

STEVEN M. DU BOIS

Experience

Potomac Patent Group, PLLC, McLean, VA (April 2002 – Present, *Principal*)

- Conduct patent opinions/studies related to scope/validity of various patents. Counsel clients regarding usage of legal opinions.
- Draft patent applications and prepare responses to office actions

Dorsál Networks, Inc., Columbia, MD (May 2001-February 2002)

- *Chief Patent Counsel*. Responsible for all intellectual property matters including trade secret program management, transactional matters, trademarks, copyrights and patent portfolio. Expanded patent portfolio from six filed applications to more than 50 patent filings. Company was acquired in January 2002 by Corvis Corporation. Handled all diligence issues and merger agreement issues related to intellectual property as part of this transaction.

Burns, Doane, Swecker & Mathis, Alexandria VA (1991- May 2001, *Equity Partner* 1999)

Prosecution

- Responsible for day-to-day management of multimillion dollar/year client; including coordinating the activities of about 20 professionals performing work for that client. Supervised associate firms in various countries as this client's patents were filed, prosecuted and issued internationally.
- Drafted approximately 250 patent applications based on disclosure materials ranging from master's theses, corporate invention disclosure forms, personal interviews, videotapes, telephonic discussions, etc. Representative technologies included software, bar code scanners, signal processing algorithms, RF communications systems and components and techniques, graphical user interfaces, website hosting architectures, business methods, pulse power circuitry and antenna design. Developed techniques to maximize time efficiency of inventors so that they can focus on core projects.
- Authored approximately 30 patent opinions/studies related to scope/validity of various patents. Counseled clients regarding usage of legal opinions.

Litigation

- Co-lead litigation counsel in district court patent infringement litigation for patents associated with equalization and synchronization techniques for high frequency communications.
 - Responsible for non-infringement, invalidity positions, preparing technical expert witnesses and deposing patent inventors.
 - Oral patent presentation and cross-examination in three day *Markman* hearing before Special Master regarding patent claim construction.
- Member of litigation team in matter before the International Trade Commission (ITC); responsible for preparing technical experts, defining substantive invalidity/non-infringement positions and answering interrogatories. Successfully defended client at trial and subsequent arbitration.

Licensing

- Negotiated, and drafted agreement for, patent license for client to obtain rights to LZW compression algorithm from Unisys Corporation.
- Negotiated, and drafted agreement for, assignment of patent from one Fortune 100 company to another Fortune 100 company.
- Negotiated, and drafted agreement for, patent license on behalf of professor to secure compensation for innovations from university.

United States Patent and Trademark Office, Arlington, VA (1987-1991) - Patent Examiner

- Examined and issued Letters Patent in various computer technologies (Group 2300).
- Received Outstanding Awards for production and quality each year.

Education

Juris Doctor, George Mason School of Law (Patent Track), 1993.
B.S.E.E., Virginia Tech, 1986.

Admissions

United States Patent Office, Registration No. 35,023
Virginia State Bar No. 36,147