

Rolando Medina, PhD

Partner

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EDUCATION

University of Pittsburgh
School of Law
JD, 2003, *cum laude*

Yale University
PhD, 1999, *Neuroscience*
MPhil, 1996, *Neuroscience*

Westminster College of Salt Lake City
BS, 1993, *Biology and Chemistry*,
magna cum laude

Rolando Medina has broad experience in intellectual property, including patent prosecution, opinions, due diligence studies, IP counseling and licensing in biotechnology and the medical sciences. Dr. Medina has experience representing academic universities and start-up companies, as well as mid-sized and large biotechnology and pharmaceutical companies. In 2017, he was named to *Who's Who Legal's* list of top Life Sciences transactional attorneys.

PRACTICE FOCUS

Intellectual Property Protection

Preparation and prosecution of patent applications, portfolio management and counseling, with particular experience in novel genes, antibodies, gene therapy, vaccines, antisense, stem cells, pharmaceutical formulations, peptide and antibody display technologies, nanotechnology, biofuels and potential treatments and diagnostic methods for various diseases.

Post Grant Proceedings

Represents clients in AIA post-grant review proceedings, including inter partes review and post-grant review proceedings.

Opinions and Due Diligence

Landscape and freedom-to-operate analyses; non-infringement and invalidity opinions; IP due diligence reviews in the context of mergers and acquisitions, venture capital financings, internal audits and licensing.

Technology Transactions

Negotiating and drafting various technology related agreements, including licenses, material transfer agreements and consulting agreements.

PREVIOUS EXPERIENCE

Dr. Medina was an associate at several Boston law firms where he focused on U.S. and foreign biotechnology patent prosecution, portfolio management, due diligence and opinion analyses and licenses. During law school, he was a research assistant for Professor Karen Engro.

ADMISSIONS

Massachusetts

U.S. Patent & Trademark
Office

PRACTICE AREAS

Intellectual Property
Protection

Life Sciences

His research involved the Americans with Disabilities Act in relation to HIV-based discrimination. He was a Postdoctoral Fellow in the Laboratory of James M. Anderson at Yale University School of Medicine, researching occludin function in epithelial cell tight junctions. As a graduate student in the Laboratory of Catherine H. Berlot at Yale University School of Medicine, his research involved structure/function analysis of the interactions of heterotrimeric G protein subunit, Gq α , with phospholipase C.

REPRESENTATIVE ENGAGEMENTS

Patent Prosecution and Counseling

- Managed and counseled on complex patent portfolios related to products in clinical trials for mid-sized biotech company.
- Performed due diligence and negotiated and drafted complex license agreement on behalf of start-up public company.
- Created strategic patent portfolio for start-up biofuel company leading to successful financing round.
- Assisted mid-sized biotech company with license and transfer of technology for creation of joint venture.
- Assisted in obtaining patent term extension due to regulatory delay for mid-sized biotech company.

Patent Trial and Appeal Board and Appellate Proceedings

- *Kashiv BioSciences, LLC v. Amgen Inc., PTAB*: Counsel for Kashiv in IPR proceedings challenging patents relating to methods of protein refolding and purification.
- *Guardant Health, Inc. v. Foundation Medicine, Inc., PTAB*: Counsel for Foundation Medicine in IPR proceedings defending patents protecting innovative comprehensive genomic cancer assays using next generation sequencing.
- *Foundation Medicine, Inc. v. Guardant Health, Inc., PTAB*: Counsel for Foundation Medicine in IPR proceedings challenging patents directed to methods for detecting genetic mutations.

PUBLICATIONS AND PRESENTATIONS

- "Biologics and Biosimilars," *moderator*, Life Sciences Patent Network North America, April 2019.
- "Does the US Government Have Rights to Your IP Under Bayh-Dole?," *moderator*, Life Sciences Patent Network North America, April 2018.
- "The Noneffect of Myriad on Personalized Medicine," *co-author, IP Law360*, July 2013.

PROFESSIONAL AND COMMUNITY INVOLVEMENT

Dr. Medina is a member of the Boston Bar Association, the Boston Patent Law Association, and is a former co-chair and board member of the Massachusetts LGBTQ Bar Association. Dr. Medina currently serves on the BBA's Diversity & Inclusion Section Steering Committee.