



N. SCOTT PIERCE

Principal
Concord office
978.341.0036 x 3228
Scott.Pierce@hbsr.com

Practice Areas

- Patents
- Counseling

Education

- University of Connecticut, B.S.E. in Chemical Engineering
- University of Connecticut, B.S. in Business Administration
- University of Connecticut, M.B.A.
- State University of New York School of Law at Buffalo, J.D.

Technologies

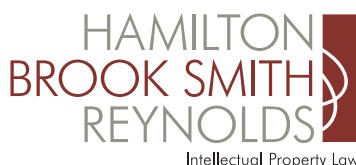
- Chemical Engineering
- Biotechnology and Life Sciences
- Chemistry
- Material Sciences
- Biologics and Immunotherapies
- Clean Technology
- Medical Devices
- Pharmaceuticals
- Robotics
- Mechanical Engineering
- Medical Imaging

Scott practices in the areas of biotechnology, chemistry, chemical engineering, electronics, medical devices, and pharmaceuticals. Recent work has included semiconductors, heterojunction bipolar transistors, lithium ion batteries, abdominal and thoracic stent grafts, biomechanics, renewable energy, water denitrification, antioxidants, wearable computers, nanotechnology, living cationic polymerization, and medical imaging.

In addition to preparing and prosecuting U.S. and foreign patent applications, Scott files and prosecutes trademark applications, conducts due diligence analyses and prepares legal opinions directed to patent infringement, inventorship and validity issues. He reviews license agreements, supports litigation, and sits on client patent committees. He has been practicing intellectual property law for over 25 years and is a member of the firm's Management Committee.

Scott regularly lectures on topical issues of intellectual property law and has authored several academic articles on intellectual property addressing such topics as written description, utility, inherency, experimental use, obviousness, statutory eligibility and the America Invents Act. He is an Adjunct Professor at Suffolk University Law School teaching biotechnology patent law and was a Senior Editor of the Buffalo Law Review.

In March 2017, Scott traveled to New Zealand and met with senior officers of the Intellectual Property Office of New Zealand (IPONZ) to discuss updates in New Zealand Patent Law and eligibility under U.S. and New Zealand patent law. While in New Zealand, Scott participated in the presentation of seminars to several New Zealand-based law firms, as well as organizations and start-up companies supported by the Ministry of Business, Innovation & Employment of New Zealand. The seminars covered recent case law and U.S. Patent Office guidelines for determining patent eligibility, and general strategies for protecting the innovations of start-up companies in view of current U.S. intellectual property law.



Professional Associations

- American Bar Association
- Massachusetts Bar Association
- Boston Patent Law Association
- American Intellectual Property Law Association
- Tau Beta Pi

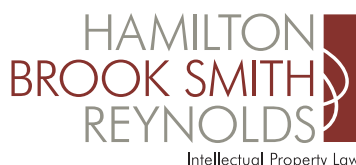
Admissions

- U.S. Court of Appeals for the Federal Circuit
- U.S. District Court, District of Massachusetts
- U.S. Patent and Trademark Office
- U.S. Supreme Court
- Connecticut
- Massachusetts

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Articles

- The Constitutionality of *Inter Partes* Review Is Before the Supreme Court, *Hamilton Brook Smith Reynolds IP Extracts*, November 15, 2017
- Intellectual Property: How Medtech Startups Can Protect It, *Medical Design & Outsourcing*, August 7, 2017
- 3 Patent Eligibility Statute Proposals - And An Alternative, *Law360*, July 31, 2017
- Deleted Teachings and Incorporation by Reference, *Hamilton Brook Smith Reynolds IP Extracts*, June 27, 2017
- The Supreme Court's Denial of Laches as a Defense to Patent Infringement, *Hamilton Brook Smith Reynolds IP Extracts*, June 27, 2017
- Possible New Approach to Negate Failure to Mark as a Limitation on Damages Under 35 U.S.C. § 287, *Hamilton Brook Smith Reynolds IP Extracts*, June 27, 2017
- On-Sale Bar to Patent Protection Under the AIA, *Hamilton Brook Smith Reynolds IP Extracts*, June 27, 2017
- Patent Eligibility as a Function of New Use, Aggregation, and Preemption Through Application of Principle, *Richmond Journal of Law & Technology*, May 19, 2017
- A Conundrum for Time Bars to Institution of *Inter Partes* Review in *Wi-Fi One, LLC v. Broadcom Corp.*, *Boston Patent Law Association Newsletter*, February 28, 2017
- Dance Marches On For Biosimilars In *Amgen V. Sandoz*, *Law360*, January 13, 2017
- Lexmark Could Profoundly Impact Patent Exhaustion, *Law360*, December 5, 2016
- *In re Aqua Products*: Claim Amendments During *Inter Partes* Review, *Boston Patent Law Association Newsletter*, October 2016
- Recent Limitations On Patent Term Adjustment For 'A' Delay, *Law360*, March 9, 2016
- Severability Of Joint Inventor's Disclosed Work Under AIA, *Law360*, January 12, 2016
- Inventorship, Double Patenting, and the America Invents Act, *Berkeley Technology Law Journal* (Volume 30, Issue 2), December 1, 2015
- A Great Invisible Crashing: The Rise and Fall of Patent Eligibility through *Mayo v. Prometheus*, *Fordham Intellectual Property, Media & Entertainment Law Journal* (Volume XXIII) 2012
- The Effect of the Leahy-Smith America Invents Act on Collaborative Research, *Journal of the Patent and Trademark Office Society*, August 27, 2012
- *Ariad Pharmaceuticals et al. v. Eli Lilly & Co.*: A Question of Possession, *BNA's Life Sciences Law & Industry Report*, May 21, 2010
- Common Sense: Treating Statutory Non-Obviousness As a Novelty Issue, *Santa Clara Computer and High Technology Law Journal*, June 2009
- A New Day Yesterday: Benefit as the Foundation and Limit of Exclusive Rights in Patent Law, *The John Marshall Review Of Intellectual Property Law*, January 2007



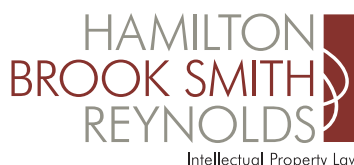
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Article (continued)

- Improper Claiming of Small Entity Status Can Cost You Your Patent - Illinois Court Holds Patents Invalid Pursuant to A Finding of Inequitable Conduct Based on Improper Claim to Small Entity Status, *Boston Patent Law Association Newsletter*, September 2006
- In Re: Dane K. Fisher: An Exercise in Utility, *Journal of High Technology Law*, 2005
- University of Rochester V. G.D. Searle & Co.: Writing on the Wall, *The John Marshal Review of Intellectual Property Law*, 2005
- *SmithKline Beecham Corp. v. Apotex: Experimental Use as Applied to Claim Scope*, 86 J. Pat. & Trademark Off. Soc'y 981 (2004)

IP News Alerts

- Federal Circuit Decides that State Law is Preempted by Biosimilar Act in *Amgen v. Sandoz*, *Hamilton Brook Smith Reynolds Alert*, December 19, 2017
- Federal Circuit Withdraws Burden Of Persuasion From Patent Owner In *In Re Aqua Products, Inc. v. Joseph Matal*, *Hamilton Brook Smith Reynolds Alert*, October 5, 2017
- Supreme Court Strengthens and Broadens Exhaustion Doctrine, *Hamilton Brook Smith Reynolds Alert*, June 1, 2017
- US Supreme Court Limits Patent Infringement in Foreign Cases in *Life Technologies Corp. v. Promega Corp*, *Hamilton Brook Smith Reynolds Alert*, February 27, 2017
- Federal Circuit Broadens Base for Patent Eligibility in *Amdocs v. Openet Telecom*, *Hamilton Brook Smith Reynolds Alert*, November 18, 2016
- Review of Patent Exhaustion by Supreme Court Likely in *Impression v. Lexmark*, *Hamilton Brook Smith Reynolds Alert*, November 2, 2016
- Federal Circuit *en banc* Vacates Obviousness and Noninfringement of Patents in *Apple, Inc. v. Samsung Electronics*, *Hamilton Brook Smith Reynolds Alert*, October 13, 2016
- Supreme Court to Review *Inter Partes* Claim Construction Standard Under AIA, *Hamilton Brook Smith Reynolds Alert*, January 19, 2016
- Patent Office Publishes Relaxed Interim Guidelines for Determining Patent Eligible Subject Matter, *Hamilton Brook Smith Reynolds Alert*, December 16, 2014
- Breaking News - Supreme Court Tosses Federal Circuit Standard for "Claim Definiteness" Requirement, *Hamilton Brook Smith Reynolds Alert*, June 2, 2014
- Cloned Sheep "Dolly" Is Not Patentable, But..., *Hamilton Brook Smith Reynolds Alert*, May 14, 2014
- Supreme Court to Address Claim Definiteness in *Nautilus, Inc. v. BioSig Instruments, Inc.*, *Hamilton Brook Smith Reynolds Alert*, January 16, 2014
- Eligibility of Computer and Software-Related Patents is Again Before the Supreme Court, *Hamilton Brook Smith Reynolds Alert*, September 23, 2013



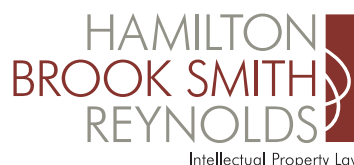
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IP News Alerts (continued)

- Filing a Petition for Inter Partes Review or Post-Grant Review Can Stay Other Patent Office Post-Grant Proceedings, *Hamilton Brook Smith Reynolds Alert*, August 23, 2013
- Supreme Court Rules on Patentability of Genes in *Myriad*, *Hamilton Brook Smith Reynolds Alert*, June 19, 2013
- Federal Circuit Splinters on the Topic of Patent Eligibility Criteria in *CLS Bank Int'l v. Alice Corp.*, *Hamilton Brook Smith Reynolds Alert*, May 21, 2013
- Transitional Program for Covered Business Methods: Scope and Distinctions from Post-Grant Review, *Hamilton Brook Smith Reynolds Alert*, January 8, 2013
- Isolated DNAs: "Products of Man" - Federal Circuit Repeats Decision in *AMP v. USPTO* and *Myriad* on Remand, *Hamilton Brook Smith Reynolds Alert*, August 2012
- Senate Passes Leahy-Smith America Invents Act, *Hamilton Brook Smith Reynolds Alert*, September 2011
- Claiming Small Entity Status Can Present Big Risks, *Nilssen v. Osram Sylvania*, *Hamilton Brook Smith Reynolds Alert*, July 2006

Speaking Engagements

- "Effective Tools & Techniques to Minimize Section 101 Rejection in a Patent Prosecution Minefield," The Knowledge Group Webcast, October 4, 2017
- "Innovation in Life Sciences: Demystifying Patent Eligibility," Hamilton Brook Smith Reynolds Lecture, Cambridge, MA, June 14, 2017
- "Patent Eligibility Case Law and U.S. Patent Office Guidelines," presented to Law Firms and Government-Supported Organizations in New Zealand, March 2017
- "Strategies for Protecting Innovations of Start-Ups and Case Studies in View of U.S. Intellectual Property Law," presented to Technology-Based Start-Up Companies in New Zealand, March 2017
- "Strategies and Considerations for Protecting Your Medical Technology Start-Up's Innovations," Hamilton Brook Smith Reynolds Lecture, Cambridge, MA, November 29, 2016
- "The Past, Present and Future of Obviousness-Type Double Patenting," Boston Bar Association Lecture, Boston, MA, April 7, 2015
- "Wake Up with the Experts: Fresh Squeezed CLE - Patentability of Genes in Light of the Supreme Court's Decision," Suffolk University Law School Lecture, Boston, MA, July 17, 2013
- "Derivation and Common Ownership Under the America Invents Act," Hamilton Brook Smith Reynolds Webcast, June 6, 2013
- "How to Protect Your Patent Rights in View of Public Disclosure under the America Invents Act (AIA)," Hamilton Brook Smith Reynolds Webcast, May 9, 2013
- "Avoiding Intellectual Property Problems in Research Collaborations Using Information Technology," Bio-IT World Conference & Expo '13, Boston, MA, April 9, 2013



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Speaking Engagements (continued)

- “Innovation and Patent Eligibility - Theories and Application to Current Cases,” Hamilton Brook Smith Reynolds Lecture, Boston, MA, January 28, 2013
- “America Invents Act - Copying of Inventions and Removal of Prior Art,” ACC America - Northeast Chapter Lecture, Waltham, MA, July 11, 2012
- “Why and How to Build a Patent Estate/Recent Changes in Patent Law,” Connecticut Law Tribune In-House CLE Lecture, Stamford, CT, May 16, 2012
- “Manufacturing’s Evolving Landscape,” Worcester Polytechnic Institute Venture Form, Worcester, MA, April 10, 2012
- “Critical Changes in Patent Law and Practice,” Suffolk University Law School Center for Advanced Legal Studies Program, Boston, MA, February 24, 2012
- “Catalyzing Innovation - Industry/Academic Collaborations,” MassMEDIC Seminar, Mass. Medical Society, 860 Winter Street, Waltham, MA, January 27, 2012
- “Leahy-Smith America Invents Act,” Hamilton, Brook, Smith & Reynolds, P.C. Breakfast Series, Waltham, MA, October 12, 2011
- “The Latest Development in Intellectual Property Law,” Suffolk University Law School Center for Advanced Legal Studies Program, Boston, MA, February 4, 2011
- “Difficult Burden: Did Ariad v. Lilly Strike the Right Balance for Incentivizing Emerging Technologies?” Boston Patent Law Association Seminar, April 29, 2010
- “Ariad v. Eli Lilly: Written Description as a Function of Enablement,” Suffolk University Law School Intellectual Property Brown Bag Luncheon Series, Boston, MA, November 4, 2009
- “The Impact of Patent Law on the Economy-Stimulus or Impediment?” Suffolk University Law School Center for Advanced Legal Studies Program, Boston, MA, March 27, 2009
- “Resolving Uncertainty in Biotechnology Patent Law-Safe Harbor/Experimental Use, Inherency, Obviousness of Utility,” Suffolk University Law School Center for Advanced Legal Studies Program, Boston, MA, November 18, 2005

