



## → James W. Soong

### Partner

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James W. Soong is partner in the Intellectual Property Practice Group in the firm's Silicon Valley office.

### Areas of Practice

Jim advises on intellectual property and patent strategy in a broad array of industries and technical disciplines. Jim regularly counsels clients – from start-ups to the Fortune 5. Drawing on his extensive in-house corporate experience, he focuses his legal advice from the lens of business objectives. Clients call on him to provide strategic direction regarding the design and optimization of corporate intellectual property policies and best practices. Before, as in-house counsel, he led the global intellectual property portfolio at Siebel Systems for six years, managing all aspects of patent, trademark, domain name, trade secret, and copyright acquisition, protection, and enforcement.

Jim's experience extends to various facets of intellectual property strategy. He has engineered and supervised preparation of countless patent applications, as well as noninfringement and invalidity opinions. In addition, his experience includes advising on intellectual property issues that arise in mergers and acquisitions, due diligence, technology licensing, risk avoidance, open source, standard setting organizations, inter-company agreements, employment, and other corporate matters. Jim has an extensive record of success in intellectual property disputes, including coordinated resolution of patent litigation and inter partes proceedings in court and before the Patent Office, including successful appeals to the Federal Circuit on cutting edge legal issues.

Jim has received extensive industrywide honors. Since 2017, Jim continues to be recognized every year by The World's Leading Patent Professionals, IAM Patent 1000. Jim is also a member of IAM Global Leaders, a gold tier ranking of the IAM Patent 1000. In addition, he continues to be ranked as an "IP Star" by Managing IP and has received similar recognition by other industry organizations. Jim is also an editorial board member of the publication *The Intellectual Property Strategist*.

Pro bono advice and counseling are an important component of Jim's practice. Jim has successfully represented various pro bono clients in intellectual property matters and before the Patent Office. He also received a Certificate of Recognition from the Legal Aid Society of San Mateo County for protecting the rights of a senior citizen under the California elder financial abuse statute in a pro bono litigation.

While attending law school, Jim served as an Editor of the U.C. Davis Law Review. He also served as an extern clerk for the Honorable Edward J. Garcia, United States District Court for the Eastern District of California.

Jim is conversationally fluent in Mandarin Chinese.

Jim is a member of the firm's Diversity & Inclusion Committee.

## Honors

Global Leaders (California), *IAM Patent 1000*, 2022-2023

IP Star, Managing Intellectual Property, 2021-2022

## Experience

### Representative Matters

#### Litigation

- Represented world's largest mobile phone maker in patent litigation involving touchscreen interface technology.
- Represented world's largest mobile phone maker in patent litigation involving voice recognition systems.
- Represented top mobile phone maker in patent litigation involving client-side image manipulation.
- Represented world's leading PC manufacturer in patent litigation involving wireless communication standards.
- Represented leading global supplier of business and personal electronics in patent litigation involving computer peripheral technology.
- Represented world's largest maker of electronic components in patent litigation involving semiconductor packaging.
- Represented second-largest worldwide retailer of computers and notebooks in patent litigation involving wireless communication standards.
- Represented industry-leading supplier of memory modules in patent litigation involving flash memory.
- Represented leading computer peripheral supplier in patent litigation involving computer input device technology.
- Represented leading multinational in patent litigation involving online card fraud and payment processing algorithms. *Cybersource Corp. v. Retail Decisions, Inc.*, 654 F. 3d 1366 (Fed. Cir. 2011).
- Represented prominent startup in multi-patent infringement litigation involving ultra wideband HD video distribution technology.
- Defended the validity and enforceability of mobile phone industry leader's asserted patent in an ITC action involving linearization and power control circuitry.
- Represented third-largest Indian food manufacturer in Lanham Act trademark and unfair competition suit.
- Represented leading networking company in multi-patent infringement litigation involving packet data communications.
- Represented mobile phone industry leader, strategizing claim construction and patent noninfringement positions in an ITC action involving semiconductor packaging.
- Represented leading DRAM designer in multi-patent infringement litigation.

- Represented niche workstation company in multi-patent infringement litigation involving microprocessor caching technology.
- Represented prominent subsystem designer in patent infringement action involving semiconductor memory modules.
- Represented leading computer manufacturer in patent infringement action involving electronic graphical display circuits. Lans v. Digital Equipment Corp., 252 F.3d 1320 (Fed. Cir. 2001).

## Other Intellectual Property Matters

- Drafted and negotiated patent transfer agreement involving patent sale valued at more than \$1 million per patent.
- Represented buy and sell sides for myriad patent portfolio transactions.
- Helped design and execute patent licensing strategies for semiconductor industry leader involving patent selection, infringement diligence, assertion strategy, bite-back analyses, and licensee engagement.
- For leading enterprise software company, devised global intellectual property strategy. Launched patent procurement and enforcement strategy. Enforced trademark rights in multiple domain name recovery actions. Enforced trademark, copyright, and trade secrets in global anti-counterfeiting campaign. Drafted, negotiated, and advised on IP licenses and licenses involving software, SSOs, alliances, open source, OEMs, and vendors.
- Led intellectual property teams in various M&A and related due diligence, including acquisitions of e-commerce software company (\$760 million), financial services software company (\$1.1 billion), business analytics software company, e-marketing software company, incentive compensation software (\$3 million), hosted CRM provider (\$50 million), financial services software company (\$70 million), and online billing company (\$115 million). \*Certain of the above representations were handled by Mr. Soong prior to his joining Sheppard Mullin

## Articles

- Alice and Incongruity In PTAB Appeals  
*The Intellectual Property Strategist (republished in Law.com)*, 10.2020
- Safeguard Design Freedom: Patent Strategy In Corporate Deals  
*Law360*
- Author, "Joint Defense Agreement Considerations in NPE Patent Litigation," *The Intellectual Property Strategist*
- Co-Author, "Preissuance Submission Strategies for Patent Prosecution and Litigation," *The Intellectual Property Strategist*
- Author, "Five Tips for Protecting Your Inventions," Legal Services for Entrepreneurs Newsletter
- Co-Author, "Patent Disputes in This Economy: Why Your CXO or Client May Require a New Look at Reexamination as a Cost-Effective and Strategic Alternative to Litigation," *Intellectual Property Today*
- Author, "IP Roundtable," *Managing Intellectual Property*
- Co-Author, "The Threat of Evidence Destruction: Strategies to Safeguard and Accelerate Proof of Patent Infringement," *Patent Strategy & Management*
- Author, "Patent Damage Strategies and the Enterprise License: Constructive Notice, Actual Notice, No Notice," *Duke Law & Technology Review*

- Author, "Definite Confusion Over Likely Confusion: The Scope of Appellate Review," *Hastings Communications and Entertainment Law Journal*
- Author, "Another Estoppel: Acquiescence in Prosecution May Cause Patent Forfeiture in Litigation," *Journal of the Patent and Trademark Office Society* (also published in *Intellectual Property Today*)
- Author, "Intellectual Property Protection for Computer-Related Technology in the United States, Republic of China, Japan, and People's Republic of China," *Wiley Intellectual Property Law Update*
- Author, "Taiwan and Mainland China: Unfinished Business," *U.C. Davis Journal of International Law and Policy*

## Intellectual Property Law Blog

- "Artificial Intelligence And Subject Matter Eligibility In U.S. Patent Office Appeals – Part Three Of Three," September 8, 2021
- "Artificial Intelligence And Subject Matter Eligibility In U.S. Patent Office Appeals – Part Two Of Three," September 1, 2021
- "Artificial Intelligence And Subject Matter Eligibility In U.S. Patent Office Appeals – Part One Of Three," August 25, 2021
- "'Winning' Prosecution Arguments Can Invalidate Your Patent As Indefinite," March 3, 2021
- "Alice and Incongruity in PTAB Appeals" rel="noopener" href="https://www.intellectualpropertylawblog.com/archives/alice-ptab-appeals">"Alice and Incongruity in PTAB Appeals," October 8, 2020

## Media Mentions

Plugged In - James Soong  
*The Recorder*, 10.20.2014

Sheppard Mullin Adds Greenberg Patent Vet In Silicon Valley  
*Law360*, 02.13.2013

## Speaking Engagements

Speaker, "Patent Strategy and Cost," 31<sup>st</sup> Annual - Silicon Valley Association of General Counsel (Nov. 2019)

Speaker, "Standard Setting Organizations, Standard Essential Patents, and Related Patent Remedies," Mobile Payments Law, Law Seminars International, Palo Alto, CA

Speaker, "Preissuance Submission as Preemptive Litigation Strategy," 2013 Intellectual Property Institute, IP Section of The State Bar of California, Berkeley, CA

Panelist, "The American Invents Act: Final Provisions to Become Effective," Intellectual Property Section of California State Bar, University of California, Hastings College of Law

Speaker, "Managing U.S. Patent Risk for High Tech Companies: Federal Circuit and AIA Developments," Taiwan Technology Industry Legal Officers Association (TILO)

Speaker, "Internet Companies and Patent Litigation," Greenberg Traurig, LLP, Silicon Valley, CA

Speaker, "Internet Companies and Patent Litigation," Greenberg Traurig, LLP, San Francisco, CA

Speaker, "Recent Developments in U.S. Patent Law: Legal Strategies for Taiwan and other Global Companies," Taiwan Technology Industry Legal Officers Association (TILO)

Speaker, "Strategic Intellectual Property Considerations for Business," Lawyer's Committee for Civil Rights

Speaker, "Intellectual Property Transactions and Select Issues in the Patent Transfer Agreement," University of California at Davis King Hall School of Law

Speaker, "Patents and Intellectual Property," Technology Entrepreneur Center of University of Illinois at Urbana Champaign with Plug and Play Tech Center

Guest Lecturer, "Software Patents – The Law and the Controversy," University of California at Berkeley School of Law

Speaker, "IP Issues in License Agreements," Siebel Systems Legal Training Series

Speaker, "Patent Claims Drafting," University of Washington Continuing Legal Education Intellectual Property Certificate Program

## Memberships

Editorial Board Member, The Intellectual Property Strategist

Board Member, Asian Law Alliance

Former Member, Rainbow Chinese School of Cupertino, Curriculum Committee

Former Chair, City of San Mateo, Community Improvement Commission

Former Member, Chung Tai Zen Center, Translation Committee

Member, Silicon Valley Intellectual Property Law Association

## Practices

Intellectual Property

Copyrights

False Advertising, Lanham Act and Unfair Competition

IP Licensing, Technology and Commercial Transactions

Patent Litigation

Patent Prosecution and Counseling

Trade Secrets

Trademarks and Trade Dress

Post-Grant Proceedings  
Technology Transactions

## Education

J.D., University of California, Davis, Editor, *U.C. Davis Law Review*  
B.S., Electrical Engineering, University of California, Los Angeles, *Eta Kappa Nu* nom  
I.C.L.P., National Taiwan University

## Admissions

California  
U.S. Court of Appeals for the Federal Circuit  
U.S. District Court for the Central, Eastern, Northern and Southern Districts of California  
U.S. District Court for the Western District of Washington  
U.S. Patent and Trademark Office  
Washington