

## 2017 Winter Meeting of the Association of Corporate Patent Counsel

January 29 – February 1, 2017 BoardWalk Inn Orlando, FL

# ACPC

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#### 2016/2017 EXECUTIVE COMMITTEE LISTING

#### Officers: Jennis Skarvan *Ca*

President, Dennis Skarvan, Caterpillar Inc. Secretary, Karen Borrelli, Newell Brands Treasurer, Darryl Frickey, The Dow Chemical Company

#### At-Large Members: Douglas Norman, *Eli Lilly and Company (Immediate Past President)* Luke Dohmen *(Past President)* Glenn Edwards, *Ingersoll Rand* Krish Gupta, *EMC Corporation* Kevin Rhodes, *3M* Bernie Zidar, *McKesson Corp.*

### ACCPC Association of Corporate Patent Counsel

Dear January 2017 ACPC Meeting Attendees:

Thank you for attending the ACPC's Winter Meeting in Orlando, FL. We are excited to present what promises to be another excellent program.

First, as many of you know, it's been a difficult start to the year with the loss of Carl Horton, former Vice President and Chief IP Counsel for GE, ACPC Vice President, and beloved husband and father. We will honor Carl with a brief presentation before the program begins on Monday morning.

Our Professional Program should once again prove very educational with presentations on The Internet of Things, Managing Multi-Jurisdictional Issues, the Impact of Brexit on Patent Strategies and IP Tax Strategies. Of course, we will also have three different presentations from our members sharing benchmark information on their "IP Operations."

We are honored to also hear from Chief Judge Sharon Prost of the United States Court of Appeals for the Federal Circuit, as well as Michelle K. Lee. We thank them and all of our wonderful speakers for taking the time to address our group.

Tim Douros has arranged the Monday golf tournament at Disney's Palm Golf Course. We are also excited about the great interest in our first Benchmarking Sessions, available on Tuesday afternoon from 2-4pm. If you did not sign up for one with your registration, you're still welcome to join!

Our meetings provide an opportunity for you to meet and get to know your peers. It is probably our most important member benefit. Please keep a look out for new ACPC Members who will be wearing red ribbons.

As always, please don't hesitate to reach out to me or any member of ACPC's Executive Committee with your thoughts and ideas about future programs.

I look forward to enjoying our Winter Meeting with you!

Warm Regards,

Dennis Skarvan President



#### Monday, January 30

- 8:00-8:15 **Opening Remarks** Dennis Skarvan | ACPC President, Caterpillar Inc.
- 8:15-9:15 Federal Circuit Honorable Sharon Prost | Chief Judge, United States Court of Appeals for the Federal Circuit
- 9:15-10:30 Benefits and Pitfalls of IP Tax Strategies in an Evolving Global Landscape Paul Schmidt | BakerHostetler
- 10:30-10:45 Break
- 10:45-11:30 IP Operations at Masco Corporation Raj Parikh | Assistant General Counsel – Director of Commercial Legal Affairs

#### Tuesday, January 31

- 8:00-8:15 ACPC Business Update/Vote
- 8:15-9:30 The Internet of Things moving toward a digital industrial world Sid Venkatesan | Chief IP Counsel, GE Digital Legal & Compliance Chip Lutton | General Counsel and Head of IP, Nest Jill Bowman | Associate General Counsel, Intel Dan Hoffman | Chief Innovation Officer, Montgomery County
- 9:30-10:30 Managing Global Multi-Jurisdictional Issues Cheryl Tubach | Chief IP Counsel, J.M. Huber Corporation Harry Gwinnell | Greenblum & Bernstein Andrew Lagatta | Merchant & Gould
- 10:30-10:45 Break
- 10:45-11:30 IP Operations at CoreLogic, Inc. Rouz Tabaddor / VP, Chief IP Counsel
- 2:00-4:00 Benchmarking Session

#### Wednesday, February 1

8:00-9:00 USPTO Update Russ Slifer / Former Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the USPTO
9:00-10:00 The Impact of Brexit on Patent Strategies Edward Nodder / Bristows
10:00-10:15 Break
10:15-11:00 IP Operations at Merck Bill Krovatin / SVP and Assistant General Counsel



Disney's Boardwalk Inn January 29 – February 1, 2017



#### Sunday, January 29

3:00 pm – 5:00 pm 4:00 pm – 8:30 pm 6:30 pm – 8:30 pm Executive Committee Meeting – *Marvin Gardens C* Registration – *Belle Vue Landing* Welcome Reception – *Marvin Gardens Hall* 

#### Monday, January 30

7:30 am - 9:00 am 7:30 am - 12:00 pm 8:00 am - 11:30 am 11:45 am - 1:30 pm 1:00 pm 6:00 pm - 8:00 pm

#### Tuesday, January 31

7:30 am - 9:00 am 7:30 am - 12:00 pm 8:00 am - 8:15 am 8:15 am - 11:30 am 1:00 pm 2:00 pm - 4:00 pm 6:00 pm - 6:30 pm 7:00 pm - 10:00 pm

#### Wednesday, February 1

7:30 am - 9:00 am 7:30 am - 12:00 pm 8:00 am - 11:00 am Full Breakfast – *Marvin Gardens Hall* CLE Registration – *Belle Vue Landing* Professional Program – *Promenade E IV-VI* ACPC Women's Lunch – *The Attic (Boardwalk Villas)* Optional Golf Tournament – *Palm Golf Course* IPO Reception – *Sea Breeze Point* 

Full Breakfast – *Marvin Gardens Hall* CLE Registration – *Belle Vue Landing* ACPC Business Meeting – *Promenade E IV-VI* Professional Program – *Promenade E IV-VI* Optional Activity: Open Golf – *Magnolia Course* Optional Benchmarking Sessions – *Promenade E IV, V and VI* Reception - *Marvin Gardens Hall, group will walk to Epcot at 6:30* Dinner and Fireworks – *American Adventure Rotunda, Epcot* 

Full Breakfast – *Marvin Gardens Hall* CLE Registration – *Belle Vue Landing* Professional Program – *Promenade E IV-VI* 



2017 Winter Meeting

**Speaker Biographies** 

#### Speaker Information for Monday, January 30 (in order of appearance)



#### Honorable Sharon Prost, Chief Judge – United States Court of Appeals for the Federal Circuit

Sharon Prost was appointed by President George W. Bush in 2001 and assumed the duties of Chief Circuit Judge on May 31, 2014. Prior to her appointment, Judge Prost served as Minority Chief Counsel, Deputy Chief Counsel, and Chief Counsel of the Committee on the Judiciary, United States Senate from 1993 to 2001. She also served as Chief Labor Counsel (Minority), Senate Committee on Labor and Human Resources from 1989 to 1993. Prior to her work on Capitol Hill, she served for fifteen years in five different agencies of the executive branch. These agencies included the Department of the Treasury, National Labor Relations Board, and General Accounting Office. Judge Prost received a B.S. from Cornell University in 1973, an M.B.A. from George Washington University in

1975, a J.D. from the Washington College of Law, American University in 1979, and an LL.M. in tax law from George Washington University School of Law in 1984.



#### Paul Schmidt, *BakerHostetler*

Paul Schmidt, a former legislation counsel to the Joint Committee on Taxation, has extensive experience in corporate and international tax matters and has worked on all facets of taxation, from controversy to transactions to planning. Paul also has significant experience handling issues in connection with examinations by the Internal Revenue Service and frequently advises clients on issues raised by foreign tax authorities. Paul's practice includes representation of several *Fortune* 500 corporate clients in industrial, energy, and commodities businesses, as well as financial institutions in connection with international tax issues. He regularly advises private equity and hedge funds as well as publicly traded partnerships and master limited partnerships on tax matters and has unique knowledge of global taxable presence and transfer pricing issues facing funds. Paul regularly deals with tax issues

in connection with the hospitality industry, including hotel groups, timeshares and fractional interests. He has considerable experience in hedging transactions and global hedging and trading centers. He also has worked extensively on tax issues associated with intellectual property, supply chain management, contract manufacturing, and structuring inbound and outbound global joint ventures. Paul chairs BakerHostetler's national Tax Group and is the leader of the International Tax practice team, and is a member of the firmwide Policy Committee, the firm's governing body. He is ranked in Chambers USA: America's Leading Lawyers for Business, is listed in The Best Lawyers in America<sup>®</sup> and appears on the Washington, D.C. "Super Lawyers" list. Paul is the U.S. Vice Chair of the American Bar Association Tax Section Foreign Lawyers Forum and also a member of its Government Relations Committee and formerly served as the Chair of the AICPA International Taxation Technical Resource Panel. Paul is a Certified Public Accountant in Virginia and serves as an adjunct professor of law, teaching international tax at Georgetown University.



### Nirav Raj Parikh, Assistant General Counsel, Director of Commercial Legal Affairs – Masco Corporation

Nirav Raj D. Parikh is Assistant General Counsel – Director of Commercial Legal Affairs at Masco Corporation, one of the world's largest manufacturers of brand name products for the home improvement and new home construction markets. Mr. Parikh has been with Masco Corporation for 13 years and is responsible for Intellectual Property, Commercial, Environmental and International Law. Mr. Parikh joined the Masco legal staff in 2003 after 10 years of practicing in a broad spectrum of areas including intellectual property, environmental and general corporate with Owens-Illinois, Inc., a worldwide leader in rigid packaging products. Prior to his work with Owens-

Illinois, Mr. Parikh was an associate with the law firm of Fuller & Henry in Toledo, Ohio. He received a bachelor's degree in 1988 from Millsaps College with a major in Chemistry and a minor in Political Science, and his law degree in 1991 from Case Western Reserve University School of Law. Mr. Parikh has lectured widely in areas of environmental, intellectual property and international law. Outside of Masco, Mr. Parikh serves on boards of several for-profit corporations and nonprofit organizations.

#### Speaker Information for Tuesday, January 31 (in order of appearance)



#### Sid Venkatesan, Chief IP Counsel – GE Digital Legal & Compliance

Sid Venkatesan is Chief IP Counsel at GE Digital, the leading industrial big data company that the N.Y. Times recently called a "124 Year Old Software Startup." In this role, Sid is responsible for all aspects of GE Digital's IP strategy, including patent portfolio management, trade secrets protection, standards participation, IP transactions and diligence, open source management, brand protection and litigation. Prior to joining GE, Sid was an IP litigation partner at Orrick, Herrington & Sutcliffe LLP, and a veteran of numerous high stakes cases in state and

federal court as well as the ITC. Sid is a commissioner for the State Bar of California and has remained active in community responsibility initiatives and pro bono representations throughout his legal career. Sid is an aerospace engineer by training and worked as software engineer at two internet startups prior to becoming a lawyer. In his free time, Sid tries (often with mixed success) to keep up with his two small children.



#### Chip Lutton, General Counsel and Head of IP - Nest

Since 2012, Chip has been general counsel for Nest Labs, a smart home appliance company founded in Silicon Valley and acquired by Google in 2014. Previously, from 2001-2011, he was the chief intellectual property officer of Apple Inc. during the iPod, iPhone, and iPad decade. Throughout his career, he has been involved in all aspects of technology law, litigation, and patent development, acquisition, and licensing. He has testified before Congress and the Federal Trade Commission on patent issues. While at Google, he helped launch the License on Transfer Program, serving as the initial executive director of that program. He served as a judicial law clerk to Randall Rader of the U.S. Court of Appeals for the Federal Circuit, and was an attorney for Sun Microsystems,

Micron Technology, and Arnold, White & Durkee. Chip holds a J.D. from Columbia University School of Law and a Bachelor of Science degree in electrical engineering from Rice University.



#### Jill Bowman, Associate General Counsel - Intel

Jill Hubbard Bowman is an Associate General Counsel, Intellectual Property for Intel Corporation. Jill supports Intel's Internet of Things Group. Jill focuses on IPR strategy and complex transactions. Jill also leads Intel's Technology Licensing Practice Group and facilitates women's leadership programs for Intel's Diversity Initiatives. Prior to joining Intel, Jill worked for major U.S. law firms and litigated complex IP cases in federal and state courts, the ITC, and AAA and ICC arbitrations. Jill is a registered patent attorney. She earned her J.D. from the University of Michigan Law School.



#### Dan Hoffman, Chief Innovation Officer - Montgomery County, Maryland

Dan Hoffman is the first Chief Innovation Officer for Montgomery County, Maryland, a position he has held since October 2012. He is responsible for creating and maintaining strategies and programs that generate innovative ideas in Montgomery County. The program he oversees serves as a laboratory for civic improvement and a safe place to test out new processes, technologies and ideas. He manages projects on a broad range of topics, from the Internet of Things (IoT) to autism technology to food security and more. Prior to his time at Montgomery County he was an appointee at the Nuclear Regulatory Commission and a consultant with

PricewaterhouseCoopers. He is a recognized expert on open data, civic engagement and IoT policy. He holds degrees from The George Washington University and Johns Hopkins University.

#### Cheryl Tubach, Chief IP Counsel - J.M. Huber Corporation



Since December 2008, Cheryl Tubach has been Chief Intellectual Property Counsel for J.M. Huber Corporation, which produces specialty chemicals, such as rheology modifiers, silica, and wood composites. Prior to joining Huber, Ms. Tubach has served as in house patent counsel for The Coca-Cola Company and Eastman Chemical Company. She also practiced IP law for a two boutique law firm in Atlanta, GA and briefly worked for Fulton County, GA as Assistant Solicitor. Prior to becoming a lawyer, Ms. Tubach worked as a technical service engineer and sales engineer for 5 years with Dow Corning Corporation in the electronics, aerospace and high

technology industries. Ms. Tubach has also been active in professional organizations as a current member of the GSU Intellectual Property Advisory Board and GSU Corporate IP Roundtable, current board member of the Georgia Lawyers for the Arts, and a past member of the Board of Directors of the Intellectual Property Owners Association (IPO). Ms. Tubach obtained a law degree from Georgia State University and a B.S. in Chemical Engineering from the University of Kentucky.

#### Harry Gwinnell, Greenblum & Bernstein, P.L.C.



Harry is currently Counsel at Greenblum & Bernstein, P.L.C., in Reston, Virginia. Prior to that he was Vice-President, Chief Intellectual Property Counsel, at Cargill Incorporated, in Minneapolis, Minnesota; Assistant General Counsel, Intellectual Property, and Assistant Secretary, at Eastman Chemical Company, in Kingsport, Tennessee; Intellectual Property Corporate Counsel and Assistant Secretary, at Cabot Corporation, in Boston, Massachusetts; and Assistant Chief Patent Counsel, at United Technologies Corporation, in Hartford, Connecticut. He has been named by Intellectual Asset Management Magazine as one of the World's Leading IP Strategists, he has received the IPO President's Distinguished Service Award, was Vice-Chair of IPO's

Corporate IP Practice Committee, has been a member of the Association of European Chief IP Counsel, the President of the Association of Corporate Patent Counsel, the President of the Tennessee Intellectual Property Law Association, the President of the Connecticut Patent Law Association, the Founding President of the Intellectual Property Owners Education Foundation, the Vice-President of the Intellectual Property Owners Association, a member of the Board of Directors of the National Inventors Hall of Fame, a Member of the Advisory Board of the University of New Hampshire, Franklin Pierce Law Center, a Member of Advisory Board of William Mitchell College of Law, St. Paul, Minnesota – 2009 to 2011, and a speaker at numerous colleges and universities on the topic of intellectual asset management. He has also been an active participant in Big Brothers/Big Sisters Program in Minneapolis.



#### Andy Lagatta, Merchant & Gould

Andy is a Partner at Merchant & Gould P.C. in Minneapolis, MN. He is the current chair of Merchant & Gould's Post-Grant practice group, and has represented petitions and patent owners in over twenty PTAB trials, as well as appeal, reissue, and reexamination proceedings (*ex parte* and *inter partes*). Andy also serves as vice-chair of Merchant & Gould's Electrical and Software Patent Prosecution practice group, and regularly advises U.S. and international clients regarding patent portfolios in technology areas such as consumer electronics, mobile and cloud software systems, medical devices, semiconductor devices, mechanical equipment, industrial/chemical processes, and business methods. Prior to becoming a lawyer, Andy worked as an engineer

at Intel Corporation, on design and testing of processors and chipsets. Andy has a B.S. in electrical engineering from the University of Wisconsin and a J.D. from the University of Minnesota.



#### Rouz Tabaddor, VP, Chief IP Counsel - CoreLogic, Inc.

Mr. Tabaddor has over 20 years of experience in intellectual property law. His experiences includes being a Patent Examiner at the US Patent Office, associate at major IP firms in Washington DC and VP and Deputy General Counsel at CoreLogic, Inc. He also actively participated in patent and trademark litigations in various federal courts throughout the U.S. Furthermore, Rouz spent 1 year living in Taiwan assisting Taiwanese electronic companies with protection of their intellectual property rights. He spent time conducting lectures throughout Taiwan and other southeastern Asian countries. Currently, Mr. Tabaddor is the VP, Deputy General Counsel for a spin-off of a Fortune 300 company, where is head of the Intellectual Property Program and is

responsible for monitoring all patent, trademark, copyright and other intellectual property rights in the U.S and throughout the world. Rouz also manages legal team for the Data & Analytics businesses of CoreLogic. In 2014, Rouz received the General Counsel Rising Star Award by the Orange County Business Journal. In 2015 and 2016, Rouz was recognized by Managing IP magazine as an IP Star in the annual IP Stars Handbook. In 2016, Rouz was nominated for First Chair Top in-house IP Counsel.

#### Speaker Information for Wednesday, February 1 (in order of appearance)



#### Michelle K. Lee, Director of the USPTO

As the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (USPTO), Michelle K. Lee provides leadership and oversight to one of the largest intellectual property offices in the world, with over 12,000 employees and an annual budget of over \$3 billion. Ms. Lee also serves as the principal advisor to the President, through the Secretary of Commerce, on domestic and international intellectual property policy matters. Ms. Lee is the first woman to serve as Director of the U.S. Patent and Trademark Office in the country's history. Prior to public service, Ms. Lee has spent most of her

professional career advising some of the country's most innovative companies on technical, legal, and business matters. She was Deputy General Counsel for Google and the company's first Head of Patents and Patent Strategy. She joined the company when it was relatively young, and was responsible for formulating and implementing its patent strategy for all of its products and services worldwide. She also served as a partner at the Silicon Valley-based law firm of Fenwick & West LLP, where she advised a wide range of high-technology clients from startups to Fortune 100 companies intellectual property, licensing, litigation and corporate matters. Before her career as a legal advisor to technology companies, Ms. Lee worked as a computer scientist at the M.I.T. Artificial Intelligence Laboratory and Hewlett-Packard Research Laboratories. Ms. Lee worked in the federal judiciary as a law clerk on the U.S. Court of Appeals for the Federal Circuit for Judge Paul R. Michel and District Court for the Northern California for Judge Vaughn R. Walker. She holds a B.S. and M.S. in electrical engineering and computer science from M.I.T., as well as a J.D. from Stanford Law School. Ms. Lee has been recognized by numerous organizations for her work including by Politico Magazine as one of the "Top 50 Most Influential Visionaries in American Public Policy" in 2015, by Washingtonian Magazine as a "Tech Titan" in 2015, and by the San Francisco Business Times and San Jose Business Journal as the Best Bay Area IP Lawyer in 2012 and one of the top 100 most influential women in the Silicon Valley in 2013.

#### Edward Nodder, Bristows



Edward was until 2016 the long-serving head of Patent Litigation and has specialised in intellectual property, especially patent litigation, for over 35 years. He has been responsible for more than 100 patent cases, including landmark UK decisions such as 3M v. Rennicks (validity and infringement, stay of injunction and damages), 3M v. Plastus Kreativ (cross-border injunctions), 3M v. Nippon Carbide (stay pending EPO opposition), Unilin v. B&Q (entitlement to priority, amendment, res judicata and EPO) and Servier v. Apotex (enquiry as to damages under cross-undertaking). Beyond the UK, Edward has taken a particular interest in the development of the Unitary Patent and the Unified Patent Court (UPC). He has had the opportunity to do so through his service on the Board and Advisory Board of the European Lawyers Association (EPLAW). EPLAW has been very closely involved with the

preparation of the legislation and the rules of procedure of the UPC and Edward has given presentations on the rules to all the leading European Patent Judges at the Venice Conferences organised jointly by EPLAW and the EPO. His work with the European Patent judiciary has included participation in "Mock Trials" conducted before these Patents Judges and already using the law and rules of the UPC. This has been a unique experience making Edward ideally qualified to advise clients on UPC issues when they arise. He has further honed his UPC skills sitting as a "Judge" in the first real-time mock trials of UPC cases which Bristows has been conducting in the expectation that the UPC will commence operation in a few years despite the uncertainty of "Brexit".

#### William Krovatin, SVP and Assistant General Counsel - Merck



Bill Krovatin is a Senior Vice President and Assistant General Counsel at Merck & Co., Inc. and is responsible for IP matters at Merck including patents, trademarks, copyrights and IP litigation. Bill joined Merck in 1993 as an attorney in the IP litigation group. He has held various positions of increasing responsibility in the Legal Department before assuming his present position in January 2014. Prior to joining Merck, Bill was an attorney at Hoffmann- La Roche and at Morgan & Finnegan. Bill has BS in Biology from MIT and a JD from Rutgers Law School. He is admitted to practice in New York, New Jersey and the USPTO. Bill lives in New Jersey with his wife and two of their three children, an avid Mets fan and an active member of the Glen Ridge Volunteer Ambulance Squad.



🕒 BoardWalk Joe's Marvelous Margaritas Disney's Magical Express Bus Stop Automated External Defibrillators 🚺 Big River Grille & Brewing Works X Side Show Games Arcade Y Muscles & Bustles Health Club D Belle Vue Lounge (2nd Floor) T Disney's Character Carnival S Screen Door General Store W Luna Park Crazy Play Area H BoardWalk Pizza Window P Leaping Horse Libations **Dining & Entertainment** C Resort Airline Check-In **B** Disney Vacation Club® J Ample Hills Creamery U Thimbles & Threads Information Center Atlantic Dance Hall BoardWalk Bakery A Lobby/Concierge Q Dundy's Sundries R Wyland Galleries G Trattoria al Forno Z Community Hall V Luna Park Pool **Guest Services** F AbracadaBar K ESPN Club Bus Stop
 Disney's M
 Laundry E Flying Fish Elevators N Jellyrolls Recreation Shopping 

**Designated Smoking Locations** new balance<sup>®</sup> RUNNING TRAIL

1

(0.8 mile)

grassy areas adjacent to parking lots. ©Disney BW2001INN/12375093 0716 Service animal relief areas located in





# **Guest Services**

- B Disney Vacation Club® A Lobby/Concierge
  - Information Center
- C Resort Airline Check-In

## Dining

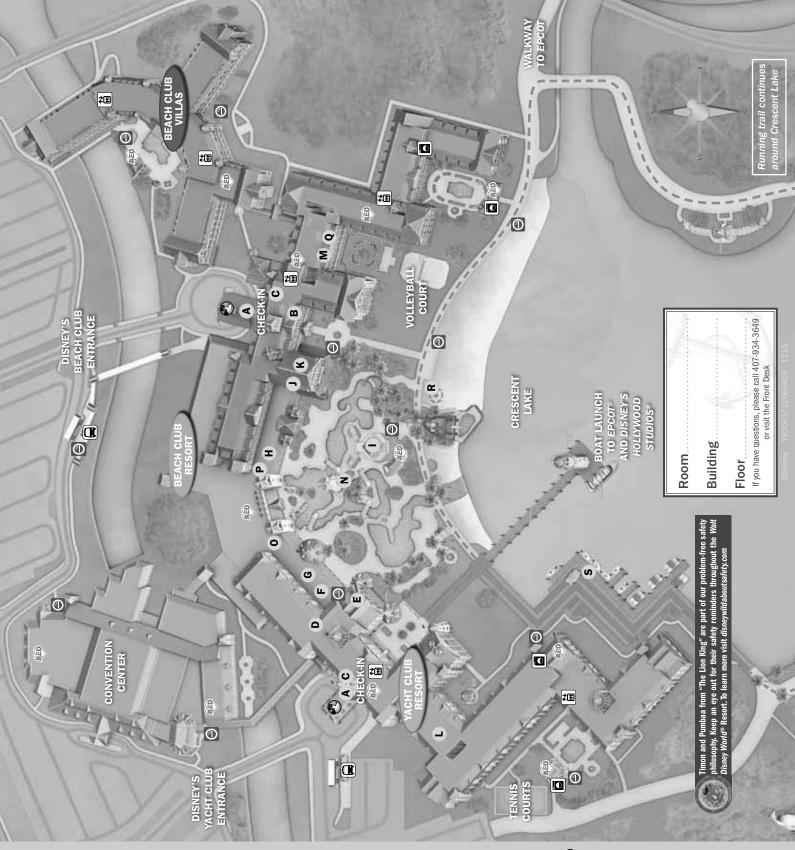
- **D** Ale and Compass Lounge
  - E) Captain's Grille
    - F Crew's Cup Lounge
- **G** Yachtsman Steakhouse
- H Beaches & Cream Soda Shop
  - Hurricane Hanna's Waterside Bar & Grill
    - J Martha's Vineyard
      - K Cape May Cafe

## Shopping

- Clothes & Notions L Fittings & Fairings
- MuBeach Club Marketplace

## Recreation

- O Ship Shape Massage, Salon N Stormalong Bay
  - and Fitness
- P Lafferty Place Arcade
  - Sandcastle Club o
    - R Campfire
- S Bayside Marina
- Disney's Magical Express Bus Stop **Bus Stops** Bus Stops Disney's M Laundry
- Automated External Defibrillators (ED)
  - Elevators 20
- **Designated Smoking Locations** new balance<sup>®</sup> RUNNING TRAIL (0.8 mile)
  - Wi-Fi is available in many areas
- throughout our Resorts including Guest rooms, main lobbies and
- feature pools. (Coverage may vary.) Service animal relief areas located in
  - grassy areas adjacent to parking lots.



## ACCPC Association of Corporate Patent Counsel

#### SITES OF FUTURE ACPC MEETINGS

#### 2017 Summer Meeting

Park City, Utah Stein Eriksen Lodge June 25-28, 2017

#### 2018 Winter Meeting

Palm Springs, California La Quinta Resort and Club January 21-24, 2018