



**Drawing on more than a decade of experience helping clients build and leverage their intellectual property assets, Derek Roller applies critical thinking about how different IP rights can help achieve clients' business goals. He supports clients' commercial activity by planning and structuring strategic patent portfolios, as well as review and analysis of competitor IP.**

A large portion of Derek's practice focuses on IP portfolio development, particularly with regard to patents. Focusing first on understanding business objectives and the competitive landscape, Derek crafts a portfolio strategy and efficiently executes by procuring patents that are ready for assertion, while recognizing the limits of real world budgets.

He is skilled in managing U.S. and foreign applications to offer clients global innovation protection, including handling appeals, reexamination, and inventorship studies.

Derek helps clients maximize their R&D and legal investments by creatively leveraging all types of IP, such as patents, trademarks, copyrights, and trade secrets, as well as non-traditional IP-related assets. For example, he assists early stage companies in developing intellectual property strategic plans that identify key areas of innovation, and provide a roadmap of patent applications or other IP registrations to cover those innovations. Importantly, he helps establish procedures for ongoing innovation harvesting and plans for monitoring competitor activity and clearing commercial products for market release. These plans have been recognized as value creators for companies, increasing their attractiveness to investors and partners.

In addition, Derek has deep experience analyzing and adapting a client's existing IP portfolio to shifting objectives over time. For instance, he helps clients review their pending patent applications and devise new claim strategies for continuation practice to cover new commercial activity, whether it be the client's own or a competitor's. Leveraging existing filings in this manner helps maximize the value of an IP portfolio and provide a "second life" for filings that might otherwise have been abandoned.

## Derek Roller

### Partner

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### EDUCATION

Boston College Law School, (J.D.)

Northwestern University, (B.S.),  
mechanical engineering

Northwestern University, (B.A.),  
manufacturing and design engineering

### BAR ADMISSIONS

Massachusetts

U.S. Patent and Trademark Office

### COURT ADMISSIONS

U.S. District Court for the District of  
Massachusetts

### LANGUAGES

English

### PRACTICES

Intellectual Property

Mergers and Acquisitions - Intellectual  
Property

Opinions

Patent Services - Counseling and  
Prosecution

### INDUSTRIES

Life Sciences

Further, Derek adds value in support of client commercial activity and contested proceedings. He conducts practical IP due diligence in connection with corporate transactions and opinions related to freedom to operate, invalidity, and non-infringement. Derek also has experience handling various contested proceedings through federal court litigation, mediation, and inter partes review at the U.S. Patent and Trademark Office (USPTO).

Drawing on his mechanical and manufacturing engineering background, Derek has a broad base of technical knowledge, as well as practical experience in the information technology space. His experience encompasses myriad technologies, including medical and surgical devices and methods, computer hardware and software, electronic components, imaging technologies, power regulation and delivery systems, process control and automation systems, solar technology, and wireless communications technology.

## **Professional and Community Involvement**

Board member, Boston Patent Law Association

Member, Intellectual Property Owner's Association

Member, American Intellectual Property Law Association

Member, Boston Bar Association

## **Honors**

Massachusetts Super Lawyers, Rising Stars, 2013-2019