

JENN BURNETTE

‘Science Nerd’ Masters Arts for Businesses With Patent Portfolios

by Dustin J. Seibert



Jennifer Burnette is, by her own admission, a completely unrepentant “nerd.”

STEM (science, technology, engineering and mathematics) has guided her life and fascinations since she was a young girl, and her interest in law grew from her father’s love of being a lawyer.

Burnette ultimately found a home for both as an intellectual property attorney. She has merged her passion for the legal and scientific worlds as a partner and chemical practice group chair at Marshall Gerstein & Borun LLP.

She quickly landed at the intellectual property firm. She started as a second-year summer associate, came on board as a full-time associate in 2007, and made partner in 2015.

In her 12 years with Marshall Gerstein, she’s used her unique skill set to advance the firm in ways that most other associates without her background could not have, says Jeremy Kriegel, fellow partner and chair of the firm’s strategic planning committee. He says Burnette has been invaluable in his mechanical

prosecution practice group.

“Jenn is a double threat when it comes to technology because she has that background in chemical and mechanical arts,” he says. “I’ve had many clients over the years with interdisciplinary needs. Whenever it is on the materials science side of things, I have not hesitated once to bring Jenn into the mix. She’s always able to offer superior counseling.”

A FAMILY OF LAWYERS

The Burr Ridge native is the oldest of three children to Hercules, a lawyer, and mother Diane Bolos, a bank director and IT manager. The bulk of Hercules’ career was as a special assistant general and chief counsel for the Illinois Commerce Commission. Each child was clearly influenced by their father and by other members of the family, as they are all practicing lawyers.

“He is happy that we are all lawyers,” Burnette says of her dad. “He liked the profession and maybe he pushed us in that direction a little bit. But I was the outlier from my siblings since I went into the field of

science before I went into law.”

Burnette’s future legal career was also inspired by an opportunity to be a high school intern for the legal department at the now-defunct Chicago Bridge and Iron Company, where she was first introduced to patent law.

“I was fortunate to have a firsthand opportunity to see how a legal department operated and to be able to hear from different attorneys about their practice,” she says. “At the time, it struck me how much science played a role in patent law. I had already been drawn to math and science at that time, so it sparked an interest.”

Indeed, Burnette has two bachelor of science degrees from Northwestern University: one in applied mathematics and engineering and the other in material science and engineering. She was motivated by Dr. Ilya Koltover, a professor who brought her in for a high-level, research-focused project. Although she was happy to have had that opportunity, it also helped her realize that being in a lab simply wasn’t for her.

“I was fortunate to obtain a lot of experience doing lab work as an undergraduate and

realized it wasn't where I saw myself career-wise," she says. "It was a wonderful learning experience, and it contributed greatly to my problem-solving skills, but I realized it wasn't my passion."

That realization led her to the next phase of her life, enrolling in the University of Minnesota Law School. There she developed a "very strong sense" that she wanted to pursue patent law because of its foundation in science.

"Law school taught me a variety of areas of law, but ultimately, I found I still really liked science, and I didn't want to leave it behind," she says.

Burnette was driven to patent prosecution over litigation in large part because she liked the idea of being part of the cutting edge of science, working with new developments and inventions.

"With patent prosecution, I have the ability to see what's coming down the development pipeline and help companies protect the new products they're putting out and strategies for new product lines they're looking to get into," she says.

ONE-SHOP CAREER

At Marshall Gerstein, Burnette focuses primarily on patent prosecution and counseling: She assists companies in developing and protecting their patent portfolios through prosecution. She truly enjoys being involved in the strategic development aspect of the portfolios—specifically, aligning the IP strategy with the business strategy.

"You can write a patent application to cover just about anything," she says. "I strive to craft IP strategies that fit with the overall business strategy to protect a development or product line."

Discovering the business motivation for intellectual property is among the more stimulating aspects of her work.

"I really like to understand what the business motivation is for a company's IP," she says. "Because then you're really part of that company. If you're partnered with them, it's a very strategic process, and I have a love of wanting to know what the business justification is for doing something and spending the time to figure out how to best structure the IP."

Burnette acknowledges that Marshall Gerstein has always championed and cultivated her interdisciplinary science background. The firm works to utilize all scientific disciplines and intellectual property fields in a fashion that produces the best result for the client.

"What's unique about our practice is that we have the whole range of scientific disciplines here, and we practice in all IP fields," she says.

"I'm able to tap true subject-matter experts whenever I need them—those people with expertise in other areas so that we can develop a cohesive strategy for our clients. Having a singular focus with multiple experts helps our clients protect themselves and their inventions from a variety of angles.

"You could just take what a company tells you, write their disclosure, get something issued, and rinse and repeat, but we strive to be partners with our clients," she says. "We want to understand their goals and competitive threats and then figure out the IP strategy to help achieve those goals and really protect their product line. That's what my firm focuses on—making it matter."

“When I'm working on the phone with my engineers and we're trying to understand something about the patents, she provides excellent inquiries and questions to probe and obtain additional information for me and the engineers.”

Burnette does a masterful job of bringing those resources together, Kriegel says.

"She can put herself in the position of the client to understand what their business needs are, then filter the complex legal and technical information into a format the client can understand to make an informed business decision based on her recommendation."

LOVE OF BOTH WORLDS

Burnette's material sciences background not only allows her the opportunity to work on a range of transactions but it also allows her to engage in the nuances of product development that would escape many attorneys.

"I love the ability to understand the technology a client asks me to protect and to be that bridge between the inventors, who are very knee-deep and engrossed in the technology, and the higher-level business folks," she says.

"Inventors want somebody who can speak their language and understand the scientific underpinnings of their development. Being a science nerd, I love to get into those details. At the same time, I can bridge certain gaps and translate the important features for the business people."

Burnette admits that the curiosity behind her clients' businesses runs deeper than simply

learning how to best serve them. She gains gratification from learning the ins and outs of the technical aspects.

"I love that I know how things work and that I get to see behind the curtain a little bit," she says. Whether it is an absorbent used in a construction site or a new medication, I get to understand the details of how it works and why it was developed a particular way. I get to talk to people about the amazing things they develop. For a science nerd, that's awesome."

Pamela Wingood, vice president and patent counsel for the office of the general counsel of Hasbro, Inc. based in Rhode Island, has been Burnette's client for just under two years. She knows firsthand Burnette's ability to understand the science aspects better than other IP lawyers she might work with.

"When I'm working on the phone with my engineers and we're trying to understand something about the patents, she provides excellent inquiries and questions to probe and obtain additional information for me and the engineers," Wingood says.

"She doesn't stop at 'There's nothing here.' She is very curious and inquisitive and gets her client thinking a bit more to build something that wasn't so obvious before that. She extracts additional information to build opportunities to offer protection."

Burnette's love of the intellectual aspect of her business was reflected in a 2017 transaction with a mid-size company. Burnette had worked for several years with the company, strategically developing IP portfolios for a number of product lines, including a new product line that touched many industries, downstream customers and project partners.

She and her team strategically developed the IP portfolio with a focus on maximizing licensing strategies for multiple targets. When the company was ultimately sold, its valuation was significantly enhanced by its thicket of utility and design patents.

"It was a great moment to see how the IP portfolio drove value," she says.

Burnette has served on the women's board of the Adler Planetarium since 2010. She became interested in the board because of its support for "women and girls in sciences." Money that's raised through the women's board is designated for supporting Adler's STEM education programs.

"All through college, I participated in women in STEM events and organizations. The planetarium board is a nice opportunity to reengage with those activities," she says.

"Seeing more women like me pursuing STEM careers is definitely encouraging, and I hope that number continues to grow." ■