest of over \$70 million (USD). Antor Media was represented by an aggressive law firm that demanded significant payment before it would relinquish its claims. But after our lawyers explained the risks that face Antor Media if we were to stay in the case, plaintiff reduced its demand by over 98%, and accepted a payment of \$20,000.

LITIGATION MANAGEMENT

Companies sometimes find themselves in the unenviable position of engaging several major law firms for a single case. In the absence of a lawyer who is willing or able to effectively manage the multiple legal teams, these companies can find themselves increasing their legal spend by several multiples, while at the same time reduce their likelihood for achieving success (because the legal teams are uncoordinated and unfocused). Our lawyers have years of experience managing cases involving multiple law firms. It is sometimes necessary to disengage certain firms from the pending matter to bring discipline and focus to the case. But as often as not the disparate legal teams just need guidance on how the responsibility for the case needs to be allocated. Here are a few examples:

- When a telecommunications client engaged 9 separate law firms for a single litigation in East Texas. We persuaded the client that the arrangement was counter-productive, and helped bring order to chaos.
- When legal teams refused to take either direction from our client or responsibility for their actions/inaction, we were brought-in to assess the situation and implement corrective actions.

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