

Courtney J. Miller

Partner



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Practices/Industries

- Intellectual Property
- Patent Prosecution, Drafting & Counseling
- IP Licensing
- Patent Litigation

Education

The College of Wooster
(B.A., Biology, 1989)
Capital University Law School
(J.D., 1998)
(LL.M., 2002)

Overview

Courtney is a registered patent attorney with more than 20 years of experience. In his practice, he focuses on U.S. and foreign patent procurement, IP portfolio management, patent opinions, technology development and commercialization, technology transactions, and various regulatory issues involving medical devices. He has drafted, filed, and successfully prosecuted hundreds of patent applications for his clients.

Courtney counsels clients in a wide variety of industries, and has experience with biotechnology, molecular biology, immunology, medical devices, drug delivery systems, welding and joining technologies, consumer products, and more. He has worked with companies of all sizes and with research-based hospitals and universities and has been an in-house counsel at a large contract research organization. He has successfully negotiated numerous transactions related to the licensing and commercialization of new products and technologies. Courtney also engages in patent litigation and provides clients with legal opinions such as freedom-to-operate, non-infringement, invalidity, and patentability opinions. He also frequently works with clients to obtain USFDA approval for medical devices through the 510(k) premarket notification and 513(g) processes.

Before practicing law, Courtney was directly involved in numerous complex research programs sponsored by industrial, commercial, and governmental clients during the 10 years he spent as a research scientist in the biotechnology and medical products groups at Battelle Memorial Institute in Columbus, Ohio.

Experience

- Counsels clients through all phases of product and technology development - from initial concept through product launch or exit.
- Directs the development of domestic and global IP strategies.
- Manages large domestic and foreign patent and trademark portfolios.
- Conducts due diligence for new product development and commercialization.
- Creates client-specific intellectual property capture, protection, and commercialization strategies.
- Prepares and prosecutes U.S. patent applications (utility and design) including the areas of: medical and surgical devices, molecular biology, immunology, and biotechnology, chemical compositions, formulations, and processes, nanotechnology, polymers, drug delivery systems and devices, mechanical systems and devices, materials consumer and household products, sporting goods, computer software, and business methods.
- Prepares non-infringement, invalidity, and freedom-to-operate opinions with particular expertise in pharmaceuticals, medical devices, welding and joining technologies, and consumer products.
- Experience with medical devices and medical reagents including T-cell based diagnostics and therapeutics, biomarkers, nucleic acid sequencing, antibodies, cell-based pathogen and target analyte detection systems, biosensors, and organoids.

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Experience (Cont)

- Negotiates and drafts technology-oriented transactional agreements including; patent and trademark license agreements, technology transfer agreements, sponsored research agreements, manufacturing and distribution agreements, joint venture agreements, confidentiality and non-disclosure agreements, non-compete agreements, and asset purchase agreements.
- Prepared and prosecuted hundreds of patent applications before the U.S. Patent and Trademark Office.
- Previously worked as in-house counsel of a large, international technology company and as well as managing the intellectual property portfolio and conducting contract research and development.

Presentations

- “Patentable Subject Matter,” BioOhio Expo & Showcase (July 2016)
- “Enforcement of Trade Secrets – What You Need to Know,” CLE Presentation at Rev1 Ventures (October 2015)
- “Trade Secrets & Non-Compete Agreements: What Is Enforceable in Ohio?” Business Breakfast Briefing (September 2014)
- “Technology Transactions,” Business Breakfast Briefing (February 2014)

Publications

- “From Concept to Patent Number: A road map for a productive relationship between inventors and patent counsel,” Corporate Counsel Business Journal (January 2016)
- “Safeguarding Trade Secrets: What You Need To Know,” MWN Publication (November 2015)

Involvement

Professional Affiliations

- Columbus Bar Association
- Ohio State Bar Association
- American Intellectual Property Law Association (AIPLA)
- Columbus Intellectual Property Law Association (Past Secretary, Vice President, and President, 2000-2003)
- Appointed Special Counsel to the Ohio Attorney General for Patent and Trademark Matters
- Intellectual Property Owners Association

Community Involvement

- Cystic Fibrosis Foundation—Central Ohio Chapter (Board of Directors, Chair of Fundraising, 2018-2019)
- Friends of the Lower Olentangy Watershed (Board of Directors, 2003-2007)
- Team Battelle/Battelle Rivers and Streams Beautification Project (Sponsor, Participant, 2000-present)

Admissions

- State of Ohio
- U.S. Supreme Court

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Admissions (Cont)

- Court of Appeals for the Federal Circuit
- U.S. District Court, Northern District of Ohio
- U.S. District Court, Southern District of Ohio
- U.S. Patent & Trademark Office