

Marshall, Gerstein & Borun LLP

Biotechnology Law Firm of the Year

USA

Firm Profile

Since its founding in 1955, Marshall, Gerstein & Borun LLP has focused exclusively on intellectual property law. The Firm counsels and assists clients throughout the world with protection, enforcement and transfer of intellectual property rights. We deliver perspective where science, law and business converge. Our professionals collaborate with each other and with our clients to provide a sophisticated work product that integrates intellectual property with business goals.

We have over 80 attorneys, patent agents and technical specialists with training in many scientific, technical and legal disciplines.

- More than 90% of the Firm's attorneys and patent agents are admitted to practice before the U.S. Patent and Trademark Office.
- More than 90% of the Firm's attorneys have science or engineering degrees.
- More than 80% of the Firm's agents and technical specialists have a Ph.D. or other advanced technical degree.

Nearly half of the Firm's professionals have worked in-house as general counsel, patent counsel, technology transfer managers, scientists, engineers, or consultants. The Firm's

ability to understand the nuances of intellectual property law, science and business enables the Firm to provide sound advice to clients.

The Firm's attorneys have the talent and experience to develop and execute intellectual property strategies and comprehensive IP solutions. Marshall, Gerstein & Borun LLP is ranked as a top intellectual property law firm by *Chambers USA*, *U.S. News & World Report* and *Best Lawyers*, as well as *Corporate Counsel*, *Managing IP*, *Fortune*, *Intellectual Property Today*, and *Intellectual Asset Management* magazines.

Areas of Focus

- Design Patents
- IP Litigation
- IP Transactions
- Patent Prosecution, Interferences and Oppositions
- Trade Secrets
- Trademarks and Copyrights

Representative Clients

- Amgen Inc.
- BASF Group
- BioMarin Pharmaceutical, Inc.
- deCODE genetics
- Eli Lilly and Co.
- Illumina, Inc.
- InterMune, Inc.
- Ludwig Institute for Cancer Research
- Merck Serono
- The Procter & Gamble Company

Biotechnology and Pharmaceuticals

Marshall, Gerstein & Borun understands the often unpredictable science and lengthy product development lifecycles for biotechnology and pharmaceuticals. We work with clients to devise successful strategies that build U.S. and foreign patent portfolios to protect commercial products and processes and maximize patent life cycles.

The Firm's large biotechnology group includes lawyers and patent agents with broad experience in a variety of biotechnology disciplines, including: DNA, RNA, vaccine, protein, and antibody therapeutics and diagnostics; cell-based and viral therapeutics; drug and gene therapy delivery vehicles; plant biotechnology; industrial technology and research platforms; nanotechnology and interdisciplinary inventions. The vast majority of its members have advanced degrees, such as Ph.D.s, masters' and M.D. degrees and/or industry or research experience. This combination of technical experience, coupled with the insights learned over years of client representation of both commercial entities and non-profit universities, hospitals and research institutions, provides a level of intellectual property service that few firms can equal.

The Firm's professionals are skilled at providing

patent counseling relating to the interface between patents, clinical product development, FDA regulations and regulatory exclusivity. The Firm is experienced in traditional, chemical-based pharmaceuticals, formulations, and delivery technologies, in addition to biopharmaceuticals. The Firm has:

- Procured, enforced and/or defended patents for biotech companies relating to a number of billion-dollar biologic or pharmaceutical products.
- Handled key patents for clients covering more than a dozen different commercially marketed products and numerous clinical trial candidates.
- Been ranked by *Chambers USA* as "one of the best biotechnology practices in the entire country," and a "highly-regarded boutique [providing] a comprehensive service." The Firm also ranks among the "World's Leading Intellectual Property Practices" for patents, biotechnology and trademarks (*Managing IP's 2013 World IP Survey*).



Patent Prosecution, Counseling, and Inter Partes Practices

Marshall, Gerstein & Borun's team of patent prosecution attorneys, patent agents, and technical advisors is among the larger patent prosecution practices in Chicago and has the advantage of broad and deep experience managing large and interrelated U.S. and foreign patent portfolios across major technical fields and industries. Our prosecutors work closely with clients' scientists and engineers to draft effective patent applications and prosecute the applications in the U.S. Patent and Trademark Office, and also throughout the world through a network of trusted foreign associates.

Experienced at preparing validity and infringement opinions, the Firm has the knowledge and understanding of what is needed to make these opinions stand up in litigation contexts, and the infrastructure and personnel in place to immediately perform this work in an effective manner.

Marshall, Gerstein & Borun is at the forefront of using new procedures at the U.S. Patent and Trademark Office (USPTO) that result in creative solutions for clients. The Firm's attorneys use reissue, reexamination, *inter*

partes review, and interference proceedings to supplement, or as an integral part of achieving, clients' overall litigation and prosecution goals. This experience, coupled with the Firm's knowledge of the nuances of patent law in various scientific and technical areas, enables Marshall, Gerstein & Borun to develop effective subject matter-specific prosecution strategies. Drawing on the experience of the Firm's litigation and transaction practices helps clients maximize return on investment in innovation.

IP Litigation

Marshall, Gerstein & Borun has earned a national reputation for patent and trademark litigation, having successfully represented clients involving some of the most significant issues in intellectual property law during the last 59 years, many resulting in major victories and landmark decisions. The Firm's trial attorneys are able to understand complex technologies and are adept at conveying the substance and significance of technological innovations to judges and juries in a clear, persuasive manner. This skill, together with substantial jury trial experience in IP cases, distinguishes the Firm. Clients turn to us for their most visible, high-stakes IP cases and to provide solid enforcement and defense strategies. Marshall, Gerstein & Borun has the acumen and experience to protect clients' interests and advance their goals. *Chambers & Partners* ranked Marshall, Gerstein & Borun "first-rate for litigation."

IP Transactions

The professionals at Marshall, Gerstein & Borun understand intellectual property transactional best practices and deliver practical solutions that can be implemented and enforced. Coupled with experience as in-house general counsel, patent counsel and technology transfer managers, the Firm's attorneys deliver practical solutions and bring understanding of a wide range of deal strategies and markets. They craft comprehensive agreement structures that implement clients' priorities, minimize unallocated risks and allow for changing

circumstances. These agreements are clear and concise using only those customized provisions necessary for the deal at hand. The number and variety of industries for which the Firm drafts and negotiates deals allows it to bring best practices from a wide range of deal strategies. The Firm's professionals have been recognized among the "World's Leading Intellectual Property Strategists" and the "World's Leading IP Patent and Technology Licensing Lawyers" by *Intellectual Asset Management* magazine.

Trademarks and Copyrights

Whether clients' business interests are focused on the domestic U.S. market or extend across the globe, Marshall, Gerstein & Borun provides seasoned advice on the risks and advantages of branding objectives and assists in clearing, registering and protecting clients' trademarks. Marshall, Gerstein & Borun's trademark team has exceptional depth and a unique combination of experiences in medical devices, pharmaceuticals, and biotechnology brand protection. The Firm represents aggrieved brand

owners and alleged infringers in the resolution of disputes involving trademark design and trade dress infringement, counterfeit products, dilution, unfair competition and trade practices, trade secret misappropriation and rights of publicity. Marshall, Gerstein & Borun is ranked among the "World's Leading Intellectual Property Practices" for trademarks according to *Managing IP's* 2010-2014 *World IP Survey* and as a "Top Trademark Law Firm" in *World Trademark Review*, 2011-2014.

Heather R. Kissling, Partner and Chair, Biotechnology - Marshall, Gerstein & Borun LLP

233 South Wacker Drive, 6300 Willis Tower, Chicago, Illinois 60606-6357, USA

Tel: 312.474.6300 | Fax: 312.474.0448 | Website: www.marshallip.com