

Chemical Sciences

Chemistry—The Central Science and a Core Firm Practice

Marshall, Gerstein & Borun LLP was established more than 60 years ago by patent lawyers educated in chemical engineering and chemistry—commonly referred to as the central science. Over time, the Firm’s Chemical Sciences Practice Group has counseled all types of clients, from independent inventors to the world’s largest companies, in their intellectual property matters. Collectively, the lawyers in this group have formal education spanning the entire spectrum of the chemical sciences, combined with direct, practical experience before the federal courts and the U.S. Patent and Trademark Office (USPTO).

Focused diversity—a strength, not a paradox

The chemical sciences are diverse and far-reaching, and their principles are directly applicable in a broad range of disciplines, from classical chemistry to industrial chemical processes, pharmaceuticals, materials science, and other fundamental fields of engineering. We draw on our in-depth, diverse experience to counsel clients whose products and processes are steeped in traditional chemical sciences, as well as those whose business focus may seem unrelated to chemistry, but whose intellectual property issues do involve chemical principles. This focused diversity enables us to form decades-long client relationships with independent inventors, universities, small and mid-sized companies, and the world’s largest organizations, no matter their business focus.

Continuity and long-lasting relationships

Our client relationships have been forged through trust and our ability to maintain continuity. The Firm’s Chemical Sciences Practice Group is led by a team of partners who have been with Marshall Gerstein for decades—many for their entire careers. Continuity does not mean a lack of momentum, however; we continue to grow and diversify to stay ahead of changes in technology and the marketplace that affect our clients’ products. Our highly experienced professionals are also deeply involved in training the associates, patent agents, and technical specialists in the group who are the Firm’s future partners. This long-term perspective enables us to assure clients that we have the capabilities and resources to manage their complex, important matters, now and in the future.

Headquarters for tough patents

Marshall Gerstein is known for providing sophisticated solutions to the most complex patent-related challenges. We make compelling arguments to the USPTO and courts that push boundaries and clarify murky legal waters, and draw on our technology resources to protect and maximize the value of our clients’ IP assets. Our track record of protecting intellectual property in more than 100 countries on six continents makes us a strong resource to coordinate intricate, international patent portfolios.

Respected by clients and peers

The Firm and its individual lawyers consistently win top marks from publications such as *Intellectual Asset Management (IAM)* magazine and *Managing IP’s World IP Survey*, which called us “the most complete patent team in Chicago” and “in terms of critical thinking, scientific capability, and unwavering commitment to quality ... the best around.”

We protect innovation in a wide array of chemical arts, from novel molecules to multidisciplinary applications, including:

- Alternative energy
- Green technology
- Materials science
- Natural product research for drug discovery
- Nanotechnology

- Process chemistry
- Pharmaceuticals
- Renewable/sustainable/bio-based materials
- Targeted drug delivery

IP protection for your business life cycle

Marshall Gerstein assists chemical services businesses with:

- Prosecution
- Interferences
- Reexaminations
- Inter-partes reviews
- Appeals
- Litigation
- Arbitration
- Licensing
- Due diligence
- Mergers
- Portfolio management
- Global patent strategies
- Patent extensions
- Trademark coordination

Representative clients

- AMCOL International Corp.
- BASF Group
- The Chemithon Corp.
- Clear Lam Packaging, Inc.
- InterMune, Inc.
- Lipo Chemicals, Inc.
- MonoSol, LLC
- OPKO Health
- Penford Corp.
- The Procter & Gamble Company
- USG Corp.
- Valspar
- Numerous universities and hospitals

Representative matters

- **Shedding Light on a Complex Patent**

When our client discovered that certain known chemical structures could prolong the life of UV-light absorbers, we drafted and filed applications to patent the structures as photostabilizers. After a hard-fought battle to convince the USPTO of patentability, we secured patents that have helped our client become the exclusive provider of these products to major sunscreen and cosmetics manufacturers.

- **Helping Heartland Technology Partners Protect and Monetize Innovative Wastewater Treatment Technology**

We collaborated with Heartland Technology Partners (HTP) to negotiate finance agreements, prepare licensing agreements, complete patent applications, and draft options on a group of green technologies that help prevent lakes and rivers from becoming polluted with wastewater as a result of oil and gas drilling or other industrial processes.

- **Leading the Protection and Defense of a Well-Known Drug Patent**

Our work on Cialis[®], a blockbuster drug used to treat erectile dysfunction, is another example of the long-term trust that the world's leading biotechnology and pharmaceutical companies place in Marshall Gerstein. After tadalafil, the active compound in Cialis[®], was discovered in 1992, the biotechnology company ICOS (now part of Eli Lilly & Co.) turned to us to draft, file, and prosecute the patent applications covering this compound. ICOS also relied on the Firm to finalize its joint venture with Eli Lilly to market Cialis[®]. When Vanderbilt University sought to add its scientists as co-inventors to patents covering the manufacture, sale, and use of tadalafil, ICOS again turned to the Marshall Gerstein team. We conducted a two-week bench trial before then-Chief Judge Sue Robinson in the U.S. District Court for the District of Delaware and won a decision in favor of ICOS. We also successfully represented ICOS in Vanderbilt's subsequent appeal to the U.S. Court of Appeals for the Federal Circuit and its petition for *certiorari* to the U.S. Supreme Court.

- **Settling an Infringement Case Before Trial**

On behalf of a pharmaceutical client, we obtained a favorable claim construction ruling on a patented formulation of an injectable anesthetic product, which positioned the client to reach a favorable settlement of an infringement case before trial.

- **The Sweet Smell of Success: Helping a Client Protect the Essence of a Fragrance**

On behalf of a developer and manufacturer of flavor and fragrance chemicals, we prepared and prosecuted to issuance patent applications relating to antimicrobial coating formulations, biodegradable polymer compositions, and synthetic methods.

- **Providing Patent and Trademark Prosecution in the United States and Europe**

When a pharmaceutical company launched a key drug in the United States and in Europe the following year, we obtained Orange Book-listable patents covering the composition and its method of use. We continue to handle the related patent portfolio worldwide for this product.