




# Terry J. Stalford

## Principal

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## Overview

### About Terry

Terry Stalford is a principal in the Dallas office of Fish & Richardson P.C. and is the firm's China Practice Chair. His practice emphasizes U.S. and international patent portfolio development, patent litigation, infringement risk management, and licensing in the software, communications, and energy fields. He also provides general intellectual property counseling on other strategic issues, including patent mapping, patent categorization, and industry benchmarking.

Mr. Stalford's clients are among the top technology companies in the world. He works with his clients to build world-class patent portfolios and navigate complex litigation issues across a wide range of technologies, including wireless communications, telecommunications networks, software, AI and machine learning, blockchain, cloud computing and multi-tenant environments, semiconductors, and energy. At the Patent Trial and Appeal Board, Mr. Stalford has provided oversight for over 90 *inter partes* reviews since 2017. His work on behalf of his clients has been widely recognized; for example, the Patent Scorecard published by the *Wall Street Journal* ranked a patent portfolio that Mr. Stalford built with a small client as one of the strongest in the energy and environmental industries. He also regularly leads public conferences and in-house training events at client sites touching on opinions, licensing, patent prosecution, post-grant proceedings, and patent litigation.

Mr. Stalford is committed to using his practice to improve the lives of others through technological innovation. For the past several years, he has provided pro bono legal representation to Workshops for Warriors, a charitable organization that trains combat veterans for post-military careers in advanced manufacturing, and LIMBS International, which provides affordable, sustainable prosthetic solutions to individuals in developing countries. He also represents financially under-resourced independent inventors and small businesses in U.S. Patent and Trademark Office (USPTO)

proceedings through the Federal Circuit Bar Association's PTO pro bono program.

Before entering the practice of law, Mr. Stalford had a distinguished career in the engineering field. He worked as a process/facility engineer for Hercules, where he programmed the control system for the facility's fully-automated processes, as well as designed the facilities and processes for a \$35-million capital modernization project. He also served as a manager for Hercules, where he set and enforced management policy and ensured safety, production, and quality control.

## Focus Areas

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### **Services**

- IP Licensing, Transactions, and Agreements
- Patent
- Opinions and Strategic Counseling
- Patent Portfolio Management
- Patent Prosecution
- ITC Litigation

### **Industries**

- Cleantech
- Energy and Petrochemical
- Financial and Business Services
- Manufacturing
- Optics
- Semiconductors
- Software
- Standard Essential Patents
- Telecommunications

## Education

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J.D. *magna cum laude*, Order of the Coif, University of Georgia School of Law (1993) Editor, *Journal of Intellectual Property Law*

B.S., Engineering, University of Oklahoma (1986)

## Experience

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Representation of Direct Drive Systems in its sale to FMC Technologies for approximately \$120 million in cash.

Representation of Calnetix Power Solutions in its sale to GE Power Solutions.

*Huawei Technologies Co. Ltd v. T-Mobile US, Inc. and T-Mobile USA, Inc.* (E.D. Tex. 2016) Series of four related cases concerning T-Mobile's infringement of 14 standard essential patents (or SEPs) related to 3GPP/LTE standards for core network equipment, as well as a declaratory judgment case regarding FRAND licensing obligations.

*Nokia Solutions and Networks US LLC and Nokia Solutions and Networks Oy v. Huawei Technologies Co. Ltd. and Huawei Device USA, Inc.* (E.D. Tex. 2016) After successfully obtaining an order severing Nokia's counterclaims from another series of cases, defended Huawei in a series of four related lawsuits brought by Nokia alleging infringement of 9 patents concerning 3GPP/LTE standards for cellphones and tablets.

*NXP v. BlackBerry et al.* (M.D. Fla. 2012) – Represented Defendant BlackBerry (formerly RIM) against six asserted patents involving various technologies, including computer buses, WiFi, and semiconductor manufacturing; argued the Markman hearing that ultimately resulted in three dropped patents and a jury verdict of no infringement, and invalidity of the three remaining patents.

*Cheetah Omni LLC v. Alcatel-Lucent USA Inc. et al.* (E.D. Tex. 2011) – Obtained favorable settlement for Huawei in multi-patent litigation involving optical networking components.

*Summit 6 LLC v. Research In Motion* (N.D. Tex. 2011) – Represented RIM in a patent infringement action related to web-based media submission tools; obtained favorable settlement after Markman ruling.

*In the Matter of Certain Mobile Telephones and Wireless Communication Devices Featuring Digital Cameras, and Components Thereof* (337-703) and *Research In Motion v. Eastman Kodak* (N.D. Tex.

2008) – Represented RIM in multi-jurisdictional dispute, including i) Respondent in ITC investigation where 2 ALJs and the Commission invalidated Kodak’s asserted patent involving camera technology and ii) as a declaratory judgment Plaintiff in a multi-patent infringement action related to camera technology and data integration technology.

Worldwide software company – development and management of a patent portfolio directed to business software solutions, applications, and services.

Major financial software company – development and management of a patent portfolio revolving around financial reporting and outsourcing capabilities to banks and finance companies; counsel in license negotiations, litigation, and due diligence projects.

Global oilfield service company – development and management of a patent portfolio revolving around equipment, systems and processes for drilling and production of oil and gas; license negotiations, and litigation.

Exploration and production company – development and management of a dominant patent portfolio directed toward unconventional resources; counsel in license negotiations, joint development agreements, litigation, and other special projects.

International mobile payment company – strategic advice and patent portfolio development.

International communications company – strategic advice and counsel, litigation, patent portfolio development, post-grant and licensing related to communications, including wireless communications and standard essential patents (SEPs).

International semiconductor company – patent procurement related to semiconductor fabrication, memory, and digital signal processing.

## Insights

### Publications and Presentations

- *Claiming AI in the US and in Europe*, client presentation, Shenzhen, China and Hangzhou, China (September 2019)
- *Foreign Intellectual Property Rights*, Hangzhou Future Sci-Tech City (STC), Hangzhou, China, September 2017.
- *Reducing Risk from Patent Litigation in the USA*, Shenzhen IP Bureau, Shenzhen, China, 2015.
- *How to Hold the Value in Your Portfolio as US Law Erodes Patent Scope and Raises Bars to Enforcement*, TexasBarCLE 11th Annual Course Advanced Patent Litigation, Texas, July 2015.
- “Rainmaker Q&A: Fish & Richardson’s Terry Stalford,” *Law360*, August 29, 2013

- *Innovation and Intellectual Property: China and the United States*, Federal Circuit Bar Association International Series, Renmin University, Beijing, China, 2012
- *Working Effectively With the United States Patent and Trademark Office*, Las Vegas, NV, March 2007.
- *Intellectual Property: Uses and Safeguards*, Executive MBA program, Business School of Centenary College, Shreveport, LA, April 2006.
- *Comments on the USPTO Rule Proposals Published January 3, 2006*, Japan, May 2006.
- *Opinions of Counsel*, United States Patent Law and Litigation, Munich, Germany (December 2005)
- *Patent Reform and Legislative Changes on the Horizon: What You Need to Know About the Changing Patent Process & IP Protection*, Dallas, Texas (October 2005)
- *Standardization in Optical Networking, United States Patent and Trademark Office Technology Fair* (June 2003)

## Recognition

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- Named to “The Best Lawyers in America” list by *The Best Lawyers in America*© (2021-2022)
- Named a “Leading Patent Professional” by *IAM Patent 1000* (2021)
- Named a “Texas Trailblazer,” *Texas Lawyer* (2019)
- Recognized in *The National Law Journal*, Trailblazers Energy & Environmental (2017)
- Recognized in *IAM Patent 1000, Texas, Prosecution* (2014-2020)
- Named a Texas “SuperLawyer,” (2012-2018)