



## Heather R. Kissling

Partner and Prosecution Practice 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.

Heather 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 Heather." In recognition of her outstanding patent work in life sciences, she has been named a "Life Sciences Star" by *LMG Life Sciences* since 2016, and selected as one of the "World's Leading Patent Practitioners" by *Intellectual Asset Management (IAM)* magazine since 2017. She was selected to the 2014 and 2016–2020 editions of *Managing Intellectual Property's* IP Stars list of the Top 250 Women in IP, and was also named an "IP Star" in the *Managing Intellectual Property* IP Stars Survey since 2015. She was selected for inclusion in the 2018–2020 *Illinois Super Lawyers*<sup>®</sup> lists and the 2013–2017 *Illinois Rising Stars*<sup>®</sup> lists, featuring outstanding young attorneys in the state. Heather was also designated as an "Emerging Lawyer" in the 2015–2020 editions of *Emerging Lawyers Magazine*, in which individuals are recognized among the top up-and-coming attorneys in Illinois. Since 2021, Heather has been named a "Leading Lawyer". In 2020, Heather was recognized amongst *Crain's Chicago Business* Notable Women in Law. Most recently, Heather was included in the inaugural *Lawdragon* 500 Leading Litigators in America list.

Clients say that Heather "exhibits all the qualities that inside counsel desire from outside counsel, including creativity, fantastic organizational skills, ethical conduct and strategic thinking." She "brings her A game to each and every matter that she handles; an invaluable member of any team." In addition, she "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 Heather."



## Practices

- Patent Prosecution
- Post-Grant Patent Proceedings

## Industries

- Biotechnology & Life Sciences
- Cleantech & Renewables
- Pharmaceutical
- Entrepreneurship, Startups & Emerging Companies

## 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.

Heather 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

Heather 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.

Heather 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

- "Invest in Yourself ...Don't Lay Yourself Off," Co-Presenter, *Licensing Executive Society Webinar Hosted by the Women in Licensing Committee*, October 13, 2020.
- "Women In Bio-Chicago Sixth Annual Start-Up Challenge," Moderator, Women In Bio-Chicago, September 10, 2020.
- "Enhancing Your Research & Development Pipeline," Moderator, Consero IP Forum for Life Sciences, December 8, 2019.
- "Women In Bio-Chicago Fifth Annual Start-Up Challenge," Moderator, Women In Bio-Chicago, September 18, 2019.
- "Understanding Patents - Answering Common Questions From Academic Inventors," Co-Presenter, Innovation and New Ventures (INVO) at Northwestern University, October 9, 2018.

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

[See Heather's additional publications and presentations.](#)

## 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

## Insights

October 13, 2020

**"Invest in Yourself ...Don't Lay Yourself Off"**

Licensing Executives Society Webinar Hosted by the Women in Licensing Committee

December 8, 2019

**"Enhancing Your Research and Development Pipeline"**

2019 Consero IP Forum for Life Sciences

September 18, 2019

**Women In Bio-Chicago Fifth Annual Start-Up Challenge**

October 9, 2018

**Understanding Patents - Answering Common Questions From Academic Inventors**

September 17, 2018

**Women In Bio-Chicago Fourth Annual Start-Up Challenge**

September 30, 2015

**“Start-up Challenge”**

Women in Bio-Chicago

March 2015

**“Best practice series: Women's initiatives”**

Managing Intellectual Property

March 2, 2012

**In the News**

Chicago Daily Law Bulletin

September 2000

**83(6): 782-791**

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