

## Marilyn J. Chimes

[mchimes@scharfbanks.com](mailto:mchimes@scharfbanks.com)

224-374-9060

Marilyn J. Chimes concentrates her practice on complex litigation and life sciences. Dr. Chimes brings an unusual combination of experiences to the practice of law. A Doctor of Veterinary Medicine, with board certification in laboratory animal medicine, she has used her medical and pharmaceutical company experience in such areas as litigation, risk management and risk counseling, analysis of license and contract agreements, the development of medical, pharmaceutical and biotech products and other health-related engagements.

Marilyn has had hands-on experience in pre-clinical drug safety evaluation, protocol design, report drafting and review, and a range of planning analysis and writing in the area of biomedical research. She is also registered to practice before the United States Patent and Trademark Office and licensed in veterinary medicine and surgery in Illinois, New York and Michigan.

Marilyn has experience in intellectual property law, including infringement and validity opinions, licensing, contracts, litigation, and some patent and trademark prosecution. She has advised clients on the development, protection, marketing and defense of intellectual property. She also has extensive experience in health care law, including negotiation and drafting of corporate documents, agreements, policies and procedures. Her clients have been primarily pharmaceutical, medical device, and health care companies, as well as groups of health care professionals. In addition, Marilyn has represented closely held corporations and high net worth individuals in corporate and commercial matters, estate planning and real estate transactions.

Dr. Chimes received her D.V.M., with honors, from Michigan State University in 1979. She received her J.D., with high honors, from the Chicago-Kent College of Law in 1999 where she was awarded a Certificate in Litigation and Alternative Dispute Resolution, was



### **Practice Areas:**

Complex Litigation  
Intellectual Property  
Life Sciences

### **Education:**

J.D., Chicago-Kent College of Law, with high honors, 1999  
D.V.M., Michigan State University, with honors, 1979

### **Admissions and Qualifications:**

Illinois  
New Mexico  
U.S. District Court for the Northern District of Illinois  
Registered Patent Attorney, U.S. Patent & Trademark Office  
Licensed in Veterinary Medicine and Surgery, IL, NY, MI  
Diplomate of the American College of Laboratory Animal Medicine

### **Prior Experience:**

Jenner & Block, LLP (1999-2006)  
Schoeman, Updike, Kaufman & Scharf (2008-2012)

a Kent Legal Scholar and was admitted to the Order of the Coif.

## Experience

### Health

- Advised pharmaceutical, medical device, pharmacy, veterinary, medical association, hospital, and charitable organization clients about a wide variety of issues at the intersection of law and medicine.
- Counseled clients regarding regulations relevant to pharmaceutical compounds, medical devices, pharmacies, nursing facilities, animal shelters, veterinary practice, and personal health information in connection with various types of activities, events, and issues.
- Assisted clients in compliance with FDA regulations and HIPAA regulations.
- Drafted HIPAA policies, procedures, and authorizations, as well as business associate and data use agreements.
- Pharmaceutical and medical litigation, including litigation related to drugs, vaccines, drug-eluting coronary stents, Medicare/Medicaid fraud, advertising, and organ transplants.
- Counseled clients in various situations likely to lead to litigation.

### Intellectual Property

#### Patent Protection, Enforcement and Defense

- Worked on prosecution of patent applications relating to medical reference systems, diabetic health monitoring methods, treatment systems for amblyopia, intraocular lenses, saddletrees, and fuel filters.
- Prepared infringement and validity opinions relating to, among other things, patents for various technologies, including methods of medical treatment and drug delivery, blood glucose monitors, drugs, chemical enantiomers, beverages, and nutritional supplements.

- Counseled clients on patent strategies.

## **Patent Protection, Enforcement and Defense**

- Prepared trademark registrability and infringement opinions.
- Prosecuted applications for trademarks and service marks, including preparation of applications, responding to office actions, and advising clients.
- Worked with foreign associates to prosecute and assign trademarks and patents worldwide.
- Advised certifying organizations on licensing, enforcement, and liability issues with certification marks.

## **IPR Investigation, Enforcement and Litigation**

- Drafted and reviewed agreements relating to intellectual property, including agreements for licenses, nondisclosure of confidential information, services, supplies, distribution, research and development, marketing, joint litigation defense, and settlement of litigation.
- Participated in litigation involving disputes over intellectual property relating to biomarkers, canola oil, plastic packaging, light bulbs, a movie, and more.

## **Licensing, Distribution and Technology Transfer**

- Drafted and reviewed agreements relating to intellectual property, including agreements for licenses, nondisclosure of confidential information, services, supplies, distribution, research and development, and marketing.
- Advised clients on licensing negotiation and litigation strategies.
- Counseled pharmaceutical and medical device company clients on creation and dissolution of joint ventures for product development and marketing.

## Acquisitions and Dispositions of IPR and Technology Companies

- Obtained copyright registrations.
- Performed due diligence reviews and advised clients regarding intellectual property rights in connection with financing, acquisition, merger, and restructuring transactions.

## IPR-Related Antitrust Advice and Litigation

- Advised clients regarding various legal and business issues relating to patents, trademarks, and copyrights.

## Corporate

- Formed, maintained, merged, and dissolved for-profit and not-for-profit corporations and limited liability companies.
- Drafted contracts and service agreements for matters of research and development, employment, real estate purchases and sales, leases, publishing, and credit card payment processing.
- Prepared assignments of shareholder and partnership interests.
- Drafted and advised clients regarding letters to shareholders and donors.
- Counseled corporate and association clients on various matters including healthcare related regulations, exports, officer compensation, product liability, employment, employee benefits, real estate, intellectual property, tax, accumulated earnings, contracts, insurance, security, voting, bylaws, public relations.

## Professional Activities

### Bar

- American Bar Association
- Illinois State Bar Association
- American Intellectual Property Law Association

- State Bar of New Mexico
- Animal Law Section of the State Bar of New Mexico

## Community

- Tree House Animal Foundation Inc. (Vice President, Board of Directors, 2003-2006)
- Tree House Animal Foundation Inc. (Member, Board of Directors, 2001-2006)

## Professional Associations

- American Veterinary Medical Association
- American Veterinary Medical Law Association (Charter Member)
- American College of Laboratory Animal Medicine (Diplomate)
- American Society of Laboratory Animal Practitioners
- Association of Primate Veterinarians
- American Association for Laboratory Animal Science
- Albuquerque Aerostat Ascension Association

## PUBLICATIONS

- "Confidential and Proprietary Information," M.J. Chimes & P. Sankar, in J. Silverman et al. eds., *The IACUC Handbook* 503, CRC Press, 3rd ed. 2014.
- "Response to Protocol Review Scenario: Violators Beware!", 36(8) *Lab Animal* 13, September 2007.
- "Confidential and Proprietary Information," M.J. Chimes, L.B. Ergin, & K.A. Donohue, in J. Silverman et al. eds., *The IACUC Handbook* 407, CRC Press, 2nd Ed. 2007.
- "Medical Corporation," *Business Entities and Corporate Law in Illinois*, Matthew Bender, 2006.

- "Introduction," The Use of Toxicology in Tort Litigation: A Survey of Federal and State Jurisdictions, M.J. Chimes, S.A. Scharf & L.T. Spacapan, American Bar Association, 2005.
- "Corporate Responsibility and Corporate Compliance: A Resource for Health Care Boards of Directors," Jenner & Block Health Law Briefs, Chicago, Illinois, Fall 2003.
- "HHS Issues Interim Final Rule Requiring Electronic Submission of Medicare Claims," Jenner & Block? Health Law Briefs, Chicago, Illinois, Fall 2003.

## **SPEAKING ENGAGEMENTS**

- "Beyond the AWA: Other Protections for Research Animals," The Law and Bioethics of Using Animals in Research, State Bar of New Mexico Center for Legal Education, Albuquerque, New Mexico, August 2017.
- "Veterinary Medicine: The Role of Research in a Regulatory Agency," Food and Drug Law Institute Annual Conference, Washington, District of Columbia, April 2005.
- "Compounding Rx Symposium," Western Veterinary Conference, Las Vegas, Nevada, February 2005.