

## Michael A. Shinall

### Principal



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#### Practice Areas

Intellectual Property Protection  
 Complex Intellectual Property Disputes  
 Life Sciences

#### Education

Boston College Law School  
 JD (2013)  
 Senior Editor, *International & Comparative Law Review*

Boston University  
 MA (2009) Organic Chemistry

Fairfield University  
 BS (2007)

#### Admissions

Massachusetts  
 U.S. District Court, Massachusetts  
 U.S. Patent and Trademark Office

Michael Shinall, using his industry and research experience in the fields of chemistry and pharmaceuticals, works with clients to develop strategies to protect their technology and business assets. His practice focuses on patent portfolio management, post-grant proceedings, and licensing/transactional agreements.

Michael has assisted a wide variety of clients, big and small, from maintaining worldwide patent coverage for approved small molecule therapeutics, to establishing foundational IP to build value for a new company. He also counsels clients on lifecycle management of their critical programs, and works with clients to identify creative solutions to protect their valuable assets.

In addition, Michael advises clients on contentious matters in the United States (including *inter partes* review and post-grant review proceedings), as well as extensions of those proceedings outside the U.S., such as third party observations in Europe. His clients include Progenics Pharmaceuticals, Forma Therapeutics, Saudi Arabian Oil Company, Olema Oncology, and Casma Therapeutics.

#### Industry Experience

Before law school, Michael was a medicinal chemist at AstraZeneca, where he designed and synthesized molecules for use as potential cancer therapeutics. In graduate school, Michael worked both on novel synthetic methods, as well as natural product synthesis. The majority of his work focused on visible light photoredox catalysis utilizing Ru(bpy)<sub>3</sub>Cl<sub>2</sub> to promote an intramolecular radical addition to indoles and other organic compounds.

#### Representative Engagements

##### Prosecution, Counseling, and Diligence

- Prepares patent applications in the subject areas of chemistry, pharmaceuticals, and materials science for prosecution globally.
- Counsel and executed strategy to obtain broad formulation claims for product-stage small molecule therapeutic.
- Develop strategy for companies developing companion diagnostics.
- Represented multiple pharmaceutical companies as IP counsel in initial public offerings.
- Performed IP due diligence analyses and opinions for initial public offerings on behalf of private companies.
- Counsel for clients seeking collaboration agreements for research and clinical development.

## Contentious Matters

- Counsel for Progenics Pharmaceuticals, Inc. in a PGR proceeding challenging a patent directed to compounds for preparing <sup>18</sup>F-radiolabeled Prostate-Specific Membrane Antigen (PSMA)-targeting conjugates.
- Counsel for Saudi Arabian Oil Company in an IPR proceeding challenging a patent directed to polycarbonates.
- Assist with strategy in ex-U.S. suit brought by client against foreign entity related to radiopharmaceuticals through analysis of data, art, and expert declarations.
- Prepare arguments for third party observations for pharmaceutical company in Europe.
- Analyzed art and worked directly with expert to assist in preparation of expert report, and assisted with the preparation of demonstratives for jury trial in patent litigation.

## Publications and Presentations

- “The Secrets to PTAB Success: Advanced IPR Strategies,” panelist, IPWatchDog: PTAB Masters, February 2023
- “2022 Trends at the PTAB,” speaker, Boston Patent Law Association’s Annual Intellectual Property Symposium, June 2022
- “Priority and Disclosure: Challenges and Protections to Small Inventors in a First-to-File World,” author, *94 Journal of the Patent & Trademark Office Society* 362

## Professional and Community Involvement

- Member, Boston Patent Law Association
- Member, PTAB Bar Association
- Member, Boston Bar Association
- Category 1 cyclist on the Green Line Velo/Zipcar Elite Cycling Team