Compliance Course
Agreement Maintenance Course
IP Portfolio Management Course

November 5-7, 2018

Hyatt Regency Bethesda
Bethesda, Maryland

autm

Transforming Ideas into Opportunities

www.autm.net

#18compliancecourse
#18agreementcourse
#18ipportfoliocourse

Compliance Course
Agreement Maintenance Course
IP Portfolio Management Course

Compliance course leadership:

Program Co-chairs:

Sabrina Darnell,
University of Kentucky

Michelle O'Shea,
Borman and Company LLC

Program Committee:

Monya Dunlap, RTTP, *University of Florida*

Courtney Grate, *NUtech Ventures*

Rebecca Hernandez,
California Institute of Technology

Corin Hindenach, *University of Louisville*

Jianling Liu, *University of Arizona*

Adrienne Padgett, *University of Florida*

Diane Titus, *Princeton University*

Agreement Maintenance course leadership:

Program Co-chairs:

Jennifer Folger, *Michigan State University*

Amanda Ottaway, RTTP

Program Committee:

Tiffany Beverly, JD,
University of South Carolina

Monya Dunlap, RTTP, *University of Florida*

Linda Galvin, Stony *Brook University*

Judy B. O'Neal, *Auburn University*

DawnMarie Portoff, *Yale University*

Intellectual Property Portfolio Management course leadership:

Program Chair:

Monya Dunlap, RTTP, *University of Florida*

Lee C. Heiman, *Azos AI LLC*

Program Committee:

Karen Boghossian, *Inteum Company*

Kimberly Dunn, *Emory University*

Courtney Grate, *NUtech Ventures*

Cheryl Horst, *NUtech Ventures*

Glenn Ladwig,
Saliwanchik Lloyd & Eisenschenk

Felicia Metz, *University of Maryland*

Our Courses are Paperless

As a courtesy to the environment, we have dispensed with handouts.
Attendees have online access to materials before, during and after the courses.

*AUTM Compliance, Agreement Maintenance and IP Portfolio Management Courses provide **15 hours** of continuing education (CE) credits for those who attend the entire meeting.*

About AUTM

AUTM is the non-profit leader in efforts to educate, promote and inspire professionals to support the development of academic research that changes the world. AUTM's community is comprised of more than 3,100 members who work in more than 800 universities, research centers, hospitals, businesses and government organizations around the globe.

Registered Technology Transfer Professional (RTTP)

Demonstrate your expertise in the academic technology transfer by becoming a Registered Technology Transfer Professional (RTTP). All AUTM professional development courses and designated educational offerings and meetings are eligible for continuing education (CE) credits, which support your registration application. For more information about the registration process and requirements, visit the Alliance of Technology Transfer Professionals (ATTP) website at www.attp.info.

Certified Licensing Professionals (CLP) Continuing Education

Certified Licensing Professionals (CLP) are required to demonstrate continued competence in their field to maintain their certification status. Individuals who hold the CLP designation can renew their credential by earning at least 40 continuing education (CE) credits. All AUTM professional development courses and designated educational offerings on the topics of licensing, technology transfer and technology commercialization at AUTM conferences or meetings are eligible for CLP continuing education credits for certification renewal. Visit www.licensingcertification.org for more information on the recertification requirements.

Thanks to Compliance Course Sponsor

TreMonti

Thanks to IP Portfolio Management Course

MURGITROYD

Meeting Agenda

Monday, November 5

7 – 5 p.m. **Registration**

Location: Meeting Room Foyer

7 – 8 a.m. **Breakfast**

Location: Terrace

7:30 – 7:45 a.m. **Welcome and Introductions**

Location: Terrace

Speakers: Sabrina Darnell,
University of Kentucky
Michele O'Shea,
Borman and Company LLC

8 – 8:45 a.m. **Bayh-Dole Update at the Federal Level**

Location: Cabinet/Judiciary

Speaker: Paul Zielinski, *National Institute of Standards and Technology*

Join us for an update on federal regulation changes across all agencies, and a discussion on the implications for institutions regarding non-compliance and the necessary communication between sponsored research and the technology transfer office.

8:45 – 10 a.m. **Bayh-Dole Compliance: iEdison Update**

Location: Cabinet/Judiciary

Speakers: Scott Cooper,
National Institutes of Health
Mary Fran Deutsch,
National Institutes of Health

This session will review key Bayh-Dole compliance obligations and initiatives of the National Institutes of Health (NIH). You will learn all the requirements for compliance under Bayh-Dole disclosures including deadlines related to reporting federally funded inventions.

10 – 10:30 a.m. **Networking Break**

Location: Meeting Room Foyer

10:30 – Noon **iEdison Reporting I**

Location: Cabinet/Judiciary

Speakers: Carolyn Mosby,
National Institutes of Health
John Salzman,
National Institutes of Health

This session is an advanced discussion of iEdison, reviewing the step-by-step process of reporting an invention through its entire cycle, including recommendations on how to resolve problems such as advanced reporting, linking patent families, waivers and regulation questions.

Noon – 1:30 p.m. **Lunch**

Location Terrace

1:30 – 3:00 p.m. **iEdison Reporting II**

Location: Cabinet/Judiciary

Speakers: Carolyn Mosby,
National Institutes of Health
John Salzman,
National Institutes of Health

This session is an advanced discussion of iEdison, reviewing the step-by-step process of reporting an invention through its entire cycle, including recommendations on how to resolve problems.

3 – 3:30 p.m. **Networking Break**

Location: Meeting Room Foyer

3:30 – 4:15 p.m. **Invention Reporting – National Institutes of Health**

Location: Cabinet/Judiciary

Speaker: Ann Hammersla,
National Institutes of Health

This session will focus on how Bayh-Dole reform affects the National Institute of Health (NIH) compliance and reporting processes.

4:15 – 5 p.m. **National Institutes of Health Open Q&A**

Location: Cabinet/Judiciary

In this session, specific National Institute of Health (NIH) questions will be answered and problems addressed.

5:30 – 7:00 p.m. **Welcome Reception**

Location: Terrace

Meet your colleagues and make new friends at this opening reception.

Meeting Agenda

Tuesday, November 6

7 – 5 p.m.   **Registration**

Location: Meeting Room Foyer

Sign-up at the registration desk for a 15-minute, one-on-one meeting with NIH staff, scheduled throughout the day.

7 – 8 a.m.   **Breakfast**

Location: Terrace

8 – 9 a.m.   **Invention Reporting – National Aeronautics and Space Administration**

Location: Cabinet/Judiciary

Speaker: Mark Dvorscak, *NASA Agency Counsel for Intellectual Property*

National Aeronautics and Space Administration (NASA) has its own system of compliance, which is different from all other federal agencies. This session will be an advanced course on NASA compliance reporting requirements including process, utilization, data collection and answers to reporting questions.

9 – 10 a.m.   **Invention Reporting – U.S. Department of Defense**

Location: Cabinet/Judiciary

Speaker: Elizabeth Arwine, *U.S. Army Medical Research and Material Command*

This session will cover current reporting requirements specific to the Army Medical Research and Material Command, including changes resulting from recent Bayh-Dole reform. This advanced presentation provides an overview of the U.S. Department of Defense (DOD) process, utilization and data collection. There will be time for questions and DOD contact details will be provided.

10 – 10:30 a.m.   **Networking Break**

Location: Meeting Room Foyer

10:30 – 11:15 a.m.   **How to Handle Joint Inventions with Government Agencies**

Location: Cabinet/Judiciary

Speakers: Gail Poulos, *USDA-ARS*
              Donna Johns, *Iowa State*

Institutions often work together to collaborate for intellectual property (IP); but what happens when there's a government employee inventor or federal funding? Learn about common agreement terms, how to determine lead entity and the responsibilities this creates with reporting.

11:15 a.m. – Noon   **U.S. Department of Veterans Affairs Dual Inventors and Reporting**

Location: Cabinet/Judiciary

Speaker: Kalpana Reddy, *U.S. Department of Veterans Affairs*

The U.S. Department of Veterans Affairs has revised its compliance mechanisms and we'll talk about the specific reports required and obligations relating to joint inventors. Best practices and streamlining techniques will also be covered.

Noon – 1:30 p.m.   **Lunch**

Location: Terrace

1:30 – 2:15 p.m.   **Invention Reporting – Department of Energy**

Location: Cabinet/Judiciary

Speakers: Marianne Lynch, *U.S. Department of Energy*
              Maritza Rodriguez, *U.S. Department of Energy*

This session will cover current processes for reporting under the new Bayh-Dole reform including, but not limited to utilization and data collection, focusing on areas that may be unique to the U.S. Department of Energy (DOE). Reporting questions will be answered and current DOE contacts will be provided during this advanced compliance course.

2:15 – 3 p.m.   **Invention Reporting – U.S. Department of Agriculture**

Location: Cabinet/Judiciary

Speakers: Sharon V. Lumpkin, *U.S. Department of Agriculture*
              Tekila Gray, *U.S. Department of Agriculture*

This session will identify items unique to U.S. Department of Agriculture (USDA) reporting requirements, compliance processes, utilization and data collection.

3 – 3:30 p.m.   **Networking Break**

Location: Meeting Room Foyer

Meeting Agenda

3:30 – 4:15 pm.   **Invention Reporting –
National Science Foundation**

Location: Cabinet/Judiciary

Speakers: Robin Clay,
National Science Foundation
Dana Thibodeau,
National Science Foundation
Suzanne Plimpton,
National Science Foundation

This session will focus on in depth compliance processes with a focus on how Bayh-Dole reform is changing National Science Foundation (NSF) reporting. Speakers will also identify items unique to the NSF reporting requirements, iEdison notification resolutions and questions, and provide the current NSF contact information.

4:15 – 5 p.m.   **Non-Federal, State, Foundation,
and Industry Sponsored Research
Reporting Best Practices**

Location: Cabinet/Judiciary

Speaker: Jianling Liu, *Tech Launch Arizona*
Adrienne Padgett,
University of Florida

Sponsored research often leads to development of intellectual property (IP), but do you know about the reporting obligations? Private funding sources such as foundation grants and state program funds are often used to help inventors further their research and many of these have requirements for reporting IP. Learn about these types of situations, common reporting expectations and contract terms to look for when these awards apply to your invention.

Wednesday, November 7

7 – 10 a.m.   **Registration**

Location: Meeting Room Foyer

7 – 8 a.m.   **Breakfast**

Location: Terrace

8 – 10 a.m.   **How to Strengthen Your
Institution's Compliance Program**

Location: Cabinet/Judiciary

Speakers: Becky Hernandez,
California Institute of Technology
Corin Hindenach,
University of Louisville
Michele O'Shea,
Borman and Company LLC

Do you believe it's possible to have a vibrant compliance program at your institution? In this session, seasoned compliance veterans share tips and lessons learned that can help you strengthen your institution's compliance program. Join us as we wrap it all up. We'll answer questions about course content and gather your feedback on this new course.

10 – 10:15 a.m.   **Brief Break**

10:30 – 1 p.m.   **Tour of the USPTO Headquarters
(optional). Transportation will be
provided**

The tour will consist of visiting the United States Patent and Trademark Office (USPTO) museum and public search facility. The tour will start at 11:30 a.m. and end at 1 p.m. The bus will depart at 10:30 a.m. Meet in the hotel lobby at 10:15 a.m.

1 p.m.   **Course Adjourns**

Meeting Agenda

Agreement Maintenance

Monday, November 5

7 a.m. – 5 p.m.   **Registration**

Location: Meeting Room Foyer

7 – 8 a.m.   **Breakfast**

Location: Terrace

7:30 – 7:45 a.m.   **Welcome and Introductions**

Speakers: Jennifer Folger,
Michigan State University

8 – 10 a.m.   **Anatomy of a License and Other Agreements**

Location: Embassy/Patuxent/Potomac

Speakers: Cory Acuff, *University of Georgia*
Tiffany Beverly,
University of South Carolina

For attendees who play a role in managing executed license agreements, the ability to read a license agreement and to understand each party's obligations under it is a key skill for doing your job effectively. This session will help attendees understand the obligations – both your institution's and the licensees' – owed under license agreements. Using examples, this session will provide an explanation of the sections and terms of typical license agreements, with attention to those most relevant to administrators. The session will include an interactive discussion of best practices for reporting, invoicing, and calendaring to ensure that your university receives the money, reports, and other obligations due under a license for years to come.

10 – 10:30 a.m.   **Networking Break**

Location: Meeting Room Foyer

10:30 a.m. – Noon   **Agreement Compliance: Positioned for Success**

Location: Embassy/Patuxent/Potomac

Speakers: Sarah Chambers, *NC State*
Brian Wright, *Auburn University*

We all celebrate the signing of a new agreement as a job well done but living with the deal and the terms of the deal can be a full-time job. Whether it is an exclusive license with a company promising to bring your technology to market, or an inter-institutional agreement with the co-owner of your intellectual property rights, how can you be sure that your partners are living up to their end of the deal? This session will focus on agreement compliance, including on both financial and non-financial terms. Learn about instituting pre-agreement procedures that enhance post-license compliance; convincing your colleagues that post-licensing compliance requires a "team" approach; and using checklists, correspondence templates, and your databases as

tools for enhancing post-license, all while focusing on building and maintaining the relationships with your partners that are essential to getting technology and products to market and creating value.

Noon – 1:30 p.m.   **Lunch**

Location: Terrace

1:30 - 3 p.m.   **Inter-Institutional Agreement Maintenance – Why It's Tricky**

Location: Embassy/Patuxent/Potomac

Speakers: Jason Felsch,
Alexion Pharmaceuticals
Jennifer Folger,
Michigan State University
Linda Kesselring, *Emory University*

Managing license agreements involves third-party considerations, whether in the form of obligations that arise from a research agreement, or from inter-institutional agreements and co-owners of the licensed intellectual property (IP). These third-party agreements introduce additional monitoring and reporting activities for the contract administrator. We will examine several of the main components involved in working with inter-institutional agreements, including patent management between your institution and the third party, managing financial obligations in multiple directions, and the impact of third-party agreements on license terms.

3 – 3:30 p.m.   **Networking Break**

Location: Meeting Room Foyer

3:30 – 5 p.m.   **Let's Talk Financials: Legal Expense Review, Approval and Invoicing Licensees**

Location: Embassy/Patuxent/Potomac

Speaker: Linda Galvin, *Stony Brook University*

One of the most difficult tasks related to technology transfer is managing and controlling patent expenditure. We really don't like surprises! There are various methods that can be utilized to help technology transfer offices (TTOs) with this process, such as implementing good habits with service providers, requesting estimates and setting caps for commissioned work. We will also discuss some practical ways to simplify and improve the legal invoice review process to allow case managers to focus on licensing rather than being bogged down reviewing legal expenses, as well as processing legal invoices and electronic expense import (EEI). Each attendee will leave with fresh ideas on how to improve this process in their own institution.

5:30 – 7 p.m.   **Welcome Reception**

Location: Terrace

Meet your colleagues and make new friends at this opening reception.

Meeting Agenda

Tuesday, November 6

7 a.m. – 5 p.m. — **Registration**

Location: Meeting Room Foyer

7 – 8 a.m. — **Breakfast**

Location: Terrace

8 – 10 a.m. — **Show Me the Money: Strategies to Get Licensees to Pay Up**

Location: Embassy/Patuxent/Potomac

Speakers: Steve Kousouris, *Johns Hopkins*
Sid Rattner, *Ocean Tomo, LLC*
Rose Robotham, *NuTech Ventures*

Getting an executed license is very important to a technology transfer office (TTO), but it is just the beginning! The TTO still has to manage that deal for the life of the agreement and ensure the university is getting the full benefit of the deal. This can be a major undertaking as your portfolio of licenses grows. This session will cover some of the common issues that arise during license management and provide helpful solutions and suggestions. Key examples will be given that can be shared with licensing personnel in order for them to negotiate future licenses with terms that support strategies to get licensees to pay up! We will also discuss the processes relating to handling delinquent accounts, default letters, termination letters as well as write-off requests.

10 – 10:30 a.m. — **Networking Break**

Location: Meeting Room Foyer

10:30 a.m. – Noon — **When Life Gives You Lemons: Handling the Inevitable Changes in Agreement Management**

Location: Embassy/Patuxent/Potomac

Speakers: Jennifer Folger,
Michigan State University
Brian Wright, *Auburn University*

Your agreement is fully executed, the database is populated, and everything is chugging along like a well-oiled machine. Until it isn't. In this session we'll discuss common hiccups in agreement management with suggestions on how to keep things on track. Challenges will include new licensee personnel, the acquisition of your licensee by another company, new interpretations of old language, and agreement amendments. Join us for a look at adding technology, dropping technology, acquainting new folks with their obligations, and the work that goes along with this.

Noon – 1:30 p.m. — **Lunch**

Location: Terrace

1:30 – 3:00 p.m. — **Let's Talk Financials: Royalties and Distribution of License Income**

Location: Embassy/Patuxent/Potomac

Speakers: Linda Galvin, *Stony Brook University*
Karen Boghossian,
Inteum Company, LLC

Each technology transfer office has its own established policies and procedures for distributing licensing or royalty income. Taking care of this administrative task in an accurate, consistent, and timely manner may not always generate accolades from recipients of the income, but failure to distribute properly will likely generate unfavorable responses. This session will demonstrate the importance of understanding the terms and status of agreements, understanding royalty distribution policies, communicating with royalty participants, establishing a standard royalty distribution process, and avoiding obstacles while completing the distribution. This group will discuss the framework as well as provide useful tools that can help technology transfer professionals smoothly carry out this important task.

3 – 3:30 p.m. — **Networking Break**

Location: Meeting Room Foyer

3:30 – 5 p.m. — **Do I Have a Story to Tell You! (or Tales from the Trenches)**

Location: Embassy/Patuxent/Potomac

Speaker: Jennifer Folger,
Michigan State University

Are you looking for a forum to discuss specific issues you struggle with in your job? Are you searching for resources that will give you a way forward in managing your institution's agreement portfolio? Do you need a place to start? Your search is over! We will use this time to discuss actual challenges faced by our attendees. Join us for this facilitated discussion where we will pool our experiences to talk about real-world situations that can (and must) be addressed..

Meeting Agenda

Wednesday, November 7

7 – 10 a.m.	**Registration**
Location:	Meeting Room Foyer

7 – 8 a.m.	**Breakfast**
Location:	Terrace

8 – 10 a.m.	**Using Technology Automation to Manage Contracts**
Location:	Embassy/Patuxent/Potomac
Speakers:	Ali Bocook Yankey, *University of Kentucky* Nekeshia Maloney, *Johns Hopkins Technology Ventures* Linda Kesselring, *Emory University*

Our panel will discuss the latest innovations in technology transfer contract management at each point in the agreement maintenance setup and monitoring cycle. We will also cover the opportunities and pitfalls in using contract management software, and give pointers on topics to consider when selecting software or an outsourcing vendor.

10 – 10:15 a.m.	**Brief Break**

10:30 – 1 p.m.	**Tour of the USPTO Headquarters (optional). Transportation will be provided.**

The tour will consist of visiting the museum and the public search facility. The tour will start at 11:30 a.m. and end at 1 p.m. The bus will depart at 10:30 a.m. Meet in the hotel lobby at 10:15 a.m.

1 p.m.	**Course Adjourns**

Join
Learn
Connect
Collaborate

Why Join AUTM? It's the benefits.

Network

Connect with the world's largest community of technology transfer professionals and share insights, best practices and mentorship.

▶ In-Person Networking – exchange ideas with nearly 2,000 colleagues at our Annual and Region Meetings

▶ Online Communities – connect anytime with peers and mentors focused solely on technology transfer

▶ Member Directory – quickly and easily locate colleagues and contacts around the world

▶ Special Interest Groups – network with those who share your passion in specific areas

Advance Your Career

Whether you're new to the profession or a seasoned professional, you'll find education tailored to your specific career needs.

▶ Professional Development Courses – from beginning to advanced, offered year-round

▶ Webinars – stay up-to-date with access to more than 90 courses

▶ Technology Transfer Practice Manual – discover a vast library of best practices and sample policies and agreements

▶ AUTM Learning Center – manage your professional development, continuing education and certificate programs online

▶ Professional Certification – demonstrate your qualifications and experience by earning credentials

Measure Your Impact

AUTM is the leader in gathering and reporting key metrics about technology transfer's impact.

▶ Licensing Activity Survey – the industry's most comprehensive benchmark report on licensing income, start-ups and more

▶ Salary Survey – valuable insights on compensation and tools to map successful careers within the technology transfer profession

▶ STATT – an online, searchable database with more 25 years of licensing statistics

▶ TransACT – a comprehensive database of terms and conditions, and fair market values to help improve your negotiations

Learn more at www.autm.net/join

Meeting Agenda

Monday, November 5

7 a.m. – 5 p.m.   **Registration**
Location: Meeting Room Foyer

7 – 8 a.m.   **Breakfast**
Location: Terrace

7:30 – 7:45 a.m.   **Welcome and Introductions**
Location: Terrace
Speakers: Monya Dunlap, *University of Florida*
Lee Heiman, *Azos AI LLC*

8 – 10 a.m.   **Invention Disclosures**
Location: Old Georgetown/Congressional
Moderator: Felicia Metz,
University of Maryland, College Park
Speakers: Korie Counts, *Ohio University*
Reanee Unger, *Michigan State*
Courtney Grate, *NUtech Ventures*

Invention disclosures are the foundation for the entire technology transfer process. This session will cover the overall process associated with obtaining, evaluating and managing an invention disclosure and the resulting intellectual property.

10 – 10:30 a.m.   **Networking Break**
Location: Meeting Room Foyer

10:30 a.m. – Noon   **The U.S. Patent Application Process Explained from Start to Finish (Part 1)**
Location: Old Georgetown/Congressional
Speakers: Lee Heiman, *Azos AI LLC*
Glenn Ladwig,
Saliwanchik Lloyd & Eisenschenk
Patrick Nolan, *USPTO*

Join us to learn or enhance your understanding of the U.S. patent application process from start to finish. The patent process requires a high-level skill set and a wide knowledge. These sessions will provide an overview of the process and terminology of patent preparation, prosecution, issuance, maintenance, and enforcement. Beginning with an invention disclosure, we will discuss patent searching, application drafting, timing and formal requirements for filing an application, dealing with the USPTO, patent issuance or abandonment, patent families, maintaining an issued patent in force, and how patents are used—and enforced if necessary—to support commerce.

Noon – 1:30 p.m.   **Lunch**
Location: Terrace

1:30 – 3 p.m.   **The U.S. Patent Application Process Explained from Start to Finish (Part 2)**
Location: Old Georgetown/Congressional
Speakers: Lee Heiman, *Azos AI LLC*
Glenn Ladwig,
Saliwanchik Lloyd & Eisenschenk
Patrick Nolan, *USPTO*

In this session, we will discuss preparing and filing provisional and non-provisional applications; "needs" and attorney-client communication during drafting and prosecution; determining, limiting, and paying official fees; an overview of the U.S. prosecution process; patent and trademark office deadlines, extensions of time, and related fees; examination backlog, the "14/4/4 rule," and procedures for accelerating examination; official notices and other channels of communication; electronic filing (EFS) and status (PAIR) systems; managing patent prosecution: the four major types of official actions during prosecution, and responsive actions by the applicant

3 – 3:30 p.m.   **Networking Break**
Location: Meeting Room Foyer

3:30 – 5 p.m.   **The U.S. Patent Application Process Explained from Start to Finish (Part 3)**
Location: Old Georgetown/Congressional
Speakers: Lee Heiman, *Azos AI LLC*
Glenn Ladwig,
Saliwanchik Lloyd & Eisenschenk
Patrick Nolan, *USPTO*

During part 3, we will discuss working with the USPTO; seeking review of official actions by appeals; allowance of claims and patent issuance; patent term extension and patent term adjustment; anatomy of a patent; correcting errors in an issued patent; co-pendency, continuing applications, and patent application families; maintaining patents in force; licensing and post-issuance change of ownership; attacking, defending, and enforcing issued patents after Grant.

5:30 – 7 p.m.   **Welcome Reception**
Location: Terrace

Meet your colleagues and make new friends at this opening reception.

Meeting Agenda

Tuesday, November 6

7 – 5 p.m.　　　　　　**Registration**

Location:　　　　　　Meeting Room Foyer

7 – 8 a.m.　　　　　　**Breakfast**

Location:　　　　　　Terrace

8 – 10 a.m.　　　　　　**PCT: Navigating the International Stage – Processes and Strategies**

Location:　　　　　　Old Georgetown/Congressional

Moderator:　　　　　　Kimberly Dunn, *Emory University*

Speakers:　　　　　　Michael Neas, *USPTO*
　　　　　　　　　　Brian Giles, *Thomas Horstemeyer LLP*

An interactive session with a senior member of USPTO PCT Receiving Office and an intellectual property attorney who will provide an overview of the PCT Process, timelines involved, and strategies for complying with routine and advanced issues, each from their own perspective. Discussed will be filing techniques, international search, defects, additional fees, international publication, international preliminary examination and entering the national phase.

10 – 10:30 a.m.　　　　　　**Networking Break**

Location:　　　　　　Meeting Room Foyer

10:30 – Noon　　　　　　**Patent Protection in Foreign Jurisdictions – The Yin to the U.S. Yang**

Location:　　　　　　Old Georgetown/Congressional

Speakers:　　　　　　Kimberly Dunn, *Emory University*
　　　　　　　　　　Brian Giles, *Thomas Horstemeyer LLP*

This session will provide an overview of the filing and prosecution process in foreign jurisdictions, whether it be a national stage filing or a direct filing without the benefit of a Patent Cooperation Treaty (PCT), together with best practices for managing costs. Discussions will include a range of topics, including filing strategies, differences of national application versus direct filing, costs/budgets, limitations of scope of invention; claim strategies, voluntary amendments, examination and grant.

Noon – 1:30 p.m.　　　　　　**Lunch**

Location:　　　　　　Terrace

1:30 – 3:00 p.m.　　　　　　**Working with Internal Counsel**

Location:　　　　　　Old Georgetown/Congressional

Speakers:　　　　　　Joseph Contrera,
　　　　　　　　　　Johns Hopkins University
　　　　　　　　　　Dustin Lee,
　　　　　　　　　　University of Maryland, Baltimore
　　　　　　　　　　Denise Walcott,
　　　　　　　　　　Mount Sanai School of Medicine

Join this session to learn what functions are handled in-house verses what is sent out in technology transfer offices with internal patent counsel. Panelists will discuss decision-making responsibility and how they handle functions including patent preparation, prosecution, inventorship determinations, and other substantive and procedural matters. Hear how different universities make these decisions and how to operate within each scheme.

3 – 3:30 p.m.　　　　　　**Networking Break**

Location:　　　　　　Meeting Room Foyer

3:30 – 5 p.m.　　　　　　**Working with Outside Counsel**

Location:　　　　　　Old Georgetown/Congressional

Moderator:　　　　　　Cheryl Horst, *NUtech Ventures*

Speakers:　　　　　　Shelley Jones, *LeClairRyan*
　　　　　　　　　　Gail Knott,
　　　　　　　　　　University of Maryland, Baltimore
　　　　　　　　　　Keisha Hylton-Rodic,
　　　　　　　　　　Hylton-Rodic Law PLLC

Learn about the roles and responsibilities of the licensing office, the inventor(s), co-owners, the licensee, and outside patent counsel. We will discuss when and how to contract with outside counsel, what information to provide, and how to efficiently and effectively facilitate the process from start to finish. Find out what experienced patent attorneys consider the most difficult aspects of the process. Discuss evaluation of attorneys and potential process improvements.

Meeting Agenda

Wednesday, November 7

7 – 10 a.m.	**Registration**
Location:	Meeting Room Foyer
7 – 8 a.m.	**Breakfast**
Location:	Terrace
8 – 10 a.m.	**Managing an Intellectual Property Portfolio**
Location:	Old Georgetown/Congressional
Speakers:	Ryan Brady, *Utah University*
	Korie Counts, *Ohio University*
	Dave Sadowski, *Penn State University*
	Reanee Unger, *Michigan State University*

So you've spent the past few days learning about intellectual property and everything that goes along with it. Now how do you put it all together? This session is designed to help you connect the dots by providing a comprehensive overview of the process with our panel of experts. They will provide tips and tricks that they've learned using real-world examples. Some of the information shared will include: tracking intellectual property deadlines; keeping forward momentum during prosecution; reviewing and approving legal expenses (including EEI/LEDES); cost management; using patent annuity services; navigating and searching the public Patent Application Information Retrieval (PAIR) and other patent and trademark office websites; tracking metrics; and more! The participants should come prepared to introduce questions, situations where advice or guidance is needed, or share useful tips and tricks that they have learned.

10 – 10:15 a.m.	**Brief Break**
Location:	Meeting Room Foyer
10:30 – 1 p.m.	**Tour of the USPTO Headquarters (optional). Transportation will be provided**

The tour will consist of visiting the United States Patent and Trademark Office (USPTO) museum and public search facility. The tour will start at 11:30 a.m. and end at 1 p.m. The bus will depart at 10:30 a.m. Meet in the hotel lobby at 10:15 a.m.

1 p.m.	**Course Adjourns**

Annual Meetings

2019
February 10 - 13
JW Marriott Austin
Austin, Texas

2020
March 8 - 11
Manchester Grand Hyatt San Diego
San Diego, California

2021
March 14 - 17
Washington State Convention Center
Seattle, Washington

save the **date**