Michael Scarpati, Ph.D.

PARTNER AND AI & EMERGING TECHNOLOGIES INDUSTRY GROUP CO-LEADER

Michael’s practice spans all major areas of intellectual property law, including patent prosecution, due diligence investigations, district court litigation involving patents, trademarks, and copyrights, and post-grant proceedings before the U.S. Patent and Trademark Office.



Industries

AI & Emerging Technologies
— ArentFox Schiff Industry Guide to the Metaverse
Life Sciences
Longevity & Healthspan
Venture Capital & Emerging Businesses

Practices

Complex Litigation
Copyright
Patent
Trademark

Education

Brooklyn College, PhD, Molecular, Cellular & Developmental Biology, 2017

Hunter College, MS, Biology, 2007

University of Illinois, BS, Computer Science; Summa cum laude, 2015

Benjamin N. Cardozo School of Law, JD, 2012

Baruch College, BS, Biology, Economics; Magna cum laude, 2005

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Michael’s practice spans all major areas of intellectual property law, including patent prosecution, due diligence investigations, district court litigation involving patents, trademarks, and copyrights, and post-grant proceedings before the U.S. Patent and Trademark Office (e.g., *inter partes* review, reexamination, and reissue proceedings). He has extensive experience drafting patent invalidity, non-infringement and freedom-to-operate opinions, conducting prior art searches, and analyzing patent portfolios. Michael has advanced degrees in the areas of molecular biology, which he leverages to draft and prosecute patent applications related to biotechnology, pharmaceuticals, diagnostics, agricultural products, medical devices, and related life sciences subject matter. Michael also has a degree in computer science, providing cross-disciplinary expertise necessary for the prosecution of software patents. In that regard, he has experience drafting and prosecuting patents directed to software and business methods that implement machine learning, blockchain-based ledgers and other cutting-edge technologies. In addition to the above, Michael also has several years of experience prosecuting and litigating utility and design patents related to consumer products technology, and has counseled clients regarding intellectual property issues at all stages of the product development life cycle.

Client Work

Michael has extensive experience working with a wide range of clients, including Fortune 100 companies, start-ups, and research universities, in the areas of biotechnology, software, consumer products, and other technological niches. His practice is primarily focused on helping clients develop, manage, and enforce patent portfolios and other intellectual property assets. To that end, Michael has also assisted clients with licensing and enforcement actions to defend and/or monetize their intellectual property assets, in state and federal court litigation.

Previous Work

Prior to joining ArentFox Schiff, Michael was an attorney at a biotechnology-focused boutique based

in New York. Before entering the legal field, Michael was an academic and research scientist and has extensive hands-on experience with biotechnology, with over a decade of experience working at the lab bench at university and private laboratories. His research interests include all aspects of molecular biology, with a particular focus on structural biology and signal transduction. He is familiar with both standard wet lab techniques and bioinformatics-based approaches. He is also familiar with machine learning and data science techniques, as applied to “big data” analyses for biological research and other fields of technology.

Selected Publications, Presentations & Recognitions

Selected Publications

- Intellectual Property & Technology Law Journal, “Premarket Testing of Diagnostic Medical Software Protected From Claims of Patent Infringement,” by § 271 Safe Harbor Defense; January 2021.
- Scarpati, M., Qi, Y., Govind, S. and Singh, S., 2019. “A combined computational strategy of sequence and structural analysis predicts the existence of a functional eicosanoid pathway in *Drosophila melanogaster*.” *PLoS ONE*, *14*(2).
- Scarpati, M., Heavner, M.E., Wiech, E. and Singh, S., 2016. “Proteomic Tools for the Analysis of Cytoskeleton Proteins.” In *Cytoskeleton Methods and Protocols* (pp. 385-413). Humana Press, New York, NY.
- Embrione, V., Scarpati, M., Uzzel, Z.D., Ahmad, R., Sury, F.A.D., Sheetz, T.J., Coppola, V., Singh, S.M., Saxena, A.D., Croce, C.M. and Palmieri, D., 2018. “A human scFv as a tool to understand the biogenesis of a subset of oncogenic microRNAs.” *Cancer Research*, 78(13 Supplement), p.476.
- Heavner, M.E., Ramroop, J., Gueguen, G., Ramrattan, G., Dolios, G., Scarpati, M., Kwiat, J., Bhattacharya, S., Wang, R., Singh, S. and Govind, S., 2017. “Novel organelles with elements of bacterial and eukaryotic secretion systems weaponize parasites of *Drosophila*.” *Current Biology*, *27*(18), pp.2869-2877.

Selected Presentations

- “Patenting Diagnostic Methods: Navigating the Evolving Court Treatment, USPTO Guidance.” (Feb. 3, 2022, live webinar), StraffordPub.com.

Selected Recognitions

- *The Legal 500* - Intellectual Property: Patent Prosecution (2023 - 2025)

Professional Activities

- New York State Bar Association (NYSBA)
- American Intellectual Property Law Association (AIPLA)
- New York Intellectual Property Association (NYIPLA)

Bar Admissions

New York
US Patent and Trademark Office

Court Admissions

US District Court, Southern District of New York