



→ Nam H. Kim

Partner
650 Town Center Drive
Tenth Floor
Costa Mesa, CA 92626

T: +1.714.424.8280
nkim@sheppardmullin.com

Nam Kim is a partner in the Intellectual Property Practice Group in the firm's Orange County office and spends a considerable amount of time in the Seoul office.

Areas of Practice

Nam's practice focuses on patent litigation, patent preparation and prosecution, ex parte reexamination, AIA post-grant review proceedings and IP counseling. He is involved in patent litigation matters to defend clients' IP rights against infringers and defend clients against alleged infringements. He is also experienced in preparing and prosecuting patent applications and provides strategic IP counseling. Nam also represents clients in reexamination and *inter partes* review proceedings. He has experience and knowledge in a variety of technologies, including various wireless technologies (WCDMA, HSPA, LTE, CDMA2000, wireless modems, cellular Multimedia Messaging Service (MMS)), vehicle navigation systems, digital and analog electronics, optics, LCD and other display technologies, magnetic resonance imaging technology, digital image processing, nanotechnology, MEMS devices, photovoltaic cells, hard disk drive technology, semiconductor devices and processing, medical devices, computer software, motors and motor drives for electric vehicles and CNC machining centers.

Nam also counsels clients on trademark applications, oppositions and infringement matters.

Honors

Recommended by *Legal 500 Asia Pacific: Intellectual Property - Foreign Firms*, 2019-2020

San Diego Rising Star, *Super Lawyers*, 2015-2018

Number 11 ranked IPR attorney in the country representing Petitioners, *Patexia IPR Intelligence Report*, 2019

Experience

Representative Patent Litigation Experience

- *Ericsson v. TCL*: Represents TCL and TCT Mobile in a five-patent infringement action relating to patents Ericsson has alleged cover aspects of cellular phone hardware and the Android OS.
- *TCL v. Ericsson*: Represents TCL Communication in breach of contract and declaratory judgment action relating to FRAND and the IPR policies of ETSI and 3GPP relating to alleged Standard Essential Patents (SEPs) for 2G GSM/GPRS/EDGE, 3G UMTS and 4G LTE technology.

- *Evolved Wireless v. HTC*: Represents HTC Corporation and HTC America, Inc., in a five-patent lawsuit relating to SEPs alleged to cover the LTE standard. HTC has also asserted a counter-claim for breach of contract alleging that Evolved Wireless has failed to license its patents on Fair, Reasonable and Non-Discriminatory (FRAND) terms.
- *INVT SPE LLC v. HTC*: Represents HTC Corporation in a seven-patent infringement action relating to alleged SEPs directed to the 2G EGPRS, 3G UMTS/WCDMA/HSPA and 4G LTE standards. Client has asserted a counter-claim that Plaintiff has failed to license its patents on FRAND terms.
- *Bike Builders Bible v. Lee*: Represented defendant Mr. Lee, an inventor in two patents and the CEO of a Korean manufacturer of motorcycle parts, in a declaratory judgment action for invalidity and non-infringement of Mr. Lee's patents. Resulted in dismissal of the case for lack of personal jurisdiction over Mr. Lee.
- *Parallel Networks v. Abercrombie*: Represented Sony in the Eastern District of Texas in a patent infringement lawsuit involving a software patent relating to web browsers and Java applets. Resulted in summary judgment of non-infringement on behalf of Sony.
- *Wi-LAN v. Alcatel*: Represented HTC Corporation and HTC America, Inc., in a multi-patent lawsuit in the Eastern District of Texas relating to 3G cellular technology, including HSDPA, HSUPA and HSPA. Resulted in jury verdict of invalidity and non-infringement of all claims of the asserted patents.
- *Wi-LAN v. Apple*: Represented HTC America, Inc., in a multi-patent lawsuit in the Eastern District of Texas relating to Wi-Fi, HSPA, LTE and CDMA2000 (EVDO Rev. A) technologies. Resulted in a favorable settlement on behalf of HTC.
- *Novatel Wireless v. Franklin Wireless*: Represented Franklin Wireless, Inc., in a four-patent lawsuit in the Southern District of California relating to wireless modems, USB modems and Wi-Fi.
- *Golden Bridge v. HTC*: Represented HTC Corporation and HTC America, Inc., in a two-patent lawsuit in the District of Delaware relating to WCDMA 3G technology.
- *Intellect Wireless v. HTC*: Represented HTC Corporation and HTC America, Inc., in a two-patent lawsuit in the Northern District of Illinois relating to sending pictures to a paging receiver. The accused technology is MMS.
- *Extricom, Inc. v. Meru Networks LLC*: Represented plaintiff Extricom involving patent infringement claims relating to WLAN and Wi-Fi technologies and advanced managerial functions.
- *Wi-LAN v. PCD*: Represented Personal Communication Devices, LLC, (PCD) in a two-patent lawsuit in the Eastern District of Texas relating to Wi-Fi and CDMA2000 technologies. Resulted in favorable settlement for PCD.

Representative Post-Grant Proceeding Experience Before the USPTO

- *TCL Corporation et al. v. Telefonaktiebolaget LM Ericsson*, No. IPR2015-1583. Represents Petitioner TCL in challenging the validity of U.S. Patent No. 6,418,310, a patent directed to the control programs for wireless communication devices. Petition was instituted on all asserted grounds and all challenged claims were invalidated.
- *TCL Corporation et al. v. Telefonaktiebolaget LM Ericsson*, No. IPR2015-1584. Represents Petitioner TCL in challenging the validity of U.S. Patent No. 6,029,052, a patent directed to multi-mode direct conversion receiver circuitry. Petition was instituted on all asserted grounds and all challenged claims were invalidated.
- *TCL Corporation et al. v. Telefonaktiebolaget LM Ericsson*, No. IPR2015-1600. Represents Petitioner TCL in challenging the validity of U.S. Patent No. 6,029,052, a patent directed to multi-mode direct conversion receiver circuitry. Petition was instituted on all asserted grounds and all challenged claims were invalidated.

- *TCL Corporation et al. v. Telefonaktiebolaget LM Ericsson*, No. IPR2015-1602. Represents Petitioner TCL in challenging the validity of U.S. Patent No. RE43,931, a patent directed to contact-sensitive transducers for controlling a GUI on a mobile phone. Petition was instituted on all asserted grounds and all challenged claims were invalidated.
- *TCL Corporation et al. v. Telefonaktiebolaget LM Ericsson*, No. IPR2015-1605. Represents Petitioner TCL in challenging the validity of U.S. Patent No. 7,149,510, a patent directed to access control for application software. Petition was instituted on all asserted grounds.
- *TCL Corporation et al. v. Telefonaktiebolaget LM Ericsson*, No. IPR2015-1622. Represents Petitioner TCL in challenging the validity of U.S. Patent No. 7,149,510, a patent directed to access control for application software. Petition was instituted on all asserted grounds.
- *TCL Corporation et al. v. Telefonaktiebolaget LM Ericsson*, No. IPR2015-1628. Represents Petitioner TCL in challenging the validity of US Patent No. 7,149,510, a patent directed to access control for application software. Petition was instituted on all asserted grounds.
- *TCL Corporation et al. v. Telefonaktiebolaget LM Ericsson*, No. IPR2015-1637. Represents Petitioner TCL in challenging the validity of U.S. Patent No. RE43,931, a patent directed to contact-sensitive transducers for controlling a GUI on a mobile phone. Petition was instituted on all asserted grounds and all challenged claims were invalidated.
- *TCL Corporation et al. v. Telefonaktiebolaget LM Ericsson*, No. IPR2015-1641. Represents Petitioner TCL in challenging the validity of U.S. Patent No. RE43,931, a patent directed to contact-sensitive transducers for controlling a GUI on a mobile phone. Petition was instituted on all asserted grounds and all challenged claims were invalidated.
- *TCL Corporation et al. v. Telefonaktiebolaget LM Ericsson*, No. IPR2015-1646. Represents Petitioner TCL in challenging the validity of U.S. Patent No. RE43,931, a patent directed to contact-sensitive transducers for controlling a GUI on a mobile phone. Petition was instituted on all asserted grounds and all challenged claims were invalidated.
- *TCL Corporation et al. v. Telefonaktiebolaget LM Ericsson*, No. IPR2015-1650. Represents Petitioner TCL in challenging the validity of U.S. Patent No. 6,535,815, a patent directed to using quality-of-service parameters in A-GPS for mobile terminals. Petition was instituted on all asserted grounds and all challenged claims were invalidated.
- *TCL Corporation et al. v. Telefonaktiebolaget LM Ericsson*, No. IPR2015-1674. Represents Petitioner TCL in challenging the validity of U.S. Patent No. RE43,931, a patent directed to contact-sensitive transducers for controlling a GUI on a mobile phone. Petition was instituted on all asserted grounds and all challenged claims were invalidated.
- *TCL Corporation et al. v. Telefonaktiebolaget LM Ericsson*, No. IPR2015-1676. Represents Petitioner TCL in challenging the validity of U.S. Patent No. RE43,931, a patent directed to contact-sensitive transducers for controlling a GUI on a mobile phone. Petition was instituted on all asserted grounds and all challenged claims were invalidated.
- *TCL Corporation et al. v. Telefonaktiebolaget LM Ericsson*, No. IPR2015-1761. Represents Petitioner TCL in challenging the validity of U.S. Patent No. RE43,931, a patent directed to contact-sensitive transducers for controlling a GUI on a mobile phone. Petition was instituted on all asserted grounds and all challenged claims were invalidated.

- *TCL Corporation et al. v. Telefonaktiebolaget LM Ericsson*, No. IPR2015-1772. Represents Petitioner TCL in challenging the validity of U.S. Patent No. 6,535,815, a patent directed to using quality-of-service parameters in A-GPS for mobile terminals. Petition was instituted on all asserted grounds and all challenged claims were invalidated.
- *TCL Corporation et al. v. Telefonaktiebolaget LM Ericsson*, No. IPR2015-1806. Represents Petitioner TCL in challenging the validity of U.S. Patent No. RE43,931, a patent directed to contact-sensitive transducers for controlling a GUI on a mobile phone. Petition was instituted on all asserted grounds and all challenged claims were invalidated.
- *TCL Corporation et al. v. Telefonaktiebolaget LM Ericsson*, No. IPR2015-1878. Represents Petitioner TCL in challenging the validity of U.S. Patent No. 6,535,815, a patent directed to using quality-of-service parameters in A-GPS for mobile terminals. Petition was instituted on all asserted grounds and all challenged claims were invalidated.
- *HTC Corporation, and HTC America, Inc. et al. v. Evolved Wireless LLC*, No. IPR2016-00758. Represents Petitioner HTC in challenging the validity of U.S. Patent No. 8,218,481. Petition was instituted on all asserted grounds.
- *HTC Corporation and HTC America, Inc et al. v. Evolved Wireless LLC*, No. IPR2016-01310. Represents Petitioner HTC in challenging the validity of U.S. Patent No. 7,768,965. Petition was instituted on all asserted grounds.
- *HTC Corporation and HTC America, Inc et al. v. Evolved Wireless LLC*, No. IPR2016-00757. Represents Petitioner HTC in challenging the validity of U.S. Patent No. 7,881,236. Petition was instituted on all asserted grounds.
- *HTC Corporation and HTC America, Inc et al. v. Evolved Wireless LLC*, No. IPR2016-01208. Represents Petitioner HTC in challenging the validity of U.S. Patent No. 7,746,916. Petition was instituted on all asserted grounds.
- *HTC Corporation and HTC America, Inc et al. v. Evolved Wireless LLC*, No. IPR2016-01227. Represents Petitioner HTC in challenging the validity of U.S. Patent No. 7,746,916. Petition was instituted on all asserted grounds.

Patent Preparation, Prosecution and Transaction Experience

- Nam prepared and prosecuted numerous domestic and foreign patent applications for various clients, including Samsung, Qualcomm, Western Digital, CareFusion, Lawrence Livermore National Laboratory and Lockheed Martin.
- Nam represented clients in *inter partes* and *ex parte* reexaminations of issued U.S. patents.
- Nam also provided various opinions and counseling relating to patent infringement and validity issues in the context of litigation and licensing.

Additional Experience

- While in graduate school, Nam developed and patented world's first electronic compass involving a metallic glass material and licensed the technology to a startup that manufactured electronic compasses based on the technology for consumer, automotive and military markets.
- Prior to becoming a patent attorney, Nam founded and worked as a chief engineer for a startup that specialized in industrial sensors and developed new sensor technologies for which he obtained a number of U.S. and foreign patents.
- While in law school, Nam worked for the technology transfer office of the University of Illinois at Urbana-Champaign, where he evaluated technologies developed at the University for patentability and commercial viability.

Articles

Intellectual Property Law Blog Posts

- "Software and Business Method Inventions After *Alice*," September 26, 2016
- "Federal Circuit Reaffirms Its Longstanding Patent Exhaustion Precedents in *Lexmark. v. Impression Products* (Fed. Cir. Feb. 12, 2016) (en banc)," March 18, 2016
- "*Calcar and Thorne*: Attempting to Reconcile the Federal Circuit's Claim Construction Jurisprudence," July 23, 2012

Books

Intellectual Property Guide to U.S. Ecommerce
2020

Speaking Engagements

"IP Policies and Dispute Resolution Procedures for Ecommerce Platforms," KOTRA 2020 Intellectual Property Strategy Seminar, November 19, 2020

"U.S. Patent Law: Patent Prosecution and Litigation," delivered at the Electrical Engineering department of University of California at San Diego to visiting Korean scholars, January 5, 2012

"Protecting IP and Licensing Technology In & Out," William J. von Liebig Center Entrepreneurial Seminar Series, May 9, 2009

Events

Trends in Intellectual Property - Keep Up or Get Left Behind
01.18.2018

2013 U.S.-Korea Law Day
07.27.2013

Memberships

Member of legal advisors to Korea Trade-Investment Promotion Agency (KOTRA) advising on IP-related issues

Board Member, Pan Asian Lawyers of San Diego (PALSD)

Member, Board of Advisors for U.S.-Korea Law Foundation

Former President, Korean American Bar Association of San Diego (KABA-SD)

Member, National Asian Pacific American Bar Association (NAPABA)

Practices

Intellectual Property
International Reach
Korea
Post-Grant Proceedings

Industries

Automotive
Life Sciences

Education

J.D., University of Illinois College of Law, 2007, *cum laude*
M.S., Physics, Cornell University, 1990
B.S., Physics, Stanford University, 1985, *with honors*

Admissions

California
U.S. Patent and Trademark Office

Languages

Korean