

Annual
Conference
Program



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Denver, Colorado | July 17-19, 2022 | Magnolia Denver Hotel

NAPP 25TH ANNUAL MEETING & CONFERENCE



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Message from the President



Welcome to the National Association of Patent Practitioners (NAPP) 2022 Annual Meeting and Conference (AMC) held in beautiful Denver, Colorado.

Over the past few years, the pandemic took its toll on us, some more than others. Yet, NAPP persevered and continued its work to be the organization of choice for patent professionals. In 2020 and 2021, NAPP pivoted to virtual AMCs. Now, the 2022 AMC convenes its members as “neighbors down the hall” who connect and reconnect around the “water cooler.” Accordingly, the 2022 AMC highlights in-person social and networking events. For example, on Sunday, July 17, you should attend the 3-hour food tour with Local Table Tours LoDo Denver. On the afternoon of Monday, July 18, meet for lunch with your special interest group to talk about, for example, how you came to be a member of NAPP, what you think of the patent profession, experiences you’ve had, or issues you’re concerned about. In the evening of Monday, July 18, meet new colleagues at the networking reception at the Magnolia lounge.

In addition to rekindling in-person connections, the AMC planning committee brings together an impressive group of in-person experts with updates on patent practice. On Sunday, July 17, keynote speaker Carl Oppedahl highlights “ant-like persistence” in patent practice. On Monday, July 18, the AMC features speakers from the USPTO, including Judge Scott Moore (Lead Judge at Patent Trial and Appeal Board), Molly Kocialski (Director of the Rocky Mountain Regional USPTO), and Will Covey (USPTO Deputy General Counsel and Director for the Office of Enrollment and Discipline). On Tuesday, July 19, speakers cover issues ranging from process and prosecution, high stakes M&A and litigation, and conduct and diversity.

Plan to attend the NAPP Annual Meeting (Sunday, July 17) to learn about this year’s candidates for election, vote, and receive an NAPP annual report. The Annual Meeting is a great time to hear from committee leaders, learn more about volunteer opportunities with the NAPP organization, and discover other member benefits and professional development opportunities. The NAPP organization relies on its members to keep moving forward. The Board welcomes member suggestions, and this is an excellent time to provide feedback.

Your participation in the AMC shows NAPP is a dynamic, professional association. Thank you for your attendance and continued work within NAPP to make a difference in the patent profession.

Enjoy the AMC!

Christopher M. Turoski, President, NAPP



ATM Planning Committee

Dr. Daniel J. Krueger, Chair 2022
Thomas Bassolino
David Ladner
Alex Pokot
Dan Smith

Highlighted Social Events

Sunday, July 17, 2022

Local Table Tours LoDo Denver is from 6:00 PM - 9:00 PM

Local guides will share information about Denver and the local food scene over a 3-hour foodie tour. Guests will enjoy food & drinks spread out across three different restaurants for a progressive meal and a mix-and-mingling experience. Must have pre-registered by June 17, 2022. Check the registration desk for availability. Participants are to meet in the lobby at 5:45 PM and walk a few blocks the first location. Remember to wear comfortable shoes and clothes for walking, and bring a jacket and umbrella just in case you need it.

Monday, July 18, 2022

Local Lunch Reservations for Special Interest Groups is from 12:05 PM - 1:20 PM

NAPP is facilitating lunches for small groups at local restaurants. Sign up at the registration desk to have lunch with other attendees with common interests! Each attendee is responsible for paying for their own meal.

Networking Reception is from 5:30 PM - 7:30 PM

Join us for cocktails and hors d'oeuvres in the Magnolia Lounge!

General Information

Conference Wi-Fi

Network ID: Magnolia Conference
No Password required

Covid-19 Safety Information

While participating in the National Association of Patent Practitioners (“NAPP”) sponsored events “social distancing” must be practiced and we strongly suggest that unvaccinated attendees wear face coverings at all times to reduce the risks of exposure to COVID-19.

Duty to Self-Monitor

Participants and volunteers have agreed to self-monitor for signs and symptoms of COVID-19 (symptoms typically include fever, cough, and shortness of breath) and, contact NAPP at napp@napp.org if he/she experiences symptoms of COVID-19 within 14 days after participating or volunteering with NAPP.

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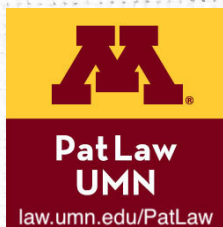
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Meeting & Conference Schedule

Sunday, July 17, 2022

Meeting Room

7:00am	Continental Breakfast & Registration Desk Open	Magnolia Lobby
8:15am	Welcome and Opening Remarks	17th by Magnolia
8:30am-9:00am	<i>Engagement, Disengagement & Non-engagement (Ethics)</i> Tamsen Valoir, PhD, Partner, Boulware & Valoir, NAPP Member	
9:05pm-9:35pm	<i>Do's and Don'ts for Filing, Allowance and Reporting</i> Sparkle T. Ellison, PhD, Legal Counsel at LyondellBasell	
9:40am-10:10am	<i>Your Drawings Are Your Claim, Doing Better Design Patents</i> Margaret Polson, Founder and Principal Attorney, Polson Intellectual Property Law, PC	

Refreshment Break (15 minutes)

Magnolia Lobby

10:25am-10:55am	<i>What Examiners Wish Practitioners Understood</i> Gary O'Neill, Managing Director, Examiners Edge, NAPP Member	
11:00am-11:30am	<i>Continuation Claim Strategies</i> Yehuda Binder, May Patents, NAPP Member	
11:35am-12:05pm	<i>Practitioner's Guide to Post Grant Practice</i> Melissa Schwaller, Hogan Lovells, NAPP Member	
12:05pm - 1:20pm	Keynote Presenter Carl Oppedahl and Lunch	Magnolia Lounge
1:25pm-2:10pm	<i>Take Home Lessons from Case Law Summaries</i> Genna Hibbs, Founder, Hibbs Law, LLC, NAPP Member	
2:15pm-2:45pm	<i>Drafting Tips for International Prosecution</i> Sarah Foley, Partner, Barta, Jones & Foley, PLLC, NAPP Member	
2:50pm-3:20pm	<i>Practicing Outside Home State/Country (Ethics)</i> Kevin Kuelbs, Lead Partner, Osha, Bergman, Watanabe & Burton LLP	

Meeting & Conference Schedule

Refreshment Break (15 minutes)

Magnolia Lobby

3:35pm-5:10pm Annual Meeting
NAPP President, Christopher M. Turoski,
University of Minnesota Law School & NAPP Leadership

5:10pm Closing Remarks

6:00pm - 9:00pm Local Table Tours LoDo Denver

**Offsite:
Meet in Hotel Lobby**

Monday, July 18, 2022

Meeting Room

7:30am Continental Breakfast & Registration Desk Open

Magnolia Lobby

8:00am Opening Remarks

17th by Magnolia

8:15am-8:45am *Intersections: FDA & IP*
Genna Hibbs, Founder, Hibbs Law, LLC, NAPP Member

8:50am-9:20am *Appeals Practice*
James Gourley, Partner, Carstens & Cahoon, LLP

9:25am-9:55am *Tips for Appeal Briefs & Oral Hearings*
Judge Scott Moore, Patent Trial and Appeal Board

Refreshment Break (15 minutes)

Magnolia Lobby

10:10am-10:40am *Avoiding Malpractice When Filing PCT Applications*
Carl Oppedahl, Founding Partner, Oppedahl Patent Law Firm LLC

10:45am-11:15am *Working With Foreign Associates (Ethics)*
Emil J. Ali, Partner, McCabe & Ali, LLP

11:20am-12:05pm *Advocacy and Developments at USPTO*
Molly Kocialski, Regional Director, USPTO Rocky Mountain Regional Office

Meeting & Conference Schedule

- 12:05pm - 1:20pm** *Special Interest Groups - Local Lunch Reservations*
- 1:25pm-2:10pm** *Professional Responsibility and Practice Before the USPTO (Ethics)*
William Covey, Deputy General Counsel and Director, and
Dahlia A. George, Staff Attorney, Office of Enrollment and Discipline, USPTO
- 2:15pm-2:45pm** *Legislative or Executive?*
Possible Approaches to Fixing 101
Christal Sheppard, Ph.D., Adjunct Professor,
Nebraska College of Law and University of Minnesota
- 2:50pm-3:20pm** *Patent Professionalism*
Kelli Daniels Morin, Intellectual Property Lawyer, IBM

Refreshment Break (15 minutes)

Magnolia Lobby

- 3:35pm-4:35pm** *"What Every IP Lawyer Should Know About Administrative Law"*
David Boundy, Partner, Potomac Law Group, PLLC, NAPP Member
- 4:40pm-5:10pm** *Small Words -> Big Problem*
Thomas L. Irving, Partner, Finnegan
- 5:10pm** Closing Remarks
- 5:30pm-7:30pm** Networking Reception

Magnolia Lounge

Meeting & Conference Schedule

Tuesday July 19, 2022

Meeting Room

7:30am	Continental Breakfast & Registration Desk Open	Magnolia Lobby
8:00am	Opening Remarks	17th by Magnolia
8:15am-8:45am	<i>Avoiding Bad Faith (Ethics)</i> Thomas L. Irving, Partner, Finnegan	
8:50am-9:20am	<i>Shortcuts & Automation Tips for Practitioners</i> Mike Carey, Patent Attorney, F. Chau & Associates, NAPP Member	
9:25am-9:55am	<i>Promoting Diversity in Patents and Patent Practice</i> Kirby Drake, Founder, Kirby Drake Law PLLC	

Refreshment Break (15 minutes)

Magnolia Lobby

10:10am-10:40am	<i>Patent Prosecution Tips</i> Nihal S.A. Parkar, Associate, Eversheds Sutherland	
10:45am-11:15am	<i>Prepping for Due Diligence: Buyer's and Seller's Perspective</i> Priya Sinha Cloutier, Chief General Counsel, Picnic Works, Inc., NAPP Member	
11:20am-12:20pm	<i>What Happens to Your Claims During Litigation: "It Depends on What the Meaning of the Word 'Is' Is"</i> Panelists: Bernie Greenspan, PhD, Principal Consultant, Greenspan IP Management, NAPP Member David Boundy, Partner, Cambridge Technology Law LLC, NAPP Member Jonathan Stroud, General Counsel, Unified Patents	
12:20pm	Closing Remarks	

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Emil Ali, Partner,
McCabe & Ali, LLP
Working With Foreign Associates (Ethics)

Emil J. Ali Emil J. Ali is a partner at McCabe & Ali, LLP where he focuses his practice on helping lawyers understand their obligations under state

and federal law. As a registered patent attorney, a significant focus of his practice involves advising lawyers and law firms (as well as patent agents) on all aspects of the intersection of IP and ethics matters. Emil's work includes counseling clients on lateral transitions, malpractice avoidance, expert opinion and testimony, and respondent's defense work before various bars and courts. You can view his musings on IP ethics issues at www.ipethicslaw.com



Yehuda Binder,
May Patents
Continuation Claim Strategies

Mr. Yehuda Binder holds a B.Sc. (cum-laude) in Electronic Engineering from the Israeli Technion Institute of Technology, as well as an M.Sc.E.E. (cum-laude) and an

M.B.A. from the Tel-Aviv University. Yehuda was Orckit's representative to the ETSI-TM6 and ANSI T1E1.4 standard committees, and took an active role in the actual drafting of the HDSL and ADSL standards, for both European and North-American markets. Yehuda is an U.S. Patent Agent, and named on over 200 (!!) issued US patents, and over 250 patents worldwide. Most of the patents were sold in multiple transactions, and many were successfully

litigated in the U.S., and Yehuda is considered an expert in patent monetization. Yehuda was involved in many successful Israeli start-ups, such as Orckit Communication (IPOed in Nasdaq) and Indigo (bought by HP), and also solely founded and managed SercoNet Ltd. The total investments in Yehuda's founded start-ups exceeded \$30M, and the investors typically enjoyed substantial return on their investments.

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David Boundy, Partner,
Potomac Law Group, PLLC
What Every IP Lawyer Should Know About Administrative Law

David Boundy of Potomac Law Group PLLC, in Boston, Massachusetts, practices at the intersection of patent and administrative law, and

consults with other firms on matters before and appeals from the Patent Trial and Appeal Board. David is recognized as one of the nation's experts in administrative law: in March 2018, the United States Court of Appeals for the Federal Circuit invited David to lead a panel that included the President's chief regulatory oversight officer, in a program at the court's Judicial Conference to assist the court and bar in understanding administrative law issues. In 2007-09, David led teams that successfully urged the Office of Management and Budget to quash the Patent Office's continuations, 5/25 claims, IDS, and appeal regulations. In addition, he prosecutes patent applications and advises on intellectual property strategy. He may be reached at DBoundy@PotomacLaw.com.

Conference Speakers



Mike Carey,
F. Chau & Associates
*Shortcuts & Automation Tips
for Practitioners*

Mike Carey is a patent attorney with F. Chau & Associates. He focuses on the technology areas of software and electrical engineering, with an emphasis on artificial intelligence. Mike also develops technology and processes to increase the efficiency of patent preparation and prosecution. He founded the company Fenix.ai to implement his patent automation methods. Prior to becoming a patent attorney, Mike was an officer in the United States Air Force, and flew a C-130 in multiple combat deployments. He has a BS in Mathematics from BYU, an MS in Physics from North Carolina State, and JD from Harvard.



Priya Sinha Cloutier,
Chief General Counsel,
Picnic Works, Inc.
*Prepping for Due Diligence
"Buyer & Seller Perspectives"*

Priya Sinha Cloutier, after spending 20 years in private practice, joined Picnic Works, Inc as Chief General Counsel.

Priya has experience in all aspects of intellectual property protection, strategy and law, including patents, trademarks, copyright, and trade secrets and addressing issues regarding patentability analysis, drafting, filing, patent prosecution, transactions, standards, cease and desist issues, indemnification, due diligence, trademark and patent infringement analysis, design arounds, right to market clearances, competitive landscapes,

and requests to license. Expertise in drafting and negotiating international, commercial, supplier, partner, collaboration and development agreements, joint research, NDAs, supply contracts, master service agreements, SaaS, cloud services and software, and consortium deals with strong IP, export control, compliance, and other complex issues. Experience with client counseling on IP strategy and open source and client, paralegal and attorney training, trade secret protection, document marking, government contracts compliance. Experience as outside general counsel for startups and closely held corporation, including outside counsel management, international employment, debt recovery, privacy, anti-corruption, and open source. Experience with government contracts (grants and CRADAs) and compliance programs.



Will Covey,
**USPTO Deputy General
Counsel and Director for
the OED**

*Professional Responsibility
and Practice Before the USPTO
(Ethics)*

As Deputy General Counsel and Director for the Office of Enrollment and Discipline (OED), Will Covey is responsible for ensuring that the nation's patent attorneys and agents are of good moral character and sufficiently knowledgeable to practice before the USPTO. Mr. Covey's team of attorneys and other professionals develop and administer a registration examination designed to measure applicants' knowledge of patent law and practice. Successful applicants are registered to practice by OED. In addition, OED investigates complaints of unethical conduct made against individuals practicing patent or trademark law before the USPTO. Mr. Covey has held a number of key positions in the USPTO, including acting general counsel and

Conference Speakers

deputy general counsel for the Office of General Law. Mr. Covey was appointed to the Senior Executive Service in 2007. Mr. Covey received his undergraduate degree from Fordham University (Magna Cum Laude, Phi Beta Kappa) and earned his J.D. from Fordham University Law School in 1991. He graduated from Harvard University's JFK School of Government (Senior Executive Fellowship) in 2005 and the U.S. Army War College with an M.S. (Strategic Studies) in 2010. Prior to joining the USPTO in 2000, Mr. Covey was a special assistant U.S. Attorney for the District of New Jersey. He also served on active duty in the Pentagon and was a senior officer in the Army Reserve assigned to the Army Staff, Office of the Judge Advocate General. He completed combat tours in Iraq (2007) and Afghanistan (2011) and served as deputy legal counsel to the Chairman of the Joint Chiefs of Staff.



**Kirby Drake, Founder,
Kirby Drake Law PLLC**
*Promoting Diversity in Patents
& Patent Practice*

Kirby B. Drake is the Founder and Managing Partner of Kirby Drake Law PLLC in Dallas, Texas. Since 2002, Ms. Drake has focused her

efforts on helping clients successfully navigate their intellectual property (IP) challenges. She has a special focus on the patent process, as she is a registered patent attorney. Ms. Drake is active in the American Chemical Society, both on the local and national levels. Most recently, she served as Chair of the National Committee on Patents and Related Matters, and she currently serves on the National Committee on Constitution and Bylaws (C&B).



**Dr. Sparkle Ellison,
Legal Counsel at
LyondellBasell**

*Do's and Don'ts for Filing,
Allowance and Reporting*

Sparkle T. Ellison, Ph.D. is in-house counsel at LyondellBasell in Houston, Texas, where she manages the IP needs of

the Advanced Polymer Solutions business in the Americas. Before joining LyondellBasell, Sparkle was a partner at a small IP boutique firm in Houston as a fullservice intellectual property attorney in the areas of chemical, oil and gas, stem cell, and medical devices. Prior to law school, Sparkle conducted research in the fields of synthetic polymer analysis, forensic analysis, and testing/analysis of drugs of abuse in complex biological matrices, with an emphasis on mass spectrometry and spectroscopy.



**Sarah Foley, Partner,
Barta, Jones & Foley, PLLC**
*Drafting Tips for International
Prosecution*

Sarah Foley is a registered U.S. patent attorney experienced in advising and counseling clients in all areas of intellectual property law. Her practice

focuses on patent portfolio management, including preparing and filing patents and worldwide prosecution of applications, as well as acquisitions, due diligence, product clearance, portfolio analysis, and trademark preparation and prosecution. Her experience includes an array of technology involving software, hardware, networking, computer

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systems, aerospace, robotics, and automotive and mechanical fields. Barta, Jones & Foley, P.C. is a women and minority-owned law firm with attorneys in Texas, Missouri, and Kansas, committed to diversity and inclusion both within the Firm and in partnership with clients around the world.



Dahlia A. George,
Staff Attorney,
Office of Enrollment and
Discipline, USPTO

*Professional Responsibility
and Practice Before the USPTO
(Ethics)*

Dahlia George first joined the U.S. Patent and Trademark

Office (USPTO) in January 2005 as a Trademark Examining Attorney. In January 2008, she joined the USPTO Office of General Law where she investigated and prosecuted EEOC complaints, grievances, and Merit Systems Protection Bureau appeals. She also responded to subpoenas for Government witnesses and documents, investigated Federal Tort Claims Act claims and IG inquiries, and handled Reasonable Accommodation requests for legal sufficiency. In addition, she was the USPTO FOIA Officer. Since January 2011 to the present, she joined the USPTO Office of Enrollment and Discipline where she investigates grievances and complaints alleging misconduct by patent and trademark practitioners; conducts moral character and "fitness to practice" applications for individuals seeking registration before the USPTO; and heads the Diversion Pilot Program for impaired practitioners.

Before working at the USPTO, Ms. George was an Assistant Attorney General for the N.H. Office of Attorney General where she investigated and prosecuted professional misconduct cases against licensed professionals such as physicians,

psychiatrists, psychologists, and social workers, before their respective licensing boards.

Prior to her stint as a N.H. Assistant Attorney General, she served a tour of duty as a Judge Advocate General (JAG) in the United States Air Force where she served as a prosecutor for the United States in courts-martial and administrative discharge proceedings; handled procurement and claims matters; and advised base and wing commanders on the legality of base activities such as bingo night and mess activities. Later she was promoted to the position of Area Defense Counsel for three bases covering 15,000 military and civilian personnel, where she represented military personnel in courts-martial (felony trials) and discharge proceedings.

She is licensed to practice law in the District of Columbia.



CARSTENS & CAHOON, LLP

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James Gourley,
Partner, Carstens &
Cahoon, LLP
Appeals Practice

James R. Gourley practices primarily in commercial litigation, including intellectual property litigation, intellectual property prosecution and entertainment law.

Mr. Gourley has prosecuted and obtained patents for clients in a wide range of technology fields, including oil and gas production, consumer electronics accessories, computer software, food chemistry, product packaging, medical devices, pet care, nuclear energy, and pumps and compressors.

Conference Speakers

He has also applied for and obtained federally registered trademarks for clients in many different industries. Mr. Gourley understands that intellectual property rights are among a company's most valuable assets, and he has been successful in helping companies build strong intellectual property portfolios. He has also negotiated a variety of intellectual property licensing, development, and employment agreements, and provided intellectual property due diligence advice with respect to corporate merger and acquisition transactions. Mr. Gourley has represented individual artists and filmmakers as parties to copyright infringement lawsuits in federal court. He has also represented start-up internet companies with a wide variety of copyright, trademark, and patent issues. He has also helped clients enforce and defend patent, trademark, and other commercial rights in court, including recently serving as lead defense counsel in the first ever patent infringement lawsuit in the field of cannabis formulation. Mr. Gourley has also served as an expert witness in civil litigation on issues related to intellectual property. Mr. Gourley earned his Doctor of Jurisprudence degree from Southern Methodist University in 2005. Prior to law school, he graduated from the University of Oklahoma with a Bachelor of Science degree in Chemical Engineering. His undergraduate education exposed him to a wide range of technical courses, including high level organic and physical chemistry, biochemistry, physics, mechanics, electronics, and computer science, which gives him the unique ability to help companies protect technology in many different fields. Mr. Gourley is a registered patent attorney before the United States Patent and Trademark Office. He currently serves on the Board of the Dallas Bar Association, Intellectual Property Section. He is licensed to practice in Texas and Colorado, and he is admitted to the United States District Courts for the Northern, Southern, Eastern and Western Districts of Texas.



**Bernie Greenspan,
Greenspan IP Management**

*What Happens to Your Claims
During Litigation: "It Depends
on What the Meaning of the
Word 'Is' Is"*

Dr. Greenspan is the Principal Consultant at Greenspan IP Management. He provides

business advice on intellectual property strategies for life science, pharmaceutical, biotech, diagnostic, and medical device companies. He assists clients with patentability studies and claim drafting for robust protection of inventions and products. Combining his 20 years in R&D with 20+ years in IP management, Bernie provides a unique approach that takes into account scientific, regulatory, business, and patent aspects. Bernie has held positions as Senior Director of Intellectual Property at Prometheus Laboratories and Nestlé Health Science, Director of IP Strategy Management for Pfizer La Jolla Laboratories, and Senior Director of Intellectual Property at Verus Pharmaceuticals. He has managed patent portfolios in a variety of therapeutic areas including respiratory drug formulation, dosing, and delivery devices; ophthalmology; oncology; virology; diabetes and obesity; anaphylaxis and autoinjector technology; and diagnostic markers and methods in gastrointestinal diseases. Bernie's research and development career has included positions as Director of Aerosol Technology at Dura Pharmaceuticals and Elan Pharmaceuticals and Staff Scientist at Battelle Pacific Northwest National Laboratory, and Staff Scientist at Union Carbide Corporation's toxicology laboratory. He is an inventor on 11 issued US patents. Bernie holds a BA

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in physics with honors from Clark University, and an MS and Ph.D. in biophysics from the University of Rochester School of Medicine and Dentistry. He is registered to practice at the USPTO as a patent agent. He may be reached at bernie@GreenspanIP.com.



Genna Hibbs,
Founder, Hibbs Law LLC
NAPP Case Law Summaries,
Take Home Lessons

Genna's legal career reflects her diverse background in science, literature, and business, applied with an earnest desire to provide

superior quality and accessible legal representation to her clients. She double majored in Genetics and English Literature at the University of Kansas, worked QA/QC in the biotech contract processing industry, and taught English in Japan before entering the legal field. A cum laude graduate of Gonzaga University School of Law, in 2013 Genna founded Hibbs Law, LLC, an intellectual property boutique law firm serving the greater Chicago area and Southern Wisconsin. With a particular interest in intellectual property and regulatory compliance law, Genna is a member of the Illinois bar, the U.S. District Court for the Northern District of Illinois, and the U.S. Patent and Trademark Office. She deeply enjoys applying her legal knowledge (affectionately known as "practicing legal wizardry") to address the unique needs of her clients.

FINNEGAN



Tom Irving,
Partner, Finnegan

Avoiding Bad Faith

Tom Irving has some 45 years of experience in intellectual property law. His U.S. pharma practice includes America Invents Act (AIA) post-grant proceedings, due diligence,

counseling, patent prosecution, reissue, and reexamination. In addition to advising on procuring strong U.S. patents, Tom counsels clients on a wide range of mainly pharmaceutical matters, including pre-litigation, Orange Book listings of patents covering FDA-approved drugs, infringement issues, enforceability, supplemental examination, and validity analysis. He has served as lead counsel in numerous patent interferences, reissues, and reexaminations; as lead counsel in numerous AIA post-grant proceedings; and as an expert witness in patent litigation and patent procurement.

Tom's current practice is heavy on due diligence analysis, as well as AIA post-grant proceedings, including how to evaluate and enhance the strength of U.S. patents in the pharmaceutical space to protect against post-grant challenges. Tom directed the preparation of two highly complex IPR's, which worked out well for the innovative pharma patent owner. Tom also focuses on 35 U.S.C. § 112 (f), supplemental examination, and *Sanofi v. Watson*-type claims, all of which he considers to be under-utilized.

Tom has been extensively involved in counseling, due diligence, prosecution and prelitigation for matters involving major drugs such as Kalydeco®, Orkambi®, Aloxi®, Tecfidera®, Lorcaserin®, Pulmicort®, Respules®, Taxotere®, Eloxatin®, Lantus®,

Conference Speakers

Crestor®, Targretin®, Brilinta®, Halaven®, Allegra®, Apidra®, Epiduo Gel®, Rilutek®, Ramipril®, Jakafi®, Duexis®, Viracept®, Keveyis®, and other drugs such as Rimonabant®, VX-661, and HMPL 0004®, in clinical trials prior to FDA approval. He successfully reissued the patent for the low molecular weight heparin drug, Lovenox®, a blockbuster product.

For more than 25 years, Tom served as principal teacher of the Patent Resources Group (PRG) Chemical Patent Practice course, a comprehensive course on U.S. chemical patent law taught twice a year, and he coauthored the multi-volume treatise used in the course. He originated PRG's Orange Book and Due Diligence courses, which helped prepare patent owners, through effective application drafting and prosecution, to withstand the rigors of AIA's inter partes review (IPR) and post-grant review (PGR). He presents analyses of U.S. Court of Appeals for the Federal Circuit and Patent Trial and Appeal Board (PTAB) decisions for many state bar association groups and has spoken at numerous national trade and bar association meetings, including the now ubiquitous virtual presentations, such as Intellectual Property Owners Association, American Intellectual Property Law Association (AIPLA), and American Bar Association. Tom has lectured at many law schools in both the United States and China, and at the Patent Office of the State Intellectual Property Offices (SIPO) of the People's Republic of China. He has participated in more than 150 Strafford Webinars on U.S. patent law topics, including several that dealt with 35 U.S.C. § 112 (f), supplemental examination, and Sanofi v. Watson-type claims, supplemental examination, inducement to infringe, claim construction, enablement, written description, claim definiteness, and AIA post-grant proceedings.

Over the years, Tom has been recognized by Intellectual Asset Management as a global IP leader and leading patent prosecutor in the D.C.

metro area, as well as nationally for post-grant procedures. The Legal 500 U.S. has recognized him for patent portfolio management and licensing. Tom was inducted into the LMG Life Sciences Hall of Fame and recognized as the Patent Strategy & Management Attorney of the Year: District of Columbia.

Tom opened the firm's first European office in Brussels in 1993 and paved the way for involving Finnegan in extensive patent work in the State of Israel. He holds Judicial®, AV-Preeminent®, and AV® ratings by Martindale-Hubbell.



Molly Kocialski,
Director, Rocky Mountain
Regional USPTO

Advocacy and Developments at USPTO

As the Director of the Rocky Mountain Regional United States Patent and Trademark Office (USPTO), since January

2016, Mollybeth (Molly) Kocialski carries out the strategic direction of the Under Secretary of Commerce for Intellectual Property and Director of the USPTO, and is responsible for leading the Rocky Mountain regional office. Focusing on the nine states within this region and actively engaging with the community, Ms. Kocialski ensures the USPTO's initiatives and programs are tailored to the region's unique ecosystem of industries and stakeholders. Ms. Kocialski brings more than 20 years of intellectual property experience to the USPTO. Most recently, Ms. Kocialski was the Senior Patent Counsel for Oracle America, Inc., where she was responsible for managing an active patent prosecution docket and was also responsible for all of the post-grant procedures and patent investigations for Oracle and its subsidiaries. Prior to Oracle, she worked at Qwest Corporation and

Conference Speakers

was also in private practice in both New York and Colorado focusing on intellectual property litigation for multiple high-tech companies while maintaining an active prosecution docket. Ms. Kocialski is a recognized IP leader in the Rocky Mountain region. Ms. Kocialski currently serves on the Colorado Federal Executive Board's Executive Committee. Ms. Kocialski is the President of the Colorado IP Inn of Court and was previously the Chair of the Planning Committee and a member of the Board of Directors of the Colorado IP Inn of Court. Further, Ms. Kocialski is a member of the Planning Committee for the Rocky Mountain Intellectual Property Institute, an annual two-day conference on intellectual property that attracts over 500 attendees. She was the Chair of the Intellectual Property Section of the Colorado Bar Association and served on the Colorado Bar Association's Board of Governors. Ms. Kocialski served as the head of the IP Committee and was a member of the Board of Directors for the Colorado Chapter of the Association of Corporate Counsel and served on the National IP Committee of the Association of the Corporate Counsel. In 2015, Ms. Kocialski was recognized by *ManagingIP* magazine as one of its North America Corporate IP Stars. Ms. Kocialski is a graduate of the State University of New York at Buffalo School of Law and received a Bachelor of Science in Chemical Engineering from the University of New Mexico. Ms. Kocialski is a registered patent attorney and is admitted to the U.S. Patent and Trademark Office, the New York and Colorado state bars as well as to the United States Courts in those jurisdictions.



Kevin Kuelbs, Osha, Bergman, Watanabe & Burton LLP

Practicing Outside Your Home State/Country (Ethics)

Kevin Kuelbs is the lead partner for the Boulder, Colorado office of Osha Bergman

Watanabe & Burton (OBWB). Kevin's practice covers a variety of technology areas including next-generation telecommunications, enterprise storage systems, automotive control systems, embedded computing, and human-machine interfaces. In this regard, Mr. Kuelbs' experience includes drafting and prosecuting foreign and domestic patent applications, presenting oral arguments before the Patent Trials and Appeals Board (PTAB), drafting claim charts for Inter Partes Review (IPR) proceedings, drafting invalidity opinions, and performing diligence activities for portfolios of interest. In addition, Mr. Kuelbs has extensive experience in the acquisition of Standard Essential Patents (SEPs). Locally, Kevin participates in economic growth initiatives in the state of Colorado empowering small and medium businesses to bring emerging technologies to market. Prior to joining the firm, Mr. Kuelbs worked as a hardware and software engineer at Hewlett-Packard, where he led a diagnostics validation lab that collaborated globally with team members, stakeholders, and vendors.

Conference Speakers



PTAB Judge Scott Moore

Tips for Appeal Briefs & Oral Hearings

Lead Judge Scott C. Moore was appointed to the Patent Trial and Appeal Board in 2014. Judge Moore began his legal career as an associate at Irell and Manella LLP, and was a litigation partner at Morrison & Foerster LLP until he joined the Board. Judge Moore earned his law degree from The University of Chicago Law School. He holds a Bachelor of Science degree in Aerospace Engineering from North Carolina State University.



Kelli Daniels Morin, IP Lawyer, IBM

Patent Professionalism

Kelli studied biomedical engineering and psychology at Case Western Reserve University in Cleveland and went on to get her JD at Boston University. While in law school, Kelli gained experience at the Massachusetts Department of Developmental Services, which provides supports for individuals with intellectual and developmental disabilities, and clerking for the Honorable Judge S. Arthur Spiegel in the United States District Court for the Southern District of Ohio. Following law school, Kelli spent nine years as an intellectual property attorney at a boutique IP firm in Indianapolis, Indiana before taking her current role as an in-house patent attorney for IBM in Rochester, Minnesota.



Gary O'Neill, Managing Director, Examiners Edge

What Examiners Wish

Practitioners Understood

Gary serves as Managing Director of Examiners Edge® and is a Registered US Patent Agent. In his present role he leads a multidisciplinary team of specialized patent professionals who help senior company leaders protect business profits and checkmate their competition through strategic and tactical leverage of the US patent system. Gary is a former US Patent Examiner with over a decade of experience at the United States Patent Office where he successfully prosecuted more than 500 patent applications in complex optical systems and electrical arts. At NAPP, Gary serves on the Diversity and Inclusion task force and engages in forum discussions. Gary has achieved recognition as a Senior Grade member of the Institute of Electrical and Electronic Engineers, IEEE, and serves on the IEEE-USA Intellectual Property Committee. Prior to focusing on intellectual property, Gary pursued a robust engineering and engineering management career highlighted in the pharmaceutical sector at Merck & Co., and the automotive arena at General Motors Corp. Gary holds a Bachelor's degree in Electrical Engineering from NYU Tandon School of Engineering, and a Master of Divinity degree from Calvary Baptist Theological Seminary.

Conference Speakers



**Carl Oppedahl,
Oppedahl Patent
Law Firm LLC**

Carl Oppedahl is a frequent speaker and lecturer on the Patent Cooperation Treaty. He is author of the Ant-Like Persistence blog. He is a founding partner of Oppedahl

Patent Law Firm LLC and has been serving clients for many years.



**Nihal S.A. Parkar,
Associate, Eversheds
Sutherland**

Patent Prosecution Tips

Nihal Parkar is an associate at Eversheds Sutherland. He focuses on patent preparation and prosecution in the medical devices, chemicals,

pharmaceuticals, life sciences, and materials fields. He helps clients manage the complete patent life-cycle, from the early stages of innovation through patent grant.

A registered US patent attorney, Nihal manages complex international patent portfolios and coordinates patent strategies in several different jurisdictions throughout the world. Nihal also counsels clients on questions of patentability, clearance, validity, and infringement, and conducts intellectual property due diligence to facilitate corporate transactions.

Nihal earned his JD from the University of Minnesota Law School, a Master of Science degree in Chemical Engineering from the University of Illinois at Chicago, and a Bachelor of Technology degree in Food Engineering from the Institute of Chemical Technology in Mumbai.



POLSON INTELLECTUAL PROPERTY LAW PC
Patent, Trademark and Copyright Attorneys



**Margaret Polson,
Founder and Principal
Attorney Polson**

*Intellectual Property Law
Your Drawings Are Your Claim,
Doing Better Design Patents*

Margaret Polson is founder and principal attorney for

Polson Intellectual Property Law. Overseeing the preparation and prosecution of utility and design patent applications, trademarks, and copyrights, she also assists clients with licensing and intellectual property strategy and management. In the United States, Ms. Polson has drafted, prosecuted and enforced utility patents for diverse clients and obtained patents in a wide variety of technical areas, from drilling tools to computer-controlled rock saws, complex amusement rides, and vegetable-based engine oil. She helps multinational corporations protect their intellectual property worldwide, including IP strategy, patent portfolio management, and enforcement. Ms. Polson also has obtained hundreds of design patents for her clients on a wide variety of commercial products. Ms. Polson's clients include IFly Indoor Skydiving, Fitbit, and US Thrillrides. Ms. Polson also specializes in helping startups spend their limited intellectual property budget wisely, having counsel hundreds of startups and individual inventors during her career. Ms. Polson is a frequent speaker on IP, particularly designs and is a past Chair of the Industrial Designs Committee of the American Intellectual Property Law Association (AIPLA), and is chair of the AIPLA Design Rights Boot Camp programming committee and Chair of the AIPLA Professional Programs Committee.

Conference Speakers

Hogan
Lovells



**Dr. Melissa Schwaller,
Hogan Lovells**

*Practitioner's Guide to Post
Grant Practice*

Melissa focuses her practice on intellectual property within the life science and chemical industries. She has broad experience protecting

intellectual property related to biotechnology, pharmaceuticals, medical devices, and plants. She assists clients in seeking and maintaining patent and trademark protection and provides opinions regarding intellectual property issues. She has particular experience in freedom-to-operate, due diligence, and patentability opinions as well as post grant proceedings. Melissa has represented clients before the Patent and Trial Appeal Board. Additionally, Melissa prepares and reviews agreements regarding intellectual property rights. Prior to joining Hogan Lovells, Melissa was a partner at an intellectual property firm in Houston. Melissa earned a Ph.D. in biochemistry from Baylor College of Medicine, where she studied protein folding. Melissa has authored multiple scientific publications and legal articles.



**Dr. Christal Sheppard,
Nebraska College of Law**

USPTO Approaches to Fixing 101

Dr. Christal Sheppard has over 3 decades of science, intellectual property law and policy experience covering a large proportion of the IP ecosystem. Her experience

includes serving as chief counsel of patent and trademarks in the United States House of Representatives, as the first Director of the first USPTO Regional Office, as a member of the Administration's Public Patent Advisory Committee, and in the International Trade Commission's General Counsel's Office. Among many other endeavors, currently she is an adjunct professor at the University of Nebraska College of Law and the University of Minnesota, serves as a Distinguished Fellow at the Nebraska Governance and Technology Center and is Vice Chair of the American Intellectual Property Legislation committee and serves on the Naples Conference Amicus Brief Committee.



Jonathan Stroud

*What Happens to Construction
Claims During Litigation*

Jonathan Stroud is General Counsel at Unified Patents, LLC, where he manages a growing team of talented, diverse attorneys and oversees a docket of administrative

challenges, appeals, licensing, pooling, and district court work in addition to trademark, copyright, administrative, amicus, policy, marketing, and corporate matters.

Prior to Unified, he was a litigator with Finnegan, Henderson, Farabow, Garrett & Dunner LLP, and prior to that, he was a patent examiner at the USPTO. He earned his J.D. with honors from the American University Washington College of Law; his B.S. in Biomedical Engineering from Tulane University; and his M.A. in Print Journalism from the University of Southern California. He enjoys teaching, writing, and speaking on patent and administrative law.

Conference Speakers



**Christopher M. Turoski,
NAPP President**

NAPP Annual Meeting

Christopher M. Turoski currently serves as President of the National Association of Patent Practitioners and is an Assistant Professor of Patent Law

Programs at the University of

Minnesota Law School. Turoski is the author of the treatises "Assets & Finance: Intellectual Property in Mergers and Acquisitions, 2021 ed." and "The America Invents Act: A Guide to Patent Litigation and Patent Procedure, 2021 ed.," both published by Thomson Reuters. Previously, Turoski held a series of executive-level positions at Cargill Inc., the largest privately held corporation in the United States. Turoski previously served as secretary and general counsel for the Epilepsy Foundation of Minnesota, and as a Board Director for the Minnesota Distance Running Association and its Foundation. He began his legal career at Foley & Lardner, an international law firm. Turoski graduated from the University of Minnesota Law School magna cum laude, serving on the law review.



**Dr. Tamsen Valoir, Partner,
Boulware & Valoir**

*Engagement, Disengagement &
Non-engagement (Ethics)*

Dr. Valoir focuses her practice on intellectual property and FDA regulation in the life sciences and oil & gas, but she also has extensive experience

in copyright and trademark enforcement. Her work includes patent prosecution, infringement and patentability opinion work, licensing, due diligence, FDA patent term extensions and data exclusivities, as well as litigation related to copyright, trademark and patent infringement. In the last few years, in addition to patent prosecution, Dr. Valoir's practice has focused on intellectual property due diligence, regulatory due diligence, clinical trial agreements, as well as various licensing agreements, including those to migrate intellectual property to low tax jurisdictions. She has also focused on freedom to operate (FTO) work in the pharmaceutical, biotechnology, oil & gas and agricultural industries. She has assisted a major pharmaceutical company to address FTO issues in its biotechnology research group in a cost effective and timely manner and helped them to develop policies and procedures for addressing such issues.

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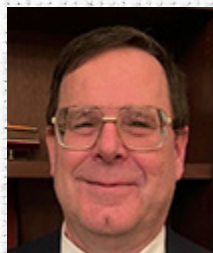
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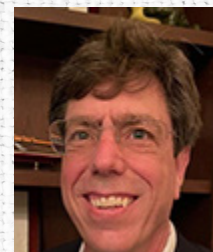
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Director Term
2019-2022



Karen Miles, CAE, CMP
Interim Executive Director

2022 Candidates for Director



C. Evan Cook, OD, JD

Company: Patent Consultants, LLC

Practitioner Type: Attorney

Total Years in Practice: 1

Describe your previous involvement with NAPP (examples: Committee work, volunteer work, involvement with NAPP programs/activities):

As a new practitioner I look forward to significant involvement in NAPP as it serves as our voice.

Describe your impressions of NAPP:

Together we are stronger, as such NAPP provides a framework where we can all come together as practitioners to protect our profession and help advance those interests that allow us to better advocate and help our clients.

Why you would like to serve as a NAPP Director (what are your personal objectives?):

As a relatively new practitioner I look forward to being actively involved in the protection and advancement of the profession.

Bio:

Evan Studied Biology and Chemistry at the University of Georgia. He then completed a Doctorate at the Southern College of Optometry, after which he practiced in the medical field for 15 years. During this time, he completed a Juris Doctor degree at Northwestern California University School of Law. He then completed post graduate admission to the United States Patent and Trademark office after passing the bar.

Evan Currently practices at Patent Consultants, LLC and enjoys being involved in helping inventors protect their intellectual assets.

2022 Candidates for Director



Joel Douglas

Company: Menlo Park Patents

Practitioner Type: Agent

Total Years in Practice: 20

Describe your previous involvement with NAPP (examples: Committee work, volunteer work, involvement with NAPP programs/activities):

No previous involvement with NAPP; however, the USPTO recognized me as one of the recipients of the 2021 Pro Bono Certificates. You can see the press release here: <https://www.uspto.gov/about-us/news-updates/record-number-practitioners-and-law-firms-helped-under-resourced-inventors>.

Describe your impressions of NAPP:

NAPP is the premier organization for the networking, education and exchange of ideas for the patent practitioner community.

Why you would like to serve as a NAPP Director (what are your personal objectives?):

I would like to help other practitioner provide high quality and comprehensive services to their clients and I believe that my experience as a practitioner and inventor (named inventor on 102 granted US patents) will be helpful to achieve that goal.

Bio: Joel is an USPTO Registered Patent Agent [Reg. No 76025] and experienced in drafting and prosecuting patent applications, and in conducting prior art searches related to patentability and infringement. He is an EFS web-registered private PAIR e-filer with extensive knowledge of intellectual property laws and statutes, and has superior analytical and communication skills. Named inventor on 102 granted U.S. Patents.

Joel is a licensed professional engineer in Florida, Connecticut and Vermont.

Joel held management positions at Komag (the innovator in Thin Film Disk technology), LifeScan and General Dynamics

Joel Co-founded the following companies:

Amira Medical, Co-founder, sold to Roche Diagnostics.

Sterling Medivations, Co-founder, sold to Spectrx.

Mystic Technology Partners, Co-founder, sold to Simplified Energy Solutions.

Education:

University Of Connecticut, BS Civil Engineering
University of New Haven, MS Computer Science
Executive Engineering Program Stanford University / 1995

Awards

Academy of Distinguished Engineers University of Connecticut / 2005

100 Notable People in the Medical Device Industry MD&DI / 2004

Medical Design Excellence Award (Silver) 2000

Shingo Prize for Excellence in Manufacturing

Business Winning Team (LifeScan) / 1995

2022 Candidates for Director



John T. Davis

Company: Barta, Jones & Foley, P.C.

Practitioner Type: Attorney

Total Years in Practice: 10

Describe your previous involvement with NAPP (examples: Committee work, volunteer work, involvement with NAPP programs/activities):

I joined NAPP in 2016, just as I was beginning my patent career, after having practiced general civil litigation since 2011. My membership has profoundly impacted my life. NAPP not only provided me an opportunity to meet fellow practitioners, but also, through the Forums, a collaboration and learning platform that would have been otherwise unavailable to me as a solo patent attorney. A fellow member not only mentored me, but also offered me my first position with a patent prosecution firm. My experience there not only improved my skills as a patent attorney, but also gave me an opportunity to learn and hone new management skills and strategies that have continued to serve me well both in my practice and as a volunteer with NAPP and other organizations. I have been involved in NAPP projects since 2016, working with other members on a variety of committees and teams, including the task force that selected the current forum software in 2018. I have also served on the Legal Affairs Committee, which I previously chaired, as well as the Member Benefits, Government Affairs, and Public Relations Committees. Since 2018, I have been the Forum Manager of the NAPP Forum and also volunteer as one of the moderators. I was elected to the Board of Directors in 2019 and have been honored to serve as Chairperson of the Board since July 2020.

I am also active in both local and regional organizations, including as a member of the Peer Assistance, Fee Dispute, CLE, and Morris Harrell Professionalism Committees of the Dallas Bar Association, and have endeavored to bring the skills and experience I have learned with these organizations to my leadership roles in NAPP. I am deeply interested in and concerned with the positive development of patent policy and professionalism in the patent practitioner and wider legal services communities, and have engaged through my position on the Board of Directors in various NAPP projects intended to further those goals and otherwise advocate for improving careers and livelihoods of all our members. I have been especially grateful for the opportunity to advocate for our members directly at the USPTO through NAPP's unique ability to open a dialogue with their leadership. Should I be re-elected, I intend to continue supporting such initiatives for the benefit of our community.

Bio: John is a registered U.S. patent attorney. He graduated from SMU Dedman School of Law (J.D., cum laude) and was admitted to the State Bar of Texas in 2011. His technical training includes a degree in computer science (B.A., magna cum laude) from Southwestern University. He is also admitted to practice before the U.S. District Court of the Eastern District of Texas and the U.S. Court of Appeals for the Federal Circuit.

2022 Candidates for Director



David "Dan" Smith

Company: CableLabs

Practitioner Type: Agent

Total Years in Practice: 14

Describe your previous involvement with NAPP (examples: Committee work, volunteer work, involvement with NAPP programs/activities):

Dan Smith and Mike Carey started the Colorado Chapter of NAPP 4+ years ago, which has met almost every month since its inception. Dan also began NAPP's Practitioner Harmonization work and is now the Chair of the Advocacy Committee working on Practitioner Harmonization as well as other topics important to NAPP members.

Describe your impressions of NAPP:

NAPP is the only Patent Practitioner focused organization. This focus allows NAPP to address patent practitioner issues and to utilize its influence to push for necessary change within patent practice. NAPP also provide comradery and collaboration for its members, especially those that work in solo practice or as a sole in-house Patent Practitioner, like myself. While NAPP is a relatively small organization it punches well above its weight to the benefit of its members, and I only see that happening more in the future.

Why you would like to serve as a NAPP Director (what are your personal objectives?):

Dan has been active in NAPP for a number of years and finds great satisfaction in advocating for patent practitioners and has been impressed by NAPP's support his advocacy work. The patent practitioner career path is a wonderful vocation, but it has obstacles that reduces the number of new patent practitioners entering the career and makes it difficult to keep existing patent practitioners in the

career, especially diverse practitioners. Dan's goal as a NAPP Director is to remove those obstacles, to expand opportunities for patent practitioners, and help make our community stronger and more influential.

Bio: Dan started patent work as a Technical Specialist/Scientific Advice at Lathrop and Gage, LLP (now Lathrop GPM), in 2008. In 2015 Dan went to CableLabs as the in-house Patent Agent, moving up to the Director of Patents and Innovation Coach over his 7 years there.

CableLabs is a non-profit innovation lab for the global cable industry, allowing Dan to work on technologies ranging from Quantum Communication, Wired and Wireless communication (e.g., the 5G and 6G Standards, Optical Comm, the DOCSIS protocol, etc.) Blockchain, PKI and security infrastructure, Network Virtualization, etc. Dan oversees in-house drafting and prosecution, six outside patent firms in the US, and 5-10 in foreign associates (depending on the year and the technology priorities). Dan also spends a substantial portion of his time cultivating new inventions, working with Standards Development Organizations (CableLabs participates in ~30 different SDOs), Standard Essential Patent Pools, and Anti-NPE (Non-Practicing Entities, also called Patent Trolls by some) groups (e.g., Unified Patents and Allied Security Trust (AST)), and as one CableLabs Innovation Bootcamp coaches.

Dan is named on three issued patents and has a dozen more in prosecution.



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Unified is the ONLY entity that DETERS abusive NPEs (aka Patent Trolls) and NEVER pays

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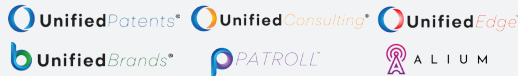


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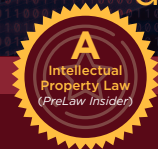
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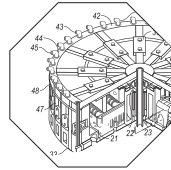
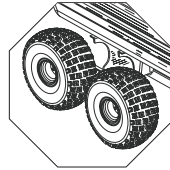
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HISTORIC ALEXANDRIA, VIRGINIA



Thank you

for attending the 2022 NAPP Annual Meeting and Conference (AMC)!

We hope that you plan to join us next year in the historic Alexandria, Virginia.

Dates will be published in Fall 2022.



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