

William A. Carroll, Ph.D.

Senior Counsel

Overview

Bill provides strategic patent counsel to clients in the chemical, pharmaceutical, and medical device areas. With a Ph.D. in Organic Chemistry and more than 20 years of experience in pharmaceutical research, he brings a wealth of scientific expertise to his patent prosecution, counseling, and opinion practice.

Clients rely on Bill's insight and counsel to successfully translate their innovations into intellectual property assets. His background and experience as an inventor on 50 U.S. patents allow Bill to create tailored solutions for clients in the intersecting realms of law, science, and technology.

He provides advice on the full spectrum of patent portfolio management, including: patent prosecution and drafting; global patent portfolio management; counseling on infringement and validity, freedom-to-operate, patentability analysis, and due diligence investigations; development of design around strategies; and prior art search and analysis.

Bill has deep experience with the following technologies:

- Small molecule drugs
- siRNA and delivery vehicles
- Oligosaccharides
- Pharmaceutical formulations
- Immune oncology treatments
- Bone regeneration treatments
- Batteries
- Refrigerants and propellants
- Catalysts
- Polymers
- Medical devices

Prior to entering firm practice, Bill spent nearly 20 years working in research and patent roles for Abbott Laboratories, a global healthcare company.



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Industries

Life Sciences

Water

Practices

Intellectual Property

Patent

Experience

- Developed a global strategy for filing, prosecuting, and determining inventorship for a client's patent portfolio covering small-molecule drugs and their collaborator's delivery technologies. This included working proactively with foreign counsel to anticipate and avoid potential ownership, enforcement, and double patenting issues in various overseas jurisdictions. Resulted in successfully securing patents covering the intellectual property solely owned by the client separate from that owned jointly with the collaborator
- Represented major pharmaceutical companies in conducting due diligence investigations of the intellectual property assets involved in potential multimillion dollar acquisitions or license agreements
- Procured patents covering complex technologies involving pharmaceuticals, medical devices, batteries, and refrigerants by working seamlessly with clients, inventors, and experts to develop the persuasive technical evidence and legal arguments that lead to grant

Honors & Recognitions

- Abbott Laboratories President's Award, 2000, 2007
- Abbott Laboratories Chairman's Award, 1999

During law school, Bill received the following honors and awards:

- CALI Award for Remedies, Summer 2011
- The John Marshall Law School Homer Schneider Scholarship Award, 2010
- ABA-BNA Award for Excellence in the Study of Intellectual Property Law, 2010
- CALI Award for Professional Responsibility, Summer 2010
- CALI Award for Estates and Trusts, Spring 2010

Professional Activities

- Member, American Chemical Society
- Member, American Bar Association
- Member, American Intellectual Property Law Association
- Member, Intellectual Property Law Association of Chicago

Education

- The John Marshall Law School, Juris Doctor (J.D.), *magna cum laude*, 2012
- Indiana University Bloomington, Doctor of Philosophy (Ph.D.), 1993; Organic Chemistry
- University of Illinois, Bachelor of Science (B.S.), 1985; Chemistry

Admissions

- Illinois
- United States Patent and Trademark Office
- United States Supreme Court

Related News

PUBLICATION

December 3, 2018

Pharmaceutical Dosage Form Claims Held Not Enabled in USPTO Post-Grant Review

PUBLICATION

November 6, 2017

Law360

Demystifying Inherent Obviousness