



Deborah M. Herzfeld

Partner

Deb provides the catalyst to synthesize a valuable patent portfolio from your chemical inventions

Deb Herzfeld's practice focuses on client counseling and worldwide patent prosecution and portfolio management, with an emphasis on pharmaceutical life cycles and medical devices. She also has extensive experience with cosmetic, biofuel, polymer, catalyst, and petroleum-based technologies.

Deb has worked in all phases of intellectual property law, beginning her career pursuing both litigation and prosecution work, which allowed her to realize and develop her passion and expertise for both short and long-term portfolio management. Her extensive client counseling experience includes pre-litigation portfolio and due diligence analyses, as well as freedom-to-operate, patentability, validity, and infringement opinion work. These overall "portfolio health" analyses frequently include the development of specific prosecution strategies to correct errors and work around potential obstacles. Deb's pharmaceutical work also includes Orange Book listings of patents covering FDA-approved products, patent term extension analysis, and applications therefor.

Prior to joining McNeill Baur PLLC, Deb practiced as an attorney for over 15 years at Finnegan, Henderson, Farabow, Garrett & Dunner, LLP. Prior to Finnegan, Deb was a law clerk for the Honorable Christine O.C. Miller of the US Court of Federal Claims. While in law school, Deb gained patent prosecution and licensing experience as a student associate at the University of Virginia Patent Foundation, and received the Charles J. Frankel Award in Health Law upon graduation. Deb was promoted to partner at McNeill Baur in 2022.

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Admissions

California
District of Columbia
US Court of Appeals, Federal Circuit
US Court of Appeals, Veterans Claims
US Court of Federal Claims
US Supreme Court
US Patent and Trademark Office

Education

University of Virginia School of Law
J.D., 2000

Emory University
BS, Chemistry; BA, English, 1996

Judicial Clerkships

US Court of Federal Claims

Selected Publications

"Adjusting for the New Normal: Thoughts on Enhancing the Possibilities of Success for the Patent Owner in an AIA Post-Grant Proceeding," *Buffalo Intellectual Property Law Review*, Dec. 4, 2015 (coauthor).

"An Update on Unsuccessful Inter Partes Review Petitions," *Law360*, May 28, 2015 (coauthor).

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"3 Lessons from Unsuccessful Inter Partes Review Petitions," Law360, April 22, 2015 (coauthor).

"Inside the New U.S. Patent Law," SPIE Professional, Oct. 2013 (coauthor).

"Top Five Dangers for the AIA Unwary," Landslide, May/June 2013 (coauthor).

"A Panacea for Inequitable Conduct Problems or *Kingsdown* Version 2.0? The *Therasense* Decision and a Look into the Future of U.S. Patent Law Reform," *Virginia Journal of Law & Technology*, Fall 2011 (coauthor).

Selected Speaking Engagements

PRG Advanced Course, "Patent Due Diligence in the AIA Era," San Antonio, TX, October 23-25, 2016.

PRG Advanced Course, "Preparation & Prosecution of Pharma U.S. Patents," San Antonio, TX, October 19-21, 2016.

Oregon Patent Law Association Conference, "Enhancing the Possibilities Of Success For The Patent Owner In AIA Post-Grant Proceedings: Lessons From PTAB Denials Of Institution," Salishan, Oregon, April 16, 2016.

Strafford Publications Webinar, "Strategic Use of Patent Reissue: Determining Whether and When to Pursue a Reissue Application," January 14, 2016.

Strafford Publications Webinar, "Patent Prosecution: Leveraging Declarations to Strengthen Patents Against Post-Grant Proceedings," May 12, 2015.

PRG Advanced Course, "Chemical Patent Practice," regular speaker including Albuquerque, NM, October 13-15, 2015; Orlando, FL, April 12-14, 2015; Las Vegas, NV, September 27-29, 2014; Bonita Springs, FL, March 30-April 1, 2014; Huntington Beach, CA, October 20-22, 2013.

PRG Advanced Course, "CCPA and early Federal Circuit Decisions for Guidance on Common Problems Faced by U.S. Chemical and Pharma Patent Practitioners," Albuquerque, NM, October 15, 2015; New York, NY, September 10, 2015; Boston, MA, June 10, 2015; Orlando, FL, April 15, 2015.

American Chemical Society Conference, "Best Practices in Identifying, Protecting, and Managing your Intellectual Property Portfolio," Philadelphia, PA, August 21, 2012.

Strafford Publications Webinar, "Orange Book Use Codes: Impact of *Caraco v. Novo Nordisk* - Pursuing or Defending Against Counterclaims to Correct Method-of-Use Patents," June 5, 2012.