



RASHAD L. MORGAN **SHAREHOLDER**

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EDUCATION

J.D., cum laude
University of Cincinnati College of Law, 2006
B.S., magna cum laude, Chemical Engineering
Florida A&M University, 2003

BAR ADMISSIONS

North Carolina
Illinois
U.S. Patent & Trademark Office
U.S. Dist. Court, N.D. Illinois
U.S. Court of Appeals, Fed. Cir.

Rashad Morgan maintains a broad-based intellectual property practice that includes opinion work, due diligence review, and patent litigation, with a particular focus on patent prosecution both in the United States and abroad. For clients in the pharmaceutical, medical device, biotech, chemical, and other industries, he provides full-service counsel on legal strategies for entire patent families. He regularly prepares freedom-to-operate studies and infringement/validity studies, as well as representing clients in USPTO proceedings in which the validity of patents is at stake.

Rashad's clients include emerging and middle market companies as well as large corporations. Across all of his engagements, Rashad appreciates the opportunity to protect his clients' interests, which begins with a detailed understanding of their business and innovations. In his patent prosecution practice—where he is particularly experienced prosecuting patents in the areas of chemistry, biotechnology, and the mechanical arts—he often assists clients in securing patent protection in foreign jurisdictions in addition to the United States. He also has been involved in litigations (including cases initiated under the Hatch Waxman Act), covering pharmaceuticals, medical devices, consumer products, and other technologies.

Rashad is Co-Chair of the Diversity and Inclusion Committee and he is Co-Chair of the Chemical, Energy, and Agriculture Industry Group of Brinks Gilson & Lione. Rashad also sits on the Hiring Committee of Brinks Gilson & Lione. He thinks forward about diversity and inclusion issues, making a difference by taking on leadership roles within the firm and the profession, including the North Carolina Bar Association, where he is active on the Minorities in the Profession Committee, where he served as Co-Chair, and Legal LINK, a program designed to increase interest in legal careers among high-school members of populations underrepresented in the legal profession. Rashad previously served as Vice Chair of the Science and Technology Committee of the ABA Young Lawyers' Division.

EXPERIENCE | OVERVIEW

- Developed and managed domestic and international patent portfolios for clients including drafting, filing, and prosecuting applications, attending to amendments, examiner interviews, continuation practice, restriction and election requirements, reexamination, appeals and correction of patents in technology areas including chemistry and medical devices.
- Drafted multiple invalidity opinions and freedom-to-operate opinions for clients in the medical device, biotech, chemical, and other industries.

Biographies | Rashad L. Morgan

- Coordinated with foreign counsel on the successful prosecution of patents in Europe, Japan, Australia, and other foreign jurisdictions.
- Counseled clients on the identification of their intellectual property rights and protection of their technology, assessing patentability, infringement, and other intellectual property options.
- Advised and counseled clients on intellectual property due diligence issues for transactional matters.

EXPERIENCE | LEGAL

- **Brinks Gilson & Lione**, Research Triangle Park, N.C. and Chicago, Ill.
Shareholder, January 2016-present
Associate, September 2006-2015
Co-Chair, Chemical, Energy, and Agriculture Industry Group, 2016-present
Diversity Committee, 2011-present
Co-Chair, 2018-present
Hiring Committee, 2010-present
Associates Committee Representative, 2007-2009
Summer Associate, 2005
- **Dinsmore & Shohl, LLP**, Cincinnati, Ohio
Summer Associate, Summers 2004-2005
- **Frost Brown Todd, LLC**, Cincinnati, Ohio
Summer Associate, Summer 2004
- **The Procter and Gamble Company**, Cincinnati, Ohio

EXPERIENCE | NON-LEGAL

- **The Procter and Gamble Company**, Cincinnati, Ohio
Process Engineering Intern, Summers 1999-2002

PRACTICE GROUPS

Copyright

International Trade Commission (ITC)

Litigation

Post-Grant Patent

Design Protection

Patent Prosecution

AREA OF FOCUS

Chemicals, Energy & Agriculture

Biotechnology & Pharmaceutical

FORWARD THINKING

Alerts

- USPTO Announces Proposed Second Round of AIA Rule Changes, August 20, 2015
- Paying for Attorneys' Fees Whether you Win or Lose on Appeals from the PTAB, June 28, 2017

Blog Posts

- Paying for Attorneys' Fees Whether you Win or Lose on Appeals from the PTAB, June 28, 2017
- USPTO Launches New System for Filing and Searching, July 13, 2016

Presentations

- Presenter, "The Importance of the 'I' in D&I Initiatives." North Carolina Bar Association Annual Meeting 2019

Biographies | Rashad L. Morgan

- Panelist, "Finding Your Path: Career for Lawyers." Minority Pre-Law Conference, North Carolina Bar Association 2019.
- Presenter, "Implications of the USPTO's Guidance Changes on Patent Subject Matter Eligibility." Brinks 2019 IP Developments Webinar.
- Facilitator, Adelante! Moving Forward Program, North Carolina Bar Association 2019
- Facilitator, "Diversity & Inclusion Symposium", North Carolina Bar Association 2018
- Presenter, "Intellectual Property in the Age of the Technology Boom." North Carolina Central University School of Law Intellectual Property Symposium 2018
- Moderator, "Diversity in the Courts, Agencies, Corporations and Law Firms." Federal Circuit Bar Association and Center for Innovation Policy at Duke Law 2018
- Presenter, Adelante! Moving Forward Program, North Carolina Bar Association 2018
- Presenter, Brinks Webinar, "The Realm of Chemicals: Nanotechnology and Key Cases for 2017," February 1, 2017
- Panelist, "Professionalism: From Law School to Law Practice Adelante! Moving Forward: Surviving and Thriving Student Skills Building Event, North Carolina Bar Association 2017
- Presenter, Brinks Webinar, "Patent Prosecution Strategies in the WAKE of USPTO's Myriad-Mayo Guidance" June 25, 2014
- Presenter, "CAFC and Supreme Court Watch: Three Cases that May Have Radical Impact on Pharmaceutical Patent Life Cycle Strategies," ACI's 12th Annual Maximizing Pharmaceutical Patent Life Cycles, New York City, October 4, 2011

HONORS

- National Black Lawyers Top 100, 2015, 2016
- Publications Editor, *University of Cincinnati Law Review*, University of Cincinnati College of Law
- Dean's List, 5 of 6 semesters, University of Cincinnati College of Law
- Wood Scholarship Recipient, University of Cincinnati College of Law
- Vice President, Black Law Students Association, University of Cincinnati College of Law
- *Tau Beta Pi*, Engineering Honor Society
- Golden Key International Honour Society
- Distinguished Scholarship Award Recipient, Florida A&M University

AFFILIATIONS

- North Carolina Bar Association
Minorities in the Bar Committee, Co-Chair 2017-2019
Legal LINK, Chair, Young Lawyers Division, 2016 –2017; 2017 –2018
Young Lawyers Division Fellow, 2018-present
- American Bar Foundation
Fellow, 2016-present
- American Bar Association
Vice Chair, Science and Technology Committee, Young Lawyers Division, 2015 –2016
- National Bar Association
- Chicago Committee on Minorities in Large Law Firms
Associate Board, 2010-2011
- Licensing Executives Society
- American Chemical Society
- American Institute of Chemical Engineers

TECHNICAL BACKGROUND

- Biopharma

REPRESENTATIVE MATTERS

- *Kannar v. Altacor Inc., et al.* 09-CV-2500 (C.D. Cal., filed December 2008). Representing defendants in a patent infringement suit.
- *Abbott Labs. v. Sandoz Inc.* 07-1400 (Fed. Cir. May 18, 2009) (en banc). Successfully represented Sandoz Inc. in an appeal before the U.S. Court of Appeals for the Federal Circuit dealing with claim construction and the proper interpretation of product-by-process claims. In a landmark decision, the Federal Circuit affirmed the district court's claim construction, and the en banc Court resolved the long-standing conflict on the interpretation of product-by-process claims between its prior decisions in *Atlantic Thermoplastics* and *Scripps Clinic*. Following Supreme Court precedent, the Court upheld the rule in *Atlantic Thermoplastics* that product-by-process claims are limited by their process steps.
- *Abbott Labs. v. Sandoz Inc.* 486 F. Supp. 2d 767 (N.D. Ill. 2007). Successfully defended Sandoz Inc. against request for temporary restraining order and preliminary injunction by Abbott and Astellas before Judge Wayne R. Andersen over patents relating to a polymorph of crystalline cefdinir, an antibiotic also sold as Omnicef®.
- *Anchor Sports I, Inc. v. Schutt Sports, Inc.* (E.D. Tex. 2007). This case, and a companion ITC action, involved a patent related to molded plastic parts. Case settled after Markman positions were exchanged.
- *One World Technologies, Ltd. v. Rexon Industrial Corp., Ltd., et al.*, No. 04 C 4337 (N.D. Ill., Nov. 2006). *Subject:* Infringement of our clients' patents relating to a miter saw having a laser arbor and to a portable power tool support assembly. *Resolution:* Case resolved by a confidential settlement agreement.