



DAVID W. O'BRIEN

Partner

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PRACTICES: Intellectual Property, Patents, Patent Office Trials, Patent Prosecution and Counseling, Technology Transactions; **INDUSTRIES:** Technology, Medical Device and Technology, Autonomous Transportation, Vehicle Electrification, Streaming Media

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EDUCATION AND CLERKSHIPS

- J.D., University of Texas School of Law, 1995, *with honors*
- M.S.E., Electrical and Computer Engineering, University of Texas at Austin, 1987
- B.S.E.E., Electrical Engineering, Cornell University, 1986

ADMISSIONS

- Texas
- U.S. Patent and Trademark Office

David O'Brien leads the firm's Patent Office Trials Practice Group and focuses on *Inter Partes* Review (IPR) and Covered Business Method (CBM) review before the Patent Trial and Appeal Board (PTAB). He has more than 20 years of experience in software, semiconductor, microprocessor architecture, information security and protocol related technologies.

David handles all phases of IPR and CBM proceedings, from development of the grounds of challenge to petition drafting, briefing, trial, oral argument and appeal strategy. He is an experienced lead counsel in petitioner-side and patent owner-side representations alike. To date, David has served as lead counsel in nearly 30 contested PTAB proceedings.

In addition to his PTAB trial practice, David prepares and prosecutes high-value patent applications. He provides clients with focused offensive and defensive analyses of intellectual property positions, including opinions, assertion analyses and acquisition due diligence. Over the years, David has provided strategic counsel to a variety of multi-national corporations and emerging companies in the context of major eCommerce, network security, content delivery, microprocessor and semiconductor patent assertions. He renders defensive non-infringement and/or invalidity opinions when appropriate. David also prepares agreements and advises clients in technology transactions and licensing matters.

David's representation of technology clients builds on substantial prior-career experience including R&D for DARPA and other clients, in areas of multiprocessor architecture; software and algorithms for parallel and distributed computing; semiconductor devices, fabrication and materials; internetworking protocols; process control; opto-electronics and lasers, and computer vision/imaging systems. David's patent legal representations span computer several generations of computer hardware and software technologies including superscalar, multicore and massively parallel processors, various programming languages and code development environments, operating system internals, memory and storage hierarchies, internetworking standards and RFCs, cryptosecurity, INFOSEC and malware, virtualization, compilers, debuggers and execution tracing, eCommerce, geolocation and mobility.

David is published and lectures on patent law and protection of computer software. Recent topics include IPR and CBM strategies, section 101 law, litigating divided infringement claims, including issues of transnational and joint liability for infringements, claim

construction, and continuing application strategy.

Professional Recognition

- Recognized as a leading patent litigator by *Intellectual Asset Management (IAM) Patent 1000*, Globe Business Media Group, 2019 and 2020

Selected Client Representations

- Successfully challenged patents (for petitioners in IPR) asserted against major technology companies concerning cloud/hosting services, multimedia/MPEG-oriented microprocessors, computer-aided software engineering/design (CASE/CASD) environments, and geographic information system (GIS) and mapping systems.
- Successfully defended (for patent owners in IPR and CBM) patented DOCSIS 3 modem/channel bonding, voice over internet protocol (VOIP), telecom system provisioning, and product/service configuration and eCommerce technologies.
- Prepared *amicus* briefing to the Supreme Court of the United States (SCOTUS) relative to international exhaustion questions presented in *Impression Products v. Lexmark International*.
- Manages and develops portfolios; prepares and prosecutes high-value patents for major semiconductor, microprocessor, software, and network security clients; manages and directs other attorneys in furtherance of client engagements.
- Successfully identified targets and developed infringement proofs for client patent assertion program generating \$3 million to \$5 million annual licensing revenue.
- Counsels clients regarding portfolio coverage, filing and prosecution strategy, appeals, reexamination/reissue and licensing value; prepares and negotiates licenses (in and out); conducts/contributes to due diligence investigations.
- Advised major telecommunications client regarding claim constructions, post-verdict proceedings and appeal relative to district court and ITC actions in major third party patent dispute involving communications semiconductors.
- Provided general litigation counsel with targeted and effective patent-related legal advice that resulted in business-ending injunction for opposing party and repatriation of misappropriated intellectual property; prepared dispositive motions for related actions in state and federal court.
- Developed non-infringement and invalidity positions relative to counterclaims in client patent assertion; contributed to resolution of matter with a \$5 million settlement for client.
- Developed patent portfolio and essential patents strategy for software modem startup client successfully acquired by major semiconductor company for \$170 million.
- Advised major microprocessor company regarding scope of coverages relative to third party patent assertion against competitor and subsequent portfolio acquisition.
- Provided defensive patent analysis for major Asian semiconductor manufacturer in context of more than \$10 million at stake licensing negotiations.

Professional and Community Activities

- American Intellectual Property Law Association (AIPLA)
- Intellectual Property Owners Association (IPO), Post-Grant Patent Office Practice Committee
- PTAB Bar Association, Trials Committee
- Institute of Electrical and Electronics Engineers (IEEE)
- Association for Computing Machinery (ACM)
- Hon. Lee Yeakel, Austin Intellectual Property Inn of Court, Master of the Bench, Barrister, 2010-present
- Austin Intellectual Property Law Association (Austin IPLA), President, 2010, Board of Directors, 2007-2011

Selected Publications and Speeches

- "PTAB/TTAB Judges' Panel Discussion," moderator, Austin IPLA, Austin, TX, January 22, 2020.
- "IPR Strategy: Claim Construction and Estoppel Considerations," moderator, Berkeley-Stanford Advanced Patent Law Institute: Silicon Valley, Palo, Alto, CA, December 13, 2019.
- "Party Crashers: the Role of Latent 101 and 112 Issues Arising in Post-Grant Matters," panelist, PTAB Bar Association Annual Conference, Washington, DC, March 14, 2019.
- "Developments at the PTAB and the Federal Circuit," panelist, Stanford Law School's IP Law and the Biosciences Conference, Stanford, California, April 26, 2018.
- "PTAB Practice and Strategy," speaker, 18th Annual Berkeley-Stanford Advanced Patent Law Institute, Mountain View, CA, December 15, 2017.
- "Advanced IPR Topics Panel with Q&A," panelist, Chicago Regional IPR Seminar, Chicago, December 7, 2017.
- "Mastering the "Ins and Outs" of Selecting and Authenticating the Best Prior Art References," Post-Grant PTO Proceedings: Practical Strategies and Insights for IPR PGR and CBM Review, New York, NY, May 10-11, 2017.
- "PTAB Trial Proceedings - A Boot Camp & Advanced Practice Before the PTAB," panelist, PTAB Bench Bar Conference, Plano, TX, October 18-20, 2016.
- "PTAB Trials: Lessons Learned from the Perspective of Practitioners and In-House Counsel" with Gregory Huh, 17th Annual IP Symposium, The University of Texas School of Law, Austin, TX, March 4, 2016.
- "Post-Grant Review" with M. Kocalski and W. Stacy, 2016 Intellectual Property Symposium: Future World IP, University of Denver School of Law, Denver, CO, February 5, 2016.
- "The Rise of PTAB: Hot topics and Strategies" with S. DeBruine, E. Lamison and T. Stanek Rea, 16th Annual Advanced Patent Law Institute: Silicon Valley, Palo Alto, CA, December 11, 2015.
- "Lessons from Proxyconn: First Federal Circuit Reversal of an IPR," panelist, Intellectual Property Owners Association Chat Channel discussion, July 7, 2015.
- "Practice Before the PTAB in IPRs and CBMRs," panelist (with Steve Baughman, Judge Peter Chen, Dr. Rose Thiessen and Lee Van Pelt, Stanford Symposium on The PTO and the Courts, April 17-18, 2015.
- "Post-Grant Patent Trials 'Lessons Learned' Part I: Petition & Pre-Trial," panelist (with

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- Peter Ayers and Michael Rosato), 2014 Advanced Patent Law Institute, Austin, November 6, 2014.
- "Joint or Divided Infringement after SCOTUS Decision(s) in *Akamai v. Limelight*," in-house CLE presentation for major semiconductor company, August 26, 2014.
 - "Supreme Court Hedges Risk for Defendant CLS Bank on Business Method Patentability," with Kenneth Parker and Richard Rochford, IP Beacon, June 21, 2014.
 - "Highly-Anticipated *en Banc* Decision in *CLS Bank International v. Alice Corp.* Provides Little Clear Guidance," IP Beacon, June 3, 2013.
 - "2014 General Counsel Panel," Moderator, Association of Corporate Counsel, Austin Chapter, Austin, TX, March 25, 2014.
 - "Joint or Divided Infringement after *Akamai/McKesson (en banc)*," 2012 Advanced Patent Law Institute, Palo Alto, California, December 7, 2012.
 - "Joint or Divided Infringement," co-presenter with Mark A. Lemley, 2011 Advanced Patent Law Institute, Palo Alto, California, December 8, 2011 and Austin, Texas, October 28, 2011.
 - "Capability Claiming," co-presenter with Mark A. Lemley, 2011 Advanced Patent Law Institute, Austin, Texas, October 28, 2011.