



## → 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.

*"James goes above and beyond to help his clients, and provides sound advice and an excellent work product."*

- IAM 2023 (client feedback)

### 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 advised on the establishment of a large number of successful corporate patent programs. He also 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.

## Articles

- "Generative AI and Patent Considerations – Part Two," June 20, 2023 (first published in *The Intellectual Property Strategist / ALM law.com*)
- "Generative AI and Patent Considerations – Part One," June 7, 2023 (first published in *The Intellectual Property Strategist / ALM law.com*)
- "Artificial Intelligence And Subject Matter Eligibility In U.S. Patent Office Appeals – Part Three Of Three," September 8, 2021 (first published in *The Intellectual Property Strategist / ALM law.com*)
- "Artificial Intelligence And Subject Matter Eligibility In U.S. Patent Office Appeals – Part Two Of Three," September 1, 2021 (first published in *The Intellectual Property Strategist / ALM law.com*)
- "Artificial Intelligence And Subject Matter Eligibility In U.S. Patent Office Appeals – Part One Of Three," August 25, 2021 (first published in *The Intellectual Property Strategist / ALM law.com*)
- "Alice and Incongruity In PTAB Appeals," October 1, 2020 (first published in *The Intellectual Property Strategist / ALM law.com*)
- "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*

## Healthcare Law Blog Posts

- "Recent Patent Trial and Appeal Board Approaches to Patent Claims on Medical Technology Implementing AI," February 13, 2024

- "Medical Technology – Recent Decisions at the Federal Circuit and the Patent Trial and Appeal Board," November 10, 2023

## 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

Volunteer, Cupertino Union School District Wellness Committee

Volunteer, St. Simon Parish

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

## Industries

Artificial Intelligence

## 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