



**Kathleen E. McCarthy**

**King & Spalding LLP**

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Katie McCarthy is a partner in the New York office of King & Spalding’s IP practice group with more than 30 years of experience in trademark, design, internet, advertising and copyright matters. Katie graduated from Columbia University School of Law and secured her bachelor’s in psychology from The College of the Holy Cross.

Katie advises clients on global IP, advertising and platform liability issues and litigates cases in the federal courts and the U.S. Patent and Trademark Office Trademark Trial and Appeal Board.

Katie is actively involved with the New York Intellectual Property Law Association (NYIPLA), having just finished several years on the Board and a term as President.

Katie also recently finished a two-year term as the Editor-In-Chief of the International Trademark Association’s scholarly journal *The Trademark Reporter*, having written, solicited and edited articles for the journal for more than 20 years. Her article on trademark parodies, “Free Ride or Free Speech: Predicting Results and providing Advice for Trademark Disputes involving Parody,” was published in *The Trademark Reporter* in 2019 and won INTA’s 2020 Ladas Memorial Award in the Professional Category.

Katie speaks frequently for the NYIPLA, INTA and PLI, and serves as the new editor for the PLI one volume treatise, *Kane on Trademark Law*. Katie also actively promotes diversity in the profession through her involvement in King & Spalding’s Women in IP and Technology initiatives and her mentorship of young lawyers and law students through various programs including the Leadership Council on Legal Diversity.

Katie lives in Astoria, New York with her husband and two sons.



## **Christine-Marie Lauture**

*IP Managing Attorney*

### **Bar Admissions**

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

### **Education**

- J.D., Brooklyn Law  
School
- B.A., Hofstra  
University

I'm an award-winning intellectual property and litigation attorney whose main priority is to help safeguard the ownership and value of creators like you.

Based in NYC and Long Island, I have years of experience in intellectual property, litigation, entertainment, and contracts, serving clients through the United States and internationally. I bring a breadth of knowledge in intellectual property law with my experience of counseling clients across various entertainment and technology-related industries, including: digital media, music, photography, podcasting, tech, fashion, consumer goods, e-sports and gaming, sports, performing arts, and publishing.

Growing up as a kid engulfed in the arts (dance & choreography, theater, music, sports, you name it), it was my **destiny** to fulfill my passion of protecting and serving the very spaces and communities that helped nurture my creativity. After pursuing my legal education with a focus in intellectual property, media, and information law, and later servicing a wide-scale of clients from start-ups to Fortune 500 companies, I realized that IP remains a foreign area of law for most creatives and business owners.

**In an ever-loving area of law and looking to help translate its respective IP vernacular, I founded Lauture IP to bridge the knowledge gap.**

As a business owner myself, I know first-hand what comes with being an entrepreneur and how to legally protect your business and make sure it thrives! Whether the task at hand is on the lighter end of performing IP searches, filing, portfolio management, reviewing entertainment contracts, or on the more complex end of IP prosecution, oppositions, take-downs, and infringement, my focus is to provide practical advice to help you focus on bringing life to your visions, and perfecting your business.

## Biography

### Rashmi Raj

Chief Intellectual Property Counsel

NielsenIQ

85 Broad Street

New York, NY 10004



Ms. **Rashmi S. Raj** is the Senior Vice President of the Intellectual Property Legal Department for NielsenIQ. She is actively engaged in reviewing and advising on the global IP landscape for the company. Her areas of focus include patent assertions, licensing, open source, M&A, trademarks/copyrights, patent prosecution and commercial transactions.

Prior to Nielsen, Ms. Raj worked in the intellectual property departments of multinational technology companies Pentair/Tyco & Siemens.

During her free time, Ms. Raj is dedicated to advancing females in engineering and science. For the last 25 years, she has offered a yearly scholarship at her local high school for a young woman who has demonstrated academic excellence and an interest in pursuing science or engineering in honor of her mother: Dr. Swadesh Sharma Raj.

She is a recipient of the City College Grove School of Engineering's Annual Women in Engineering Appreciation Award. She has also led and participated in a panel discussion at the MIP Women Leadership Forum in 2017 (NY, NY) on China – US IP Trade Wars: Policy and business concerns and participated as a panel member for PLI's Intellectual Property Rights Enforcement session in 2019 (NY, NY).

Ms. Raj earned her J.D. from Seton Hall School of Law, & a B.S. in Mechanical Engineering from Cornell University. She is registered to practice law in NY & NJ and before the United States Patent and Trademark Office and is an active member of several legal organizations. She enjoys long walks, traveling and cooking with her family.



**Eric Albrecht**

*IP Counsel*

Mitsubishi Power Americas

Mr. Albrecht is IP Counsel for Mitsubishi Power Americas, where he has worked for since November 2013. He earned a Bachelors of Science in Mechanical Engineering (BSME) from Tufts University, Masters of Business Administration (MBA) from Rensselaer Polytechnic Institute, and JD from the University of Connecticut School of Law. His experience includes 12 years as a design and manufacturing engineer, 2 years of private practice, and a total of 15 years practicing corporate Intellectual Property Law.



## David Bomzer

Counsel

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20 Church Street, 22nd Floor, Hartford, CT 06103



David has served as both in-house and outside counsel to some of the largest and most recognizable Fortune 500 companies. In these positions, he has been responsible for developing, coordinating and executing all aspects of patent protection strategies among global teams of business and technology hubs. In addition, he has developed objectives and procedures for identifying and protecting high value technology assets, and organized and led teams of technology leaders, who assisted in coordinating enterprise-wide protection efforts. David also managed patent procurement efforts by in-house and outside counsel.

David has drafted and prosecuted patent applications in the mechanical, electro-mechanical, telecommunication arts, to name a few, and participated in various post grant reviews. David also has extensive experience in procuring design patents for his clients. He has also drafted many freedom-to-operate opinions and patentability opinions for his clients. Further, David has protected his clients' interests in litigation matters via various Examination Before Trial (EBT) proceedings, including taking and defending depositions, preparing and examining infringement claim charts, preparing Markman briefs and assisting in Markman hearings.

David enjoys lecturing about intellectual property and technical subject matter, and has participated in and chaired many industry conferences and panels. David has lectured about patents, including utility and design patents, as well as other forms of intellectual property, to clients, startups, and to other attorneys via local and regional committee activities. He taught Cyber Law at Quinnipiac University School of Law as an Adjunct Professor for several years. He also taught mechanical and aerospace engineering courses to undergraduate and graduate students at the NYU Tandon School of Engineering (formerly known as Brooklyn Polytechnic University) as an Adjunct Professor for several years.

### Technologies

Aerospace & Aeronautics  
Automotive Technology  
Computer and Systems Engineering  
Computer Science & Software  
Electrical Engineering & Electronics  
Electro-Communications  
Energy  
Internet & E-Commerce  
Mechanical Engineering  
Metallurgy & Ceramics  
Semiconductor Devices & Processing Methods  
Telecommunications

### Practice Areas

Computer Science Practice  
Derivation Proceedings  
Design Patents Practice  
Due Diligence in IP Acquisitions  
Ex Parte Reexaminations  
Expedited Patent Examination  
Foreign & PCT Patent Filing  
Inter Partes Review  
International  
Invalidity Opinions  
IP Transactional

Continued

## Experience Highlights

Counsel, Cantor Colburn LLP, 2016-present

Counsel, Patents, Trade Secrets, Technology, Aetna, 2015-2016

Assistant Intellectual Property Counsel, United Technologies Corporation, Pratt & Whitney Division, 2012-2015

Counsel, Day Pitney, LLP, 2007-2012

Senior Associate, Jordan & Hamburg, LLP, 2004-2007

Associate, Scully, Scott, Murphy & Presser, P.C., 2001-2003

Associate, Darby & Darby, P.C., 1999-2001

Structural Dynamics / Acoustics Engineer, Electric Boat Corporation, a General Dynamics Company, 1996-1997

Processes Design Engineer, Pall Corporation, 1995-1996

Junior Engineer, CCI Manufacturing, A Ryder Truck Company, 1994-1995

## News

Cantor Colburn Client Alert: The Essentiality of Legal Title Assignment  
August 20, 2021  
(David Bomzer, Sara Colburn, and Charlie O'Brien)

Client Alert: Supreme Court Maintains, and Identifies Exceptions, to Assignor Estoppel  
June 30, 2021  
(Katherine Tassmer and David Bomzer)

## Events

IP Transactions Bootcamp 2021  
October 14, 2021  
virtual

David Bomzer, an active member of the New York Intellectual Property Law Association (NYIPLA), currently serving as Programs Planning Committee Chair of the Transaction and Patent Practice Committees, is one of the coordinators of the NYIPLA IP Transactions Bootcamp, taking place virtually in October and November 2021.

PLI's Patent Fundamentals Bootcamp 2021: An Introduction to Patent Drafting and Prosecution  
June 2, 2021  
Live Webcast

Licensing

Non-infringement Opinions

Opinions

Patent Landscaping and Risk Analysis

Patent Reissue

Patentability Opinions

Patents

Post Grant Practice

Post-Grant Review

Product Clearance

Right to Practice Opinions

Strategic IP Portfolio Development and Management

Technology Transfer

Trade Secrets

Utility, Design, and Plant Patent Filing with the USPTO

## Admissions

State of Connecticut, 2012

Supreme Court of the United States, 2008

U.S. Patent and Trademark Office, 2001

State of New York, 2000

U.S. District Court for the Southern District of New York, 2000

U.S. District Court for the Eastern District of New York, 2000

## Education

Benjamin N. Cardozo School of Law, JD, 2000

NYU-Tandon School of Engineering (formerly Polytechnic Institute), M.S. in Mechanical Engineering, 2006

NYU-Tandon School of Engineering (formerly Polytechnic Institute), Graduate Certificate in Network Telecommunications,

Continued

David Bomzer will speak at PLI's Patent Fundamentals Bootcamp 2021: An Introduction to Patent Drafting, Prosecution, and Litigation via Live Webcast on June 2-4, 2021.

The 99th Annual Dinner in Honor of the Federal Judiciary  
April 22, 2021

The New York Intellectual Property Law Association's 99th Annual Dinner in Honor of the Federal Judiciary is virtual on April 22, 2021.

David Bomzer Speaks on Patents v. Trade Secrets at New York City Bar  
April 21, 2021  
Webinar

David Bomzer spoke about patents versus trade secrets at the New York City Bar webinar, "An Introduction to IP Law for the Small Law Firm Practitioner: When Might Your Client Have an IP Issue and How to Start to Think About It," on April 21, 2021.

2019 ScaleUP CT  
June 6, 2019

Sacred Heart University, Fairfield, Connecticut  
Cantor Colburn is proud to sponsor 2019 ScaleUP CT on June 6, 2019 at Sacred Heart University in Fairfield, Connecticut. Presented by the Connecticut Technology Council, ScaleUP CT is designed to support companies that are beyond the startup phase. ScaleUP CT is an event built to educate and invigorate the leaders of Connecticut's growing tech-oriented companies. Now in its third year, the event will support companies in the tech sector at every stage of their growth and development. Co-managing partner Michael Cantor is on the CTC board of directors and will be a part of the program.

Blockchain IP: Innovation and the Distributed Ledger Revolution  
November 29, 2018  
New York City

Cantor Colburn's David Bomzer is a speaker at the New York City Bar and MIT Enterprise Forum of NYC program "Blockchain IP: Innovation and the Distributed Ledger Revolution," on November 29, 2018, a program for members and non-members alike.

What Non-IP Attorneys and Business Professionals Need to Know About IP Transactions  
November 13, 2018

Charlie O'Brien and David Bomzer will present "What Non-IP Attorneys and Business Professionals Need to Know About IP Transactions," with West LegalEdcenter, a Thomson Reuters Webinar. This session will provide attorneys and business professionals with an overview of the basic categories of intellectual property and describe the various structures of typical IP transitions.

2005

State University of New York at Buffalo, B.S. in Aerospace Engineering, 1994

### Teaching Positions

Quinnipiac University School of Law, Adjunct Professor of Cyber Law

NYU-Tandon School Of Engineering, Adjunct Professor of Mechanical Engineering

NYIT (Westbury), Adjunct Professor of Aerospace Engineering



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Re-Opening of the People's United Center for Innovation & Entrepreneurship

October 24, 2018

Hamden, Connecticut

Quinnipiac University School of Business and People's United Bank are re-opening the People's United Center for Innovation & Entrepreneurship at a reception on October 24, 2018. Cantor Colburn attorneys Todd Garabedian, Ph.D. and David Bomzer are adjunct professors at Quinnipiac School of Law.

A Lawyer's Primer on Blockchain and Smart Contracts CLE

October 12, 2018

New Britain, Connecticut

The Connecticut Bar Association is offering a CLE, "A Lawyer's Primer on Blockchain and Smart Contracts," on October 12, 2018.

Stanley + Techstars Additive Manufacturing Accelerator Demo Day

October 11, 2018

Hartford, Connecticut

Stanley + Techstars Additive Manufacturing Accelerator Demo Day is October 11, 2018 at the Bushnell Theatre in Hartford. It is the culmination of a 12-week program in which ten companies from around the globe relocated to the new Advanced Manufacturing Center of Excellence – Manufactory 4.0 – in Hartford, CT. Cantor Colburn was one of the first law firms in the country to have an Additive Manufacturing Practice Group, led by Dave Christensen.

PACE IEEE Workshop in Intellectual Property

November 11, 2017

Central Connecticut State University, New Britain, Connecticut

David Bomzer will present a professional development workshop on Intellectual Property to the Professional Activities Committees for Engineers (PACE), the grassroots network of Institution of Electrical and Electronics Engineers (IEEE) volunteers and committees, on November 11, 2017, at Central Connecticut State University in New Britain, Connecticut.

Panelist, Supreme Court Update, 13th annual World Congress Patents for Financial Services Summit, New York, July 21, 2016

Panelist, Diverse Careers in IP Law and Strategies for Achieving Success, NYIPLA and Cardozo School of Law Alumni Association, April 19, 2016

Event Chair, Corporate IP Counsel Forum, IP World Congress, New York, Mar. 23, 2006

Panelist, Annual IP Trademark, Copyright & Licensing Counsel Forum, ALM, New York, November 3, 2015

Panelist, Careers in IP Law, NYIPLA, Quinnipiac Law School, April 16, 2015

Event organizer/Panel Moderator, One-Day Patent CLE Seminar, NYIPLA, New York, Nov. 20, 2014

Event Co-Chair/Panel Moderator, Annual IP Trademark, Copyright & Licensing Counsel Forum, ALM, New York, Oct. 28, 2014

Moderator/Co-Chair, "Key Leadership Issues in Sports and Media Law: Maximizing Profits and Protecting the Brand," the New York County Lawyers Association, April 29, 2014



## Continued

Speaker, "Ethics in Social Media 2014," the Practising Law Institute, New York, NY, Mar. 17, 2014

Moderator, "NYIPLA 2014 One-Day CLE Program", the New York Property Lawyers' Association, The University Club, New York, NY, Jan. 16, 2014

Speaker, "Intellectual Property Basics-With Case Law Updates: Copyright Basics For The Corporate Attorney," McCarter & English and the New York County Lawyers Association, Dec. 18, 2013

Speaker, "Intellectual Property in an International Landscape: What's Your Risk?", Corporate Counsel's 6th Annual IP Trademark, Copyright & Licensing Counsel Forum, The University Club, New York, NY, Oct. 22, 2013

Speaker, "Understanding Patents, Copyrights & Trademarks: Practicing & Dispute Basics with Case Law Updates", Day Pitney and the New York County Lawyers' Association, April 10, 2013

Speaker, "Patent Law For Non-Patent Lawyers: Understanding A Patent", the New York City Bar Association, Mar. 19, 2013

Speaker, "Protecting Your Products and Discoveries Perspectives from both In-House and Outside Patent Counsel," McCarter & English and the New York County Lawyers Association, Dec. 11, 2012

Speaker, "Patent Law and the America Invents Act," Day Pitney and the New York County Lawyers' Association, Feb. 22, 2012

Speaker, "Patent Law Upheaval? The New America Invents Act & Its Impact On Patent Rights", the Nassau County Bar Association, Jan. 30, 2012

Speaker, "The Patent Reform Act," the New York City Bar Association, Jan. 26, 2012

Moderator, "The Supreme Court's Increased Interest In Patent Law," New York Intellectual Property Lawyers Association, Nov. 3, 2011

Speaker, "A Review of Supreme Court Patent Law Decisions from 2011 & Their Impact on Your Practice," the New York City Bar Association, Oct. 12, 2011

Moderator, "Roundtable: Updates on Damages and the Use of Experts," New York City Bar Association, June 7, 2011

Speaker, "Exploring Obviousness," Long Island Systems, Applications and Technology Conference, Farmingdale State College of the State University of New York, May 6, 2011

Speaker, "Patent Basics for Inventors, Engineers, Scientists, Entrepreneurs, and Students," New York City Bar Association, April 7, 2011

Speaker, "What Is Patent Eligible Following the 2010 Supreme Court's Bilski Decision?" IEEE Consultants Network of Long Island, Feb. 9, 2011

Speaker, "Patent Protection Update: Software and Financial Method Patents," New York Technology Council, Inc, Jan. 18, 2011

Chair and Moderator, "Supreme Court Update," New York City Bar Association, Jan. 11, 2011

Speaker, "Navigating The Supreme Court's Bilski v Kappos Decision, Subsequent Federal Circuit and District Court Decisions, Including Prometheus Labs," Day Pitney and the New York County Lawyers' Association, Dec. 22, 2010

Continued

Speaker, "Getting The Most Out Of Your Patent Licensing, The Impact of *Bilski v Kappos*," New York City Bar Association, Dec. 6, 2010

Organizer, "NYIPLA 2010 Fall One-Day CLE Program," New York Intellectual Property Lawyers' Association, Nov. 4, 2010

Speaker, "Understanding the 2010 Examination Guidelines Update: Developments in the Obviousness Inquiry After *KSR v. Teleflex*," Day Pitney and the New York County Lawyers Association, Oct. 7, 2010

Speaker, "Patent Marking, How to Navigate This Changing Area Of Law," Day Pitney and the New York County Lawyers Association, Mar. 25, 2010

Organizer and Panel Moderator, "NYIPLA 2009 Fall One-Day CLE Program", Nov. 5, 2009

Organizer and Panel Moderator, "Current Issues in Patent Practice," New York City Bar Association, Oct. 8, 2009

Speaker, "Federal Circuit Update: *Prometheus Labs v Mayo Collaborative Services*," Day Pitney and the New York County Lawyers Association, Oct. 1, 2009

Speaker, "How to Protect Your Intellectual Property without Breaking Your Budget," Day Pitney Webinar, May 5, 2009

Speaker, "Following *Bilski*, *Comiskey* & Recent Board Decisions, How To Navigate the Changing Area of Law for Business Method Patents," Day Pitney and the New York County Lawyers Association, Feb. 24, 2009

Moderator, "Navigating Effective Intellectual Property Enforcement on the Web," Day Pitney, Dec. 11, 2008

Panelist, "Roundtable on *In Re Bilski*," New York City Bar Association, Dec. 2, 2008

Moderator, "NYIPLA 2008 Fall One-Day CLE Program", The University Club and the New York Property Lawyers' Association, Nov. 7, 2008

Panelist, "Design Patent Infringement - *Egyptian Goddess v. Swisa*," Benjamin N. Cardozo School of Law, Apr. 14, 2008

## Professional Affiliations

Connecticut Bar Association, Intellectual Property Section Executive Committee, 2021-2022

New York Intellectual Property Law Association (NYIPLA), Programs Planning Committee Chair 2021-2022, Transaction and Patent Practice Committees

New York City Bar Association (NYCBA), Patent and Trade Secret Committees 2020-present

Connecticut Intellectual Property Lawyers Association (CIPLA)

Institute of Electrical and Electronics Engineers (IEEE), Section Vice President

Intellectual Property Owners Association (IPO)

International House of New York, Steering Committee



Continued

**Community/Civic Involvement**

National Ski Patrol (N.S.P.), Patroller





**Andrew Chien**

*Lead Counsel IP*

Siemens Healthineers

Andrew Chien is currently the Lead Counsel for Intellectual Property for Point of Care Diagnostics at Siemens Healthineers, where he regularly counsels the business on matters of IP transactions, portfolio management and enforcements. Prior to joining Siemens Healthineers, Andrew was Senior Counsel of Intellectual Property at Allergan, where he focused on collaborations, licensing and M&A related to Intellectual Property. Andrew is also an active member of the New York Intellectual Property Law Association (NYIPLA), and is a former co-chair of the IP Transactions Committee.



## **ANGELA COLLISON**

Intellectual Property Manager & Patent Counsel

Canon USA, Inc.

**Angela Collison** is an Intellectual Property Manager and Patent Counsel at Canon U.S.A., Inc. She currently manages the intellectual property portfolio for Canon's Healthcare Optics Research Laboratory which works in collaboration with Massachusetts General Hospital and Brigham and Women's Hospital. Ms. Collison is also managing the development of an intellectual property program at Canon Virginia, Inc.

Her practice is focused on portfolio development, patent and trademark prosecution before the United States Patent and Trademark Office, patent licensing, agreement drafting and negotiation, landscape and freedom to operate searches, due diligence, and supporting product development activities.

Prior to starting at Canon, Ms. Collison was an attorney at an intellectual property law firm in Manhattan. She has experience in a wide variety of practice areas including biotechnology, molecular diagnostics, infectious disease diagnostics, molecular biology, vaccines, animal health, food science, pharmaceuticals, medical imaging, robotics, medical devices, and consumer electronics. Ms. Collison is the co-author of papers relating to the patentability of antibodies and antivirals.

Ms. Collison received a B.S. in Biophysics with a minor in Chemistry from the State University of New York at Geneseo, and an M.S. in Biomedical Engineering from the State University of New York at Stony Brook. Ms. Collison received her J.D. from Fordham University School of Law where she was a member of the Law Review.

Ms. Collison is a member of the State Bars of New York and Connecticut, and is authorized to practice before the United States Patent and Trademark Office.

# HAUG PARTNERS

**WAN CHIEH (JENNY) LEE**



[JLee@haugpartners.com](mailto:JLee@haugpartners.com)

(212) 863-2063

Wan Chieh (Jenny) Lee is a partner in the New York office of Haug Partners. Her practice focuses on strategic counseling, procurement of worldwide patent rights, due diligence, freedom to operate, and intellectual property transactions.

Ms. Lee combines extensive experience across all aspects of patent law with a strong ability to analyze complex technical information to provide clients with business-oriented patent strategies and insights. She routinely advises clients in the pharmaceutical, biotechnology and medical device industries regarding patentability, validity, freedom-to-operate, and regulatory exclusivity. Drawing from her extensive experience across all aspects of patent practice, Ms. Lee develops and executes patent procurement strategies that are aligned with clients' immediate and long-term business goals, including product life cycle management under the Hatch-Waxman Act and the Biologics Price Competition and Innovation Act. She leverages her strong ability to digest complex technical information with her experience in both patent procurement and litigation to provide clients with valuable transactional insights and a unique approach to negotiating intellectual property terms in agreements.

**HEIDI LUNASIN**  
Special Counsel

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Washington, DC 20004-2166  
USA

**Heidi E. Lunasin** practices in the area of intellectual property law, representing clients in all areas of patent and trademark law. Ms. Lunasin crafts patent strategies in technology fields ranging from biotech and engineering to composition, electrical, mechanical and design. In addition, she counsels clients in the development, maintenance and protection of intellectual property in the United States, as well as throughout the world.

Ms. Lunasin assists clients in establishing competitive patent review and enforcement programs. She has assisted in developing appropriate strategies to defend patents asserted in litigation before the Patent Trial and Appeal Board (PTAB). Further, Ms. Lunasin has experience working on clearance of products, due diligence reviews, performing comprehensive and in-depth patent searches, preparing non-infringement and invalidity opinions, and drafting and evaluating intellectual property contracts.

Prior to working for Duane Morris, Heidi served as Senior Patent Counsel for adidas AG and IP Counsel at Treofan in Germany and gained valuable insight into the concerns of in-house patent counsel, especially those operating on a world-wide scale. Throughout Ms. Lunasin's

life, she has been fortunate to work in several industries gaining an understanding of the issues affecting them. Before studying law, she worked for the US Army Corps of Engineers, Cyro Industries, Dell Computer, and the Third Military Academy of Korea.

Ms. Lunasin is registered to practice before the United States Patent and Trademark Office and admitted to practice in New York, New Jersey, and the District of Columbia. She is a 2008 graduate of Seton Hall University School of Law. She earned an M.S. in Public Health from the University of North Carolina and a B.S. in Chemical Engineering from Rutgers University.

### **Areas of Practice**

- Intellectual Property
- Patents
- Trademark Law
- Biotechnology

### **Admissions**

- New York
- New Jersey
- District of Columbia
- U.S. Patent and Trademark Office
- U.S. Court of Appeals for the Federal Circuit
- U.S. District Court for the Southern District of New York
- Supreme Court of the United States

### **Education**

- Seton Hall University School of Law, J.D., 2008
- University of North Carolina, M.S., Public Health, 1999
- Rutgers University, B.S., Chemical Engineering, 1994

### **Selected Speaking Engagements**

- Clinician, "Patent Amendment Writing," Practising Law Institute's Patent Fundamentals Bootcamp 2021, June 2-4, 2021



- Presenter, "Tensions Between Nonobviousness and Written Description in U.S. Patent Law," Duane Morris LLP, Webinar, October 27, 2020
- Clinician, "Patent Fundamentals Bootcamp 2020: An Introduction to Patent Drafting, Prosecution, and Litigation," Practising Law Institute Webinar, June 2-4, 2020
- Speaker, "Patent Fundamentals Bootcamp 2019: An Introduction to Patent Drafting, Prosecution, and Litigation," Practising Law Institute, June 13, 2019

### Selected Publications

- Co-author, "Sharing the Blame: Parent Company Can Still Be on the Hook for Subsidiary's Alleged Infringement," *Duane Morris Alert*, May 25, 2021
- Co-author, "Considerations and Implications of the Proposed Temporary Waiver of COVID-19 Vaccine-Related Intellectual Property Rights," *Duane Morris Alert*, May 6, 2021
- Co-author, "Who Watches the Watchmen? Supreme Court to Decide Fate of Administrative Patent Judge Appointments," *Duane Morris Alert*, March 8, 2021
- Co-author, "Forum Selection Clause Held Inapplicable for Precluding Inter Partes Review Before the Patent and Trial Appeal Board," *Duane Morris Alert*, February 8, 2021
- Co-author, "Through the Ages and Across Art Units: How Interpretations of 35 U.S.C. § 101 Are Changing American Innovation", Patent Fundamentals Bootcamp 2020 Course Handbook, Practising Law Institute, 2020
- Co-author, "US Privilege While Operating on the World Stage," Advanced Patent Prosecution Workshop Course Handbook, Practising Law Institute, 2019
- Co-author, "Getting an Audience with the USPTO", Patent Fundamentals Bootcamp 2018 Course Handbook, Practising Law Institute, 2018

**THOMAS J. KOWALSKI****Partner****Phone: +1 212 692 1025****[TJKowalski@duanemorris.com](mailto:TJKowalski@duanemorris.com)****Duane Morris LLP****1540 Broadway****New York, NY 10036-4086****USA**

**Thomas J. (Tom) Kowalski** is a seasoned registered U.S. patent attorney and a partner in the firm's New York (Broadway) office. He is Chair of the Life Sciences, Pharmaceuticals, and Biotechnology Division of the firm's Intellectual Property Practice Group and is a member of the firm's Life Sciences group. His practice includes biotechnology, chemical and medical apparatus litigation/contentious matters, patent prosecution, licensing, investor due diligence, and counseling, and litigation, with extensive experience in matters of personal and personalized medicine, genetics and genetic engineering (e.g., CRISPR, TALEN/TALENS, zinc fingers, siRNA, and RNAi), plant varieties and genetically modified plants, biological inventions arising from big data/data mining/AI (including from data from massively parallel sequencing, transcriptome analyses, single cell genomics, cell signatures and the various "Seq" tools, e.g., "DropSeq," "RNASeq" and "PerturbSeq"), virology, immunology, antibodies, vaccinology, T-cell receptors, cell-based therapies such as tumor infiltrating lymphocytes, biologics, pharmaceuticals, medicinal chemistry, crystallography and small molecules, amongst other fields of biotechnology and chemistry. Mr. Kowalski also represents his clients in procuring and enforcing trademarks and design patent rights. He obtains trademark and design patent protection domestically and worldwide, and he enforces trademark rights and defends clients accused of trademark infringement in the United

States. He also actively works with clients on strategies to avoid litigation, clear out the IP underbrush that impedes passage through IP thickets, and maximize patent portfolios and investor funding.

Mr. Kowalski received an American Chemistry Society Certified B.S. in Chemistry from New York University and a J.D., with honors, from St. John's University School of Law.

In fulfilling the requirements for American Chemistry Society certification, Mr. Kowalski extensively studied graduate biochemistry, graduate inorganic chemistry, genetics, and computer science; and conducted laboratory research (a joint project amongst NYU (in the laboratory of Yorke E. Rhodes, Ph.D.), Columbia University and The NASA Goddard Institute for Space Studies (under Carl A. Gottlieb, Ph.D.)).

Also while studying at NYU, he was awarded a National Science Foundation Undergraduate Research Participant (NSF-URP) Grant and performed laboratory research at Hunter College, City University of New York (in the laboratory of Joseph J. Dannenberg, Ph.D.). Results of this research were published in the *Journal of Organic Chemistry* (J. J. Dannenberg, J. K. Barton, B. Bunch, B. J. Goldberg and T. Kowalski, "Trifluoroacetolysis of optically active 2-butyl tosylate," *J. Org. Chem.* 1983, 48, 24, 4524-4527, <https://doi.org/10.1021/jo00172a016>).

Mr. Kowalski holds a number of professional appointments and affiliations including as a faculty member of the Practising Law Institute, a member of the editorial boards of *Pharmaceutical Patent Analyst* and *Journal of Commercial Biotechnology*, and an editorial advisor for Intellectual Property for *Nature Biotechnology*.

Mr. Kowalski has extensive international experience and has appeared before courts and in proceedings throughout the world, including London, England; The Hague, Netherlands; Dusseldorf, Mannheim and Munich, Germany; Vienna, Austria; Tokyo, Japan; Rio de Janeiro, Brazil; and Melbourne and Canberra, Australia.

### Areas of Practice

- Intellectual Property Law
- Inter Partes Proceedings
- Appellate IP Advocacy

### Representative Matters

- Represented Pentraxin Therapeutics Limited, with respect to the inventions of Sir Mark Pepys including those out-licensed to GlaxoSmithKline (GSK), *see, e.g.*, US Patents 9,192,668 and 7,910,106, entitled "Combinations of SAP depleting agents and anti-SAP antibodies"; US Patent 8,236,984, entitled "Compound and use thereof in the treatment of amyloidosis"; US Patents 8,173,694 and 7,691,897 entitled "Therapeutic agent"; US Patents 8,039,222, 7,615,543, and 7,390,795 entitled "Treatment and prevention of tissue damage"; and US Patent 7,659,299 entitled "Compounds inhibiting the binding of sap for treating osteoarthritis".
- Represented The University of Edinburgh and the Wellcome Trust with respect to the inventions of Brian Robert Walker, Christopher Richard Watkin Edwards, and Jonathan Robert Seckl, *see, e.g.*, US Patent 7,790,706 entitled "Treatment of inflammation with 5 $\alpha$  reduced metabolites" and US Patents 7,129,231, 7,122,532, 7,122,531, 7,087,400, 6,946,487, 6,838,253, and 6,368,816 entitled "Regulation of intracellular glucocorticoid concentrations".
- Prosecuted patents in the field of plant genetics and biology (including traditional breeding) for Rijk Zwaan.
- Represented a biomedical and genomic research center in preparing and prosecuting patent applications and strategic counseling in obtaining allowance and grant and as to third party portfolios and contentious matters.
- Represented Merial, Inc. in a contentious matter: the offense of a patent opposition / nullity brought by Merial Inc. against Intervet International B.V. to clear away an invalid patent.
- Represented a leader in T-cell therapy in patent prosecution, licensing counseling, and strategy including as to clearing away third party invalid patent through ex parte means that avoided contentious matters.

## Admissions

- New York
- U.S. Patent and Trademark Office
- U.S. District Court for the Southern District of New York
- U.S. District Court for the Eastern District of New York
- U.S. District Court for the Western District of New York
- U.S. Court of Appeals for the Federal Circuit

- Supreme Court of the United States

## Education

- St. John's University School of Law, J.D., *cum laude*, 1986
- New York University, B.S., Chemistry, 1982

## Experience

- Duane Morris LLP
  - Partner, 2018-present
- Vedder Price PC
  - Partner, 2010-2018
- Frommer Lawrence & Haug LLP
  - Partner, 1997-2010
- Curtis, Morris & Safford PC
  - Partner, 1991-1997
- Wyatt Gerber Burke & Badie
  - Associate, 1989-1991
- Brooks Haidt Haffner & Delahunty
  - Associate, 1986-1989

## Professional Activities

- American Intellectual Property Law Association (AIPLA)
- Association of University Technology Managers (AUTM)
- Nassau County, New York Bar Association
  - Intellectual Property Committee
- New York State Bar Association
- American Bar Association
  - Chair, Intellectual Property Law Pro Bono Committee
- New York Intellectual Property Law Association (NYIPLA)
  - *Amicus* Brief Committee, 2012-2018
- The International Association for the Protection of Intellectual Property (AIPPI)
- Protein Sciences Corporation Advisory Board
- New Jersey Intellectual Property Law Association (NJIPLA)
- *Journal of Commercial Biotechnology*
  - Editorial Board

- *Pharmaceutical Patent Analyst*  
- Editorial Board
- *Intellectual Property for Nature Biotechnology*  
- Editorial Advisor
- Practising Law Institute Faculty (Including Co-Chair: PLI Fundamentals of Patent Prosecution 2018, 2019: A Boot Camp for Claim Drafting & Amendment Writing Practising Law Institute, New York, New York)
- Future Medicinal Chemistry Peer Reviewer

### Honors and Awards

- Listed in World *Intellectual Property Review* (WIPR) Leaders Directory, 2022
- Named as a Thomson Reuters Stand-out Lawyer, 2022
- *New York Law Journal* 2019 (inaugural list) New York Trailblazer
- Listed in *LMG Life Sciences Intellectual Property Stars*, 2018-2021
- Listed in New York Super Lawyers, 2006-2009, 2014-2019
- Listed in *Who's Who Legal*, 2010-2011 and 2011-2012
- AV Preeminent® Peer Review Rated by Martindale-Hubbell®

### Selected Publications

- Co-author, "Broad Patent Prosecution Bars Risk Effectively Decoupling Complementary Patent Litigation and Prosecution Practices," *Duane Morris Alert*, August 22, 2022
- Co-author, "The Other Side of the Coin: Diligent Patent Prosecution Does Not Lead to Unreasonable Delay and Application of Prosecution Laches," *Duane Morris Alert*, July 22, 2022
- Co-author, "Silence Is Not Necessarily Golden for Negative Patent Claim Limitations," *Duane Morris Alert*, July 7, 2022
- Co-author, "Russian Sanctions Could Impact IP Holdings in Russia and Eurasia," *Duane Morris Alert*, March 25, 2022
- Quoted, "How Counsel Can Seal CRISPR Collaboration Deals," *Managing IP*, February 18, 2022
- Co-author, "Paying for Your Delay: Application of Prosecution Laches Can Render Issued Patents Unenforceable," *Duane Morris Alert*, August 17, 2021; republished in

*Intellectual Property & Technology Law Journal*, November-December 2021

- Co-author, "Sharing the Blame: Parent Company Can Still Be on the Hook for Subsidiary's Alleged Infringement," *Duane Morris Alert*, May 25, 2021
- Quoted, "Inside the Biden Administration's Support for a Vaccine Patent Waiver," *MM+M*, May 10, 2021
- Quoted, "U.S. Move to Loosen Vaccine Patents Will Draw Drug Companies to Bargain," *Reuters*, May 7, 2021
- Co-author, "Texas Court Will Not Delay In-Person Trial to Permit Vaccination of Participants," *Duane Morris Alert*, March 22, 2021
- Co-author, "Who Watches the Watchmen? Supreme Court to Decide Fate of Administrative Patent Judge Appointments," *Duane Morris Alert*, March 8, 2021
- Co-author, "Forum Selection Clause Held Inapplicable for Precluding Inter Partes Review Before the Patent and Trial Appeal Board," *Duane Morris Alert*, February 8, 2021
- Co-author, "Patent-Eligible Subject Matter in Biotech Should Recite More Than a 'Telescope'," *Duane Morris Alert*, December 8, 2020; reprinted in *Intellectual Property & Technology Law Journal*, March 2021
- Co-author, "Playing Your Cards Right: Arguments Against Obviousness Can Be Detrimental for Satisfying the Written Description Requirement," *Intellectual Property & Technology Law Journal*, October 2020
- Co-author, "Playing Your Cards Right: Arguments Against Obviousness Can Be Detrimental for Satisfying the Written Description Requirement," *Duane Morris Alert*, July 2, 2020
- Co-author, "The Capricious and Ever-Changing Nature of IP Practice Under COVID-19: Deadline Extensions, Sometimes with a Catch, and Ungracious Grace Periods," *Duane Morris Alert*, May 4, 2020
- Co-author, "Numerical Ranges: More Than Just Endpoints in Patent Process," *Duane Morris Alert*, February 14, 2020
- Co-Author, "Revised Eligibility Guidelines for Patentable Subject Matter," *National Law Review*, December 18, 2014
- Co-Author, "Uncertain Times for Biotech and Pharma Patents," *National Law Review*, October 23, 2014
- Co-Author, "Federal Circuit Shears Hopes for Patent on "Dolly" the Sheep: Holding Clones Are Natural Products and Not Patent Eligible Subject Matter," *National Law Review*, May 9, 2014

- Co-Author, "Guidelines for Patentable Subject Matter Eligibility," *National Law Review*, March 9, 2014
- Co-Author, "How to Manage Collaborative Inventions," *INSIDE*, the newsletter of the Corporate Counsel Section of the New York State Bar Association (NYSBA), 2013
- "Preparing for Full Implementation of the America Invents Act," *Vedder Price Newsletter/Bulletin*, 2013
- "US Patent Law and the Attorney-Client Privilege," *The Pharmaceutical Patent Analyst*, 2013
- "*Bowman v. Monsanto*: The Supreme Court Got It Right on the Law and the Science But Is the Unanimous Decision Belied by the Ultimate Paragraph?," *NYIPLA Bulletin*, April/May 2013
- "Supreme Court Sides with Monsanto on Issue of Patent Protection for Genetically Modified Seeds; Ruling Is a Major Victory for the Biotechnology Industry," *Vedder Price Newsletter/Bulletin*, 2013

### Selected Speaking Engagements

- Speaker, "Patent Agreements," New York Intellectual Property Law IP Transactions Bootcamp, October 6, 2022
- Speaker, "Opening Remarks," PLI Patent Fundamentals Bootcamp 2022: An Introduction to Patent Drafting, Prosecution, and Litigation, September 14, 2022
- Clinician, "Clinic II: Patent Amendment Writing, PLI Patent Fundamentals Bootcamp 2022: An Introduction to Patent Drafting, Prosecution, and Litigation," September 14, 2022
- Speaker, "Protecting CAR-T and other Immunotherapies: In-House Challenges," LSPN North America Spring Conference, May 12, 2022
- Speaker, "Standing Out in a Crowded CRISPR World: How to Strengthen Your Patents Utilizing CRISPR Technology," 20th Advanced Summit on Life Sciences Patents Conference, June 3, 2022
- Speaker, "Dean's Hour: Plant Inventions in Everyday Life," Nassau County Bar Association CLE, November 4, 2021
- Speaker, "Biologics: Where Are We Now?" IP Life Sciences Conference, October 12, 2021



- Speaker, "Odds and Sods – The Importance of Plant Inventions to Everyday Life," Intellectual Property Law Committee, Nassau County Bar Association, September 23, 2021
- Speaker, "19th Advanced Summit on Life Sciences Patents," American Conference Institute, Webinar, July 21-22, 2021
- Presenter, "Conducting the Examiner Interview" and "Patent Amendment Writing," Practising Law Institute's Patent Fundamentals Bootcamp 2021, June 3, 2021
- Presenter, "Tensions Between Nonobviousness and Written Description in U.S. Patent Law," Duane Morris LLP, Webinar, October 27, 2020
- Speaker, "18th Advanced Summit on Life Science Patents," American Conference Institute, New York, August 4-6, 2020
- Speaker, "US Patent-Eligible Subject Matter – Latest Thinking," Chartered Institute of Patent Attorneys (CIPA), Webinar, July 2, 2020
- Speaker, "Entering the U.S. Market for European Pharma: Essential IP and Regulatory Considerations," Duane Morris Webinar, June 23, 2020
- Co-Chair, "Patent Fundamentals Bootcamp 2020: An Introduction to Patent Drafting, Prosecution, and Litigation," Practising Law Institute Webinar, June 2-4, 2020
- Speaker, "CRISPR: What Is It and Why Should I Care?," Duane Morris and LES Chicago Webinar, May 14, 2020
- Moderator, "Building, Managing and Maintaining a Strong IP Department," MIP European Patent USA Forum 2019, New York, New York, December 2019
- Invited Speaker, "Antibody Patent Review: Global Perspectives on Enhancing Biologic Assets Protections," ACI's Third Annual Advanced Summit on Life Sciences Patents, New York, New York, May 17, 2019
- Co-Chair, "PLI Fundamentals of Patent Prosecution 2019: A Boot Camp for Claim Drafting & Amendment Writing," Practising Law Institute, New York, New York, June 2019
- Moderator, "Don't Get Too Close to the Edge: What Life Science Companies Need to Know About Managing Standards Setting and Open Source Risks," AIPLA Midwinter Institute, Tampa, Florida, February 1, 2019
- Co-Chair, "PLI Fundamentals of Patent Prosecution 2018: A Boot Camp for Claim Drafting & Amendment Writing," Practising Law Institute, New York, New York, June 2018
- Organizer, "Procedures Before the European Patent Office (EPO): Changes and Challenges for U.S. Applicants," Webinar, September 2018

- Invited Speaker, "Legal Certainty at an Affordable Price – the European Opposition Procedure," BIO, Boston, Massachusetts, June 2018
- Invited Speaker, "East of England Meeting," Chartered Institute of Patent Attorneys (UK), US Updates, Cambridge, UK, March 2018
- Invited Speaker, "European Patent Office: Subject Matter Eligibility Under 35 U.S.C. § 101," Munich, The Hague, February 2017
- Invited Speaker, "Walking the Line: Ethical Issues in Patent Law & Social Media," AIPLA Webinar, December 2016
- Invited Speaker, "PLI Fundamentals of Patent Prosecution 2016: A Boot Camp for Claim Drafting & Amendment Writing," Practising Law Institute, New York, June 15-17, 2016
- Invited Speaker, "The 101 Issue: Patent Eligibility in the United States - Should Europe Fear the US System?" C5's 8th Conference on Pharma & Biotech Patent Litigation, Amsterdam, March 15, 2016
- Invited Speaker, Vedder Price IP Symposium Webinar with European Patent Office Representatives, New York, October 2015
- Invited Speaker, Broad Symposium at the Japan Patent Office, Tokyo, November 2015
- Invited Speaker, Broad Symposium for Harvard & MIT alumni in Japan, Tokyo, November 2015
- Invited Speaker, Broad Symposium at the Chinese Patent Office, Beijing, November 2015
- Invited Speaker, Broad Symposium at Tsinghua University, Beijing, November 2015
- Invited Speaker, Broad Symposium for Harvard & MIT alumni, Singapore, November 2015
- Invited Speaker, PLI Fundamentals of Patent Prosecution 2015: A Boot Camp for Claim Drafting & Amendment Writing, Practising Law Institute, New York, June 2015
- Invited Speaker, Broad Symposium, Cambridge, Massachusetts, April 27-29, 2016
- Invited Speaker, PLI Fundamentals of Patent Prosecution 2014: A Boot Camp for Claim Drafting & Amendment Writing, Practising Law Institute, New York, June 2014
- Speaker, "Biologics: Where Are We Now?" IP Life Sciences Conference, New York City, October 12, 2013

Matt Prater  
Senior Counsel, Intellectual Property  
SABIC

Matt is senior counsel, IP for SABIC - a Saudi company that manufactures chemicals, polymers, fertilizers and metals. SABIC ranks as the fourth-largest chemical producer on the Fortune Global 500 and is 70% owned by Saudi Aramco. Matt is based in Houston, Texas at SABIC's regional headquarters.

Matt is a specialist in application technology and supports several teams, including SABIC's [Solutions for Automotive](#) team, which offers industry-leading expertise in designing customer solutions made from engineered materials such as thermoplastics. His work is focused on drafting and negotiating contracts and patents, but extends to other realms as required. Trained as a mechanical engineer at Michigan Technological University and as a lawyer at Mitchell Hamline School of Law, Matt has been in the legal practice for 19 years, beginning his legal career at Schwegman, Lundberg and Woessner, where he had the privilege of representing clients like Ferrari and Tesla, and where he drafted the notorious MyPillow® patent. Matt currently serves on the board of the Houston Intellectual Property Association. Matt is admitted to practice in Minnesota, Texas, and before the US Patent and Trademark Office.

