

Vinit Kathardekar

Registered Patent Attorney

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PRACTICE AREAS

[Intellectual Property](#)
[Life Sciences](#)
[Patent Services](#)
[Intellectual Property](#)
[Transactional Services](#)
[Trademark & Copyright](#)
[Services](#)

EDUCATION

Widener University School
of Law (J.D.)
The University of Akron,
(M.S., Organic Chemistry)
Pepperdine University,
(MBA)

ADMISSIONS

California
Pennsylvania
United States Patent and
Trademark Office

OVERVIEW

Vinit Kathardekar is a registered patent attorney and has over 25 years of legal experience, primarily in the pharmaceutical and chemical field. He holds a B.Sc. in Chemistry, MS in Organic Chemistry, a JD, and an MBA. Vinit is admitted to all the state and federal courts of California and Pennsylvania and is registered to practice before the United States Patent and Trademark Office. Prior to entering the legal field, Vinit worked as a research chemist for large and small pharmaceutical corporations. His scientific and legal experience provides him with a strong background to represent pharmaceutical and chemical companies.

Vinit has worked in-house as well as been in private practice. Vinit's patent experience includes drafting and prosecuting patent applications for protecting new chemical entities, including small molecule drug candidates, and evaluating and formulating strategies for protecting technologies in chemical and pharmaceutical areas. Additionally, Vinit is experienced in providing freedom to operate, patentability and non-infringement opinions, conducting due diligence for technology licensing, analyzing prior art searches, and developing IP portfolios for new products and technologies. Vinit is well versed in providing general legal support including reviewing and negotiating licensing agreements, clinical trial agreements, joint collaboration agreements, CDAs, and MTAs, and filing and prosecuting TM applications.

Vinit works with clients in creating and developing cost-effective, strategic intellectual property (IP) portfolios. He was instrumental in developing the combinatorial chemistry patent portfolio resulting in acquisition of the combinatorial chemistry assets. Additionally, his legal experience encompasses numerous technologies such as novel antibiotics, cancer therapeutics, cardiovascular therapeutics, drug delivery, drug discovery, nanotechnologies, antioxidants, nutraceuticals and dietary supplement technologies, and medical devices.

In addition to the creation and management of IP portfolios and related counseling, Vinit's experience includes commercialization of IP, including the negotiation and drafting of transactional agreements for the transfer of intellectual property rights, such

as IP licenses, material transfer agreements, strategic collaborations, mergers and acquisitions, as well as conducting due diligence related licensing activities.

Currently, Vinit volunteers as a Consultant/Mentor at Silicon Valley SCORE providing legal and business advice to entrepreneurs in starting new business ventures, advising on strategies to protect new products, and advising on general business related legal and commercial strategies. Vinit is also an inventor on granted patents and pending and patent applications, and an entrepreneur who has developed and marketed consumer products.

REPRESENTATIVE MATTERS

- Drafting and negotiating licensing agreements, manufacturing agreements, joint collaboration agreements, service agreements, clinical trial agreements, vendor agreements, CDA's, and MTA's.
- Drafting and prosecuting pharmaceutical and chemical patent applications, managing global patent dockets, advising on IP development and ownership issues, developing in-house document retention policies, and IP docketing systems.
- Experienced in drafting FTO and patentability opinions, IP due diligence for technology licensing and joint collaborations, and working with and managing outside counsel.
- Developing global patent strategies for product life cycle management and corporate development.
- Filing and prosecuting trademark applications.

Collaborations / Licensing

- Represented a large multinational pharmaceutical corporation for in-licensing a clinical candidate in a deal worth over \$200 million USD.
- Represented a pharmaceutical company in integrating in-licensed approved therapeutics
- Represented a pharmaceutical company in transferring technology and assets in a deal valued over \$50 million USD.

Representative Filed and/or Prosecuted Patents

- S. Patent 9,402,701 Positionable delivery device and method
- S. Patent 8,415,381 Heteroaryl compounds and their uses
- S. Patent 7,932,262 Quinazolines for PDK1 inhibition
- S. Patent 7,820,646 Cyclized derivatives as Eg-5 inhibitors
- S. Patent 6,919,327 Texaphyrin coordination compounds and uses thereof

- S. Patent 6,150,379 Compounds and compositions as anticoagulants
- S. Patent 7,678,826 Organic compounds for the treatment of inflammatory or allergic conditions
- S. Patent 6,069,248 Process for the synthesis of triazolopyridazine compounds
- S. Patent 5,801,262 Process for preparing polysiloxane microspheres with a narrow size distribution
- S. Patent 5,773,502 Fire Retardant Blends
- S. Patent 5,767,225 High melting fast crystallizing copolymer compositions
- S. Patent 5,726,270 Process for the synthesis of mono-modal aqueous dispersions of polysiloxanes
- S. Patent 5,716,589 Method for making reaction products of phosphorus pentachloride and ammonium chloride

SEMINARS / PUBLICATIONS

Publications and Presentations

- *Structure-Based Design of Substituted Diphenyl Sulfones and Sulfoxides as Lipophilic Inhibitors of Thymidylate Synthase*. Journal of Medicinal Chemistry, 1997, 40, 677-683.
- *Structure-Based Design of Lipophilic Quinazoline Inhibitors of Thymidylate Synthase*. Journal of Medicinal Chemistry, 1996, 39, 904-917.
- *Inactivation of Yeast Alcohol Dehydrogenase by Nitropropionamides*. Journal of Enzyme Inhibition, 1994, Vol. 8 pp 133-146.
- *Design of Thymidylate Synthase Inhibitors Using Protein Crystal Structures: The Synthesis and Biological Evaluation of a Novel Class of 5-Substituted Quinazolines*. Med. Chem. 1993, 36, 733-746.

Speaking and Volunteer Engagements

- Guest Speaker at the National Conference on Rational Drug Design, Topic: Drug Discovery and Intellectual Property: November 7-8, 2008, Mumbai, India

IN THE COMMUNITY

- Currently a Consultant/Mentor at Silicon Valley SCORE: Providing legal and business advise to entrepreneurs in starting new business ventures, advising on strategies to protect new products, and advising on general business related legal

and commercial strategies.