



Tony D. Chen

Attorney At Law
Patent Attorney

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PRACTICE

Mr. Chen represents both U.S. and international clients in numerous federal district and California state courts, and the U.S. International Trade Commission (ITC). He is registered to practice before the United States Patent and Trademark Office (PTO) and has obtained many hundreds of patents for his clients. He was a partner for many years at top tier international law firms.

Mr. Chen specializes in intellectual property and business law matters. His practice includes patent prosecution and evaluation, trademark and copyright registration, technology transfer and licensing, misappropriation of trade secret and unfair competition claims, corporate affairs, business and commercial transactions, contract and trade disputes, and all related litigation.

Mr. Chen has a broad educational background in both theoretical and applied physics as well as extensive experience in mechanical and electrical engineering and computer-related technologies. He was a research assistant at the Beijing Institute of Technology, working on several projects involving computer and automated-machinery technologies. He spent two years as an engineer for a computer manufacturer where he worked on many different types of computer systems and developed several software programs for database management and data-processing applications using various advanced computer languages. He was also involved in aerospace research programs funded by National Aeronautics and Space Administration (NASA) in his two years at the Denver Research Institute of University of Denver, Colorado.

Mr. Chen is very active in Southern California Chinese-American business communities and has served as outside counsel of many Far East-based companies.

Mr. Chen reads and writes Chinese and is fluent in Mandarin.

EDUCATION

J.D., Loyola Law School, 1994

M.S., California State University at Northridge, 1986

B.S., Peking University, 1982

ADMISSIONS

California

U.S. District Courts, Central, Northern, Southern and Eastern Districts of California

U.S. Court of Appeals, Ninth Circuit and Federal Circuit

U.S. Patent and Trademark Office

LEGAL EXPERTISE

Mr. Chen specializes in intellectual property (IP) law, which primarily includes patent, trademark and copyright law. His professional legal services include:

- Analyzing patentability of new inventions
- Filing and prosecuting U.S. and other foreign patent applications
- Studying validity of issued patents
- Filing for and obtaining U.S. trademark and copyright registrations
- Preparing and negotiating technology licensing and assignment agreements
- Litigating IP infringement claims
- Litigating misappropriation of trade secret and unfair competition claims
- Handling U.S. International Trade Commission (ITC) investigations

Mr. Chen's practice also includes many aspects of business law matters, including contract, corporate affairs, commercial transactions and trade disputes. He provide legal expertise in:

- Establishing new businesses (corporations, partnerships, joint ventures, *etc.*)
- Drafting, reviewing and revising corporate documents and business contracts
- Counseling negotiations of business transactions
- Preparing confidentiality, nondisclosure and non-circumvention agreements
- Protecting trade secrets and proprietary business information
- Litigating disputes arising out of commercial transactions and business contracts

TECHNICAL EXPERTISE

Mr. Chen has obtained many hundreds of U.S. and international utility and design patents for his clients in a wide range of technology fields, including:

- Automated mass-production machinery
- Automobile, bicycle and motorcycle parts and accessories
- Clothing, shoes, jewelry and cosmetic merchandise
- Computer hardware devices and software programs
- E-commerce and online system and process
- Environmental waste recycling and recovery processes
- Farming and gardening tools
- Hi-fidelity signal processing circuitry and electronic apparatus
- Electrical and electronic home appliances
- Household consumer products
- Industrial scale air and water-treatment apparatus and procedures
- Internet, computer network and telecommunication technologies

- Medical and therapeutic instruments and equipment
- Personal safety and health care devices
- Portable and multiple-mode security alarm systems
- Sports and exercise equipment
- Structural and mechanical system for aerospace applications
- Valuable and/or rare earth metal separation and recovery methods

REPRESENTATIVE MATTERS

For patent owners — Helped patent owners enforcing their rights by obtaining injunctions and negotiating favorable settlements and licensing agreements

For technology and trade companies — Provided consultation to clients in patent disputes by conducting patent validity and infringement analysis, providing “freedom to operate” opinions, assisting “designs around” to avoid infringement, , assessing economic value of litigation and exploring alternative dispute resolutions

for manufacturers and distributors — Obtained quick and economic resolutions in various patent, trademark and copyright infringement defense cases

For consumer electronic-product developers — Advised consumer-electronic product developers in establishing patent portfolios and negotiating strategic alliances with major software providers in order to develop software application programs

For business owners — Represented business owners in contract, product liability and labor disputes, unfair competition and misappropriation of trade secret claims

REPRESENTATIVE CASES

Patent infringement action — Represented an air conditioner safety component manufacturer in a federal district court action and successfully defended the patent infringement claims, resulted in plaintiff’s dismissal of the case.

Patent infringement action — Served as litigation counsel in a federal district court action for a Fortune 500 national movie-rental chain which was sued on a business method patent for subscription based online movie rental (the case was successfully settled after expert discovery and filing of a summary judgment motion).

Declaratory judgment action — Represented an electrical safety product producer in a declaratory judgment action on patent infringement and validity claims and obtained favorable settlement after issuance of a claim construction order.

Complex litigation on unfair competition — Served as litigation counsel for a Fortune 500 global food and beverage company in action pending in the Complex Litigation Department of California State Court for its U.S. unfair competition claims as part of a global multi-jurisdictional legal action

Patent infringement action — Represented a furniture manufacturer to defend a patent infringement claim in federal district court and successfully settled the case.

ITC Sec. 337 Investigation — Represented Chinese electrical product manufacturer and its U.S. distributors in a U.S. International Trade Commission (ITC) Section 337 investigation on alleged patent infringement claims by a U.S. manufacturer.

Consumer product liability class action — Served as counsel for a consumer product manufacturer in a class action which was settled shortly before trial.

Breach of contract action — Represented small business owner in breach of contract, misappropriation of trade secret and unfair competition action against rogue former employee and successfully obtained speedy recovery of business loss.

FINRA arbitration — Service as counsel for a security brokerage firm to arbitrate a dispute with its former representatives involving private placement and venture capital investment projects in the United States and Asia.

HONORS

Super Lawyers, Southern California (2009)

Super Lawyers, Southern California Rising Stars (2005)

MEMBERSHIPS

Member, American Bar Association (ABA)

Member, Los Angeles County Bar Association (LACBA)

Member, American Intellectual Property Law Association (AIPLA)

Member, Los Angeles Intellectual Property Law Association (LAIPLA)

Board member, Chinese CEO Organization