




# J. Peter Fasse

## Principal

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## Overview

### About J. Peter

Peter Fasse is a principal in the Boston office of Fish & Richardson P.C. His practice emphasizes client counseling and patent prosecution in a wide variety of technologies, with an emphasis on healthcare, medical devices, and other biological and medical fields as well as various green technologies. Peter helps clients from startups to multinationals to develop competitive worldwide patent strategies and to establish solid and defensible patent portfolios. He performs competitive patent analyses, identifies third-party patent risks, and provides patentability and freedom to operate opinions. Peter also has experience in opposing and defending patents before the European Patent Office and in U.S. litigation and post-grant proceedings.

Mr. Fasse has experience in various fields including medical therapeutics, diagnostics, devices, and imaging, microfluidic systems, liquid biopsy, nucleic acid sequence analysis systems and software, cell culturing and bioprocessing, molecular biology, complex biomedical systems, optics, machine tools, and lasers. Specific applications relate to, e.g., cancer antibodies, RNAi and CRISPR therapeutics, engineered AAV systems, microfluidic analysis of circulating tumor and fetal cells, cell-free DNA analysis, next generation sequence analysis, CO2 laser systems, 3D printing, e.g., of tissues, human and bacterial genes and polypeptides, dendritic cell- and DNA- based vaccines, nanoparticle and vector-based delivery of therapeutic agents including AAV delivery of DNA to eye and ear tissues, automated blood analysis systems, nucleic acid probes, tissue engineering, infusion pumps, biochips, laser ablation devices, cellulose processing for ethanol production, CO2 recycling power plants, implantable drug delivery devices and microcapsules, ultrasound probes, wind and solar power, cytokines such as IL-8 and PF4, and diagnostic and therapeutic methods for, e.g., AIDS, cancer, autism, diabetes, psoriasis, and arthritis.

In litigation and European opposition matters, Mr. Fasse has represented clients in a variety of patent

infringement suits and trade secret misappropriation cases. Specific subject matter at issue included, e.g., cancer therapeutics (Erbix), cardiac biomarkers, cell culturing systems, methods of treating arthritis (CTL4lg), dental implants, hook and loop fastener systems, computer-controlled medical infusion pumps, and fiberglass casting materials.

## Focus Areas

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### **Services**

- Patent
- Opinions and Strategic Counseling
- Patent Acquisition and Due Diligence
- Patent Portfolio Management
- Patent Prosecution
- Startup and Early-Stage Companies
- Strategic Counseling, Registration, and Opinions

### **Industries**

- Academic Research and Medical Centers
- Chemicals
- Cleantech
- Digital Health
- Life Sciences
- Manufacturing
- Medical Devices
- Nanotechnology
- Optics

## Education

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J.D., George Washington University Law School (1987)

B.S., Bioelectrical Engineering, Massachusetts Institute of Technology (1983)

B.S., Life Sciences, Massachusetts Institute of Technology (1983)

## Insights

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### Publications

- “Coordinating Patent Prosecution in the U.S. and Europe,” *Managing IP* (June 8, 2022)
- “Patent Eligibility of Nature-Based Products: Current View of the United States Patent & Trademark Office,” *Industrial Biotechnology* (April 2015)
- “Intellectual Property of Plants and Plant Products: Is Fruit Juice Eligible for Patent Protection?” *Industrial Biotechnology* (October 2014)
- “The USPTO’s Current View on Patent Eligibility,” *Industrial Biotechnology* (June 2014)
- “Patent Eligibility of Biological Methods and Compositions,” *Industrial Biotechnology* (June 2013)
- “Upcoming Changes in Patent Law May Significantly Impact the Biotech Industry,” *Industrial Biotechnology* (October 2012)
- “Patent Eligibility of Method Claims: What Is the Impact of the Supreme Court’s *Prometheus* Decision?” *Industrial Biotechnology* (June 2012)
- “Strategies for expediting examination of US patent applications,” *Industrial Biotechnology* (October 2011)
- “Isolated, purified, covalent bonds, or magic microscopes? What defines patentable nucleic acid molecules?,” *Industrial Biotechnology* (June 2011)
- “The America Invents Act and Its Importance to Patent Prosecution in the Biotech Sector,” *Industrial Biotechnology* (April 2012)
- “Current Views on Obviousness Under US Patent Law,” *Industrial Biotechnology* (October 2010)
- “‘Best Mode’ Requirements Under US Patent Law: When Your Best Description is Just Not Good Enough,” *Industrial Biotechnology* (August 2010)
- “After *In re Kubin*, can the manner in which an invention was made render the invention ‘inherently obvious?’” *Industrial Biotechnology* (June 2009)
- “Maximizing IP value in an economic downturn (& beyond) in the life science industry,” *Industrial Biotechnology* (March 2009)

- “Do’s and Don’ts for Maximizing Your IP Value in Uncertain Times,” (December 2008)
- “BENCH TO BENCH: USPTO’s security & energy reviews, Pitfalls and practice tips to help prevent loss of patent rights,” *Industrial Biotechnology* (June 2008)
- “For better or for worse? How US legislative patent reform may affect the biotech sector,” *Industrial Biotechnology* (March 2008)
- “Issues in Identifying Contributors to Inventions Under U.S. Law,” *AUTM Technology Transfer Practice Manual*, Volume 3, Part 2, Chapter 5 (January 2008)
- “Beyond *KSR v. Teleflex*: How the courts and USPTO have decided biotechnology and chemistry cases,” *Industrial Biotechnology* (October 2007)
- “What the US Supreme Court’s *KSR v. Teleflex* decision means for biotech,” *Industrial Biotechnology* (June 2007)
- “Intellectual Property (IP) Do’s and Don’ts for Start-Up Companies,” (March 2007)
- “Do’s and Don’ts for Keeping Lab Notebooks,” *Law.com* (May 1999)

## Presentations

- “Friends and Family and Other Seed Funding,” *The Boston Entrepreneurs’ Network* (October 18, 2022) (download presentation slides)
- “Successful Strategies for Patenting Bioinformatics and Computational Genomics,” *Fish Webinar* (October 26, 2022)
- “Faculty Inventions Lead to a Robust Academic Pipeline,” *AUTM Eastern Region Meeting* (September 13, 2022) (download presentation slides)
- “Best Practices in European and US Patent Law,” *Fish Patent Webinar* (May 12, 2022)
- “Managing Priority Between U.S. and European Patents: Minimizing Ownership, Same Invention, Scope, and Other Risks,” *Stratford Webinar* (July 29, 2021)
- “Coordinating Patent Prosecution in the U.S. and Europe,” *Fish Patent Webinar* (March 10, 2021)
- “Bringing University Research to Market: An IP Perspective,” *Boston Entrepreneurs’ Network* (May 2020)
- “The Section 101 Landscape,” *IP Counsel Breakfast at Flagship Pioneering* (December 2019)
- “IP Do’s and Don’ts for Startups,” *Presentation to Boston Entrepreneurs’ Network* (December 2019)
- “2018 Life Sciences Year in Review,” *Boston Seminar Series* (January 2019)
- “The ‘Muddy Metaphysics’ of Inventorship: What You Need to Know,” (June 2016)
- “Patent Eligible Subject Matter” *Partners Healthcare* (May 2016)
- “Patents – Just the Basics” *The Massachusetts Eye & Ear Infirmary and The Schepens Eye Research Institute* (March 2016)
- “Biotech & Pharmaceutical Patent Cases: 2015 Year in Review” (January 2016)
- “Is My Project Patentable? (And What Does that Really Mean?)” *Boston Children’s Hospital* (June 2015)
- “Nature-Based Products and Abstract Ideas under Recent PTO Guidance and Court Decisions

- Is There New Hope under Section 101?” *Illumina’s Patent Department* (February 2015)
- “Patent Cases at the Supreme Court and Federal Circuit: Significant Cases in 2013,?” *University of Massachusetts Commercial Ventures and Intellectual Property Case Managers’ Meeting* (January 2014)
- “Recent Changes in US Patent Law,,” *Mass Eye & Ear Infirmary and the Office of Intellectual Property & Commercial Ventures* (July 2013)
- “Changes in US and European Patent Law: What YOU need to Know,,” *University of Massachusetts Commercial Ventures and Intellectual Property Case Managers Meeting* (February 2013)
- The “America Invents Act”: What You Need to Know, *University of Massachusetts Commercial Ventures and Intellectual Property Case Managers Meeting* (October 2011)
- The “America Invents Act”: What You Need to Know, *Boston Breakfast Seminar Series* (September 2011)
- “Biotech and Pharmaceutical Patents at the Federal Circuit: 2010 Year in Review,,” Seminar on biotech and pharmaceutical IP law topics (January 2011)
- “2010 Patent Law Update,,” *Seminar for University of Massachusetts Technology Transfer Office* (April 13, 2010)
- “Innovations in Patent Law in Europe and the U.S.: What European Companies Need to Know to Protect Their Most Important Assets,,” Munich, Germany (February 2009)
- “Innovations in Patent Law in Europe and the U.S.: What European Companies Need to Know to Protect Their Most Important Assets,,” Munich, Germany (January 2008)
- “Beyond KSR: What is Obvious Today?,,” *Massachusetts Association of Technology Transfer Offices seminar* (January 2008)
- “Current Trends in Investing in the Very Small,,” *3rd Annual Nanotech and Microtech Investors Forum* (December 2007)
- “Do’s and Don’ts for Biotech Startups,,” *BIO 2007* (May 2007)
- “Going Green: Ins and Outs of Growing a Green Start Up,,” *2007 World Congress on Industrial Biotechnology and Bioprocessing* (March 2007)
- “Innovations in Patent Law in Europe and the U.S.: What European Companies Need to Know to Protect Their Most Important Assets,,” Munich, Germany (January 2007)
- “The Application of Tiny Technologies to Real Products – An Industry Perspective,,” *2nd Annual Nanotech Investors Forum* (December 2006)
- “Innovations in Patent Law in Europe and the U.S.: What European Companies Need to Know to Protect Their Most Important Assets,,” Munich, Germany (December 2005)
- “What You Need To Know About Nanotechnology” *Advanced Legal Studies Course at Suffolk University Law School, Boston, Massachusetts* (October 2004)

## Media Mentions

- Interview, “Patents in His Blood,,” *Angel Invest Boston Podcast* (March 2017)

## Recognition

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Recognized in “The World’s Leading Patent Practitioners” by *IAM Patent 1000* (2018-2022).

Recognized as a 2013 Top Rated – AV® Preeminent™ Lawyers in Intellectual Property Law and received the 2013 International Legal Award for Practice Excellence from *Corporate INTL Magazine*.

## Languages

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- English
- German