MARSHALL GERSTEIN

Patent Prosecution

Patent Prosecution — Sophisticated Legal Solutions for Complex Portfolios

Today's technologies no longer fall only within distinct categories of biotechnology, chemical, mechanical, electrical, and other arts. Just as products and processes now incorporate multiple disciplines, businesses require counsel with the wide-ranging legal, technical, and scientific experience to develop and implement comprehensive strategies that effectively manage, protect, and maximize value from their intellectual property assets.

A record of success and service
Marshall, Gerstein & Borun has remained focused on intellectual property protection for more than six decades. We earned a reputation for prosecuting business-critical patents and managing high-value patent portfolios for clients worldwide. *Managing Intellectual Property* recently named Marshall Gerstein Patent Prosecution Midwest Firm of the Year. *Chambers USA*, *U.S. News & World Report*, and *Leading Lawyers Network Magazine* also recognized our Firm and individual lawyers for their excellent legal counsel and client service.

World-class IP team with superior technical skills
More than 90 percent of our patent prosecution lawyers, patent agents, and technical specialists have advanced scientific training and are admitted to practice before the U.S. Patent and Trademark Office (USPTO). Many of our lawyers obtained Ph.D. degrees, and in one case an M.D., before beginning their legal careers. As a result, we understand the hard science behind our clients' technical innovations. Perhaps more important — particularly given the rapid pace of technology development — we know *how* to learn, how to apply existing knowledge, and how to adapt proven best practices to our clients' evolving patent opportunities and challenges.

Our lawyer retention rate is high and our dedicated client service teams are extraordinarily stable. We also have an extensive network of foreign patent agents with whom we work daily on international patent matters. Our in-house docketing department is staffed with skilled professionals who monitor and manage high-volume patent portfolios at every step. We integrate the latest available technology to efficiently maintain and enhance our management of matters entrusted to us by our clients. We also routinely consult with IP software solution developers to propose improvements, many of which have been implemented into product updates.

Full-spectrum patent prosecution counsel
The Firm's comprehensive patent prosecution services include:

- Rendering patentability, validity, and non-infringement opinions
- Preparing and prosecuting utility and design patent applications, including preparing and prosecuting reissue applications and re-examinations
- Prosecuting and defending contested post-grant patent proceedings, including *inter partes* reviews (IPRs), post-grant reviews (PGRs), covered business method (CBM) reviews, and patent interferences
- Counseling regarding direct and virtual patent marking
- Analyzing inventorship issues, making inventorship determinations, and creating invention disclosure forms
- Resolving ownership disputes regarding patent rights
- Managing patent interferences and oppositions
- Advising on patent lifecycle management
- Auditing patent portfolios
- Providing in-house educational training and seminars on patent law and related matters

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Enduring, global client relationships
Our clients include U.S. and foreign multinational corporations and middle-market companies in numerous industries such as:

- Biotechnology
- Chemical engineering
- Chemistry
- Computer hardware and software
- Consumer products
- Financial services and insurance
- Life sciences, including healthcare, medical devices, and pharmaceuticals
- Manufacturing
- Online and brick-and-mortar marketing
- Telecommunications and social media
- Travel and hospitality

We also advise research institutions and emerging companies with proven growth technologies. We have represented a number of businesses for more than 20 years and are committed to strengthening all of our client relationships through the consistent delivery of high-quality, cost-effective counsel.

Thought leaders in law and technology
Well before passage of the America Invents Act (AIA), patent law was a complex discipline. As the AIA was being debated, we helped clients prepare for the impact of this sweeping legislation. We frequently leverage USPTO initiatives, such as the Patent Prosecution Highway and Track One accelerated examination procedures, to expedite patent office review of our clients' patent applications.

Our patent lawyers continue to work at the forefront of U.S. and international patent and technology developments. We publish articles in leading journals such as *World Intellectual Property Review* and *Corporate Counsel*, are interviewed by major media outlets, and make presentations to clients, industry groups, and legal associations on precedent-setting judicial decisions, agency initiatives, and other issues.

Representative clients

- Amgen, Inc.
- BASF Group
- Baxter Healthcare Corp.
- BOSS Snowplows (a division of The Toro Company)
- Clear Lam Packaging, Inc.
- Emerson Electric Co.
- Gogo
- Google
- InterMune, Inc.
- Marcadia Biotech, Inc.
- Medela
- MonoSol, LLC
- Newell Rubbermaid
- Northwestern University
- OPKO Health, Inc.

- Shop-Vac Corp.
- State Farm
- The Procter & Gamble Company
- Twitter
- University of Michigan
- Walgreen Company

Representative matters

- **26 Business Units, Billions of Dollars of Innovation**
  As a preferred provider of intellectual property law services to a Fortune 250 global conglomerate, Marshall Gerstein manages U.S. and foreign filings for 26 of the client's business units — protecting billions of dollars of patentable innovation. We recently drafted and filed a series of more than two dozen high-priority patent applications to protect the company's investment in developing a new system architecture that will radically change the process-control environment.

- **Accelerating the Examination Process Leads to Faster Biologics Development**
  We collaborated with XOMA Corporation's scientists and attorneys to draft patent applications and pursue accelerated examinations for the issuance of a U.S. patent for a flexible manufacturing system. This modular manufacturing facility helps biotechnology companies overcome hurdles traditionally encountered during early stage biologics development.