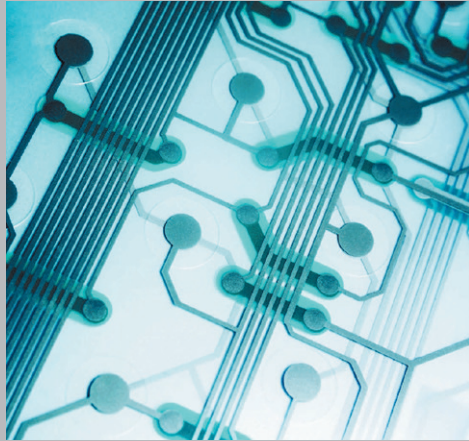




Wolf Greenfield

INTELLECTUAL PROPERTY LAW



Since our founding in 1927, our focus has been exclusively intellectual property. Whether representing multinational corporations, prestigious universities and research institutions, or “unicorn” startups, our firm is structured around providing top-quality service to clients whose IP is at the core of their business. We have been recognized for excellence by Chambers, U.S. News & World Report/Best Lawyers, and others.

BOSTON | NEW YORK

wolfgreenfield.com

Wolf, Greenfield & Sacks, P.C.
©Copyright 2020 Vault.com, Inc. Photocopying is illegal and expressly forbidden.

Wolf, Greenfield & Sacks, P.C.

Heather DiPietrantonio, Associate—Biotechnology, and Jessamine (“Jas”) Lee, Shareholder—Chemical and Material Technologies

Heather DiPietrantonio is a senior patent attorney practicing in the field of biotechnology with experience in gene editing, genetic engineering, nucleic acid nanotechnology, synthetic gene circuitry, nucleic acid vaccines, antibody therapeutics, and immune and stem cell therapeutics. Her practice focuses on patent prosecution, strategic patent portfolio development, and life cycle management. Heather counsels startup companies, research and academic institutions, and small to mid-sized biotech companies.

Jas Lee works with clients in IP strategy development and execution, including IP portfolio management, U.S. and foreign patent prosecution, non-infringement and invalidity opinions, and due diligence. She counsels a variety of clients, including startup companies, large global corporations, venture capital firms, and academic institutions on U.S. and international patent issues. Jas earned her B.Sc. in Chemistry from McGill University, her A.M. and Ph.D. in Chemistry from Harvard University, and her J.D. from Suffolk University Law School.

Describe your practice area and what it entails.

Heather: I guide clients through the patent application process, which includes drafting patent applications and prosecuting the applications at the U.S. Patent Office (USPTO). I also work with foreign counsel to prosecute internationally and work to obtain patents that will protect a client's invention. I counsel clients on both patent- and business-related issues, including freedom to operate, licensing, and various due diligence processes.

Jas: My practice focuses on client counseling and IP portfolio management. I advise clients on how to protect their IP, including identifying patentable inventions, deciding which inventions to keep a trade secret, and developing filing strategies, as well as how to build and maintain their patent portfolios. I also advise clients from a defensive position, including reviewing competitor patents and assessing freedom to operate.

What types of clients do you represent?

Heather: I represent both large and emerging biotech companies developing antibody therapeutics. I also represent privately financed growth-phase companies developing vaccine technologies and prestigious academic and research institutions on the cutting edge of gene editing and nucleic acid nanotechnologies.

Jas: I particularly enjoy advising startup companies but also work with large global corporations, venture capital firms, and academic institutions. I have represented clients in a broad range of fields, including microfluidics, medical devices and diagnostics, drug delivery, bioreactors, cleantech technologies, electrochemical devices (lithium batteries), nanotechnology, microfabrication, materials chemistry, organic chemistry, and pharmaceuticals.

What types of cases/deals do you work on?

Heather: I generally work on cases related to patent prosecution and assessment for companies and research institutions in the genetic engineering, vaccine technology, and genetic mouse model spaces. I work with clients to develop and strengthen their IP portfolios, and I also work with clients to assess the strengths and weaknesses of their competitors' IP portfolios.

Jas: I have worked with clients to develop and manage their patent portfolios, including our clients' own patent applications and licensed-in patents. I advised one client through several stages of venture financing, acquisition, and integration with a multinational pharmaceutical and diagnostics company. I have also evaluated complex patent portfolios and developed strategies to best position clients in worldwide coordinated efforts. I have assessed clients' freedom to operate (likelihood of getting sued) by coordinating non-infringement and invalidity studies and writing opinions directed towards our clients'.

competitors' patents. I have also analyzed patent portfolios as part of due diligence on prospective acquisitions for large clients and venture capitalists.

How did you choose this practice area?

Heather: Impulsively. One afternoon, while in the lab staring through a microscope, I thought, "I'm ready for a change." A search for "alternative careers in science" landed me on "patent agent." I applied for a position at a couple of IP boutiques, was fortunate to have been offered a position soon after, and dove in. I have been loving it ever since.

Jas: In graduate school, I worked on a project that ended up going through the patenting process, and through this experience, I had the opportunity to work with patent attorneys. I was intrigued by the process, and it soon became clear to me that patent law was an avenue where I could apply my scientific and analytic skills in a unique way. I spoke to several law firms in Boston that had a technology specialist program and chose Wolf Greenfield. The program allowed me to obtain hands-on experience in patent law and interact with clients.

What is a typical day like and/or what are some common tasks you perform?

Heather: One of the things I love about this career is that there is no "typical." Each day is full of a mixture of different technologies, different client interactions, different strategies to develop, and different problems to solve. I spend my days writing, participating in conference calls, meeting with clients, teaching, and being taught. Every day is something new and exciting.

Jas: I manage patent portfolios for and work closely with several clients, so each day brings new and exciting challenges. On a typical day, I will have calls with clients about a particular matter, such as a new invention or how to argue against a rejection in an office action issued by the U.S. Patent Office. I work with individuals who help me with these analyses, and together, we formulate arguments and make recommendations to our clients. I review drafts of the responses themselves, as well as drafts for new patent applications that will be filed. I am also active in mentoring junior attorneys and technology specialists, so I meet with or speak with them regularly.

What training, classes, experience, or skills development would you recommend to someone who wishes to enter your practice area?

Heather: Someone entering this practice area should have a strong technical background, organizational skills, and outstanding communication skills—both written and verbal. It also helps to be calm, sensible, and adaptable.

Jas: Someone entering this practice area should be curious, be organized, be able to learn quickly, have strong analytical skills, be strong technically, and be able to communicate effectively. Much of our practice involves seeing a new technology for the first time and being able to ask the right questions to gain a solid understanding of it—enough to be able to describe it in your own words and distinguish it from other technologies, all the while instilling confidence in your client.

What is the most challenging aspect of practicing in this area?

Heather: The most challenging aspect for me is maintaining boundaries between work life and all the rest of life. I think a lot of us do what we do because we are really good at it, and we are really good at it because we enjoy it. If I didn't set aside enough time to enjoy with friends and family, ultimately, I wouldn't be any good at work.

Jas: My practice in patent law is extremely rewarding but also very intense when there are many things going on for several different clients. I find that I need to be recharged in order to focus on my work and use my time effectively, so I make it a priority to exercise regularly and spend time with my family and friends. My husband and I have two young children, and we are constantly coordinating their activities and our time together and balancing it all with the demands of work.

What do you like best about your practice area?

Heather: Our clients and colleagues. I am really fortunate to have had the opportunity to build strong relationships with our clients, many of whom are not only intelligent, driven visionaries, but are also kind, witty, and understanding. Also, as patent prosecutors—particularly in the biotechnology practice area—we are among the first to learn about and guide the development of the most exciting technologies, we have the opportunity to talk with and advise the most innovative minds, and we are responsible for arguing with the USPTO to secure valuable intellectual property rights.

Jas: I love the diversity in the types of clients I work with and the kinds of projects I work on. Every day brings a new challenge, and I am constantly learning something new, whether it's a new technology, new aspect of patent law, or how to best address the needs of a client. I also love the flexibility of my job. I can take my work with me anywhere I go as long as I get it done and am responding to our clients' and the firm's needs.

What is unique about your practice area at your firm?

Heather: Leading biotech companies, innovative startups, and prominent research institutions consistently turn to us

to protect and enforce their intellectual property rights. We take a team-based approach, including recognized leaders in the biotechnology area, combined with a mix of paralegals and seasoned administrative professionals to maximize efficiencies. We maintain a comprehensive internal educational program, which includes periodic lunches, seminars, and email threads. We also share a common hallway, which ensures our entire staff is conversant in relevant case law and emerging issues in the U.S. and abroad.

Jas: Many of our practitioners have science or engineering degrees or advanced degrees. We also have more than 100 attorneys and technology specialists working in practice groups that are divided by technology, including biotechnology, chemical and materials technologies, electrical and computer technologies, mechanical technologies, and pharmaceuticals. It is, therefore, quite easy to put together a team that has the

right technical fit to address a particular client's needs, even when a client's technology spans different technologies. We also have trademark, litigation, and post-grant groups.

What are some typical tasks that a junior lawyer would perform in this practice area?

Jas: Junior practitioners may be given an office action in which the USPTO has rejected the claims of a patent application. He/she would review the prior art cited by the examiner (typically a patent or research article), come up with a strategy for distinguishing our client's invention from the prior art, and summarize their findings with a supervising attorney. They may then draft arguments for a response to be filed with the Patent Office. Junior practitioners work closely with supervising attorneys, so they receive feedback on their work.

WOLF, GREENFIELD & SACKS, P.C.

“I love the diversity in the types of clients I work with and the kinds of projects I work on. Every day brings a new challenge, and I am constantly learning something new, whether it's a new technology, new aspect of patent law, or how to best address the needs of a client.”

Jessamine (“Jas”) Lee, Shareholder