



William K. Merkel, Ph.D.

Partner

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William K. Merkel, Ph.D., has provided a range of intellectual property legal services to a diverse portfolio of clients for more than 15 years. With a current focus on patent prosecution in the biotechnological arts, he has prosecuted numerous domestic and foreign patent applications drawn to such diverse technologies as modulators of metabolic pathways involved in disease states, viral oncotherapies, agricultural developments in the greentech arena, and pharmaceutical products and methodologies. Dr. Merkel's efforts to protect his clients' interests has extended beyond patent issuance, to the litigation of matters requiring court intervention. As a result, his clients gain a trusted resource capable of evaluating and appropriately protecting the most complex technologies.

He has been selected by the *Chicago Law Bulletin's* Leading Lawyer Network as a "Leading Lawyer."

PRACTICE AREAS

- Patent Prosecution
- Post-Grant Patent Proceedings

INDUSTRIES

- Biotechnology
- Cleantech and Renewables
- Medical Devices
- Non-Profit Technology Transfer
- Pharmaceutical

REPRESENTATIVE EXPERIENCE

- Successfully prosecuted domestic and foreign patent applications directed to attenuated viral therapeutics for treatment of cancer; also directed successful defenses of two European patents in opposition proceedings.
- Advised client on global patenting strategy for greentech agricultural technologies, and protected the technologies by securing comprehensive domestic and foreign patents.
- Counseled start-up companies and academic institutions on intellectual property strategies able to accommodate the recent economic downturn.
- Counseled clients conducting due diligence inquiries relating to intellectual property portfolios.

Dr. Merkel has secured intellectual property rights in varied biotechnologies such as:

- Anti-cancer therapeutics involving attenuated viruses
- Recombinant expression systems for a variety of biologically active compounds such as growth factors, transcription factors, and signal proteins
- Molecular immunological methodologies for treating infertilities
- Anti-HIV therapeutics
- Plant-based systems for environmental remediation
- Cell growth technologies

He has litigated cases including:

- *Abbott Laboratories v. Biosite Diagnostics, Inc.*, Civil Action No. 94-C-2808 (N.D. Ill.)
- *Hyseq, Inc. v. Affymetrix, Inc.*, Civil Action No. C-97-20188 (N.D. Cal.)

BACKGROUND AND CREDENTIALS

Biotechnology clients benefiting from Dr. Merkel's technical and legal experience have ranged from industry leaders to start-up enterprises. He has experience in medical diagnostics and therapeutics, agricultural and pharmaceutical products and methods, genomics, and medical and agricultural biotechnology. In addition to providing prosecution and litigation services in these areas, he develops intellectual property strategies and assists clients with validity, infringement and patentability opinions.

Dr. Merkel's contributions to the field of biotechnology include graduate-level research that has contributed to our understanding of the molecular genetics of vitamin biosynthesis in prokaryotes. As a Research Fellow, he discovered the Pan Operon, revealing the organization of genes involved in pantothenate biosynthesis, as reported in the peer-reviewed literature. This research experience and advanced training equip him with the ability to thoroughly understand the complex scientific technologies of his clients.

Dr. Merkel received his J.D. from New York University School of Law and his Ph.D. in Biological Sciences from the University of Illinois at Chicago. He earned a B.A. in Economics and Psychology from Knox College.

EDUCATION

- New York University School of Law J.D.
- University of Illinois at Chicago Ph.D., Biological Sciences
- Knox College B.A., Economics and Psychology

ADMISSIONS

- Illinois
- U.S. District Court, Northern District of Illinois
- U.S. Patent and Trademark Office

PUBLICATIONS AND PRESENTATIONS

Summer 2013

"Myriad Further Limits Patent Eligibility"

BioProcessing Journal

Spring 2013

"Patent Exhaustion: A Tireless Limit on Patent Rights"

BioProcessing Journal

Winter 2012/2013

William K. Merkel, Ph.D. and Vivien C. Nielsen, Ph.D. "Induced Patent Infringement Breaks Free from Direct Infringement: The Implications for Bioprocessing"

BioProcessing Journal

January 22, 2013

"IP: The Supreme Court levels its eye at agricultural GMOs"

InsideCounsel

December 25, 2012

"IP: Value in the backwaters of patent law"

InsideCounsel

November 27, 2012

"IP: America Invents Act implementation ends with a bang"

InsideCounsel

April 2012

"Take these steps to ensure your TTO is ready for AIA"

Technology Transfer Tactics

April 2012

"Mayo v. Prometheus: A looming 'disaster' for tech transfer?"

Technology Transfer Tactics