



## Monica Chin Kitts

ASSOCIATE

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### OVERVIEW

Monica Chin Kitts focuses her practice on patent prosecution, with a specialization in counseling biotech and pharmaceutical clients. Her clientele is evenly split between domestic and foreign companies. With over 25 years of experience, she brings a wealth of judgment and knowledge to her work, which makes her an invaluable asset to any client dealing with the complex, high-stakes patent prosecution process in the United States and worldwide.

Monica doesn't necessarily help her clients shape their goals, but rather facilitates achieving them. As an example, a startup may need a patent granted relatively quickly in order to secure investment capital. For these clients, Monica will prepare an application with narrower claims in order to showcase the company's main technology. Monica will later work with the company to obtain broader claims to protect the technology from potential competitors. By tailoring the contents of a patent application to the circumstances of each client, she is able to draft both a workable patent application, and one that's strategically appropriate.

A critical part of Monica's work is working with patent Examiners. Her role is to assist clients in navigating the patent office and procedures, and in doing this she leverages the relationships with Examiners that have arisen from her many years in practice. There is often an interpersonal component to patent prosecution that Monica utilizes to smooth the path for her clients. She can often help clients anticipate potential objections and rejections from

### Practices

Counseling, Transactions, and Guidance

Licensing and Transactions

Opinions, Freedom to Operate, and Patentability Analysis

Patent and Trademark Office Proceedings

Patent Prosecution

Patent Strategy and Counseling

Portfolio Management

Prosecution

### Education

J.D., George Mason University  
Antonin Scalia Law School

M.S., Biotechnology with  
concentration in Bioinformatics,  
Johns Hopkins University

B.S., Biology, Virginia Polytechnic  
Institute and State University

### Bar Admissions

District of Columbia

U.S. Patent and Trademark Office

Examiners, and present technologies using language the Examiners will be receptive to.

In addition to helping her tailor work to a client's strategic situation, Monica's extensive experience with the patent prosecution process also makes her exceptionally efficient, a characteristic that clients appreciate. She can analyze Patent Office communications and quickly determine the optimal course of action. There is a great deal of judgment involved in preparing a patent application, and Monica's judgment, distilled from countless applications and decades of experiences, is something her clients rely on.

For foreign clients, Monica is responsible for filing the national stage of PCT applications. Although the application itself is often drafted by a foreign patent attorney, Monica provides input and guidance, and ensures that all formal requirements are met, as well as reviewing correspondence from the United States Patent and Trademark Office (USPTO) and providing ongoing recommendations and strategy to clients with respect to the USPTO's requirements, rejections, and procedures.

For domestic clients, Monica reviews their invention disclosure documentation, and assists inventors in preparing a patent application. In essence, she is responsible for overseeing the transformation of a technology or device into a marketable asset. This includes working with inventors to determine what should be included in the application, as well as what should not. After the application is prepared and filed, she ensures that all formal requirements are met. She also evaluates correspondence from the USPTO, provides counsel to clients on their responses, and provides strategies to obtain the best outcome.