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IP and Licensing Basics - A One Day Review in Houston

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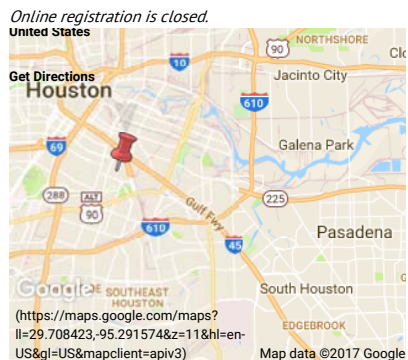
Houston Chapter IP and Licensing Basics

9/9/2016

When: 8:00 am - 7:00 pm

Where: University of Houston Law Center
4750 Calhoun Road
Houston, Texas 77004
United States

Contact: Carly Yang
qingshan.carly.yang@gmail.com (<mailto:qingshan.carly.yang@gmail.com>)



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DATE & TIME

Friday, September 9, 2016

8:00 AM - 9:00 AM: Registration & Breakfast

9:00 AM - 5:15 PM: Course

5:15 PM - 7:00 PM: Reception

Platinum**Sponsor:****Venue****Sponsor:****Overview**

This one-day course provides an overview of the basics of intellectual property (IP) and licensing. It builds a practical understanding of core IP and licensing concepts from both the business and legal perspectives. Each topic, taught by both legal and business experts working as a team, is divided into five sections with examples, exercises, and interactions between instructors and fellow students. Topics include an introduction to IP, the basics of IP commercialization and licensing, determining reasonable license fees and royalty rates, managing risks, and a licensing case study.

Who Should Attend

There is no prerequisite to attend this course. It is designed for those with no prior experience in licensing, including students, entrepreneurs, non-IP attorneys, finance professionals, business development professionals, and those considering a career in licensing.

Why You Should Attend

There is more emphasis now than ever before on commercialization, company formation, and job creation from the billions of dollars invested annually in research and development at America's universities, government laboratories, and small businesses.

Whether you are an entrepreneur in the making, a principal investigator or student at any level who wants a better grasp of the basics, or an aspiring technology transfer professional, this course will give you the tools you need to understand and participate effectively in the process of protecting IP and facilitating its commercialization.

Course Details

The course is divided into five modules:

Module 1: Introduction to IP

Introduction to the different types of IP including patents, trademarks, copyright, trade dress, and trade secrets.

Module 2: Basics of IP Commercialization & Licensing

Introduction to licensing, including reasons for licensing, description of licensing agreements, infringement, competition law, and relationship-building.

Module 3: Determining Reasonable License Fees & Royalty

Licensing risks and rewards, different valuation methods (e.g., market, financial, and cost), their pros and cons and royalty structures.

Module 4: Managing Risks

Identifying and managing different types of risk, including confidentiality, infringement, liability, collection of royalties and other fees, and unlicensed competition.

Module 5: Licensing Game

Students put into practice what they've learned by dividing into licensee and licensor teams and then discussing and negotiating terms of a licensing case study, based on both public and confidential information they are given. At the end of the negotiating session all teams report their results and how and why they reached them.

MCLE: 6.75 hours, with 0.25 Ethics hours, of Texas MCLE credit approved.

Jonathon Hance, J.D., CLP Jonathon focuses his practice on energy and intellectual property litigation, with an emphasis on complex commercial disputes relating to energy-supply agreements in the oil and gas, renewable, solar, chemical, and petrochemical industries. His litigation practice also includes cases of patent infringement, trademark infringement, false-marking, and misappropriation of trade secrets in the areas of software, open-source code, mobile devices, computer hardware, gTLDs (generic top-level domain names), and network infrastructures. Mr. Hance served as a judicial clerk to the Honorable Jennifer Walker Elrod of the United States Court of Appeals for the Fifth Circuit.

Mr. Hance has a degrees from Southern Methodist University in Applied Mathematics, Computer Science, and Viola Performance and J.D. from Washington and Lee University School of Law. He is a Certified Licensing Professional (CLP).

Kevin Tamm, J.D. Kevin is an associate in the Houston office of Bracewell LLP. He focuses on patent prosecution in the chemical and mechanical arts and also has experience with drafting inter partes review petitions, managing active post-grant cases, and assisting in IP-intensive transactions. Kevin has experience prosecuting U.S. and foreign patents for large corporate clients, universities and independent inventors and is admitted to practice before the USPTO. Kevin held a chemical associate position in an engineering consulting firm after earning his bachelor's degree in chemical engineering from University of Pittsburgh Swanson School of Engineering. While in law school, Kevin was a legal extern for the Honorable Michael R. Barrett in the United States District Court for the Southern District of Ohio. Kevin lateralled to Houston in 2015 from Indianapolis.

Karthika Perumal, J.D., Ph.D., CLP Karthika is an attorney in Dentons LLP's Intellectual Property and Technology practice in the Houston office. Before joining Dentons, she was with Bracewell & Giuliani LLP in Houston, and the Associate Director for the Center for Technology Development at the University of Texas Medical Branch in Galveston. During her ten years with UTMB, she developed commercialization strategies for over 65 technologies including multi-party collaboration agreements, sponsored research agreements, material transfer agreements, options and licensing transactions; she also participated in structuring and financing of six start-up companies for various pharmaceutical, medical device and medical informatics products. As part of her scientific training, Karthika was also involved in biological research projects and has published several articles in peer reviewed journals. Karthika holds a J.D., magna cum laude, from the University of Houston and a Ph.D. in pharmacology from Baylor College of Medicine, and is a Certified Licensing Professional.

Louise Levien, Ph.D., CLP Louise has worked in a diverse series of assignments at Exxon and ExxonMobil in Upstream Research for over 30 years. She has performed research in Petrophysics, Geologic Modeling, and Visualization, supervised diverse research programs and held several assignments in Planning and Analysis. After working with IP from the business side of ExxonMobil for many years, Louise joined the ExxonMobil Upstream Research Center's intellectual property and licensing group in 2007. She is responsible for IP processes, the intellectual property aspects of agreements, and licensing transactions impacting ExxonMobil's upstream business. She holds a ScB degree in Geological Sciences from Brown University and MS and PhD degrees in Geochemistry from Stony Brook University. She is a Certified Licensing Professional.

Tabrez Ebrahim, J.D., MBA, LL.M is an Intellectual Property Attorney at Bracewell LLP. His practice focuses on patent prosecution, outsourcing and information technology contracts, and technology transactions. He also advises clients on the financing and formation of startups and spin-outs, and is a frequent speaker on legal and business issues related to 3D printing. Previously as a R&D engineer, he was an inventor on patents for flexible display devices. Tabrez holds J.D. & M.B.A. degrees from Northwestern University and a LL.M. degree from the University of Houston Law Center.

Taylor Evans, Esq., CLP. Taylor is an intellectual-property attorney in the Houston office of Bracewell & Giuliani, LLP. He has worked in a variety of areas, including oilfield equipment, oil and gas drilling techniques, mechanical arts, biotechnology, medical devices, and semiconductor fabrication and packaging. Taylor's litigation experience includes discovery, infringement analysis, motion practice, and trademark opposition proceedings before the Trademark Trial and Appeal Board. Taylor holds a J.D. degree, cum laude, from the Franklin Pierce Law Center and a B.S. degree in mechanical engineering from the University of Utah.

Dell Charles "D. C." Toedt III, J.D. D.C. is an attorney and arbitrator and a faculty member at the University of Houston Law Center. He was formerly a partner and member of the management committee at Arnold, White & Durkee, one of the largest intellectual-property law firms in the U.S., and then vice president and general counsel of BindView Corporation, a publicly-traded network security software company that he helped the founders to start, serving there until the company's successful "exit" when it was acquired by Symantec Corporation. He was the author of, among other things, the first edition of *The Law and Business of Computer Software*, a one-volume treatise published by Thomson West, as well as the editor of the COMMON DRAFT annotated contract terms.

D.C. received his J.D. degree from The University of Texas at Austin, where he was on the editorial board of the *Texas Law Review*, and where also received his undergraduate degree in mathematics, with high honors. In between college and law school, he served his ROTC-scholarship payback time as a Navy nuclear engineering officer.

Christopher Anderson provides financial and economic consulting services to clients and counsel on commercial damages disputes, business valuations, licensing negotiations, and accounting and financial investigations.

Chris has assisted clients on engagements involving patent infringement, misappropriation of trade secrets, securities and breach of contract. He has also participated in large financial accounting investigations and general litigation matters.

Chris has experience in a wide range of industries, including healthcare, pharmaceutical, energy and financial services.

Prior to joining StoneTurn, Chris helped a top-ranked academic medical center analyze the financial, operational and clinical impacts of new medical technologies. Previously, he spent two years with an international consulting firm, where he focused on medical device intellectual property infringement. In addition to his financial and economics experience, Chris also served as a clinical monitor and a study coordinator for Phase I and II clinical trials for contract research organizations. He also worked as a business analyst for an international oilfield equipment manufacturer.

Chris is a Certified Valuation Analyst, a Certified Management Accountant and a Certified Financial Manager.

Acknowledgements

Course developed by LES South Africa Chapter. Course materials reviewed, updated and edited by the LES Houston chapter members.

REGISTRATION

Early by September 1, 2015

LES Member: \$195
Non-member: \$195
Professor: \$125
Student / Postdoctoral: \$35

Regular & Onsite

LES Member: \$245
Non-member \$245
Professor \$150
Student / Postdoctoral: \$50

HOTEL INFORMATION

A special room rate of \$159 per night has been arranged at the Hilton hotel, on the campus of the University of Houston, for September 8 and 9. The hotel is 0.3 miles and about a six-minute walk from the Law Center. The nightly room rate is exclusive of parking, taxes, and breakfast. Reservations must be made by September 1. Go to <http://www.hilton.com/en/hi/groups/personalized/H/HOUUHHF-LES-20160908/index.jhtml> (<http://www.hilton.com/en/hi/groups/personalized/H/HOUUHHF-LES-20160908/index.jhtml>) to make a reservation.

Cancellation Policy:

Cancellations with refund are accepted prior to September 1.

Cancellations received September 1 and later will not be refunded. Substitutions are permitted.

For registration assistance please contact Carmen Sevilla (csevilla@les.org (mailto:csevilla@les.org)).

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