



Joseph E Palys

Partner, Litigation Department

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Joe Palys is a partner in the Intellectual Property practice at Paul Hastings and is based in the firm's Washington, D.C. office. He focuses his patent practice on IP litigation and post-grant proceedings, as well as patent portfolio monetization and management. Mr. Palys is a former USPTO supervisory patent examiner (SPE) and leans on his more than twenty years of patent experience to counsel clients regarding district court and Federal Circuit appeal matters, along with *Inter Partes* Review (IPR) and Post Grant Review (PGR, CBM) proceedings implemented under the America Invents Act (AIA). He has extensive experience coordinating federal court and post-grant proceedings. He is the current chair of the recently-formed PTAB Bar Association's Program committee, and routinely presents on AIA-related topics.

His cases involve complex technologies, such as microprocessor and digital signal processing systems, computer and network architectures and systems, mobile device communications, semiconductor technologies, touchscreen technologies, ERP and business software systems, computer and network security, operating systems, and business methods.

Recent Representations

- Represented clients in over 200 IPRs and CBMs, and dozens of reexamination proceedings, including eBay, VirnetX, Mitek Systems, CoreLogic, Samsung, Walgreens, Wintek, Google, SAP, and Zimmer.
- Represented SAP in the first filed CBM-PGR proceeding under the AIA and in cases in district court, the Federal Circuit, and the U.S. Patent and Trademark Office.
- Represents The Walgreen Company in a patent litigation involving coupon redemption processes in the U.S. District Court for the Eastern District of Texas and in related multiple CBM proceedings before the PTAB.
- Represents L'Oréal USA, Inc. in a District of Delaware action involving hair care technologies.
- Represented SAP in district court, the Federal Circuit, and the U.S. Patent and

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Practice Areas

Life Sciences and Healthcare
Technology
Patent Litigation
Patent Office
Intellectual Property
ITC Section 337
Investigations
Litigation

Admissions

District of Columbia Bar
Virginia Bar
United States Patent &
Trademark Office

Education

The George Washington
University Law School, J.D.
2004
The Pennsylvania State
University, B.S.E.E. 1992

Joseph E Palys (Continued)

- Trademark Office (USPTO) regarding an asserted patent relating to supply chain software, and in a multi-patent infringement case and reexaminations relating to supply chain and supplier relationship management technologies.
- Represented Wintek Corporation as lead counsel in patent infringement cases involving touch panel technologies in the U.S. District Court for the Eastern District of Texas and the U.S. District Court for the Northern District of California. Also led multiple IPR matters involving the related patents.
 - Represented Huawei as lead counsel in patent infringement litigations in the District of Colorado and the Eastern District of Texas regarding voice recognition and mobile device communication technologies.
 - Represented ABBYY in a multi-patent infringement litigation involving character recognition technologies in the U.S. District Court for the Northern District of California and also led ABBYY's reexamination challenges of multiple patents before the USPTO.
 - Represented BIAX Corporation in multiple patent infringement litigations relating to parallel microprocessor technologies in the ITC, District of Colorado, and Eastern District of Texas.
 - Represented AOL in multi-patent infringement litigations involving content filtering and parental control software in the Eastern District of New York and Eastern District of Texas.
 - Represented InterVideo in patent cases involving computer power-up processes in the ITC and in reexamination proceedings.
 - Represented AeroScout in a patent infringement litigation involving remote sensor technologies.

Accolades and Recognitions

- Recognized as a top patent professional by Intellectual Asset Management in its IAM Patent 1000: The World's Leading Patent Professionals 2016

Speaking Engagements and Publications

- Speaker, Leveraging Latest Patent Decisions, Navigating New Complexities, Cases to Watch in 2017, Strafford CLE Webinar, January 26, 2017
- Coauthor, "Some Fed. Cir. Guidance on Procedural Safeguards for PTAB," Law360, June 30, 2016
- Coauthor, "Cuozzo Speed Technologies, LLC v. Lee: Business as Usual and Uncertainty for Post-Grant Proceedings," On the Docket, George Washington Law Review, June 26, 2016
- Coauthor, "PTAB Provides Guidance on AIA Estoppel Provisions," Managing IP.com, November 2015
- Speaker, USPTO's Proposed Changes to PTAB Practice: A Primer on the

Joseph E Palys (Continued)

- Recently Proposed Amendments to the Rules Governing PTAB Proceedings, AIPLA Webinar, October 6, 2015
- Speaker, Post-Grant Proceedings Under the AIA: Overview and Discussion, Yale University Law School, October 1, 2015
 - Speaker, The Twilight Zone of Privacy – A Lively Discussion of Privilege, 88th Annual Meeting Intellectual Property Institute of Canada, October 15-17, 2014
 - Speaker, Post-Grant Proceedings Under the AIA: Lessons Learned & Best Practices, APABA-SV, Palo Alto, CA, September 18, 2014
 - Speaker, IP Counsel Exchange on Post Grant Patent Challenges at the PTAB, Momentum Events, Palo Alto, CA, February 27-28, 2014
 - Coauthor, “The Practitioner’s Guide to Trials Before the Patent Trial and Appeal Board,” American Bar Association, Section of Intellectual Property Law, 2014
 - Speaker, Workshop on Strategic Use of Administrative Invalidation Proceedings in Patent Litigation, Shenzhen, China, December 5, 2013
 - Speaker, Advanced Intellectual Property Seminars, Shanghai, China, December 2, 2013
 - Speaker, 7th Annual U.S. Patent Litigation Training Program for Asian Corporations, Washington, D.C., September 23-27, 2013
 - Speaker, APABA-SV Meeting, Asian Pacific American Bar Association-Silicon Valley (APABA-SV), Palo Alto, CA, September 12, 2013
 - Speaker, Patents for Financial Services Summit, World Congress, New York, NY, July 24-25, 2013
 - Speaker, Strategies and Insights on Post-Grant Review Proceedings, Silicon Valley Intellectual Property Law Association, Palo Alto, CA, June 20, 2013
 - Coauthor, “Innovation in Audio: Update on Patent Activity in the Audio Field,” Audio Engineering Society, May 3, 2013
 - Speaker, IP Counsel Forum for Social Media and Big Data, World Research Group (WRG), New York, NY, November 7-8, 2012
 - Speaker, 6th Annual U.S. Patent Litigation Training Program for Asian Corporations, Washington, D.C., October 29-November 2, 2012
 - Speaker, Patents for the Financial Services Industry, World Research Group (WRG), New York, NY, July 25-26, 2012
 - Speaker, 5th Annual U.S. Patent Litigation Training Program for Asian Corporations, Washington, D.C., September 26-30, 2011
 - Speaker, Patents for Financial Services Summit, World Research Group (WRG), New York, NY, July 27-28, 2011
 - Speaker, 4th Annual U.S. Patent Litigation Training Program for Asian Corporations, Washington, D.C., September 27-October 1, 2010
 - Speaker, Patents & The Financial Services Industry, World Research Group

Joseph E Palys (Continued)

(WRG), New York, NY, July 28-29, 2010

- Speaker, Intellectual Property Protection for the Financial Services Industry, Global Media Dynamics, New York, NY, March 8-9, 2010
- Speaker, 3rd Annual U.S. Patent Litigation Training Program for Asian Corporations, Washington, D.C., September 21-25, 2009

Professional and Community Involvement

- Member, PTAB Bar Association, Chair, Program Committee
- Member, American Intellectual Property Law Association
- Member, American Bar Association
- Member, Virginia Bar Association
- Former supervisory patent examiner (SPE) and primary examiner at the USPTO where he examined patent applications involving computer network security, computer fault tolerance and recovery, and error detection technologies, 1993-2000
- Former Sergeant, U.S. Army Reserves, 1st Battalion, 314th Infantry Regiment, 79th Infantry Division, 1987-1995

Education

- George Washington University Law School, J.D., with honors, 2004
- Pennsylvania State University, B.S., Electrical Engineering, 1992
- Admitted to District of Colorado, District of Columbia, Virginia, U.S. Court of Appeals, Federal Circuit, and U.S. Patent and Trademark Office

News

September 19, 2019

Paul Hastings Wins at LMG Life Sciences Awards

July 26, 2019

Paul Hastings Nominated for Four LMG Life Sciences Awards

June 24, 2019

Paul Hastings Recognized in 2019 Managing Intellectual Property's IP Stars

June 07, 2019

Paul Hastings Recognized in 2019 IAM Patent 1000 as One of the Most Sophisticated Patent Litigation Practices

June 15, 2018

Joseph E Palys (Continued)

Paul Hastings Recognized in 2018 IAM Patent 1000 For Superb Track Record in Patent Litigation

August 08, 2017

Paul Hastings Recognized in 2017 IAM Patent 1000 for Pristine Patent Litigation Track Record

February 09, 2017

Paul Hastings Intellectual Property Practice Continues Leadership in PTAB Filings

May 26, 2016

CoreLogic Wins IPRs

January 07, 2016

Paul Hastings Leader in PTAB Filings, Naveen Modi Top Overall in Individual Filings

March 30, 2015

Nationally Recognized Technology Patent Trial Team Join Paul Hastings in Palo Alto and Washington, D.C.

July 14, 2014

Paul Hastings Continues IP Growth in Washington, DC with Leading Post-Grant Proceedings Partner

Insights

November 01, 2019

Federal Circuit Rules PTAB APJs Violate Appointments Clause

May 10, 2018

USPTO Proposes Changing Claim Construction Standard for IPRs, PGRs, and CBMs

April 25, 2018

A Divided Supreme Court Upholds Inter Partes Review's Constitutionality but Constrains the Patent Office's Authority

January 10, 2018

Joseph E Palys (Continued)

PTAB Section 315(b) Time-Bar Determinations Reviewable at the Federal Circuit

October 10, 2017

Aqua Products, Inc. v. Matal: Petitioners Bear the Burden of Establishing the Unpatentability of Amended Claims in IPR Proceedings

August 08, 2017

No Article III Standing Requirement for Appellees in Appeals From IPR Proceedings

May 16, 2017

Prosecution History Disclaimer Extends to IPR Proceedings

June 23, 2016

Supreme Court Upholds the BRI Standard and Provides Guidance on Judicial Review

June 16, 2016

Federal Circuit Provides Guidance on the APA's Procedural Safeguards for PTAB Proceedings

April 04, 2016

More Rule Changes for PTAB Proceedings

August 26, 2015

Important Things You Should Know about the Patent Office's New Guidance Regarding PTAB Proceedings

July 20, 2015

Federal Circuit Rules on Appealability in Post-Grant Proceedings and on What Is a CBM Patent

April 01, 2015

Quick Fixes Implemented, New Rules on the Way for PTAB Trial Practice

February 12, 2015

The Federal Circuit Offers Guidance on Appealability and the Claim Construction Standard in *Inter Partes* Review Proceedings

Joseph E Palys (Continued)

June 07, 2019

Recognized by IAM Patent 1000 for 2019

April 05, 2019

Recognized by Managing IP as the Life Sciences IP Litigation Firm of the Year

January 30, 2019

Recognized as the 2019 Post-Grant Firm of the Year by IAM Magazine

September 13, 2018

Recognized as the Hatch-Waxman Litigation Firm of the Year by LMG Life Sciences

June 15, 2018

Recognized by IAM Patent 1000 for 2018

June 06, 2017

Recognized by IAM Patent 1000 for 2017

May 27, 2016

Recognized by IAM Patent 1000 for 2016