

# Philip A. Kunz

## Partner

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## OVERVIEW

Philip A. Kunz is a USPTO registered patent attorney who concentrates his practice on patent portfolio management and counseling, opinion work, due diligence, and domestic and international patent prosecution in the areas of mechanical, electrical, software, business method, and electromechanical arts. He is also active in patent litigation counseling for disputes involving both United States and European patents. He has led intellectual property due diligence counsel on over 10 transactions each with values exceeding US$1 billion.

Phil has vast experience as a strategic team leader and supervisor for portfolio management and patent counseling related to an array of technologies, including mechanical and electrical arts, computer and software, and chemical and pharmaceutical compounds. He regularly conducts portfolio analyses and collaborates with clients to identify competitor technology and IP, evaluate offensive and defensive portfolios for strategic licensing and/or acquisition opportunities, and provides client business units with competitor commercial intelligence informed by patent literature. Additionally, Phil drafts and prosecutes domestic and international patent applications involving a wide range of technologies. He has advised on patent prosecution strategy for dozens of portfolios containing several thousand US and foreign patents for clients ranging from start-ups to large multinational corporations.

Phil's licensing experience includes advising clients on joint ventures, NDAs, patent acquisition and divestiture, and structuring creative covenants, cross-licenses, or royalty programs to settle or avoid litigations with competitors. He has counseled a client in negotiating, identifying, and valuing individual IP assets of a cross-licensing settlement agreement that included over 100 US and foreign patents, applications, nine domestic and foreign litigations, and post-grant proceedings. Phil has experience with patent and intellectual property litigation matters in the US and abroad, including patent infringement cases in the US Court of Appeals for the Federal Circuit; US District Courts; the Patent Trial and Appeal Board; patent nullity actions in the High Court of Justice in the United Kingdom; infringement cases in the District Court of Dusseldorf in Germany; revocation proceedings in the Federal Patent Court in Germany; European Patent Office (EPO) opposition proceedings at the EPO Opposition Division; and EPO opposition appeals at the Appeal Board. Phil is also the co-author of an Amicus Curiae brief before the US Supreme Court.

## PROFESSIONAL BACKGROUND

Before attending law school, Phil was a design engineer for a manufacturer of custom food mixing equipment, at which he created an implemented a product design automation program in a three-dimensional modeling program to streamline the design process.

During his law school studies, Phil worked as an in-house IP clerk at a Chicago-based international corporation. While working there, he helped to manage and develop utility and design patent prosecution strategies, filed and managed trademark applications and trademark clearance searches, and conducted research and analysis for digital rights management copyright issues.

## ACHIEVEMENTS

- Certified Legal Project Manager (LawVision)

## PROFESSIONAL / CIVIC ACTIVITIES

- IP Law Association of Chicago
- American Intellectual Property Law Association
- Certified Legal Project Manager (LawVision)

## ADDITIONAL BACKGROUND

Phil's practice includes prosecution, portfolio management, freedom to operate, due diligence, enforcement, and validity investigations in the following subject matter areas: Medical devices, infusion pumps, medical diagnostic and monitoring systems, child safety products, wireless headphones, automated pharmacies, ocular devices and treatments, counter flow centrifugation devices, micro-implants, drug-eluding stents, processes and compounds to mitigate interferences in diagnostic testing, DNA sequencing and PCR devices and methods, optoelectronic components and sensors, nutrition feeding apparatuses and compositions, gaming devices, nanotechnology, food processing and packaging, software and computer systems, and sporting equipment.

## EDUCATION

- J.D., DePaul University College of Law, 2008 *(President, Intellectual Property Law Society; Editor, Journal of Art, Technology and Intellectual Property Law)*
- B.S., University of Illinois, 2005 *(General Engineering; Certificate in Corporate Entrepreneurship and Technology Commercialization)*

## ADMISSIONS

- Bar of Illinois

- United States Patent and Trademark Office
- Supreme Court of the United States
- United States Court of Appeals for the Federal Circuit
- United States District Court for the Northern District of Illinois

## THOUGHT LEADERSHIP *POWERED BY HUB*

- February 2022, February 2022 Accolades
- 20 August 2015, USPTO Announces Second Round of AIA Rule Changes

## AREAS OF FOCUS

- IP Procurement and Portfolio Management
- IP Litigation
- Pharma and BioPharma Litigation
- Post-Grant Patents

## INDUSTRIES

- Healthcare
- Life Sciences

## REPRESENTATIVE EXPERIENCE

- Lead IP due diligence counsel on over 10 M&A deals each with values exceeding $1 billion.
- Lead supervisory patent counsel advising on patent prosecution strategy for dozens of portfolios containing several thousand U.S. and foreign patents for clients ranging from start-ups to large multinational corporations.
- Conducting portfolio analyses and partnering with clients to: identify competitor technology and IP; evaluate offensive and defensive portfolios for strategic licensing and/or acquisition opportunities; and provide client business units with competitor commercial intelligence informed by patent literature.
- Vast experience as a strategic team leader and supervisor for portfolio management and patent counseling related to an array of technologies, including mechanical and electrical arts, computer and software, and chemical and pharmaceutical compounds.
- Drafting and prosecuting domestic and international patent applications involving a wide range of technology including medical devices, infusion pumps, medical diagnostic and monitoring systems, child safety products,

wireless headphones, automated pharmacies, ocular devices and treatments, counter flow centrifugation devices, micro-implants, drug-eluding stents, processes and compounds to mitigate interferences in diagnostic testing, DNA sequencing and PCR devices and methods, optoelectronic components and sensors, nutrition feeding apparatuses and compositions, gaming devices, nanotechnology, food processing and packaging, software and computer systems, and sporting equipment.

- Providing strategic counseling for and handling of U.S. Inter Partes Review proceedings, reexaminations, and other Post-Grant proceedings.
- Performing patentability and invalidity analyses and opinions. He counsels clients in patent related matters including claim analysis due diligence for potential portfolio acquisition, patent clearance, invalidity, and non-infringement opinions.
- Licensing experience includes counseling a client in negotiating, identifying, and valuing individual IP assets of a cross-licensing settlement agreement that included over one hundred U.S. and foreign patents, applications, nine domestic and foreign litigations, and post-grant proceedings.
- Other licensing experience includes advising clients on joint ventures, NDAs, patent acquisition and divestiture, and structuring creative covenants, cross-licenses or royalty programs to settle or avoid litigations with competitors.
- Mr. Kunz was a strategic architect for a series of enforcement actions on behalf of a plaintiff client against several of its competitors in various US District Courts (Western Texas, Northern California, Southern California, Massachusetts, and Utah).
- Mr. Kunz was the primary architect and strategic lead of an ongoing infringement investigation of a multi-jurisdictional global enforcement project in which 15 patents were asserted in two separate actions in US District Court and 6 patents were asserted in two separate actions in the District Court of Dusseldorf, Germany against a competitor.
- Mr. Kunz was the primary strategic and technical counselor for a plaintiff client in a competitor lawsuit in the U.S. District of Delaware.
- Mr. Kunz was the primary strategic and technical counselor for a defendant client in a competitor lawsuit in the U.S. District of South Carolina