



## Sandip H. Patel

Partner

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Sandip H. Patel has successfully counseled clients in all aspects of patent law. He has helped clients obtain and enforce patents, defend against allegations of patent infringement, and design products and processes to avoid their competitors' patents. Those clients are diverse in size and focus, and have included independent inventors, venture capital investors, specialty chemical companies, universities, and multinational corporations. He has a formal education in chemical engineering, and his day-to-day work deals typically with inventions focusing on chemistry and chemical engineering. But, Mr. Patel's work for the Firm's clients has spanned the entire spectrum of engineering and sciences. And through that experience, he has proven adept at quickly understanding diverse technologies and devising efficient intellectual property strategies that clients have used to achieve their business goals.

Mr. Patel was selected for inclusion in the 2013-2016 *Illinois Super Lawyers*® lists. Only five percent of the lawyers in the state were selected for this honor. He was also selected by his peers for inclusion in the 2016 edition of *The Best Lawyers in America*® in the practice area of Patent Law. Additionally, Mr. Patel has been named an "IP Star" in *Managing IP's* 2016 *IP Stars Survey* (fka the *World IP Handbook and Survey*).

### Practices

- IP Litigation
- Patent Prosecution
- Post-Grant Patent Proceedings

### Industries

- Biotechnology & Life Sciences
- Chemical Sciences
- Cleantech & Renewables
- Consumer Products
- Pharmaceutical

### Representative Experience

- Successfully served as lead counsel in recent patent interferences in the U.S. Patent and Trademark Office, and currently serves as lead counsel in other inter partes proceedings there. Over the years, he has counseled clients in dozens of inter partes matters in the Patent Office in a variety of sciences including biotechnology

(e.g., avirulent vaccines, DNA sequencing methods, genetically-engineered plants, and keratinocyte growth factors), chemistry/chemical engineering (e.g., pharmaceutical compounds and compositions, food processing chemicals, and chemical reactor design), mechanical engineering (e.g., railcar shock absorbers, correction-tape dispensers, and infant diapers), and electrical engineering (e.g., piezoelectric ink-jet printers, process control systems and software).

- Prepared and prosecuted to issuance patent applications relating to consumer products, semiconductors, catalytic reaction engineering processes, industrial chemical compositions, pharmaceutical compositions, and methods of treating various disease states in humans.
- Counseled clients in patent infringement actions in the federal courts involving biotechnology patents (e.g., recombinant growth hormone, recombinant erythropoietin), pharmaceutical chemistry patents (e.g., platinum coordination compounds and methods of treating cancerous tumors), and chemical engineering operations (e.g., air pollution control processes and equipment).

## Background and Credentials

Sandip H. Patel has been a partner of the Firm since 2002, having joined as an associate following his graduation from law school in 1996. While at the Firm, he has drafted and prosecuted hundreds of patent applications, and has served as counsel in numerous contested proceedings in the U.S. Patent and Trademark Office and in associated appeals, and as counsel in a number of patent cases in the federal courts. Mr. Patel also served as chairperson of the Firm's attorney recruiting committee for ten years beginning in 2002.

Mr. Patel received his J.D. from Indiana University Maurer School of Law, in Bloomington, Indiana, in 1996. During law school he served as a Notes and Comments Editor of the *Indiana Law Journal*. He received a B.S. degree (with honors) in Chemical Engineering from Michigan State University in 1993.

## Education

- Indiana University Maurer School of Law (Bloomington) (J.D.)
- Michigan State University (B.S.)
  - Chemical Engineering

## Bar Admissions

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

## Publications and Presentations

April 28, 2016

**"High Court May Be Next Stop For PTAB Deference Issue" (featured quotes)**

*Law360*

May 27, 2015

**"Supreme Court Holds that an Accused Infringer's Belief Regarding Patent Validity is Not a Defense to Induced Infringement"**

*Client Alert*

October 13, 2014

**"Preparing Patents to Withstand AIA Trials and Defending a Patent in AIA Trials"**

*2014 IP Defense Summit, Chicago, IL*

October 2014

**"The amendment conundrum of inter partes review"**

*InsideCounsel*

March 18, 2014

**"The never-ending debate over appellate review of patent claim construction: The debate dividing the Federal Circuit is not likely over, although it should be"**

*InsideCounsel*

February 18, 2014

**"Supreme Court to redefine patent law's definiteness standard: The Supreme Court is poised, yet again, to decide an issue in *Nautilus v. Biosig* hardly requiring its review and one that Congress did not even consider in its recent wholesale revisions to the patent laws"**

*InsideCounsel*

January 21, 2014

**"IP: The murky morass plaguing the patent system: A look back to how we've gotten to this point with section 101 of the 1952 Patent Act"**

*InsideCounsel*

October 30, 2013

**"U.S. Patent and Trademark Office Issues Final Rules to Implement Provisions of the Patent Law Treaty that Change Aspects of U.S. Patent Laws"**

*Client Alert*

April 2013

**Idenix Pharmaceuticals (featured quotes)**

*BioPharm Insight*

November 27, 2012

**"Kappos a Tough Act to Follow as USPTO Director" (featured quotes)**

*Law360*

September 18, 2012

**"Patent office gets face-lift over the weekend with new rules, prices" (featured quotes)**

*Chicago Daily Law Bulletin*

September 2012

**"The America Invents Act -- What Patent Administrators Need to Know"**

*Keynote speaker, Association of Legal Administrators IP Retreat*

December 11, 2009

**"The Limited Benefits of Product-By-Process Claims"**

*Intellectual Property Today*

November 2009

**"Resetting Judicial Doctrine of Inequitable Conduct"**

*Author and Moderator, ABA Roundtable Discussion*

June 2005

**"Patents and Tying: Why the Supreme Court Is Getting Involved"**

*Law360*

April 2005

**"Industries Await Exemption Verdict"**

*Managing IP, No. 14*

1996

**"Graduate Students' Ownership and Attribution Rights in Intellectual Property" 71 Ind. L.J. 481**

## **Representative Inter Partes Matters**

*Adams (Monsanto)\* v. Leemans (Bayer CropSciences)*

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Patent Interference

Biotechnology

*Amgen Inc.\* v. F. Hoffmann-LaRoche LTD et al.*

U.S. District Court, District of Massachusetts

Biotechnology

*Amgen Inc.\* v. Hoechst Marion Roussel*

U.S. District Court, District of Massachusetts

Biotechnology

*Amgen Inc.\* v. United States of America Dept. of Health & Human Services*

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Patent Interference

Biotechnology

*Barton v. Fischhoff\* (Monsanto) v. Adang (Mycogen Plant Science)*

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Patent Interference

Biotechnology

*Braun (Eastman Kodak Company) v. Temple et al. (Xaar Technology Limited)\**

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Patent Interference

Mechanical Engineering, Electrical Engineering/Computer Software

*Chee (Affymetrix) v. Drmanac (Hyseq)\**

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Patent Interference

Biotechnology

*Chen (Bristol-Myers Squibb Co.) v. Hester (Pharmacia & Upjohn Co.)\**

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Patent Interference

Pharmaceutical Chemistry

*Coca Cola Inc. v. The Procter & Gamble Company\**

U.S. Patent and Trademark Office

Inter partes Reexamination

Chemistry

*Correa et al. (Johnson & Johnson) v. Roberts et al. (Procter & Gamble Company)\**

U.S. Court of Appeals for the Federal Circuit

Patent Interference Appeal

Mechanical Engineering

*Crater (Control Technologies Corporation) v. Nixon (Fisher-Rosemount Systems, Inc.)\**

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Patent Interference

Electrical Engineering/Computer Software

*Gardner (Northern Innovations and Formulations Corp.) v. Hastings (Reliv International Inc.)\**

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Patent Interference

Chemistry

*Hester (Pharmacia & Upjohn Co.)\* v. Bouchard (Aventis Pharma S.A.)*

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Patent Interference

Pharmaceutical Chemistry

*Hester (Pharmacia & Upjohn Co.)\* v. Chen (Bristol-Myers Squibb Co.)*

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Patent Interference

Pharmaceutical Chemistry

*Lai v. Palmer (Newell Rubbermaid)\**

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Patent Interference

Mechanical Engineering

*Li (Human Genome Sciences) v. Godiska (ICOS Corp.)\**

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Patent Interference

Pharmaceutical Chemistry

*Macove v. Luxton (The Gillette Company)\**

U.S. Patent and Trademark Office Patent Trial and Appeal Board

Patent Interference

Mechanical Engineering

*Matlin v. Aries (ACCO Brands Corporation)\**

U.S. Patent and Trademark Office Patent Trial and Appeal Board

Patent Interference

Mechanical Engineering

*Martuza et al. (Massachusetts General Hospital) v. Roizman et al. (ARCH Development Corporation)\**

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Patent Interference

Biotechnology

*McDonald (University of Tennessee) v. Miyazaki (Kirin Brewery Company Ltd.)\**

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Patent Interference

Pharmaceutical Chemistry

*Monaco (Keystone Industries)\* v. Kalina (FM Industries)*

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Patent Interference

Mechanical Engineering

*Novo Nordisk v. Pharmacia & Upjohn Co.\**

U.S. District Court, District of New Jersey

Patent Infringement

Pharmaceutical Chemistry and Biotechnology

*Opposition and Appeal re: Baxter International Inc.\* & Baxter Healthcare S.A.\**

Boards of Appeal of the European Patent Office

Patent Opposition and Appeal

Chemical Engineering

*Opposition and Appeal re: Lawrence Industries Inc.\**

Boards of Appeal of the European Patent Office

Patent Opposition and Appeal

Chemistry/Chemical Engineering

*Research Corp. Techs. and Bristol-Myers Squibb Co. v. Ben Venue Labs\* et al.*

U.S. District Court, District of New Jersey

Pharmaceutical Chemistry

*Stevens (Newell Rubbermaid Inc.)\* v. Tamai (Seed Rubber Company)*

U.S. Court of Appeals for the Federal Circuit

Patent Interference Appeal

Mechanical Engineering

*Universite Laval v. Regents of the University of Michigan\**

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Patent Interference

Biotechnology

*Vegenics Pty Limited\* v. Universita Degli Studi di Siena*

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Patent Interference

Biotechnology

\*Party Represented

## **Community and Professional Involvement**

- American Intellectual Property Law Association
- Federal Circuit Bar Association
- Intellectual Property Owners Association