

## IP MasterClass

“The A-Z of IP: Navigating the IP Challenges in Securing your Innovations”

Monday, 22 May 2017

10:30 - 16:00

CERTH, Thessaloniki

# SEMINAR AGENDA



**CERTH**  
CENTRE FOR  
RESEARCH & TECHNOLOGY  
HELLAS



10:00 - 10:20	Registration
10:20 - 10:30	Welcome - Introduction Dr. Athanasios G. Konstandopoulos, Chairman of CERTH
<b>Session I</b> <b>Making Your IP Irresistible: How to Structure Patents as Opportunity Scaffolds</b> <b>Dr. Reuven K. Mouallem, LL.M., IP Management Consultant/Strategic Advisor/  Patent Attorney – FlashPoint IP Ltd.</b>	
10:30 - 11:10	<b>Tactics for Successful Patent Outcomes from an Engineering Design Approach</b> Decisions made in patent application drafting and prosecution can significantly impact the potential value for patent monetization and/or commercialization. This presentation relates engineering prototyping and failure analysis to patent prosecution and patent strategy execution. After a brief overview of patent basics, proper approaches for methodically dealing with prosecution hurdles will be described. Patent gaffes such as misleading terminology, weak claim structure, inadequate assessment of the prior art, and focusing on a narrow set of implementations, which can lead to weak, invalid, and/or unenforceable patents, will be highlighted.
11:10 - 11:30	<b>Questions &amp; Answers</b>
11:30 - 11:45	<b>Coffee Break</b>
11:45 - 12:25	<b>More Tales from the Claim Fixer: Digging Deeper into Prosecution Dynamics</b> This presentation will consider specific real examples of claims in which prosecution advancement critically hinged on strategic aspects that Examiners were looking for. In such cases, Examiner responses to appropriate amendments were dramatic, highlighting the importance of understanding underlying motivations by the Examiners. Such dynamics can serve as a general playbook for avoiding such problems when first amending the claims during prosecution as will be summarized.
11:45 - 12:25	<b>The Secret Sauce for Patent Allowance of S/W in an Anti-Software Patent Environment</b> This presentation reviews the current understanding of what is patentable with regard to software from the perspective of the EPO, as well as emphasizing the USPTO's previous guidelines (prior to the 2014 Alice Decision on patentable subject matter). We will then address recent changes since patent eligibility guidelines were introduced by the USPTO in 2015 and 2016, which many consider to have skewed the examination process to be an unfriendly environment for software inventors, as well as how such changes have raised the threshold for obtaining and defending software patents. Concrete strategies for preventing such rejections from arising will be described.
12:25 - 12:45	<b>Questions &amp; Answers</b>
12:45 - 13:30	<b>Light Lunch Break</b>

## Session II

### An Eye for Strategic Positioning in the Art of Obtaining the Right Terms

Adv. Dalia Mouallem, Esq., Senior Legal Counsel: Licensing, Litigation, & Trademark Attorney – FlashPoint IP Ltd./Navid Ventures Ltd.

#### Technology Licensing Agreements: Vehicles for Avoiding Disputes in Business Transactions

This presentation focuses on the basics of forming an agreement with an emphasis on licensing agreements, and how a strong technology licensing contract can protect the parties' IP rights, as well as prevent future disputes and conflicts. Some examples and pitfalls to avoid will be discussed

#### The Ins and Outs of NDAs

This presentation includes discussion of the key elements of a non-disclosure agreement (NDA), its relevance in IP protection, and when an NDA is required in general. It further defines confidential information, and points out the scope of confidentiality obligations under an NDA with examples to illustrate where problems can arise

13:30 - 14:10

14:10 - 14:30

Questions & Answers

14:30 - 14:45

Coffee Break

## Session III

### Building Meaningful Asset Value While Being Mindful of Cost Containment

Dr. Reuven K. Mouallem, LL.M., IP Management Consultant/Strategic Advisor/Patent Attorney – FlashPoint IP Ltd.

#### Developing Smart, Value-Added IP Portfolios for Enhanced Patent Asset Monetization and Efficient Resource Utilization

This presentation focuses on how patent portfolios are typically developed in which many aspects of the decision-making process such as timing, costs, and strategic impact are not assessed cohesively. Such approaches often end up falling short of expectations for value creation, frequently long after substantial sunk costs have been incurred. A more holistic approach is described for developing effective portfolios at the onset while being wary of budgetary constraints

#### Patenting without a Clear Market Horizon

This presentation deals with the challenges of unpredictable, nascent, rapidly developing, and/or merging technical areas. Such technologies pose great risk/reward opportunities, but are often deemed unwieldy to foster and manage. Frequently, foresight is limited, and a bit of luck is always a key ingredient. However, clever tiered structuring of patent applications can keep avenues open while mitigating cost overrun

14:45—15:25

15:25 - 15:45

Questions & Answers

15:45 - 16:00

Closing Remarks

16:00 - 17:30

Private Consulting Sessions (Scheduling upon request)

# Speakers

Dr. Reuven K. Mouallem, LL.M.



Dr. Reuven Mouallem is a registered Patent Attorney/Agent both in Israel and the US, and is an EQE-Level EP Practitioner. Reuven received a BS in Chemistry, PhD in Chemical Physics (focusing on nanotechnology, catalysis, and semiconductor processing), MS in Management of Technology, and LLM in Intellectual Property Law and Management with years of industrial and legal experience.

Dr. Mouallem's IP practice involves a diverse array of technical fields, focusing on strategic client counseling, due diligence investigations, legal opinions, patent portfolio management and analysis, prosecution of both U.S. and foreign patent applications, IP valuations, IP analytics, and competitive intelligence.

Strategic portfolio management and counseling clients is an integral part of Dr. Mouallem's practice. An expert in US IP law, he further gained significant knowledge about the EPC and the diversity of laws and practice among the European national systems during his LLM studies at the University of Strasbourg. His knowledge of the European legal system, and how it differs from the United States, allows Dr. Mouallem to effectively counsel both European and US clients with global interests in intellectual property.

Dr. Mouallem founded FlashPoint IP to provide a unique blend of traditional IP services with a high-level consultancy in order to better service the changing role that IP has been playing as a key driver in the corporate arena. He has recently lectured and chaired seminars on Risk Management in IP, Patent Quality as a Systemic Problem in the Patent Offices, and Assessing the NPE Economy for the EPO, as well as Advanced Patent Search Methodologies for the Pharmaceutical Industry and Other Technical Arts for the WIPO.

FlashPoint IP was the 2016 winner of Acquisition International's IP Awards for Best IP Firm – Israel and Recognised Leader in Patent Portfolio Management.

**Adv. Dalia Mouallem, Esq.**



Advocate Mouallem's practice focuses on strategic contract preparation, review, and negotiation including technology-transfer, licensing-royalty, and investment agreements. Dalia also counsels clients in trademark filing, prosecution, and portfolio management, directly handling filings in several jurisdictions. She represents a diverse range of large and small clients in the consumer products, cosmetics, health care, manufacturing, education, medical device, gaming, pharmaceutical, software, and consulting fields. Dalia has counseled startup clients, SMEs, and large ventures alike, and has extensive litigation experience.

Ms. Mouallem received a bachelor's degree in Sociology and Pre-Medical Studies, and her law degree from the Hofstra University School of Law with a J.D. as the Robin Dana Cohen Memorial Award Recipient. She is admitted to the N.Y. State Bar and the U.S. District Court, as well as the Israel Bar.

Dalia has served as Senior Legal Counsel for FlashPoint IP since its inception, in addition to her position as CEO & Managing Attorney at Navid Ventures.