



Ya-Chiao Chang

Partner

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Ya-Chiao draws on his training as an electrical engineer and two decades of legal experience to help his clients fully understand the issues at hand in patent disputes and achieve their business goals through patent litigation. He was previously a founding partner of the Beijing office of one of the world's largest law firms, having extensive experience working with multinational Chinese companies and global clients to resolve high-stakes intellectual property disputes in China and the United States.

Ya-Chiao is a partner in Winston's Shanghai office and senior IP advisor to Yuanda China Law Offices, Winston's strategic alliance partner in Shanghai. Ya-Chiao has over 25 years of experience representing multinational corporations in a broad range of complex intellectual property matters, with a focus on U.S. patent litigation. He regularly advises on Chinese IP matters and is particularly experienced in defending Taiwanese and mainland Chinese clients in high stakes U.S. IP litigation and resolving patent disputes around the world.

In addition, Ya-Chiao advises clients on injunctive relief, trial, claim construction, customs enforcement, post-trial proceedings, arbitration of patent disputes on Amazon.com, industry standards (IEEE 802.11, MPEG, GSM, and CDMA), patent misuse and exhaustion, reasonable and nondiscriminatory (RAND) royalty, unfair competition, trade secrets, and proceedings before the United States Patent and Trademark Office. His experience ranges from

wireless communications, integrated circuit design, digital TV, semiconductors to liquid crystal display, and other technologies.

Ya-Chiao served as the co-founding partner and chief registered representative of the Beijing office of one of the world's largest law firms. He was previously a patent examiner at the United States Patent and Trademark Office.

Key Matters

Some of the experience represented below may have been handled at a previous firm.

- Represented Advanced Micro-fabrication Equipment Company Ltd. (AMEC) in administrative proceedings and 28 U.S. Code §2201 declaratory judgment action (D. D.C.) (unfiled).
- Represented Amazon.com online merchants in Utility Patent Neutral Evaluation (UPNE) in patent arbitration, 35 U.S. Code §299 joinder and 28 U.S. Code §2201 declaratory judgment action (N.D. Ga.) (unfiled).
- TCL in inter partes review (unfiled) and *Vista Peak Ventures v. TCL Corp. et al.* (E.D. Tex.) cases no. 19-cv-188; 19-cv-189; 19-cv-190; 19-cv-191; *Semcon v. TCT Mobile et al.* (E.D. Tex.) cases no. 18-cv-194 and *ex parte* review (unfiled); *Anton Innovations Inc. v. TCL et al.* (C.D. Cal.) 17-cv-02077; Shanghai IP Court (2020) hu 73 zhi min chu 532; *ACT v. TCL et al.* (Shanghai IP Court) (2019) hu 73 zhi min chu 255; hu 73 zhi min chu 256; hu 73 zhi min chu 257; (2020) hu 73 zhi min chu 1205; hu 73 zhi min chu 1206; hu 73 zhi min chu 1207; hu 73 zhi min chu 1353; hu 73 zhi min chu 1354; hu 73 zhi min chu 1355.
- Defended Hisense Co. Ltd. et al. in *Vista Peak Ventures LLC v. Xianyang Caihong Optoelectronics Co. Ltd. et al.* (E.D. Tex.) cases no. 21-cv-260; 21-cv-262; 21-cv-263.
- Certain Does in *General Tools Instruments v. Does 1-2092* (N.D. Ill.) case no. 19-cv-02519 and removal of temporary restraining order (TRO).
- Foxconn and Gigabyte Technology in IPR2018-00325 and IPR2018-00326.
- Giantplus Technology in *inter partes* review (IPR2019-01633, unfiled) and *Vista Peak Ventures v. Giantplus Technology* (E.D. Tex.) cases no. 19-cv-183; 19-cv-184; 19-cv-185; 19-cv-187.
- Actions Semiconductor in *SigmaTel vs. Actions* (W.D. Tex.; ITC 538).
- BenQ America in *Compression Labs vs. Acer et al.* (E.D. Tex.) case no. 04-cv-294.
- Chi Mei Optoelectronics in *Plasma Physics et al. vs. Chi Mei Optoelectronics et al.* (E.D. N.Y.) case no. 08-cv-01628, *LG Philips LCD vs. Chi Mei Optoelectronics* (D. Del.), and *Semiconductor Energy Laboratory v. Chi Mei Optoelectronics* (N.D. Cal.) case no. 04-cv-04675.
- Compal Electronics in *Via Licensing vs. Compal et el.* (N.D. Cal.) case no. 16-cv-01409.
- Dell in a Chinese company's patent assertion in China and in Taiwin's patent assertion in Taiwan (*Taiwin Electronics vs. Dell*).
- Gigabyte and GBT in *PACid vs. Asustek et al.* (E.D. Tex.) case no. 10-cv-108.
- HannStar Display, Hannspree and Proview Technology in *Semiconductor Energy Laboratory vs. HannStar et al.* (E.D. Tex.) case no. 06-cv-190.
- Huga Optotech in *Rothschild vs. Huga* (ITC 640).
- Lite-On in *Guardian Industries vs. Dell et al.* (D. Del.) case no. 05-cv-27.
- MediaTek in *Rambus vs. MediaTek* (N.D. Cal.; ITC 753).
- MediaTek and its subsidiary Ralink in a United States ITC investigation initiated by LSI Corporation and Agere Systems Inc. (no. 337-TA-837).

- MSI and ViewSonic in *Positive Technologies vs. Sony et al.* (E.D. Tex.) case no. 10-cv-263.
- Nokia in *Qualcomm vs. Nokia* – acted as lead patent counsel and international counsel to Nokia in patent infringement suits brought by Qualcomm in Asia.
- Primax in *Microsoft vs. Primax* (ITC 654).
- Proview Technology and VIZIO in *Positive Technologies vs. BenQ America et al.* (E.D. Tex.) case no. 07-cv-67.
- System General in *Power Integrations vs. System General* (N.D. Cal.) case no. 04-cv-02581 and ITC 541.
- Taiwan Semiconductor Manufacturing Company Ltd. (TSMC) in a United States International Trade Commission (ITC) investigation initiated by Tela Innovations Inc. (no. 337-TA-906), and *University of New Mexico vs. TSMC et al.* (ITC 729).
- Tating in *Mondis vs. LG et al.* (E.D. Tex.) case no. 07-cv-565 and *Guardian Media Technologies vs. Acer et al.* (E.D. Tex.) case no. 10-cv-676.
- TPK Touch Solutions in *In Re HTC et al.* (N.D. Cal.) case no. 16-mc-80193 under 18 U.S. Code § 1782 foreign discovery assistance to O-Film v. TPK (Nanchang Intermediate Court, China).
- United Microelectronics Company Ltd. (UMC) in third party discovery in *Godo Kaisha IP Bridge 1 v. Xilinx, Inc.* (E.D. Tex.) case no. 17-cv-100.
- ViewSonic in a patent infringement case (S.D. Fla.) filed by Zenith Electronics LLC, Panasonic Corporation, U.S. Philips, and Columbia University (case no. 9:13-cv-80570), two patent infringement cases (E.D. Tex.) respectively filed by E-Contact Technologies LLC (case no. 12-cv-352) and Lochner Technologies LLC (no. 11-cv-395), as well as *Advanced Display Technologies vs. ViewSonic et al.* (E.D. Tex.) case no. 11-cv-00011 and *Ogma vs. ViewSonic et al.* (E.D. Tex.) case no. 11-cv-277.
- ViewSonic, Nuvoton and Realtek in *Sony vs. ViewSonic et al.* (C.D. Cal.) case no. 09-cv-07698 and ITC 713.
- Vivitek in *Ogma vs. Nintendo et al.* (ITC 773).
- Wintek in *Honeywell vs. Apple et al.* (D. Del.) case no. 04-cv-01338.
- Xilinx in a patent infringement case (D. Del.) filed by Semcon Tech, LLC (case no. 12-cv-691).

Recognitions

Ya-Chiao has received the following rankings and recognition:

- “China’s Elite 100 Lawyers (Foreign Firms),” *China Business Law Journal’s* “A-List” 2021
- 2021 ALB China IP Rankings (Patents)
- Awardee/Arbitrator, MOOT SHANGHAI 2021
- The Third Prize, China Law Society, 2019 China Law Society Legal Research Conference for Lawyers
- First Prize, China Law Society, 2018 Annual Conference Paper Selection
- “Leading Individual” for Intellectual Property, *Chambers Global*, 2011-2015
- “Leading Individual” for Intellectual Property (Band 1), *Chambers Asia*, 2010
- Client Choice Award, International Law Office, 2012 & 2014

Credentials

EDUCATION

Ya-Chiao received his B.S. in electrical engineering from The Cooper Union for the Advancement of Science and Art in 1991, a Chinese Law Certificate from East China University of Politics and Law in 1994. He received his J.D. from Hastings College of the Law, University of California in 1994.

ADMISSIONS

- U.S. Patent & Trademark Office
- New Jersey
- Texas
- New York

Related Insights & News

Publications

- “Wuhan D/B/A Chicago of China, Now Epicenter of Anti-Suit Injunctions”, *YuandaWinston Publications*, Apr. 22, 2021.
- “The Jurisdiction System of the U.S. Technology Industry: Eurasian Countries’ Responses and Implications for China”, *2019 Chinese Law Society Lawyers and Law Research Association*.
- “U.S. Patent Reexamination Proceedings,” *NAIP*, Jan. 31, 2019.
- “On the Important Focus and Insights of Disputed Intellectual Property Disputes in the Semiconductor Industry,” *Paper Selection at the 2018 Annual Conference of the Chinese Law Society*.
- “Expert Says - Principal of FRAND in Patent Law,” *China Times*, Oct. 18, 2013.
- “Eli Lilly’s Landmark Win in Chinese Court Sparks Hopes for Better Trade Secret Protection, IP Lawyers Say,” *Policy and Regulation Report*, Aug. 30, 2013.
- “Realtek’s win at court echoes growing chorus against injunctive relief for SEP holders,” *Commercial Times*, Jul. 10, 2013.
- “Google Versus Oracle Century Legal Battle Has Not Ended,” *China Times*, Sept. 28, 2012.
- “Expanded administrative power in fourth revision to China’s Patent Law raises eyebrows,” *Financial Times*, Aug. 17, 2012.
- “America Invents Act Ends the First-to-Invent System,” *Commercial Times*, Jul. 13, 2012.
- “A Valiant Fight to Break the Patent Siege,” *China Times*, May 25, 2012.
- “On Patent Protracted War: Insistent and Persistent,” *Commercial Times*, Apr. 25, 2012.
- “When Patent Meets Capital: Supra-Knowledge-Economy v.2.0,” *China Times*, Mar. 28, 2012.
- “Art of Patent Wars: Think, Decide, Win,” *China Times*, Feb. 21, 2012.

Speaking Engagements

- “U.S. IP Litigation,” Foreign IP Gold Camp of Future Drive patsnap Wisdom Buds IPRdaily, Shanghai, Nov. 13, 2020.
- “U.S. IP Litigation: Standard-essential Patent (SEP) Interpretation and Practical Experience”, Shanghai, Oct. 20, 2020.
- “U.S. Patent Litigation Settlement Negotiations”, Shenzhen, Qingdao, Apr. 8, 20, 23, 2020.

- “Patent Practice”, Hsinchu, Taipei and Taiwan, Feb. 7, 20, 26, 2020, and Mar. 17-18, 25, 2020.
- “U.S. Patent Litigation Briefing”, Shanghai, Jan. 17, 2020.
- “U.S.-China Patent Invalidation and Court Litigation”, Xiamen, Apr. 19, 2019.
- “Overseas IPR Infringement Risk Prevention and Technology Import and Export Compliance Essentials”, Nanjing, Mar. 22, 2019.
- “Patent Infringement Dispute Handling Practice in Mainland China”, Patent Litigation Practice Class, Intellectual Property Training Institute, National Taiwan University, May 24, 2017.
- “Patent Trend and Litigation in Communications Industry, Deconstructing Patent Holdup by NPE and New Strategies to Fight Against NPE”, Communications Industry Trends and Patent Litigation Elite Forum, Taipei, Taiwan, Dec. 4, 2013.
- “Strategies to deal with Cross Borders International Patent Litigation regarding NPE”, 6th Annual Cross-Strait Patent Forum, Jinan, Shandong, Nov. 19, 2013.
- “RAND”, National Applied Research Laboratories Science and Technology Policy Research Information Center, Taiwan, Oct. 19, 2013.
- “License and Standing to Sue”, National Applied Research Laboratories Science and Technology Policy Research Information Center, Taiwan, Oct. 18, 2013.
- International Law Office (ILO) Asia IP Award, Hong Kong, Jan. 24, 2013.
- “Proving Infringement to the Jury in U.S. Patent Litigation”, at National Taiwan University Law School of Taipei, Taiwan, Oct. 30, 2012.
- “Going Global: Legal Challenges and Strategies for Taiwanese Businesses”, Hsinchu and Taipei, Taiwan, Jul. 19-20, 2012.
- “U.S. Patent Litigation from a Different Perspective: Licensing and Business Competition”, National Chengchi University of Taipei, Taiwan, May 25, 2012.
- “U.S. Patent Litigation”, National Chiao-Tung University of Hsinchu, Taiwan, May 8, 2012.
- “U.S. Litigation Strategies for Taiwan Companies”, the General Chamber of Commerce of Hsinchu and Taipei, Taiwan, Apr. 23-24, 2012.

BLOG

When U.S. Discovery Meets China’s New Data and Privacy Laws

JULY 26, 2022

RECOGNITIONS

Winston Partner Ya-Chiao Chang Named to A-List of Top 100 Foreign Lawyers in China

JANUARY 28, 2022