



Paul B. Stephens

Partner

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From innovative Fortune 100 companies and elite universities to cutting-edge startups, Paul partners with some of the smartest people on the planet to protect and defend their valued technological, engineering, and intellectual assets. Whether working with entrepreneurs or in-house counsel teams, professors or licensing professionals, research scientists, or corporate managers, Paul draws on his experience as a counselor, IP strategist, and patent prosecutor to help clients cut through the sea of complexity, navigate business challenges, and identify growth opportunities. He also challenges competing patents in the USPTO through reexamination and IPR proceedings.

A former IP litigator, Paul has represented clients at the U.S. Court of Appeals for the Federal Circuit and in district courts across the country, including successful litigation through jury trial. Today, his role in litigation is primarily managerial, counseling clients on cases filed by competitors and patent trolls and directing the liability phase of lawsuits—always in close concert with the firm's highly skilled litigation partners and associates.

Paul was named by Lawyers of Color to the Nation's Best 2020 list, which recognizes practitioners who have demonstrated a commitment to advancing diversity, equity, and inclusion efforts in the legal profession. In 2020, he was selected by *Crain's Chicago Business* as one of the Notable Minorities in Accounting, Consulting and Law, which features professionals who have overcome challenges and bias to rise to the top of their field. Paul has also been selected as a "Leading Lawyer" by Law Bulletin Media and he was included in the inaugural *Lawdragon* 500 Leading Litigators in America list. Most recently he was selected for inclusion in the 2024 edition of *The Best Lawyers in America*® in the practice areas of Litigation–Intellectual Property, Litigation–Patent, and Patent Law.

Practices

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

Industries

- Aerospace
- Artificial Intelligence
- Cleantech & Renewables
- Consumer Products
- Electrical & Computer Technologies
- Entrepreneurship, Startups & Emerging Companies
- Insurance & Financial Services
- Materials Science
- Medical Devices
- Nanotechnology

Representative Experience

Since beginning his career at Marshall Gerstein in 1998, Paul has written more than 100 patent applications specifically involving leading-edge technologies. He works extensively with universities throughout the development lifecycle to build licensable IP portfolios involving medical diagnostic equipment, data analysis techniques, and implantable medical devices, as well as network security technology, software, microsensors, optical applications, and interdisciplinary technologies.

Additional representative matters include:

- For a cutting-edge bioinformatics company, managing a large precision medicine IP portfolio focused on cancer diagnostics and therapy and strategizing with the in-house legal team to protect the client's burgeoning machine learning technology
- For a Fortune 100 client, secured a rare patent involving the client's loyalty program that facilitated multibillion-dollar infusion of cash at the outset of the COVID-19 pandemic
- For a university client, overtook prosecution of a licensed portfolio of patents (involving magnetic bead detection of targeted analytes) that had languished for years and quickly reached allowance for the client
- On behalf of a Fortune 50 client, prepared a "ready-to-file" inter partes reexamination that led to the favorable settlement (prior to answering the complaint) of a district court action involving a patent NPE (District of Delaware)
- Strategically positioned a client to minimize damages exposure arising from indemnification claims from multiple defendants in an NPE lawsuit (East District of Texas)
- As lead attorney, oversaw the development of liability phase defenses for a patent infringement lawsuit regarding process control software for a Fortune 50 U.S. manufacturer (East District of Texas)
- Representing the plaintiff, led the development of a successful non-infringement defense in a patent jury trial (East District of Texas)

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

- Biotechnology, medical imaging, and data-informed medical diagnostics
- AI and machine learning, with a focus on precision medicine and bioinformatics
- Medical devices (implantable and wearable)
- Biological sensors and smart materials
- Quantum computing, including quantum dot and giga-scale computing technologies
- Machine vision
- Industrial materials modeling and optimization
- Augmented reality (AR), virtual reality (VR), and corrective optics
- Retail and warehousing optimization, security, and fulfillment
- Wireless, mobile, and related communications and telecommunications
- Nanotechnology (nanoparticles, nanowire lasers)
- Optics and laser photonics
- Computer architecture, with a focus on microchip IP security
- Semiconductor devices
- Radiofrequency (RF) devices
- E-commerce systems
- Antenna applications and drone technology
- Sensing applications

Background and Credentials

Clients turn to Paul for guidance on complex subject matter because of his broad experience in highly technical areas. It all started with a high school math obsession that included long hours in the library studying fractals, golden ratios, Fibonacci series, and other subjects that fed his lifelong intellectual curiosity. Paul continued down that path by earning bachelor's and master's degrees in electrical engineering, the latter of which included advanced research in non-linear phenomena at the National Science Foundation Center for Ultrafast Optical Science.

During law school, Paul completed an externship with the South African Human Rights Commission in Johannesburg, where he investigated claims of human rights violations and helped HRC Commissioners develop education policy proposals.

Education

- 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

Community and Professional Involvement

In addition to his client-focused work, Paul serves as Chair of the firm's Pro Bono Committee. He is also actively involved with a number of charitable and professional organizations:

- Fellows of the American Bar Foundation, member
- Cabrini Green Legal Aid, member of the Executive Board
- Chicago Volunteer Legal Services, guardian ad litem
- Lawyers Lend-A-Hand to Youth, past Board member
- Chicago Black Partners Alliance, member
- Black Men Lawyers' Association, member
- Stephens Family Endowed LEAD Minority Student Scholarship, University of Michigan

In his spare time, Paul is an avid cyclist, tennis player, and photographer, and a bit of a foodie. He also practices transcendental meditation and enjoys music and reading.