



Sandip H. Patel

Partner

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Sandip Patel advises companies in the chemical and life sciences industries on all aspects of patent law. He is one of a small group of U.S. patent lawyers with extensive experience in all areas of patent law, including preparing and prosecuting patent applications, patent portfolio management, opinion counseling, inter partes practice before the Patent Trial and Appeal Board, litigation in the federal courts, and participation in foreign opposition and litigation matters in Australia, China, Europe, and Japan. Clients particularly value this extraordinary breadth of experience in resolving their most complex patent issues.

After graduating from Indiana University's Maurer School of Law, Sandip joined the firm. There, a collection of the firm's leading patent lawyers who were working at the cutting edge of the law and biotech and chemical sciences, trained him. As their apprentice, he learned how to write and prosecute patent applications in ways that strategically strengthened patent portfolios for multinational corporations such as BASF, BP Corporation, International Paper Company, Pfizer, and Raytheon Corporation, among many others. Sandip also learned how to draw out of inventors their discoveries. He worked with them to ensure their patents would offer a competitive advantage and withstand adversarial scrutiny and rigorous foreign opposition systems. Now, he pays it forward by working with junior lawyers at the firm to ensure they too learn these critically important skills.

Early in his career, Sandip learned the basics of patent litigation, including how to conduct discovery, position clients for advantageous dispute resolution, and how to prepare for and participate in federal court trials for companies such as Amgen and the Procter and Gamble Company. He also learned how to navigate the complex and often unwritten rules of Patent Office interferences, where he helped clients contend for patents on early cancer treatments, genetically modified plants, and innovations underlying many household consumer products. For more than two decades, he has successfully handled and led contested interferences for many of the companies listed above, and ACCO Brands, Gillette, Monsanto, Newell Rubbermaid, and Pharmacia & Upjohn, as well as smaller companies and universities.

Today he provides clients strategic counseling in all areas of patent law, with a particular focus on Patent Office (AIA) trials whose procedural rules were drawn from those used to administer interferences. And he has spent much of the past decade helping clients, including a Nobel Laureate, obtain a robust portfolio of patents worldwide on fundamental CRISPR-Cas9 gene editing technologies. This includes counseling in multiple foreign oppositions and U.S. patent interferences. In these cases, and many others, he has benefited from cooperatively working with the best among his peers at other law firms in the U.S. and overseas.

The clients he advises are diverse and include specialty chemical companies, universities, start-ups, and a variety of large, multinational corporations focused on biotechnology, chemicals, or consumer products. While many of the clients he helps are not publicly affiliated with the firm, it's not surprising that the strategic counseling he offers them is purposely shielded from the public eye. New clients find him through recommendations of the above-listed companies and others when they have a particularly challenging issue.

Sandip has a formal education in chemical engineering from Michigan State University (Go Green!), but his work has spanned the entire spectrum of engineering, chemical and life sciences. And through that experience, he has proven adept at quickly grasping diverse technologies and devising efficient intellectual property strategies that clients have used to achieve their business objectives. Sandip also mentors junior lawyers and law school students, and shares his practical insights publicly, having written dozens of articles on various patent law topics.

Sandip's peers and clients have recognized his legal work and his other successes in numerous attorney directories and awards, including *Best Lawyers in America*® (since 2016), *Illinois Super Lawyers*® (since 2013), an "IP Star" (since 2016) in the *Managing Intellectual Property* IP Stars Survey, a "Life Sciences Star" (since 2016) according to *LMG Life Sciences*, and a "Leading Lawyer" (since 2019) according to Law Bulletin Media's Leading Lawyers division. Sandip was also named to the inaugural list of the Lawdragon 500 Leading Litigators in America in 2022 and has been named to that list each year since. He is thankful for this recognition and, more importantly, for the many clients who have sought his advice for over twenty years, such as Amgen, BASF, and Procter and Gamble. Furthermore, he remains a proud member of the firm, having previously chaired the attorney recruiting committee for ten years and later having served on the executive committee for six years.

Practices

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

Industries

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

Representative Experience

- Counseled clients in dozens of inter partes matters in the Patent Office in a variety of sciences including:
 - biotechnology (e.g., antibody formulations, avirulent vaccines, DNA sequencing methods, fundamental CRISPR technologies, genetically-engineered plants, and keratinocyte growth factors)
 - chemistry/chemical engineering (e.g., pharmaceutical compounds and compositions, food processing chemicals, and chemical and biochemical reactor design and operation)
 - mechanical engineering (e.g., railcar shock absorbers, correction-tape dispensers, paper shredders, computer locks, hand held razors, and baby diapers)
 - electrical engineering (e.g., piezoelectric ink-jet printers, process control systems and software)
- Counseled clients in patent infringement actions in the federal courts involving:
 - biotechnology patents (e.g., antibody formulations, recombinant growth hormone, recombinant erythropoietin)

- pharmaceutical chemistry patents (e.g., platinum coordination compounds and methods of treating cancerous tumors)
- chemical engineering patents (e.g., air pollution control processes and equipment, reaction engineering and reactor design)
- mechanical engineering (e.g., personal care devices, such as razors and feminine care products, computer locks, and smart device stands/platforms)
- Prepared and prosecuted to issuance patent applications concerning, for example:
 - consumer products (e.g., baby diapers, feminine hygiene products, dish and laundry cleaning compositions, pens, inks, paints)
 - industrial products (e.g., semiconductors, construction materials)
 - reaction engineering processes (e.g., catalytic reactors, biochemical reactors, industrial gas combustion turbines, sulfonation processes)
 - chemical compositions and processes (e.g., superabsorbent polymers, commodity chemicals, cleaning solvents)
 - pharmaceutical compositions and associated manufacturing methods (e.g., taxol formulations, antibody formulations, central nervous system analgesics)

Background and Credentials

Sandip has been a partner of the firm since 2002, having joined as an associate following his graduation from law school in 1996. While at the firm, he has drafted and prosecuted hundreds of patent applications, and has served as counsel in dozens of contested proceedings in the U.S. Patent and Trademark Office and in associated appeals, and as counsel in a number of patent cases in the federal courts. Sandip also served as chairperson of the firm's Attorney Recruiting Committee for ten years, and later served for six years on the firm's Executive Committee.

Sandip received his J.D. from Indiana University Maurer School of Law, in Bloomington, Indiana, in 1996. During law school, he served as a Notes and Comments Editor of the *Indiana Law Journal*. He received a B.S. degree (with honors) in chemical engineering from Michigan State University in 1993.

Education

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

Bar Admissions

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

Publications and Presentations

- "[Federal Circuit Holds Recoverability of Attorney's Fees Does Not Extend to AIA Trials](#)," *IP Litigator*, July 1, 2024.
- "Potentially Poisonous Patents," *AUTM Insight*, May 3, 2024.
- "[Federal Circuit Imperils Term-Adjusted Patents](#)," *ALM's IP Strategist*, November 2023.
- "[Patent Interferences May Not Involve Pure AIA Patent](#)," *IP Litigator*, September/October 2023.
- "[Intel Cancels One VLSI Patent Underlying \\$2 Billion Verdict](#)," *Bloomberg Law*, May 12, 2023 (featured quotes).

See Sandip's additional thought leadership.

Representative Inter Partes Matters

*AbbVie Inc. v. Amgen Inc.**

U.S. District Court, District of Delaware
Biotechnology (BPCIA)

*Coca Cola Inc. v. The Procter & Gamble Company**

U.S. Patent and Trademark Office
Inter partes Reexamination
Chemistry

Opposition and Appeal re: Baxter International Inc. & Baxter Healthcare S.A.**

Boards of Appeal of the European Patent Office
Patent Opposition and Appeal
Chemical Engineering

Stevens (Newell Rubbermaid Inc.) v. Tamai (Seed Rubber Company)*

U.S. Court of Appeals for the Federal Circuit
Patent Interference Appeal
Mechanical Engineering

*The Broad Institute, Inc., Massachusetts Institute of Technology, and President and Fellows of Harvard College v. The Regents of the University of California, University of Vienna, and Emmanuelle Charpentier**

U.S. Patent and Trademark Office Patent Trial and Appeal Board
U.S. Court of Appeals for the Federal Circuit
Patent Interference
CRISPR-Cas9 technology

*Party Represented

See Sandip's additional Representative Matters.

Community and Professional Involvement

- American Bar Association
- American Intellectual Property Law Association
- Intellectual Property Owners Association

Insights

July 1, 2024

"Federal Circuit Holds Recoverability of Attorney's Fees Does Not Extend to AIA Trials"

IP Litigator

May 3, 2024

"Potentially Poisonous Patents"

AUTM Insight

November 13, 2023

"Federal Circuit Imperils Term-Adjusted Patents"

ALM's IP Strategist

September/October 2023

"Patent Interferences May Not Involve Pure AIA Patent"

IP Litigator

May 12, 2023

"Intel Cancels One VLSI Patent Underlying \$2 Billion Verdict" (featured quotes)

Bloomberg Law

June 17, 2021

"How I Made Law Firm Leader: Advice From Marshall Gerstein Executive Committee Member Sandip Patel"

Law.com

September/October 2020 Issue

"Does Section 285 Permit an Award of Attorney's Fees for Patent Office Proceedings?"

IP Litigator

April 13, 2020

"The Impact of Distinct Printed Publication Rules In Exams, IPR" (featured quotes)

Law360

February 4, 2020

"The PTAB Precedential Opinion Panel's Hulu Decision: Any Guidance is Better than No Guidance"

IPWatchdog

January/February 2019 Issue

"Supreme Court Decision Invites Confusion and Delay"

IP Litigator

January 24, 2019

Supreme Court Confirms Secret Sales Can Invalidate Patents

Marshall Gerstein Alert

December 17, 2018

"The Biggest Patent Cases of 2018" (featured quotes)

Law360

December 13, 2018

"Industry Reaction to Helsinn Healthcare v. Teva Pharmaceuticals Oral Arguments" (featured quotes)

IPWatchdog

December 5, 2018

"Supreme Court Steps in as Grammar Police for AIA's On-Sale Bar" (featured quotes)

BioWorld

December 5, 2018

"US Supreme Court Likely to Limit On-Sale Bar to Public Prior Art" (featured quotes)

Managing Intellectual Property

December 5, 2018

"SCOTUS Helsinn v Teva Showdown Begins" (featured quotes)

Intellectual Property Magazine

December 4, 2018

"SCOTUS Likely to Reverse Helsinn v Teva Ruling, Say Lawyers" (featured quotes)

World Intellectual Property Review

June 25, 2018

Supreme Court Decides Infringement Remedies May Include Foreign Lost Profits

Marshall Gerstein Alert

April 25, 2018

"Oil Firms' Supreme Court Spat Could Change Patent Law, Attorneys Say" (featured quotes)

Westlaw Journal Intellectual Property

April 25, 2018

"SAS: When the Patent Office Institutes IPR it Must Decide Patentability of All Challenged Claims" (featured quotes)

IPWatchdog

April 24, 2018

Supreme Court Decides that IPR Final Decisions Must Address All Challenged Claims

Marshall Gerstein Alert

April 17, 2018

"SCOTUS: Patent Case Sparks Concerns Over International Relations" (featured quotes)

World Intellectual Property Review

April 16, 2018

"Justices Press Both Sides Over Foreign Patent Damages" (featured quotes)

Law360

November/December 2017 Issue

"Fractured Federal Circuit Reallocates a Burden of Proof in AIA Trials"

IP Litigator

March 2, 2017

"Patent Owners and Petitioners Weigh In"

PTAB Bar Association Inaugural Conference

January 26, 2017

"AIA Estoppel Provision Not As Restricted As Many Expected" (featured quotes)

Law360

August 16, 2016

"Amendments Case Could Help Patents Survive AIA Review" (featured quotes)

Law360

April 28, 2016

"High Court May Be Next Stop For PTAB Deference Issue" (featured quotes)

Law360

May 27, 2015

"Supreme Court Holds that an Accused Infringer's Belief Regarding Patent Validity is Not a Defense to Induced Infringement"

Marshall Gerstein Alert

October 13, 2014

"Preparing Patents to Withstand AIA Trials and Defending a Patent in AIA Trials"

2014 IP Defense Summit, Chicago, IL

October 2014

"The amendment conundrum of inter partes review"

InsideCounsel

March 18, 2014

"The Never-ending Debate Over Appellate Review of Claim Construction"

InsideCounsel

February 18, 2014

"Supreme Court to Redefine Patent Law's Indefiniteness Standard"

InsideCounsel

January 21, 2014

"The Murky Morass Plaguing the Patent System"

InsideCounsel

October 30, 2013

"U.S. Patent and Trademark Office Issues Final Rules to Implement Provisions of the Patent Law Treaty that Change Aspects of U.S. Patent Laws"

Marshall Gerstein Alert

April 2013

"Idenix Pharmaceuticals" (featured quotes)

BioPharm Insight

November 27, 2012

"Kappos a Tough Act to Follow as USPTO Director" (featured quotes)

Law360

September 18, 2012

“Patent office gets face-lift over the weekend with new rules, prices” (featured quotes)

Chicago Daily Law Bulletin

September 2012

“The America Invents Act—What Patent Administrators Need to Know”

Keynote speaker, Association of Legal Administrators IP Retreat

December 11, 2009

“The Limited Benefits of Product-By-Process Claims”

Intellectual Property Today

November 2009

“Resetting Judicial Doctrine of Inequitable Conduct”

Author and Moderator, ABA Roundtable Discussion

June 2005

“Patents and Tying: Why the Supreme Court Is Getting Involved”

Law360

April 2005

“Industries Await Exemption Verdict”

Managing IP, No. 14

1996

“Graduate Students’ Ownership and Attribution Rights in Intellectual Property” 71 Ind. L.J. 481

Client Successes

Protecting Carbon-Capture Technologies

Marshall, Gerstein & Borun LLP obtained a successful result for CO₂ Solutions, Inc., in an Inter Partes Review (IPR) of one of CO₂ Solutions’ patents covering its enzyme-based technology for capturing carbon dioxide from exhaust gas. The Patent Trial and Appeal Board (PTAB) at the U.S. Patent and Trademark Office ruled in favor of CO₂ Solutions on four of the five grounds of review, upholding CO₂ Solutions’ commercially significant claims of the challenged patent.

CO₂ Solutions’ proprietary carbon-capture technologies, as covered by the upheld patent claims and by other patents in CO₂ Solutions’ portfolio, provide environmentally-friendly, efficient, and cost-effective methods for reducing carbon emissions. As stated by Evan Price, President and CEO of CO₂ Solutions, “We believe this confirms CO₂ Solutions’ possession of the least expensive and most environmentally friendly carbon capture technology available on the market.”

IPR Win for ACCO’s ClickSafe® Locks

Marshall Gerstein successfully represented ACCO Brands Corporation and ACCO Brands USA LLC in Inter Partes Reviews (IPR) before the Patent Trial and Appeal Board (PTAB), appeal of that decision to the U.S. Court of Appeals for the Federal Circuit, and in related infringement litigation in the Eastern District of New York, in which Think Products accused ACCO’s ClickSafe® line of computer locks of infringing two Think Products patents.

Marshall Gerstein petitioned for IPR of each asserted patent, arguing that the Think Products patents were obvious over combinations of prior-art references, and anticipated by a published video disclosing the accused ClickSafe® product.

In both IPRs, the PTAB ruled in favor of ACCO on all grounds of review, cancelling all challenged claims of the patents, and these decisions were upheld on appeal to the Federal Circuit.

Representative Matters

AbbVie Inc. v. Amgen Inc. *

U.S. District Court, District of Delaware
Biotechnology (BPCIA)

Adams (Monsanto) v. Leemans (Bayer CropSciences)*

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences
Patent Interference
Biotechnology

Akermin, Inc. v. CO₂Solutions Inc. *

U.S. Patent and Trademark Office Patent Trial and Appeal Board
Inter Partes Review
Chemical Engineering

Amgen Inc. v. AbbVie Inc.*

U.S. Patent and Trademark Office Patent Trial and Appeal Board
Inter Partes Review
Biotechnology

Amgen Inc. v. F. Hoffmann-LaRoche LTD et al.*

U.S. District Court, District of Massachusetts
U.S. Court of Appeals for the Federal Circuit
Biotechnology

Amgen Inc. v. Hoechst Marion Roussel*

U.S. District Court, District of Massachusetts
U.S. Court of Appeals for the Federal Circuit
Biotechnology

Amgen Inc. v. United States of America Dept. of Health & Human Services*

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences
Patent Interference
Biotechnology

Barton v. Fischhoff (Monsanto) v. Adang (Mycogen Plant Science)*

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences
Patent Interference
Biotechnology

*Biocrede, Inc. v. Regents of the University of Michigan**

U.S. Patent and Trademark Office Patent Trial and Appeal Board
Derivation Proceeding
Biotechnology

*Braun (Eastman Kodak Company) v. Temple et al. (Xaar Technology Limited)**

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Patent Interference
Mechanical Engineering, Electrical Engineering/Computer Software

Canfield Scientific, Inc. v. Melanoscan, LLC*
U.S. Patent and Trademark Office Patent Trial and Appeal Board
U.S. Court of Appeals for the Federal Circuit
Inter partes Review
Medical Device

*Chee (Affymetrix) v. Drmanac (Hyseq)**
U.S. Patent and Trademark Office Board of Patent Appeals and Interferences
Patent Interference
Biotechnology

*Chen (Bristol-Myers Squibb Co.) v. Hester (Pharmacia & Upjohn Co.)**
U.S. Patent and Trademark Office Board of Patent Appeals and Interferences
Patent Interference
Pharmaceutical Chemistry

*Coca Cola Inc. v. The Procter & Gamble Company**
U.S. Patent and Trademark Office
Inter partes Reexamination
Chemistry

*Commonwealth Scientific and Industrial Research Organisation v. BASF Plant Science Company GmbH**
U.S. Patent and Trademark Office Patent Trial and Appeal Board
Post Grant Reviews (multiple)
Chemistry

*Correa et al. (Johnson & Johnson) v. Roberts et al. (Procter & Gamble Company)**
U.S. Court of Appeals for the Federal Circuit
Patent Interference Appeal
Mechanical Engineering

*Crater (Control Technologies Corporation) v. Nixon (Fisher-Rosemount Systems, Inc.)**
U.S. Patent and Trademark Office Board of Patent Appeals and Interferences
Patent Interference
Electrical Engineering/Computer Software

*Gardner (Northern Innovations and Formulations Corp.) v. Hastings (Reliv International Inc.)**
U.S. Patent and Trademark Office Board of Patent Appeals and Interferences
Patent Interference
Chemistry

Hester (Pharmacia & Upjohn Co.) v. Bouchard (Aventis Pharma S.A.)*
U.S. Patent and Trademark Office Board of Patent Appeals and Interferences
Patent Interference
Pharmaceutical Chemistry

Hester (Pharmacia & Upjohn Co.) v. Chen (Bristol-Myers Squibb Co.)*
U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Patent Interference
Pharmaceutical Chemistry

Groupon, Inc. v. Kroy IP Holdings, LLC*
U.S. Patent and Trademark Office Patent Trial and Appeal Board
U.S. Court of Appeals for the Federal Circuit
Inter partes Reviews (multiple)
Computer Science

Groupon, Inc. v. Online New Link LLC*
U.S. Patent and Trademark Office Patent Trial and Appeal Board
Covered Business Method Patent Reviews (multiple)
Computer Science

*Lai v. Palmer (Newell Rubbermaid)**
U.S. Patent and Trademark Office Board of Patent Appeals and Interferences
Patent Interference
Mechanical Engineering

*Li (Human Genome Sciences) v. Godiska (ICOS Corp.)**
U.S. Patent and Trademark Office Board of Patent Appeals and Interferences
Patent Interference
Pharmaceutical Chemistry

*Macove v. Luxton (The Gillette Company)**
U.S. Patent and Trademark Office Patent Trial and Appeal Board
Patent Interference
Mechanical Engineering

*Matlin (Fellows Brands Corporation) v. Aries (ACCO Brands Corporation)**
U.S. Patent and Trademark Office Patent Trial and Appeal Board
Patent Interference
Mechanical Engineering

*Martuza et al. (Massachusetts General Hospital) v. Roizman et al. (ARCH Development Corporation)**
U.S. Patent and Trademark Office Board of Patent Appeals and Interferences
Patent Interference
Biotechnology

*McDonald (University of Tennessee) v. Miyazaki (Kirin Brewery Company Ltd.)**
U.S. Patent and Trademark Office Board of Patent Appeals and Interferences
Patent Interference
Pharmaceutical Chemistry

Monaco (Keystone Industries) v. Kalina (FM Industries)*
U.S. Patent and Trademark Office Board of Patent Appeals and Interferences
Patent Interference
Mechanical Engineering

*Novo Nordisk v. Pharmacia & Upjohn Co.**
U.S. District Court, District of New Jersey

Patent Infringement
Pharmaceutical Chemistry and Biotechnology

Opposition and Appeal re: Baxter International Inc. & Baxter Healthcare S.A.**
Boards of Appeal of the European Patent Office
Patent Opposition and Appeal
Chemical Engineering

*Opposition and Appeal re: Lawrence Industries Inc.**
Boards of Appeal of the European Patent Office
Patent Opposition and Appeal
Chemistry/Chemical Engineering

*Quantificare, Inc. v. The Procter & Gamble Company**
U.S. Patent and Trademark Office Patent Trial and Appeal Board
Inter partes Reviews
Medical Device

*Refsell (Valent USA Corp.) v. Sievernich et al. (BASF SE)**
U.S. Patent and Trademark Office Patent Trial and Appeal Board
Patent Interference
Chemistry

*Refsell (Sumitomo Chemical Co.) v. Sievernich et al. (BASF SE)**
U.S. Patent and Trademark Office Patent Trial and Appeal Board
Patent Interference
Herbicide Compositions

Research Corp. Techs. and Bristol-Myers Squibb Co. v. Ben Venue Labs et al.*
U.S. District Court, District of New Jersey
Pharmaceutical Chemistry

The Regents of the University of California, University of Vienna, and Emmanuelle Charpentier v. Sigma-Aldrich Co., LLC*
U.S. Patent and Trademark Office Patent Trial and Appeal Board
Patent Interference
CRISPR-Cas9 technology

The Regents of the University of California, University of Vienna, and Emmanuelle Charpentier v. The Broad Institute, Inc., Massachusetts Institute of Technology, and President and Fellows of Harvard College*
U.S. Patent and Trademark Office Patent Trial and Appeal Board
U.S. Court of Appeals for the Federal Circuit
Patent Interference
CRISPR-Cas9 technology

Stevens (Newell Rubbermaid Inc.) v. Tamai (Seed Rubber Company)*
U.S. Court of Appeals for the Federal Circuit
Patent Interference Appeal
Mechanical Engineering

*The Broad Institute, Inc., Massachusetts Institute of Technology, and President and Fellows of Harvard College v. The Regents of the University of California, University of Vienna, and Emmanuelle Charpentier**

U.S. Patent and Trademark Office Patent Trial and Appeal Board

U.S. Court of Appeals for the Federal Circuit

Patent Interference

CRISPR-Cas9 technology

*Think Products Inc. v. ACCO Brands Corporation**

U.S. Patent and Trademark Office Patent Trial and Appeal Board

U.S. Court of Appeals for the Federal Circuit

Inter Partes Review

Mechanical Engineering

*Think Products Inc. v. ACCO Brands Corporation**

U.S. District Court, Eastern District of New York

Mechanical Engineering

*Think Products Inc. v. ACCO Brands Corporation**

U.S. District Court, Northern District of Illinois

U.S. Court of Appeals for the Federal Circuit

Mechanical Engineering

*Universite Laval v. Regents of the University of Michigan**

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Patent Interference

Biotechnology

*Vegenics Pty Limited*v. Universita Degli Studi di Siena*

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Patent Interference

Biotechnology

*Party Represented