

Karen L. Elbing, Ph.D.

Partner

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EDUCATION

J.D. *magna cum laude*, Suffolk University Law School

Ph.D., Genetics, Harvard University

B.S. *cum laude*, Microbiology, University of Massachusetts

BAR ADMISSIONS

U.S. Patent and Trademark Office
Massachusetts

U.S. Court of Appeals for the Federal Circuit

PRACTICE AREAS

Corporate & Investment Diligence

Licensing & Transactions

Patent Opinions

Patent Prosecution

Strategic Counseling

Trade Secrets

Trademarks

TECHNOLOGIES

Chemistry & Materials Science

Industrial Devices

Life Sciences

Medical Devices & Diagnostics

OVERVIEW

Exceptional problem solving skills combined with creative thinking characterize Dr. Karen Elbing's approach to patent prosecution, IP portfolio management, and strategic counseling.

Since co-founding Clark+Elbing in 1996, Karen has represented clients ranging from start-ups and educational institutions to Fortune 500 companies. Clients rely on her deep scientific background and legal acumen developed over her lengthy career to identify intellectual property, build and maximize worldwide patent portfolios through strategic patent prosecution, in-licensing, and patent term extension, and analyze competitor's IP positions. She regularly carries out clearance analyses on key products and provides advice on patent infringement, validity, and inventorship issues. Her practice touches on a wide range of technologies that include protein therapeutics (with a particular emphasis on antibody therapeutics), gene therapies, immunotherapies, companion diagnostics, drug delivery systems, and small molecule therapeutics, as well as platform technologies such as antibody engineering approaches and emerging drug discovery technologies such as DNA-encoded libraries.

As a scientist, Karen studied molecular biology at Harvard University, and she is the first author on research articles in *Cell* and *Journal of Bacteriology*. She is also an original contributor to *Current Protocols in Molecular Biology*. Prior to founding Clark+Elbing, Karen was a patent attorney at Fish & Richardson, where her practice included patent prosecution and litigation, including serving as second chair on behalf of Genentech in patent litigation before the U.S. International Trade Commission (human growth hormone) and participating in an appeal to the U.S. Court of Appeals for the Federal Circuit on behalf of New England Medical Center (human IL-1beta).

Karen has been rated an AV Preeminent Lawyer, an honor based on strong legal ability and high ethical standards and shared by only 10% of attorneys nationwide. She has been described in client reviews as "superlatively thoughtful," a "one-of-a-kind counselor," and "absolutely stand-out."

EXPERIENCE

- Has successfully secured and continues to secure U.S. and worldwide patents for a major biotechnology company on key oncology products having yearly sales in the billions of dollars.
- Assists an extremely innovative venture capital group in the identification and development of foundational intellectual property for their portfolio biotechnology companies in a range of therapeutic areas including oncology, neurology, metabolic disorders, and microbiome modulation.
- Has served as patent counsel, since its founding, to a highly valued biotechnology company, collaborating with corporate counsel to devise a robust partner licensing strategy and also successfully developing a worldwide patent portfolio on its DNA-encoded library technology platform as well as leading the efforts to invalidate a third party patent through European opposition.
- Developed an effective patent portfolio for a mid-size biotechnology company working in the area of emerging

antibody engineering technologies that was key to the company's later acquisition.

- Has served as patent counsel to numerous companies in the biologics and small molecule therapeutics areas from their inception through acquisition, partnering, or public offering.

Honors:

- AV-ranked Preeminent Attorney (an honor shared by only 10% of attorneys nationwide).
- Described in client reviews compiled by *IAM 1000* as:

"However complex a matter is, it [Clark+Elbing] will have the unique know-how to handle it." Genentech is one heavyweight which has recently benefited in this regard: prosecution whizz Karen Elbing has been helping it to devise a comprehensive worldwide IP strategy. Her foresight, analytical sharpness and facility for problem solving make her a top choice.

"Superlatively thoughtful" Karen Elbing is a "one-of-a-kind counselor." Building and managing catalogues of rights for domestic and Japanese clients, the name partner is "absolutely stand-out."

- Massachusetts and New England Super Lawyer, Intellectual Property
- "Most Outstanding Woman Law Student," National Organization of Women Lawyers
- Articles Editor, Suffolk University Law Review
- Jurisprudence Awards in Constitutional Law and Conflicts of Law, Suffolk University Law School
- Phi Beta Kappa