

Charles W. Calkins

Partner

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Services

Asset Creation - Prosecution &

Counseling

Intellectual Property

Mergers & Acquisitions

Patent Due Diligence

Patents

Post-Grant Proceedings

Industries

Health & Life Sciences

Technology

Charles Calkins practices intellectual property law with a focus on patent law and intellectual property transactions. Mr. Calkins, a registered patent attorney, has more than 25 years of experience in client counseling and portfolio management in patent procurement, licensing and enforcement, primarily in the life sciences, chemical, medical and computer software arts. His current practice includes a focus on the corporate and transactional aspects of intellectual property, including licensing, research and development/joint venture agreements and merger, acquisition and/or equity investment due diligence. He has been involved in well over 100 transactions in a variety of technologies including aerospace, pharmaceuticals, commodity futures trading, medical devices, personalized genetic medicine, semiconductors and DNA sequencing technologies including NextGen sequencing.

Mr. Calkins' experiences allow him to understand the business value of intellectual property and work with clients to maximize return on their investments and/or acquisitions. Mr. Calkins has worked with companies, investment banks, private equity groups, venture capitalists and other institutional investment groups to conduct due diligence and provide counseling relating to potential investments, acquisitions and/or mergers ranging in size from several hundreds of thousands of dollars to more than one billion dollars. In addition to his legal practice, Mr. Calkins is a Chair of the Piedmont Angel Network, an investor in over forty emerging technology companies and active in the regional and national technology communities. He is also past Chair of the Scientific Advisory Board at University of North Carolina Greensboro.

Mr. Calkins is AV® rated by Martindale-Hubbell* and has been named to Business *North Carolina's* "Legal Elite" list. He has been recognized as a North Carolina "Super Lawyer" in the areas of Intellectual Property and Mergers & Acquisitions by *Super Lawyers* magazine. He was recognized in The *Best Lawyers in America*® for

Intellectual Property Law in 2018 and the 11 years immediately preceding and for Biotechnology and Life Sciences Practice, Intellectual Property Litigation, Patent Litigation, and Patent Law in 2019. He was also named a "Greensboro Lawyer of the Year" in 2013, 2015 and 2018 in the area of Patent Law and in 2017 and 2019 for Patent Litigation by The *Best Lawyers in America*[®]. Mr. Calkins was named a "Law Impact Leader" by Business Leader magazine. He was named a "Global IP Luminary" by *IP World* for his exemplary work in the intellectual property legal area. In 2016, Mr. Calkins was recognized among the Triad's "Most Influential" professional executives by the *Triad Business Journal* for the 12th consecutive year. He is listed in the 2019 and the seven immediately preceding editions of *Chambers USA* in the area of Intellectual Property and he is listed in the 2019 and the six preceding editions as #1 in the area of Intellectual Property. Mr. Calkins has been recognized as an "IP Star" in 2019 and the six years immediately preceding by *Managing Intellectual Property* magazine. He was recognized as a top patent practitioner in 2019 and the four years immediately preceding by *IAM Patent 1000 – The World's Leading Patent Practitioners*. Mr. Calkins was recommended by *Legal 500 US* in 2015, 2016 and 2018 for Patent Prosecution and again in 2016 for Patent Portfolio Management and Licensing. He is a former Chair of the North Carolina Bar Association's Intellectual Property Section and remains active on the Section Council.

*CV, BV, and AV are registered certification marks of Reed Elsevier Properties Inc., used in accordance with the Martindale-Hubbell certification procedure's standards and policies.

Experience

Represent a leading clinical laboratory services provider in intellectual property related services, including freedom to operate analyses, patent license negotiation and review, collaborative research and development agreement preparation and analysis, patent prosecution and litigation services and due diligence and pre-litigation counseling. Technologies include clinical diagnostic services; robotics; bioinformatics; genome mapping; genetic testing; gene mapping and counseling; companion diagnostics; blood testing services, and biotechnology.

Represented a major U.S. financial institution its investments and equipment loans to emerging life sciences companies, including performing merger and acquisition due diligence, document preparation and negotiation, and transaction closing work. The due diligence work involved reviewing patent estates and related intellectual property assets, analysis of joint ventures, collaborative research agreement and patent licenses, for technologies including, small and large molecule therapeutics, medical devices, recombinant DNA technologies, microfluidic devices and related laboratory techniques and equipment.

The firm served as lead counsel on behalf of a health care company in the Southern District of Illinois against charges of patent infringement by Document Generation Corporation, an Acacia subsidiary. The lawsuit relates



to electronic medical record technology. Defendants in the case were successful in persuading the U.S. Patent and Trademark Office to reexamine the patent in suit. The litigation is currently stayed pending the outcome of the reexamination proceeding.

Provided intellectual property related services, including patent preparation and prosecution in automotive fabrics, knitwear and medical prostheses' fabrics. We also successfully defended the client's manufacturing contractor in a patent infringement action relating to automotive storage nets (trunk nets). We negotiated a dismissal of the action. We also represent our client in patent counseling, prosecution, and transactional matters, including negotiating contracts with customers and suppliers.

The firm assisted a global supplier of systems and services to the aerospace and defense industries with their acquisition of optical and infrared sensing technology from a privately-held defense contractor. The firm's work included pre-acquisition due diligence relating to the technology and related intellectual property. The firm also assisted in the preparation and review of acquisition and licensing documents in the transaction.

The firm assisted an aerospace manufacturer with their acquisition of semiconductor and infrared sensing technology. The firm's work included pre-acquisition and pre-licensing due diligence relating to the technology and related intellectual property. The firm also assisted in the preparation and review of acquisition and licensing documents in the transaction.

The firm assists one of the world's largest clinical laboratory network's in pre-acquisition and pre-licensing due diligence relating to technology assets, including genetic markers, laboratory technologies and methodologies, microfluidics and related intellectual property. The firm also assists in the preparation and review of acquisition and licensing documents resulting from the due diligence.

The firm assisted one of the world's largest clinical laboratory networks in its acquisition of a leading laboratory automation supplier. Our work included due diligence on the supplier's laboratory equipment and robotics technology. We also assisted with acquisition documents and post-closing transition of the intellectual property.

The firm assisted one of the world's largest clinical laboratory networks in its acquisition of an international biotechnology laboratory. Our work included due diligence on the laboratory's oncology, virology, microfluidics and reagent technology and over 200 related patents and applications. We also assisted with acquisition documents and post-closing transition of the intellectual property.

Represents one of the largest apparel companies in the world in protecting their hosiery, hosiery machinery, knitwear, casual wear, shoes, lingerie and related clothing technologies through the use of patents, trade



secrets, trademarks and copyrights. The firm counsels the apparel company in IP related enforcement and transactional matters including patent and trademark infringement actions, patent licensing, freedom to operate opinions, consulting contracts, patent licenses, invalidity and non-infringement studies, patent enforcement studies and advertising. The firm protects key products worldwide with both design and utility patents and we work closely with the key technical and business personnel to identify and protect innovations with patents to achieve the company's strategic corporate goals. We counsel the company with respect to its overall patent strategy, provide licensing services, and evaluate third-party intellectual property rights.

Represented supplier of aerospace systems and services with patent and intellectual property related transactional issues in merger and acquisition transactions including due diligence and agreement drafting and negotiation. The firm also provided patent counseling, including non-infringement and freedom to operate counseling, and patent acquisition services. Technologies include remote sensing, optics, semiconductors and aluminum alloys.

Represented a Massachusetts consulting firm in the preparation and negotiation of an asset purchase agreement wherein they sold patent assets and related underlying financial services product technology.

Represents a *Fortune* 200 global consumer goods corporation and provides advice related to protecting their food production processes and packing and food product technologies through the use of patents, trade secrets, trademarks, and copyrights. Additionally, we provide advice related to enforcement and transactional matters including patent and trademark infringement actions, patent licensing, freedom to operate opinions, consulting contracts, patent licenses, invalidity and non-infringement studies, and patent enforcement studies.

Represent Wake Forest University Health Sciences in preparing and prosecuting numerous U.S. and international patent applications, including applications relating to cancer diagnostics and/or treatment, the treatment of neuronal dysfunction. For example, patents have been granted for methods to prevent neurodegeneration, to detect elevated MAP-2 in melanoma, and the use of angiotensin antagonists to treat cancer. Also, the firm assisted with patent license counseling and negotiation, inventorship disputes, and inter-university agreement negotiations.

Advised a global chemical company in patent acquisition, including patent application preparation and prosecution in the U.S. and foreign countries, for their carbon black, polymer emulsion, masterbatch, and polymer compositions inventions. The firm has appeared with the company in proceedings in the U.S. and European Patent Offices. Additionally, we have assisted the company with patent acquisition in the tantalum, niobium, and uranium ore processing, disposal, products and related technologies, and fumed silica technologies.



Education

Boston University, J.D. (1984)

Massachusetts Institute of Technology, S.B., Chemical Engineering & Life Sciences

Admissions

District of Columbia (1989)

Massachusetts (1985)

North Carolina (1995)

Court Admissions

U.S. Patent and Trademark Office

Professional & Community Activities

North Carolina Bar Association Intellectual Property Section, Section Council Member and Past Chair

University of North Carolina Greensboro, Scientific Advisory Board

AIPLA, Biotech/Diagnostic Subcommittee

Greensboro Symphony Orchestra, Board Member

Raven's Pursuit, Board Member

The Prairie Club, Board Member

Piedmont Angel Network, Co-Chair

Insights

[News Releases](#)

Kilpatrick Townsend Receives High Rankings in 2019 IAM Patent 1000

July 11, 2019

[News Releases](#)

Kilpatrick Townsend Receives Top Rankings from 2019 Legal 500 US

July 10, 2019

[News Releases](#)

Kilpatrick Townsend Attorneys Named 2019 Managing Intellectual Property IP Stars

June 17, 2019



[In The News](#)

35 Kilpatrick Townsend Attorneys Named to the North Carolina Pro Bono Honor Society

May 24, 2019

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Kilpatrick Townsend Achieves Top-Tier Recognition from Chambers USA 2019

May 2, 2019

[In The News](#)

Kilpatrick Townsend Launches Extranet Patent Tool

February 4, 2019

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Kilpatrick Townsend Attorneys Named 2019 North Carolina Super Lawyers

January 28, 2019

[In The News](#)

New Kilpatrick Townsend Portal Helps Clients Check Patent Statuses, Deadlines On the Fly

January 25, 2019

[News Releases](#)

Kilpatrick Townsend Launches State-Of-The-Art Patent Prosecution Extranet for Clients

January 22, 2019

[News Releases](#)

Best Lawyers in America® Names Kilpatrick Townsend Attorneys 2019 Lawyers of the Year

August 21, 2018

[In The News](#)

Record-Breaking Recognition for Kilpatrick Townsend in The Best Lawyers in America® 2019

August 20, 2018

[News Releases](#)

Kilpatrick Townsend Recognized in 2018 IAM Patent 1000

July 2, 2018



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Kilpatrick Townsend Attorneys Named 2018 Managing Intellectual Property IP Stars
June 19, 2018

[News Releases](#)

Kilpatrick Townsend Achieves Recognition From Chambers USA 2018
May 11, 2018

[News Releases](#)

Forty-Four Kilpatrick Townsend Attorneys Named to 2017 - 2018 International Who's Who of Business Lawyers
March 19, 2018

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Kilpatrick Townsend Attorneys Named 2018 North Carolina Super Lawyers
February 6, 2018

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Best Lawyers in America® Names Kilpatrick Townsend Attorneys 2018 Lawyers of the Year
August 16, 2017

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Kilpatrick Townsend Attorneys Named 2017 Managing Intellectual Property IP Stars
June 27, 2017

[News Releases](#)

Kilpatrick Townsend Receives High Rankings in 2017 IAM Patent 1000
June 8, 2017

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Kilpatrick Townsend Achieves Recognition From Chambers USA 2017
May 30, 2017

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Kilpatrick Townsend Attorneys Named 2017 North Carolina Super Lawyers
January 30, 2017



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Kilpatrick Townsends Steve Berlin and Charles Calkins Once Again Named “Most Influential People” in the Triad
November 8, 2016

[In The News](#)

Kilpatrick Townsend's Media Report, October 22 - November 4, 2016
November 7, 2016

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Best Lawyers in America Names Kilpatrick Townsend Attorneys 2017 Lawyers of the Year
August 24, 2016

[News Releases](#)

Kilpatrick Townsend Earns Record-Breaking Recognition in Annual Best Lawyers in America 2017
August 16, 2016

[Alerts](#)

“Patents 4 Patients”: A New Cancer Immunotherapy “Fast Track” for U.S. Patent Applicants
July 6, 2016

[News Releases](#)

Kilpatrick Townsend Recognized by Prestigious 2016 Legal 500 US
June 20, 2016

[News Releases](#)

Kilpatrick Townsend Attorneys Named to 2016 IAM Patent 1000
June 2, 2016

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Kilpatrick Townsend Once Again Achieves Recognition From Chambers USA 2016
May 31, 2016

[News Releases](#)

Thirty-Two Kilpatrick Townsend Attorneys Named 2016 Managing Intellectual Property IP Stars
May 26, 2016



Events

Current Issues in Patent Licensing

February 24, 2016

News Releases

Kilpatrick Townsend Attorneys Named 2016 North Carolina Super Lawyers

January 15, 2016

In The News

Kilpatrick Townsend's Media Report November 6-19, 2015

November 20, 2015

News Releases

Kilpatrick Townsends Steve Berlin and Charles Calkins Named 2015 Most Influential in the Triad

November 13, 2015

In The News

Kilpatrick Townsend's Media Report October 2-8, 2015

October 9, 2015

News Releases

Kilpatrick Townsend Earns Record-Breaking Recognition in Annual Best Lawyers in America 2016

August 19, 2015

News Releases

Kilpatrick Townsend Recognized by Prestigious 2015 Legal 500 US

July 15, 2015

In The News

Kilpatrick Townsend's Media Report June 19-25, 2015

June 26, 2015

News Releases

Twenty-Two Kilpatrick Townsend Attorneys Named to 2015 IAM Patent 1000

June 18, 2015



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Kilpatrick Townsend Once Again Achieves Recognition From Chambers USA 2015

May 22, 2015

[News Releases](#)

Twenty-Nine Kilpatrick Townsend Attorneys Named 2015 Managing Intellectual Property IP Stars

May 6, 2015

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IPRs and Exclusively Licensed Patents - Questions Regarding Real Parties in Interest

March 12, 2015

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Kilpatrick Townsend Attorneys Named 2015 North Carolina Super Lawyers

January 28, 2015