



Marcie Beth Clarke, PhD

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Intellectual Property | Patents | Life Sciences | Venture Capital & Emerging Growth Companies

Marcie has a passion for understanding the science behind new products and technologies and is known for her responsiveness and attention to detail when advising clients.

Dr. Marcie Beth Clarke has earned a national reputation as a life science intellectual property lawyer, particularly in the fields of biotechnology, molecular biology, immunology, microbiology, molecular diagnostics, gene therapy, antiviral therapeutics, agriculture, and protein therapeutics.

In order to help clients develop effective IP strategies to protect and facilitate commercialization of pharmaceutical products and platform technologies, Marcie assists clients with patent drafting, worldwide patent prosecution, patentability analyses, patent validity opinions, freedom-to-operate opinions, competitive landscape analyses, and investigating and resolving inventorship disputes. She works with clients on intellectual property due diligence for financings, including initial public offerings (IPOs), and on licensing strategies, negotiations, and agreements. Marcie has worked with a broad range of clients, including start-ups, academic institutions, and established pharmaceutical companies.

Marcie won first place in the Boston Patent Law Association's 2010 Annual Writing Competition for her article entitled "The 'Separate' Written Description Requirement and its Impact on Biotechnology Patent Law" and graduated as Salutatorian from Suffolk University Law School. While at Suffolk University Law School, she received an Academic Leadership Tuition Scholarship and was awarded the Honorable Mention for her legal brief in the Legal Practice Skills Program.

Prior to law school, Marcie received her PhD in Molecular Microbiology from The University of Texas Southwestern Medical Center. She was the recipient of the Ruth Kirschstein Pre-doctoral Fellowship from the National Institutes of Health and has published scientific articles in several journals, including the Proceedings of the National Academy of Science. Marcie has presented her work at various scientific meetings, including the Gordon Conference on Sensory Transduction, and was a Richard and Mary Finkelstein invited speaker at the American Society for Microbiology General Meeting.

Outside of her busy practice, Marcie enjoys spending time with her husband and two children, traveling, and volunteering in the local community.

Representative Matters

Various life sciences clients—Worldwide IP and patent strategy

Strategized and implemented worldwide intellectual property and patent strategies for clients' lead product candidates and platform technologies in a variety of life science

areas, including gene therapy, microbiology, antibody therapeutics, T cell receptors, diagnostics, novel drug delivery mechanisms, vaccines, and agricultural products.

Various life sciences clients—Patent portfolio prosecution

Drafted and prosecuted a patent portfolio regarding delivery mechanisms for large protein therapeutics for a university, which was licensed by a start-up that was ultimately acquired by an international pharmaceutical company for about \$90 million, as well as an antibody therapeutic patent portfolio which was acquired by a large pharmaceutical company for about \$235 million.

Pharmaceutical company—Competitive landscape and freedom-to-operate analyses

Performed competitive landscape and freedom-to-operate analyses for clients' research programs and lead product candidates, including a freedom-to-operate clearance for a client's manufacturing process for a multimillion dollar per year therapeutic product.

Various biotechnology companies—Collaboration and license agreements

Assisted clients with intellectual property and patent negotiations with respect to collaboration and license agreements, including a collaboration agreement worth about \$80 million up-front and about \$1.4 billion in potential future payments.

Various biotechnology companies—IP due diligence

Performed intellectual property due diligence for multiple clients' financings and initial public offerings (IPOs), including sales of clients' common stock with net proceeds of about \$30 million, \$50 million, and \$75 million.

Education

Suffolk University Law School, JD Intellectual Property Law Concentration, Patent Law Specialization, *summa cum laude*, 2011

University of Texas Southwestern Medical Center, PhD Molecular Microbiology, 2005

University of Texas, BS Molecular Biology, 2001

Bar Admissions

Massachusetts

Vermont

U.S. Patent & Trademark Office

Memberships and Certifications

Boston Patent Law Association

Junior League of Boston
Secretary, 2014-2015

Recognitions*

Massachusetts Rising Star, *Super Lawyers*, 2016-2021

IAM Patent 1000, 2020-2023

* No aspect of this or any advertisement has been approved by the Supreme Court of New Jersey. For ranking methodologies, please see [here](#).

Alerts

New USPTO Proposal for Claim Interpretation in PTAB Proceedings Would Strengthen Patent Rights, Intellectual Property Alert , 5.10.2018

USPTO Issues Guidance on PTAB Proceedings in Light of SAS Institute Case, Intellectual Property Alert, 4.27.2018

USPTO Issues Written Description Guidance on Antibody Claims in View of Amgen v. Sanofi Case, Intellectual Property Alert, 3.19.2018

Webinars

IP Virtual Executive Roundtable For Life Sciences, Consero, 10.8.2020

Quoted

Microbiome Biotechs Grapple with How to Protect Their IP, Boston Business Journal, 8.8.2019

For CRISPR Patents, the Ugliest Phase May Be Still to Come, STAT News, 9.17.2018

Broad Institute Wins Landmark Case over Gene Editing Patents, Boston Business Journal, 9.10.2018

3 Must-Knows for Provisional Patent Applications, Law360, 8.10.2017