

# 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 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

### **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.
- 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.

## Client Successes

### "KlickFix" kicks-in

The "KlickFix" Sequentially-Deployable Lip Seal System increases productivity while assuring on-line capability in manufacturing, thanks to the Marshall, Gerstein & Borun IP team who helped make this useful system become a world-wide reality.

Almost all centrifugal and rotary pumps require a sealing system to provide sealing integrity of the drive shafts carrying the impellers and protect against pumped fluid leakage. The "KlickFix" cartridge system is a new environmentally conscious alternative to mechanical seals and compression packing. Marshall, Gerstein & Borun patent attorneys were successful in preparing, filing and prosecuting US & foreign patent applications on behalf of Ashbridge & Roseburgh Inc., a Canadian entity. These applications resulted in a number of patents covering the Sequentially-Deployable Lip Seal System embodied in the "KlickFix" seal system, and described as "The Future of Seal Technology".

The "KlickFix" cartridge sealing system, manufactured and distributed by James Walker & Company Ltd, aids in achieving environmental plant management standards by eliminating leakage, reducing power consumption and minimizing flush water requirements. The sequentially-deployable lip sealing system also significantly reduces downtime of shaft-driven manufacturing equipment. When a lip seal wears down, instead of dismantling the machinery to replace a seal, one of several pre-loaded back-up seals is deployed. The machinery can remain on-line, thereby avoiding significant disruptions.

The patent protection our Firm coordinated for "KlickFix," in the US, Australia, Europe, Canada, Brazil, Mexico, China, and Japan, was instrumental in our IP Transaction team's successful negotiation of a global patent license agreement with James Walker & Company Ltd, a UK-based multi-national company with a worldwide reputation for providing fluid sealing solutions.

## Eliminating spillover via an *inter partes* victory

The Firm secured a complete victory for SSW Holding Company, Inc., in an *inter partes* review proceeding challenging the validity of an SSW patent, making its client one of just a handful to emerge from the newly established *inter partes* review process with every challenged patent claim fully intact.

*Inter partes* review (IPR) is a streamlined process for challenging patents created through the Leahy-Smith America Invents Act of 2011 and, to date, has proven favorable to those challenging patents. Of the 78 decisions issued in IPR proceedings through June of 2014, the Patent Trial and Appeal Board cancelled or invalidated nearly 80 percent of the patent claims before it. In only 14 percent of such cases did the board find in favor of the patent owner with respect to all of the patent claims under consideration, as it did in *Schott Gemtron Corp. v. SSW Holding Company, Inc.* The Patent Trial and Appeal Board's decision rejected arguments that SSW's patent — which covers spill-containing refrigerator shelving technology used by major appliance manufacturers — was "obvious" and therefore invalid. Oral argument in the case took place on June 23, 2014.

## Amgen launches new Neulasta® (Pegfilgrastim) wearable delivery kit

In 2015, Amgen announced that the Neulasta® (pegfilgrastim) OnPro™ Kit is now available in the United States (U.S.). The Neulasta® OnPro™ Kit includes a specially designed single-use prefilled syringe co-packaged with a new On-Body Injector. With the Neulasta® OnPro™ Kit, the healthcare provider (HCP) initiates administration of Neulasta® with the On-Body Injector on the same day as cytotoxic chemotherapy. Administration is delayed however, and this results in the automatic delivery of the patient's full dose of Neulasta® the day following chemotherapy administration. This advantageously eliminates the need for the patient to return to the HCP to receive the Neulasta® injection, which can be physically and emotionally challenging a mere day following cytotoxic chemotherapy treatment.

Marshall Gerstein worked closely with Amgen to navigate a sophisticated and complex field of prior art to build a robust international patent portfolio directed to the novel On-Body Injector included within the Neulasta® OnPro™ Kit.

Infections send 200,000-300,000 cancer patients to the hospital per year. The Neulasta® OnPro™ Kit makes delivery of infection-fighting drugs one less worry for those fighting the disease.