CHERIAN HARKINS DUNHAM LLP



ELIZABETH A. O'BRIEN

elizabetho@chdlaw.com
(202) 873-1726

Ms. O'Brien is Counsel in the D.C. office of Cherian Harkins Dunham LLP focusing primarily on patent litigation, both in federal court and before the USPTO. Her litigation practice involves strategic consideration of concurrent proceedings in different forums and the management of post-grant matters at the USPTO.

Ms. O'Brien has experience in a variety of intellectual property matters, including patent prosecution, patent transactions, and patent litigation. She has counseled technology companies, ranging from small start-ups to Fortune 500s, and helped those clients protect, monetize, and enforce their patent rights. From these experiences, Ms. O'Brien understands the needs of client-companies and the constraints that affect business decisions.

Ms. O'Brien received her undergraduate degree in Biomedical Engineering, with a concentration in Materials Science, from the University of Virginia. She received her law degree from Boston College Law School and served as the Managing Editor of the intellectual property law journal.

PRACTICES:
Patent Litigation, Intellectual Property Litigation (copyright, trademark, trade secret), Trials and Appeals, PTAB Litigation, Intellectual Property Strategies, IP Transactions & Licensing, Patent Prosecution

BAR ADMISSIONS:
District of Columbia
New Jersey
U.S. Court of Appeals for the Federal Circuit
USPTO Patent Attorney

OTHER MEMBERSHIPS:
PTAB Bar Association
ChIPs Network (Advancing Women in Technology, Law, and Policy)

EDUCATION:
Boston College Law School, J.D.
University of Virginia, B.S.

REPRESENTATIVE CASES

Supported appellate team in consolidated set of *inter partes* review appeals at the Federal Circuit.

Conducted international depositions both remotely and in-person at the U.S. Embassy in Japan.

Presented oral argument before the PTAB in *inter partes* reviews, post-grant reviews, and *ex parte* reexamination appeals.

Obtained PTAB grant of proposed amended claims in post-grant review.

Managed over 25 concurrent post-grant matters at the USPTO, including *inter partes* reviews, post-grant reviews, and *ex parte* reexaminations.

Prevented competitors from joining existing *inter partes* review proceedings to protect the patent owner from undue prejudice and serve the interests of justice.

Argued for discretionary denial and successfully prevented institution of multiple *inter partes* review proceedings due to parallel proceedings in district court.

Supported trial team that won a multimillion-dollar jury verdict of willful patent infringement against a competitor in the Eastern District of Texas, confirming validity of all asserted patent claims.

Prevented defendants from striking infringement contentions and later, succeeded on a motion for partial summary judgment on res judicata in patent infringement litigation in the Eastern District of Texas.

Prepared infringement/invalidity analyses in both district court proceedings and USPTO proceedings.

Participated in fact and expert discovery in various district court proceedings directed at mechanical and computer science technologies.

Drafted and prosecuted patent applications directed at orthopedic and cardiovascular devices, as well as lithium ion batteries.

Performed valuation methods to analyze existing patent portfolios and compiled due diligence reports for potential patent acquisitions.

Counseled clients on claim scope in different jurisdictions including Europe to provide the best protection for medical device manufacturers.

Performed detailed comparison of patent systems in Japan and the United States to counsel international clients.

Conducted prior art searches and freedom-to-operate analyses for clients interested in new market entry.

Supported in-house counsel for a pharmaceutical company drafting and negotiating development and commercialization agreements with drug manufacturers worldwide for Phase III clinical trials.

Worked with the Board of Directors and monitored SEC compliance for a public company.

Prepared material transfer agreements and helped negotiate licensing agreements for a university tech-transfer office.

Facilitated commercialization of novel materials, surface coatings, and texturization methods for a university tech-transfer office.

Created valuable business relationships for a university tech-transfer office to increase investment in R&D.

Articles Published

'Web-Based Publications As Prior Art Under Section 102' in the New Jersey Law Journal (April 3, 2017)