



## JAMES M. HEINEN, JR.

**PARTNER, INTELLECTUAL PROPERTY PRACTICE  
GROUP LEADER**

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Jim Heinen, Jr., leads Armstrong Teasdale's Intellectual Property practice group, which consists of more than 100 multitalented lawyers and staff professionals, many of whom hold advanced scientific degrees and are experienced in all facets of IP law including patent preparation, prosecution and litigation. In his legal practice, Jim focuses on the preparation and prosecution of U.S. and foreign patent applications for those in a broad range of diverse technologies.

Licensed to practice before the U.S. Patent and Trademark Office, Jim also has extensive experience in all facets of patent matters, not only in the preparation and prosecution of applications but also in opinion-related work, including freedom-to-operate, patentability, state-of-the-art searching and white-space analysis. His experience also includes post-grant proceedings, including inter partes reviews, validity assessments, foreign oppositions and patent term analysis comprising the calculation of term adjustments and expiration dates. His client list includes large corporations, emerging and startup companies, and individual inventors. Jim also supports numerous universities, both public and private, and tech-transfer offices on their patent portfolios.

Jim's experience involves a variety of subject matters spanning a broad range of chemical and biochemical technologies, such as pharmaceuticals, small molecule design, trace detection systems, nanotechnologies, medical devices, cardiology and vascular access products, herbicides, pesticides, fungicides, rice breeding technology, polymeric materials, skin science and technology, personal care articles and formulations, electrochemical cells, pediatric and adult nutritionals, microencapsulation, semiconductor materials, creative packaging solutions, bottle/container/closure technology and design.

Active in firm management, Jim is a member of Armstrong Teasdale's Hiring Committee. In addition, he served as leader of the firm's Higher Education industry team, and leader of the Patent Agent/Engineer subgroup, overseeing the hiring, training and development of patent agents and patent engineers/scientists.

### EDUCATION

- University of Maryland School of Law (J.D., *cum laude*, 2006)
- Miami University - Oxford, Ohio (B.A., 2003)
  - Chemistry

### SERVICES AND INDUSTRIES

Intellectual Property  
Post Grant Proceedings  
Patent  
Higher Education

### ADMISSIONS

Missouri  
Virginia  
District of Columbia  
U.S. Patent and Trademark  
Office  
U.S. District Court, Eastern  
District of Virginia

## PROFESSIONAL ACTIVITIES

- Virginia State Bar
- District of Columbia Bar
- American Intellectual Property Law Association (Mentoring Program, 2012-2014)
- St. Louis Sports Commission Associates
- Armstrong Teasdale Hiring Committee
- Armstrong Teasdale Patent Agent/Engineer Subgroup (Leader, 2013-2020)
- Armstrong Teasdale Higher Education Industry Team (Leader, 2018-2020)

## CHARITABLE AND CIVIC INVOLVEMENT

- Miami University Alumni Association, St. Louis Chapter (President, 2009-2014)

## ACCOLADES

- Up & Coming Award, Missouri Lawyers Media (2018)
- Selected as Mentor for the American Intellectual Property Law Association (2012-2014)

## BACKGROUND

Prior to attending law school, Jim interned as a chemist for The Sherwin-Williams Co. at the Breen Technology Center. Prior to joining the firm, he was an attorney at a Washington, D.C., law firm.

## EXPERIENCE

### **Filed University's First Ever Patent Applications**

Filed the first ever patent applications for a university client. Worked with the university to create and implement internal intellectual property procedures for the client.

### **Inter Partes Review for Multinational Security Company**

Handled four different *inter partes* reviews for multinational company specializing in security and identity solutions.

### **IP Due Diligence Review for Billion-Dollar Fragrance, Flavors Company**

Managed large IP due diligence review for a billion-dollar fragrance and flavors company leading up to a significant acquisition.

### **Pharmaceutical Patent Portfolio for University**

Managed pharmaceutical patent portfolio that includes filings in over 16 different countries. Worked with university and licensee on achieving patent protection worldwide.

### **Successful Chemical Plant Clearance**

Cleared all chemical engineering processes and related products for a major chemical

plant in the U.S. for one of the largest international chemical producers in the world.

**Due Diligence for Multinational Chemical Company**

Managed significant due diligence project for multinational chemical company. The project included clearing the client's product through a freedom-to-operate opinion and also identifying any potentially problematic references owned by competitors.

**Prepared Invalidity Opinions for Client's New Product Release**

Prepared over a dozen invalidity opinions on competitors' patents that presented a potential issue for a global client's release of a new product.

**IP Due Diligence in \$3.4 Billion Acquisition of Medical Device Manufacturer**

Led IP due diligence for a major medical device company, including in-depth research and analysis of both the target company and its competitors, resulting in our client's decision to move ahead with its \$3.4 billion acquisition of a medical device manufacturer.

**Successful Product Clearance in China, India and Indonesia**

Cleared an entire consumer product line in China, India and Indonesia for one of the largest food companies in the world.

**Conducted Competitive Strategy Projects for Pharmaceutical Company**

Ran year-long competitive strategy projects for multinational client. The projects included in-depth analyses and presentations on competitors' complete intellectual property portfolios, including freedom-to-operate positions, invalidity opinions and strategic patent application filings to gain a competitive edge.

**Patent Portfolio Review for Multinational Client**

Conducted a week-long review of every patented product of a multinational client's portfolio at their facilities. After the review, prepared an in-depth analysis of the patent term/life of each of the respective products.