



**American Bar Association  
Section Of Intellectual Property Law  
Young Lawyers Committee**

*presents*

**Practical Tips on  
Intellectual Property Law:  
Intellectual Property  
Transactions and  
Management**



**September 28, 2007**

**The John Marshall Law School  
Chicago, Illinois**

*in cooperation with*

**The John Marshall Law School**

# Practical Tips on Intellectual Property Law: Intellectual Property Transactions and Management

As the United States has moved towards a knowledge-based economy, intellectual property has become increasingly important to American businesses. However, most law school courses and seminars continue to focus on litigation and prosecution issues. This Practical Tips program offers a survey of the use of intellectual property in business transactions and will explore IP issues that arise in strategic business planning, due diligence, tax planning, securities compliance and transactional valuation. The program features top professionals from the IP field who will provide practical advice on dealing with the nuts and bolts of these emerging issues. For the eleventh year, the Practical Tips program is sponsored by the Young Lawyers Committee of the ABA Section of Intellectual Property Law, this program in cooperation with The John Marshall Law School.

## **Program Co-Chairs:**

Christopher J. McGeehan, *Greer, Burns,  
& Crain, Ltd.*, Chicago, IL

Petty Tsay, *Eisner & Frank*,  
Los Angeles, CA

Robert K. Fergan, *Brinks Hofer Gilson  
& Lione*, Ann Arbor, MI

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# Program Schedule

**Friday, September 28, 2007**

**8:45 - 8:50 a.m.**

## **WELCOMING REMARKS**

Pamela Banner Krupka, *Krupka Law Group, P.C., Los Angeles, CA*. Section Chair, ABA Section of Intellectual Property Law.

**8:50 - 9:00 a.m.**

## **INTRODUCTORY REMARKS**

Richard S. Gruner, *Director, Center for Intellectual Property Law, The John Marshall Law School, Chicago, IL*

**9:00 - 10:00 a.m.**

## **DEVELOPING CORPORATE INTELLECTUAL PROPERTY POLICIES**

Developing procedures to identify and develop new intellectual property; deciding which ideas to patent and marks to register; protecting trade secrets; developing an effective IP management program.

Kara E.F. Cenar, *Bell, Boyd & Lloyd LLP, Chicago, IL*

Janet M. Garetto, *Nixon Peabody LLP, Chicago, IL*

**10:00 - 11:00 a.m.**

## **INTELLECTUAL PROPERTY DUE DILIGENCE PART I**

Intellectual property ownership and maintenance; security interests in intellectual property assets; effect of bankruptcy on intellectual property rights.

Beverly A. Berneman, *Querrey & Harrow, Chicago, IL*

Michael J. Femal, *Schwartz Cooper, Chicago, IL*

**11:00 - 11:15 a.m.**

## **BREAK**

**11:15 a.m. - 12:15 p.m.**

## **INTELLECTUAL PROPERTY DUE DILIGENCE PART II**

Investigating patents and trademarks for inequitable conduct and fraud on the USPTO.

Alejandro Menchaca, *McAndrews, Held & Malloy, Ltd., Chicago, IL*

Julie A. Katz, *Welsh & Katz, Ltd., Chicago, IL*

**12:15 - 1:30 p.m.**

## **BUFFET LUNCHEON**

**“Birth of an Intellectual Property Marketplace”**

Michael Lasinski, *Managing Director, Ocean Tomo, Chicago, IL*

**1:45 - 2:45 p.m.**

## **TAXATION AND INTELLECTUAL PROPERTY**

Ownership and licensing of intellectual property and tax planning; strategies for minimizing taxes on royalties and IP revenue; IP issues related to tax reduction strategies.

Alexey V. Manasuev, *KMPG LLP, Washington, DC*

Margaret A. Dobrowitsky, *Brinks Hofer Gilson & Lyon, Ann Arbor, MI*

**2:45 - 3:45 p.m.**

## **SECURITIES LAW AND INTELLECTUAL PROPERTY**

Understanding the application of securities law (including Sarbanes-Oxley) to the intellectual property of publicly traded companies; responding to audit requests from accountants; preparation of reliance opinions regarding intellectual property assets.

Matthew A. Griffin, *Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP, Chicago, IL*

David Luetgen, *Foley & Lardner LLP, Milwaukee, WI*

**3:45 - 4:00 p.m.**

## **BREAK**

**4:00 - 5:00 p.m.**

## **TRANSACTIONAL INTELLECTUAL PROPERTY VALUATION**

Methods of valuing intellectual property as a business asset; securitizations of intellectual property revenue streams; valuation of donated intellectual property.

Robert Chiang, *Navigant Consulting, Chicago, IL*

Gordon Green, *LECG, Chicago, IL*

**5:00 p.m.**

## **ADJOURN**

# Registration and Program Information

**Advance Registration:** You may register online at [www.abanet.org/intelprop/2007tips\\_september](http://www.abanet.org/intelprop/2007tips_september), or complete and mail the registration form with your payment. If paying by credit card, you may fax the completed form to 312/988-6800. Deadline for receipt of advance registration is September 14, 2007. Payment must accompany form.

**Onsite Registration:** Onsite registration will be available at The John Marshall Law School, Friday, September 28, 2007 beginning at 8:00 a.m. Onsite registrations must include payment.

**Registration Confirmation:** Confirmations will be sent via e-mail in advance of the program for all registrations received prior to September 14, 2007.

**Cancellation Policy:** Registrants unable to attend the program may receive a refund, less a \$50 administrative fee, if a cancellation request is received by September 14, 2007. Requests should be sent via e-mail to [iplaw@abanet.org](mailto:iplaw@abanet.org), or by fax to 312/988-6800, attn.: Practical Tips. No refunds will be granted after September 14, 2007. Substitutions are acceptable. The ABA reserves the right to cancel any program and assumes no responsibility for personal expenses.

**Food and Beverage:** There will be coffee service prior to the start of the program, and at breaks. A buffet luncheon is included in the registration fee.

**Location and Lodging:** The site of the program is The John Marshall Law School, 12th Floor, 315 S. Plymouth St., Chicago, Illinois. No sleeping rooms have been reserved for this meeting— individuals are on their own to make reservations at the hotel of their choice.

**Travel:** If you are traveling to the program, and need airline reservations, you are encouraged to make your reservations on the ABA Online Travel site, [www.abanet.org/travel/onlinetravel.html](http://www.abanet.org/travel/onlinetravel.html) where you automatically receive ABA airfare discounts from a variety of carriers. Further information on current discounts and special promotions can be found on the main ABA Travel page at [www.abanet.org/travel](http://www.abanet.org/travel).

**CLE Credit:** CLE accreditation has been requested for this program from every state in the U.S. with mandatory continuing legal education requirements for lawyers. Each state granting such credit makes its own determination as to the number of hours of credit to be awarded for attendance. Attendees requesting credit for the program must follow the instructions for CLE provided on site at the registration area CLE table. Certificates of attendance will be available at the CLE table, as well as Texas CLE Cards and Pennsylvania CLE Certificates. New York and Delaware attorneys must sign in and sign out each time they enter or leave the room. New York attorneys must complete the special New York certificate of attendance at the end of the program and have it signed by authorized ABA personnel.

You may contact the ABA Service Center toll free at 800/285-2221 or the program coordinator at 312/988-5598 within two weeks of the start of the program for confirmation of the number of CLE credit hours requested by the ABA or credit approved by any particular state.

For more information on the ABA Section of Intellectual Property Law, visit the Section website at [www.abanet.org/intelprop](http://www.abanet.org/intelprop), e-mail [iplaw@abanet.org](mailto:iplaw@abanet.org), or call 312/988-6268.

Financial hardship waivers are available for this program. To receive such consideration or request additional information, e-mail: [iplaw@abanet.org](mailto:iplaw@abanet.org), or call 312/988-6268.



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# Registration Form

## PRACTICAL TIPS ON INTELLECTUAL PROPERTY LAW: INTELLECTUAL PROPERTY TRANSACTIONS AND MANAGEMENT

September 28, 2007 ❖ Chicago, Illinois

Yes, please register me for the Practical Tips program.

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Confirmation will be sent via e-mail. If you prefer fax please check here:

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*(course materials and lunch included in registration fee)*

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