



## Paul B. Stephens

Partner

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For a wide range of clients innovating in the medical diagnostics and imaging, medical devices, wireless communications, network architecture and security, and e-commerce industries, Paul B. Stephens protects the value of their businesses in all aspects of patent law, including prosecution, counseling, opinions and litigation. Clients often come to him with highly complex technological subject matter because of his broad experience and technical proficiency, built on his graduate studies in electrical engineering and advanced research in non-linear phenomena. In addition to his client-focused work, Paul also serves as Chair of the firm's Pro Bono Committee.

Paul has been selected as a "Leading Lawyer" by Leading Lawyers, a division of *Law Bulletin Media* and was named to Lawyers of Color's inaugural Nation's Best List which recognizes lawyers who have demonstrated a commitment to advancing diversity, equity and inclusion efforts in the legal profession. In 2020, he was selected as one of the Notable Minorities in Accounting, Consulting and Law by *Crain's Chicago Business* which features professionals who have overcome challenges and bias to rise to the top of their profession.

### Practices

- IP Litigation
- Patent Prosecution
- Post-Grant Patent Proceedings

### Industries

- Aerospace
- Cleantech & Renewables
- Consumer Products
- Electrical & Computer Technologies
- Materials Science

- Medical Devices
- Nanotechnology

## Representative Experience

Paul has handled matters in a wide variety of technologies, such as:

- Wireless and wired communications and telecommunications
- Medical diagnostics and imaging
- Health sensing technologies
- Nanotechnology
- Healthcare information management software
- e-commerce and business processes
- Mobile apps and instant messaging
- Computer architecture and networking
- Network architecture and security
- Database management software
- Process control systems
- Pumping systems, actuators, transportation, and dock-related products

## Background and Credentials

Paul's clients include Fortune 100 companies, elite universities, and cutting-edge startups. Since joining the firm in 1998, he has protected and defended the valued technological, engineering, and intellectual assets of his clients. Whether working with general counsel or an entrepreneur, a professor or a licensing professional, a research scientist or in-house IP counsel, Paul offers an un-paralleled depth of knowledge and expertise.

Today, Paul's practice is primarily focused on protecting client assets through prosecuting patents, counseling, post-grant review, and developing IP strategies. He also advises clients on challenging competitor patents through reexamination, IPR, PGR, and CBM proceedings, topics about which he has lectured at both client-exclusive and industry-wide CLEs. A good portion of his work over the last decade has been directed toward building licensable IP portfolios for startups and universities.

Paul's practice also includes considerable litigation experience wherein he has successfully represented clients at the CAFC and in district courts across the country, including successfully litigating through jury trial. Today, his role in litigation is more managerial: counseling clients on cases filed by both competitors and patent trolls and assisting with liability phases, while relying upon the deep bench of skilled and experienced litigation partners and associates to the day-to-day "heavy lifting." Paul is a firm believer in the team approach, finding the best resource in the firm for the project at hand.

Paul received his J.D. from the University of Michigan Law School in 1998. He received his M.S.E. in Electrical Engineering and his B.S.E. in Electrical Engineering, *magna cum laude*, both from the

University of Michigan College of Engineering. His graduate research was performed at the National Science Foundation Center for Ultrafast Optical Science in Ann Arbor, Michigan.

- Works extensively with universities on medical diagnostic equipment, data analysis techniques, and implantable medical devices.
- Works extensively with universities on network security technology, software, micro sensors, optical applications, and interdisciplinary technologies.
- For a university client, overtook prosecution of a portfolio of cases, directed to magnetic bead detection of targeted analytes, that had languished for years and successfully and quickly reached allowance for the client.
- On behalf of a Fortune 50 client, successfully pressured favorable settlement of district court action (and prior to answering complaint) with patent NPE, through the preparation of “ready-to-file” inter partes reexam, District of Delaware.
- Strategically positioned client to minimize damages exposure against indemnification claims from multiple defendants in NPE lawsuit, East District of Texas.
- Lead attorney overseeing development of liability phase defenses for patent infringement lawsuit regarding process control software for major (Fortune 50) U.S. industry products manufacturer (East District of Texas).
- Lead development of successful non-infringement defense in patent jury trial (plaintiff, East District of Texas).

## Education

- The University of Michigan Law School (J.D.)
- University of Michigan (M.S.)
  - Electrical Engineering
- University of Michigan (B.S., *magna cum laude*)
  - Electrical Engineering

## Bar Admissions

- Illinois
- U.S. Court of Appeals, Federal Circuit
- U.S. District Court, Northern District of Illinois
- U.S. Patent and Trademark Office

## Publications and Presentations

“Roundtable Discussion on Diversity,” speaker, 2008 Microsoft Women and Minority Law Student IP Summit; program focused on career development, recruiting and retention for minorities and women in law firms and corporate legal departments.

### Community and Professional Involvement

- Board member for Lawyers Lend-A-Hand
- Chair of Firm's Pro Bono Committee
- Board member for Cabrini Green Legal Aid; represents clients in Expungement Petitions
- Guardian ad litem for Chicago Volunteer Legal Services
- Avid photographer, 35mm and Medium Format
- Avid tennis player