

## W. Paul Schuck



### Contact

Main: 415.956.1900  
Direct: 415.291.4543  
Fax: 415.956.1152  
Email: [pschuck@bzbm.com](mailto:pschuck@bzbm.com)

### Education

University of Michigan School of Law,  
J.D. Cum Laude (Michigan Law Review), 1999

University of Wisconsin, M.A.  
(American History), 1985

Yale College, B.A. (History), 1983

### Professional Affiliations

State Bar of California, Intellectual Property  
Section

San Francisco Bay Area Intellectual Property  
Inns of Court

American Intellectual Property Law Association

Bar Association of San Francisco

### Bar Admissions

State of California

Northern, Central, Eastern and Southern  
Districts of California

Ninth Circuit Court of Appeals

Federal Circuit Court of Appeals

United States Supreme Court

### Practice Areas

Business Litigation

Trade Secret Litigation

Intellectual Property Litigation

Trademark, Copyright and Technology Licensing Litigation

Patent Litigation

### Experience

Paul Schuck is Special Counsel to the firm. He focuses on intellectual property litigation, especially patent and trade secret litigation. Mr. Schuck has litigated patent and trade secret disputes involving a broad array of technologies ranging from biotech to software to mechanical devices, such as oil drilling equipment and gaming machines. He also has extensive experience with trademark, right of publicity and licensing matters. His practice has included matters in U.S. District Courts across the country. In addition, Mr. Schuck has handled appellate matters before the Federal Circuit, the Ninth Circuit and the United States Supreme Court.

Mr. Schuck also counsels clients on intellectual property matters. For intellectual property owners seeking to protect their property, he has provided guidance on non-disclosure and licensing agreements, patent portfolio management, and registration of trademarks and copyrights. Mr. Schuck also regularly advises clients concerned about infringing others' intellectual property rights in an effort to avoid future litigation and liabilities.

### Representative Cases

*Natera, Inc. v. Sequenom, Inc.* (N.D. Cal.). Mr. Schuck was lead counsel representing declaratory judgment plaintiff asserting that patent-in-suit relating to non-invasive, prenatal genetic testing is not valid and not infringed. He obtained summary judgment of patent invalidity for lack of patentable subject matter under 35 U.S.C. § 101, a judgment that was unanimously affirmed in *Ariosa Diagnostics, Inc., et al v. Sequenom, Inc.*, 788 F.3d 1371 (Fed. Cir., 2015), cert. denied 136 S. Ct. 2511 (2016).

*Xilinx, Inc. v. Papst Licensing GMBH & Co.KG; Altera Corporation v. Papst Licensing GMBH & Co.* (N.D. Cal.). Mr. Schuck was co-counsel representing a German defendant in declaratory judgment actions regarding patent invalidity and non-infringement. The court dismissed all claims in favor of his client after granting a motion to dismiss for lack of personal jurisdiction. 113 F.Supp.3d 1027 (N.D. Cal. 2015).

*Genetic Technologies Limited v. Natera, Inc.* (D. Del., N.D. Cal.). Mr. Schuck was lead counsel defending a genetic testing company against claims of patent infringement by a non-practicing entity. After obtaining transfer to the Northern District of California, 2014 WL 1466471 (D. Del. Apr. 15, 2014), the plaintiff dismissed all claims in a "walk away" agreement without payment.

## Speaking Engagements and Publications

"Biotech's Hopes for Answers Dashed by Supreme Court," *Daily Journal*, July 8, 2016

"The Rise of Divided Infringement and the Demise of Form 18," presented at San Francisco Bay Area Intellectual Property Inn of Court, October 21, 2015

"Supreme Court's Bilski Decision Leaves Status of Business Method and Software Patents Uncertain," *Orange County Business Journal*, July 2010

## Representative Cases [Continued]

*Antennatech, LLC v. Jamba, Inc.* (D. Del.). Mr. Schuck represented a juice drink provider in a patent dispute with non-practicing entity that was successfully resolved prior to any significant litigation.

A beverage company developing new product was advised by Mr. Schuck on potential patent issues and the implications of the doctrine of exhaustion.

*Innovus Prime, LLC v. LG Electronics, Inc.; Innovus Prime LLC v. VIZIO, Inc.* (N.D. Cal.). Mr. Schuck defended VIZIO in patent infringement litigation initially brought by a non-practicing entity against eighteen leading television producers.

*Duhn Oil Tool, Inc. v. Cooper Cameron Corp.* (E.D. Cal.). Mr. Schuck was a member of the trial team in a patent infringement action related to oil and natural gas drilling equipment. At trial, the jury awarded his client nearly \$10,000,000 in damages. The case settled while on appeal.

*EBS Automotive Systems et al. v. Illinois Tool Works et al.; Illinois Tool Works v. MOC Products Company et al.* (S.D. Cal.). Mr. Schuck represented Illinois Tool Works in two patent infringement cases involving motor vehicle maintenance equipment.

*AntiCancer, Inc. v. Carestream Health, Inc.* (S.D. Cal.). Mr. Schuck defended a medical equipment company against claims that it infringed patents concerning the use of cancer cells that were transformed to express green fluorescing proteins. The case settled favorably after a partial summary judgment of non-infringement was granted in favor of his client.

*International Printer Corp. v. Brother International Corp. et al.* (E.D. Tex.). Mr. Schuck defended the producer of imaging and printing equipment in a patent infringement suit in the Eastern District of Texas regarding the systems and methods for monitoring and controlling copy machines.

*DR Systems, Inc. v. Fujifilm Med. Sys. USA Inc. et al.* (S.D. Cal.); *DR Systems, Inc. v. Eastman Kodak Company* (S.D. Cal.). A leading imaging company was represented by Mr. Schuck in two separate patent infringement suits regarding picture archiving and communications systems (PACS) for medical images such as MRI and CT scans.

*Board of Regents of the University of Texas, et al. v. Eastman Kodak Company, et al.* (W.D. Tex.). Mr. Schuck successfully defended the provider of dental image management software against claims of patent infringement.

*In re Columbia University Patent Litigation* (M.D.L., D. Mass., N.D. Cal.). Mr. Schuck represented a major biotechnology company in high-profile, multidistrict litigation regarding the validity of a basic DNA technology patent for co-transformation of cells. The litigation was resolved favorably when the patent holder entered into a covenant not to sue and terminated its infringement claims. 113 F.Supp.3d 1027 (D. Mass. 2004). The U.S. Patent and Trademark Office, after reexamination proceedings, ultimately found the patent to be invalid for double patenting.

*Tegic v. Zi Corporation* (N.D. Cal.). Mr. Schuck was a member of the team representing Tegic in trial involving cross-claims for patent infringement of multiple patents. He successfully handled the post-trial briefing sustaining a jury award of over \$8,000,000 in Tegic's favor.

## Representative Cases [ Continued ]

*Shuffle Master v. Alliance Gaming* (D. Nev.). Mr. Schuck represented a gaming industry company in patent and trade secret disputes involving numerous patents for table game monitoring technology. Summary judgment was granted in favor of his client on most major issues.

*Hoffer v. Microsoft Corp., et al.* (N.D. Cal. and Fed. Cir.); *Hoffer v. International Business Machines Corp.* (S.D. Cal., N.D. Cal. and 9th Cir.). Mr. Schuck defended a leading computer company in patent litigation concerning Internet databases. He obtained summary judgment of non-infringement, affirmed in *Hoffer v. Microsoft Corp., et al.*, 405 F.3d 1326 (Fed. Cir. 2005). He also successfully obtained dismissal of claims in a related trade secret and business torts case which was also affirmed on appeal.

*Webgain, Inc. v. Borland Software Corporation* (N.D. Cal.). Mr. Schuck represented Borland in complex patent litigation involving multiple patents concerning programming environments for creating software. The case settled favorably after positive rulings on claim construction and motions for partial summary judgment.

*Davis et al. v. Electronic Arts, Inc.* (N.D. Cal.). Mr. Schuck represented retired NFL football players in a class action asserting right of publicity and related claims against a leading sports video game producer. He successfully defended against an anti-SLAPP motion to dismiss case.

*LumaSense v. Neoptix, Inc.* (N.D. Cal.). Neoptix, a manufacturer of fiber-optic temperature sensors, was represented by Mr. Schuck in its defense against allegations of cybersquatting, trademark infringement, and trade secret misappropriation. The matter was settled at an early stage in mediation.

*Hannah v. Currie Acquisitions, LLC.* (Cal. Sup. Ct., Los Angeles). Mr. Schuck represented a well-known actress in a right of publicity suit based on the defendants' unlicensed use of photographs of the actress in advertising and promotional materials.

Mr. Schuck defended a start-up semiconductor producer and its employees in a trade secret and wrongful hiring dispute.

*Bancorp v. Hartford Life Insurance* (E.D. Mo.). Mr. Schuck represented the plaintiff in patent and trade secret cases concerning business methods for insurance investment products that resulted in a nine-figure verdict in favor of his client.

A leading toy company was represented by Mr. Schuck in multiple trademark and domain name disputes, many implicating constitutional issues of fair use and free speech.

*Sedona Corporation v. Open Solutions, Inc.* (D. Conn.). Mr. Schuck represented the developer of customer relationship management software in a suit based on alleged misuse of proprietary technology in a breach of license and trade secret case.

*AvAero Noise Reduction Joint Venture v. AeroTech Services, Inc.* (C.D. Cal.). Mr. Schuck represented inventors of a fuel-saving aircraft modification asserting a breach of license granting rights to patent and an FAA-issued certificate permitting use of the modification and related patent infringement claims.

*Towantic Energy, L.L.C. v. General Electric Company* (N.D. Cal.). Mr. Schuck represented the producer of gas and steam turbine generators in a breach of contract dispute regarding a contractual termination fee of over \$20,000,000.