

Michael Santonocito

he/him

SENIOR COUNSEL

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About Michael

Patent counsel grounded in physics and USPTO knowledge

Michael Santonocito focuses on patent procurement for clients large and small across an array of technologies. With a background in physics, he is especially knowledgeable in the area of electro-optics, including image sensing, image projection and display, and photovoltaics. Michael's experience also includes prosecuting patent applications related to:

- **Semiconductor devices**
- **Wireless communication including 5G New Radio and IoT**
- **Nuclear, plasma and quantum technology**
- **Nanotechnology**
- **Medical imaging**

Michael prides himself on his ability to quickly assimilate a range of new technologies and his ability to generate creative solutions to serve his clients' larger business interests. He is known for achieving results even when faced with difficult patent examiners and complex arguments.

Before beginning his career as a practicing attorney, Michael was a patent examiner in the U.S. Patent and Trademark Office (USPTO) optics group.

Education and Honors

DePaul University College of Law (J.D.)

Michigan State University (B.S.)

Bar Admissions

Illinois

District of Columbia

Court Admissions

U.S. Patent and Trademark Office

Languages

Italian





Experience in Action

- **Advises on and develops patent portfolio and global enforcement and defense strategies, including preparing post-grant challenges in multiple jurisdictions**, such as PGR filings in the United States, preparing and filing pre-issuance third-party submissions, and developing successful arguments against post-grant challenges filed by competitors.
- **Helps clients' research and engineering teams** conduct invention harvesting sessions.
- **Educates inventors on patent and non-patent intellectual property avenues**, including trade secrets.
- **Prepares invalidity, patentability, freedom-to-operate** and infringement opinions and analyses.

Successes

- Managed a key technology area of a patent portfolio of a multinational consumer electronics corporation.
- Defended a mid-size company in inter partes dispute over electromechanical devices.
- Successfully sought invalidation of competitor's issued patent on behalf of a small biophotonics company.

Capabilities

Intellectual Property

Patent

Patent - High Tech

Patent - Manufacturing

Patent - University Research and Technology Transfer

Research Institutions & Higher Education

Technology Transfer

