



→ Chris Ponder

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Chris Ponder is a partner in the Intellectual Property Practice Group in the firm's Silicon Valley office.

"... deeply knowledgeable on the PTAB's intricate procedural rules ..."

- IAM Patent 1000 (2022)

Areas of Practice

With a focus on complex patent and business litigation, Chris represents leading companies in the digital media streaming, enterprise software, video game, telecommunications, and medical device industries.

Chris has significant expertise in representing patent challengers in PTAB proceedings. He has assisted clients in challenging patents across technologies, and has over a 90% institution rate. In addition to handling proceedings before the PTAB, he has extensive experience developing and executing strategies for appeals from the PTAB to the Federal Circuit.

Chris has participated in several jury trials involving patent infringement and other commercial claims. This experience includes motion advocacy, arguing motions in federal court, and taking depositions of high-level corporate executives including a chief operating officer, a chief technology officer, and a general counsel, as well as expert witnesses.

Clients also turn to Chris for his experience in handling complex trade secret and copyright issues, including disputes arising from employee departures and ending business relationships. He routinely counsels clients with regard to negotiating and evaluating patent licenses, evaluating software license agreements, responding to trademark and copyright infringement issues, and implementing trade secret policies.

Honors

Ranked as one of the most active attorneys representing petitioners, *Patexia* IPR Intelligence Report, 2021-2022

The World's Leading Patent Professionals, *IAM Patent 1000*, 2022-2023

Northern California Rising Star, *Super Lawyers*, 2015-2018

Experience

Inter Partes Review (IPR)

- Representing a leading streaming service as petitioner in 15+ IPRs and related appeals to the Federal Circuit challenging patents asserted by Broadcom.
- Representing leading streaming services as petitioners in several IPRs and related appeals challenging patents asserted by a Fortress-funded patent portfolio holding company.
- Defended a leader in implantable hearing solutions as the patent owner in an IPR brought by a competitor. All claims were found not unpatentable.
- Represented a leading music streaming service in 4 IPRs that settled shortly after filing.
- Represented a leader in wearable devices as petitioner in appeals from IPRs (Fed. Cir.). The Federal Circuit affirmed two final written decisions finding the claims unpatentable and reversed and remanded a third final written decision that found some claims not unpatentable.
- Represented a leading streaming service in 7 IPRs relating to compression technology (over 85 claims found unpatentable across 5 patents).
- Represented a leading game developer in an IPR and on appeal where all challenged claims held unpatentable following an unsuccessful IPR challenge by a different game developer.
- Represented a leader in wearable devices as petitioner in an IPR where the patent owner (a Wi-LAN subsidiary) disclaimed the challenged claims after institution.

Patent Infringement Litigation

- Representing leading software provider in a 3 patent assertion related to communication protocols, after successful transfer from the Eastern District of Texas (W.D. Tex.).
- Representing leading software provider in a 2 patent assertion related to electronic design automation for semiconductors (N.D. Cal.).
- Represented leading semiconductor company in 6 district court actions (D. Del. and D. Mass.) and an ITC investigation, with 11 asserted patents. Previously represented the same client in an ITC investigation that was voluntarily dropped by the plaintiff.
- Represented leading streaming service provider in district court (C.D. Cal.) and corresponding IPR. Obtained institution of the IPR, after which patent owner surrendered all claims and dismissed the district court action.
- Represented a leading video game company in litigation involving erasure code technology (W.D. Tex.). Case settled favorably.
- Defended a leading game developer in a district court action involving a non-practicing entity (C.D. Cal.). Case was dismissed after a successful inter partes review was upheld on appeal, and the court found the case was exceptional and awarded attorneys' fees against the NPE.
- Represented leading ticket website in district court litigation involving resale of tickets (W.D. Tex.). Plaintiff dismissed action without payment.
- Represented leading furniture manufacturers in district court litigation (E.D. Tex.) and 2 related IPRs concerning augmented reality technology. Case settled favorably.
- Represented a medical technology company in litigation against a competitor involving radiotherapy technology (N.D. Cal.), and in related IPRs as the patent owner.

- Represented a major luxury retailer in litigation brought by a non-practicing entity (E.D. Tex.).
- Represented a leading TV manufacturer in litigation involving various technologies including 802.11 wireless standards (E.D. Tex.).
- Represented a leading music streaming service in patent litigation (D. Del.).
- Represented a leading provider of satellite communications equipment and satellite data service against claims of infringement involving satellite communications technologies brought by a major military contractor (E.D. Tex.).
- Represented a provider of enterprise and carrier real-time communications technology in patent infringement countersuit brought by a competitor involving telecommunications technologies (E.D. Tex.).
- Represented a provider of enterprise and carrier real-time communications technology in patent infringement action against a competitor involving VoIP, media gateway, and session border controller technologies (E.D. Tex.).
- Represented a provider of captioning services for hard of hearing users in competitor litigation involving captioned telephone technology (W.D. Wis.); developed petitioner's response to plaintiff's secondary considerations evidence in eight co-pending IPRs.
- Defended a leading telecommunications carrier against claims that its services infringe a patent directed to location-based services (E.D. Tex.).
- Defended a major computer company against claims that hard drives shipped with its computer systems infringe a patent directed to switchable hard drive acoustic properties (E.D. Tex.).
- Defended a major computer company against claims that its computer systems infringe a patent that covers transcoding video into a format for optical discs (E.D. Tex.).
- Represented a major computer company in a patent infringement action involving enterprise iSCSI storage systems (N.D. Tex. and Fed. Cir.).
- Represented a U.S. appliance manufacturer in a patent infringement action involving refrigerator storage and ice and water dispensing systems (D. Del.).

Copyright and Trade Secret Infringement

- Represented a leading game developer in a copyright infringement lawsuit against a video game developed by former employees (C.D. Cal.).
- Represented a leading game developer in an international arbitration involving former employees and claims for unpaid royalties, breach of contract, breach of common law duties, improper solicitation, and breach of confidentiality.
- *Represented a* provider of enterprise and carrier real-time communications technology in competitor litigation involving trade secret misappropriation and unfair competition counterclaims (E.D. Tex. and Texas State court).

Counseling

- Assisted client with contracting for independent software support services that comply with their enterprise software licenses.
- Provided an opinion to a client analyzing their ownership rights in software works they derived from licensed software.

- Assisted client with providing intellectual property disclosures for their shelf offering registration.
- Apprised a client of their rights in software code developed for them by a third party contractor.

Articles

- Gaming IP Dispute Is Instructive For Cos. On PTAB Litigation
Law360, 09.09.2021
- Vexing PTAB Apple Decision May Overtax West Texas Court
Law360, 06.25.2020
- Part 2: How to Assert and Defend Trade Secret Claims After 'Waymo v. Uber'
The Recorder, 02.20.2018
- Lessons Learned From 'Waymo v. Uber' and Other Trade Secret Disputes, Part One: How to Properly Protect Your Trade Secrets
The Recorder, 02.13.2018
- How To Make Secondary Considerations Matter (Or Not)
Law360, 06.09.2016

Game Counsel: Gaming and Esports Blog Posts

- "Clash of Game Companies: Lessons Learned from GREE and Supercell Dispute" September 22, 2020

Law of the Level Blog Posts

- "Addressing Video Game Claims Under the Phillips Standard at the PTAB," August 26, 2019
- "Converting an IPR Loss into a District Court Win," May 8, 2019
- "Caution to Game Companies: PTAB Continues to Preclude PTAB Challenges That It Views As Untimely," April 10, 2019
- "Failure to Launch: Not Identifying the Proper Parties Can Prematurely End an Video Game IPR Challenge," February 5, 2019
- "Challenges in Filing Successful IPR Petitions for Video Game Patents," January 3, 2019

Intellectual Property Law Blog Posts

- "Left Empty Handed: Valve Shut Down on Written Prior Art, Highlighting Importance of System Art," December 6, 2019
- "Perils of Waiting: PTAB's Precedential Opinion Panel Designates Two More Decisions Rejecting 315(b) Arguments Regarding Time Bars," September 16, 2019
- "PTAB Continues to Preclude PTAB Challenges That It Views As Untimely," April 12, 2019

Media Mentions

Fed. Circ. Affirms Netflix's PTAB Win Against Broadcom
Law360, 06.22.2023

Fed. Circ. Sends Wearable Tech IP Back To PTAB In Fitbit Fight
Law360, 07.08.2020

World Of Tanks Creator Sues Ex-Employees Over 'Blitz' TM
Law360, 03.26.2020

PTAB Upholds 1 Realtime Patent In Netflix Row, Axes Another
Law360, 01.17.2020

Netflix Gets Realtime Data Compression Patent Nixed At PTAB
Law360, 01.10.2020

Fed. Circ. Affirms PTAB Ax Of Online Gaming Patent Claims
Law360, 11.19.2019

Fed. Circ. Affirms PTAB Ax Of Wearable Tech Patent Claims
Law360, 09.29.2019

Fed. Circ. Mulls Terms In Patent That Fitbit, Apple Got Axed
Law360, 09.04.2019

Sheppard Adds 3 Baker Botts Attys To Calif. IP Team
Law360, 09.26.2018

Apple, Fitbit Get Heart Sensor Patent Slashed At PTAB
Law360, 08.07.2018

Speaking Engagements

Moderator, "Advanced Damages Techniques," ABA Section of Intellectual Property Law Spring Meeting, Washington, D.C., 04.14.2023

Speaker, "Open Source 2.0," Games Industry Law Summit Vilnius, 09.08.2022

Speaker, "Intellectual Property Update," 9th Video Game Bar Association - Game Business & Legal Affairs Conference, 05.24.2022

Speaker, "Year In Review: Patent Litigation," ABA Section of Intellectual Property Law Spring Meeting, Washington, D.C., 04.07.2022

Speaker "Fighting (Patent) Trolls with Dragons: How to Effectively and Efficiently Defend Against Patent Assertions," Video Game Bar Association Virtual Townhall, 12.16.2020

Events

Games Industry Law Summit – Open Source 2.0
National Museum of Art, 09.08.2022

Game Business & Legal Affairs Conference
9TH VGBA Summit Bay Area
May 23-24, 2022

Fighting (Patent) Trolls with Dragons: How to Effectively and Efficiently Defend Against Patent Assertions
Video Game Bar Association Virtual Townhall
12.16.2020

Memberships

American Bar Association - Section of Intellectual Property Law

Practices

Intellectual Property
False Advertising, Lanham Act and Unfair Competition
Patent Litigation
Post-Grant Proceedings
Trade Secrets

Industries

Entertainment, Technology and Advertising
Esports & Games
Life Sciences
Semiconductors
Space & Satellite

Education

J.D., University of Houston, 2008, *magna cum laude*, Articles Editor, *Houston Law Review*, *Order of the Coif*
B.S., Computer Science, University of Houston, 2004, *cum laude*, Member of the Honors College

Clerkships

Law Clerk to the Honorable Roy S. Payne of the United States District Court for the Eastern District of Texas.

Admissions

California

Texas

United States Patent and Trademark Office

United States Courts of Appeals for the Federal Circuit and Ninth Circuit

United States District Courts for the Central and Northern Districts of California

United States District Court for the Eastern and Western Districts of Texas