

Paul C. Onderick

Partner

Minneapolis, Minnesota

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Service Areas:

- Intellectual Property

Education:

- J.D., *cum laude,* University of Minnesota Law School
- O.D., Indiana University
- B.S., Optometry, Indiana University
- Chemistry Major, Kentucky Wesleyan College

Admissions:

- Minnesota
- Minnesota Supreme Court
- U.S. District Court for the District of Minnesota
- U.S. Court of Appeals for the 8th Circuit
- U.S. Patent and Trademark Office

Paul is a partner in the firm's Minneapolis office and is a member of the Intellectual Property Group and he is also a licensed optometrist. He may be the only patent attorney in the country who is also a licensed optometrist with a history of clinical practice. He assists clients with protecting, developing, and managing their patent portfolios and enforcing their IP rights. He enjoys developing intellectual property strategies that contribute to the success of the exceptionally talented and driven innovators who are his clients.

His experience as a licensed optometrist benefits many of his clients who seek to protect innovations in technologies that relate to his background in optometry, including optical products such as microscopes and digital projectors, clinical and surgical instrument-related products, heads-up and night vision displays, and laser-refractive surgical technologies. In addition to his work related to optometry inventions, Paul also works with manufacturers who develop biomedical instruments, automated and robotic manufacturing equipment, and other medical devices. In the area of mechanical devices, he has assisted numerous clients with obtaining patent protection for their intellectual property.

While in clinical practice, Paul was responsible for diagnosis and treatment of eye disease, monitoring disease progression and coordinating care with sub-specialists for conditions such as diabetic retinopathy, dry and wet aging related macular degeneration, retinal and choroidal dystrophies and degenerations, anterior segment disease and vitreous disease.

Prior to becoming a patent lawyer, Paul was a clinical optometrist for nearly twenty years. He was president and owner of Professional Eye Care, Ltd., where he cared for patients and managed the day-to-day operations of the business. His broad scientific background, which includes areas of optics, medicine, biology, biotechnology, chemistry, and physics, coupled with first-hand knowledge of the running a business, gives him a unique ability to relate to the needs of his clients.

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Representative Technology Experience

- Cataract & Intraocular surgery
- Surgical microscopes
- Refractive, vitreo-retinal & glaucoma surgery
- LASIK (Laser Assisted in Situ Keratomileusis) procedures
- FLEx (Femtosecond Lenticule Extraction) procedures
- Small incision lenticule extraction (SMILE) procedures
- Ophthalmic clinical instruments
- Femtosecond & excimer lasers
- OCT (Optical Coherence Tomography
- Microsurgery & surgical instruments
- ZEISS technology
- Automated manufacturing systems, including window and door manufacturing
- Mechanical devices
- Post Grant Proceedings
- IP Licensing
- Appeals to the Patent Trial and Appeal Board

Affiliations

- Past Director and Treasurer, Central Minnesota Legal Services
- Member - American Bar Association
- Member - American Intellectual Property Law Association
- Member - Hennepin County Bar Association
- Member - Minnesota Intellectual Property Law Association
- Volunteer - Children's Law Center of Minnesota, volunteer attorney representing children in foster care
- Volunteer - White Bear Center for the Arts

Articles & Presentations

- "In Black and White" - The Ophthalmologist, December 2018
- "The New Patent Landscape: What Innovators in Low Vision Rehabilitation Should Know" - Envision Conference, September 2016
- "The New Patent Landscape: What Innovators in Low Vision Rehabilitation Should Know About Recent Changes to US Patent Laws" - Envision Conference, September 2015
- "Qualifying for Micro-entity status: Implications for Universities and TTOs, Technology Transfer Tactics" - Vol. 7, No. 7 (pp. 97 – 112) July 2013
- "The Request for Continued Examination (RCE) and How to Make Yours a Priority" - Ideas on Intellectual Property Law, April/May 2013
- "USPTO's Narrow Interpretation of Prior Art Could Make Grace Period Exceptions "All But Non-Existent" - The Tech Transfer Blog, October 2012
- "Mayo Laboratories v. Prometheus: Medical Trademarks and the Future" - Minnesota Business Magazine, July 2012
- "Interested in Patent Protection? Beware of Statutory Bars" - University of Minnesota Duluth (UMD) Center for Economic Development Newsletter, June 2012
- "Recent Court of Appeals Decision Strengthens Design Patents" - University of Minnesota Duluth (UMD) Center for Economic Development Newsletter, May 2012
- "Even a Patent Can be Decorative" - Minnesota Business Magazine online, December 2009
- "Don't "Over-License" Your Patent Rights" - Ideas on Intellectual Property Law, September 2009
- "Reflections: From Patients to Patents" - Optometric Management, March, 2009

Notable Representations

- Successfully utilized trade dress enforcement to stop competitors who were copying the distinct look of our client's world leading wearable magnification products
- Completed appeal to the Board of Patent Appeals and Interferences on a patent application for a surgical microscope including making oral arguments before the board. The appeal led to the board reversing the USPTO examiner and allowance of all pending claims in the application
- Prepared Patent Owner's Amendment and Response in an ex parte reexamination that led to issuance of a Reexamination Certificate affirming the patentability of all claims in the reexamined patent, which related to computerized microscope-image processing
- Represented a client in nine (and counting) broadening reissue applications and continuation reissue applications seeking broader claim protection than acquired in original patents related to minimally invasive cardiac catheter technologies. The client has successfully enforced the family of patents against multiple competitors and is currently in litigation seeking to enforce the patent family against another competitor