



Heather R. Kissling

Partner and Prosecution Chair

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Heather R. Kissling draws from over a decade of experience securing biotechnology patents to develop worldwide filing and prosecution strategies that further her clients' business objectives. Using her advanced training in biotechnology, she actively collaborates with bench scientists, business development personnel, and in-house counsel to maximize protection of biotechnology innovations in a broad range of technologies. Her background in interference and opposition proceedings also benefits clients seeking advice with respect to competitor patent positions and third party challenges in the patent office. Clients find her to be a forward-thinking advocate that shares their commitment to realizing the maximum value from their intellectual property assets.

Ms. Kissling has been recognized in the 2016 Women Worth Watching list by *Profiles in Diversity Journal*, a list highlighting women who are using their influence to change their workplace, marketplace, and the world. She was named the exclusive winner in the International Law Office (ILO) Client Choice Awards 2016 "Intellectual Property–Patents" category for Illinois where a client was quoted, "when it comes to effectiveness, knowledge, skill and customer service in the complex and competitive field of patent law, I have found no better colleague than Ms. Kissling." In recognition of her outstanding patent work in life sciences, Ms. Kissling has been featured as a "Life Sciences Star" in the 2016–2018 editions of *LMG Life Sciences*. She was selected to the 2014 and 2016 editions of *Managing IP's* IP Stars list of the Top 250 Women in IP, and was also named an "IP Star" in *Managing IP's* 2015–2018 IP Stars Survey (fka the *World IP Handbook and Survey*). Ms. Kissling was selected for inclusion in the 2018–2019 *Illinois Super Lawyers*® list and the 2013–2017 *Illinois Rising Stars*® lists, featuring outstanding young attorneys in the state. Ms. Kissling was also designated as an "Emerging Lawyer" in the 2015–2019 editions of *Emerging Lawyers Magazine*, in which individuals are recognized among the top up-and-coming attorneys in Illinois.

Clients say that Ms. Kissling "exhibits all the qualities that inside counsel desire from outside counsel, including creativity, fantastic organizational skills, ethical conduct and strategic thinking." Ms. Kissling "brings her A game to each and every matter that she handles; an invaluable member of any team." In addition, Ms. Kissling "can think holistically about the problems we are facing and help us to find solutions that best work for our business quickly." Also, "when it comes to effectiveness, knowledge, skill and customer service in the complex and competitive field of patent law, I have found no better colleague than Ms. Kissling."



Practices

- Patent Prosecution
- Post-Grant Patent Proceedings

Industries

- Biotechnology & Life Sciences
- Cleantech & Renewables
- Pharmaceutical

Representative Experience

- Successfully secured patents relating to antibodies and their medical uses for large biotechnology company.
- Advised client investigating cleantech and renewables technology with respect to third party patent landscape and partnering opportunities.
- Managed complex patent portfolio for viral vector technology applied in phase III gene therapy clinical trials for pancreatic cancer.

Ms. Kissling has skillfully worked on patent matters in diverse technologies, including:

- Antibody and protein technology
- Gene Therapy
- Viral vector and cell line technologies
- Recombinant DNA and expression systems
- Genetically-modified plants
- Screening methods for anti-viral therapies

Background and Credentials

Ms. Kissling uses her experience in all phases of prosecution work to help biotechnology clients strategically develop and maintain patent portfolios to achieve business goals. She has evaluated the patentability of client inventions and prepared and prosecuted patent applications before the U.S. Patent and Trademark Office and foreign patent offices for universities, non-profit research institutions,

governmental agencies, start-ups, and established biotechnology companies. She aids clients in defining commercial opportunities by investigating competitor patent landscapes, patent validity, and freedom to operate issues. She also has participated in patent interference proceedings before the Board of Patent Appeals and Interferences and assisted foreign associates in opposition proceedings abroad.

She received her Juris Doctorate, with high honors, from the Chicago-Kent College of Law, where she was also awarded the Order of the Coif. During law school, she was a Judicial Extern for the Honorable Reuben Castillo in the U.S. District Court for the Northern District of Illinois.

Ms. Kissling graduated with an M.S. degree in biotechnology from Northwestern University. Her graduate research experience included serving as an industrial resident at Abbott Laboratories and a research resident in the Lurie Cancer Center of the Northwestern University School of Medicine. She received a B.S. in biology and liberal arts chemistry, *magna cum laude*, from the University of Evansville.

Education

- Chicago-Kent College of Law, Illinois Institute of Technology (J.D.)
- Northwestern University (M.S.)
 - Biotechnology
- University of Evansville (B.S., *magna cum laude*)
 - Biology and Liberal Arts Chemistry

Bar Admissions

- Illinois
- U.S. District Court, Northern District of Illinois
- U.S. Patent and Trademark Office

Publications and Presentations

- “Start-up Challenge,” Moderator, Women in Bio-Chicago, September 30, 2015.
- “Best practice series: Women's initiative,” Co-Author, *Managing Intellectual Property*, March 2015.
- “In the News,” *Chicago Daily Law Bulletin*, March 2, 2012 (profile).
- Tonetti D.A, Chisamore, M.J., Grdina W., Schurz (Kissling), H., Jordan V.C., *Br J Cancer*, 2000 Sept.; 83(6): 782–791.

Ms. Kissling also presents seminars on recent developments in case law, current trends at the U.S. Patent and Trademark Office, and building intellectual property assets.

Community and Professional Involvement

- Biotechnology Industry Organization, International Convention Programming Committee 2013, 2012, 2010 and 2006.
- Women In Bio–Chicago Chapter, Board of Directors

Representative Matters

Gencell S.A. v. Kovesdi et al. v. Gencell S.A.

U.S. Patent Office Board of Patent Appeals and Interferences

Case Type(s): Patent Interference

Area(s) of practice: Biotechnology

Kovesdi et al. v. Zhang et al.

U.S. Patent Office Board of Patent Appeals and Interferences

Case Type(s): Patent Interference

Area(s) of practice: Biotechnology

Wickham et al. v. McClelland et al.

U.S. Patent Office Board of Patent Appeals and Interferences

Case Type(s): Patent Interference

Area(s) of practice: Biotechnology

Kroczek v. Tamatani et al.

U.S. Patent Office Board of Patent Appeals and Interferences

Case Type(s): Patent Interference

Area(s) of practice: Biotechnology

Opposition and Appeal re: Darwin Discovery Ltd.

European Patent Office

Case Type(s): Opposition, Appeal

Area(s) of practice: Biotechnology