

Tayan B. Patel

Partner

New York

45 Rockefeller Plaza
New York, NY 10111-0100

Washington, D.C.

Washington Square, 1050 Connecticut Ave, N.W.
Suite 1100
Washington, DC 20036-5403

T +1.202.861.1798

tpatel@bakerlaw.com



“Tayan Patel manages our work ... and can be trusted for incisive and frank advice on any matter.”

— A comment appearing in India Business Journal

As co-leader of the Electrical, Mechanical and Computer Science Prosecution team, Tayan focuses on IP-centric transactions and counseling involving patent development, monetization and risk management strategies in the emerging, high-tech and life sciences sectors. With more than 20 years of significant technical and legal experience in the electrical, software, mechanical and chemical arts, Tayan is uniquely qualified to not only deliver results clients expect but also develop and execute strategies they may not have known were even possible. From mature technology start-ups to Fortune 50 companies servicing both private and government demands, Tayan employs a holistic approach to understand key stakeholders' objectives and provide practical business advice. He then leads teams of attorneys to execute the strategic vision.

Tayan's transactional and litigation experience spans a vast array of technologies, including wireless and optical communications, software/AI, IoT, cloud computing, data analytics, AR/VR, fintech, metaverse, crypto/NFTs, consumer electronics, semiconductors and ICs, heavy machinery, chemicals/materials, medical devices and life sciences. As a trusted business counselor, Tayan proactively secures opportunities with prospective investors, collaborators and license/sale candidates; performs IP-centric valuations and

Education

- B.E., Chemical Engineering, Stevens Institute of Technology
- M.S., Electrical Engineering, Drexel University
- J.D., Rutgers University School of Law

Bar Admissions

- District of Columbia
- New York

comprehensive due diligence; and structures complementary IP, technology, data rights and commercial agreements.

As a former patent examiner, Tayan is skilled at helping clients navigate cases through the USPTO's complex ecosystem. His ability to quickly understand difficult issues and thoughtfully communicate arguments to examiners and judges helps minimize the cost and time spent procuring rights, as well as preserving broad claim scope post-issuance to deter competitive encroachment. As needed, Tayan and his team offer strategic counseling on post-grant options such as reissue, reexamination and supplemental examination to strengthen patent assets in view of related licensing and assertion campaigns, or when faced with invalidity challenges. Defensively, he and his team routinely monitor IP assets in competitive technology spaces and provide risk assessments to help clients make calculated business decisions on appropriate non-contentious and contentious mitigation options.

According to IAM Research, Tayan is considered as “the go-to attorney for US patent filings”, citing his ‘prompt service and excellent advice’. He has a rich mix of prosecution, transactions, counselling and litigation experience and is a former USPTO examiner, all of which gives him a deep strategic playbook to draw on.”

Experience

Transactional and Monetization Counseling

- Assisted a software services company in drafting and updating its various software, privacy and intellectual property agreements with vendors and customers.
- Assisted a financial services company in drafting a confidentiality and intellectual property agreement.
- Represented a large telecommunications company in the analysis and enforcement of indemnification rights across complex patent infringement litigations, resulting in the recovery of significant monetary amounts.
- Drafted and negotiated an intellectual property and technology license agreement for a mid-sized filter company.
- Drafted and negotiated a distribution agreement on behalf of a company to procure and sell goods manufactured by a foreign entity.
- Drafted and negotiated a joint development agreement between a Fortune 500 chemical company and a European chemical company.
- Drafted and negotiated a worldwide license between a Fortune 500 company and a large foreign company.
- Prepared and negotiated a joint development agreement between a Fortune 500 chemical company and a European chemical company.
- Represented a technology client on a deal to sell a large worldwide wireless IP portfolio.

Court Admissions

Areas of Focus

Industries

Life Sciences
Media and
Telecommunications

Services

Artificial Intelligence (AI)
Biotechnology, Chemical,
and Pharmaceutical
Digital Transformation and
Data Economy
Electrical, Mechanical, and
Computer Science
Prosecution
Intellectual Property
Software
Technology and IP
Transactions and
Outsourcing



- Identified and introduced acquisition targets to a manufacturing company seeking to expand footprint in strategic geographic areas.
- Represents a hospitality company in licensing out intellectual property.

Intellectual Property Procurement and Portfolio Management

- Represents a technology company in procuring intellectual property directed towards wireless, optical, telecommunications and cybersecurity technology. The company has filed more than 200 new patent applications.
- Represents a mid-sized Asian pharmaceutical company seeking to expand its footprint in the US.
- Represents a large foreign government entity seeking to procure intellectual property in the US.
- Successfully argued numerous patent cases before the Patent Trial and Appeal Board involving technologies such as semiconductors, wireless, consumer products and software technology.
- Managed a global IP patent portfolio for a Fortune 500 company specializing in inks, coatings and adhesives, including coordination and oversight of foreign counsel.
- Managed several European opposition and appeal matters relating to security printing inks, pigments and dyes, over a three-year period.
- Managed a large semiconductor intellectual property portfolio on behalf of a Japanese client.

Recognitions and Memberships

Recognitions

- IAM Patent 1000: The World's Leading Patent Practitioners
 - District of Columbia: Recommended for Patent Prosecution (2021 to 2023)
 - District of Columbia: Recommended for Patent Transactions (2021 to 2023)
- IAM Strategy 300: Global Leader (2021 to 2024)
- The Legal 500 United States (2019, 2022)
 - Recommended in Intellectual Property – Patent: Prosecution (including reexamination and post-grant proceedings)
- India Business Law Journal (2019, 2021)
 - Ranked among leading International Counsel for India-related work



Memberships

- Licensing Executive Society
 - High Technology Sector
- National Asian Pacific American Bar Association (NAPABA)
- South Asian Bar Association of North America
- American Bar Association

Community

- Stevens Venture Center: Entrepreneur-in-Residence
- Johns Hopkins Carey Business School: Adjunct Mentor/Expert