

Mark D. Schuman
Carlson, Caspers, Vandenburg
and Lindquist
225 South Sixth Street, Suite 3200
Minneapolis, MN 55402
Telephone: 612.436.9650
Fax: 612.432.9605
Cell: 612.805.2225



Legal

- Partner, Carlson, Caspers, Vandenburg & Lindquist, 2008-Present
- Partner, Merchant & Gould, 1992-2008
- Associate, Merchant & Gould, 1986-1992
- Law Clerk, Judge Friedman, United States Court of Appeals for the Federal Circuit, 1985-1986
- Adjunct Professor, University of Minnesota Law School, 1987-1992

Education

- J.D., University of Wisconsin-Madison, *cum laude*, law review, law review editor, Order of the Coif, 1985
- B.S., Chemical Engineering, Northwestern University, with distinction, Tau Beta Pi, Omega Chi Epsilon, 1982

Bar Admissions

- Wisconsin State Bar, 5-24-85
- Minnesota State Bar, 10-3-86
- United States District Court for the District of Minnesota, 11-5-86
- United States District Court for the Eastern District of Michigan, 7-22-92
- United States District Court for the Eastern District of Wisconsin, 3-3-99
- United States Supreme Court, 5-22-89
- United States Court of Appeals for the Eighth Circuit, 12-8-86
- United States Court of Appeals for the Tenth Circuit, 9-19-89
- United States Court of Appeals for the Federal Circuit, 4-6-87

Awards

- Robert C. Watson Award, American Intellectual Property Law Association, 1984

Practice Description

Mr. Schuman's practice encompasses contested matters in the United States District Courts, state courts and administrative agencies. Mr. Schuman has participated in numerous district court trials to both the bench and jury on matters related to patents, trademarks and other intellectual property rights. He also has participated in numerous Markman hearings. He has, for many years, took first chair responsibility for litigation at Merchant & Gould. Mr. Schuman obtained a temporary restraining order and seizure order against a Taiwanese company. He also has headed ANDA litigation over the drugs Prilosec®, Protonix®, Zantac® oral solution, Axert®, and Nitro-Dur®.

Mr. Schuman's technology exposure has been broad. He has headed litigation involving electronic circuitry, mechanical devices, optics, surface roughness, chemical compositions, adhesives, software and pharmaceutical drugs.

Mr. Schuman's other work experiences include advising clients on licensing, and providing infringement and validity opinions. He has advised clients on design-around strategies.

For a number of years, Mr. Schuman managed the intellectual property portfolio of a company in Alexandria, Virginia. The portfolio included United States utility and design patent, their foreign counterparts and United States and foreign trademarks. While representing this client he supervised a patent revival suit in Switzerland, a patent infringement suit in Germany, a validity suit in Great Britain, and a trademark cancellation in Japan. Mr. Schuman was Merchant & Gould's foreign litigation contact.

Mr. Schuman has an interest in litigation automation. He serves as the Chair of Merchant & Gould's automation steering committee and on the automation steering committee of the Minnesota Federal District Court. Mr. Schuman filed the first [inter partes hypertext brief](#) to be accepted by the Federal Circuit.

Mr. Schuman is active in bar organizations and currently is the past Chair of AIPLA's Patent Litigation Committee. He currently serves on AIPLA's nomination committee.

Organizations

- Wisconsin State Bar
- Minnesota State Bar
- American Bar Association
- American Intellectual Property Law Association
- Federal Circuit Bar Association
- Minnesota Intellectual Property Law Association

Papers and Talks

- [Patent Protection for Microbiological Processes: Has In re Argoudelis Been Mutated?](#), 1985 Wis. L. Rev. 1697 (winner of the AIPLA's Robert C. Watson Award in 1984).
- Appellate Advocacy*, Litigation Committee of the American Intellectual Property Law Association, Los Angeles, CA, Spring meeting, 1989
- Forum on Appellate Advocacy*, Minnesota Intellectual Property Law Association's Spring Roundup, 1989
- [A Guide to United States Patent Litigation](#), 3rd Edition, Merchant & Gould, March 2003
- Confidentiality on the Internet*, Internet Seminar sponsored by Merchant & Gould, spring 1996
- [Relearning the 3 Rs of Intellectual Property Law for the Computer Industry](#), Minnesota State Bar Association, CLE, October, 1996
- Internet Security*, Global Business Strategies and Solutions with Internet, Intranet and Emerging Technologies, Minnesota Trade Office, November 1996
- [Dare I Connect My Laptop to the Internet: Confidentiality Issues Surrounding the Internet](#), Emerging Technologies Committee of the American Intellectual Property Law Association, Palm Springs, CA, Mid-Winter meeting, 1997
- [An Introduction to Markman Hearings](#), 1998 MIPLA CLE Stampede, Minneapolis
- [Hypertext Briefing](#), First Bench and Bar Meeting of the Federal Circuit, St. Thomas, VI, April, 1998
- [How to Avoid Pitfalls on Appeal to the Federal Circuit](#), American Intellectual Property Law Association, Washington, D.C., Annual Meeting, 1998
- [Hypertext Briefing](#), Daily Journal Legal Works, The Technology Answer Show Conference & Exhibition, Glasser Legal Works, 1999
- [Hypertext \(Interactive\) Briefing](#), Litigation Technology Summit, New York, June 7-8, 1999
- [Hypertext \(Interactive\) Briefing](#), Legal Works 2000, March 6-7, 2000

- [Hypertext Briefing](#), Law Practice Quarterly, June 2000
- [Enforcing Patents on Pharmaceuticals](#), Minnesota Intellectual Property Law Association Biotechnology Meeting, 2002
- [Brief Briefs & Appealing Appeals: Tips for Better Appellate Advocacy](#), MIPLA Roundup, Minneapolis MN
- [AIPLA Resolution to amend 35 U.S.C. § 284](#)
- [AIPLA Resolution to amend the Patent Marking Statute](#)
- [AIPLA Resolution to eliminate the legislative inference](#)
- [A summary of Comments on the Damage Reform Resolutions](#), AIPLA 2002 Annual Meeting, Washington, D.C.
- [President's Forum on Patent Damages](#), American Intellectual Property Law Association, Atlanta Spring Meeting, 2003
- Program Moderator and Judge's Panel Moderator, AIPLA Patent Litigation Roadshow, Minneapolis, June 2003
- [Representing Youth in Foster Care](#), Children's Law Center of Minnesota News, Volume II, No. 1, Fall/Winter 2003
- [AIPLA Markman Subcommittee Interpretation of Patent Claims](#), AIPLA Quarterly Journal, Volume 31, No. 1, Winter 2004
- [Willful Infringement Prior to the Federal Circuit: Statutes and Cases](#). AIPLA Mid-Winter Meeting, Orlando Florida, January 26-29, 2005
- [Mediation/Arbitration/ADR - When and What to do in the Courtroom of the Future](#), INTA Annual Meeting, Atlanta GA, May 1-5 2004
- [Reaching the Summit - Prevailing at the Federal Circuit](#), IP Value - January 2005 ed.
- [A Resolution on District Court Specialization](#), AIPLA Mid-Winter Meeting, La Quinta, CA, February 1, 2006
- Comparative Evidence Gathering Mechanisms Around the World, AIPLA 2006 Annual Meeting, Washington, D.C., 2005
- [Markman Hearings](#), ABA/MIPLA Seminar, Minneapolis, MN, 2006
- [The Sedona Guidelines: Best Practices Addressing Protective Orders, Confidentiality and Public Access in Civil Cases](#), AIPLA Spring Meeting, Chicago, IL, May 3-5, 2006
- [E-tools for Effective Case Management](#). FICPI 10th Open Forum, Seville, Spain, 2007
- [Laches, Estoppel and Declaratory Judgment: Peril in the Face of Inaction](#), AIPLA Mid-Winter Institute, New Orleans, LA, 2007

Activities

- United States District Court for the District of Minnesota. Technology Advisory Committee, 1999-present
- United States District Court for the District of Minnesota. Electronic Case Filing Advisory Committee, 2002-present
- Minnesota Advocates for Human Rights. Pro Bono Volunteer
- Children's Law Center. Pro Bono Volunteer

- American Intellectual Property Law Association. Chair of Subcommittee on Patent Marking Reform, 2002-2007
- American Intellectual Property Law Association. Chair of Subcommittee on Patent Damages Reform, 2003-2007
- American Intellectual Property Law Association. Vice Chair of Patent Litigation Committee, 2003-2005
- American Intellectual Property Law Association. Chair of Patent Litigation Committee, 2005-2007
- American Intellectual Property Law Association. Nominating Committee, 2008

Professional Rating

-Martindale-Hubbell AV

Representative Clients

Teva Pharmaceuticals, Imation, H.B. Fuller, Ecolab, Pillsbury, ADC, Toro, Schwarz Pharma, Nomadic Display, Belron

Sample Work

Schwarz Pharma's [Videotape](#) Describing the Technology and Matters in Issue, Civ. Action No. 97-498 (D. Del)

Reported Cases

- [Altana v. Teva Pharmaceuticals USA, Inc.](#), Civil Action No. 04-2355 (JLL), U.S. District Court for the District of New Jersey
- [Astra Aktiebolag v. Kremers Urban Development Co.](#), Nos. 99 Civ. 8928 and 99 Civ. 9888, U.S. District Court for the Southern District of New York
- [Key Pharmaceuticals, Inc. v. Schwarz Pharma, Inc.](#), Civ.99 498, U.S. District Court for the District of Delaware
- [Diversey Lever Inc. v. Ecolab Inc.](#), Nos. 98-1380, 1447, 1472, and 1534, U. S. Court of Appeals for the Federal Circuit
- [Faberware Inc. v. Alternative Pioneer Systems Inc.](#), No. 90 Civ. 4163, U.S. District Court for the Southern District of New York
- [Spectronics Corp. v. H.B. Fuller Co. Inc.](#), No. 91-1041, U.S. Court of Appeals for the Federal Circuit
- [Padco Inc. v. Newell Companies Inc.](#) (Unpublished), Nos. 88-1584, 1585, U.S. Court of Appeals for the Federal Circuit

-Padco Inc. v. Newell Companies Inc., No. 85-C-1325, U.S. District Court for the Eastern District of Wisconsin

-H. B. Fuller Co. v. National Starch and Chemical Corp., No. 4-85-1632, U.S. District Court for the District of Minnesota

Litigation Experience

Lead Counsel

-Altana v. Teva Pharmaceuticals USA, Inc. (D.N.J.)

Mr. Schuman is leading a trial team for defendants seeking to introduce a generic version of Protonix into the marketplace. The case currently is pending.

-Glaxo v. Teva Pharmaceuticals USA, Inc. (D. DEL)

Mr. Schuman is leading a trial team for a client seeking to introduce a generic version of Zantac® oral solution. The case settled favorably for the client.

-Celgene v. Teva Pharmaceuticals USA, Inc. (D.N.J.)

Mr. Schuman is leading a trial team for a client seeking to introduce a generic version of Focalin®. The case currently is pending.

-Almirall v. Teva Pharmaceuticals USA, Inc. (S.D.N.Y.)

Mr. Schuman is leading a trial team for a client seeking to introduce a generic version of Axert®. The case settled favorably for the client.

-Nisus v. Perma-Chink

Mr. Schuman co-trieed a case for Nisus over a borate containing wood preservative product. Mr. Schuman also conducted the Markman hearing for this case.

-Astra v. Kremers Urban Development Co. and Schwarz Pharma (S.D.N.Y)

Mr. Schuman led a trial team with as many as 14 attorneys defending a client seeking to introduce a generic version of Prilosec into the market. Prilosec had domestic sales of \$10,000,000 a day and the litigation was hotly contested. The case was put into multi-district litigation for discovery with three other defendants. At trial, only Kremers Urban Development Co. and Schwarz Pharma were found not to infringe the patents and, therefore, were the only defendants able to introduce a generic version of Prilosec into the market. The decision will be worth hundreds of millions of dollars to Kremers Urban Development Co. and Schwarz Pharma.

-Key Pharmaceuticals v. Schwarz Pharma (D. Del.)

Mr. Schuman represented a defendant seeking to introduce a generic version of a transdermal nitroglycerin patch to treat angina. Following a successful Markman determination, a settlement was reached in the case allowing Schwarz Pharma to

introduce its generic transdermal nitroglycerin patch into the United States market.

-Sabinsa v. Leward Resources and Indfrag (D.N.J.)

Mr. Schuman represented a nutraceutical company from India who was accused of infringing a patent covering the use *coleus forskohlin* for weight loss. A settlement in the case resulted in Mr. Schuman's clients' ability to sell *coleus forskohlin* in the United States.

-Diversified Dynamics v. Wagner (D. Minn.)

Mr. Schuman represented the patent holder in this patent infringement suit over a valve for consumer wall painting products. After discovery, the case settled with a cash payment to Mr. Schuman's client and a cross-license of technology between both parties.

-Spectronics v. Detector Electronics (Fed. Cir.)

Mr. Schuman was lead counsel on this appeal related to smoke detector technology. A decision is pending at the Federal Circuit.

-Ecolab v. Gardner (Fed. Cir.)

Mr. Schuman was lead counsel in an appeal that included an emergency motion to force the district court to send the case to arbitration. Mr. Schuman was able to defeat the emergency motion and, in the process, was able to have the appeal dismissed without further briefing.

-Kinetics Fluid Systems v. Talon Innovations (N.D. Cal.)

Mr. Schuman represented the defendant in a patent infringement case related to modular components for the handling of ultra-low impurity gases for use in semiconductor manufacturing. After discovery in the case, Mr. Schuman was able to negotiate a cross-license arrangement that extended beyond the products in dispute.

-Spectronics v. H.B. Fuller (E.D.N.Y.)

Mr. Schuman represented the defendant in a declaratory judgment case of patent infringement related to florescent dyes for automotive air conditioning systems. After discovery, Mr. Schuman was able to have the case dismissed. Mr. Schuman also handled the appeal in which the district court's decision was affirmed on appeal.

-Blackwolf Lodge v. Zurich American & Capitol Indemnity v. Kohler Co.
(E.D.Wis.)

Mr. Schuman represented the trademark owner in a trademark dispute over the trademark BLACK WOLF RUN for golf courses. After discovery, the infringer agreed to change its name in accordance with Mr. Schuman's client's wishes.

-Kohler Company v. Madison Baseball (W.D. Wisc.)

Mr. Schuman represented the trademark owner in a trademark dispute over to the trademark BLACK WOLF RUN for golf courses. After discovery, the infringer stopped using the trademark.

-3M v. Athana (N.D. Cal.)

Mr. Schuman represented 3M in a patent infringement case related to magnetic tape. After extensive discovery, the defendant paid 3M a multi-million dollar settlement.

-3M v. Verbatim (N.D. Cal.)

Mr. Schuman represented 3M in a patent infringement case related to magnetic tape. After extensive discovery, the defendant paid 3M a multi-million dollar settlement.

-Nomadic Displays v. Skyline Displays (U.S. Pat. Office)

Mr. Schuman represented Nomadic Displays in an interference proceeding in the United States Patent Office related to tradeshow display technology. The case resulted in a settlement after Mr. Schuman prevailed on preliminary motions.

Co-Counsel

-Toro v. Scag (D. Neb.)

Mr. Schuman represented the plaintiff, Toro, in a lawsuit involving four patents related to lawn mower technology. After extensive discovery, the case settled with a multi-million dollar payment to Toro.

-Farberware v. Alternative Pioneer Systems (D. Minn.)

Mr. Schuman represented Alternative Pioneer Systems as a defendant in a patent infringement lawsuit on a convection oven. After extensive discovery, settlement was reached.

-Radisson v. Starwood (D. Minn.)

Mr. Schuman represented Radisson in a patent infringement suit related to a computer reservation reward system. After extensive discovery, the defendant paid Radisson a multi-million dollar settlement.

-National Starch v. H.B. Fuller (D. Minn.)

Mr. Schuman represented the defendant on a patent related to block copolymer adhesives for use in diapers. The case was tried to a judge and the result was a verdict of less than \$100,000 against H.B. Fuller.

-Padco v. Newell (E.D. Wis.)

Mr. Schuman acted as co-counsel for Padco in a patent infringement case related to covered paint rollers for consumer wall painting. After a trial to a jury, the jury awarded a multi-million dollar verdict to Padco. The award was affirmed on appeal.

-Cohen v. 3M (D. Minn.)

Mr. Schuman represented 3M as the defendant in a patent infringement case involving diffractive bifocal contact lenses. After extensive discovery, 3M obtained a license on the technology.

-Skyline Displays v. Nomadic Displays (D. Minn.)

Mr. Schuman represented Nomadic Displays on a patent dispute over tradeshow display stands. After extensive discovery, Nomadic Displays was able to continue manufacturing their product.

-Dacomed v. Medical Engineering Corp. (D. Minn.)

Mr. Schuman represented Dacomed in a patent infringement lawsuit related to penile rigidity and tumescence monitors. After extensive discovery, the parties entered into a cross-licensing arrangement.

-Wollard v. Harris Watson Yachts (S.D. Fla.)

Mr. Schuman represented Harris Watson Yachts in a patent infringement dispute related to boat hull design. After a jury trial, the jury found that Harris Watson Yachts did not infringe the patent.