



Jennifer Burnette

Partner and Chair, Chemical Sciences

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Jennifer Burnette advises clients that innovate in material and polymer sciences, chemistry/chemical engineering, pharmaceuticals, nanotechnology, and mechanical products. Jennifer has experience in strategic patent portfolio management and counseling, foreign and domestic prosecution of patent applications, inter partes post grant proceedings, and counseling clients on invalidity, non-infringement, and freedom to practice matters. She uses her interdisciplinary training in material science to quickly establish in-depth understanding of technologies and invest in understanding a client's business needs and objectives to counsel clients on how to maximize the value of their patent portfolio. Clients gain an advocate who works intensively and with dedication to their interests.

Jennifer was selected for inclusion in the 2013–2019 *Illinois Rising Stars*[®] lists, featuring outstanding young attorneys in the state. She was also selected for inclusion as an “Emerging Lawyer” in the 2017–2019 editions of *Emerging Lawyers Magazine*, in which individuals are recognized among the top up-and-coming attorneys in Illinois.

Practices

- Patent Prosecution

Industries

- Chemical Sciences
- Cleantech & Renewables
- Consumer Products
- Materials Science
- Industrial & Mechanical Technologies
- Nanotechnology
- Pharmaceutical

Representative Experience

- Advised client investigating hydrophobic coating technologies with respect to patent filing strategies and third party patent landscape
- Strategic development of a global patent portfolio to leverage in a multi-faceted licensing structure
- Preparation and prosecution of global patent portfolios in pharmaceutical and formulation technologies

- Counseling of clients with respect to freedom to practice issues

Jennifer has capably prosecuted patents for clients in a wide variety of technologies, including:

- Microfluidic systems
- Pharmaceutical and formulation technologies
- Semiconductor fabrication
- Nanotechnology
- Metallurgical technologies including metal processing and specialty alloy development
- Battery technologies
- Hydrogen storage technologies
- Analytical sensor systems
- Electroplating technologies
- Coatings, such as conformal coatings, water-repellent fabric coatings, and hydrophobic surface coating
- Ink compositions and correction fluids
- Personal care products

Background and Credentials

Jennifer earned her J.D., *magna cum laude*, from the University of Minnesota Law School in 2007, where she was Editor in Chief of *The Minnesota Journal of Law, Science and Technology*.

She gained her interdisciplinary technical training while earning B.S. degrees in material science & engineering and in engineering science & applied mathematics in 2004 from Northwestern University. While at Northwestern University, she was involved in the research and development of an oxidation resistant niobium superalloy. She was also involved in the research and development of a method for biosynthesis of molecular building blocks for nanoscale patterning and self-assembly. Jennifer also participated in an internship program involving the development of a novel liposome drug delivery system with applications as chemotherapy drug delivery units. Additional research covered the synthesis of iron oxide magnetic particles for use with drug delivery systems.

Education

- University of Minnesota Law School (J.D., *magna cum laude*)
- Northwestern University (B.S.)
 - Engineering Sciences and Applied Mathematics
- Northwestern University (B.S.)
 - Material Science and Engineering

Bar Admissions

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

Community and Professional Involvement

- Women's Board of the Adler Planetarium

Publications and Presentations

- ""Science Nerd' Masters Arts for Businesses With Patent Portfolios," *Emerging Lawyers Magazine*, April 2020 Issue.

Client Successes

Eliminating Spillover via an Inter Partes Victory

The Firm secured a complete victory for SSW Holding Company, Inc., in an inter partes review proceeding challenging the validity of an SSW patent, making its client one of just a handful to emerge from the newly established inter partes review process with every challenged patent claim fully intact.

Inter partes review (IPR) is a streamlined process for challenging patents created through the Leahy-Smith America Invents Act of 2011 and, to date, has proven favorable to those challenging patents. Of the 78 decisions issued in IPR proceedings through June of 2014, the Patent Trial and Appeal Board cancelled or invalidated nearly 80 percent of the patent claims before it. In only 14 percent of such cases did the board find in favor of the patent owner with respect to all of the patent claims under consideration, as it did in *Schott Gemtron Corp. v. SSW Holding Company, Inc.* The Patent Trial and Appeal Board's decision rejected arguments that SSW's patent—which covers spill-containing refrigerator shelving technology used by major appliance manufacturers—was “obvious” and therefore invalid. Oral argument in the case took place on June 23, 2014.