

John J. Cahill, Jr., MBA, PhD

Associate

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Dr. Jay Cahill provides clients with strategic advice backed by a first-hand, practical understanding of technology, engineering and management to assist clients in achieving their goals. Having nearly 15 years of experience as a scientist and engineer with great emphasis on product development, Dr. Cahill provides a wide-ranging technical skill set and knowledge. He excels at combining his technical expertise and a sophisticated business understanding to provide innovative solutions for clients.

EDUCATION

Seton Hall University School of Law
JD, 2010

Tulane University
PhD, 1999, *Physical Chemistry*

Loyola University
MBA, 1998

Saint Anselm College
BA, 1994, *Biochemistry*

PRACTICE FOCUS

Intellectual Property Protection

Preparation and prosecution of patent applications; opinion drafting and counseling assessing patent validity, infringement, freedom to operate, and patentability of inventions; due diligence and strategic assessment of patent portfolios.

Complex Intellectual Property Disputes

Participating in all aspects of patent litigation along with advising litigation teams on technical scientific concepts.

PREVIOUS EXPERIENCE

Prior to joining Choate, Dr. Cahill practiced in the intellectual property department of a well-respected Mid-Atlantic law firm prosecuting patents, providing patent opinion and counsel across a varied technology space, and litigating as a core member in several major patent disputes.

Prior to attending law school, Dr. Cahill spearheaded design and development of semiconductor diode based laser systems for medical/surgical device applications, satellites, and telecommunications. In this capacity, Dr. Cahill worked with customers in design, development of semiconductor laser package, optics array and component assembly while managing manufacture, testing and long term reliability studies for commercial deployment. He has extensive experience with development and operation of MBE and MOCVD system and a wide variety of semiconductor processing and laser test equipment. Dr. Cahill also gained valuable experience drafting FDA CDRH and FDA 510(k) regulatory submissions and research proposals.

ADMISSIONS

Massachusetts

New York

U.S. Patent & Trademark
Office

PRACTICE AREAS

Intellectual Property
Protection

Life Sciences

Complex Intellectual
Property Disputes

As a Graduate Student and Post-Doctoral Research Associate, Dr. Cahill earned knowledge and expertise in the chemistry of materials, deposition and characterization of III-V semiconductor materials and metals, UHV, optics and lasers. He also led a Smith-Kline Beecham funded study covering Tamoxifen to discover the active components remaining in the body and their lifetime.

REPRESENTATIVE ENGAGEMENTS

- Prepared and prosecuted patent applications directed to medical devices, small molecule pharmaceuticals and methods, semiconductor materials, optical arrays, software system and computer-implemented methods, and fuel cell materials.
- Analyzed and prepared due diligence reviews of patent portfolios, including covering medical/surgical device portfolio and oil/gas turbine portfolio.
- Researched and drafted opinions regarding patent validity, patent infringement, freedom to operate, and patentability, including covering optical component, semiconductor and canine vaccine.
- Participated in prosecution of *inter partes* reexamination proceeding concerning food packaging.
- Developed arguments and substantively drafted opening and reply claim construction briefs in defense of infringement claim regarding chemical composition.
- Drafted expert reports in support of invalidity of claims directed to desiccant composition and non-infringement of accused product.

PUBLICATIONS AND PRESENTATIONS

- "Patent Claim Construction of Enantiomers," *author, Tulane Journal of Technology and Intellectual Property Law*, 2012.
- "Scope of Section 337's Jurisdiction with Respect to Process Patents: Does It Reach Intermediates of an Imported End Product?," *co-author, Section 337 Reporter*, 2009.
- "Development of a Method for Investigating Carbon Removal Processes During Photoassisted Film Growth Using Organometallic Precursors: Application to Platinum," *co-author, Journal of Vacuum Science and Technology, A: Vacuum, Surfaces and Films*, 2007.
- "Design and Performance of 980 nm Pump Laser Modules Exhibiting Greater than 400 mW Kink-Free Fiber-Coupled Power," *co-author, Proceedings and Presentation, Optical Fiber Conference*, 2002.
- "On the Fate of Laser-Produced NH₂ in a Constrained Pulsed Expansion of Trimethylamine Alane and NH₃," *co-author, Chemical Physics Letters*, 2001.

- “Laser-Assisted Room Temperature Film Growth Using a Constrained Pulsed Nozzle Expansion,” *co-author, Chemistry of Materials*, 2000.

Dr. Cahill is an inventor on United States Patents 7,660,335 and 7,944,955.

PROFESSIONAL AND COMMUNITY INVOLVEMENT

Dr. Cahill is a member of the American Bar Association and the Licensing Executives Society.