

David Bomzer

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David has served as both in-house and outside counsel to some of the largest and most recognizable Fortune 500 companies. In these positions, he has been responsible for developing, coordinating and executing all aspects of patent protection strategies among global teams of business and technology hubs. In addition, he has developed objectives and procedures for identifying and protecting high value technology assets, and organized and led teams of technology leaders, who assisted in coordinating enterprise-wide protection efforts. David also managed patent procurement efforts by in-house and outside counsel.

David has drafted and prosecuted patent applications in the mechanical, electro-mechanical, telecommunication arts, to name a few, and participated in various post grant reviews. David also has extensive experience in procuring design patents for his clients. He has also drafted many freedom-to-operate opinions and patentability opinions for his clients. Further, David has protected his clients' interests in litigation matters via various Examination Before Trial (EBT) proceedings, including taking and defending depositions, preparing and examining infringement claim charts, preparing Markman briefs and assisting in Markman hearings.

David enjoys lecturing about intellectual property and technical subject matter, and has participated in and chaired many industry conferences and panels. David has lectured about patents, including utility and design patents, as well as other forms of intellectual property, to clients, startups, and to other attorneys via local and regional committee activities. He taught Cyber Law at Quinnipiac University School of Law as an Adjunct Professor for several years. He also taught mechanical and aerospace engineering courses to undergraduate and graduate students at the NYU Tandon School of Engineering (formerly known as Brooklyn Polytechnic University) as an Adjunct Professor for several years.

Technologies

Aerospace & Aeronautics Automotive Technology Computer and Systems Engineering Computer Science & Software Electrical Engineering & Electronics **Electro-Communications** Energy Internet & E-Commerce Mechanical Engineering Metallurgy & Ceramics Semiconductor Devices & Processing Methods Telecommunications

Practice Areas

Computer Science Practice Derivation Proceedings Design Patents Practice Due Diligence in IP Acquisitions **Ex Parte Reexaminations Expedited Patent Examination** Foreign & PCT Patent Filing Inter Partes Review International Invalidity Opinions **IP** Transactional

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Experience Highlights

Counsel, Cantor Colburn LLP, 2016-present

Counsel, Patents, Trade Secrets, Technology, Aetna, 2015-2016

Assistant Intellectual Property Counsel, United Technologies Corporation, Pratt & Whitney Division, 2012-2015

Counsel, Day Pitney, LLP, 2007-2012

Senior Associate, Jordan & Hamburg, LLP, 2004-2007

Associate, Scully, Scott, Murphy & Presser, P.C., 2001-2003

Associate, Darby & Darby, P.C., 1999-2001

Structural Dynamics / Acoustics Engineer, Electric Boat Corporation, a General Dynamics Company, 1996-1997

Processes Design Engineer, Pall Corporation, 1995-1996

Junior Engineer, CCI Manufacturing, A Ryder Truck Company, 1994-1995

News

Cantor Colburn Client Alert: The Essentiality of Legal Title Assignment August 20, 2021 (David Bomzer, Sara Colburn, and Charlie O'Brien)

Client Alert: Supreme Court Maintains, and Identifies Exceptions, to Assignor Estoppel June 30, 2021 (Katherine Tassmer and David Bomzer)

Events

IP Transactions Bootcamp 2021 October 14, 2021 virtual David Bomzer, an active member of the New York Intellectual Property Law Association (NYIPLA), currently serving as Programs Planning Committee Chair of the Transaction and Patent Practice Committees, is one of the coordinators of the NYIPLA IP Transactions Bootcamp, taking place virtually in October and November 2021.

PLI's Patent Fundamentals Bootcamp 2021: An Introduction to Patent Drafting and Prosecution June 2, 2021 Live Webcast Licensing

Non-infringement Opinions

Opinions

Patent Landscaping and Risk Analysis

Patent Reissue

Patentability Opinions

Patents

Post Grant Practice

Post-Grant Review

Product Clearance

Right to Practice Opinions

Strategic IP Portfolio Development and Management

Technology Transfer

Trade Secrets

Utility, Design, and Plant Patent Filing with the USPTO

Admissions

State of Connecticut, 2012

Supreme Court of the United States, 2008

U.S. Patent and Trademark Office, 2001

State of New York, 2000

U.S. District Court for the Southern District of New York, 2000

U.S. District Court for the Eastern District of New York, 2000

Education

Benjamin N. Cardozo School of Law, JD, 2000

NYU-Tandon School of Engineering (formerly Polytechnic Institute), M.S. in Mechanical Engineering, 2006

NYU-Tandon School of Engineering (formerly Polytechnic Institute), Graduate Certificate in Network Telecommunications,

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David Bomzer will speak at PLI's Patent Fundamentals Bootcamp 2021: An Introduction to Patent Drafting, Prosecution, and Litigation via Live Webcast on June 2-4, 2021.

The 99th Annual Dinner in Honor of the Federal Judiciary April 22, 2021

The New York Intellectual Property Law Association's 99th Annual Dinner in Honor of the Federal Judiciary is virtual on April 22, 2021.

David Bomzer Speaks on Patents v. Trade Secrets at New York City Bar April 21, 2021

Webinar

David Bomzer spoke about patents versus trade secrets at the New York City Bar webinar, "An Introduction to IP Law for the Small Law Firm Practitioner: When Might Your Client Have an IP Issue and How to Start to Think About It," on April 21, 2021.

2019 ScaleUP CT

June 6, 2019

Sacred Heart University, Fairfield, Connecticut

Cantor Colburn is proud to sponsor 2019 ScaleUP CT on June 6, 2019 at Sacred Heart University in Fairfield, Connecticut. Presented by the Connecticut Technology Council, ScaleUP CT is designed to support companies that are beyond the startup phase. ScaleUP CT is an event built to educate and invigorate the leaders of Connecticut's growing tech-oriented companies. Now in its third year, the event will support companies in the tech sector at every stage of their growth and development. Co-managing partner Michael Cantor is on the CTC board of directors and will be a part of the program.

Blockchain IP: Innovation and the Distributed Ledger Revolution November 29, 2018

New York City

Cantor Colburn's David Bomzer is a speaker at the New York City Bar and MIT Enterprise Forum of NYC program "Blockchain IP: Innovation and the Distributed Ledger Revolution," on November 29, 2018, a program for members and non-members alike.

What Non-IP Attorneys and Business Professionals Need to Know About IP Transactions

November 13, 2018

Charlie O'Brien and David Bomzer will present "What Non-IP Attorneys and Business Professionals Need to Know About IP Transactions," with West LegalEdcenter, a Thomson Reuters Webinar. This session will provide attorneys and business professionals with an overview of the basic categories of intellectual property and describe the various structures of typical IP transitions.

2005

State University of New York at Buffalo, B.S. in Aerospace Engineering, 1994

Teaching Positions

Quinnipiac University School of Law, Adjunct Professor of Cyber Law

NYU-Tanden School Of Engineering, Adjunct Professor of Mechanical Engineering

NYIT (Westbury), Adjunct Professor of Aerospace Engineering





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Re-Opening of the People's United Center for Innovation & Entrepreneurship October 24, 2018 Hamden, Connecticut

Hamden, Connecticut

Quinnipiac University School of Business and People's United Bank are re-opening the People's United Center for Innovation & Entrepreneurship at a reception on October 24, 2018. Cantor Colburn attorneys Todd Garabedian, Ph.D. and David Bomzer are adjunct professors at Quinnipiac School of Law.

A Lawyer's Primer on Blockchain and Smart Contracts CLE

October 12, 2018

New Britain, Connecticut

The Connecticut Bar Association is offering a CLE, "A Lawyer's Primer on Blockchain and Smart Contracts," on October 12, 2018.

Stanley + Techstars Additive Manufacturing Accelerator Demo Day

October 11, 2018

Hartford, Connecticut

Stanley + Techstars Additive Manufacturing Accelerator Demo Day is October 11, 2018 at the Bushnell Theatre in Hartford. It is the culmination of a 12-week program in which ten companies from around the globe relocated to the new Advanced Manufacturing Center of Excellence – Manufactory 4.0 – in Hartford, CT. Cantor Colburn was one of the first law firms in the country to have an Additive Manufacturing Practice Group, led by Dave Christensen.

PACE IEEE Workshop in Intellectual Property

November 11, 2017

Central Connecticut State University, New Britain, Connecticut

David Bomzer will present a professional development workshop on Intellectual Property to the Professional Activities Committees for Engineers (PACE), the grassroots network of Institution of Electrical and Electronics Engineers (IEEE) volunteers and committees, on November 11, 2017, at Central Connecticut State University in New Britain, Connecticut.

Panelist, Supreme Court Update, 13th annual World Congress Patents for Financial Services Summit, New York, July 21, 2016

Panelist, Diverse Careers in IP Law and Strategies for Achieving Success, NYIPLA and Cardozo School of Law Alumni Association, April 19, 2016

Event Chair, Corporate IP Counsel Forum, IP World Congress, New York, Mar. 23, 2006

Panelist, Annual IP Trademark, Copyright & Licensing Counsel Forum, ALM, New York, November 3, 2015

Panelist, Careers in IP Law, NYIPLA, Quinnipiac Law School, April 16, 2015

Event organizer/Panel Moderator, One-Day Patent CLE Seminar, NYIPLA, New York, Nov. 20, 2014

Event Co-Chair/Panel Moderator, Annual IP Trademark, Copyright & Licensing Counsel Forum, ALM, New York, Oct. 28, 2014

Moderator/Co-Chair, "Key Leadership Issues in Sports and Media Law: Maximizing Profits and Protecting the Brand," the New York County Lawyers Association, April 29, 2014

Continued

Speaker, "Ethics in Social Media 2014," the Practicing Law Institute, New York, NY, Mar. 17, 2014

Moderator, "NYIPLA 2014 One-Day CLE Program", the New York Property Lawyers' Association, The University Club, New York, NY, Jan. 16, 2014

Speaker, "Intellectual Property Basics-With Case Law Updates: Copyright Basics For The Corporate Attorney," McCarter & English and the New York County Lawyers Association, Dec. 18, 2013

Speaker, "Intellectual Property in an International Landscape: What's Your Risk?", Corporate Counsel's 6th Annual IP Trademark, Copyright & Licensing Counsel Forum, The University Club, New York, NY, Oct. 22, 2013

Speaker, "Understanding Patents, Copyrights & Trademarks: Practicing & Dispute Basics with Case Law Updates", Day Pitney and the New York County Lawyers' Association, April 10, 2013

Speaker, "Patent Law For Non-Patent Lawyers: Understanding A Patent", the New York City Bar Association, Mar. 19, 2013

Speaker, "Protecting Your Products and Discoveries Perspectives from both In-House and Outside Patent Counsel," McCarter & English and the New York County Lawyers Association, Dec. 11, 2012

Speaker, "Patent Law and the America Invents Act," Day Pitney and the New York County Lawyers' Association, Feb. 22, 2012

Speaker, "Patent Law Upheaval? The New America Invents Act & Its Impact On Patent Rights", the Nassau County Bar Association, Jan. 30, 2012

Speaker, "The Patent Reform Act," the New York City Bar Association, Jan. 26, 2012

Moderator, "The Supreme Court's Increased Interest In Patent Law," New York Intellectual Property Lawyers Association, Nov. 3, 2011

Speaker, "A Review of Supreme Court Patent Law Decisions from 2011 & Their Impact on Your Practice," the New York City Bar Association, Oct. 12, 2011

Moderator, "Roundtable: Updates on Damages and the Use of Experts," New York City Bar Association, June 7, 2011

Speaker, "Exploring Obviousness," Long Island Systems, Applications and Technology Conference, Farmingdale State College of the State University of New York, May 6, 2011

Speaker, "Patent Basics for Inventors, Engineers, Scientists, Entrepreneurs, and Students," New York City Bar Association, April 7, 2011

Speaker, "What Is Patent Eligible Following the 2010 Supreme Court's Bilski Decision?" IEEE Consultants Network of Long Island, Feb. 9, 2011

Speaker, "Patent Protection Update: Software and Financial Method Patents," New York Technology Council, Inc, Jan. 18, 2011

Chair and Moderator, "Supreme Court Update," New York City Bar Association, Jan. 11, 2011

Speaker, "Navigating The Supreme Court's Bilski v Kappos Decision, Subsequent Federal Circuit and District Court Decisions, Including Prometheus Labs," Day Pitney and the New York County Lawyers' Association, Dec. 22, 2010

Continued

Speaker, "Getting The Most Out Of Your Patent Licensing, The Impact of Bilski v Kappos," New York City Bar Association, Dec. 6, 2010

Organizer, "NYIPLA 2010 Fall One-Day CLE Program," New York Intellectual Property Lawyers' Association, Nov. 4, 2010

Speaker, "Understanding the 2010 Examination Guidelines Update: Developments in the Obviousness Inquiry After KSR v.Teleflex," Day Pitney and the New York County Lawyers Association, Oct. 7, 2010

Speaker, "Patent Marking, How to Navigate This Changing Area Of Law," Day Pitney and the New York County Lawyers Association, Mar. 25, 2010

Organizer and Panel Moderator, "NYIPLA 2009 Fall One-Day CLE Program", Nov. 5, 2009

Organizer and Panel Moderator, "Current Issues in Patent Practice," New York City Bar Association, Oct. 8, 2009

Speaker, "Federal Circuit Update: Prometheus Labs v Mayo Collaborative Services," Day Pitney and the New York County Lawyers Association, Oct. 1, 2009

Speaker, "How to Protect Your Intellectual Property without Breaking Your Budget," Day Pitney Webinar, May 5, 2009

Speaker, "Following Bilski, Comiskey & Recent Board Decisions, How To Navigate the Changing Area of Law for Business Method Patents," Day Pitney and the New York County Lawyers Association, Feb. 24, 2009

Moderator, "Navigating Effective Intellectual Property Enforcement on the Web," Day Pitney, Dec. 11, 2008

Panelist, "Roundtable on In Re Bilski," New York City Bar Association, Dec. 2, 2008

Moderator, "NYIPLA 2008 Fall One-Day CLE Program", The University Club and the New York Property Lawyers' Association, Nov. 7, 2008

Panelist, "Design Patent Infringement - Egyptian Goddess v. Swisa," Benjamin N. Cardozo School of Law, Apr. 14, 2008

Professional Affiliations

Connecticut Bar Association, Intellectual Property Section Executive Committee, 2021-2022

New York Intellectual Property Law Association (NYIPLA), Programs Planning Committee Chair 2021-2022, Transaction and Patent Practice Committees

New York City Bar Association (NYCBA), Patent and Trade Secret Committees 2020-present

Connecticut Intellectual Property Lawyers Association (CIPLA)

Institute of Electrical and Electronics Engineers (IEEE), Section Vice President

Intellectual Property Owners Association (IPO)

International House of New York, Steering Committee





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Community/Civic Involvement

National Ski Patrol (N.S.P.), Patroller



Andrew Chien is currently the Lead Counsel for Intellectual Property for Point of Care Diagnostics at Siemens Healthineers, where he regularly counsels the business on matters of IP transactions, portfolio management and enforcements. Prior to joining Siemens Healthineers, Andrew was Senior Counsel of Intellectual Property at Allergan, where he focused on collaborations, licensing and M&A related to Intellectual Property. Andrew is currently the co-chair of the IP Transactions Committee at NYIPLA.

ANGELA COLLISON



Intellectual Property Manager & Patent Counsel

Canon USA, Inc.

Angela Collison is an Intellectual Property Manager and Patent Counsel at Canon U.S.A., Inc. She currently manages the intellectual property portfolio for Canon's Healthcare Optics Research Laboratory which works in collaboration with Massachusetts General Hospital and Brigham and Women's Hospital. Ms. Collison is also managing the development of an intellectual property program at Canon Virginia, Inc.

Her practice is focused on portfolio development, patent and trademark prosecution before the United States Patent and Trademark Office, patent licensing, agreement drafting and negotiation, landscape and freedom to operate searches, due diligence, and supporting product development activities.

Prior to starting at Canon, Ms. Collison was an attorney at an intellectual property law firm in Manhattan. She has experience in a wide variety of practice areas including biotechnology, molecular diagnostics, infectious disease diagnostics, molecular biology, vaccines, animal health, food science, pharmaceuticals, medical imaging, robotics, medical devices, and consumer electronics. Ms. Collison is the co-author of papers relating to the patentability of antibodies and antivirals.

Ms. Collison received a B.S. in Biophysics with a minor in Chemistry from the State University of New York at Geneseo, and an M.S. in Biomedical Engineering from the State University of New York at Stony Brook. Ms. Collison received her J.D. from Fordham University School of Law where she was a member of the Law Review.

Ms. Collison is a member of the State Bars of New York and Connecticut, and is authorized to practice before the United States Patent and Trademark Office.

Fay Kaplun & Marcin LLP

Wan Chieh (Jenny) Lee - Counsel

<u>CONTACT</u> (212) 619-6000, ext. 205 JLee@fkmiplaw.com

EDUCATION

- J.D., Benjamin N. Cardozo School of Law, Yeshiva University, 2005
 - Dean's Merit Scholarship
 - Cardozo Journal of Conflict Resolution, Staff
- B.S. in Chemical Engineering, Biomedical Engineering minor, Massachusetts Institute of Technology, 2002
 - Bioengineering Undergraduate Research Award
 - Polymer Science Laboratory, Teaching Assistant

BAR ADMISSIONS

- New York
- Court of Appeals for the Federal Circuit
- U.S. District Courts for the Southern and Eastern Districts of New York
- U.S. Patent and Trademark Office

Wan Chieh (Jenny) Lee is a Counsel at Fay Kaplun & Marcin LLP.

Ms. Lee's practice encompasses all areas of intellectual property, focusing on patent due diligence, freedom to operate reviews, transactions and negotiations involving patent rights, patent licensing, strategic counseling and procurement of worldwide patent rights, complex proceedings (e.g., patent reexaminations, reissue applications, supplemental examination, and administrative appeals) before the United States Patent and Trademark Office (USPTO), and patent litigation.

Ms. Lee has experience providing strategic counseling to clients in the pharmaceutical, biotechnology and medical device industries, with a particular emphasis in pharmaceutical/biologics patent life cycle management, patent validity analysis, and issues under the Hatch-Waxman Act and the Biologics Price Competition and Innovation Act of 2009. Her experience spans a broad range of technologies within the pharmaceutical and biotechnology industries, including small molecule compounds, pharmaceutical formulations, combination therapies, antibodies, vaccines and diagnostic assays. She also has experience working with a variety of other technologies including polymer technology, cosmetic products and devices, chemical products and processing, manufacturing process controls, mechanical devices, paper products, and business methods.

During her time at MIT, Ms. Lee participated in cardiac and cartilage tissue engineering research using polymeric scaffolds in Professor Robert Langer's laboratory, for which she earned the school's bioengineering undergraduate research award. Additionally, she researched and studied drug delivery coatings for cardiovascular stents, and served as a teaching assistant for the undergraduate polymer chemistry laboratory. Ms. Lee also worked at a major pharmaceutical company where she designed and conducted experiments related to pharmaceutical manufacturing processes.

<u>DuaneMorris</u>

HEIDI LUNASIN Special Counsel



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Duane Morris LLP 505 9th Street, N.W., Suite 1000 Washington, DC 20004-2166 USA

Heidi E. Lunasin practices in the area of intellectual property law, representing clients in all areas of patent and trademark law. Ms. Lunasin crafts patent strategies in technology fields ranging from biotech and engineering to composition, electrical, mechanical and design. In addition, she counsels clients in the development, maintenance and protection of intellectual property in the United States, as well as throughout the world.

Ms. Lunasin assists clients in establishing competitive patent review and enforcement programs. She has assisted in developing appropriate strategies to defend patents asserted in litigation before the Patent Trial and Appeal Board (PTAB). Further, Ms. Lunasin has experience working on clearance of products, due diligence reviews, performing comprehensive and in-depth patent searches, preparing non-infringement and invalidity opinions, and drafting and evaluating intellectual property contracts.

Prior to working for Duane Morris, Heidi served as Senior Patent Counsel for adidas AG and IP Counsel at Treofan in Germany and gained valuable insight into the concerns of in-house patent counsel, especially those operating on a world-wide scale. Throughout Ms. Lunasin's

life, she has been fortunate to work in several industries gaining an understanding of the issues affecting them. Before studying law, she worked for the US Army Corps of Engineers, Cyro Industries, Dell Computer, and the Third Military Academy of Korea.

Ms. Lunasin is registered to practice before the United States Patent and Trademark Office and admitted to practice in New York, New Jersey, and the District of Columbia. She is a 2008 graduate of Seton Hall University School of Law. She earned an M.S. in Public Health from the University of North Carolina and a B.S. in Chemical Engineering from Rutgers University.

Areas of Practice

- Intellectual Property
- Patents
- Trademark Law
- Biotechnology

Admissions

- New York
- New Jersey
- District of Columbia
- U.S. Patent and Trademark Office
- U.S. Court of Appeals for the Federal Circuit
- U.S. District Court for the Southern District of New York
- Supreme Court of the United States

Education

- Seton Hall University School of Law, J.D., 2008
- University of North Carolina, M.S., Public Health, 1999
- Rutgers University, B.S., Chemical Engineering, 1994

Selected Speaking Engagements

• Clinician, "Patent Amendment Writing," Practising Law Institute's Patent Fundamentals Bootcamp 2021, June 2-4, 2021

- Presenter, "Tensions Between Nonobviousness and Written Description in U.S. Patent Law," Duane Morris LLP, Webinar, October 27, 2020
- Clinician, "Patent Fundamentals Bootcamp 2020: An Introduction to Patent Drafting, Prosecution, and Litigation," Practising Law Institute Webinar, June 2-4, 2020
- Speaker, "Patent Fundamentals Bootcamp 2019: An Introduction to Patent Drafting, Prosecution, and Litigation," Practising Law Institute, June 13, 2019

Selected Publications

- Co-author, "Sharing the Blame: Parent Company Can Still Be on the Hook for Subsidiary's Alleged Infringement," *Duane Morris Alert*, May 25, 2021
- Co-author, "Considerations and Implications of the Proposed Temporary Waiver of COVID-19 Vaccine-Related Intellectual Property Rights," *Duane Morris Alert*, May 6, 2021
- Co-author, "Who Watches the Watchmen? Supreme Court to Decide Fate of Administrative Patent Judge Appointments," *Duane Morris Alert*, March 8, 2021
- Co-author, "Forum Selection Clause Held Inapplicable for Precluding Inter Partes Review Before the Patent and Trial Appeal Board," *Duane Morris Alert*, February 8, 2021
- Co-author, "Through the Ages and Across Art Units: How Interpretations of 35 U.S.C. § 101 Are Changing American Innovation", Patent Fundamentals Bootcamp 2020 Course Handbook, Practising Law Institute, 2020
- Co-author, "US Privilege While Operating on the World Stage," Advanced Patent Prosecution Workshop Course Handbook, Practising Law Institute, 2019
- Co-author, "Getting an Audience with the USPTO", Patent Fundamentals Bootcamp 2018 Course Handbook, Practising Law Institute, 2018