

Wednesday, June 24, 2009



Sponsored by **O'MELVENY & MYERS LLP**

Hosted by **TIPSGROUP**

**1000 Elwell Court, Suite 150, Palo Alto, CA 94303 (650) 293-3350**  
**11:30 AM – 2:00 PM**

**Topic: “Settlement Agreements – A Boon or Burden”**  
**“How to Protect Your Company From Making Mistakes That Will Cost in the Long Run”**

### **Brief Description**

In an effort to conclude expensive and disruptive intellectual property litigation, a party may enter into a settlement agreement that resolves the current dispute, but does not satisfactorily address the party's long-term strategic goals. For example, settlement agreements may include terms that cause a company to become an unattractive merger candidate. This presentation will offer advice on best practices for negotiating and drafting settlement agreements in the context of on-going litigation, and provide examples of “pitfalls” for settlement agreements and suggestions on how to avoid them. The presentation will also address issues related to licensing schemes that are often part of settlement agreements.

Some of the specific topics of the presentation will include:

- Deciding whether the settlement agreement will cover improvements, enhancements, updates, or modifications of the intellectual property in dispute.
- Identifying proper entities (*e.g.*, members of a party's supply chain) in waivers and releases.
- Differentiating between covenants not-to-sue and licenses as they relate to settlement of litigation, and lessons learned from the recent Federal Circuit opinion in *Transcore, LP et al. v. Electronic Transaction Consultants Corp.*
- Structuring payment schemes (*e.g.*, royalty payments) in licenses so that the underlying business is not overly burdened.
- Ensuring that necessary on-going rights are transferrable or available to potential acquirers or partners.
- Avoiding antitrust pitfalls that arise out of settlement agreements.
- Identifying other strategic issues relating to the settlement process.

**Featured Speakers:** Please see the following page for detailed speaker bios, or click on name to link to site.

**Paul J. Meyer, Jr.** is a counsel in O'Melveny & Myers LLP's Silicon Valley office and a member of the firm's Intellectual Property and Technology practice. His practice focuses on intellectual property counseling, and structuring and negotiating technology transactions, including licensing, joint ventures, complex strategic alliances and mergers and acquisitions.

**George Yu** is a counsel in O'Melveny's San Francisco office and a member of the Intellectual Property and Technology Practice Group within the Litigation Department. George focuses his practice on intellectual property litigation and counseling with an emphasis on patent infringement and technology-related trade secret misappropriation actions. With a strong background in biochemistry and biology, George has particular experience handling matters involving complex biotechnology and medical technology products. George also has experience handling matters involving high tech and software products.

**Location:** Hosted by TIPS Group 1000 Elwell Court, Suite 150, Palo Alto, CA 94303 (650) 293-3350

TIPS Group provides a broad range of services to small companies from early stage start-ups to mature organizations and provides intellectual property services to clients of all sizes.

For directions, please go to [http://maps.google.com/maps?q=1000+elwell+ct+palo+alto+ca&oe=utf-8&rls=org.mozilla:en-US:official&client=firefox-a&um=1&ie=UTF-8&split=0&gl=us&ei=GPEjSugyo4y2A5DpyJoE&sa=X&oi=geocode\\_result&ct=title&resnum=1](http://maps.google.com/maps?q=1000+elwell+ct+palo+alto+ca&oe=utf-8&rls=org.mozilla:en-US:official&client=firefox-a&um=1&ie=UTF-8&split=0&gl=us&ei=GPEjSugyo4y2A5DpyJoE&sa=X&oi=geocode_result&ct=title&resnum=1)

**Meeting format:**

11:30 – 12:30 Registration and Networking buffet lunch  
12:30 – 2:00 Program

**Registration:**

**LES Members Registration Fees are:** \$45. if paid by Friday, June 19, 2009  
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**Paul J. Meyer, Jr.** is a counsel in O'Melveny & Myers LLP's Silicon Valley office and a member of the firm's Intellectual Property and Technology practice. His practice focuses on intellectual property counseling, and structuring and negotiating technology transactions, including licensing, joint ventures, complex strategic alliances and mergers and acquisitions.

Paul has represented a variety of high technology, biotechnology and pharmaceutical companies on a broad range of transactions, including inbound and outbound licensing, joint research and development collaborations, manufacture and supply arrangements, clinical trial agreements, distribution and reseller relationships, co-marketing agreements, strategic joint ventures, and mergers and acquisitions.

In addition to his transactional experience Paul has also practiced as a patent prosecutor and as an intellectual property litigator. His technical background is in microbiology and he is a member of the U.S. Patent and Trademark Office. Paul has drafted or prosecuted over a hundred patent applications for biotechnology, medical device, and pharmaceutical inventions, including applications related to drug delivery systems such as stents and catheters, small-molecule pharmaceuticals, polymer chemistry and coating technology, and bioremediation. Paul has also conducted patent due diligence for medical device and pharmaceutical clients.

Paul's litigation experience includes patent litigation matters related to various technologies including computer peripherals, printers, laminators, network software, health care software, ophthalmic pharmaceuticals, and nutraceuticals.

Paul's experience in the various facets of intellectual property law and his technical background makes him particularly well attuned to the larger business and operational context for transactions and the strategic market issues that public and growing technology companies face. Paul's substantive legal knowledge in intellectual property combined with his deep technology background and understanding of business issues in the technology market enable him to advise clients on a wide range of practical legal and business issues.

**George Yu** is a counsel in O'Melveny's San Francisco office and a member of the Intellectual Property and Technology Practice Group within the Litigation Department. George focuses his practice on intellectual property litigation and counseling with an emphasis on patent infringement and technology-related trade secret misappropriation actions. With a strong background in biochemistry and biology, George has particular experience handling matters involving complex biotechnology and medical technology products. George also has experience handling matters involving high tech and software products.

#### **Illustrative Professional Experience**

- Served as Assistant General Counsel, Litigation for a research leader and major developer, manufacturer and worldwide distributor of microarray technology used for analyzing complex genetic information and represented the company in defending against claims of patent infringement, including: a patent infringement matter ending with a successful summary judgment on non-infringement, affirmed on appeal; a successful defense against another claim of patent infringement, which led to a favorable settlement; and work on a patent litigation in the District of Delaware where the opposing party was found to have infringed five of the company's patents and paid the company \$95 million as part of a settlement
- Headed the technical and scientific aspects of a high-profile patent infringement case involving monoclonal antibody technology on behalf of one of the world's leading developers of tools, products and services used to screen blood and ensure blood safety in the transfusion industry
- Defended a semiconductor company in a patent infringement action and helped to negotiate a favorable settlement
- Defended an online matchmaking company in a patent infringement action and helped to negotiate a favorable settlement
- Represented a party in U.S. District Court litigation in successfully compelling arbitration in Sweden of a breach of contract claim involving enterprise software
- Represented the plaintiff in a three-week bench trial of a trade secret misappropriation case involving the theft of FDA manuals and cells used to make monoclonal antibodies, which resulted in a multi-million dollar verdict in favor of the plaintiff, affirmed on appeal
- Represented the plaintiff, a non-profit research institute, in preparing for a jury trial involving ownership of patents relating to nucleic acid detection technology



**REGISTRATION FORM**  
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**PLEASE NOTE – ALL REGISTRATIONS ARE HANDLED BY LES HQ!**

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For questions regarding online registration please contact

Curtis Gore, LES Membership & Chapter Coordinator  
[cgore@les.org](mailto:cgore@les.org) (703) 299-8209

Name: \_\_\_\_\_

Title: \_\_\_\_\_

Company: \_\_\_\_\_

Address: \_\_\_\_\_

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Telephone: \_\_\_\_\_

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**METHOD OF PAYMENT:**

**Total Payment:** \$ \_\_\_\_\_  
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No refund of registration fees will be given after June 19, 2009.

**Enclosed is my check, drawn on a U. S. bank, in U. S. funds, made payable to *LES* (Licensing Executives Society USA and Canada, Inc.) Please put **“LES-SVC 06/19/09 Event “ in the memo section of the check.****

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**Please fax the completed form to Curtis Gore:  
 FAX (703) 836-3107**

**For more information or questions, please visit:  
[www.les-svc.org](http://www.les-svc.org) or contact:**

**Franca Gargiulo – LES-SVC Coordinator**

**Email: [franca.gargiulo@att.net](mailto:franca.gargiulo@att.net)**

**Phone: (415) 564-2600**