

## Rolando Medina, PhD

### Partner



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#### Practice Areas

Life Sciences  
Intellectual Property Prosecution  
Intellectual Property Strategies

#### 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*

#### Admissions

Massachusetts  
U.S. Patent & Trademark Office

Dr. Rolando Medina has extensive experience representing academic universities and start-up companies, as well as mid-sized and large biotechnology and pharmaceutical companies in intellectual property, including patent prosecution, opinions, due diligence studies, IP counseling, and licensing in biotechnology and the medical sciences. This includes advising clients on a broad range of patent matters, including the 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.

Rolando has led hundreds of 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. He also routinely provides advice to clients in AIA post-grant review proceedings, including inter partes review and post-grant review proceedings.

Prior to law school, Rolando 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 $\alpha$ , 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

- “Going Global: How Can You Maximize the Potential of Your International IP Portfolio,” moderator, Life Sciences Patent Network North America, May 2023
- “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*

## Professional and Community Involvement

- Member, Boston Bar Association
- Member, Boston Patent Law Association
- Former Co-Chair and Board Member, Massachusetts LGBTQ Bar Association
- Member, Boston Bar Association Diversity & Inclusion Section Steering Committee

## Recognition

- A World’s Leading Patent Practitioner by *IAM Patent 1000* (2022-2023)
- *Who’s Who Legal’s* list of top Life Sciences transactional attorneys
- “Patent Star” by *Managing Intellectual Property* (2019-2023)