

Author Biographies

Rouget Frederic (Ric) Henschel

Chapter 1: The State of the Law of Claim Construction and Infringement

Rouget Frederic (Ric) Henschel is a partner at Potomac Law Group, PLLC. He is registered to practice before the U.S. Patent and Trademark Office and is a member of the Virginia and District of Columbia bars. He earned a Ph.D. in organic chemistry from City University of New York and his law degree from Georgetown University Law Center. He has served as contributing editor of the Federal Circuit Bar Journal. He is a former law clerk for Judge Randall R. Rader (ret.) of the U.S. Court of Appeals for the Federal Circuit.

Bradley C. Wright

Chapter 2: Pitfalls in Patent Drafting

Bradley C. Wright is a principal shareholder with the law firm of Banner & Witcoff, Ltd. in Washington, D.C. His practice includes patent prosecution, litigation, and counseling as well as appellate matters. He earned his electrical engineering degree from M.I.T. and his law degree, with distinction, from the George Mason University School of Law. He is a former law clerk to the Hon. William C. Bryson, Circuit Judge of the U.S. Court of Appeals for the Federal Circuit. He is registered to practice before the U.S. Patent and Trademark Office and is a member of the Virginia and District of Columbia bars. He is admitted to the bars of the U.S. Supreme Court, the U.S. Court of Appeals for the Federal Circuit, and several district courts. Mr. Wright was also an adjunct professor of law at the George Mason University School of Law, where he taught patent law and copyright law.

H. Wayne Porter and Bradley C. Wright

Chapter 3: Drafting the Winning Patent

H. Wayne Porter is a principal shareholder with the law firm of Banner & Witcoff, Ltd. in Washington, D.C. His practice includes patent prosecution, counseling, and related opinion work. He earned his mechanical

engineering degree from the Georgia Institute of Technology and his law degree, with high honors, from the University of Florida. He is registered to practice before the U.S. Patent and Trademark Office and is a member of the District of Columbia and Florida bars.

Bradley C. Wright is a principal shareholder with the law firm of Banner & Witcoff, Ltd. in Washington, D.C. His practice includes patent prosecution, litigation, and counseling as well as appellate matters. He earned his electrical engineering degree from M.I.T. and his law degree, with distinction, from the George Mason University School of Law. He is a former law clerk to the Hon. William C. Bryson, Circuit Judge of the U.S. Court of Appeals for the Federal Circuit. He is registered to practice before the U.S. Patent and Trademark Office and is a member of the Virginia and District of Columbia bars. He is admitted to the bars of the U.S. Supreme Court, the U.S. Court of Appeals for the Federal Circuit, and several district courts. Mr. Wright was also an adjunct professor of law at the George Mason University School of Law, where he taught patent law and copyright law.

Andrew R. Sommer

Chapter 4: Continued Prosecution of the Patent

Andrew R. Sommer is a partner with the law firm of Winston & Strawn LLP in Washington, D.C., where he is the leader of the firm's Patent Trial and Appeal Board (PTAB) Trial Practice. He focuses on patent litigation in federal court, the International Trade Commission, and the PTAB. He also counsels clients on issues regarding the management and monetization of patent rights. In 2014, the National Law Journal recognized him as one of Washington D.C.'s *Top 40 Age 40 and Under*, citing his "vigorous intellectual property practice." He has also been recognized in the IAM Patent 1000 since 2016 and IAM Strategy 300 in 2017 and 2018. Drew earned his B.S. in optics from the University of Rochester and his law degree, *magna cum laude*, from George Mason University School of Law. While in law school, he was a patent examiner at the USPTO. He left private practice to clerk for the Hon. Kimberly A. Moore, United States Court of Appeals for the Federal Circuit from 2006 to 2007. He is registered to practice before the USPTO, and is a member of the bars of the Commonwealth of Virginia and the District of Columbia.

John A. Marlott

Chapter 5: Mechanical Patents

John A. Marlott is a partner in the Intellectual Property Practice at Jones Day in Chicago, Illinois. Mr. Marlott acts as lead trial counsel in patent litigation matters in federal district courts throughout the country, and he also practices before the U.S. International Trade Commission, and the U.S. Court of Appeals for the Federal Circuit. He has extensive experience in the prosecution of domestic and foreign patent applications, as

well as in post-grant proceedings before the Patent Trial & Appeal Board in the U.S. Patent & Trademark Office (including *inter partes* reviews, covered business method reviews, and legacy *ex parte* and *inter partes* reexaminations). Before joining Jones Day in 1995, Mr. Marlott spent three years as a Patent Examiner at the U.S. Patent and Trademark Office, where he examined applications relating to a wide variety of mechanical and electro-mechanical technologies. Mr. Marlott received his J.D., with high honors, from the George Washington University, and his B.S. in General Engineering from the University of Illinois. He is a member of the Illinois and District of Columbia bars, as well as the trial bar for the U.S. District Court for the Northern District of Illinois, and is registered to practice before the U.S. Patent & Trademark Office.

Michael J. Shea

Chapter 6: Electrical Patents

Michael J. Shea is a shareholder with the law firm of Nixon & Vanderhye PC in Arlington, Virginia. His practice includes patent prosecution, litigation, and counseling. He earned his physics degree (magna cum laude) from Manhattan College and his law degree from Georgetown University Law Center. He is registered to practice before the U.S. Patent and Trademark Office and is a member of the Virginia, District of Columbia, and New York bars. Mr. Shea was also an adjunct professor of law at the Georgetown University Law Center, where he taught intellectual property law.

Michael A. Sartori, Ph.D.

Chapter 7: Software, E-Commerce, Internet, and Business Method Patents

Michael A. Sartori, Ph.D., is a partner at Venable LLP in Washington, D.C., and Chair of Venable's Patent Prosecution and Counseling Group. His practice includes patent prosecution, counseling, opinion work, and litigation. Dr. Sartori received his Bachelor of Science, Master of Science, and Doctorate in Electrical Engineering from the University of Notre Dame and graduated, cum laude, from the Georgetown University Law Center. Dr. Sartori has received several patents for inventions resulting from his research. He was also a Patent Examiner with the U.S. Patent and Trademark Office. He is registered to practice before the U.S. Patent and Trademark Office and is a member of the Virginia and District of Columbia bars.

Rose M. Thiessen, Ph.D. and C. Dylan Turner, Ph.D.

Chapter 8: Chemical and Pharmaceutical Patents

Rose M. Thiessen, Ph.D., is a partner in the San Diego office of Knobbe Martens Olson & Bear, LLP. She has a Ph.D. in Chemistry from Purdue University and a J.D. from Rutgers University. Dr. Thiessen special-

izes in U.S. and international patent portfolio management, patent prosecution, and licensing for chemical, pharmaceutical, and medical device technologies.

C. Dylan Turner, Ph.D., is an associate in the Palo Alto office of Sheppard, Mullin, Richter & Hampton LLP. He has a Ph.D. from the University of British Columbia and a J.D. from Northwestern University School of Law. Dr. Turner practices intellectual property law, including patent procurement, litigation, and licensing, and specializes in the chemical and pharmaceutical arts.

Milan M. Vinnola and Lisa M. Hemmendinger

Chapter 9: Biotechnology Patents

Milan M. Vinnola is of counsel in the Denver office of Polsinelli PC. Her practice focuses on intellectual property counseling, patent procurement, and licensing, as well as involvement in opinion, litigation, interference, and opposition practice primarily in the chemical, pharmaceutical, and biotechnology areas. She earned her B.S. in Chemical Engineering from the University of Kansas, her M.S. in Engineering and Applied Physics in Biomedicine from the Johns Hopkins University, and her law degree from the Georgetown University Law Center. Prior receiving her law degree, she also worked as a patent examiner at the USPTO.

Lisa M. Hemmendinger, Ph.D., is a principal shareholder with the law firm of Banner & Witcoff, Ltd. in Washington, D.C. Her practice includes patent prosecution and counseling in the Life Sciences fields, including biologics and small molecule pharmaceuticals. She earned her Ph.D. degree in Biology from the University of Chicago and her law degree, with honors, from the University of Maryland School of Law. She is registered to practice before the U.S. Patent and Trademark Office and is a member of the Maryland and District of Columbia Bars. She is admitted to the bars of the U.S. Supreme Court and the U.S. Court of Appeals for the Federal Circuit.

Robert S. Katz and Alisa S. Abbott

Chapter 10: Design Patents

Robert S. Katz is a principal shareholder with the law firm of Banner & Witcoff, Ltd. in Washington, D.C. His practice includes patent prosecution, litigation, and counseling and he is internationally recognized as one of the leading practitioners in the field of industrial designs. He earned his mechanical engineering degree from Carnegie-Mellon University and his law degree, with honors, from the George Washington University Law School. He is registered to practice before the U.S. Patent and Trademark Office and is a member of the Virginia and District of Columbia bars. He is admitted to the bars of the U.S. Court of Appeals for the Federal Circuit and several district courts. Robert S. Katz is a principal shareholder with the law firm of Banner & Witcoff, Ltd. in Washington, D.C. His practice includes patent prosecution, litigation, and counseling and he is inter-

nationally recognized as one of the leading practitioners in the field of industrial designs. He earned his mechanical engineering degree from Carnegie-Mellon University and his law degree, with honors, from the George Washington University Law School. He is registered to practice before the U.S. Patent and Trademark Office and is a member of the Virginia and District of Columbia bars. He is admitted to the bars of the U.S. Court of Appeals for the Federal Circuit and several district courts. Mr. Katz has served as the Chair of the Industrial Design Committee for both AIPLA and FICPI, and currently serves as Treasurer on the Executive Board of the U.S. Section of FICPI. Mr. Katz is a professor at the George Washington University Law School teaching Design Law and also was an adjunct professor at Georgetown University Law Center and is teaching a class on Intellectual Property Pretrial Litigation Skills. Prior to joining the firm, Mr. Katz was a patent examiner at the USPTO.

Alisa S. Abbott is an attorney in the Washington, D.C., office of Banner and Witcoff, Ltd. She represents clients in all facets of design patent procurement, prosecution, and intellectual property counseling. Before joining Banner & Witcoff, she practiced at a boutique intellectual property firm advising one of the world's largest electronics manufacturers on both foreign and domestic design procurement and prosecution. Ms. Abbott earned her J.D. from Washington & Lee University, focusing the majority of her practicum-based studies on intellectual property coursework.

David Hricik

Chapter 11: Combining Prosecution with Other Forms of Representation

Professor **David Hricik** received his undergraduate degree *magna cum laude* and *Phi Beta Kappa* from the University of Arizona, where he majored in English. He received his law degree with honors from Northwestern University School of Law. He practiced with Baker Botts L.L.P. and small litigation boutiques from 1988 to 2002, litigating cases primarily involving patent infringement, legal malpractice, and general complex commercial matters.

In 2002, he joined Mercer University School of Law, where he teaches legal ethics, patent law and litigation, federal civil procedure, and other courses. In 2012-13, he served as law clerk to Chief Judge Randall R. Rader at the Federal Circuit. He rejoined Mercer and also became Of Counsel to Taylor English Duma, LLP, where he continues to represent clients in patent and complex litigation. He was elected to the American Law Institute in 2016. He has authored the only treatise on ethical issues in patent litigation, and co-authored the only treatise on ethical issues in patent prosecution. In addition to serving leadership positions on ethics committees with the AIPLA and ABA and serving as an expert witness, he has written dozens of articles and given well over 100 presentations on issues at the intersection of ethics and patents. His articles and testimony have been adopted by both state and federal courts.

Tim Jump and James Tumbridge***Chapter 12: Drafting U.S. Patents With a View Toward Europe***

Tim Jump is a European and British Patent attorney. He also holds UK Higher Courts Patent and Trade Mark Litigation certificates. Tim was previously the managing and senior partner at Venner Shipley LLP in London and is now a consultant to the firm. Tim specializes in contentious British and European patent matters, and regularly represents clients at opposition and appeal hearings before the European Patent Office. Tim has also been involved in a number of successful, high profile revocation and infringement actions in the UK courts.

Tim has worked in many technical fields including medicinal and formulation chemistry, detergents, cleaning compositions, bulk chemical processing, hygiene articles, drug delivery, diagnostics and therapeutics, genetics, proteomics, chiral chemistry, cancer therapeutics, immunotherapeutics, and vaccines. He is also experienced in the field of patent and know-how licensing and has advised many clients on the acquisition of companies and their IP portfolios. Tim graduated from University College London with an honors degree in Chemistry.

James Tumbridge is an Intellectual Property Litigation Partner with Venner Shipley. In the past 20 years, his patent work has covered a wide range of technology, from bagless vacuum cleaners and the Viagra litigation to mobile telecoms standards cases and fiber glass manufacturing methods. As a litigator he has been involved in cases in several jurisdictions at the highest levels, including: the U.K. Supreme Court decision in *R. v. Prudential* on the issue of whether legal professional privilege applies to non-lawyers representing the interests of the IP community; the House of Lords decision in *RPR v. Yeda* concerning patent entitlement to a cancer therapy, and *CCH v. the Law Society of Upper Canada*, a decision of the Canadian Supreme Court concerning copyright in legal judgments. James is additionally an ad hoc advisor to various UK Members of Parliament and Members of the European Parliament on a range of IP issues and other disputes. Through his engagement with policy makers he has garnered extensive government relations experience, and accordingly advises clients on how to prepare for legislative changes and regulation compliance.

Andrew R. Sommer***Chapter 13: Validity Trials at the Patent Trial and Appeal Board***

Andrew R. Sommer is a partner with the law firm of Winston & Strawn LLP in Washington, D.C., where he is the leader of the firm's Patent Trial and Appeal Board (PTAB) Trial Practice. He focuses on patent litigation in federal court, the International Trade Commission, and the PTAB. He also counsels clients on issues regarding the management and monetization of patent rights. In 2014, the National Law Journal recognized him as one of Washington D.C.'s *Top 40 Age 40 and Under*, citing his "vigorous intellectual property practice." He has also been recognized in the IAM

Patent 1000 since 2016 and IAM Strategy 300 in 2017 and 2018. Drew earned his B.S. in optics from the University of Rochester and his law degree, *magna cum laude*, from George Mason University School of Law. While in law school, he was a patent examiner at the USPTO. He left private practice to clerk for the Hon. Kimberly A. Moore, United States Court of Appeals for the Federal Circuit from 2006 to 2007. He is registered to practice before the USPTO, and is a member of the bars of the Commonwealth of Virginia and the District of Columbia.

