

# PAUL M. SCHOENHARD

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## • ACADEMIC INTERESTS •

**Research:** My research focuses on the boundaries and enforceability of intellectual property rights, with special attention to the delicate balance between public benefit and private right and to the impact of intellectual property laws on the United States' relationship with its international trading partners.

**Core subjects:** Intellectual Property (esp. Patents, Trademarks); International Trade; Veterans Affairs

**Additional subjects:** Real Property; Contracts; Civil Procedure

## • EDUCATION •

### HARVARD LAW SCHOOL, J.D.

June 2003

Research grant: Mark DeWolfe Howe Fund

Journal work: *Harvard Journal of Law and Public Policy* (Executive Editor)

*Harvard Journal of Law and Technology* (Article Editor)

### DUKE UNIVERSITY SCHOOL OF LAW, Visiting Student, 2002–2003

### DARTMOUTH COLLEGE, B.A., High Honors in Mathematics, Computer Science minor

June 2000

Honors: *magna cum laude*

Phi Beta Kappa

Presidential Scholar

Phillips Award in Applied and Professional Ethics

Francis L. Town Scientific Prize in Mathematics

Thesis: *Least Crossings of Complete Graphs: An Iterative Approach*

## • EXPERIENCE •

### ROPES & GRAY LLP (formerly FISH & NEAVE), Washington, DC / Palo Alto, CA

Nov. 2009 – Present

*Associate*

Sept. 2003 – Oct. 2008

*Summer Associate*

June – Aug. 2001

Engaged in patent litigation in federal courts and the U.S. International Trade Commission. Briefed, argued and secured summary judgment of infringement in patent case; prepared cases for trial; took and defended fact and expert depositions; worked closely with expert witnesses. *Pro bono* work: Represented non-profit voter registration and advocacy groups in National Voter Registration Act and First Amendment rights cases.

### AMERICAN UNIVERSITY, WASHINGTON COLLEGE OF LAW, Washington, DC

*Professional Lecturer*

Aug. 2009 – Present

Teaching “Patent & Trademark Appeals Before the Federal Circuit” and “Veterans Affairs Law.”

### UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, Washington, DC

*Law Clerk to the Honorable Arthur J. Gajarsa*

Oct. 2008 – Oct. 2009

### UNIVERSITY OF UTAH, S.J. QUINNEY COLLEGE OF LAW, Salt Lake City, UT

*Visiting Associate Professor*

Aug. – Dec. 2007

Taught “Intellectual Property Survey” and “Trademark & Unfair Competition Law.” Advised students interested in research and writing on topics related to intellectual property law.

### WOMBLE CARLYLE SANDRIDGE & RICE, Research Triangle Park, NC

*Research Assistant*

Apr. – Sept. 2003

Researched issues relating to regional governance and Smart Growth. Prepared two papers for presentation to the North Carolina chapter of the American Planning Association.

### DUKE UNIVERSITY SCHOOL OF LAW, Durham, NC

*Research Assistant to Professor Steven L. Schwarcz*

Sept. 2002 – Aug. 2003

Researched principles governing corporate disclosure and securitization.

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- VENABLE, BAETJER, HOWARD & CIVILETTI, LLP**, Washington, DC  
*Summer Associate* **July – Aug. 2002**
- SHAW PITTMAN LLP**, Washington, DC  
*Summer Associate* **May – June 2002**
- HARVARD LAW SCHOOL**, Cambridge, MA  
*Research Assistant to Professor Oliver Oldman* **Feb. – Oct. 2001**  
Researched banking law, concentrating on state taxation issues. Drafted chapter for textbook revision.
- ORACLE CORPORATION**, Redwood Shores, CA **June – Aug. 2000**  
*Intern, Office of the General Counsel/Patent Operations* **Mar. – Sept. 1999**  
Researched the impact of e-commerce on Oracle's licensing and contracting arrangements. Drafted software license assignments and partnership agreements. Researched and wrote opinions on patent infringement issues.
- DARTMOUTH COLLEGE**, Hanover, NH **Sept. – Dec. 1999**  
*Teaching Assistant, Computer Science Dept., "Introduction to Programming"*  
*Teaching Assistant, Computer Science Dept., "Data Structures"* **Sept. – Dec. 1997**  
Provided supplementary lectures; conducted office hours; graded exams and programming work.
- CHICAGO DEPT. OF PUBLIC HEALTH**, Chicago, IL **June – Aug. 1997**  
*Statistical Consultant*  
Audited and conducted statistical analyses of cumulative sexually transmitted disease data (1986-1996). Prepared data requests for program administrators, the Centers for Disease Control and Prevention, and community planning groups.

## • WORKS IN PROGRESS •

- Just Passing Through: Whether U.S. Law Should Reach the Transshipment of Patented Goods.*
- A Model for the Assessment of Patent Damages Attributable to Downstream International Sales.*
- IP at Our Borders: How CBP Can Most Efficiently Help U.S. IP-Rights Holders.*
- VETERANS AFFAIRS LAW & POLICY (casebook).

## • PUBLICATIONS •

- Reconceptualizing Inventive Conception: Strengthening, Not Abandoning the First-to-Invent System*, 17 FED. CIR. B.J. 567 (2008).
- A Three-Dimensional Approach to the Public-Private Distinction*, 2008 UTAH L. REV. 635.
- Who Took My IP?: Defending the Availability of Injunctive Relief in Patent Cases*, 16 TEX. INTELL. PROP. L.J. 187 (2008).
- Commercial Speech*, in 1 ENCYCLOPEDIA OF THE SUPREME COURT OF THE UNITED STATES 370 (David S. Tanenhaus, ed. 2008).
- Should Foreign Sales Figure in Domestic Damages?*, NAT'L L.J., Jan. 21, 2008, at S8.
- Reversing the Reversal Rate: Using Real Property Principles to Guide Federal Circuit Patent Jurisprudence*, 17 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 299 (2007).
- No Trespassing: The Supreme Court Should Buttress Patent Owners' Right to Refuse*, LEGAL TIMES, May 8, 2006, at 42.
- Judging Trial Judges*, IP L. & BUS., Mar. 2006, at 22.

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*Why Marks Have Power Beyond the Rights Conferred: The Conflation of Trademarks and Service Marks*, 87 J. PAT. & TRADEMARK OFF. SOC'Y 970 (2005).

*Awards of Attorney Fees in ANDA Infringement Suits*, INTELL. PROP.—USA (International Law Office, London, UK), Sept. 6, 2004 (with Richard L. Rainey).

*Tariff Act and Imports of Products Manufactured by Patented Processes*, INTELL. PROP.—USA (International Law Office, London, UK), June 14, 2004 (with Richard L. Rainey).

*Federal Circuit's First Review of Section 272 of the Patent Act*, INTELL. PROP.—USA (International Law Office, London, UK), Mar. 22, 2004 (with Richard L. Rainey).

*Medichem: A New Standard of Review for Patent Interference Practice*, INTELL. PROP.—USA (International Law Office, London, UK), Jan. 26, 2004 (with Richard L. Rainey).

*Festo IX and the Future of Prosecution History Estoppel*, INTELL. PROP.—USA (International Law Office, London, UK), Nov. 10, 2003 (with Richard L. Rainey).

Book Note, *Genetically Modified Foods: Debating Biotechnology*, 16 HARV. J.L. & TECH. 559 (2003).

Note, *Disclosure of Government Information Online: A New Approach from an Existing Framework*, 15 HARV. J.L. & TECH. 497 (2002).

Comment, *The End of Compelled Contributions for Advertising: United States v. United Foods*, 25 HARV. J.L. & PUB. POL'Y 1185 (2002).

Book Note, *The Internet Upheaval: Raising Questions, Seeking Answers in Communications Policy*, 14 HARV. J.L. & TECH. 767 (2001).

## • PRESENTATIONS •

*When Patent Property Rights Vest: Why Entitlements Should Be Assigned Consistently on the Basis of Inventorship*, Fifth Annual Works In Progress Intellectual Property (WIPIP) Colloquium, American University, Washington College of Law (Sept. 28, 2007).

*When Patent Property Rights Vest: Why Entitlements Should Be Assigned Consistently on the Basis of Inventorship*, Faculty Workshop, University of Utah, S.J. Quinney College of Law (Sept. 26, 2007).

*Who Took My IP?: Defending the Availability of Injunctive Relief*, Faculty Workshop, George Mason University School of Law (Jan. 2006).

## • ADMISSIONS •

District of Columbia Bar

Virginia State Bar

U.S. Court of Appeals for the Federal Circuit

U.S. Court of Appeals for the Fourth Circuit

U.S. District Court for the District of Columbia

U.S. District Court for the Eastern District of Virginia

U.S. District Court for the Southern District of Texas

## • ASSOCIATIONS •

American Intellectual Property Law Association

Federal Circuit Bar Association

OBG Cocker Spaniel Rescue