

Fall ©CLE 2019 SEMINAR®

Friday
Nov 1, 2019
NASHVILLE, TN

Presented by
**THE TENNESSEE INTELLECTUAL
PROPERTY LAW ASSOCIATION**

Hosted by:
Bradley Arant Boult Cummings LLP
1600 Division Street, Suite 700
Nashville, TN
615-244-2582



PROGRAM

FRIDAY, NOV 1, 2019

8:00 – 8:25	Breakfast
8:25 – 8:30	Welcoming Remarks by Lakita Cavin, Ph.D. University of Tennessee Research Foundation Memphis, TN
8:30 – 9:00	Trade Secrets and the Prior Use Defense Thor Urness, <i>Bradley Arant Boult Cummings LLP</i> Nashville, TN
9:00 – 9:30	Ethics and Trademarks Robert Thornburg, <i>Allen Dyer Doppelt & Gilchrist,</i> PA, Miami, FL
9:30 – 10:00	Options and Strategies for Expedited Examination and Deferred Examination Robb Edmonds, <i>Edmonds & Cmaidalka</i> Houston, TX
10:00 – 10:15	Morning Break
10:15 – 10:45	IP Issues Related to Casinos, Racetracks and the Gambling Industry Michael J. Leonard, <i>Fox Rothschild LLP</i> Philadelphia, PA
10:45 – 11:15	The Auto Industry vs. Ford – The Intersection of Trademarks and Patents Michael Turner, <i>Brooks Kushman,</i> Southfield, MI
11:15 – 11:50	Responding to a Claim of Patent Infringement Nicholas Jackson, <i>Dentons US,</i> Washington, DC

11:50 – 12:50

Lunch

12:50 – 1:30

IP and Pro Bono Work – Can It Be Done?

Seth Ogden, Ph.D. *Patterson IP Law,* Nashville, TN
Mary Anne Smith, *Chicago Kent College of Law*
Chicago, IL

1:30 – 2:00

**Nike vs. Kahwi – The Intersection of
Trademarks, Copyrights and Celebrities**

Chase LanCarte, *LanCarte Law,* Nashville, TN

2:00 – 2:20

**Who is the Senior User? Trademarks and the
Capitol Grille**

Micheline Johnson, *Taylor English,* Chattanooga, TN

2:20 – 2:35

Afternoon Break

2:35 – 3:15

Current Issues Related to IPR Petitions

R. Wilson “Trey” Powers III, Ph.D. *Sterne Kessler*
Washington, DC

William Sekyi, *Patterson IP Law,* Nashville, TN

3:15 – 3:50

Strategies in IP Mediation

A.J. Bahou, *Waller Lansden,* Nashville, TN
Terry Clark, *Bass Berry + Sims,* Washington, DC
John Jackson, *Chambliss Bahner & Stophel*
Chattanooga, TN

3:50 – 4:00

Break

4:00 – 4:30

**Issues Related to Restriction Requirements and
Divisional Patent Applications**

Adam Arnold, *Pitts and Lake,* Knoxville, TN

4:30

Adjourn

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Adam Arnold practices primarily in the areas of patent and trademark procurement as well as IP transactional matters and is a former Patent Examiner at PTO in the Computer Graphics Art Unit. Prior to such service he worked for 10 years as Corporate Intellectual Property Counsel for United Technologies Corporation in Hartford CT and as Patent Counsel for Michelin North America in Greenville, SC. Adam received his BS in Electrical Engineering from the University of South Florida, an MS in Software Engineering from Monmouth University, and his JD from the Florida State University College of Law. Adam is serving or has served as a board member on various nonprofit organizations, and is a former tennis professional.

A.J. Bahou is a mediator and registered patent attorney who practices in the area of data privacy, software agreements, healthcare, cannabis law, and intellectual property law, including prosecuting and litigating patents, trademarks, copyrights, and trade secrets. He has extensive experience in all aspects of patent infringement litigation, from pre-complaint investigation through trial and appeal. Mr. Bahou has worked on cases involving varying technologies such as medical devices, computer hardware, software, and Internet security systems. He has represented clients in electronic discovery disputes, motion practice, claim construction ("Markman") hearings, PTAB trials, federal court trials, and appeals before the United States Court of Appeals for the Federal Circuit and U.S. Supreme Court. He earned a B.S. in Engineering from Tennessee Tech, an M.S. with honors in Electrical and Computer Engineering (focusing in Networking and Data Security) from the Johns Hopkins University, a J.D. and LL.M. in Intellectual Property Law from the University of New Hampshire.

Lakita Cavin, J.D., Ph.D. is a Senior Staff Attorney for the University of Tennessee Research Foundation. She is responsible for managing and licensing university technology, as well as preparing and reviewing research-related contracts, such as material transfer, research and confidentiality agreements. She also provides legal support and advice to the UTRF licensing staff. As a registered patent attorney, Lakita provides strategic support for drafting and prosecuting patent applications on new disclosures from across the UT System. She has been with UTRF as a staff attorney and licensing associate since 2007. Prior to joining UTRF, Lakita was a post-doctoral research scientist and assistant professor in the Department of Pharmacology at the University of Tennessee Health Science Center, where her research focused in the area of liver cancer. She holds a Ph.D. in Chemistry from Auburn University and a J.D. from the University of Memphis.

Terry Clark has counseled technology companies on intellectual property related matters including patent portfolio development, strategic planning and IP protection through litigation and ADR before various national and international forums, including various district courts, the Federal Circuit, the USPTO, including PTAB, and the US International Trade Commission. Terry received his BS from Murray State University, his JD from the University of Kentucky College of Law and his LL.M. (Patent and Trade Regulation) from The George Washington University National Law Center. He has been an arbitrator on various domestic and international panels and a mediator, with an emphasis on high technology and intellectual property disputes, for AAA for over 30 years. Among his numerous publications, he authors a chapter on ADR in patent litigation for the ABA treatise, Patent Litigation Strategies Handbook.

Robb Edmonds is a founding member of Edmonds & Cmaidalka in Houston. His practice concentrates on patent prosecution, litigation, portfolio management, and licensing matters. Robb's practice combines his prior engineering experience in oil & gas, hydrocarbons, polymers and chemical processing with an expertise in patent drafting, prosecution, IP enforcement, and client counseling on IP related matters. He received his BS in Chemistry from Emory University, his Masters in Chemical Engineering from Texas A&M University and his JD from South Texas College of Law.

John Jackson has tried to verdict numerous civil cases, both jury and non-jury, but just as importantly has obtained relief for clients without the need for litigation and has counseled clients on ways to avoid or minimize the threat and uncertainty of litigation. This practice continues today. John has focused his practice on litigating patent, trademark, copyright, trade secret and other complex civil matters for over 20 years. He is a Tennessee Supreme Court Rule 31 Listed General Civil Mediator who focuses on intellectual property and other complex disputes. He received his JD from the University of Cincinnati College of Law and his BS from The University of Tennessee at Chattanooga.

Nicholas Jackson is a member of Dentons' Intellectual Property and Technology practice, with a focus on patent litigation. He has practiced before US courts at the trial and appellate levels, including the US Court of Appeals for the Federal Circuit, and before the US International Trade Commission (ITC). Nick has BS in mechanical engineering and prior to entering the legal profession worked as a quality assurance engineer for Denso Manufacturing, a tier-one OEM automotive part manufacturer, managing customer-side quality control. He received both his JD and BS from the University of Tennessee College of Law.

Micheline Johnson synthesizes her chemistry, finance, and legal education and experience to elevate her work as a corporate IP Strategist - developing, managing, and leveraging Intellectual Property (IP) assets to improve businesses' bottom lines. Micheline has been responsible for the management of over 8,000 US and international trademark, patent, and copyright applications and registrations. She has used her abilities to assist clients in a variety of fields, including a global car sharing/rental company that diversified into tech; an international television and radio network; pharmaceutical companies; consumer products companies; hospitality interests; and web-based service providers. Micheline received her JD and MBA from Vanderbilt University and her BS in Chemistry from Spring Hill College.

Chase LanCarte practices in the areas of music and entertainment, copyright, trademark, trade secret, and corporate law. Chase's areas of focus are largely inspired by his musical upbringing and passion for the arts. As a musician, Chase has had the honor of playing and singing along-side such notable artists as Michael Martin Murphey and Tanya Tucker. Chase's deep understanding and appreciation of business and the arts led him to earn a BBA in Marketing with a minor in Music from The University of Texas at Austin, his JD from Texas Wesleyan School of Law, and his LL.M. in Trial Advocacy from Temple University School of Law.

Michael J. Leonard provides strategic counsel on the availability and adoption of trademarks as well as the management and enforcement of trademark portfolios in the US and abroad. Michael teaches the Institute's U.S. Trademark Law and Practice course at the Munich Intellectual Property Law Center at the Max Planck Institute for Intellectual Property. He is an active member of Marques, the Association of European Trademark Holders. Michael received his LLM from the Munich Intellectual Property Law Center at the Max Planck Institute for Intellectual Property, his JD from the University of Tulsa College of Law and his BA from the University of Pittsburgh.

Seth Ogden, Ph.D. joined Patterson Intellectual Property Law in 2015. After earning a Biology degree at the University of Virginia, he earned his Ph.D. in Cancer Biology at Vanderbilt then his JD at American University Washington College of Law. Seth has experience in patent infringement litigation and patent prosecution in the fields of biotechnology, pharmaceuticals, medical devices, industrial chemicals, software and electronic devices. Seth has also provided non-infringement and invalidity opinions and strategic positioning reports in the areas of biotechnology (diagnostics and biologics), pharmaceuticals, industrial chemicals and material science. Seth's practice also includes advising clients on protecting their know-how through both state and federal trade secret regimes.

R. Wilson "Trey" Powers III, Ph.D., is a director in Sterne Kessler's Trial & Appellate and Biotechnology & Chemical Practice Groups. He has served as counsel on over 85 inter partes review and post grant review proceedings and has extensive experience litigating before the Patent Trial and Appeal Board. Trey also works with clients on a variety of other matters including district court litigation, intellectual property strategic advice, licensing, US International Trade Commission investigations under §337, evaluating patent portfolios, drafting patent applications, and prosecuting interferences. Trey earned his BA in biology from the University of Virginia, his Ph.D. in molecular and cellular biology from the University of Washington and the Fred Hutchinson Cancer Research Center and his JD from American University Washington College of Law.

William Sekyi is an of Counsel patent attorney with Patterson Intellectual Property Law in Nashville. He began his practice in Washington DC in 2002 and has been litigating patent disputes in district courts, appellate courts, and the International Trade Commission ever since. In addition to litigating, he counsels clients on IP matters, prosecutes patents, and more recently has been involved in a number of inter partes review proceedings before the PTO. William earned a BSc in mechanical engineering from Imperial College, London University, his MS in petroleum engineering from Louisiana State University, and his JD from Georgetown University Law Center.

Mary Anne Smith is Director of the Chicago-Kent Patent Hub, which is sponsored by Illinois Institute of Technology's Chicago-Kent College of Law. She retired in 2012 as vice president and general counsel of Illinois Institute of Technology, after 35 years representing the University as its primary attorney. Mary Anne has been a volunteer attorney for Chicago Volunteer Legal Services Foundation since 1978, and has chaired a CVLS law clinic in the South Loop of Chicago since 1988. She received her BA in Mathematics from Mundelein College, her MS in Mathematics from the Illinois Institute of Technology and her JD from IIT/Chicago-Kent College of Law.

Robert Thornburg is a nationally recognized intellectual property litigation specialist who has a built a reputation over the past 15 years in bet-your-business patent, copyright, trademark, trade secret and technology focused litigation on behalf of international and Florida-based businesses. In addition, he has filed over 400 trademark applications and over 100 patent applications on diverse technologies. Robert received his BS in Chemical Engineering from the University of Notre Dame, his JD from the University of Florida Levin College of Law and his LL.M. in Intellectual Property Law from The John Marshall Law School.

A primary focus of **Michael Turner's** practice is domestic and foreign patent prosecution for mechanical matters, electromechanical matters, systems, business methods, and designs. His industry background in robotics and automation provides him with experience in various technologies and manufacturing processes. Michael counsels clients on procedures for filing domestic patent applications that meet the varying requirements for both domestic and international protection, particularly addressing the various international nuances associated with design patents. He received his BS in Mechanical Engineering from GMI Engineering and Management Institute (now Kettering University) and his JD from Wayne State University Law School.

Thor Urness is a Partner at Bradley Arant Boult Cummings LLP where has practiced IP and commercial litigation since 1989. In addition to trying IP cases, including obtaining two of Tennessee's largest jury verdicts, he mediates IP disputes, having qualified as a Rule 31 General Civil Mediator by the Tennessee Supreme Court Commission on ADR. Thor served as inaugural chair of the Tennessee Bar Association's IP Section, chaired the Nashville Bar Association's IP Law Committee, and led Tennessee's successful effort to adopt the Uniform Trade Secrets Act. Thor is a graduate of Indiana University and its law school and a Fellow of the American, Tennessee, and Nashville Bar Foundations.

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☐ \$95 Students

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Mail checks and this registration form to:

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