

Jeffrey T. Gendzwill

Partner

607 14th Street, NW

Suite 900 , Washington , DC USA 20005

t 202.481.9924 | f 202.379.3462

jgendzwill@kilpatricktownsend.com

Services

Adversarial Patent ProsecutionSM

Asset Creation - Prosecution &
Counseling

Intellectual Property

ITC Section 337

Licensing, Transactions &
Monetization

Market Protection - Opinions &
Dispute Avoidance

Patents

Post-Grant Proceedings

Trade Secrets

Industries

Energy

Health & Life Sciences

Retail & Consumer Goods



Jeffrey Gendzwill is a registered patent attorney who concentrates his practice on patent-related matters with a focus on client counseling, portfolio strategy and management, US and foreign patent preparation/prosecution, post grant proceedings and enforcement. Mr. Gendzwill's 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. Mr. Gendzwill also has extensive experience preparing complex patentability, invalidity, non-infringement, and freedom-to-operate opinions, as well as state-of-the-art analyses.

Prior to joining the firm, Mr. Gendzwill was a shareholder in a Virginia IP boutique firm where his areas of practice included client counseling, portfolio management, opinions, licensing and patent preparation/prosecution. Before that, Mr. Gendzwill was an associate at both a Washington, D.C. office of a large Chicago-based firm and at a mid-sized firm in metro-Detroit, where he handled patent portfolios for automotive manufacturers and component suppliers. Prior to launching his legal career, Mr. Gendzwill 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.

Mr. Gendzwill is a frequent speaker on many IP law issues including post-*Alice Corp.* patent eligibility and joint infringement jurisprudence. He recently presented *Helsinn v. Teva; Filing Strategies in China: Don't Forget the Utility Model*; and *Streamlined PCT Prosecution Strategies* to a professional group at an industry-leading packaging specialty company's IP headquarters. He also has presented on *Patent Monetization: Options in Patent Sales* for various clients.

Experience

Representing Ascend Performance Materials, the world's largest fully integrated producer of nylon-6,6, working hand-in-hand to help them define a robust IP footprint in various spaces as they create innovative approaches and solutions for its numerous technology platforms. We have worked and continue to work 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, we also helped Ascend navigate multiple third party patent matters, both in the U.S. and worldwide. On the litigation front, we strategize with legal, technology, and business teams on enforcement matters including potential infringement suits (offensive and defensive), as well as invalidation and opposition proceedings in the U.S. and worldwide.

Representing 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. We also provide counsel regarding global enforcement strategies, licensing opportunities, and navigation of third party patent rights – including opposition and invalidation proceedings before foreign patent offices.

Representing 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. We work to build out the IP portfolio for two of its three core business groups. In addition to IP development, we also have an outstanding track record handling post-grant proceedings before the Patent Trial & Appeal Board. We also provide counsel regarding global enforcement strategies, licensing opportunities, and navigation of third party patent rights – including opposition and invalidation proceedings before foreign patent offices.

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



Paraguay.

Serving as counsel for Ascend Performance Materials in IPR proceedings and global invalidation proceedings challenging U.S. Pat. No. 9,819,057 and its foreign equivalents, owned by Samsung SDI Co., Ltd. The IPR Petition has been filed and we are awaiting Patent Owner's Preliminary Response. PTAB Case Number IPR2020-00349.

Successfully secured denial of post-grant review (PGR) of U.S. Pat. No. 9,989,684 relating to near infrared optical interference filters for Materion Corporation. 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.

Served as counsel for Celanese International Corp. in IPR proceedings wherein we successfully challenged 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 client 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.

Education

University of Detroit Mercy School of Law, J.D. (2004) *magna cum laude*

University of Michigan, B.S., Chemical Engineering (1993)

Admissions

District of Columbia (2008)

Michigan (2005)

Court Admissions

U.S. Patent and Trademark Office (2004)

U.S. District Court for the Eastern District of Michigan (2014)

Professional & Community Activities

Kilpatrick Townsend & Stockton D.C. Veterans Initiative, Steering Committee, Member



Insights

[Perspectives](#)

Patent Monetization: Options in Patent Sales

October 1, 2019

[In The News](#)

Kilpatrick Townsend's Media Report February 27-March 5, 2015

March 6, 2015

[In The News](#)

Kilpatrick Townsend's Media Report February 6-12, 2015

February 13, 2015

[News Releases](#)

Kilpatrick Townsend Adds Chemistry and Life Sciences Team in DC

February 3, 2015