



David L. McCombs

Partner

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PRACTICES Intellectual Property, Intellectual Property Litigation, International, Asia, Patent Prosecution and Counseling, Patents, Patent Litigation, Patent Office Trials, U.S. Inbound Investment, Social Media, Technology Transactions, Technology

David McCombs is primary counsel for many leading corporations in *inter partes* review (IPR) and is regularly identified as one of the most active attorneys appearing before the Patent Trial and Appeal Board (PTAB). His clients benefit from his 35 years of practice, which include appellate argument, patent litigation, and portfolio development.

Nationally ranked, David is recognized for having a “strong Federal Circuit patent litigation practice and prominent PTAB expertise” (*Chambers Global*, 2019, Chambers and Partners). *Chambers Global* 2020, Chambers and Partners, describes him as “one of the best, not just of patent practitioners but practitioners generally” and “extremely organized, responsive, thoughtful and calm.”

David’s clients appreciate that he is an “ultra-organized, extremely responsive and sophisticated counselor who is a true pleasure to partner with” and a “zealous but very professional advocate” (*IAM Patent 1000*, 2020, Law Business Research). David has also been cited as “a leading practitioner when it comes to the thoughtful and strategic analysis of patents in the marketplace and critical opinion work” (*IAM Patent 1000*, 2019, Law Business Research). He is AV® Peer Review Rated Preeminent by *Martindale-Hubbell® Law Directory*.

David’s work for clients is enhanced by his experience as in-house patent counsel prior to joining the firm in 1989. He worked for a diversified technology company with a long history of developing breakthrough chemical/material science, diagnostic, robotics, and motion management technologies.

David is an active educator, writer, and speaker on topics related to patent law and intellectual property litigation. He is the co-author of “Intellectual Property Law,” published annually by Southern Methodist University’s (SMU’s) renowned *SMU Law Review* (2010-present) and is an adjunct professor at SMU’s Dedman School of Law. He also serves on the conference planning committees and faculty for the Annual Silicon Valley Advanced Patent Law Institute (2001-present), and the Advanced Patent Law Institute at the U.S. Patent and Trademark Office (2006-present).

QUALIFICATIONS

EDUCATION

HAYNES BOONE

- J.D., University of Miami, 1984
- B.S., Physics, Denison University, 1981

ADMISSIONS

- Texas
- U.S. Patent and Trademark Office

COURT ADMISSIONS

- U.S. Court of Appeals for the Federal Circuit
 - U.S. Court of Appeals for the Fifth Circuit
 - U.S. District Court for the Eastern District of Texas
 - U.S. District Court for the Northern District of Texas
 - U.S. District Court for the Western District of Texas
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PUBLICATIONS AND SPEAKING ENGAGEMENTS

- "Fed. Circ. Holding Recalls the Potential for PTAB Challenges," co-author, *Law360*, April 8, 2022.
- "IPR Tricks of the Trade: Federal Circuit clarifies scope of IPR estoppel," co-author, *Reuters*, March 24, 2022.
- "Fed. Circ. Gives 7 Patent Appeals Quick Closure," quoted, *Law360*, March 15, 2022.
- "Forum Selection Clauses May Bar an IPR," co-author, *IPWatchdog*, March 10, 2022.
- "After West Texas Ruling, Patenting AI Could be More Nuanced," co-author, *Law360*, February 25, 2022.
- "IPR Tricks of the Trade: Federal Circuit limits use of applicant admitted prior art," co-author, *Reuters*, February 10, 2022.
- "IPR Tricks of the Trade: Discretionary Institution When There is Parallel ITC Investigation," co-author, *Reuters*, January 11, 2022.
- "Federal Circuit Rejects Constitutional Challenge to PTAB's Structure," co-author, *The Patent Law*, 52-54 (Nov-Dec. 2021).
- "IPR Tricks of the Trade: The Tough Task of 'Swearing Behind' an Asserted Prior Art Reference," co-author, *Reuters*, November 26, 2021.
- "Where We Are on AI Invention and Where We Should be Heading," co-author, *IPWatchdog*, October 12, 2021.
- "IPR Tricks of the Trade: Contractual Obligations v. PTAB Trial Practice," co-author, *Reuters*, October 7, 2021.
- "The USPTO's New Director Review Procedure Post-Arthrex," co-author, *ABA Landslide Magazine*, September/October 2021.
- "Under Discretion," co-author, *Intellectual Property Magazine* 52-53, September 2021.
- "IPR Tricks of the Trade: Use of Stipulations to Overcome a *Fintiv* Challenge in Patent Litigation," co-author, *Reuters*, August 2021.
- "Considering Short- And Long-Term Effects Of COVID IP Waiver," co-author, *Law360*, August 11, 2021.
- "Understanding Law Firm Resources," co-author, *Bloomberg Law*, August 2021.
- "IPR Tricks of the Trade: Director Review of Patent Decisions After 'Arthrex,'" co-author, *Reuters*, July 16, 2021.
- "IPR Tricks of the Trade: Not all Appeals From Patent Board are Made Equal," co-author, *Westlaw Today*, June 15, 2021.
- "Discretionary Institution," co-author, *Intellectual Property Magazine*, June 1, 2021.
- "The U.S. Patent Office's guidance on indefiniteness in AIA post-grant proceedings," co-author, *The Patent Lawyer*, June 2021.

- "Why the USPTO Does not Receive Chevron Deference," co-author, *The Patent Lawyer* 20-22, May-June 2021.
- "Changes at the USPTO Under Former Director Andrei Iancu: A Retrospective," co-author, *Westlaw Today*, May 24, 2021.
- "Analysing 'Takings Clause' challenges to PTAB reviews," co-author, *World IP Review*, May 4, 2021.
- "Drawing the Line: Appealability of Issues in PTAB Institution Decisions," co-author, *IP & Technology Law Journal*, Vol. 33 No. 5, May 2021.
- "On Second Thoughts," co-author, *IP Magazine*, April 2021.
- "Law Firms are Looking for Tech-Savvy Lawyers: What That Means to Law Students," co-author, *Legaltech News*, March 31, 2021.
- "COVID Testing and Patentability," co-author, *Bloomberg Law*, March 8, 2021.
- "Evolving Contours of IPR Joinder," co-author, *Intellectual Property Magazine*, February 25, 2021.
- "Obviousness by Resort to Common Sense," co-author, *Intellectual Property & Technology Law Journal*, Volume 32, No. 10, Nov.-Dec. 2020.
- "Ringling the Changes," co-author, *Intell. Prop. Mag.* 41-43 (October 2020).
- "Judge or jury?," co-author, *Intell. Prop. Mag.* 41-43, (October 2020).
- "Good for the Gander: Patent Owners Face IPR Estoppel, Too," co-author, *The Patent Law.* 8-10, Sep.-Oct. 2020.
- "It's OK to (Silently) Disagree With Proposed Claim Constructions in an IPR," co-author, *Westlaw Today*, September 24, 2020.
- "PTAB 2020: Adjusting to Win," co-author, Advanced Patent Trial and Appeal Board (PTAB) Trial Strategies 2020, September 2020.
- "Advanced Patent Trial and Appeal Board (PTAB) Trial Strategies 2020," speaker, Practising Law Institute, September 8, 2020.
- "PTAB May Raise a New Ground of Unpatentability Only Under 'Rare Circumstances'" (analysis of the POP's *Hunting Titan, Inc. v. DynaEnergetics Europe GmbH* decision), *The Patent Law.* 46-48 (July-Aug. 2020).
- "AI Invents But Can't Be an Inventor. So Now What?," co-author, *LegalTech News*, August 31, 2020.
- "Brave New World: How AI Tools Are Used in the Legal Sector," co-author, *LegalTech News*, August 12, 2020.
- "The Ethics Of Using Chatbots For Legal Services," co-author, *Law360*, August 3, 2020.
- "Navigating A New Realm: AI and Patent Law," co-author, *LegalTech News*, July 16, 2020.
- "Know Your Limits," co-author, *Intell. Prop. Mag.* 54-56 (June 2020).
- "Join the Party (analysis of the Federal Circuit's *Facebook, Inc. v. Windy City Innovations* decision)," co-author, *Intell. Prop. Mag.* 56-57 (May 2020).
- "PTAB Discretionary Institution and Parallel Petitions," co-author, *The Patent Law.* 30-32 (Mar.-Apr. 2020).
- "Collateral Estoppel Split," co-author, *Intell. Prop. Mag.* 52-53, April 2020.
- "Juries in FRAND Setting (analysis of how FRAND rate findings will be handled following the Federal Circuit's *TCL Commc'n Tech. Holdings Ltd. v. Telefonaktiebolaget LM Ericsson* decision)," co-author, *Intell. Prop. Mag.* 53-54, Mar. 2020.
- "The Evolution of IPR Estoppel After SAS," co-author, *The Patent Law.* 18-20, Jan-Feb. 2020.
- "Litigation Strategies for Post-Grant Proceedings," speaker, ABA Section of Intellectual Property Law's 2019 IP WEST CLE Institute, San Antonio, TX, October 3, 2019.
- "PTAB Launch: The Preliminary Proceeding - New Tactics, Evolving Risks and Trial Institution," speaker, PLI's USPTO Post-Grant Patent Trials 2019: New Challenges & Tactics, New York, NY, September 11, 2019.
- "2019 PTAB Update," speaker, Rocky Mountain Intellectual Property & Technology Law Institute, Westminster, CO, May 30, 2019.

- "PTAB Master Class," moderator, PTAB Bar Association Annual Conference, Washington, D.C., March 13, 2019.
- "The (De)Stabilizing Effect of Administrative Adjudication," speaker, 18th Annual Texas Intellectual Property Law Journal Symposium, University of Texas School of Law, Austin, TX, February 22, 2019.
- "PTAB: 'All Things' PTAB," panelist, Bench & Bar Conference, Coronado, CA, June 23, 2018.
- "PTAB Launch: The Preliminary Proceeding – New Tactics, Evolving Estoppel Risks and Trial Institution," speaker, PLI's USPTO Post-Grant Patent Trials 2018: Change & Recalibration Seminar, San Francisco, CA, May 15, 2018.
- "Advanced IPR Topics Panel with Q&A," panelist, Chicago Regional IPR Seminar, Chicago, December 7, 2017.
- "Patent Policy – The Future of Patent Litigation and the PTAB," moderator, Corporate Intellectual Property Strategy Conference, Santa Clara, CA, November 16, 2017.
- "IPR: A real Threat or Just Fake News?" panelist, Eastern District of Texas 2017 Bench Bar Conference, Plano, TX, October 4-6, 2017.
- "Concurrent Proceedings before PTAB and District Courts," moderator, UT-USPTO 12th Annual Advanced Patent Law Institute, Alexandria, VA, March 9-10, 2017.
- "Complex Issues in PTAB Practice," speaker, PTAB Bar Association Inaugural Conference, Washington, D.C., March 1-3, 2017.
- "Preparing an IPR Petition and a Preliminary Order Response," panelist, Texas Bar 30th Annual Advanced Intellectual Property Law Course, Austin, TX, February 23- 24, 2017.
- "Interview with the USPTO Texas Regional Director," moderator, UT Advanced Patent Law Institute, November 3-4, 2016.
- "*Inter Partes* Review and Post-Grant Review – The Interplay of PTAB and District Court Litigation," PLI, 10th Annual Patent Law Institute, New York, NY, April 14-15, 2016 and San Francisco, CA, May 5-6, 2016.
- "[In-House Perspectives on Patent Office Trials: Lessons from 2015](#)," USPTO Post-Grant Patent Trials 2016, PLI, New York, New York, March 14, 2016.
- "The Evolving PTAB and Best Practices," 11th Annual Advanced Patent Law Institute, United States Patent and Trademark Office, Alexandria, Virginia, March 11, 2016
- "Strategies for Appealing Cases to the PTAB and TTAB," PTAB/TTAB Stadium Tour, Dedman School of Law, Dallas, TX, February 24, 2016.
- "Patent Trial and Appeal Board Mock Trial," Co-Presenter, 29th Annual Advanced Intellectual Property Law, Texas State Bar, San Antonio, TX, February 18-19, 2016.
- "[Inter Partes Review in Patent Disputes](#)," *Corporate Disputes Magazine*, July-September, 2014.
- "Interplay of PTO Review and District Court Litigation," Doug Cawley and David McCombs, 10th Annual Advanced Patent Litigation Course, Texas Bar CLE, San Antonio, Texas, July 17, 2014.
- "The PTAB Petition, Pre-Trial Phase, and Trial Institution," Co-Presenter, USPTO Post-Grant Patent Trials 2014, Practising Law Institute, New York, NY, March 27, 2014.
- "Lessons Learned for the Post-Issuance Proceedings," Co-Presenter, 27th Annual Advanced Intellectual Property Law Course, Texas State Bar, Dallas, TX, March 19, 2014.
- "Federal Circuit Appeals From the PTAB: A New Game or Just the Same Old Practice," *Journal of the Patent & Trademark Office Society*, November 22, 2013.
- "Critical Issues Still Facing Patent Law," Advanced Practice under the America Invents Act, Institute for Law and Technology, Center for American and International Law, Dallas, Texas, April 12, 2013.
- "Ethics in the Post-AIA World," 15th Annual Richard C. Sughrue Symposium on Intellectual Property Law and Policy, The University of Akron School of Law, Akron, Ohio, March 4, 2013.
- "Federal Circuit Appeals From the PTAB: A New Game or Just the Same Old Practice?" co-author, Haynes and Boone White Paper, February 1, 2013.
- "Litigation Strategies After AIA," 2013 Annual Advanced Patent Law Institute, The United States Patent and Trademark Office, George Mason University School of Law, and The University of Texas

School of Law, Alexandria, Virginia, January 24, 2013.

- "Trial Practice in Contested Proceedings before the Patent Trial and Appeal Board," 50th Anniversary Conference on Intellectual Property Law, The Center for American and International Law, Plano, Texas, November 12, 2012.
- "Ethics-Related Implications of the America Invents Act," Intellectual Property Owner's IP Chat Channel, October 23, 2012.
- "Risk Management and Intellectual Property," 2012 Symposium on Global Markets – Managing Risks and Potential Liabilities in Uncertain Times: The Duties and Responsibilities of the International Lawyer, The Center for American and International Law, Plano, Texas, June 19, 2012.
- "Thinking Strategically About *Inter Partes* Review," 13th Annual Silicon Valley Advanced Patent Law Institute, The Stanford Program in Law, Science, & Technology, the Berkeley Center for Law & Technology at Boalt Hall, and the University of Texas School of Law, San Jose, California, December 6, 2012.
- "The Corporate Response to New Legislation: Changes in Portfolio Development and Patent Defense Strategies," 2012 Annual Advanced Patent Law Institute, The United States Patent and Trademark Office, George Mason University School of Law, and The University of Texas School of Law, Alexandria, Virginia, January 19, 2012.
- "The New Calculus for Challenging Patents Under the America Invents Act," 23rd Annual All Hands Meeting, Silicon Valley Association of General Counsel, Santa Clara, California, December 7, 2011.
- "Alternative Dispute Resolution in Patent Cases," State Bar of Texas Advanced Patent Litigation Course, San Antonio, Texas, July 2010.
- "Inter Partes Reexamination," 4th Annual Patent Law Institute, Practising Law Institute, San Francisco, California, March 22, 2010.

PROFESSIONAL AFFILIATIONS AND ENGAGEMENTS

- Executive Board Member, Southern Methodist University, Simmons School of Education and Human Development (2020 – Present)
- Texas Bar Foundation, Fellow
- American Bar Association
- State Bar of Texas, Intellectual Property Law Section, Chair, 2005-2006
- Dallas Bar Association, Intellectual Property Section, Chair, 2003
- National Portrait Gallery of the Smithsonian Institute, Commissioner, 2017-present
- Dallas-Fort Worth Intellectual Property Law Association, President, 1994
- Institute for Law and Technology of the Center for American and International Law, Chair, 2007-2008
- Institute of Electrical and Electronic Engineers
- Licensing Executives Society
- Board of Trustees, St. Philips School and Community Center, 2012-2018
- Advisory Board Member, Metroplex Technology Business Counsel, Richardson Chamber of Commerce, 2005-present
- Executive Board Member, Richardson Symphony Orchestra, 2007-2012

SELECTED CLIENT REPRESENTATIONS

- Lead counsel in numerous *inter partes* reviews before the U.S. Patent & Trademark Office's Patent Trial and Appeal Board

- World's largest dedicated semiconductor foundry - representations in federal and state court proceedings, transactions, and patent procurement related to semiconductor devices and processing technologies
- Leading U.S. silicon innovation manufacturer - multiple *inter partes* patent reexaminations involving concurrent litigation
- Leading U.S. open source software developer - numerous representations in patent disputes, transactions, portfolio development, patent procurement, and reform policy
- Telephone equipment manufacturer - defense of patent infringement action involving SS7 network for mobile phones
- Global oil field service company - numerous representations in patent and trade secret disputes and licensing transactions
- Telecommunications service provider - enforcement of patents covering the electronic processing of call detail records against major long distance providers, several RBOCs, and other service providers
- Leading medical device company - representations in defense of actions for patent infringement and misappropriation of trade secrets; patent prosecution; and patent licensing
- Counsel to Department of Justice in the matter of Summit Technology, Inc. and VISX, Inc. involving dissolution of patent pooling arrangement for patents on LASIK eye surgery
- Neutral Arbitration of dispute between major airline and information technology service provider
- Mediator in patent litigation between oil field tool manufacturers

AWARDS AND RECOGNITION

- Recognized in *IAM Global Leaders*, Globe Business Media Group, 2022
- Recognized as a 2021 Technology "Lawyer of the Year" by *The Best Lawyers in America*, Woodward/White, Inc.
- Recognized by *The Best Lawyers in America*, Woodward/White, Inc., in Litigation - Intellectual Property Law, 2005-2022; Patent Law, 2019-2022; Litigation - Patent, and Technology Law, 2009-2022
- Recognized among "Top 50 Most Active Attorneys overall representing Petitioners or Patent Owners" (15th overall); "Top 100 Most Active Attorneys representing Petitioners" (7th overall); and "Top 100 Best Performing Attorneys representing Petitioners or Patent Owners" (59th overall) in *Patexia's* 2019 IPR Intelligence Report.
- Recognized as a "Lawyer of the Year" by *Best Lawyers*, Woodward/White, Inc., in Litigation - Intellectual Property, 2015; Litigation - Patent, 2016; Technology Law, 2017-2018
- Named a leading intellectual property lawyer for Texas in *Chambers USA*, Chambers and Partners, 2003-2021
- Recognized by *Chambers Global* (Chambers and Partners) for Patent Law, 2018-2022
- Honored in *Intellectual Asset Magazine (IAM) Patent 1000*, Globe Business Media Group, 2014, 2016 and 2018-2021
- Named as one of the Best Lawyers in Dallas by *D Magazine*, D Magazine Partners, 2002-2012, 2015-2018 and 2020-2022
- Recognized by *Texas Super Lawyers*, Thomson Reuters, Intellectual Property, 2003-2021
- Recognized in *Managing Intellectual Property Magazine*, Euromoney Institutional Investor PLC, as a "Highly Recommended" IP Star, 2013, 2015 and 2019-2022
- Docket Navigator's Year in Review listed David as one of the top ten "Attorneys in the PTAB," 2018
- Selected as Best Lawyers' 2013 Dallas Intellectual Property Lawyer of the Year and Dallas Technology Law Lawyer of the Year, Woodward/White, Inc., 2013