

Paul K. Legaard, Ph.D.

Partner

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Paul K. Legaard is a registered patent attorney who concentrates his practice on all aspects of intellectual property. Paul's practice includes intellectual property matters for Fortune 500 companies, midsize pharmaceutical and biotechnology companies, startup companies and venture capital groups, as well as for nonprofit companies, academic institutions and research institutes.

Paul's practice focuses on the pharmaceutical, biotechnology, diagnostics, genetics, vaccines, immunobiology, small molecule chemistry, polymer chemistry, oligonucleotide chemistry, nutraceutical, nanotechnology, biomedical device, scientific instrumentation, and food and beverage industries.

Areas of Paul's comprehensive expertise includes:

- transactional: licensing agreements, collaboration agreements, confidentiality agreements and material transfer agreements
- client counseling: patent application and claim drafting counseling, prosecution strategies, related life-cycle management, foreign filing strategy and trade secret protection
- patent procurement: patent drafting and prosecution, patentability assessment, reissues, reexaminations and appeals before the USPTO
- due diligence: ownership and inventorship investigations, portfolio analysis, and freedom-to-operate and validity searches, analyses and opinions
- post-grant procedures: patent term extension, interference and litigation support

RESULTS

- conducted multiple IP due diligence investigations for pharmaceutical companies acquiring assets involving numerous small molecules, including:
 - multiple due diligence assessments regarding naphthalene, neuropharmaceutical, neurological, antihistamine, benzofuran, piperazine, piperidine, indole, benzamide, propanoic acid and phosphodiesterase inhibitor compounds for big pharma companies
 - multiple due diligence assessments regarding several pain products for a midsize pharmaceutical company

(continued)

FOCUS

Intellectual Property
Intellectual Property Patent Procurement
Intellectual Property Opinions Counseling & Due Diligence
Life Sciences
Health Law

BAR ADMISSIONS

Pennsylvania
U.S. Patent and Trademark Office

COURTS

Supreme Court of Pennsylvania
U.S. Court of Appeals for the Federal Circuit
U.S. District Court for the Eastern District of Pennsylvania

EDUCATION

J.D., Temple University Beasley School of Law
Ph.D., University of Missouri – Columbia, Department of Molecular Microbiology and Immunology
B.A., Gustavus Adolphus College, emphasis in Biology and Chemistry



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- conducted multiple IP due diligence investigations for biotechnology companies acquiring assets involving antibodies, biological receptors and immunogenic peptides, including:
 - due diligence regarding humanized/hybrid antibodies for a big biotechnology company
 - due diligence regarding a vanilloid receptor for a big biotechnology company
 - due diligence regarding vaccine peptides for a small biotechnology company
 - due diligence regarding adhesion variants for a midsize biotechnology company
- rendered multiple IP legal opinions on issues of patentability, inventorship, ownership, infringement, invalidity, freedom-to-operate (FTO) and enforceability for pharmaceutical, biotechnology and medical device companies
 - invalidity opinion for a major biotechnology company regarding monoclonal antibodies
 - invalidity opinion for a major ecommerce company regarding electronic invoicing and payment systems
 - infringement opinion for a biopharmaceutical company regarding the mammalian methadone-specific opioid receptor gene
 - infringement opinion for a big pharma company regarding quinolone carboxylic acid-metal ion-acid complexes
 - infringement opinion for a big pharma company regarding fluoroquinolones
 - infringement opinions for a major biotechnology company regarding antibodies inhibiting collagen binding to VLA-1 epitope
 - infringement opinion for a major biotechnology company regarding hybrid antibodies
 - infringement opinion for a major biotechnology company regarding adhesion variants
 - invalidity opinions for a major pharmaceutical company regarding immune regulation by amino acids
 - FTO opinion regarding a sustained release formulation for a big pharma company
 - FTO opinion regarding biphenyls for a big pharma company
 - FTO/patentability opinion regarding benzimidazoles for a big pharma company
 - FTO/patentability opinion for preparation of small molecules for a big pharma company
 - FTO/patentability opinion for tropanes for a big pharma company



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- FTO opinion for synthesis of neurological compounds for a big pharma company
- FTO/patentability opinion for a checkpoint kinase inhibitor for a big pharma company
- FTO opinion for a human receptor tyrosine kinase for a big pharma company
- FTO opinion for a purinoceptor for a big pharma company
- patentability opinion for an atypical antipsychotic for a big pharma company
- FTO/patentability opinion for methods involved in eye surgery for a pharmaceutical and medical device company
- conducted internal IP due diligence investigations on behalf of pharmaceutical and biotechnology companies in preparation for partnering, financing and public offerings
- conducted IP due diligence on small pharmaceutical and biotechnology companies on behalf of venture capital funds and other investment funds
- conducted IP due diligence defense for a midsize pharmaceutical company for a successful initial public offering
- provided counsel on patent and licensing issues related to product and technology portfolios, patent coverage analysis and potential infringement issues, including:
 - assessment of a sponsored research agreement with an academic institution for a major biopharmaceutical company
 - assessment of a European opposition by a diagnostics company for a major biotechnology company
 - assessment of an IP estate co-owned by biotechnology companies directed to CpG oligonucleotides for a major biotechnology company
 - assessment of material transfer agreement involving a major biotechnology company for a major health care system
 - assessment of alternate method of preparing a marketed drug for a big pharma company
 - preparation of white paper regarding pro-drug and metabolite patent strategy for a big pharma company
 - conducted inventorship analysis for a big pharma company for a \$3 billion/year product
 - provided guidance for Orange Book listings for pharmaceutical companies
 - provided guidance on life-cycle management for pharmaceutical and biotechnology companies
 - provided guidance for a big pharma company seeking patent term extension under Hatch-Waxman



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SPEAKING ENGAGEMENTS

- Presenter, “IP Due Diligence in Commercial Transactions,” Penn Biotech Group
- Presenter, “Intellectual Property and Biotechnology,” Penn Biotech Group
- Presenter, “Intellectual Property Strategy and Strength – Lessons for Life Sciences Companies”
- Presenter, “America Invents Act of 2011: Impact and Implementation”
- Presenter, “Is Your IP Strategy Sound? Impact of the AIA (America Invents Act) for Early-Stage Companies,” North Shore Innoventure Center

RECOGNITION

- *Pennsylvania Super Lawyers*, Rising Star

IN THE COMMUNITY

Paul has provided pro bono IP guidance to Bringing Hope Home, an organization dedicated to help individuals and families that are affected by cancer.

