

Frank Amini, Ph.D.

Of Counsel

Practices: Intellectual Property; IP Litigation; IP Transactional

Industries: Healthcare; Higher Education; Life Sciences; Nanotechnology; P3, Infrastructure & Project Finance

Frank Amini is an attorney in Winstead's Intellectual Property Practice Group with substantial experience in patent prosecution, intellectual property licensing, intellectual property transactions, and intellectual property litigation.

Patent Prosecution

As a registered patent attorney, Frank has written and successfully prosecuted numerous patent applications in various technological areas, including materials science, nanotechnology, biotechnology, the life sciences, and the chemical arts. Frank's patent prosecution experience has spanned the following areas:

- Development and use of small molecules for chemical detection, imaging, enzyme inhibition, and disease treatment;
- Development and use of pharmaceutical compositions and nanoparticles for drug delivery and disease treatment;
- Development and use of genetically modified crops;
- Development and use of food additives, food supplements, nutraceuticals, aquaculture feed, and animal feed;
- Development and use of various materials for water and air purification (e.g., CO₂ capture);
- Development and use of various materials for imaging, sensing, purifying and detecting analytes (e.g., hydrocarbons, pollutants, etc.);
- Development and use of various carbon-based materials for the fabrication of energy storage devices;
- Fabrication of various carbon nanomaterials (e.g., carbon nanotubes, graphenes, graphene nanoribbons, graphene oxides, graphene quantum dots, graphene nanoplatelets, etc.); and
- Fabrication of inorganic and ceramic compositions (e.g., cement, adhesive materials, conductive materials, electrolytes, etc.).

Intellectual Property Licensing

Frank has drafted and negotiated numerous intellectual property license agreements in connection with the acquisition of commercialization rights for numerous technologies, including medical diagnostics, medical devices, fluid purification processes, software, and databases.

Intellectual Property Transactions

Frank has also drafted and negotiated numerous agreements related to technology transactions, including master services agreements, consulting services agreements, non-disclosure agreements, facilities use agreements, and asset purchase agreements.

Additionally, Frank has substantial experience in the following intellectual property-related transactions:



Houston Office

713.650.2795 Direct

713.650.2400 Fax

famini@winstead.com

Austin Office

phone: 713.650.2795

fax: 713.650.2400

Education

Chicago-Kent College of Law

– J.D., 2009

– Dean's List

University of Texas Southwestern Medical Center

– Ph.D., Biological Chemistry, 2003

The University of Texas at Austin

– B.A., Microbiology, 1997

– Dean's List

- Preparation of freedom to operate opinions;
- Rendering opinions regarding patentability;
- Evaluation of the intellectual property portfolios of various companies and institutions in connection with mergers, acquisitions, lending, and capital investments; and
- Devising intellectual property protection strategies that include the utilization of patents, trademarks, copyrights, trade secrets, and contractual agreements.

Intellectual Property Litigation

Frank has also provided assistance with numerous intellectual property litigation matters. Such activities have included rendering opinions regarding patent infringement, reviewing discovery documents, and preparing witnesses for depositions.

Prior to joining Winstead, Frank was a technical specialist at a Chicago law firm, where he assisted attorneys with the evaluation and management of various patent litigation cases in different technological areas, including pharmaceuticals, bio-therapeutics, medical devices, and mechanical devices. Frank also began his legal studies in Chicago. Prior to that, Frank worked on the development of a novel protein labeling method as a graduate student at the University of Texas Southwestern Medical Center in Dallas.

Frank has also served as a pre-doctoral fellow at the National Institutes of Health, where he conducted research on the role of a novel protein on the regulation of gene expression in mice. In addition, he has research experience in the field of microbial genetics.

Representative Experience

- Patent Prosecution
- Intellectual Property Licensing
- Intellectual Property Transactions
- Intellectual Property Litigation

Frank is a contributing writer for Winstead's [Destination Health Law](#) and [WinTech](#) blogs.

Publications

- Amini, F. Protein Proximity Labeling Mediated by Genetically Encoded Peptide Tags. 2003. Thesis. The University of Texas Southwestern Medical Center.
- Amini, F., Denison, C., Lin, H., Kuo, L., and T. Kodadek. 2003. Quantitative characterization of protein-protein and protein-peptide complexes using oxidative cross-linking and proximity labeling. *Chemistry and Biology*. 10(11):1115-1127.
- Amini, F., Kodadek, T., and K. Brown. 2002. Protein affinity labeling mediated by genetically encoded peptide tags. *Angewandte Chemie International Edition*. 41(2):356-359.
- Fancy, D.A., Denison, C., Kim, K., Xie, Y., Holdeman, T., Amini, F., and T. Kodadek. 2000. Scope, limitations and mechanistic aspects of photo-induced cross-linking of proteins by water-soluble metal complexes. *Chemistry and Biology*. 7(9):697-708.
- Amini, F. and J. R. Walker. 1997. Characterization of a mutant dnaA-dnaN region that suppresses a temperature sensitive defect in the dnaX gene of *Salmonella typhimurium*. *Proceedings of National Conference on Undergraduate Research*. 11:765-768.

Professional & Community Service

- State Bar of Texas
- Houston Bar Association
- Houston Young Lawyers Association
- Rice Alliance
- Biotechnology Innovation Organization (BIO)
- Association of University Technology Managers (AUTM)
- Licensing Executives Society (LES) (member of the Education Committee)

Awards & Recognition

- *Best Lawyers: Ones to Watch*, Woodward/White, Inc., 2021-2022

Admissions

- Texas, 2010
- U.S. Patent and Trademark Office
- U.S. District Court Southern and Eastern Districts of Texas