

# Tania Shapiro-Barr, M.D., J.D.

## VIKSNINS HARRIS PADYS MALEN LLP

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**Practice Areas:** Medical device and life sciences patent prosecution;  
trademark prosecution

### **Education**

**Juris Doctor, J.D.**, William Mitchell College of Law, May 2008

**Doctor of Medicine, M.D.**, University of Wisconsin Medical School, May 2005

**Bachelor of Science, B.S.**, University of Wisconsin-Madison, May 2001  
Medical Microbiology and Immunology

### **Bar Admissions**

- U.S. Patent and Trademark Office
- Minnesota

### **Experience**

**Viksnins Harris Padys Malen, LLP** • Bloomington, Minnesota • October 2021 – Present

*Partner*, January 2023- Present

*Senior Patent Counsel, Patent Attorney*, October 2021-January 2023

- Prepare and prosecute domestic and foreign patent applications for medical devices, biotechnology, and pharmaceuticals
- Provide legal opinions on patentability, freedom-to-operate, infringement, and patent validity
- Conduct due diligence analyses
- Prepare and prosecute trademark registrations
- Draft licensing agreements and assignments
- Develop IP strategies, manage patent portfolios, and provide general IP counseling to clients

**Dykema Gossett, PLLC** • Minneapolis, Minnesota • May 2013 – October 2021

*Partner*, January 2021-October 2021

*Senior Associate*, January 2016-December 2020

*Associate*, May 2013-December 2015

- Prepared and prosecuted domestic and foreign patent applications for medical devices, biotechnology, and pharmaceuticals
- Provided legal opinions on patentability, freedom-to-operate, infringement, and patent validity
- Conducted due diligence analyses
- Researched and wrote patent litigation briefs and memoranda
- Served as technical advisor in patent infringement cases
- Prepared and prosecuted trademark registrations
- Drafted licensing agreements and assignments
- Developed IP strategies, managed patent portfolios, and provided general IP counseling to clients

**Schwegman, Lundberg & Woessner, P.A.** • Minneapolis, Minnesota • January 2007 - October 2010

*Associate Patent Attorney*

- Prepared and prosecuted patent applications in the biotechnology, pharmaceutical, chemical, and medical device fields
- Provided legal opinions on infringement and patent validity
- Developed IP strategies and provided general IP counseling to clients

### **Select Seminars & Speeches**

- Medical Devices: The Interplay between Patent Law and the FDA Regulatory Process, AUTM Webinar, January 24, 2023.
- The Intersection of Regulatory and Intellectual Property Issues in the Medical Device World, Dykema Webinar, May 25, 2021.
- Intellectual Property Rights: Patent Basics and Strategies, Institute for Biomedical Entrepreneurship, April 29, 2021.

### **Select Publications**

- “3 Successful Strategies For Protecting Your New Biopharma’s IP,” *Outsourced Pharma*, September 1, 2021.
- “Avoiding a catch-22,” *Intellectual Property Magazine*, June 30, 2021.
- “Collaboration in the Race to Find a Covid-19 Vaccine,” *Intellectual Property Magazine*, October 2, 2020.
- “Biosimilars: Poised to Turn to Inter Partes Review to Resolve Patent Disputes,” *Metropolitan Corporate Counsel*, June 2015.
- “In re Kubin: Federal Circuit Ignores Principles of Structural Obviousness in Applying ‘Obvious to Try’ Test,” *Patent Strategy & Management*, July, 2009.
- “Federal Circuit Applies Bilski Standard in Classen,” *Patent Strategy & Management*, March, 2009.
- “Ex Parte Kubin: Board of Patent Appeals and Interferences Applies ‘Obvious to Try’ in Post-KSR Biotechnology Appeal,” *Patent Strategy & Management*, January, 2009.
- “Federal Circuit Split Decision on ‘Public Accessibility’ of Internet Posting,” *Patent Strategy & Management*, April, 2008.

### **Quoted**

- “10 Years Later, The AIA Is Not Done Reshaping Patent Law,” *Law360*, September 15, 2021.
- “De novo petitions not the same as patent protection, but some exclusivity available,” *BioWorld*, May 2021.
- “Nintendo’s \$10 Million Escape a Cautionary Patent Law Tale,” *Bloomberg Law*, February 6, 2020.
- “Patent Legislation to Watch in 2020,” *Law360*, January 1, 2020.
- “Quick Alice Wins Dwindling in Wake of Berkheimer Ruling,” *Law360*, July 25, 2019.
- “Affirmation of USPTO Inter Partes Rights,” *World Intellectual Property Review*, April 25, 2018.
- “U.S. Supreme Court Divided Over Legality of Patent Reviews,” *WestLaw Journal*, December 5, 2017.
- “Oil States Arguments: SCOTUS Unlikely to Find IPRs Unconstitutional,” *Intellectual Property Magazine*, December 1, 2017.
- “SCOTUS hearing bodes well for IPR process, say lawyers,” *World Intellectual Property Review*, November 28, 2017.
- “5 Things To Watch As High Court Tackles AIA Reviews,” *Law360*, November 22, 2017.