






David M. Hoffman

Principal

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“David Hoffman is an incredible attorney and I would recommend him to anyone.”
— *Client testimonial, 2021 Chambers and Partners USA*

Overview

Highlights

- Extensive experience in the United States District Court for the Western District of Texas and comprehensive knowledge of the court’s recently increased role in patent filings.
- Cost-effectively manages matters from inception through trial and beyond on behalf of both patent holders and parties accused of patent infringement in district court, the International Trade Commission, and the Patent Trial and Appeal Board.
- Helped change Texas polling laws to broaden interpreter options for registered voters with limited English proficiency.

About David

David’s hardworking, budget-aware approach to the law helps him build long-term relationships with clients who trust him to make decisions not only about litigation, but also about whether to settle or take an entirely different path.

His practice emphasizes patent litigation, *inter partes* review (IPR) proceedings, commercial and civil litigation, patent prosecution, intellectual property counseling, and patent portfolio management. He has a highly successful record in regular appearances before many tribunals, including:

- U.S. district courts, with extensive familiarity with the Western District of Texas
- U.S. International Trade Commission (ITC), with considerable high-stakes patent litigation

experience

- Patent Trial and Appeal Board (PTAB), where he has appeared in more than 60 IPRs

In addition to his expertise in patent opinions, David has helped clients pursue patent rights in well over 100 patent applications in a wide variety of electrical and mechanical disciplines, including semiconductor technology, memory, software, and wireless communications.

In recent months, he has emerged as a go-to authority in the Western District of Texas. Since 2018, that court has quickly transformed into a highly active venue for patent infringement litigation. David has read nearly every order issued by the court and has a deep understanding of its procedures on claim construction hearings, motions for transfer of venue, and other proceedings, as well as comprehensive knowledge of the nuances surrounding jury trials in one of the hottest venues for patent cases.

Background

David's technical background includes working as a configuration engineer and production supervisor for Applied Materials, Inc. (2000-2003), where he performed configuration reviews on complex electromechanical semiconductor wafer fabrication equipment and was responsible for the supervision, training, and certification of 34 final test technicians. He was also a system analyst for Ford Motor Company (1995). Before practicing law, David served in the U.S. Army as an infantry platoon leader (1998-2000) and company executive officer (1999). He then continued that service in the Texas National Guard as a platoon leader (2000-2002).

Focus Areas

Services

- Litigation
- Post-Grant
- Opinions and Strategic Counseling
- ITC Litigation
- Patent Litigation

Industries

- Consumer Products
- Electrical and Computer Technology
- Hardware

- Semiconductors
- Software

Education

J.D., University of Texas Law School (2004) Staff Editor, *Texas Intellectual Property Law Journal*

B.S., Electrical Engineering, University of Texas at Austin (1997)

B.A., Plan II Liberal Arts Honors, University of Texas at Austin (1997)

Experience

Prevailed in a patent infringement case against Cisco Systems in which client SRI International was awarded \$23.7 million in a jury verdict. The case involved network security technology patent infringement. Among other things, Cisco argued the technology was an abstract idea and thus patent ineligible—the jury disagreed. (*SRI International Inc. v. Cisco Systems, Inc.*, No. 1:13cv1534 [D. Del. May 12, 2016]).

Successfully represented plaintiff Cypress Semiconductor in five IPR proceedings against GSI Technology, obtaining favorable results in each instance. Also represented Cypress in two patent litigation cases involving SRAM memory against GSI, each settled favorably.

Represented Kingston Technology's flash memory card reader technology patents against several challengers, including SanDisk, in patent litigation before various district courts and the ITC. Also successfully represented Kingston at the PTAB in several IPR proceedings. In five years, David has reached a favorable result in every finalized case for Kingston.

Inter Partes Review

Cypress

IPR2014-00121 GSI Technology, Inc. v. Cypress Semiconductor Corporation (Final decision—claims found valid)

IPR2014-00202 GSI Technology, Inc. v. Cypress Semiconductor Corporation (Final decision—claims found valid)

IPR2014-00419 GSI Technology, Inc. v. Cypress Semiconductor Corporation (Non-institution)

IPR2014-00426 GSI Technology, Inc. v. Cypress Semiconductor Corporation (Dismissed by petitioner—claims valid)

IPR2014-00427 GSI Technology, Inc. v. Cypress Semiconductor Corporation (Dismissed by petitioner—claims valid)

Kingston

IPR2016-01621 Kingston Technology Company v. Polaris Innovations Limited (Final decision—asserted claims invalid)

IPR2017-00974 Kingston Technology Company v. Polaris Innovations Limited (Final decision—asserted claims invalid)

IPR2017-00114 Kingston Technology Company v. Polaris Innovations Limited (Final decision—instituted claims invalid)

IPR2017-00116 Kingston Technology Company v. Polaris Innovations Limited (Final decision—asserted claims invalid)

NVIDIA

IPR2017-00381 NVIDIA Corp. v. Polaris Innovations Limited (Final decision—asserted claims invalid)

IPR2017-00901 NVIDIA Corp. v. Polaris Innovations Limited (Final decision—asserted claims invalid)

IPR2017-01500 NVIDIA Corp. v. Polaris Innovations Limited (Final decision—asserted claims invalid)

Lifefactory

IPR2015-00614 Leapfrog Product Development, LLC v. Lifefactory, Inc. (14 of 21 claims found valid)

BME

IPR2015-00786 Wright Medical Technology, Inc. v. Biomedical Enterprises, Inc. (Final decision—claims found valid)

Secured Mobility

IPR2015-01043 Secured Mobility LLC v. Zonar Systems, Inc. (Dismissed pursuant to settlement agreement)

FedEx

CBM2015-00093 FedEx Office and Print Services, Inc. v. CDR Printing LLC (Dismissed after District Court case dismissed)

IPR2015-01134 FedEx Office and Print Services, Inc. v. CDR Printing LLC (Dismissed after District Court case dismissed)

Yodlee

IPR2016-00275 Plaid Technologies, Inc. v. Yodlee, Inc. and Yodlee.com, Inc. (Non-institution)

CBM2016-00037 Plaid Technologies, Inc. v. Yodlee, Inc. and Yodlee.com, Inc. (Non-institution)

CBM2016-00045 Plaid Technologies, Inc. v. Yodlee, Inc. (Non-institution)

CBM2016-00070 Plaid Technologies, Inc. v. Yodlee, Inc. (Non-institution)

CBM2016-00082 Plaid Technologies, Inc. v. Yodlee, Inc. (Non-institution)

CBM2016-00088 Plaid Technologies, Inc. v. Yodlee, Inc. (Terminated—All claims remain valid)

CBM2016-00089 Plaid Technologies, Inc. v. Yodlee, Inc. (Terminated—All claims remain valid)

IPR2016-00273 Plaid Technologies, Inc. v. Yodlee, Inc. (Terminated—All claims remain valid)

CBM2016-00056 Plaid Technologies, Inc. v. Yodlee, Inc. (Terminated—All claims remain valid)

Heil Environmental

IPR2018-00139 The Heil Co. v. Advanced Custom Engineered Systems & Equipment Co. (Final decision—asserted claims invalid)

Patent Litigation

Biomedical Enterprises, Inc. v. Solana Surgical, LLC (Western District of Texas). First chair trial attorney represented plaintiff against Solana in a patent infringement suit involving medical device technology. Settled favorably at trial.

SRI Int'l, Inc. v. Cisco Systems, Inc., 13-1534 (District of Delaware). Represented plaintiff SRI against Cisco in a patent infringement suit involving network security technology. Jury verdict for \$23.7 million.

Twenty-First Century Technologies v. Chicony Electronics, 1:16-cv-00016 (Western District of Texas). Represented defendant in breach of contract suit involving electroluminescent keyboards. Case settled favorably.

STI International v. Double Nickel, LLC, 1:16-cv-00068 (Western District of Texas). Represented plaintiff in declaratory injunction action involving contract related to firearm production. Case settled favorably.

Double Nickle, LLC d/b/a Detonics Defense Technologies v. STI International, 3:16-cv-00181 (Southern District of Illinois). Represented defendant in breach of contract action related to firearm production. Case settled favorably after preliminary injunction hearing.

Graham Springs v. FedEx Office and Print Services, 2:15-cv-912 (Western District of Texas). Represented defendant in patent infringement suit involving copy equipment. Case dismissed by plaintiff prior to answering.

e.Digital v. Spansion, 3:15-cv-00141-H-BGS (Southern District of California). Represented defendant Spansion against e.Digital in a case involving flash memory. Case dismissed by plaintiff.

CDR v. FedEx Office, 2:14-cv-00801-JRG (Eastern District of Texas). Represented defendant FedEx Office against CDR in a case involving online printing. Case dismissed by plaintiff

CATR v. Kingston, 8:14-cv-1352-JLS (Central District of California). Represents defendant Kingston against CATR in a case involving USB memory devices. Case pending.

Via Vadis v. D-Link, 1:14-cv-00812-LY (Western District of Texas). Represented defendant D-Link against Via Vadis in a case involving networking technology. Case settled favorably.

Cypress Semiconductor Corp. v. GSI Technology, Inc., 3:13-cv-02013 & 3:13-cv-03757 (Northern District of California). Represented plaintiff Cypress against GSI in a patent infringement suit involving SRAM memory. Case settled.

Technology Properties Limited, LLC v. Kingston Technology Corp., 6:12-cv-00202 (Eastern District of Texas). Represented defendant in a patent infringement suit against TPL involving flash memory card readers. Case settled favorably.

Uni-Pixel Displays Inc. v. Conductive Inkjet Technology Limited (Montgomery County State Court, TX). Represented plaintiff in a breach of contract action and in a declaratory judgment action involving printed display technology. Case settled favorably.

Innovatio IP Ventures v. FedEx Corp., 1:11-cv-09308 (Northern District of Illinois). Represented FedEx in a patent infringement suit involving wireless network technology. Case settled favorably after bench trial on damages.

Microsoft v. John Doe 1 et al., 1:13-cv-01014 (Western District of Texas). Represented Microsoft in a cyber-crime proceeding against a malicious bot-net operating in Texas and throughout the United States. Case dismissed after international law enforcement involvement against bot-net operators.

Airstrip Technologies, Inc. v. MVISUM, Inc., 1:12-cv-07776 (Southern District of New York). Represented plaintiff Airstrip against MVISUM in a patent infringement suit involving remote medical monitoring technology. Case settled favorably.

CERTAIN COMPUTERS AND COMPUTER PERIPHERAL DEVICES AND COMPONENTS THEREOF AND PRODUCTS CONTAINING THE SAME, 337-TA-841 (International Trade Commission). Lead trial counsel representing respondent Kingston against TPL in suit involving flash memory card readers. Commission found non-infringement of all three patents asserted against Kingston.

MOSAID v. Freescale et al., Case No. 6:11-cv-000173 (Eastern District of Texas). Represented NVIDIA in patent infringement suit filed by MOSAID involving nine patents concerning various aspects of processor operation and design. Case settled favorably.

Semcon Tech v. Texas Instruments Inc., Case No. 12-534 (District of Delaware). Represented defendant TI in patent infringement suit involving chemical mechanical polishing of semiconductors. Case settled favorably.

TQP v Federal Express Corporation, Case No. 2:12-cv-00262 (Eastern District of Texas). Represented Federal Express Corporation in patent infringement suit filed by TQP involving encryption technology. Case settled favorably.

CERTAIN UNIVERSAL SERIAL BUS ("USB") PORTABLE STORAGE DEVICES, INCLUDING USB FLASH DRIVES AND COMPONENTS THEREOF, 337-TA-788 (International Trade Commission). Represented respondents Ritek and Verbatim against Trek in suit involving USB drives. Case resolved favorably before trial.

Integrated Device Technology, Inc. v. Phison Electronics Corp., Case No. CV-10-5168 (Northern District of California). Represented Phison in patent infringement suit involving three patents concerning aspects of on-chip oscillators. Case settled favorably.

SanDisk v. Kingston et al., No. 10-0243-C (Western District of Wisconsin). Represented Kingston adverse to SanDisk in case involving flash memory products. District Court found on summary judgment that Kingston did not infringe asserted SanDisk patents. Case settled favorably.

CERTAIN INTEGRATED CIRCUITS, CHIPSETS, AND PRODUCTS CONTAINING SAME INCLUDING TELEVISIONS, MEDIA PLAYERS, AND CAMERAS, 337-TA-709 (International Trade Commission). Represented complainant against various television manufacturers and retailers. Major parties settled favorably prior to trial.

SanDisk v. Phison et al., Case Nos. 07-0605-C and 07-0607-C (Western District of Wisconsin). Represented Kingston adverse to SanDisk in case involving flash memory products. District judge found on summary judgment that Kingston did not infringe asserted SanDisk patents. Case settled favorably.

Freescale Semiconductor v. Panasonic Corp. et al., 10-CA-138 (Western District of Texas). Represented Freescale Semiconductor in patent infringement suit involving integrated circuit and semiconductor packaging technologies. Case settled favorably.

Freescale Semiconductor v. Panasonic Corp. et al., 10-CA-139 (Western District of Texas). Represented Freescale Semiconductor in patent infringement suit involving semiconductor packaging technologies. Case settled favorably.

U.S. Ethernet Innovations v. Acer et al., 6:09-CV-448 (Eastern District of Texas). Represented NVIDIA in patent infringement case involving Ethernet technology. Case transferred to new counsel after successful change of venue motion.

CERTAIN SEMICONDUCTOR CHIPS HAVING SYNCHRONOUS DYNAMIC RANDOM ACCESS MEMORY CONTROLLERS AND PRODUCTS CONTAINING SAME, 337-TA-661 (International Trade Commission). Represented respondents in investigation concerning various aspects of DRAM memory. Parties settled after trial.

Key Ovation v. Kenesis, 09-CA-144 (Western District of Texas). Represented declaratory judgment defendant in case involving computer keyboards. Case dismissed.

CERTAIN FLASH MEMORY CONTROLLER, DRIVES, MEMORY CARDS, AND MEDIA, PLAYERS, AND PRODUCTS CONTAINING SAME, 337-TA-619 (International Trade Commission). Represented respondents in investigation concerning flash memory products. Commission found non-infringement after a seven-day trial.

Celerity v. Advanced Energy, 07-CA-1037 (Western District of Texas). Represented manufacturer of mass flow converters in patent infringement suit against competitor. Case resolved and dismissed.

CERTAIN RECHARGEABLE LITHIUM-ION BATTERIES, COMPONENTS THEREOF, AND PRODUCTS CONTAINING THE SAME

, 337-TA-600 (International Trade Commission). Represented complainant in investigation involving lithium ion battery technology. Case settled favorably.

Silicon Services Consortium v. Applied Materials, 06-CA-051 (Western District of Texas).

Represented defendant Applied Materials in connection with anti-trust claims and patent infringement counterclaims. Case settled.

Trade Secret

Windrock v. Advanced Machinery Solutions (Southern District of Texas). Represented plaintiff Windrock in a trade secrets matter involving pump monitoring equipment. Attained temporary restraining order and preliminary injunction in favor of Windrock. Case settled favorably for client.

Confidential Matter. Representing a major technology company in connection with an assertion of trade secret theft by new employees

Downhole Technology v. Stormfield Innovative Technology (Southern District of Texas). Represented Defendant Stormfield in matter asserting patent and trade secret related to downhole production equipment. Case settled favorable for client with no finding of trade secret violation.

Other Litigation

OCA-Houston v. State of Texas 1:15-CV-00679 (Western District of Texas). Represented pro bono the Asian American Legal Defense and Education Fund (AALDEF) and other plaintiffs in a case involving limited English proficient voters bringing interpreters to assist at the polls. The Texas law at issue in the case required interpreters to be registered voters. The federal district judge granted AALDEF's motion for summary judgment and enjoined the Texas law due to its' contradiction of the Voting Rights Act, which protects the rights of voters to select persons of their choice to assist them at the polls.

Pro-Bono

Represented the Asian American Legal Defense and Education Fund (AALDEF) and other plaintiffs in a pro bono case involving limited English-proficient voters bringing interpreters to assist at the polls. Texas law, which was ultimately changed due to the lawsuit, required interpreters to be registered voters. The federal district judge said the law was a contradiction of the Voting Rights Act. Fish was subsequently granted \$191,000 in attorneys' fees, which was used to create a new \$100,000 scholarship at the University of Texas School of Law and to make donations to three nonprofit organizations. (*OCA Greater Houston, et al. v. State of Texas, et al.*, No. 1:15cv679 [W.D. Tex. August 1, 2016]).

Represented plaintiff in the case referenced: “Texas voting law on language interpreters violates Voting Rights Act, court says,” *Texas Tribune* (August 17, 2017).

Quoted in “Language Can Be a Barrier at the Polls for Some Asian American Voters,” *Reporting Texas*, November 2016.

Insights

Publications

- “Fish & Richardson Spreads the Wealth With \$191K Fee in Pro Bono Case,” *Texas Lawyer* (October 2019)
- “USPTO Says Its Oversight Makes PTAB Judges Legal,” *Law360* (April 2019)
- “Flash-Drive Maker Tells PTAB Patents Should Be Tossed,” *Law360* (November 2017)
- “Lifefactory Patent on Protective Sleeves for Containers Survives IPR With Most Claims Intact ,” *IPWatchdog* (August 2016)
- “Federal Court Blocks Texas Law Restricting Language Assistance to Voters ,” *AALDEF Press Release* (August 2016)
- “Software Co. Loses IP Review Bid After Late PTAB Petition,” *Law360* (June 2016)
- “Cisco Hit With \$24M Verdict in Network Surveillance IP Row,” *Law360* (May 2016)
- “Biomedical Orthopedic Implant Patent Survives AIA Review,” *Law360* (May 2016)
- “2 Cypress RAM Patents Survive AIA Reviews,” *Law360* (April 2015)

Speaking Engagements

- “Technology Licensing 101,” *ACC San Francisco Bay Area Technology Licensing 101 CLE Event* (April 20, 2022)
- “You Violated Our IP!’ – Prevention Strategies and Responses Every In-House Counsel Should Know,” *ACC San Francisco CLE Presentation* (November 16, 2021)
- “The Two Major Patent Venues that Korean Companies Must Know About – EDTX and WDTX,” (June 17, 2021)
- “It’s 3am, Do You Know Where Your Data Is?” *University of Texas 31st Advanced Technology Law Conference* (May 2018)
- University of Texas Symposium on Patent Damages (June 2016)
- “Recent Developments in Technology Law,” *University of Texas Technology Law Conference* (May 2015)
- “Post-Grant Review Under the AIA: How USPTO Proceedings are Changing Patent Litigation Practice,” *Austin Association of Corporate Counsel December Meeting* (December 2014)

- “Executive Agency Involvement in IP Issues,” *Texas Intellectual Property Law Journal Symposium* (February 2014)
- “Antitrust Update for Patents,” *Advanced Patent Law Institute CLE* (October 2013)
- “Litigation Holds and Spoliation in Light of Rambus,” *Advanced Patent Law Institute CLE* (October 2011)
- “International Patenting and Enforcement,” *State Bar of Texas Advanced Litigation Course* (July 2011)
- “The ITC’s Unique Trial Related Procedures,” *International Trade Commission Trial Lawyers Association, Section 337 Seminar for Chinese Enterprises* (May 2011)

Media Mentions

- “Half-year Data Reveals Western District of Texas’s Rise to Top,” *Managing IP* (August 6, 2020)

Recognition

- Named a “notable practitioner in Intellectual Property,” *Chambers USA: Texas* (2018-2022)
- Named a “Leading Patent Professional” by *IAM Patent 1000* (2021-2022)
- Named a “Rising Star,” by *Super Lawyers* (2013-2015)
- Recipient of the “Judge Suzanne Covington Individual Pro Bono Service Award” (2016, 2018)

Memberships & Affiliations

2014 Member of the Texas Bar Pro Bono College