

Jeff B. Vockrodt

PARTNER

Jeff Vockrodt focuses on global patent procurement and enforcement strategies, with an emphasis on chemical and pharmaceutical industries.



Industries

Agricultural Technology
Life Sciences
Venture Capital & Emerging Businesses

Practices

Complex Litigation
Patent

International

Europe

Education

The George Washington University Law School JD, 2005
University of Arizona BS, Chemical Engineering, 1999

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Jeff represents both patent owners and challengers in disputes involving a wide range of technologies, including additive manufacturing, semiconductors, medical devices, pharmaceuticals, biotechnology, and chemical processing. Jeff serves as lead counsel in inter partes review (IPR) proceedings before the Patent Trial and Appeal Board (PTAB), and has substantial experience throughout all aspects of ex parte and inter partes reexaminations in addition to interference proceedings before that tribunal including appeals to the Court of Appeals for the Federal Circuit (CAFC).

Jeff is a registered patent attorney with a chemical engineering background. He served for four years as patent examiner before the United States Patent and Trademark Office and a law clerk in the United States International Trade Commission Office of Unfair Import Investigations before entering private practice.

Client Work

Jeff counsels several start up, mid-size and large pharmaceutical and medical device companies on all aspects of intellectual property protection including patent and related exclusivity issues, including:

- Preparing and prosecuting patent applications with an emphasis on ensuring adequate protection vis-à-vis the product under development and known competitive threats taking into account recent developments in patent jurisprudence.
- Preparing patent and market exclusivity defense strategies involving portfolio development to fend off challenges by way of Abbreviated New Drug Applications (ANDAs); 505(b)(2), or New Drug Applications related to competing products.
- Negotiate and counsel client as to license agreements including issues with respect scope, duration and patent term issues.

Counsel clients as to all issues related to patent term including patent term adjustment (PTA) and patent term extension (PTE) including filing related petitions the Patent Office or challenges in District Court.

- Defend company's patent portfolio and respond to questions about the portfolio by parties conducting due diligence as part of a financing round or prospective merger.
- Conduct due diligence, freedom-to-operate, validity and patentability analyses, and prepare formal legal opinions of counsel as to third-party patents and in connection with transactions including providing an opinion of counsel to underwriters as to the company's patent issues in an initial public offering and subsequent financing rounds.

Jeff's practice includes all manner of complex Patent Office proceedings including substantial experience with post-grant Patent Office proceedings before the PTAB, particularly with IPR, and other adversarial matters including reissue, *ex parte* reexamination, *inter partes* reexamination, and interference proceedings.

- As lead counsel to a global medical device company, obtained PTAB decision invalidating all challenged claims of a competitor's patents through IPR in a decision affirmed by the CAFC.
- Served as counsel in several IPR and CBM proceedings on behalf of the patent owner and challenger from pre-investigation, filing of the petition, litigation before the PTAB, and appeal to the CAFC.
- Represented patent owners and challengers in inter partes reexamination proceedings (the predecessor of IPR) many of which were litigation-related and included complex Patent Office petitions. One of the inter partes reexaminations Jeff handled was relied on by the Patent Office in its rulemaking related to the PTAB proceedings, Office Patent Trial Practice Guide, *In re Arviv*, Control No. 95/001,526 (Petition Decision April 18, 2011).
- Represented patent owners and petitioners in *ex parte* reexamination proceedings in cases related to pending or threatened litigation.
- Served as counsel before the Interference Trial Section on several interference proceedings to determine the party first to invent or resolve inventorship disputes among competing entities.

Publications, Presentations & Recognitions

Jeff regularly provides presentations and client updates on the recent developments before the PTAB and other Patent Office developments, including:

- Panelist, "3DHEALS Washington, DC Technology Transfer: From Bench to Market," Washington, DC (October 2018)
- Speaker, "Post-Grant Strategies: Inter Partes Review and Post-Grant Review," organized by Biomeridies and StartingBloch, Nimes, France (June 2015)
- Panelist, "Recent Trends in Patent Office Litigation before the Patent Trial and Appeal Board," Northern Virginia Technology Council, Tech Law and Procurement Committee Event (May 2015).
- Speaker, VIB (Flemish Biotech Institute)-US Patent One-Day Workshop, "Proceedings before the Patent Trial and Appeal Board" Sint-Martens-Latem, Belgium (November 2014)

Keynote Speaker, "Trends for University Patent Monetization in the Post American Invents Act Era," VirginiaTech, College of Science Academy of Integrated Science's Science, Technology and Law Program (October 2014)

Jeff enjoys exploring the implications of new legislation, contributed observations to the rulemaking process for implementation of the Leahy-Smith America Invents Act to create the PTAB, and has written on several cutting-edge issues relating to Post-Grant proceedings including:

- Co-author, "Chemical and Life Sciences Year in Review, 2017" (Jan. 19, 2018)
- Quoted Source "Three years after its passage, the AIA has brought IPRs and CBMs in front of the USPTO" Inside Counsel Alphabet Soup, Ed Silverstein (Sept. 1, 2015).
- Four Takeaways from the Federal Circuit's First Inter Partes Review Decision, *In Re Cuozzo*, BNA Intellectual Property Technology and Law Journal (February 9, 2015)
- Co-Editor, *Inter Partes* Review Year in Review 2014
- "5 Things You Should Know About Post-Grant Review," Law 360 (Sept. 19, 2014).
- Guest Lecturer on Post-Grant Proceedings, Georgetown University Advanced Patent Law Course (2014).
- Are the Board's Institution Decisions on § 315 Eligibility for *Inter Partes* Review Appealable? (April 1, 2014).
- Preserving Your Right to Patent Term Adjustment: The Exelixis Decision and Lessons From Wyeth (December 12, 2012).
- "Don't Let Your Right to *Inter Partes* Review Slip Away," Law-360 (August 29, 2012).
- Co-author, Pharmaceutical, Chemical and Biotech Year in Review, 2009-2012
- Author, Reexamination Essentials, 2010.

Bar Admissions

US Patent and Trademark Office
District of Columbia
Maryland

Court Admissions

US Court of Appeals, Federal Circuit
Supreme Court of the United States