

Stephanie L. Schonewald, PhD

Counsel

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Stephanie Schonewald counsels biotech and pharmaceutical companies on the strategic development of patent portfolios and patent prosecution.

Prior to joining Choate, Dr. Schonewald was as an associate for a law firm in Washington DC, where she focused on AIA post grant proceedings. Dr. Schonewald has handled over 30 *inter partes* review and covered business method review proceedings. Dr. Schonewald counseled clients regarding intellectual property portfolio management and patent prosecution strategy, and drafted patent applications for biotechnology, pharmaceutical, nanotechnology, medical devices and mechanical devices.

Dr. Schonewald also participated in district court patent litigation. In that capacity, she defended depositions of fact, expert and 30(b)(6) witnesses, prepared witnesses for deposition and trial testimony, as well as drafted pleadings, memoranda, dispositive motions and briefs, invalidity and non-infringement expert reports and discovery.

#### **EDUCATION**

University of Denver Sturm College of Law JD, 2009

University of Colorado at Denver Health Sciences Center PhD, 2006, *Biochemistry, Molecular Genetics* 

University of Northern Iowa BS, 2000, *Chemistry, summa cum laude* 

# PRACTICE FOCUS

#### **Intellectual Property Protection**

Drafts and prosecutes complex patent applications in US and foreign jurisdictions, drafts third party submissions and protests to challenge competitor applications, represents clients in appeals to the Patent Trial and Appeal Board, drafts supplemental examination requests, designs and analyzes patentability and freedom to operate searches, conducts due diligence analysis and provides general counseling regarding intellectual property portfolio management and patent prosecution strategy.

#### **Post Grant Proceedings**

Represent clients in AIA post grant review proceedings, including *inter partes* reviews. Consults with clients regarding European Oppositions.

## **Complex Intellectual Property Disputes**

Conducts pre-litigation validity and infringement analysis. Advises litigation teams on technical aspects.

#### **ADMISSIONS**

Massachusetts

Maryland

District of Columbia

U.S. District Court, Eastern District of Texas

U.S. Patent & Trademark Office

### **PRACTICE AREAS**

Intellectual Property Protection

# REPRESENTATIVE ENGAGEMENTS

- Representation of biotech companies in defending their patents in inter partes review.
- Counseled a large immunology company in defending its patents and challenging its competitors' patents involved in European Oppositions.
- Defended two patents through Supplemental Examination.
- Preparation and global prosecution of patent applications directed to diagnostic and therapeutic products including antibodies, gene therapies, vaccines, stem cells, pharmaceutical formulations, nanotechnology, nucleic acid molecules, biologics, medical devices, mouse platforms for antibody development, and methods of treating diseases.
- Conducted prior art searches and drafts opinions.

# PUBLICATIONS AND PRESENTATIONS

- "Networking for Young Lawyers," webinar panelist, the Federal Circuit Bar Association, January 2019.
- "PTAB Practice Post-SAS: What You Need To Know," moderator, Boston Bar Association, December 2018.
- "Post-Grant Amendments at the USPTO," panelist, Boston Patent Law Association, June 2017.
- "Practical Tips For Tackling Your First Couple of Years As An Associate," *panelist*, Federal Circuit Bar Association, February 13, 2017.
- "Will The Pendulum Swing Back In IPR Proceedings?", co-author, IP Law360, April 2015.
- "AIA Post-Grant Proceedings: Multiple Petitioners Filing a Single Petition Must Present their Case with a 'Single Voice,'" co-author, February, 2014.
- "AIA Post-Grant Proceedings: Rejection of Invalidity Defenses at District Court did not Prohibit PTAB's Later Finding of Unpatentability," co-author, February 2014.
- "The Mouse TrkB mRNA Contains Two IRESes that are Differentially Regulated," co-author, PLoS ONE, September 2008.
- "Identification of Intrinsic and Extrinsic Determinants that Regultae Internal Initiation of Translation Mediated by the FMRI 5' Leader," *co-author, BMC Mol. Bio.,* October 2008.
- "Mock Appellate Argument," co-presenter, AUTM-LES Joint Meeting, March 14, 2012.
- "Diverse Career Paths," panelist , Federal Circuit Bar Association, September 18, 2012.

## PROFESSIONAL AND COMMUNITY INVOLVEMENT

Dr. Schonewald is a member of Boston Intellectual Property American Inn of Court and Boston Patent Law Association.