

Curriculum Vitae of Andrew B. Schwaab, Esq.

ANDREW B. SCHWAAB

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Sandra Day O'Connor College of Law

Jan 2024 – Present

Arizona State University, Phoenix, AZ

Director, Lisa Foundation Patent Law Clinic

Clinical Associate Professor of Law

- Supervise students at ASU's IP clinic managing all aspects of preparing, filing and prosecuting patents, trademarks and other IP matters for pro bono clients

Greenberg Traurig, LLP

Nov 2018 – Present

Shareholder, Palo Alto, CA

- Create and manage worldwide patent portfolios, including:
 - Manage U.S. prosecution dockets for domestic and international clients
 - Supervise foreign patent portfolios including all aspects of substantive foreign prosecution
 - Secure patent for use in District Court, ITC and foreign litigation venues
 - Develop and exchange reciprocal work with network of foreign patent firms
 - Develop and secure critical IP in electrical arts including patents contributing to multi-million-dollar acquisitions of clients
 - Develop, present and implement new worldwide prosecution strategies in accordance with changes in U.S. and foreign laws
- Relationship liaison for Blackhawk Network Holdings, QMware AG, Novarion Systems GmbH, SoundThinking (previously ShotSpotter), Lynx Software Technology, NovaSolix, Primos Storage Technology LLC, and numerous other U.S. and international clients
- Advise clients regarding global patent strategies, patent litigation, assessment of third-party rights, and litigation avoidance
- Handle worldwide licensing and monetization matters for U.S. and foreign clients
- Advise senior corporate officers regarding global patent and IP licensing activities
- Lecture and conduct business development activities in the U.S., China, and Taiwan, including recent presentations with the Chinese Patent & Trademark Office as well as IP law firms and major electronics companies throughout Asia
- IAM 300 Patent Strategist and IAM 300 Global Leader, 2021-2024
- Longtime client Robert Cousins of NovaSolix awarded Silicon Valley Inventor of the Year, January 2021

Knobbe, Martens, Olson & Bear LLP

Dec 2015 – Nov 2018

Of Counsel, Palo Alto, CA

- Create and manage worldwide patent portfolios including strategic development for use in District Court, ITC and foreign venues, including:
 - Manage U.S. prosecution dockets for domestic and international clients
 - Supervise foreign patent portfolios including all aspects of substantive foreign prosecution
 - Develop and exchange reciprocal work with network of foreign patent firms
 - Develop and secure critical IP in electrical arts including patents contributing to multi-million dollar acquisitions of clients

- Develop, present and implement new worldwide prosecution strategies in accordance with changes in U.S. and foreign laws
- Advise clients regarding global patent strategies and assessment of third party rights
- Supervise worldwide licensing and monetization matters for U.S. and foreign clients
- Advise senior corporate officers regarding global patent and IP matters
- Coordinate with litigation specialists regarding technical aspects, claim charts and patent issues
- Lecture and conduct business development activities in the U.S., Korea, China, Japan and Taiwan, including recent presentations to Korean Electronics Association, Chinese Patent Office leaders, and major electronics companies throughout Asia
- Co-founder and co-leader of firm's greater China practice group
- Longtime client Lee-Lean Shu of GSI Technology awarded Silicon Valley Inventor of the Year (2017)

DLA Piper U.S. LLP

Dec 2006 – Dec 2015

Of Counsel, Palo Alto, CA

- Create and manage worldwide patent portfolios, as above, and including:
 - Develop and secure critical IP in electrical arts including patents contributing to various <\$1M through \$1.2B acquisitions of clients and client divisions
- Advise clients regarding global patent strategies and assessment of third party rights
- Supervise worldwide licensing negotiations and patent disputes
- Advise senior corporate officers regarding global patent and IP matters
- Coordinate with litigation specialists regarding technical aspects, claim charts and patent issues
- Conduct post grant proceedings including reexaminations and Inter Partes
- Lecture and conduct business development activities in the U.S., China, Korea, Japan and Canada, including presentations to Korean Electronics Association, Chinese Patent Office leaders, and major electronics companies in Asia
- Hold leadership positions in firm's Korean IP/patent group and Alice subgroup
- Prepare opinions regarding validity and infringement in electrical arts
- Longtime client Dr. Robert Showen of ShotSpotter, Inc. (now SoundThinking) awarded Silicon Valley Inventor of the Year (2013)

Finnegan, Henderson, Farabow, Garrett & Dunner LLP

Feb 2004 – Nov 2006

Associate, Palo Alto, CA

- Manage U.S. and foreign prosecution dockets
- Prepare patent applications in electrical arts
- Prepare opinions regarding validity and infringement in electrical arts
- Advise clients regarding global patent strategies and assessment of third party rights
- Analyze adverse parties' IP rights regarding litigation avoidance, including evaluation of patent validity, infringement, and enforceability; correspond and negotiate with opposing counsel
- Perform investigations of potential infringers to substantiate litigation
- Develop and implement new continuing application practice in accordance with new Chinese divisional practice law and proposed USPTO rules
- Conduct business development activities in Japan, Korea and China
- Coordinate related litigation, prosecution, and claim amendment strategies for client with extensive portfolios, litigations and interferences pending

Dergosits & Noah L.L.P.

Dec 1999 – Dec 2003

Associate, San Francisco, CA

- Prosecute patent applications before the U.S., PCT, and foreign patent offices
- Prepare opinions regarding validity, infringement, enforceability, and freedom-to-operate in electrical and related arts
- Prepare patent applications for U.S. and foreign protection in wide range of EE arts
- Handle IP litigation for patent infringement, trademark infringement, trade secret, and copyright matters, including extensive involvement with discovery and motions practices, motions for summary judgment regarding infringement and invalidity, as well as appeal to the Court of Appeals for the Federal Circuit
- Provide strategic counseling, including evaluating validity and enforceability of clients' and adverse parties' patents for licensing and litigation negotiations, advising clients regarding strategies for protection and exploitation of IP and avoidance of third party rights, analyzing technology transfer and licensing opportunities and preparing associated agreements, and performing due diligence and freedom-to-operate analyses
- Prepare and prosecute U.S. trademark applications
- Review and summarize CAFC decisions on a daily basis

**Specialized Patent Services, Kramer & Associates, BITS,
Electrotech Patent Research, and Rodney F. Brown, Esq.**

Jan 1999 – Oct 1999

Summers '95 and '98

Patent Agent

Day Work 1994-1999

Crystal City, Virginia; San Diego, California

- Conduct infringement, validity, and patentability searches, including computerized IP searching in USPTO, Dialog® and other databases
- Perform due diligence, freedom-to-operate, and patent landscape analyses
- Advise clients and prepared opinions regarding patentability, validity, and infringement
- Supervise search docket for Specialized Patent Services

Laubscher, Presta & Laubscher L.L.P.

May 1992 – Aug 1994

Patent Searcher; Patent Clerk

Summers '90 and '91

Crystal City, Virginia

- Conduct infringement, validity, patentability, trademark, and copyright searches
- Prepare validity and infringement opinions
- Perform due diligence analyses
- Draft U.S. patent applications, amendments, and other patent prosecution documents
- Interview Patent Examiners and other USPTO personnel regarding pending patent applications

Schwartz, Jeffery, Schwaab (became Foley & Lardner's IP group)

Summers '84 – '88

File and Mail Room Clerk

Alexandria, Virginia

- Organize and review patent files regarding prosecution papers and tasks
- Handle incoming USPTO papers and outgoing patent filings

EDUCATION

University of San Diego School of Law, San Diego, California
Juris Doctor Degree, 1998
Science and Technology Law Society, Founding Member

University of Virginia, Charlottesville, Virginia
B.S., Electrical Engineering (Electro-Physics), 1992

University of California at Berkeley, Berkeley, California
Non-degree coursework in Networking, Communications and Digital Signal Processing, 2003

ADMISSIONS

State Bar of California
United States Patent and Trademark Office, 1994 (Reg. No. 38,611)
State Bar of Arizona *pending*

PROFESSIONAL MEMBERSHIPS

San Francisco Intellectual Property Law Association (Past President)
Silicon Valley Intellectual Property Law Association (Past President)
U.S. Bar/CNIPA (Chinese Patent & Trademark Office) Liaison Council, immediate Past
Chair and Founding Member
American Intellectual Property Law Association (AIPLA)
Intellectual Property Owners Association (IPO)

INTERESTS

Pro bono and volunteer work (Hotel de Zink, City Team, Reimagine the Slums, Included,
Compassion for Migrant Children, Serving Those Who Serve Our Country, Leland House)
Relay team triathlons and related athletics with network of IP Attorneys for over 20 years
Gourmet barbecuing/grilling/smoking