



Technology & Intellectual Property Strategies Group PC

Paul L. Hickman ATTORNEY AT LAW

TIPS Group
1000 Elwell Court, Suite 150
Palo Alto, California 94303
www.tipsgroup.com
Telephone: 650.293.3355
Central Fax: 800.822.7095
Email: phickman@tipsgroup.com



AREAS OF LEGAL EMPHASIS

- Patent Prosecution
- Patent Licensing & Transactions
- Patent Litigation
- Trademarks
- Copyrights
- IP Counseling

PATENT TECHNOLOGY EXPERIENCE

- Computer (architecture, processors, peripherals)
- Network (servers, routers, protocols, internet)
- Software (operating systems, web, applications, user interface, embedded)
- Semiconductor (processes, materials, equipment, devices)
- Nanotechnology
- Materials (getters, ceramics, superconductors)
- Green Technology (power monitoring, power generation)
- Digital Electronics
- Analog Electronics
- Consumer Electronics
- Gaming Systems
- Micromachines & Sensors

REPRESENTATIVE PATENT LITIGATION

- *RLT Acquisition v. Innovative Concepts in Entertainment* (N.D. of CA) (counsel for plaintiff enforcing 4 patents in the electronic games field, case settled with payment of damages and ongoing royalties after favorable claim review)
- *SAES Getters SpA v. Aeronex Corp.* (S.D. of CA) (counsel for plaintiff enforcing pioneering patent for the purification of ammonia, case settled for plaintiff after favorable *Markman* hearing)
- *Aeronex Corp. v. SAES Getters SpA* (S.D. of CA) (counsel for defendant in a patent litigation case with settlement in favor of the defendant after *Markman* hearing)
- *Allure Home Creations v. Zak Designs* (DNJ) (counsel for defendant in a patent suit alleging infringement of a specialty container)

- *Water Fun Products Corp. v. Proslide Technology, Inc.* (C.D. of CA) (counsel for plaintiff in a patent suit alleging infringement of a water park slide)
- *Kirby v. Boffito*, Inter. Nos. 105,311 and 105,312, (Bd. Pat. App. & Inter. June 27, 2005) (Represented Senior Party in patent interference regarding Vacuum Insulated Panels, judgment entered against Junior Party)
- *Dex Products, Inc. v. Barbara Houghteling and Basic Comfort, Inc* (N.D. of CA) (counsel for defendant with regards to a baby positioner in a declaratory judgment action)
- *SAES Getters S.p.A. v. Innovative Micro Technology, Inc.* (C.D. of CA) (counsel for plaintiff enforcing patent for device used in manufacture of micromachines)
- *O'Dorsay, Inc. v. International Housewares, Inc.* (C.D. of CA) (counsel for defendant in an alleged patent infringement action)

SPEECHES AND PUBLICATIONS

- Speaker, "Analysis of USPTO Records for Patent Claim Scope, Validity & Enforceability," Advanced Patent Valuation (BDA Webinar, 2011)
- Speaker, "Patents: What are they Good For?." Corporate Retreat Presentation, (Sunnyvale, California, 2011)
- Speaker, "Protecting Your Idea," San Jose State University College of Business Silicon Valley Center for Entrepreneurship, (San Jose, California, 2010)
- Speaker, "Patentable Subject Matter in the United States," (Milan, Italy, 2010)
- Speaker, "Current Patent Law Issues for the U.S. Supreme Court," Intellectual Property Law Section of the Chicago Bar Association (Chicago, 2006)
- Speaker, "What the Federal Circuit Would Like to See in Litigated Patents," District of Columbia Bar Association, Intellectual Property Law Section (Washington D.C., 2005)
- Speaker, "Drafting and Prosecuting Patents in a Changing Patent Environment," 2005 Rocky Mountain Intellectual Property & Technology Institute, Co-Sponsored by the Intellectual Property Section of the Colorado Bar Association and the ABA Section on Science & Technology (Denver, Colorado, 2005)
- Speaker, "Patent Procurement Techniques for Maximizing Claim Scope and Enforceability," Washington State Patent Law Association and Oregon Patent Law Association Joint Meeting (Stevenson, Washington, 2005)
- Speaker, "Procuring Enforceable Patents per CAFC Guidelines," Silicon Valley Intellectual Property Law Association (Palo Alto, California, 2005)
- Speaker, "Writing and Prosecuting U.S. Patent Applications in the 21st Century," (Sidney, Australia, 2004)
- Speaker, "Software Patents in the U.S.," (Munich, Germany, 2002)
- Speaker, "U.S. Inventor Notebook Practice for Foreign Inventors," (Milan, Italy, 2001)
- Speaker, "U.S. Patent Prosecution Techniques," (Taipei, Taiwan, 2000)
- Speaker, "U.S. Patent Law Update," (Tokyo, Japan, 1999)
- Speaker, "Understanding the Intellectual Property License," Practicing Law Institute (San Francisco, California, 1998)
- Book Chapter, "The Patent and Technology License," *Understanding the Intellectual Property License*, Practicing Law Institute, © 1998
- Speaker, "Understanding the Intellectual Property License," Practicing Law Institute (San Francisco, California, 1997)
- Speaker, "Introduction to Intellectual Property," PASCO (Palo Alto, California, 1997)
- Book Chapter, "The Patent and Technology License," *Understanding the Intellectual Property License*, Practicing Law Institute, © 1997
- Speaker, "Will There Be Publication of U.S. Patent Applications After January, 1996?" Peninsula Intellectual Property Law Association (Santa Clara, California, 1996)

Speaker and Moderator, "The U.S. Patent System and the CAFC," World Intellectual Property and Trade Forum (Tokyo, Japan, 1992)
Speaker, "Revisiting the Means Plus Function Claim," World Intellectual Property and Trade Forum (Palo Alto, California, 1990)
Speaker, "Understanding Patents," Sunnyvale Patent Information Clearinghouse (Sunnyvale, California, 1984)

RELATED EXPERIENCE

Perkins Coie LLP, Partner, 2002-2006
Oppenheimer Wolff & Donnelly LLP, Partner, 2001-2002
Hickman, Coleman & Hughes LLP, Partner, 1990-2000
Applied Materials, Inc., Patent Counsel, 1988-1990
Hewlett Packard Company, Patent Attorney, 1986-1988
Instructor of IP Law, Institute for Paralegal Studies, Santa Clara University, 1987-1998
Adjunct Professor of Intellectual Property Law, Peninsula University School of Law, 1986-1999
Faculty member CVPA since 2011

PROFESSIONAL AND CIVIC ACTIVITIES

Silicon Valley Intellectual Property Law Association (SVIPLA), President, 2002-2003
World Intellectual Property and Trade Forum (WIPTF), Board Member, 1992-1997
American Intellectual Property Law Association (AIPLA)
Licensing Executive Society (LES)
Santa Clara County Bar Association (SCCBA)
Institute of Electrical and Electronic Engineers (IEEE)

PROFESSIONAL RECOGNITION

AV Peer Review Rated (Martindale Hubbell) 1999-2012
Northern California "Super Lawyer" 2005-2011

EDUCATION

Santa Clara University, J.D., 1983
San Jose State University, B.S. (Electrical Engineering), 1985
Stanford University, A.B., 1975

ADMITTED TO PRACTICE

United States Supreme Court
Supreme Court of California
Supreme Court of Texas
District of Columbia Court of Appeals
United States Court of Appeals: Federal Circuit
United States District Court: Northern District of California
United States District Court: Central District of California
United States District Court: Southern District of California
United States District Court: Eastern District of Texas
United States District Court: District of Columbia
United States Patent and Trademark Office