



JAMES M. HEINEN, JR.

PARTNER

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Jim Heinen, Jr. is a member of the firm's Intellectual Property practice group, serves as leader of the firm's Higher Education industry team, and leads the Patent Agent/Engineer subgroup. He is registered to practice before the U.S. Patent and Trademark Office and focuses on the preparation and prosecution of U.S. and foreign patent applications for those in the chemical and biochemical industries.

Jim also has extensive experience 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. Jim also supports numerous universities, both public and private, and tech-transfer offices on their patent portfolios.

As leader of the Patent Agent/Engineer subgroup, Jim oversees the hiring, training and development of patent agents and patent engineers/scientists.

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, polymeric materials, skin science and technology, personal care articles and formulations, electrochemical cells, pediatric and adult nutritionals, microencapsulation, and semiconductor materials.

EDUCATION

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

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

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

- Armstrong Teasdale Patent Agent/Engineer Subgroup (Leader)
- Armstrong Teasdale Higher Education Industry Team (Co-Leader)

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.

THOUGHT LEADERSHIP

February 5, 2019

Patent Term Adjustment Calculations Changing – Will the Supernus Pharmaceuticals v. Iancu Decision Stand?

January 21, 2014

Patent Term Adjustment Update - Novartis v. Lee