IP & Licensing Basics: A One-Day Review

DATE & TIME
Friday, September 11, 2015
8:00 AM - 9:00 AM: Registration & Breakfast
9:00 AM - 5:30 PM: Course
5:30 PM - 7:30 PM: Reception

LOCATION
University of Houston Law Center
4750 Calhoun Road
Houston, TX 77004
Map

INSTRUCTORS
Taylor P. Evans, Esq., CLP, Bracewell & Giuliani
Jonathon Hance, Esq., CLP, Bracewell & Giuliani
Chris Johnson, CVA, CFE, BDO Consulting
Timothy (Tim) F. Kinn, ExxonMobil Upstream Research Co.
Louise Levien, Ph.D, CLP, ExxonMobil Upstream Research Co.
Karthika Perumal, Esq., Ph.D, CLP, Dentons
D. C. Toedt, Esq., University of Houston Law Center

DESCRIPTION
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.

The course is divided into the following five modules:

Module 1. Introduction to IP: Introduction to the different types of IP including patents, trademarks, copyright, trade dress, and trade secrets.
Module 3. Determining Reasonable License Fees & Royalty: Licensing risks and rewards, different valuation methods (e.g., Market, Financial, Cost) and 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.

CLE
7.5 hours of Texas MCLE credit approved

REGISTRATION FEES
(includes breakfast, lunch, and networking reception)
Early, by September 1
LES Member and Non-Member: $195
University Faculty: $125
LES Student/Postdoc Member: $25
Non-Member Student/Postdoc: $35*

*For non-member student, fee includes one year LES (USA & Canada) student membership

After September 1 and onsite
LES Member and Non-Member: $245
University Faculty: $150
LES Student/Postdoc Member: $50
Non-Member Student/Postdoc: $50

Online Registration Deadline: September 8, 2014 12 PM CDT
Online Registration Available

CANCELLATION POLICY
No refunds after September 1
Substitutions are permitted
BIOS

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.

Jonathon Hance, Esq., CLP. Jonathon Hance 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).

Chris Johnson, CVA, CFE. Chris Johnson is a director in BDO Consulting’s Houston office. His work focuses primarily in the areas of expert witness services, valuation analyses and economic analyses. His areas of expertise include intellectual property damages, lost profits analysis, contract damage quantification, and class action damages analyses. He has provided valuation services in the context of litigation and for management’s strategic planning and financial reporting. He has valued intellectual property, options, warrants and preferred stock. Chris also conducts economic impact analyses to determine the economic impact associated with various forms of stimulus. He has developed analyses estimating the impact that major sporting events, conventions and corporate relations have on regional economies. Chris holds an M.S. in economics from Texas A&M University and a B.A. in economics from Trinity University. He is a Certified Valuation Analyst and a Certified Fraud Examiner.

Timothy (Tim) F. Kinn. Tim Kinn has over 25 years of experience in the petroleum refining and petrochemical industries; he holds a B.S. degree in Chemical Engineering from the University of California at Berkeley and a Masters Degree in Business Administration from Rutgers University. He was an office in the US Army and held a number of leadership positions before joining Mobil Chemical Company in 1990 as a process engineer in their olefins and aromatics facility in Beaumont, Texas. He served in several olefins-related engineering and production positions before being transferred to Mobil’s process research labs in Paulsboro, New Jersey. While there, he was responsible for the development and commercialization of a number of aromatics technologies including MTD-3 and TransPlus(TM), which received a 2013 Edison Award from the Research & Development Council of New Jersey. Following this, he held the postion of Paraxylene Marketing Manager for the Americas and several engineering positions, both in the US and in the Middle East. Tim moved to ExxonMobil Chemical's licensing organization in 2004 and was the aromatics technology licensing manager for the Middle East and Asia. He transferred to his present position at ExxonMobil Upstream Research Company in 2008 as an Intellectual Property and Licensing Associate supporting the company's engineering research activities. In this role, he is responsible for assisting in development of research agreements, including joint industry projects, joint development agreements, and licensing of technology both in and out.

Louise Levien, Esq., 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.

Karthika Perumal, Esq., 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.

Dell Charles “D. C.” Toedt III, Esq. 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 and of the IACCM Contract Protocols. 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.