



A scientist who practices law and appreciates business, patent adviser and advocate Dr. Scott Rothenberger is dedicated to understanding each client's specific business and commercial objectives. By working with clients as a partner, he is able to incorporate their goals and often unique perspectives into the solutions he delivers.

Scott focuses his practice on patent prosecution, licensing and intellectual property litigation, including inter partes reviews (IPR), District Court actions and International Trade Commission (ITC) actions. Scott also counsels clients on patentability issues, conducts due diligence assessments, and provides infringement and validity opinions.

He is a member of the team assisting the Special Compliance Coordinator appointed by the U.S. Department of Commerce to monitor, assess and report on the U.S. export control compliance of Zhongxing Telecommunications Equipment Corporation, of Shenzhen, China, and ZTE Kangxun Telecommunications Ltd. of Shenzhen, China (collectively, ZTE).

Scott consistently provides a thorough understanding of the technology that underlies cutting-edge inventions, which allows him to represent even the most sophisticated clients in protecting their pioneering innovations. With a doctoral degree in organic chemistry and an extensive background in science, Scott prepares and prosecutes patent applications in the pharmaceutical, chemical and biotechnology industries, specifically related to small molecules, nutraceuticals, various catalysts, fuel cells, nonwovens, films, surface modifications, business methods, software, mechanical devices, polymers and biomedical devices.

Scott views each client and representation as distinct. He is able to serve as a problem-solver who offers a nuanced point of view when evaluating scientific breakthroughs in ways his client did not previously consider. Creative in drafting patent applications and in devising the right argument with patent examiners, Scott is at his best explaining complex scientific issues in a way that a layman can understand, which results in favorable

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Partner

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EDUCATION

University of New Hampshire Franklin
Pierce School of Law, (J.D.), 1995

Albright College, (B.S.), Chemistry ,
1981

University of New Hampshire, (Ph.D.),
1985

BAR ADMISSIONS

Massachusetts

Minnesota

U.S. Patent and Trademark Office

LANGUAGES

English

PRACTICES

Biotechnology

Corporate

Drug and Medical Device

Emerging Companies and Venture
Capital

Greater China and South East Asia

Intellectual Property

IP Strategy and Management

Japanese Services

Mergers and Acquisitions - Intellectual
Property

Nanotechnology

Patent Litigation

outcomes for those he serves.

In litigation, Scott is dedicated to out-of-the-box thinking and novel approaches to dispute resolution on both enforcement and defense. A formidable advocate and direct communicator, Scott identifies the strengths and weaknesses of his client's position and delivers cogent arguments that yield the greatest possible influence on all involved constituents. Scott is appreciated for his calmness, particularly when guiding his clients toward a clear path to realizing the desired result.

Notably, Scott holds the distinction of successfully handling a patent infringement action in Ecuador, where he was asked to educate the patent tribunal regarding the rules and regulations of patent law with regard to infringement. He also served as the client's expert witness and advocate for and during the trial.

Scott completed a postdoctoral fellowship at the University of South Carolina and a postdoctoral fellowship at the State University of New York at Stony Brook. Prior to joining Barnes & Thornburg, Scott practiced with Norton Rose Fulbright US LLP in Minneapolis.

Professional and Community Involvement

Member, American Intellectual Property Law Association

Member, Minnesota Intellectual Property Association

Member, Minnesota Bar Association

Member, Massachusetts Bar Association

Member, Sigma Xi Scientific Research Society

Mentor, Twin Cities Diversity in Practice

Volunteer, Southern Minnesota Regional Legal Services

Former adjunct professor, Hamline University School of Law

Former adjunct professor, Franklin Pierce Law Center, University of New Hampshire School of Law

Former board member, Hennepin County Bar Foundation

Honors

Intellectual Asset Management Strategy 300, 2021

Intellectual Asset Management Patent 300 – The World's Leading 300 IP Strategists, 2020-2023

Intellectual Asset Management Patent 1000 – The World's Leading Patent Professionals, 2014-2015, 2020-2022

Patent Services - Counseling and Prosecution

Post-Grant and Inter Partes Review

Product Liability and Mass Torts

INDUSTRIES

Colleges and Universities

Life Sciences