MARSHALL GERSTEIN ip

William K. Merkel, Ph.D.

Of Counsel

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William K. Merkel, Ph.D., has provided a range of intellectual property legal services to a diverse portfolio of clients for more than 20 years. With a current focus on patent prosecution in the biotechnological arts, he has prosecuted numerous domestic, foreign, and international patent applications drawn to such diverse technologies as modulators of metabolic pathways involved in disease states, viral oncotherapies, agricultural technologies, and pharmaceutical products and methodologies. His efforts to protect his clients' interests have extended beyond patent issuance to the resolution of matters requiring court intervention. As a result, his clients gain a trusted resource capable of evaluating and appropriately protecting the most complex technologies.

William has been selected by the *Law Bulletin Publishing Company*'s Leading Lawyer Network as a "Leading Lawyer." He was also selected by his peers for inclusion in the 2016–2024 editions of *The Best Lawyers in America*© in the practice area of Patent Law.

WILLIAM K. MERKEL 2021 RECOGNIZED BY Best Lawyers

Practices

- Patent Prosecution
- Post-Grant Patent Proceedings

Industries

- Biotechnology & Life Sciences
- Non-Profit Technology Transfer
- Pharmaceutical

Representative Experience

- Successfully prosecuted domestic and foreign patent applications directed to attenuated viral therapeutics for treatment of cancer; also directed successful defenses of two European patents in opposition proceedings.

- Advised client on global patenting strategy for greentech agricultural technologies, and protected the technologies by securing comprehensive domestic and foreign patents.
- Counseled start-up companies and academic institutions on intellectual property strategies able to accommodate the recent economic downturn.
- Counseled clients conducting due diligence inquiries relating to intellectual property portfolios.

William has secured intellectual property rights in varied biotechnologies such as:

- Anti-cancer therapeutics involving attenuated viruses
- Recombinant expression systems for a variety of biologically active compounds such as growth factors, transcription factors, and signal proteins
- Molecular immunological methodologies for treating infertilities
- Anti-HIV therapeutics
- Plant-based systems for environmental remediation
- Cell growth technologies

William has litigated cases including:

- *Abbott Laboratories v. Biosite Diagnostics, Inc.,* Civil Action No. 94-C-2808 (N.D. Ill.
- *Hyseq, Inc. v. Affymetrix, Inc.,* Civil Action No. C-97-20188 (N.D. Cal).

Background and Credentials

Biotechnology clients benefiting from William's technical and legal experience have ranged from industry leaders to start-up enterprises. He has experience in medical diagnostics and therapeutics, agricultural and pharmaceutical products and methods, genomics, and medical and agricultural biotechnology. In addition to providing prosecution and litigation services in these areas, he develops intellectual property strategies and assists clients with validity, infringement and patentability opinions.

His contributions to the field of biotechnology include graduate-level research that has contributed to our understanding of the molecular genetics of vitamin biosynthesis in prokaryotes. As a Research Fellow, he discovered the Pan Operon, revealing the organization of genes involved in pantothenate biosynthesis, as reported in the peer-reviewed literature. This research experience and advanced training equip him with the ability to thoroughly understand the complex scientific technologies of his clients.

William received his J.D. from New York University School of Law and his Ph.D. in biological sciences from the University of Illinois at Chicago. He earned a B.A. in economics and psychology from Knox College.

Education

- New York University School of Law (J.D.)
- University of Illinois at Chicago (Ph.D.)
    - Biological Sciences
- Knox College (B.A.)
    - Economics and Psychology

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Bar Admissions

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

Publications and Presentations

- "Life Technologies Corp. Establishes a Quantitative Test Under 35 U.S.C. § 271(f)(1)," *Marshall Gerstein Alert*, February 24, 2017.
- "Myriad Further Limits Patent Eligibility," *BioProcessing Journal*, Summer 2013.
- "Patent Exhaustion: A Tireless Limit on Patent Rights," *BioProcessing Journal*, Spring 2013.
- "Induced Patent Infringement Breaks Free from Direct Infringement: The Implications for Bioprocessing," Co-Author, *BioProcessing Journal*, Winter 2012/2013.
- "IP: The Supreme Court levels its eye at agricultural GMOs," *InsideCounsel*. Jan. 22, 2013.

Access William's additional thought leadership.

Insights

October 9, 2018
Understanding Patents - Answering Common Questions From Academic Inventors

June 21, 2018
USPTO Memo Addresses Federal Circuit Authority on Patent Eligibility of Some Treatment Methods
Marshall Gerstein Alert

February 24, 2017
"Life Technologies Corp. Establishes a Quantitative Test Under 35 U.S.C. § 271(f)(1)"
Marshall Gerstein Alert

Summer 2013
"Myriad Further Limits Patent Eligibility"
BioProcessing Journal

Spring 2013
"Patent Exhaustion: A Tireless Limit on Patent Rights"
BioProcessing Journal

Winter 2012/2013
"Induced Patent Infringement Breaks Free from Direct Infringement: The Implications for Bioprocessing"
BioProcessing Journal

January 22, 2013
"IP: The Supreme Court levels its eye at agricultural GMOs"
InsideCounsel

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December 25, 2012
“IP: Value in the backwaters of patent law”
InsideCounsel

November 27, 2012
“IP: America Invents Act implementation ends with a bang”
InsideCounsel

April 2012
“Take these steps to ensure your TTO is ready for AIA”
Technology Transfer Tactics

April 2012
“Mayo v. Prometheus: A looming ‘disaster’ for tech transfer?”
Technology Transfer Tactics