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LEGAL EXPERIENCE

Schwegman, Lundberg & Woessner, P.A., Minneapolis, MN, 1993 - Present, Founding Partner. Emphasis in chemical, pharmaceutical and biotechnological patent prosecution including pharmaceutical patent life cycle strategies, opinion work, licensing and client counseling.

Merchant & Gould, P.A., Minneapolis, MN, 1984-1993, Partner.

Kenyon & Kenyon, New York, NY, Associate attorney from 1981-1984.

BAR ADMISSIONS

State: Wisconsin-1981; New York-1982; Minnesota-1984. Federal Appellate: U.S. Supreme Court; Federal Circuit; Patent Bar.

EDUCATION

Legal

University of Wisconsin, Madison Law School, Madison, Wisconsin, J.D., cum laude, 1981.

Research and Writing Editor, Wis. Law Review, 1980-1981.

Scientific

University of Wisconsin Department of Chemistry, Ph.D., Organic Chemistry, 1971. Thesis: Hexatriene-Iron Tricarbonyl Isomerizations. Synthesis of new organometallic compounds.

Cornell University, Ithaca, New York, B.A., Chemistry, 1962-1966.

SCIENTIFIC EXPERIENCE

University of Wisconsin School of Pharmacy. Postdoctoral Research Associate, 1971-1972. Developed new methods and reagents for the synthesis of natural products.

Miles Laboratories, Inc., Natural Products Laboratory, Madison, Wisconsin. Senior Research Scientist, 1972-1978. Synthesis and evaluation of new drugs.

PROFESSIONAL ACTIVITIES

American Intellectual Property Law Association, Chair, Chemical Practice Committee, 1993-1995; Chair, Professional Programs Subcommittee of Biotechnology Committee, 1999-2001; Vice-Chair, Biotechnology Committee, 2001-2003, Chair, 2003-2005; Amicus Committee, 1999-2002; 2005-present; Fellow, 2005-present.

Minnesota Intellectual Property Law Association, Member 1984-present, Chair, Biotechnology Law Committee, 1986-1987.

American Bar Association, Member, Biotechnology Committee, 1993-present. Representative to PTO Biotechnology/Chemical/Pharmaceutical Customer Partnership, 1997-present.

MNBIO (Minnesota Biotechnology Association), Board of Directors, 1999-2001.

Patent Strategy & Management, Board of Advisers, American Lawyer Media, 2000-present.

Fund for the Legal Aid Society, Minneapolis, Board of Directors, 2001- present; Executive Committee, 2003-present.

Licensing Executive's Society International. Certified Licensing Professional. 2008.

PUBLICATIONS

"Federal Circuit Applies Bilski Standard in Classen," Patent Strategy & Management, 10, 1 (2009).

"Ex parte Kubin", Patent Strategy & Management, 9, 1 (2009)

"Federal Circuit Split on 'Public Accessibility' of Internet Posting," Patent Strategy & Management, 8, 3 (2008).

"Patents on New Uses for 'Old' Inventions," Patent Strategy & Management, 7, 8 (2007).

"Claiming Metabolites: The Federal Circuit Poses New Challenges to Patent Applicants," Patent Strategy & Management, 5, 1 (2004).

"Do-Over!" - The Federal Circuit Takes a Second Look at Enzo," J. Patent and Trademark Office Society, 85, 275 (2003).

"Let's Get Physical" - Invited Open Peer Commentary on R. Eisenberg, "How Can You Patent Genes," Am. J. Bioethics, 2, 21 (2002).

"Ruling Blunts Enzo's Attack on Biotechnology," Patent Strategy & Management, 3, 1 (2002).

"The Evolution of Patents on Life -- Transgenic Animals, Clones and Stem Cells," J. Patent and Trademark Office Society, 83, 830 (2001).

"New PTO Guidelines Raise Standards for Patenting Biological Materials," Patent Strategy & Management, 11 (April 2001).

"Supreme Court Should Confirm Patent Rights For Biotech Plants," Legal Opinion Letter, Washington Legal Foundation, 11, No. 11 (July 27, 2001).

"The Evolution of Patents on Life -- Transgenic Animals, Clones and Stem Cells," J. Patent and Trademark Office Soc'y, 83, 830 (2001).

"Point of View -- Guidelines for Patenting Biologicals," Genetic Engineering News, 20, 6 (2000).

"Patenting Transgenic Animals: From the Harvard Mouse to 'Hello Dolly'", Bio-Science Law Review, 1, 3 (1999).

"The Interim Written Description Requirement Guidelines -- One Correlation Too Many?," J. Patent and Trademark Office Soc'y, 81, 147 (1999); Comment, Biotechnology Law Report, 17, 729 (1998).

"U.S. Doctors Find Swift Relief in Patent Law Amendment," with Michael A. Dryja, IP Worldwide, 20 (March/April 1997).

"Patent Prosecution One Year After GATT," Biotechnology Law Report, 15, 713 (1996).

"Bring Them Back Alive! Patents on 'Products of Nature'", with Kathleen Terry, Pharmaceutical News, 3 (1), 35 (1996).

"GATT and the Patenting of Pharmaceuticals in the 21st Century," with Kathleen Terry, Pharmaceutical News, 2 (6), 28 (1995).

"The Logjam on Pharmaceutical Patents May Be Breaking Up At Last," with Kathleen Terry, Technology Access Report, 8, 7 (1995).

"Plant and Animal Patent Strategies," AIPLA Selected Legal Papers, 11, 45 (1994).

"Patenting Life - Transgenic Animals," The Law Works, 1, 8 (1994).

AUTM Technology Transfer Practice Manual, Chapter 9.1K, "Guide To Foreign Patent Protection," (1994 ed., revised 1996).

"Plant and Animal Patenting Strategies," ATCC Biotechnology Patent Conference Workbook, (1992) at pages 11-20.

"A Review of Recent Federal Circuit Decisions Relating to Infringement," AIPLA Selected Legal Papers, 9, 1 (1991).

"Trends in Intellectual Property Law," J. Assoc. Univ. Technol. Managers, 2, 55 (1990).

"Gene Transfer in Plants--Technology and Patent Strategies," ATCC Biotechnology Patent Conference Workbook, (1989) at pages 18-23.

"Technology Transfer: From Non-Profit Research to Profit - Outside Counsel's View," Abstracts, 196th ACS National Meeting, Los Angeles, CA (September 25-30, 1988).

"Selected Aspects of Patent Law Affecting the University Inventor," Abstracts, 194th ACS National Meeting, New Orleans, LA (August 30-September 4, 1987).

"Patent Law and the Professor," Chemtech, 536 (September 1986).

INVITED PRESENTATIONS

The Collaborative Convergence Series – Medtech, Minneapolis, MN, Moderator, "Biologics & Device" (March 2009).

Association of University Technology Managers (AUTM), Annual Meeting, Orlando, FL, Speaker, "You Can't Patent That! Can You" and Judge, "A New and Exciting Game Show: Analyze that Contract" (February 2009).

Licensing Executive Society, Annual Meeting, Kissimee, FL, Moderator, "Managing the Gladiators – Surviving Patent Litigation" (October 2008).

Association of University Technology Managers, Eastern Regional Meeting, Boston, MA, Speaker, "Stem Cell Frontiers – Policy, Promise and Patents," (July 2008).

BIO 2007 International Biotechnology Convention, Boston, MA, Panelist, "Life After Merck KGaA v. Integra Life Science," (May 2007).

American Conference Institute, 8th Advanced Forum on Biotech Patents, Menlo Park, CA, Speaker, "Applying and Avoiding the Doctrine of Inherent Anticipation," (April 2007).

C5's 4th International FTO Forum, London, UK, Speaker, "Claim Interpretation and Risk Evaluation – Construing Claims," (March 2007).

American Conference Institute, 7th Advanced Forum on Biotech Patents, Boston, MA, Speaker, "Applying and Avoiding the Doctrine of Inherent Anticipation," (November 2006).

Practising Law Institute, Preparing Patent Legal Opinions, New York, NY, Speaker, "Patent Infringement and Freedom to Operate Opinions," (September 2006).

American Conference Institute, Freedom to Operate, New York, NY, Speaker, "Assessing the Impact of the Doctrine of Equivalents on Claim Interpretation and Non-Infringement Opinions," (September 2006).

Association of University Technology Managers, Central Regional Meeting, Minneapolis, MN, Speaker, "Patent Strategies for Stem Cell Technology," (July 2006).

C5, Tactical and Practical Guide to Freedom to Operate, London, UK, Speaker, "Risk Evaluation Key Tips In Construing Claims," (July 2006).

LES/AUTM 2006 Spring Meeting, Philadelphia, PA, Moderator, "Managing the Gladiators -- Surviving Patent Litigation," (May 2006).

American Conference Institute, 6th Advanced Forum on Biotech Patents, San Francisco, CA, Co-Chair, (February 2006).

American Conference Institute, A Tactical and Practical Guide to Freedom to Operate, New York, NY, "The Continuing Impact of *Festo* on Non-infringement Opinions," March 2005.

Practicing Law Institute, Preparing Patent Legal Opinions 2004, New York, NY, "Product Clearance and Non-infringement Opinions in a Post-*Festo* World," September 2004.

American Intellectual Property Law Association (AIPLA), Advanced Biotechnology & Chemical Patent Practice Seminars, "Research Tool Patents - Fight or Flight," Seattle, WA and Wilmington, DE, June 11 and 25, 2004.

BIO 2004 International Biotechnology Convention, Workshop moderator, "The Evolving Law of Research Tools," June 2004.

Association of University Technology Managers (AUTM), Annual Meeting, San Antonio, TX, "Managing the Gladiators - Surviving Patent Litigation," March 2004.

American Conference Institute, A Tactical and Practical Guide to Freedom to Operate, New York, NY, "Legal Standards for Non-infringement Opinions," April 2004, San Francisco, CA and November 2003, New York, NY.

American Intellectual Property Law Association, Annual Meeting, Washington, DC, "The Utility Requirement -- Beyond Credibility," October 2003.

Practising Law Institute, Preparing Legal Opinions 2003, New York, NY, "Patent Infringement and Freedom to Operate Opinions," September 2003.

Practising Law Institute, Preparing Patent Legal Opinions 2002, San Francisco, CA, "Patent Infringement and Freedom to Operate Opinions," October 2002.

BIO 2002 International Biotechnology Convention, Toronto, Canada, "Patenting Leading-Edge Biotechnology," June 2002.

Yale University Biotechnology Student Interest Group, Speakers Series, New Haven, CT, "Patenting Transgenic Animals -- From the Harvard Mouse to 'Hello Dolly!'," April 2002.

Association of University Technology Managers (AUTM), Annual Meeting, San Diego, CA, "Commercialization of Agricultural Biotechnology from Academia," March 2002.

American Intellectual Property Law Association, Mid-Winter Institute, Phoenix, AZ, "Litigation of Pharmaceutical Patents Under the Hatch-Waxman Act," January 2002.

American Conference Institute, Patenting Genomics, Proteomics and Complex Biotech, "Meeting the Requirements of the PTO's Utility and Written Description Requirements," November 2001.

Strategic Research Institute, Pharma and Biotech -- Intellectual Property and Business Development, San Francisco, CA, "Strategies for Successful Biotech Patent Prosecution," April 2001.

Cambridge Healthtech Institute, Human Proteomic Project Conference, McLean, VA, "Patenting Proteomics," April 2001.

American Intellectual Property Law Association, Spring Meeting, San Francisco, CA, "Practical Guide to Research Tool Patent Strategies: A Panel Discussion," May 2001.

AUTM, Annual Meeting, New Orleans, LA, "Managing the Gladiators -- Surviving Litigation," March 2001.

ATCC, Biotech Patent and Licensing Forum, Arlington, VA, "Prosecution in View of the Written Description and Utility Requirements," September 2000.

AUTM, Central Regional Meeting, Cincinnati, OH, Workshop, "Anatomy of a Home Run -- The Carbovir Story," August 2000.

American Intellectual Property Law Association, Advanced Biotechnology/Chemical Patent Practice Seminars, Program Coordinator and Speaker, "Patent Prosecution In View of the 1999 Revised Interim Utility and Written Description Requirement Guidelines," Washington, DC and San Francisco, CA, April and June 2000.

MNBIO, Symposium, "Genetically Modified Food -- Issues and Opportunities," Minneapolis, MN, "Protecting Innovation in Ag Biotech," April 2000.

AUTM, 2000 Annual Meeting, Atlanta, GA, Workshop, "Anatomy of a Home Run -- The Carbovir Story," February 2000.

American Intellectual Property Law Association, 2000 Mid-Winter Institute, LaQuinta, CA, "Strategies for Successful Biotech Prosecution in the PTO," January 2000.

BIO 1999 International Biotechnology Meeting, Seattle, WA, Session, "Patenting Early-Stage Biotechnology," June 1999.

American Intellectual Property Law Association, Spring Meeting, Chicago, IL, "*UC v. Lilly* and its Progeny -- Back to the Future?," April 1999.

AUTM, Central Regional Meeting, Minneapolis, MN, Workshop, "Patenting Early-Stage Technology," August 1998.

BIO '98 International Biotechnology Meeting, New York, NY, Session, "Patenting Transgenic Animals -- From the Harvard Mouse to 'Hello Dolly,'" May 1998.

American Intellectual Property Law Association, Advanced Biotechnology/Chemical Patent Practice Seminar, "Prosecuting Patent Applications To Meet the Enablement and Written Description Requirements of § 112," New York, NY (Spring 1998).

AUTM, Annual Meeting, San Antonio, TX, "Advanced Issues in Academic-Industry Relations," February 1998.

American Intellectual Property Law Association, Annual Meeting, Washington, DC, "How To: Patent Transgenic Animals," October 1997.

Suffolk University Law School/Boston Patent Law Association, Second Annual High Technology Law Conference, Boston, MA, "'Hello Dolly!' -- Transgenic Animal Patents from the Harvard Mouse to the Cloned Sheep," September 1997.

American Intellectual Property Law Association, Basic Biotechnology/Chemical Patent Practice Seminar, Speaker, "Drafting and Prosecuting Applications to Meet the Utility/How-To-Use Requirement of §§ 101/112," Arlington, VA, Chicago, IL, San Francisco, CA, Spring 1996.

AUTM, Annual Meeting, Charleston, SC, Workshop, "Patenting and Licensing Agricultural Biotechnology," February 1996.

AUTM, Central Regional Meeting, Ames, IA, Workshop, "Patenting and Licensing Plants and Animals," July 1995.

Wisconsin Intellectual Property Law Association and the University of Wisconsin Law School, Intellectual Property - Law and Practice, Speaker, "Methods of Medical Treatment - Suspects on Trial," May 1995.

American Chemical Society, 209th National Meeting, Anaheim, CA, Speaker, "Owning Life -- Patents on Transgenic Plants and Animals," April 1995.

American Intellectual Property Law Association, Basic Chemical and Biotechnology Patent Practice Seminar, Speaker, "Drafting and Prosecuting a Chemical Application to Meet Utility and Enablement Requirements," Boston, MA; Minneapolis, MN; Seattle, WA; Fall 1994.

AUTM, Annual Meeting, Phoenix, AZ, Workshop, "Advanced Patents," February 1994.

AUTM, Annual Meeting, Dallas, TX, Workshop, "How To Dig Out Prior Art," February 1993.

AUTM, Central Regional Meeting, Indianapolis, IN, Workshop, "Difficult License Negotiations," July 1993.

American Intellectual Property Law Association, Annual Meeting, Washington, DC, "How To: Patent Agricultural Biotechnology," October 1993.

AUTM, Annual Meeting, Orlando, FL, Workshop, "Optimizing Your Foreign Filing Program," February 1992.

American Type Culture Collection (ATCC), Biotechnology Patent Conference, Washington, DC, Speaker, "Plant and Animal Patenting Strategies," April 1992.

AUTM, Annual Meeting, San Francisco, CA, Workshop, "Maximizing The Value of Outside Counsel," February 1991.

AIPLA, Annual Meeting, Crystal City, VA, "How To: Infringement Opinions In View of Recent Federal Circuit Opinions on Estoppel," October 1991.

AIPLA, Midwinter Meeting, Palm Desert, CA, Presentation to Chemical Practice Committee: "The Application of the Doctrine of Equivalents to Chemical Practice," February 1990.

Hamline Law School, Conference on Agricultural Biotechnology, Minneapolis, MN, Speaker, "Protection of Agricultural Intellectual Property," April 1990.

Society of University Patent Administrators, Annual Meeting, New Orleans, LA, Plenary Session Speaker, "Intellectual Property Law -- Troubling Trends and What We Can Do About It," February 1989.

ATCC, Biotechnology Patent Conference, Bethesda, MD, Speaker, "Gene Transfer in Plants -- Technology and Patent Strategies," April 1989.

American Chemical Society, 196th National Meeting, Los Angeles, CA, Panelist, "Technology Transfer: From Non-Profit Research to Profit," September 1988.

American Chemical Society, 194th National Meeting, New Orleans, LA, Panelist, "Selected Aspects of Patent Law Affecting the University Inventor," September 1987.