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Sandip H. Patel

Partner

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Sandip H. Patel has broad experience in all areas of patent law. He has successfully obtained patents regarding chemical and chemical engineering inventions for a diverse collection of companies that specialize in commodity chemicals, consumer products, fuel production, pharmaceuticals, and semiconductors. Further, he has managed patent portfolios and offered strategic opinion counseling for these companies to their competitive advantage. Additionally, he has broad patent litigation experience in the district and Federal Circuit courts, and extensive experience in leading interferences, reexaminations, and inter partes reviews before the Patent Office. He successfully served recently as lead counsel in contested interferences and inter partes review proceedings, securing favorable judgments regarding mechanical and chemical engineering inventions. He continues to represent clients in these types of proceedings, including multiple inter partes review proceedings pending at the Patent Office, and interferences, recently including one involving fundamental CRISPR gene-editing technologies.

The clients he advises are diverse and include specialty chemical companies, universities, and a variety of large, multinational corporations focused on biotechnology, chemicals, or consumer products. He has a formal education in chemical engineering, but his work has spanned the entire spectrum of engineering and the chemical and life 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 2013–2018 *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 2016–2019 editions of *The Best Lawyers in America*©in the practice area of Patent Law. In recognition of his outstanding patent work in life sciences, Mr. Patel has been featured as a “Life Sciences Star” in the 2016–2017 editions of *LMG Life Sciences*. Additionally, Mr. Patel has been named an “IP Star” in the 2016–2018 editions of *Managing IP*'s *IP Stars Survey* (fka the *World IP Handbook and Survey*).

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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 and inter partes reviews in the U.S. Patent and Trademark Office, and currently represents clients in other such 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., antibody formulations, avirulent vaccines, DNA sequencing methods, fundamental CRISPR technologies, genetically-engineered plants, and kerotinocyte growth factors), chemistry/chemical engineering (e.g., pharmaceutical compounds and compositions, food processing chemicals, and chemical and biochemical reactor design and operation), mechanical engineering (e.g., railcar shock absorbers, correction-tape dispensers, paper shredders, computer locks, 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., antibody formulations, 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).

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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 dozens of 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.

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

December 13, 2018
"Industry Reaction to Helsinn Healthcare v. Teva Pharmaceuticals Oral Arguments" (featured quotes)
IPWatchdog

December 5, 2018
"Supreme Court Steps in as Grammar Police for AIA's On-Sale Bar" (featured quotes)
BioWorld

December 5, 2018
"US Supreme Court Likely to Limit On-Sale Bar to Public Prior Art" (featured quotes)
Managing Intellectual Property

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December 5, 2018
"SCOTUS Helsinn v Teva Showdown Begins" (featured quotes)
Intellectual Property Magazine

December 4, 2018
"SCOTUS Likely to Reverse Helsinn v Teva Ruling, Say Lawyers" (featured quotes)
World Intellectual Property Review

June 25, 2018
Supreme Court Decides Infringement Remedies May Include Foreign Lost Profits
Marshall Gerstein Alert

April 25, 2018
"Oil Firms' Supreme Court Spat Could Change Patent Law, Attorneys Say" (featured quotes)
Westlaw Journal Intellectual Property

April 25, 2018
"SAS: When the Patent Office Institutes IPR it Must Decide Patentability of All Challenged Claims" (featured quotes)
IPWatchdog

April 24, 2018
Supreme Court Decides that IPR Final Decisions Must Address All Challenged Claims
Marshall Gerstein Alert

April 17, 2018
"SCOTUS: Patent Case Sparks Concerns Over International Relations" (featured quotes)
World Intellecutal Property Review

April 16, 2018
"Justices Press Both Sides Over Foreign Patent Damages" (featured quotes)
Law360

November/December 2017 Issue
"Fractured Federal Circuit Reallocates a Burden of Proof in AIA Trials"
IP Litigator

March 2, 2017
“Patent Owners and Petitioners Weigh In”
PTAB Bar Association Inaugural Conference

January 26, 2017
“AIA Estoppel Provision Not As Restricted As Many Expected” (featured quotes)
Law360

August 16, 2016
“Amendments Case Could Help Patents Survive AIA Review” (featured quotes)
Law360

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”
Marshall Gerstein 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

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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"
Marshall Gerstein 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

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Representative Inter Partes Matters

*AbbVie Inc. v. Amgen Inc.**
U.S. District Court, District of Delaware
Biotechnology (BPCIA)

Adams (Monsanto) v. Leemans (Bayer CropSciences)*
U.S. Patent and Trademark Office Board of Patent Appeals and Interferences
Patent Interference
Biotechnology

*Akermin, Inc. v. CO_2Solutions Inc.**
U.S. Patent and Trademark Office Patent Trial and Appeal Board
Inter Partes Review
Chemical Engineering

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

*The Broad Institute, Inc., Massachusetts Institute of Technology, and President and Fellows of Harvard College v. The Regents of the University of California, University of Vienna, and Emmanuelle Charpentier**
U.S. Patent and Trademark Office Patent Trial and Appeal Board
U.S. Court of Appeals for the Federal Circuit
Patent Interference
CRISPR-Cas9 technology

*Think Products Inc. v. ACCO Brands Corporation**
U.S. Patent and Trademark Office Patent Trial and Appeal Board
U.S. Court of Appeals for the Federal Circuit
Inter Partes Review
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
- PTAB Bar Association
- Intellectual Property Owners Association