



# Jeffrey T. Gendzwill

Co-Chair, Patent Prosecution

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Jeff is a registered patent attorney who concentrates his practice on patent-related matters with a focus on client counseling, portfolio strategy and management, U.S. and foreign patent preparation/prosecution, and post-grant proceedings. His practice spans a wide range of technologies with a focus on the chemical and life sciences industry including chemical engineering, chemistry, clean energy, and nutritional/pharmaceutical supplements, as well as mechanical and biomechanical engineering, nanotechnology, physics, composite materials, and medical devices. Jeff also has extensive experience preparing complex patentability, invalidity, non-infringement, and freedom-to-operate opinions, as well as state-of-the-art analyses. He has represented multiple clients in disputes, both offensive and defensive, before the Patent Trial and Appeal Board (PTAB).

Jeff is a frequent speaker on many IP law issues including joint infringement jurisprudence and the post-Helsinn on-sale bar. He has recently presented Filing Strategies in China: Don't Forget the Utility Model; Patent Monetization: Options in Patent Sales; and Streamlined PCT Prosecution Strategies to legal teams at many of his industry-leading chemical and packaging clients.

He earned his J.D. at the University of Detroit-Mercy School of Law, where he graduated *magna cum laude*, and his B.S.Ch.E. from the University of Michigan-Ann Arbor. Before launching his legal career, Jeff worked in the automotive industry as a chemical engineer and as a technical sales engineer for several Fortune 500 companies including 3M Company and Henkel International.

## Experience

Successfully represented Ascend Performance Materials in a Patent Opposition hearing before the European Patent Office's Opposition Board, resulting in the revocation of all claims of a granted EMS Chemie patent broadly covering particular high-performance plastic formulations.

Prevailed on behalf of Ascend Performance Materials LLC in an *Inter Partes* Review before the Patent Trial and Appeal Board (PTAB) challenging ten claims of a Samsung patent relating to rechargeable lithium battery electrolyte technology. The representation included detailed Petition preparation, substantial expert testimony, multiple depositions (conducted in Korean with translators), and a virtual oral hearing. The PTAB issued its Final Written Decision finding all of the challenged claims to be invalid on two separate grounds, each based on different prior art.

Represented Ascend Performance Materials, the world's largest fully integrated producer of nylon-6, working hand-in-hand to help the company define a robust IP footprint in various spaces as it creates innovative approaches and solutions for its numerous technology platforms. This representation also involved working closely with Ascend's IP Team to continue to develop layers of patent protection around Ascend's specialty fibers technology, its engineering plastics platform, as well as its acrylonitrile production and specialty chemicals platforms. In addition to portfolio development, Jeff helped Ascend navigate multiple third party patent matters, both in the United States and worldwide. On the litigation front, he strategized with legal, technology, and business teams on enforcement matters including potential infringement suits (offensive and defensive), as well as invalidation and opposition

## Practice Areas

- Intellectual Property
- Patents

## Education

- University of Detroit Mercy School of Law, J.D., *magna cum laude*, 2004
- University of Michigan, B.S.Ch.E., 1993

## Bar Admissions

- District of Columbia
- Michigan

## Court Admissions

- U.S. District Court -- Eastern District of Michigan
- U.S. Patent and Trademark Office

## Awards & Honors

- *IAM Patent 1000*, 2022-2024
- BTI Client Service All-Star, 2022

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proceedings in the United States and worldwide.

Represented Avery Dennison Corporation, an industry-leading packaging specialty company, working closely with the internal legal team to coordinate and manage the global patent protection portfolio as the worldwide Research and Development teams continue to provide innovative and environmentally friendly packaging, polymers, topcoats, labels, and specialty tapes. This representation also involved providing counsel regarding global enforcement strategies, licensing opportunities, and navigation of third party patent rights – including opposition and invalidation proceedings before foreign patent offices.

Represented Materion Corp., a multinational company specializing in high-performance engineered materials – whose products include engineered beryllium (and other precious metals), inorganic chemicals, specialty coatings, ceramics, and engineered clad and plated metal systems – in connection with building out the IP portfolio for two of its three core business groups and successfully handled post-grant proceedings before the Patent Trial & Appeal Board. This representation also involved providing counsel regarding global enforcement strategies, licensing opportunities, and navigation of third party patent rights – including opposition and invalidation proceedings before foreign patent offices.

Globally enforced medical device patents of a preeminent surgeon against infringing surgical instruments of competitors, including a suit before the Southern District of New York (Case No. 18-CV-1964), related actions in Düsseldorf, Germany and Ottawa, Canada, and a license agreement in Asunción, Paraguay.

Secured denial of post-grant review (PGR) of U.S. Pat. No. 9,989,684 relating to near infrared optical interference filters for Materion Corp. The Patent Trial & Appeal Board concurred with Materion's Preliminary Response, upholding the patent, which had been challenged for lack of written description, enablement, anticipation, and obviousness. *Viavi Solutions Inc. v. Materion Corp.*, PTAB Case Number PGR2019-00017.

Represented Celanese International Corp. in IPR proceedings successfully challenging U.S. Pat. No. 9,115,071, owned by competitor Daicel Corporation. The IPR was instituted, but was terminated after institution when Daicel filed a request for adverse judgment. PTAB Case Number IPR2017-00162.

Counsel for patentee Celanese in five *inter partes* review petitions filed by competitor Daicel challenging validity of Celanese patents related to industrial acetic acid production. The Patent Trial and Appeal Board initially ruled in favor of Celanese, completely denying all five petitions, although requests for rehearing subsequently resulted in the institution of 3 of the 5 IPRs. In June of 2016, the PTAB issued final written decisions in the three IPRs, finding for patent owner Celanese and affirming all instituted claims as not unpatentable. PTAB Case Numbers IPR2014-01514, IPR2014-01515, IPR2015-000170, IPR2015-00171 and IPR2015-00173.