Jeanne C. Curtis Director CDF Consulting



Jeanne C. Curtis has practiced intellectual property law for close to 30 years, both in private practice and in academia. Most recently, Jeanne was a member of the faculty of Cardozo Law School where she was a Visiting Assistant Clinical Professor of Law and the inaugural director of the Google-funded Patent Diversity Project., a program directed to increasing the number of U.S. patents issued to women and underserved minorities. As inaugural director, Jeanne built the Project from the ground up, taking the Project mission and making it a reality. Jeanne's scholarly work includes publications addressing the issue of

increasing gender diversity in the patent bar. Ms. Curtis's work has received recognition across media outlets including Bloomberg Law and Law 360.

Before joining Cardozo, Jeanne spent several decades in private practice specializing in patent litigation and counseling. Jeanne was a partner at Fish & Neave LLP and then at Ropes & Gray LLP upon its merger with Fish & Neave. She has tried patent and trade secret cases, handling all aspects of pre-and post-trial activities in federal courts around the country. Jeanne also counseled clients on the creation and use of their intellectual property, including opinion work and licensing, and conducted due diligence in various types of transactions. Ms. Curtis's clients were varied in size and resources and that has contributed to the nature and breadth of her experience. Ms. Curtis also held numerous firm leadership positions at Fish & Neave and Ropes & Gray, including a multi-year rotation head as a department head of the litigation department at Ropes & Gray and as a member of the steering committee of Ropes & Gray's Women's Forum. Jeanne's skills as a litigator have been recognized by her peers many times over the years, through for example, inclusion in *New York Super Lawyers*, publication of articles and book chapters, as a regular speaker on intellectual property topics, and as an inaugural member of the Hon. William C. Conner Inn of Court.

For the past 5 years, Ms. Curtis has also been teaching pretrial patent litigation as an adjunct professor at the University of New Hampshire School of Law (formerly Franklin Pierce).

Jeanne is a member of the NYIPLA, the Federal Circuit Bar Association, the American Bar Association, the Association of the Bar of the City of New York, and ChIPS. Jeanne also serves as a member of the Dean's Advisory Board for the Boston University College of Arts & Sciences.

Jeanne received her J.D. from Boston University School of Law. Jeanne attended Boston University for her undergraduate studies as well where she received a B.A. in mathematics.

Nora E. Garrote Partner Venable LLP



Nora Garrote co-chairs the Intellectual Property Transactions Practice Group, and is a member of the Technology Transactions and Outsourcing team. Nora focuses on technology and intellectual property commercial transactions and counseling, internet and new media law, technology transfers, data protection and exploitation arrangements, and marketing/entertainment contracts. She counsels clients in a variety of sourcing engagements, including those involving business process outsourcing and information technology solutions and systems, typically involving complex data privacy and security issues. She represents clients in the information technology, social media, hospitality, healthcare,

energy, direct marketing, financial and insurance sectors, among others.

Nora offers clients a combination of in-depth business law, technology, intellectual property, and commercial transactions knowledge that leads to practical and creative solutions to the client's needs regarding procurement, use, exploitation, and disposition of technology, data, content and other critical business assets. With more than 30 years of experience and deep familiarity with the full range of established and evolving technologies, including in highly regulated industries, she assists companies with comprehensive technology, intellectual property, and the full spectrum of commercial contracting matters. Nora's work includes:

- Advising on and negotiating contracts for licensing, development, procurement, integration, implementation, and support of software, digital platforms, analytics solutions and computing devices
- Negotiating software as a service (SaaS), cloud computing, hosting and managed services transactions, and data exploitation and content licensing agreements
- Negotiating complex contractual arrangements for the collection, transfer and processing of sensitive or protected personal data under applicable privacy and security laws and in highly regulated environments
- Preparing joint venture agreements, intellectual property sale agreements, marketing and advertising affiliation agreements, professional services contracts, e-commerce arrangements, and partnering agreements
- Drafting branding agreements, patent and copyright licenses, entertainment program agreements, and intellectual property infringement settlements
- Negotiating mergers and acquisitions and related due diligence involving key technology, data, digital and intellectual property assets
- Representing businesses in marketing and sponsorship contracts and the full spectrum of commercial contracts

Nora chairs Venable's Diversity and Inclusion Committee, where she helps develop and implement programs, practices, outreach and mentoring opportunities that foster inclusiveness and diversity at Venable. She is a 2019 Fellow of the DMV Diversity and Inclusion Institute of the Leadership Center for Excellence, Arlington, VA. She also serves as the deputy professional development partner for the Washington, DC office, where she is involved in matters involving the professional development of associates.

Khue Hoang Partner Reichman Jorgensen LLP



Khue Hoang is a partner in Reichman Jorgensen's New York office. She has more than20 years' experience representing clients in high-stakes patent infringement and licensing disputes. A former semiconductor engineer, Khue infuses her technical background and industry insights with her courtroom skills to effectively guide clients through their most complex intellectual property issues. She works closely with clients and experts to absorb complex technologies and craft effective strategies to protect and enforce their interests.

Khue represents companies across a broad range of sectors, including telecommunications, data storage, consumer electronics, and medical devices. Her clients include a who's who list of industry leaders, including EMC, Google, Apple, Samsung, Motorola, RSA Security, and BioTelemetry among others. Khue also routinely advises clients on intellectual property and privacy issues affecting M&A, private equity, and complex business disputes.

Khue is a member of the National Asian Pacific American Bar Association, and Chips, national nonprofit organization that advances and connects women in technology, law and policy. In 2018, she received the Legal Aid Society Pro Bono Publico Award, a special honor awarded to lawyers and institutions that have demonstrated outstanding commitment to volunteer legal services for the poor and disadvantaged.

Khue is a graduate of the University of California, San Diego, where she earned a MS in Electrical Engineering. She received her law degree from the University of California, Berkeley Law School.

Chloe Steadman Vice President & Underwriter Euclid Transactional



Chloë Steadman is a Vice President and an Underwriter for Euclid Transactional. Chloë is responsible for underwriting Representations & Warranties Insurance policies for complex Mergers & Acquisitions transactions throughout the Americas.

Prior to joining Euclid Transactional, Chloë was a Business & Finance Associate at Ballard Spahr, LLP, where she advised clients on mergers and acquisitions and corporate finance matters. She also represented clients at the state and federal level as a lobbyist.

Chloë received a J.D. degree from the Arizona State University in 2016 magna cum laude, Order of the Coif, where she was an Associate Editor on the Arizona State Law Journal. She received a B.A in Political Science from the University of Arizona in 2013, magna cum laude.

Dorothy von Hollen

Vice President and Corporate Counsel for Intellectual Property Prudential Financial, Inc.



Dorothy von Hollen is Vice President, Corporate Counsel for Intellectual Property for Prudential, overseeing all trademark, patent, copyright, trade secret, and domain name issues for the company. Previously, she was an Assistant General Counsel with Nike, Inc. in Oregon, where she was responsible for a variety of trademark, copyright, and domain matters.

Dorothy has practiced law in the intellectual property groups of several general practice and intellectual property boutique firms in New York City. She was on the trial team in Hershey Food

Corps. v. Mars, Inc., an early trademark dilution case, and is the co-editor of the book <u>Law and the Environment: A Multidisciplinary Reader</u>, published by Temple University Press.

She graduated with a BA in English from Yale University, and a JD with honors from the University of Maryland School of Law, where she was an associate editor of the Maryland Law Review. She also has a Masters of Science in Conservation Biology from the University of Maryland.

Patent and Non-Traditional IP Diligence in Technology Transactions

November 13, 2019

Panelists:

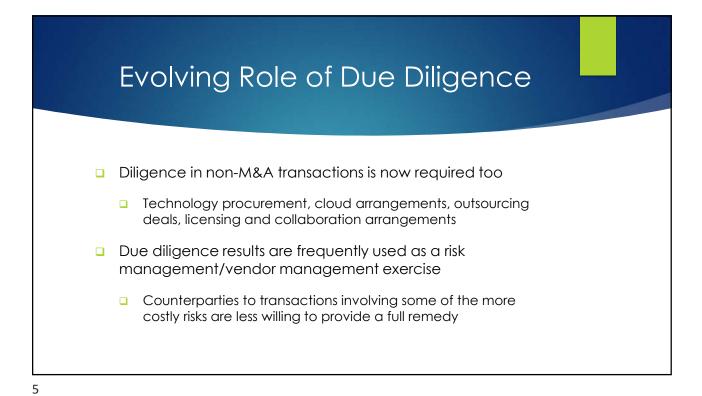
Moderator:

Nora Garrote, Partner, Venable LLP Khue Hoang, Partner, Reichman Jorgensen LLP Chloe Steadman, Vice-President, Euclid Transactional Dorothy von Hollen, Vice-President & Corporate Counsel, Prudential Financial Jeanne C. Curtis, Director, CDF Consulting

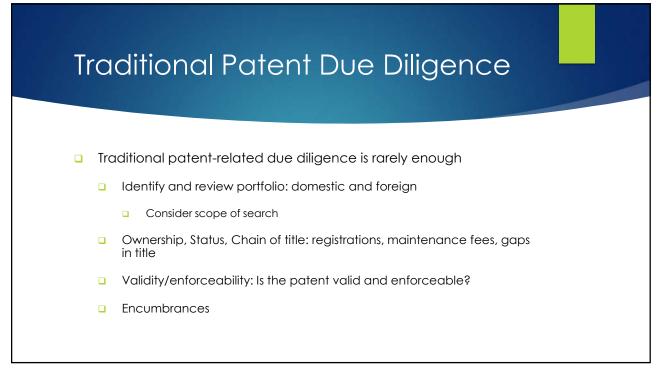


Evolving Role of Due Diligence
Traditional IP due diligence: determine intangible asset status/ownership/rights in M&A or technology asset dispositions
Patent, trademarks and registered copyrights, domain names
Searching, clearance, and basic contract review are key tasks
 Shapes key contract items, e.g., asset lists, warranties, indemnities, and limitations of liability

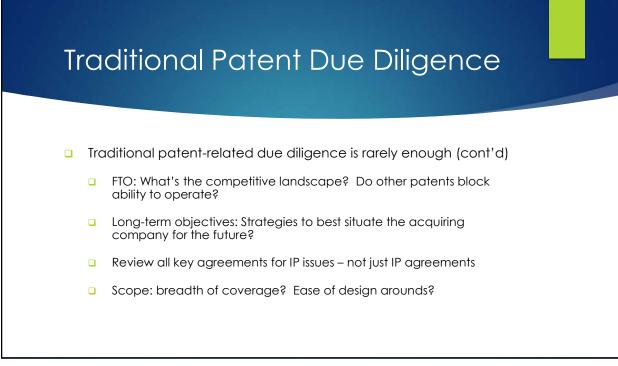


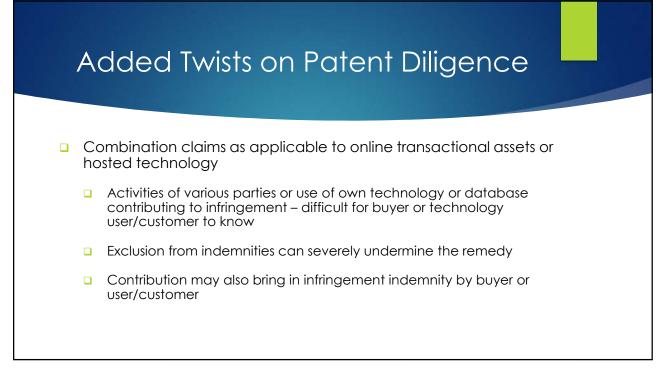




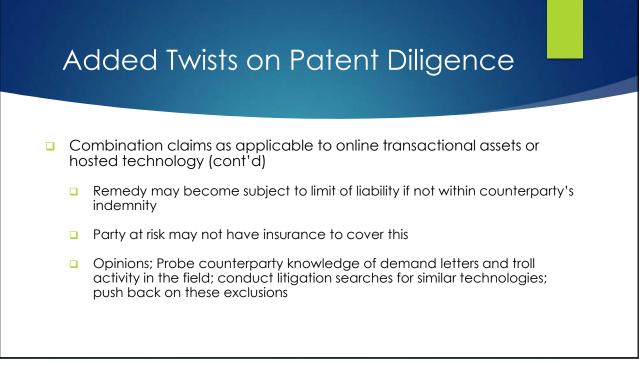


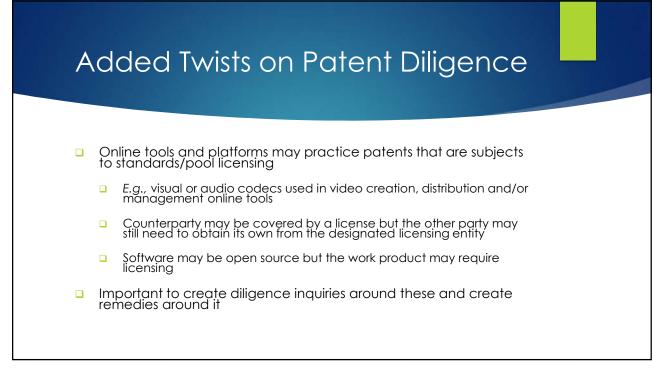
















т	
Irc	aditional Trademark Diligence
🗆 Re	estrictions
🛛 Th	ird party claims
	Coexistence and settlement agreements
🗆 Re	ecordals
Or	rdering full searches
	omain names

Added Twists on Trademark Diligence

Online assets present added challenges

- Genericized uses/evidence of use
- Establishing first use
- Applications/registrations owned by founding owners
- Non-traditional trademarks scope of protection
- Establishing and expanding int'l use

Traditional Copyright Diligence	
Determine scope and identify assets	
Copyrights central to business?	
Assess ownership, registration and enforcement	
Contractor issues	
Corporate policies	



Added	Twists on	Copyright
	Diligenc	ce

- Open Source Compliance
- User-generated content/DMCA Compliance
- Use of Templates and Third Party Formats
- Derivative Works/Wearables/Content translated to tools
- Thumbnails and Abstracts
- Related rights of privacy and publicity issues





Data as a Key Business Asset
 Identify the various types - internally generated; from consumers, users and customers; purchased/licensed; crowdsourced; marketing leads (cont'd) Diligence of sensitive data - mapping the data flows Who owns the data/clear contractual rights/how is it protected Scope of use/complying with restrictions Privacy policy impacts





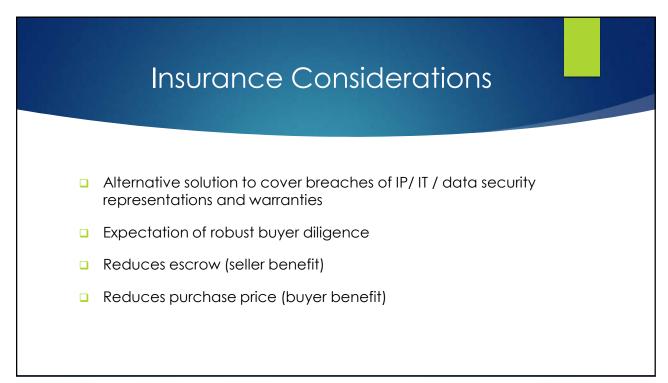




Confidential Information and Trade Secrets

What is the difference

- Contractual vs legal protection; burden of proof
- Documentation and markings
- Scope of diligence
 - How to identify; locations
 - Internal and external contractual arrangements
- Bring your own device issues



Insurance Considerations	
Increases indemnity cap	
Increases survival period	
Improves security (as opposed to recourse from seller)	





