MARSHALL GERSTEIN

Michael Muczynski

Partner

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Michael Muczynski advises clients on all issues relating to patent strategy and portfolio management, with particular emphasis in patent prosecution and opinions in pharmaceutical and other chemical fields. His clients benefit from his previous litigation experience involving generic pharmaceuticals, in anticipating potential issues and strengthening patents through prosecution.

Michael was recognized as a Life Sciences Star by *LMG Life Sciences* and has been named an “IP Star” in the *Managing Intellectual Property* IP Stars Survey since 2014. In 2013 he was selected as a Top Rated Lawyer in Intellectual Property by American Lawyer Media. He was previously recognized as an *Illinois Rising Star* by *Law & Politics* (a peer rating for attorneys 40 years old or younger or in practice for 10 years or less). Michael holds an AV® Preeminent™ Peer Review Rating by LexisNexis Martindale-Hubbell®. Additionally, he has been selected as one of the “World’s Leading Patent Practitioners” and recognized in the Strategy 300 Global Leaders guide both by *Intellectual Asset Management* (*IAM*) magazine.

Practices

- IP Litigation
- Patent Prosecution
- Post-Grant Patent Proceedings

Industries

- Biotechnology & Life Sciences
- Chemical Sciences
- Cleantech & Renewables
- Consumer Products
- Pharmaceutical

Representative Experience

Michael's technical areas of experience in pharmaceuticals range from chemical synthesis and purification, to pharmaceutical delivery and dosage forms, to diagnosis and treatment methods, to medical devices and animal health. He has also acquired an understanding of related technologies including analytical techniques and pharmacokinetics.

Representative examples from his patent prosecution and opinion practice include: crystal polymorphism, diagnostic methods, dosing regimens for improved safety and efficacy, modified release formulations, stabilized API and oral dosage formulations, and medical devices including catheter locks, syringe pumps, respiration monitors, and transdermal delivery devices.

He also advises clients on legal issues relating to generic drugs, lifecycle management, Orange Book listings, and patent term extensions. He has substantial experience in preparing and prosecuting patent applications under the USPTO accelerated examination program.

Outside the pharmaceutical space, Michael has experience in a diverse range of technologies, including analytical instruments and techniques (e.g., AFM, CLSM, FTIR, and SEM), chemical process engineering (including environmental pollution control and minerals processing), engineered paper and wood products, formulation chemistry (including cosmetics and other personal care products, inks, and polymer films), fuel chemistry (including biofuels and other synthetic fuels), nanotechnology (including non-cantilevered nanoprobe arrays and nanolithography methods), and semiconductor processing.

Michael's extensive patent work for clients with chemical and pharmaceutical technologies includes:

- Analysis of data package exclusivity, orphan drug exclusivity, and pharmaceutical patent opportunities in approximately 40 countries to support client’s global launch strategy for new pharmaceutical product.
- For a clinical stage specialty pharmaceutical company, used the USPTO "Track I" Prioritized Examination program and quickly gained allowance of key patent application directed to treatment method covering their lead product under development.
- Grant of strategically-important patents directed to:
    - side-effect-reducing initial dose titration methods for pharmaceutical product;
    - capsule dosage form;
    - pharmaceutical granulation product;
    - combination therapy invention.
- Gained allowance of a patent directed to a solvent-free method of producing a pharmaceutical implant dosage form.

Background and Credentials

Michael's practice includes strategic portfolio management as well as preparing patent applications, domestic and foreign patent prosecution, and validity and infringement opinions. A substantial part of his practice involves counseling clients on strategic decisions for patenting of inventions relating to pharmaceutical products in view of FDA regulations, related exclusivity provisions, and the competitive landscape.

His prior litigation practice included substantial experience in generic pharmaceutical litigation relating to ANDA filings under the Hatch-Waxman amendments to the Federal Food, Drug and Cosmetic Act.

He serves on the firm's docketing and technology committees and is active in associate mentoring and education within the firm.

He is admitted to practice in the state of Illinois, the U.S. District Court for the Northern District of Illinois, and before the U.S. Patent and Trademark Office.

Michael earned a J.D. degree from The University of Michigan Law School in 1997 and a B.S. degree in chemical engineering from Michigan State University in 1993.

Education

- The University of Michigan Law School (J.D.)
- Michigan State University (B.S.)
    - Chemical Engineering

Bar Admissions

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

Publications and Presentations

Michael regularly lectures on current topics in patent law to clients and prospective clients. He has also presented educational seminars on intellectual property law to audiences including non-IP law firms and alumni groups.

- "The Value of Intellectual Property to Investors," Keiretsu Forum Midwest Thought Leadership Series, Co-Presenter, April 16, 2021.
- "New EU Rules Will Help Generics and Biosimilars," Marshall Gerstein Alert, February 28, 2019.
- "Around The Water Cooler," *Chicago Lawyer*, October 26, 2009.
- Green IP—Grow Into Green Speaker Event, September 25, 2009.
- Raising Your Patent IQ—Illinois Technology Development Alliance Entrepreneur Briefcase, September 2008.

Community and Professional Involvement

- American Intellectual Property Law Association (AIPLA)
- American Bar Association's Advisory Panel (ABA)
- Keiretsu Forum, Chicago/Midwest Chapter – IP Due Diligence

Insights

February 28, 2019
New EU Rules Will Help Generics and Biosimilars
Marshall Gerstein Alert