



## Paul E. Burns, Partner

Practice Areas	Capital Markets and Securities Emerging Growth and Venture Capital Intellectual Property Litigation, Intellectual Property Licensing and Technology Transactions Litigation, Corporate and Commercial Medical Technology Patent Prosecution and Counseling Trade Secrets Trademarks and Copyrights Life Sciences eDiscovery Privacy and Cybersecurity
Admissions	California Arizona Connecticut District of Columbia Massachusetts New York Texas United States Patent and Trademark Office
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### Professional Summary

Paul concentrates his practice in intellectual property litigation, counseling and transactions, as well as



commercial litigation, arbitration and mediation. Paul splits his time working out of Procopio's Los Angeles, San Diego and Phoenix offices.

Paul has acted as lead counsel or co-counsel in patent, copyright, trademark, trade dress infringement, unfair competition, trade secret misappropriation and technology-related contract litigation involving Fortune 1000, Global 500 and public and private companies all over the United States, as well as Europe and Asia. Paul is also a registered patent attorney who (i) advises clients on intellectual property protection, enforcement and infringement avoidance, (ii) negotiates license, development, distribution and employment agreements and (iii) engages in patent prosecution, federal trademark registration and copyright registration. Paul's has handled matters involving computer hardware, software and all types of information technology, the Internet, entertainment (music, film, video, publishing, art, photography), gaming, semiconductors, electrical devices, chemical processes, manufacturing processes, mechanical devices, consumer products, franchising, medical devices, biotechnology and pharmaceuticals.

Paul's commercial litigation experience includes contract disputes, financial services (e.g. mortgages, loans, credit, securities, bankruptcy) disputes, creditors' rights, franchise disputes, employee raiding, non-solicitation and other employment-related disputes, business torts, business break-ups, antitrust claims, securities fraud, real estate and construction disputes, regulatory matters and all categories of business and commercial disputes.

Paul has extensive experience with, and is recognized as a national expert in, Electronic Discovery. He designed and teaches one of the first law school classes in the country on the subject and was a contributor to the law school casebook *Electronic Discovery and Digital Evidence* (West American Casebook Series 2008). Paul is also General Counsel to, and a member of the Executive Committee of, The Sedona Conference®, the law and policy think tank that is universally recognized as the thought leader among practitioners and the judiciary in e-discovery matters. He is Co-Chair of The Sedona Conference Institute's 5th Annual "Staying Ahead of the E-Discovery Curve," the leading E-Discovery continuing legal education program. He has also been asked to speak on the subject of E-Discovery to the American Bar Association, the District Conference of the US District Court for the District of Arizona, The Sedona Conference, Arizona State University's Sandra Day O'Connor College of Law and several other business and legal organizations. Paul has handled numerous E-Discovery issues and disputes, and has been asked to serve as a Special E-Discovery Master in litigation and arbitration matters.

Paul's intellectual property and litigation expertise has been recognized by (i) his inclusion in Best Lawyers in America and Super Lawyers, (ii) his appointment as an Adjunct Professor of Law at Arizona State University's Sandra Day O'Connor College of Law, where he teaches Patent Litigation, Biotechnology Licensing & Litigation and Electronic Discovery & Digital Evidence, (iii) his appointment to leadership



positions in the American Intellectual Property Law Association, Licensing Executives Society, Federal Bar Association, Copyright Society of the USA and The Sedona Conference, (iv) his contribution to a law school casebook on Electronic Discovery and Digital Evidence and (v) his nomination as a Fellow of the American Bar Foundation.

Paul has a substantial national arbitration and mediation practice focusing on technology, intellectual property and commercial disputes, including serving as a neutral for the American Arbitration Association and the International Institute for Conflict Prevention & Resolution (CPR). His arbitration and mediation expertise has been recognized by his appointment as an Adjunct Professor of Law to Pepperdine University School of Law's Straus Institute for Dispute Resolution and by his service as Chair of the American Intellectual Property Law Association's Alternative Dispute Resolution Committee. He has been a frequent speaker on alternative dispute resolution at national meetings of organizations such as the American Intellectual Property Law Association, the Copyright Society of the USA and Thomas Jefferson School of Law in San Diego, CA. He also serves as an Adjunct Professor in Pepperdine University School of Law's Straus Institute for Dispute Resolution, where he designed and taught its first course on Dispute Resolution in Intellectual Property.

### **Representative Matters**

- Represented an Asian-based semiconductor fabricator in preparation for preliminary injunction proceedings in trade secret misappropriation and patent licensing litigation.
- Defended a Fortune 500 health care management company in patent infringement case involving an alleged comprehensive health care management system.
- Defended several public companies against allegations of patent infringement involving bar code scanning technology.
- Defended a pharmacy benefit management company against allegations of patent infringement involving machine-vision technology.
- Represented a chemical processing company in patent licensing and inventorship dispute involving chemical purification process.
- Represented a casino game manufacturer in copyright infringement litigation against competitor.
- Defended a Fortune 100 insurance company against allegations of architectural works copyright infringement in an apartment complex.
- Represented a traffic control technology company in trade secret misappropriation case.



- Represented several companies in connection with allegations of breach of software development contracts involving enterprise-level systems in industries including health care, food services, retail products and sports memorabilia.
- Defended a semiconductor equipment manufacturer in software infringement litigation.
- Represented a software developer in copyright infringement dispute against competitor.
- Defended a specialty care product distributor in trade dress infringement case.
- Defended a computer device manufacturer in trademark/Internet domain name dispute.
- Defended a software development company against allegations of assisting in violating restrictive covenants by hiring former senior executives.
- Defended a paper products manufacturer against allegations of unfair competition and intentional interference with employment relationships.

## Recognitions

- 2019 West Coast Top Rated Lawyers, ALM
- AmLaw Top Rated Lawyer in Intellectual Property Law, 2018
- American Bar Association – Fellow
- Martindale-Hubbell® AV Preeminent Rating for Twenty Years
- *The Best Lawyers in America*® 2007-Present (Copyright Law, Litigation-Intellectual Property, Litigation-Patent, Patent Law)
- "Top Attorneys of Southern California," *Los Angeles Times*, 2016
- "Top Rated Lawyers," *San Francisco Chronicle*, 2015
- "Top Rated Lawyers," *The Arizona Republic*, 2015-2016
- "2013 Top Lawyers," *San Diego Magazine*, March 2013
- *Super Lawyers*® 2007-2012 (Intellectual Property Litigation)



## Community

- American Arbitration Association – Large Complex Case Advisory Committee, National Patent Advisory Committee
- American Bar Association
- American Intellectual Property Law Association – Professionalism & Ethics Committee, Alternative Dispute Resolution Committee Chair
- ASU Sandra Day O'Connor College of Law – Center for Law, Science, & Innovation Advisory Board
- Federal Bar Association – President, Board Member
- Intellectual Property Owner's Association – Alternative Dispute Resolution Committee
- International Trademark Association – Alternative Dispute Resolution Committee
- Licensing Executives Society – Chapter Chair
- State Bar of Arizona – Intellectual Property Section Chair
- The Copyright Society of the USA – Southwest Chapter Chair
- The Sedona Conference® – Board of Directors, Pro Bono General Counsel, Executive Committee

## Education

- JD, Boston College Law School, *magna cum laude* (*Law Review* invitee)
- BS (Computer Science), Boston College, *magna cum laude*

## News Coverage

- Moran, Lyle. "Law Briefs," *The Daily Transcript*, January 21, 2015.
- "Burns and Miller Elected Partners at Procopio," *San Diego Metro Magazine*, January 21, 2015.
- Alltucker, Ken. "Court ruling should make cancer-gene test more accessible," *The Arizona Republic*, June 20, 2013.
- "Technology-assisted review latest trend in e-Discovery," *The Daily Transcript*, May 1, 2013.
- "Demand for lower fees forces creativity," *The Daily Transcript*, May 1, 2013.



- "Talk of the Town," *Attorney at Law Magazine*, January 2013.
- "Procopio Attorney Burns Presents Before the American Arbitration Association's Annual Neutrals Conference," *Attorney Journal*, May 2, 2012.

## Seminars

- "Expert Roundtable I: Government Investigations & Regulatory Actions; IP and Tech Litigation," The Sedona Conference Institute's 7th Annual e-Discovery Program: Living on e-Discovery's Cutting Edge, San Diego, CA, March 21-22, 2013.
- "Technology Assisted Review (TAR): What, Why, When, and How," The Sedona Conference Institute's 7th Annual e-Discovery Program: Living on e-Discovery's Cutting Edge, San Diego, CA, March 21-22, 2013.
- "ESI in ADR - When the FRCP Do Not Apply," ASU-Arkfeld e-Discovery and Digital Evidence Conference, Tempe, AZ, March 13-15, 2013.
- "Protecting Your Intellectual Property: When to Rely on Trade Secrets, Copyrights and Trademarks and what to do to Avoid a Patent Infringement Suit," Procopio and SV Forum, Palo Alto, CA June 13, 2012.
- "IP & Employment Matters - Common, Costly Mistakes for Start-up Entrepreneurs to Avoid," Procopio and SV Forum, Palo Alto, CA, May 22, 2012.