

STEVEN M. DUBOIS

LICENSURE

- Virginia State Bar, 1993
- United States Patent Office, 1987

EXPERTISE

Intellectual Property Law ▪ Electrical Engineering ▪ Telecommunications
Computer Hardware ▪ Oil and gas ▪ Software ▪ User Interfaces

PROFESSIONAL EXPERIENCE

PATENT LAW

PATENT PORTFOLIO BUILDERS (formerly Potomac Patent Group), Fredericksburg, VA 2002 - Present
Principal

- All aspects of patent preparation and prosecution.
- Act as in-house patent counsel clients for small/medium size companies.

DORSÁL NETWORKS, INC., Columbia, MD 2001 - 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- 2001 *Equity Partner (1999)*

Litigation

- Co-lead litigation counsel in district court patent infringement litigation for patents associated with equalization and synchronization techniques for high frequency communications.
- Member of litigation teams in matters 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.

Prosecution

- 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.

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

GEORGE MASON UNIVERSITY SCHOOL OF LAW (Patent Track), Arlington, VA 1993
Juris Doctor

VIRGINIA TECH

