



Tom Chen

Partner

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PRACTICES Intellectual Property, Patents, Patent Prosecution and Counseling, Patent Litigation, Intellectual Property Litigation, Technology, Internet, Networking, Software, International Trade Commission Section 337 Proceedings, Sports Law

Tom Chen is a member of the firm's Executive Committee and an experienced patent attorney who prides himself in providing a client-first approach to representation. He is dedicated to understanding his clients' business goals, strategies, and priorities. Clients value Tom for his technical knowledge and insight regarding their specific patent issues.

Under Tom's guidance, the firm manages patent matters for start-ups to Fortune 100 companies. Key objectives of Tom's practice include, but are not limited to the following:

- Identify competitors, examine/maximize patent portfolios, and target filings toward possible improvements of current or new products/services that may better suit a claim or counterclaim against parties which might generate revenue and/or help settle a matter with minimal financial spend.
- Collaborate with inventors to consider new approaches, such as more "blue sky" enhancements and/or strategies regarding potential industry direction.
- Evaluate patent application invention factors from client, industry, domestic, and international perspectives.
- Provide recommendations throughout patent prosecution application process to determine appropriate strategies.

Tom's experience is founded on multiple advanced degrees in electrical engineering and significant related work at Hughes Aircraft, covering a variety of technologies, including e-commerce, mobile payments, electrical circuits, semiconductor memories/processing, semiconductor equipment, fiber optic and wireless communications, televisions, mechanical devices, Internet-related applications, microprocessors, and other computer architecture. Tom's experience extends to patent litigation as well, including matters before the International Trade Commission and district courts. He has also been involved in all phases of litigation, including discovery, depositions, expert reports, and briefs.

Aside from being a skilled and insightful intellectual property attorney and member of the firm's leadership team, Tom is co-chair of Haynes Boone's Attorney Diversity and Inclusion Committee, which focuses on advancing the hiring, retention, and promotion of diverse lawyers within the firm. Tom promotes the importance of a diverse law firm and strives to make Haynes Boone a leader in the

diversity space. He is also a member of the National Asian Pacific American Bar Association where he attends events and contributes to meaningful initiatives.

In addition to being recognized for his accomplishments in patent law and DEI, Tom has presented alongside key decision makers from client companies, which has helped him bolster his deep understanding of their core values. Additionally, he has written on various intellectual property and risk management issues, Supreme Court patent decisions, and cases before the United States Patent and Trademark Office.

QUALIFICATIONS

EDUCATION

- J.D., Pepperdine University School of Law, 1996, *cum laude*; Editor, *Pepperdine Law Review*
- Electrical Engineer, Engineer Degree, University of Southern California, 1993, Hughes Engineer's Degree Fellowship
- M.S., Electrical Engineering, California State University Northridge, 1989
- B.S., Physics, University of California Los Angeles, 1985

ADMISSIONS

- California
 - U.S. Patent and Trademark Office
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PUBLICATIONS AND SPEAKING ENGAGEMENTS

- “Generating New Clients - Part 2: Building Your Personal Brand - Reputation, Word of Mouth, & Referral Work,” panelist, The Diverse Rainmaker Summit: Excellence in Business Development, virtual, November 29, 2023.
 - “The Secrets Behind Setting Compensation in Law Firms,” panelist, NAPABA Convention, Las Vegas, NV, November 4, 2022.
 - “Tech-Backed Businesses Transforming Legal Processes: A GC Discussion from Top North American Corporations,” panelist, World Services Group webinar, virtual, October 7, 2021.
 - “The Business Case for Diversity: Diversity and Inclusion in Big Law,” panelist, Loyola University of Chicago School of Law, Chicago, IL, September 28, 2021.
 - “What Strategies are Proving Most Effective at Leveling the Playing Field?,” panelist, AT&T and IILP’s Deconstructing Systemic Racial Bias in the Legal Profession virtual program, January 12, 2021.
 - “Drafting and Prosecution Under Current Section 101 Guidance: Technology,” presenter, 14th Annual Advanced Patent Law Institute, Alexandria, VA, March 21, 2019.
 - “Recent USPTO Guidance on 35 U.S.C. § 101,” speaker, AT&T Legal Summit for AT&T in house lawyers and outside counsel, Middletown, NJ, September 13, 2018.
 - “The Hybrid In-House/Outside Counsel Patent Prosecution Model – What Works,” speaker, 4th Annual IP Strategy Summit, Orange County, CA, March 6, 2018.
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PROFESSIONAL AFFILIATIONS AND ENGAGEMENTS

- Advisory Board of the Institute for Inclusion in the Legal Profession (IILP)

- Asian Law Alliance Advisory Board
 - State Bar of California, Intellectual Property Law Section
 - Orange County Bar Association
 - National Asian Pacific American Bar Association
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SELECTED CLIENT REPRESENTATIONS

- *In re Certain GPS Chips, Associated Software and Systems, and Products Containing Same (337-TA-596)*: Represented complainant SiRF Technology, Inc. in a patent infringement matter before the ITC involving global positioning system (GPS) technology.
 - *In re Field Programmable Gate Arrays (337-TA-441)*: Represented complainant Xilinx, Inc. in a patent infringement case involving field programmable gate arrays (FPGAs).
 - *SiRF Technology v. u-Nav Microelectronics Corporation (USDC ND Cal)*: Represented SiRF Technology in a patent infringement case involving global positioning system (GPS) technology.
 - *UPI Semiconductor Corporation v. Richtek Technology Corporation (CA State and USDC ND Cal)*: Represented UPI Semiconductor in a patent infringement case involving power management integrated circuits.
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AWARDS AND RECOGNITIONS

- Recognized as "The Lawyer of the Year" in Patent Law in Orange County by *The Best Lawyers America*, Woodward/White, Inc., 2024
- Recognized in *The Best Lawyers in America*, Woodward/White, Inc., 2023-2025
- Recognized as a Recommended Lawyer, Patents: Prosecution, *Legal 500*, Legalease Ltd., 2023
- Asian Leadership Award, *Profiles in Diversity Journal*, 2023
- Recognized as a Top Lawyer in Patent Prosecution, Litigation, and Transactions in the *Intellectual Asset Management (IAM) Patent 1000* legal directory (2018-2024)
- Recognized in *Managing Intellectual Property Magazine*, Euromoney Institutional Investor PLC, as an IP Star (2019-2024)
- Recognized as "Notable Practitioner," *Chambers USA*, Chambers and Partners, 2022
- Recognized as a Global Diversity Champion, *World Intellectual Property Review's Diversity Report*, 2022
- Recognized as a "Law Firm Leaders: Nation's Best," *Lawyers of Color*, 2022, 2019
- Selected by the *Daily Journal*, Daily Journal Corporation, as one of the 2016 Top 100 Lawyers in California