



Jim Warriner, CIPP

Special Counsel

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Jim brings more than a decade of legal experience to Marshall Gerstein's Electrical & Computer Technologies Group. He has experience handling patent litigation and patent prosecution matters. Prior to his legal career, Jim worked on computer networking and information security systems for Ford Motor Company, Symantec Corp., and TruArx, Inc. He is a Certified Information Privacy Professional.

Jim has been recognized as a Texas Rising Star within IP Litigation by Thomson Reuters.

When not counseling clients, Jim enjoys bicycling, hiking, canoeing, and riding motorcycles.

Practices

- Patent Prosecution

Industries

- Electrical & Computer Technologies

Representative Experience

Jim litigates, prepares, prosecutes, and manages patent portfolios for technologies such as network security, Wi-Fi, telecommunication, Bluetooth, semiconductors, microprocessors, and content caching. Jim is also experienced in all phases of intellectual property litigation, including pleadings, discovery, summary judgement, and trial.

Jim's background in intellectual property and patent prosecution counsel includes:

- Drafted patent applications and responses to office actions in electronics, computer, laboratory testing, and medical device technologies.
- Conducted interviews with patent examiners to obtain guidance on pending patent applications.

- Drafted inter partes review petitions and patent owner responses in LED lighting, mobile tracking device, proxy server, telemedicine, semiconductor, robotics, Bluetooth, and power over Ethernet technologies.
- Drafted freedom to operate opinions and infringement opinions in semiconductor manufacturing, life insurance, and smartphone technologies.
- Interviewed clients' engineers to understand inventions in hardware, software, and other technologies.
- Reviewed clients' source code, circuit schematics, and other technical documents.
- Won summary judgment and subsequent Federal Circuit appeal invalidating all asserted claims as unpatentably abstract in a case regarding a business method patent.
- Won summary judgment of non-infringement for all asserted claims in patent infringement case relating to content caching network appliances.
- Drafted motion for summary judgment of non-infringement and obtained favorable settlement for client involving Wi-Fi hotspots.
- Drafted claim construction briefs in Wi-Fi, Bluetooth, LED lighting, and retractable roof cases.
- Evaluated patent portfolio of client's competitor using patent analytics tool.
- Helped obtain a favorable outcome for client in antitrust cases involving cellular technology.
- Argued claim constructions for a Bluetooth-related patent at Markman hearing.
- Deposed and defended fact and expert witnesses.
- Won motion to dismiss for lack of personal jurisdiction for pro bono client.

Background and Credentials

Prior to joining Marshall Gerstein, Jim was an attorney at global law firms where he focused his practice on inter partes review petitions, appellate briefs, freedom to operate opinions, patent applications, and patent infringement. After obtaining his J.D. from The University of Texas School of Law, Jim was a Judicial Clerk for the Honorable Chad Everingham in the United States District Court for the Eastern District of Texas – one of the country's busiest patent litigation dockets. Jim obtained his B.S. in Electrical Engineering and Computer Science from Duke University. After graduating from Duke University, he joined Ford Motor Company and also worked for TruArx Inc. and Symantec Corp. before attending law school.

In 2021, Jim became a Certified Information Privacy Professional.

Education

- University of Texas School of Law (J.D., *with high honors*)
- Duke University (B.S.)
 - Electrical Engineering & Computer Science

Bar Admissions

- Texas
- U.S. Patent and Trademark Office

Publications and Presentations

- "Measuring The Success Of Motions To Stay Pending IPR," *Law360*, June 6, 2017.
- "Practical E-Discovery Issues," Contributor, *The Advocate*, Summer 2010.