

Martin S. Masar, III, PhD

Counsel

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Practices

FOCUS: Intellectual Property
Antitrust and Competition
Appeals and Critical Motions
Entrepreneurial Ventures
Intellectual Property Litigation
Patent Litigation and Patents
Pharmaceutical and Life Sciences Litigation
Trademarks and Trademark Litigation

Industries

Education
Pharmaceutical and Life Sciences
Technology

Education

JD, DePaul University College of Law
PhD, Northwestern University, Inorganic Chemistry
BS, Gettysburg College, Chemistry

Bar Admissions

Illinois

Court Admissions

US Patent & Trademark Office
US District Court, Northern District of Illinois

Community Involvements

American Chemical Society
Phi Kappa Phi

Dr. Martin Masar litigates disputes requiring advanced knowledge in the scientific fields of chemistry, the pharmaceutical arts, nanotechnology and biotechnology, especially related to intellectual property rights. He regularly advises clients on matters involving pharmaceutical and cosmetic products, including Hatch-Waxman Act litigation, where he has substantial trial experience. He also provided intellectual property prosecution, opinion work, due diligence and counseling. Finally, Marty also has experience in antitrust litigation.

Diverse scientific knowledge and litigation experience

In addition to his extensive Hatch-Waxman work, Marty has also been involved in patent, trademark, antitrust and unfair competition disputes related to pharmaceutical, cosmetic and consumer products. His work extends to other scientific subject matter as well; he has litigated cases involving electrical engineering, computer engineering and software. Those cases have involved, for example, fighter pilot heads-up displays, security-camera monitoring software, run-tracking apps and web-security software.

Marty has prosecuted patent applications for clients from an array of technical fields, including topical skin creams for therapeutic uses, nanotechnology-based mass spectrometry methods and apparatus, nanotechnology-based computer chip coolers, radiation therapy methods for cancer treatment, breathable polymers, fire-detection systems, medicine-dispensing systems and methods, and dietary supplements.

As part of his doctoral studies, Marty worked with Professor Chad A. Mirkin at Northwestern University. His dissertation research related to the synthesis and development of protein mimics that were useful in catalysis and sensing applications. His work led to six publications in peer-reviewed technical journals, including *Journal of the American Chemical Society* and *Accounts of Chemical Research*. Marty received one of the 100 annual fellowships from the Multidisciplinary University Research Initiative (MURI), a division of the US

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Department of Defense. In law school, Marty was on law review and graduated in the top 5% of his class, while also receiving numerous CALI awards for best marks in both intellectual property and legal writing classes, among others.

Representative Experience

- Represented Apotex, Inc. in a case involving a generic version of the billion-dollar-a-year narcolepsy drug Provigil. Applying the stringent *Therasense* standard for inequitable conduct, the court found that Apotex proved inequitable conduct by clear and convincing evidence. The court also found the patent invalid and that Apotex's proposed product did not infringe. This ruling opened the door for Apotex's antitrust claims, which are still being litigated.
- Represented Apotex, Inc. in patent infringement case relating to its proposed generic version of linezolid tablets, an antibiotic.
- Defended Apotex, Inc. against alleged infringement of Alcon's patents on a generic version of the eyedrop Patanol. Proved that most of the asserted patent claims were obvious.
- Represented a pharmaceutical corporation in (modafinil) patent litigation in the US District Court for the Eastern District of Pennsylvania. Issues of infringement, invalidity and unenforceability were resolved in client's favor.
- Represent pharmaceutical company in patent infringement action asserting claims to certain methods for the manufacturing process for a stable form of quinapril magnesium.
- Defended manufacturing conglomerate against claims that it monopolized or attempted to monopolize the sale of disposable training pants.

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Publications

- *The Katten Kattwalk* (Triannual) | *Contributor*
- Modern Regulatory Frameworks for the Use of Genetic and Epigenetic Underwriting Technology in Life Insurance (January 4, 2021)
- FDA Reduces Regulatory Uncertainty with New Finalized Rule Defining "Biological Product" under BPCIA to Include Insulin and Other "Protein"-Based Products (February 28, 2020)
- Federal Circuit Issues Opinion on "Inherent Obviousness" in Patent Claim, Invalidating Orange Book Listed Pharma Patent (January 23, 2020)
- US Supreme Court Limits Venue in Patent Cases—Is It the Death Knell for Forum Shopping? (May 22, 2017)
- Courts' Findings of No Invalidity Are Not Binding on the Patent Office in *Inter Partes* Reviews (April 10, 2017)
- Finally! FDA Issues a Draft Guidance on Interchangeable Biosimilars (March 8, 2017)
- U.S. Supreme Court Alters Standard for Design Patent Damages and Takes Apple's \$400 Million Victory Over Samsung Away (At Least for Now) (December 7, 2016)
- US Supreme Court Adds to District Court's Ability to Award Enhanced Patent Damages (June 15, 2016)
- *Katten Patent Review* (Spring 2015)
- US Supreme Court Eliminates "Good-Faith Belief of Invalidity" Defense for Induced Patent Infringement (May 26, 2015)
- What Form Is It? Lessons From 13 Polymorph Pharmaceutical Cases (April 17, 2015)
- How Amending ANDA Specifications Can Win or Lose Pharmaceutical Patent Litigation (April 1, 2015)

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- Federal Circuit Issues Decision Affirming Obviousness of a Molecule Patent Claim (June 16, 2014)
- 2009 Year-End Intellectual Property Issues Advisory (December 2009)
- Effects of the Federal Circuit Judges on Hatch-Waxman Litigation, Masar, Martin S. III, *19 DePaul J. Art Tech. & Intell. Prop. L.* 315. (2008–2009)

Presentations and Events

- What Form Is It? Lessons From 13 Polymorph Pharmaceutical Cases (August 20, 2015) | *Presenter*