



Jeffrey A. Wolfson

Partner

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PRACTICES Intellectual Property, Patents, Patent Prosecution and Counseling, Trademarks, Mergers and Acquisitions, Corporate Strategic M&A, Israel, Trade Secret Litigation, Oil and Gas, Technology Transactions, Asia, Healthcare and Life Sciences, FDA Regulatory and Compliance, Healthcare Transactions and Regulatory, Life Sciences, Pharmaceuticals, Technology, Technology Mergers and Acquisitions, Chemical, Medical Device and Technology, Agriculture Technology

Jeffrey Wolfson, chair of the Patent Prosecution Practice Group, helps clients ranging from Fortune 500 enterprises to start-ups manage their intellectual property and related legal risk. With more than 25 years of experience in patent and intellectual property law, Jeff counsels clients on a range of strategic issues, including:

- Obtaining and managing portfolios of U.S. and foreign patent and other IP rights, including patent prosecution
- Negotiating and drafting IP-related commercial agreements
- Handling key product and service launches and related design-around opportunities and commercial IP strategies

As a reliable advisor to his clients, Jeff has represented enterprises across various industries on technologies such as brand and generic pharmaceuticals, drug delivery devices and materials, petroleum automation technology, behavioral and predictive communication routing and analytics, industrial equipment and processes, automotive polymers, food products and processing, leisure and sporting goods, and more.

Jeff is a trusted business advisor to companies facing competitive headwinds. He has in-depth experience representing clients outside the courtroom to minimize the risk of IP litigation, and to tip the strategic strengths when it cannot be avoided. Jeff prefers to keep clients out of court by obtaining quality patents while considering the latest Federal Circuit and Supreme Court decisions; negotiating and drafting licenses, distribution and other agreements while considering critical client business goals that minimize or even avoid future misunderstandings; and counseling clients on critical IP issues when developing new products and services to reduce risk at the outset.

A registered patent lawyer with a chemical engineering education, Jeff represents clients at the U.S. Patent and Trademark Office; has obtained numerous U.S. and foreign patents; has prepared hundreds of invalidity, non-infringement, patentability, freedom-to-operate, and other product clearance opinions; and has conducted numerous IP diligence evaluations in connection with mergers, acquisitions, and secured financial transactions. Jeff is frequently asked to speak to IP organizations and trade

associations on a variety of topics, including IP issues in mergers and acquisitions, patent prosecution and the effects of the America Invents Act, inter partes review proceedings, and the U.S. Biosimilars regulatory framework.

Clients and colleagues have generously rewarded Jeff with accolades, including recognition in *DC Super Lawyers*, 2013-2022 (Thomson Reuters) for intellectual property. Jeff is AV® Peer Review Rated Preeminent by *Martindale-Hubbell® Law Directory*. He was also honored in *Intellectual Asset Management (IAM) Patent 1000: The World's Leading Patent Practitioners* (Law Business Research), most recently in 2017-2022 for patent prosecution and IP transactions.

In his limited spare time, Jeff volunteers regularly for Brown University alumni interviewing, has served as a college class officer for the last 10 years, and enjoys spending time with his family—including the former teenager and occasionally even the current one.

QUALIFICATIONS

EDUCATION

- J.D., George Washington University Law School, 1995, *with honors*; Executive Managing Editor, *The G.W. Journal of Int'l Law & Economics* (now *Geo. Wash. Int'l Law Review*); Publication Staff, *AIPLA Quarterly Journal*
- Sc.B., Chemical Engineering, Brown University, 1992

ADMISSIONS

- District of Columbia
- Maryland
- U.S. Patent and Trademark Office

COURT ADMISSIONS

- Court of Appeals of Maryland
 - District of Columbia Court of Appeals
 - U.S. Court of Appeals for the Federal Circuit
 - U.S. District Court for the District of Columbia
 - U.S. District Court for the District of Maryland
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PUBLICATIONS AND SPEAKING ENGAGEMENTS

- “Practical Considerations About Russian IP,” author, *Intellectual Property and Technology Law Journal*, July 27, 2022
- “Conducting IP Audits - US Perspective,” speaker, Global IP ConfEx, February 24, 2021.
- “Fast Tracking Your *Ex Parte* Patent Appeals May be Appealing: U.S. Patent and Trademark Office Announces New Pilot Program,” co-author, *Lexology*, July 6, 2020.
- “IP Diligence in Mergers, Acquisitions and Spin-Offs,” speaker, The Adhesive & Sealant Council’s annual conference, April 10, 2019.
- “Licensing Issues,” speaker, 13th Annual Advanced Patent Law Institute, March 1, 2018.
- “Due Diligence in Competitor Licensing,” UT-Advanced Patent Law Institute at the U.S. PTO, March 11, 2016.
- “IP Diligence War Stories & Lessons Learned,” AIPLA Annual Meeting, October 23, 2015.

- “FDA’s Focus On Drug Appearance May Cause Ugly Problems,” co-authored with Evert Tu, *Law360*, August 25, 2015.
 - “FDA Throws the (Purple) Book at Biosimilars - Purple v. Orange,” co-authored with Evert Tu, *The Purple Book*, October 21, 2014.
 - “USPTO’s Final Rejection of a Patent Isn’t So Final,” co-authored with Evert Tu, *Law360*, September 5, 2013.
 - “New And Improved Third-Party Submissions,” co-authored with Tanya Faisal, *Pharmaceutical Online Guest Column*, September 11, 2012.
 - “Proceed With Caution: Does That Employment Agreement Have A Proper IP Assignment?” co-authored with Evert Tu, *Lexology*, June 9, 2011.
 - “‘Abbreviated’ Biologics Applications: The Reality of Providing Biosimilar Products,” co-authored with Evert Tu, *IPO Annual Meeting Conference Materials*, September 12-14, 2010.
 - “Coming to Terms,” author, *nature.com*, February 1, 2010.
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PROFESSIONAL AFFILIATIONS AND ENGAGEMENTS

- Brown Alumni Schools Committee – Alumni Interviewer
 - Communications Co-Chair, Brown University Class of 1992
 - Intellectual Property Owner’s (IPO) Association (Pharmaceutical Issues Committee)
 - American Intellectual Property Law Association (Chemical Practice, PCT, and Patent Law Committees)
 - American Institute of Chemical Engineers
 - D.C. Bar Association
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SELECTED CLIENT REPRESENTATIONS

- Counsel manufacturing and tech concerns as to shifting U.S. patent landscape, AIA, and Patent Office issues.
- Assisted private equity company in acquiring half-a-dozen pharmaceutical pipeline candidates from large brand pharmaceutical enterprise, with a focus on the Clinical Supply Agreements.
- Prepare and prosecute patents for petrochemical services entity to strategically protect a U.S. company’s core products and platform technology, and provide counseling and agreement assistance in support of same.
- Assist Strides Arcolab Limited in the \$1.6 billion sale of its injectables business to Mylan, Inc.
- Assisted KMG Chemicals, Inc. with IP diligence in its \$495 million acquisition of FlowChem and its \$60 million acquisition of OM Group’s UltraPure Chemicals.
- Advise domestic and foreign technology-based clients regarding the scope and strength of numerous chemical and pharmaceutical compositions and processes.
- Counsel pharmaceutical clients regarding patent issues in connection with FDA regulatory filings.
- Negotiate and prepare IP-related agreements for diagnostic testing rights and co-branding licenses in connection with a joint venture transaction in China.
- Counseled government clients on patent issues in loan guarantee project and ethanol wastewater recycling technology.
- Successfully supported trade secret litigation for a domestic manufacturer to recover damages and royalties for misappropriated sorbent technology for flue gas desulfurization.