



# 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 founding partners, Li Chen and Steve Malin, practiced together for over a decade at a large international law firm, where they served in senior positions, and where prior to his departure Li was the Group Head of the Dallas Office IP Litigation and Licensing Group. We see the practice of law as our calling, and we formed CHEN MALIN LLP to give our team the opportunity to partner with clients—without the constraints of ever-increasing hourly rates. Clients that are open to alternate fee arrangements have come to learn that we prefer compensation based on the value we bring to the client, rather than fixed hourly rates.

### STRATEGIC INSIGHTS

We are not defensive when representing defendants; and we advance credible, rather than remarkable, claims when advising injured clients. Our litigators equal transactional lawyers in understanding a client's business needs; and we know how deal terms impact downstream disputes when negotiating transactions. Our approach to transactions have prompted Fortune 50 companies to seek our counsel after observing our lawyers in action—from across the table.

### THE CHEN MALIN DIFFERENCE

Our team is led by litigators that have successfully first chaired multiple jury, bench, and ITC trials. We have prevailed against teams from Kirkland and Orrick at trials, and against Susman Godfrey, Cooley, Wilson Sonsini, and Jones Day in litigation. Time after time, we secured victory when conventional wisdom expected defeat.

### OUR EXPERTISE

We practice in the areas of INTELLECTUAL PROPERTY LITIGATION, COMMERCIAL LITIGATION, and COMPLEX TRANSACTIONS. We approach cases differently, and we welcome comparisons of our record against AmLaw 100 firms.

## 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 across the continental United States, before both district courts and the International Trade Commission, in the areas of **COMMERCIAL and INTELLECTUAL PROPERTY LITIGATION, and COMPLEX TRANSACTIONS**. We eschew the playbook approach, whether in litigation or transactions. Our arguments are guided by the facts, and we have a record of trial successes in major disputes (IP and commercial), with AmLaw 100 firms or nationally known trial boutiques acting as opposing counsel. In both litigation and transactions, we have secured results that conventional wisdom thought was unachievable.

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, and the Eastern, Northern, Southern, and Western Districts of Texas. Historically, our lawyers have been called on to advance client interests also in Pennsylvania, Delaware, Utah, Illinois, Missouri, Indiana, Michigan, and Idaho. Here are a few examples of our work.

### 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.

- 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 (contractual) 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.

## EXPERIENCE IN NORTHERN DISTRICT OF TEXAS

- Our lawyers (including one who co-chaired the task force) served on the task force that promulgated the Local Patent Rules that were adopted by the Northern District of Texas; and we were among the founding members of the Barbara M. G. Lynn American Inn of Court (the only IP Inn of Court in the Northern District of Texas), and participated as Master and Barrister members.
- Lead trial counsel for The British Museum (see above).
- 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.
- Trial counsel for Research In Motion Corp. / BlackBerry in *Innovative Sonic Ltd. v. Research In Motion Ltd.*, Civil Action No. 6:10-CV-455 (N.D. Tex.). Our lawyers conceived and developed the litigation strategy that impressed our adversary. Plaintiff Innovative Sonic had estimated its claims could be asserted against the entire smart phone industry and that those claims were ultimately worth 10-figures. But after the litigation against Research In Motion / BlackBerry, Plaintiff discontinued its assertion efforts.
- Local counsel for Wal-Mart Stores, Inc. in *Icon Laser Solutions LLC v. Wal-Mart Stores, Inc.*, Civil Action No. 3:15-CV-03724 (N.D. Tex.); and for Macy’s in *Icon Laser Solutions LLC v. Macy’s Inc.*, Civil Action No. 3:15-CV-03716 (N.D. Tex.).
- Counsel for Jericho Systems Corp. in *Jericho Systems Corp. v. Axiomatics AB*, Civil Action No. 3:14-CV-02281 (N.D. Tex.)
- Counsel for Research In Motion Corp. in *Hunts Point Ventures, Inc. v. Research In Motion Corp.*, Civil Action No. 3:13-CV-00642 (N.D. Tex.).

- Counsel for First Data Corp. in *DataTreasury Corp. v. First Data Corp.*, Civil Action No. 3:02-CV-2429 (N.D. Tex.).

## 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.

## TRANSACTIONS / INVESTIGATIONS

- Companies routinely enter into non-disclosure agreements that sunset the confidentiality obligations after a preset period of time. Multiple courts, however, have held that the practice waives the company's trade secret rights. Conventional advice to this longstanding problem is to avoid sunset provisions altogether. Because that advice is impractical, we have developed solutions designed to minimize a company's risks of waiver without interfering with its ability to conduct business. Our practical advice recently led a Fortune 50 company seek our counsel to help them implement and refine the company's trade secret protection program.
- Lead counsel for a major U.S. electronics company facing royalty demands from the holder of a standard essential portfolio (Innovatio). In particular, in a widely publicized written opinion a federal judge found Innovatio's portfolio to be standard essential, determined it to be highly valuable, and set a RAND rate for the patents. After reviewing our analysis, the patent holder abandoned its claims against the client.
- 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 payments.

- 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 Li 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.
- Lead counsel for clients in the metals, hardware, and automotive industries in multiple global enterprise resource planning (ERP) implementation 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, the implementer later sought the advice of our lawyers on licensing negotiation strategies.

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