

BRIAN A. CARPENTER

Brian has 30+ years of experience in patent and other commercial litigation. He has appeared in at least four hundred lawsuits most of which were patent cases. In addition to trial experience, Brian has argued before the Federal and Fifth Circuit Courts of Appeal. He has been a shareholder in one of the largest law firms in the country, Greenberg Traurig, as well as a founding member of a patent litigation boutique firm. His clients have ranged from large corporations, such as Fujitsu, JC Penney, and VIA Technologies, to individual inventors. Brian is a hands-on attorney who enjoys writing major briefs and taking deep dives into the documents. In addition to his first-rate litigation skills, he is also particularly adept at quickly coming up to speed and deeply understanding sophisticated technologies such as wireless protocols (e.g., Bluetooth and 802.11), computer and computer chip architectures, network architectures and components (e.g., routers, data storage, load balancers, and caching servers), and telecommunications systems (3G, 4G, and LTE). His genuine understanding of the technology in a patent case enables Brian to quickly isolate the core material issues and formulate a cost effective and winning litigation strategy. But understanding technology is not enough, and the rarer trait, which Brian has in abundance, is the ability to teach the material aspects of a complex technology to non-technical people. Patent litigation is a team sport. “Quarterbacking” a litigation team to win is one of Brian’s many talents. For example, in 2015, Brian managed four different monetization programs involving at least sixteen separate lawsuits. Brian has a keen eye to developing talented associates and enjoys mentoring them as a way of giving back to the profession.

In addition to his litigation skills, Brian obtained his certification as an Information Privacy Professional (CIPP) from the International Association of Privacy Professionals in 2017 and is knowledgeable regarding cybersecurity and privacy issues. Transactional experience includes licensing, patent prosecution, post-grant proceedings, and performing IP due diligence in connection with corporate acquisitions.

Education

- J.D., with honors, The University of Texas School of Law, 1991.
- B.S. Mechanical Engineering, *summa cum laude*, Texas A&M University, 1986.

State Bar and Court Admissions

- Texas, 1991; Colorado, 1995; California, 2009; New York, 2020.
- U.S. Patent and Trademark Office, 1993; Registration No. 37,109.
- Numerous U.S. District Courts, including but not limited to the District of Colorado, the Eastern, Western, Southern, and Northern Districts of Texas, the Northern and Central Districts of California, and the Eastern District of Michigan.
- U.S. Courts of Appeal for the Federal Circuit, Fifth Circuit, and Tenth Circuit.

Representative Hobbies and Interests

- Tennis, biking, skiing, photography, and history.

Employment History

- Partner, *Carstens & Cahoon, LLP*, July 2020 - Present
- Member, *Buether Joe & Carpenter, LLC*, 2010 – July 2020
Dallas, Texas
- Shareholder, *Greenberg Traurig*, 2003 – 2010
Denver, Colorado (2003 – 2009)/Dallas, Texas (2009 – 2010)
- Of Counsel, *LeBoeuf Lamb Greene & MacRae*, 2000 - 2003
Denver, Colorado
- Associate, *Holme Roberts & Owen*, 1998 – 2000
Denver, Colorado
- Associate, *Hall & Evans*, 1996 – 1998
Denver, Colorado
- Associate, *Dorr, Carson, Sloan & Birney*, 1994 – 1996
Denver, Colorado
- Associate, *Vial, Hamilton, Koch & Knox*, 1991 – 1994
Dallas, Texas
- Research Engineer, *Southwest Research Institute*, 1986 – 1988
San Antonio, Texas
- Intern, *IBM*, Summer 1985
Austin, Texas
- Intern, *Texas Instruments*, Summer 1984
Stafford, Texas

Partial Listing of Significant Representations

- Presently representing the patent owner in a lawsuit against Pandora Media, LLC to enforce patents concerning a complex, networked system for streaming media that includes the generation of playlists based on stored ratings. Case was filed in the W.D. Texas in 2020 and was recently transferred to the N.D. California. See *In re Pandora Media, LLC*, 2021 U.S. App. LEXIS 30963; *Bluebonnet Internet Media Servs., LLC v. Pandora Media, LLC*, 2021 U.S. Dist. LEXIS 137400.
- Presently representing the inventor and patent owner in a lawsuit against the manufacturer of well-known power tool brands sold at Home Depot and Walmart to enforce patents directed to an improved line trimmer head. The case is pending in the D. Delaware. See Civil Action No. 1:21-CV-00853-MN.
- Represented patent owner in a lawsuit against Apple involving patent claims directed to system including a short-range, low power wireless communications protocol that cover Bluetooth devices such as a wireless keyboard and mouse. *E.g., DSS Tech. Mgmt. v.*

Apple, Inc., 885 F.3d 1367 (Fed. Cir. 2018); 845 Fed. Appx. 963 (Fed. Cir. 2021).

- Represented Advanced Media Networks, LLC in lawsuits in the N.D. Texas and D. Delaware to enforce its patent against AT&T, Verizon, T-Mobile, Sprint, U.S. Cellular, Chrysler, and Audi among others. The patent concerned a mobile hub station that transferred information between a telecommunications network and a local area network using the Internet Protocol. See, e.g., *Advanced Media Networks, LLC v. AT&T Mobility LLC*, 748 Fed. Appx. 308 (Fed. Cir. 2018). Also, prepared briefs in connection with several IPRs filed by defendants.
- Successfully completed patent assertion program by Parallel Networks, LLC against manufacturers of load balancers and caching servers in a set of lawsuits brought before Judge Stark in the D. Delaware. The asserted patent covered hardware and associated software that allowed intermediate caching of dynamic webpage content by a transformation of the URL header information.
- Represented Parallel Networks, LLC against numerous gaming companies asserting patent claims directed to peer-to-peer caching. Most settled in client's favor. Several defendants did not. See, e.g., *Parallel Networks, LLC v. KOG Games, Inc.*, 2016 U.S. Dist. LEXIS 117853 (D. Del. 2016) (J. Andrews); 2018 U.S. Dist. LEXIS 95845.
- Represented Parallel Networks, LLC, being engaged after an appeal and remand, to argue additional claim construction and defend against summary judgment in lawsuits against numerous retailers as to patents directed to applets on a website. The court denied summary judgment as to some and granted it as to others. See *Parallel Networks, LLC v. Abercrombie & Fitch*, 2014 U.S. Dist. LEXIS 190190 (E.D. Tex. 2014). Subsequently, all remaining defendants settled in client's favor.
- Lead trial counsel representing VIA Technologies, Inc. in *Opti, Inc. v. Via Technologies, Inc.*, Case No. 2:10-CV-00279 in the E.D. Texas before Judge Gilstrap. Opti requested \$39 million; the jury awarded \$2.1 million. See, e.g., 2014 U.S. Dist. LEXIS 120695; 2014 U.S. Dist. LEXIS 106695; 2013 U.S. Dist. LEXIS 116923; 2012 U.S. Dist. 180834. The patent at issue concerned a method for pre-snooping the CPU cache memory prior to a transfer of data from main memory to the databus of a personal computer. Presented oral argument before the Federal Circuit. Judgment affirmed. See 636 Fed. Appx. 800.
- Negotiated favorable settlement for InFocus, Inc., in arbitration involving software purchased from an assignee for the benefit of creditors.
- Brought patent infringement suit on behalf of Terraspark Geosciences, LLC, against Paradigm, B.V. *et al.* in the S.D. Texas to protect Terraspark's patented technology relating to 3-D seismic interpretation software used in oil and gas exploration.
- Represented inventor James M. Taylor against IBM in a patent infringement suit brought in the E.D. Texas before Judge Davis. Mr. Taylor invented a highly sophisticated software tool that optimized object code. Presented oral argument in *Markman* hearing. See 2012 WL 12844020. Case settled favorably shortly before trial.
- Defended J.C. Penney Corp., Inc., in suit brought by Eolas Techs., Inc., in the E.D. Texas accusing webpages that utilized Adobe's Flash software. The asserted patents were invalidated by a jury after a bifurcated trial on validity. See, e.g., *Eolas Techs., Inc. v. Adobe Sys. et al.*, 2012 U.S. Dist. LEXIS 13643; 891 F. Supp. 2d 803.
- Represented Brookstone Company, Inc., and VF Outdoor, Inc., defendants in *David A. Tropp v. Conair Corporation, et al.*, Civil Action No. 08-CV-4446, in the S.D. New York.

The accused devices were travel locks opened by key provided to TSA. See, e.g., 2012 U.S. App. LEXIS 78 (Fed. Cir. 2012).

- Represented StoneAge, Inc., an employee-owned company that manufactures rotary hydraulic pipe cleaning tools used in refineries and power plants, as the plaintiff against NLB Corporation, and as the defendant in a lawsuit brought by HydroChem, LLC.
- Represented VIA Technologies, Inc. (Taiwan) and several subsidiaries to favorably resolve litigation brought by Phillip M. Adam and AFTG-TG, LLC by obtaining a dismissal in the D. Wyoming for lack of jurisdiction and simultaneously filing a separate lawsuit for declaratory judgment in the N.D. California. See 422 Fed. Appx. 884 (Fed. Cir. 2011) (which was after VIA settled).
- Represented Hon Hai Precision Industry Co., Ltd. and Foxconn Electronics, Inc., as plaintiffs against Molex, Inc., in the N.D. Illinois alleging breach of a license agreement, tortious interference with prospective economic advantage, deceptive business practices, commercial disparagement, and anticompetitive conduct constituting antitrust violations under the Sherman Antitrust Act. See 2009 WL 310890.
- Defended Techmedica Health, Inc. in a patent infringement action brought by Mannatech, Inc. in the N.D. Texas concerning a patent for a nutritional supplement. See, e.g., 2009 WL 3614359.
- Prepared and filed *Ex Parte* Reexamination Request No. 90/008,506 concerning U.S. Patent 4,733,159 for a Charge Pump Voltage Regulator on behalf of defendant Remy Inc. in litigation in the E.D. Texas concerning the same patent. 2:06-cv-00345-DF. Negotiated settlement after conclusion of the reexamination.
- Represented VIA Technologies, Inc., a defendant in *Opti, Inc. v. Advanced Micro Devices, Inc. et al.*, Civil Action No. 2:07-CV-278, in the E.D. Texas. Presented oral argument in *Markman* hearing. See 2009 U.S. Dist. LEXIS 68378. The accused devices were South Bridge Chips for a personal computer, and, more particularly, the low pin count (LPC) databus for peripheral devices. Negotiated favorable settlement shortly before trial.
- Defended Best Western International, Inc. in lawsuit brought by Linksmart Wireless Tech., LLC for alleged infringement by the use of internet routers and switches to provide wireless internet services in hotels. See, e.g., *Linksmart Wireless Technology, LLC v. T-Mobile USA, Inc. et al.*, 2010 WL 26450402 (E.D. Tex. 2010).
- Represented Fujitsu America, Inc. as the defendant in two separate patent lawsuits brought by ACQIS and Affinity Labs in the E.D. Texas.
- Represented Protective Optics, Inc., defendant in *Panoptx, Inc. v. Protective Optics, Inc.*, Civil Action No. 06-7610, in the N.D. California. Argued and won summary judgment declaring all claims of the asserted patent invalid. 2007 WL 3344453 (N. D. Cal. 2007) (J. Patel). See also related case *Protective Optics, Inc. v. Panoptx, Inc.*, 458 F. Supp. 2d 1053 (N.D. Cal. 2006) (J. Breyer) (*Markman* order); 2007 U.S. Dist. LEXIS 83462; 2007 WL 963972; 488 F. Supp. 2d 922. The accused devices were sunglasses.
- Presented oral argument in claim construction hearing and participated in trial representing Directed Electronics, Inc., defendant in Civil Action No. 6:05-cv-113, M.D. Florida. Obtained ruling of indefiniteness invalidating approximately 100 claims across numerous patents concerning automotive sensors and a serial databus. See Dkt. 207 (referenced in 2007 U.S. Dist. LEXIS 110697).
- Represented Gateway, Inc., defendant in *Adams v. Gateway, Inc.*, Civil Action No. 2:02-

CV-106, in the D. Utah. The case concerned the alleged infringement of a patent for a software patch for an I/O controller in a personal computer. Matter settled after trial began.

- Represented Curotto Can Co., defendant in *The Heil Co. v. Curroto Can Co.*, Civil Action No. 04-1590, before Judge Chesney, N. D. California. The plaintiff stipulated to summary judgment after Court construed claims in Curotto Can's favor. The patent concerned the waste receptacle of a garbage truck. Authored appellate briefs, and Federal Circuit affirmed *per curiam*. See 2004 U.S. Dist. LEXIS 23618; 2004 U.S. Dist. LEXIS 5183.
- Represented The Gates Rubber Company and Trico Products Corp. in a patent infringement suit brought by the patentholder in the S.D. Florida involving a patent for a wiper blade. Case settled favorably on eve of trial. See, e.g., 2004 WL 5677004.
- Obtained settlements for Brookstone Company, Inc., in several cases brought by Sharper Image involving electrostatic air purifiers in the N.D. California.
- Negotiated a \$32 million settlement for Fischer Imaging Corporation, the third largest settlement in a patent infringement case in 2002, which concluded litigation that began in 1992. Fischer owned a patent for a stereotactic breast biopsy machine.
- Assisted Teradata, Inc. in monetizing a portfolio of patents previously acquired from AT&T concerning datamining.
- Represented Gemstar-TV Guide in several lawsuits brought by Echostar concerning set-top box technology. See 1:00-cv-02440; 1:01-cv02426, D. Colorado.
- Represented Florida Power Corporation, a defendant in *Dow Chemical Co. v. Florida Power Corp. et al.*, Civil Action No. 6:00-cv-437, in the M.D. Florida. See e.g., 264 F. Supp. 2d 1018. The patent concerned a water injection system for gas turbines.
- Assisted in a bench trial on damages and validity after obtaining partial summary judgment on infringement for the owner of a patent for an active vibration isolation system. *Technical Manufacturing Co. v. Integrated Dynamics*, 1:99-cv-11362, D. Mass.
- Represented plaintiff in patent infringement lawsuit against competitor concerning a GPS device. *Navsys Corp. v. Snaptrack, Inc.*, 1:00-cv-00245, D. Colorado.
- Litigated on behalf of the owner of eight patents covering computer tape back-up drives. See *Ecrix Corp. v. Exabyte Corp.*, 95 F. Supp. 2d 1155 (D. Colo. 2000).

Awards and Recognition

- AV® Preeminent, Rated 5.0 out of 5.0, See <https://www.martindale.com/dallas/texas/brian-andrew-carpenter-300224-a/>.
- Recognized as "Super Lawyer" in Intellectual Property Litigation by Thomson Reuters.

Publications & Speaking Engagements

- Possible Limit on the Use of "Common Sense" to Invalidate a Patent Claim for Obviousness Based on a Single Reference, March 26, 2021, <https://cclaw.com/insights/>.
- Overview of Current Claim Construction Practice in View of *Phillips*, Patent Claim Construction: The Advanced Legal Forum, West Legalworks, March 6, 2008.
- Legal and Regulatory Issues for IP, IP Portfolio Management Conference, West Legalworks, November 12, 2007.