



David A. Gass

Partner

Tel 312.474.6624
dgass@marshallip.com

David Gass is a registered patent attorney for biotechnology companies, pharmaceutical companies, diagnostics companies, universities, and research institutions, helping clients develop and implement IP strategies to protect and commercialize life-improving biotechnology inventions. He assists clients with patentability analyses, drafting and prosecuting patent applications, and maximizing patent term and patent life-cycle for products. He also assists clients with freedom-to-operate issues relative to the IP rights of others. He has experience with appeals and inter partes proceedings before the U.S. Patent and Trademark Office, including interferences, reexamination and reissue proceedings. David also assists clients with international patent portfolio management and licensing, and advises counsel in foreign patent prosecution and opposition proceedings. He has lectured students and industry in the United States and Europe on intellectual property matters, including chairing of panels at the 2010–2013 BIO International Conventions on “IP Issues Affecting Biomarker-Based Diagnostics,” and the 2017 BIO International Convention on “Innovation and the Human Microbiome.”

In recognition of his outstanding patent work in life sciences, David has been featured as a “Life Sciences Star” in *LMG Life Sciences*, 2012–2019. He was selected by his peers for inclusion in the 2016–2021 editions of *The Best Lawyers in America*® in the practice area of Patent Law, was named “Biotechnology & Life Sciences Patent Lawyers of the Year–USA” in the *Corporate LiveWire* 2016 Legal Awards, and was recognized in 2015 by the *Corporate LiveWire* Legal Awards in the “Excellence in Patent Prosecution–Illinois” category. He has also been selected by the *Chicago Law Bulletin’s* Leading Lawyer Network as a “Leading Lawyer.”



Practices

- Patent Prosecution
- Post-Grant Patent Proceedings

Industries

- Biotechnology & Life Sciences
- Materials Science
- Nanotechnology
- Non-Profit Technology Transfer
- Pharmaceutical

Representative Experience

- Authored *BRIEF FOR AMICI CURIAE* to the U.S. Supreme Court for prominent biotechnology, pharmaceutical, and university trade organizations in *Sequenom, Inc. v. Ariosa Diagnostics, Inc.*
- Counseled research institution and prosecuted portfolio of patent applications relating to angiogenic treatments for ischemic conditions and anti-angiogenic treatments for cancer and ophthalmological conditions. Continued prosecution of portfolio for a startup company built around these technologies.
- Secured more than 20 U.S. patents and numerous foreign counterpart patents for prominent platform technology for large pharmaceutical company.
- Assisted with U.S. interference and subsequent prosecution of patent application for important plant biotechnology invention.
- Provided freedom-to-operate counseling to clients that wished to develop products without infringing valid intellectual property rights of third parties.
- Counseled clients in U.S. interferences and assisted foreign counsel in European and Australian opposition proceedings.

David has assisted clients with intellectual property in a wide variety of biotechnology disciplines, including the following:

- Recombinant DNA, protein, and antibody technologies
- Therapeutic antibodies, including humanized antibodies, and other immunotherapies
- Cell culture and microbiome technologies
- Genomics, proteomics, and epigenetics
- Medical diagnostic and prognostic tests, reagents, and kits that use genomic, metabolomic, and traditional markers to diagnosis disease or identify susceptibility, for diseases such as cancers, cardiovascular disease, and diabetes
- Angiogenesis and anti-angiogenesis technologies and circulatory disorders

- Gene therapy, interfering RNA, CRISPR, and antisense technologies
- Vaccines and adjuvants, including cancer vaccines
- Genetic modification of plants and animals, including transgenic organisms
- Cancer diagnosis and therapies, and oncogenes
- Anti-viral therapies, including protease inhibitors
- Polymerase chain reaction and mass spectrometry
- Nanotechnology and industrial biopolymers
- Prions, Alzheimer's disease, and neural regeneration
- Inflammation and arthritis
- Metabolic diseases and diabetes
- Therapeutic methodologies and formulations
- Stem cell therapies
- Food and beverage formulations

Background and Credentials

David received his J.D. from University of California, Berkeley, Boalt Hall School of Law (Berkeley Law). He attended the University of Michigan as an undergraduate, and graduated with Highest Honors and Highest Distinction with a B.S. in cell and molecular biology.

Prior to attending law school, he worked for two years at the University of Michigan as a researcher studying plant mitochondrial genetics.

Education

- University of California, Berkeley, Boalt Hall School of Law (J.D.)
- University of Michigan (B.S., *with highest honors*)
 - Cell and Molecular Biology

Bar Admissions

- Illinois
- U.S. Patent and Trademark Office

Publications and Presentations

September 16, 2020

“The Modified Standards for Section 706.07(b)’s first action final rejections (FAFR)”

2020 IPO Virtual Annual Meeting – U.S. Patent Office Committee Meeting

September 16, 2020

“MPEP Updates on First-Action Final Rejections”

2020 IPO Virtual Annual Meeting – Pharmaceutical & Biotechnology Issues Committee Meeting

August 19, 2020

A USPTO Examination Policy Change You May Have Missed

Law360

June 20, 2017

“Innovation and the Human Microbiome: Patent Eligibility and IP Protection”

2017 BIO International Convention

November 14, 2016

“USPTO Subject Matter Eligibility Guidelines”

USPTO Patent Subject Matter Eligibility Roundtable

December 31, 2015

“Number 1: Device Tax Suspension: Medical Device Daily’s top 10: The biggest news makers and trending stories of 2015” (featured quotes)

Medical Device Daily

December 2015

“Ariosa Diagnostics, Inc. v. Sequenom, Inc.: How the Federal Judiciary Stripped a Breakthrough Invention of Patent Protection”

Corporate LiveWire Expert Guide

December 4, 2015

“Federal Circuit passes on en banc hearing for Sequenom” (featured quotes)

Medical Device Daily

October 12, 2015

“How Sequenom Lost Patent Protection For Fetal DNA Test”

Law360

June 16, 2015

**“Sequenom Patent Invalidation May Have Ramifications for NIPT Field, Entire MDx Industry”
(featured quotes)**

GenomeWeb

June 15, 2015

“Even Breakthrough Patents Can Be Invalid, Sequenom Shows” (featured quotes)

Law360

June 15, 2015

“Hold the Mayo? Patent on groundbreaking test swept aside” (featured quotes)

Medical Device Daily

June 15, 2015

“Fed Circuit Affirms Patent Ineligibility Of Sequenom Prenatal Test Methods” (featured quotes)

Bloomberg BNA, Daily Report for Executives

March 3-4, 2015

“Global Biotech IP Update: Patent Eligibility Requirements in Life Sciences”

Webinar

December 16, 2014

“What Inventions are Eligible for Patenting? US PTO Issues New Guidelines for Examiners”

Marshall Gerstein Alert

November 2014

“Sector Focus—Bioscience”

Lawyer Monthly

June 12, 2014

“USPTO Training Memo Lacks Sound Basis in the Law”

Law360

March 10, 2014

“10 Problems in the USPTO's New Training Memo”

Law360

March 6, 2014

“What Inventions are Eligible for Patenting? USPTO Issues New Guidelines for Examiners”

Marshall Gerstein Alert

June 2013

2013 BIO International Convention, Chicago, IL

Panel speaker on the topic of IP protection for biomarker diagnostics

July 2012

“Patent Protection for Antibody Inventions”

Speaker, London, U.K.

2012

2012 BIO International Convention, Boston, MA

Panel speaker on the topic of IP protection for biomarker diagnostics

September 2011

“Are Genes Patentable?”

Financier Worldwide Magazine

2011

“Patenting Genes and Diagnostics”

Life Sciences Intellectual Property Review 2011

September 1, 2011

“Protecting Diagnostic Inventions in the U.S.”

Genetic Engineering & Biotechnology News

2011

2011 BIO International Convention, Washington D.C.

Panel moderator and speaker on the topic of IP protection for biomarker diagnostics.

May 2011

“Impact of Recent IP Case law on Biomarkers and Personalized Medicine”

Journal of Commercial Biotechnology

2011

2011 Biotechnology and Health-Related Issues Intellectual Property Law Symposium, John Marshall Law School, Chicago

Panelist, provided analysis of IP law and strategies for diagnostic and biomarker-based intellectual property in light of recent legal developments, including high profile Supreme Court and Federal Circuit cases such as Bilski, Myriad (AMP v. USPTO), Mayo v. Prometheus, and Classen.

June 2010

2010 BIO International Convention, Chicago, IL

Panel moderator and speaker on the topic of IP protection for biomarker diagnostics.

September 2008

“Written Description and Biotech Patents”

Pharmaceutical Andrews Litigation Reporter, Vol. 24, Issue 7

Community and Professional Involvement

David has served on committees for organizations such as Intellectual Property Owners Association (IPO) and Illinois Biotechnology Industry Organization (iBIO) that promote strong intellectual property rights and foster the growth of the biotechnology industry. In 2014 and 2015 he co-authored IPO's comments on the U.S. Patent and Trademark Office's guidance memoranda and training materials pertaining to determining subject matter eligibility, particularly as to inventions involving laws of nature, natural phenomena, and natural products.