

How the America Invents Act and the Patent Cases Pilot Program Changed Everything!

What Today's Inventors, Investors,
and Entrepreneurs Need to Know
about the New Patent Acts

A Presentation by **Alan M. Sack '79** to the MIT Alumni Club of Long Island
October 15, 2015

Two New Laws Affect Patents

A Legislative "Perfect Storm"

- Patent Cases Pilot Program (PCPP)—H.R. 628;
Pub. L. 111-349; 124 Stat. 3674-3676
 - Signed into Law on January 4, 2011
 - Took effect on June 4, 2011
 - Sunsets June 4, 2021
- The Leahy-Smith America Invents Act (AIA)—H.R.
1249;
Pub. L. No. 112-29, 125 Stat. 284-341
 - Signed into Law on September 16, 2011
 - Effective dates of its provisions ranged from 9/16/2011
through 3/16/2013
 - No Sunset

The Laws Interact

- PCPP is “An Act [intended to] establish a pilot program in certain United States district courts to encourage enhancement of expertise in patent cases among district judges”
 - “Participating” judges see more patent cases
 - 14 designated district courts as of June 4, 2011
 - Specialized local patent rules
 - District Courts determine validity and infringement
- AIA conforms the US Patent Laws with International Standards
 - Shift from “First to Invent and Reduce to Practice” to “First Inventor to File” standard
- Controls how Patent Validity is determined
 - Conflicts over validity can be litigated in the USPTO’s Patent Trial and Appeals Board (PTAB)
 - Venue for USPTO PTAB appeals to the Federal Circuit and District Courts

PCPP: The Courts

- By June 4, 2011 there were 14 “designated district courts”
 - They were chosen by volume of patent and plant variety protection cases, and by opt-in of District Court Judges
 - Included are the US District Courts of the: C.D. Cal., N.D. Cal., S.D. Cal., S.D. Fla., N.D. Ill., D. Md., D. Nev., D. N.J., S.D.N.Y., E.D.N.Y., W.D. Pa., W.D. Tenn., E.D. Tex., and N.D. Tex.

PCPP: The Judges

- As of June 4, 2011, 91 judges and magistrate-judges had been designated by chief judges to participate in the program
 - A list of judges' names and their respective districts is available from Legal Metric Research at www.legalmetric.com
- Cases are assigned as before, but judges who don't participate can decline the case and it will be moved to a participating judge

Patent Pilot Program Statistics

(From: *The Patent Pilot Program: Reassignment Rates and the Effect of Local Patent Rules (NYIPLA 2013)*)

by Ron Vogel, Fish & Richardson, P.C.)

Table 1— DISTRICTS PARTICIPATING IN THE PATENT PILOT PROGRAM

District	Patent Cases Filed ⁴			Time to Trial, years ⁵	Local Patent Rules Adopted ⁶
	2011	2012	Through 10/29/13		
Eastern District of Texas	413	1,231	1,195	2.13	2/2/05 ⁷
Central District of California	309	503	324	2.47	—
Northern District of California	219	256	212	2.92	1/1/01
Northern District of Illinois	217	238	182	2.52	10/1/09
District of New Jersey	178	159	121	3.06	1/1/09
Southern District of New York	152	141	95	2.85	4/8/13
Southern District of California	79	143	174	2.48	4/3/06
Southern District of Florida	63	134	155	1.66	—
Northern District of Texas	46	57	67	2.26	5/1/07 ⁸
Eastern District of New York	33	30	38	3.28	4/8/13
District of Maryland	31	42	14	2.22	7/1/11
District of Nevada	30	30	37	2.39	8/1/11
Western District of Pennsylvania	11	39	19	—	1/1/05
Western District of Tennessee	2	31	14	—	9/19/11

Patent Pilot Program Statistics (cont'd)

TABLE 2 - REASSIGNMENT OF PATENT CASES IN PATENT PILOT DISTRICTS¹¹

District	Patent Pilot Judges in District ¹²	Patent cases assigned	Cases assigned to non-patent judges	Cases reassigned by non-patent judges	95% CI for Range of Cases Reassigned	
					Low	High
Eastern District of Texas	5 of 7	2,519	78	34	32.4%	55.3%
Central District of California	6 of 37	845	601	113	15.8%	22.2%
Northern District of California ¹³	12 of 31	474	335	2	0.1%	2.1%
Northern District of Illinois	10 of 39	416	211	81	31.8%	45.3%
District of New Jersey	11 of 25	290	144	24	11.0%	23.8%
Southern District of New York	10 of 50	225	113	25	14.9%	30.9%
Southern District of California ¹⁴	5 of 17	319	145	111	68.8%	83.2%
Southern District of Florida	3 of 25	210	194	108	48.4%	62.8%
Northern District of Texas	3 of 14	102	71	54	64.5%	85.4%
Eastern District of New York ¹⁵	15 of 42	69	61	35	44.1%	70.0%
District of Maryland	3 of 18	45	36	20	38.1%	72.1%
District of Nevada	4 of 12	70	26	23	69.8%	97.6%
Western District of Pennsylvania	6 of 14	53	13	13	75.3%	100.0%
Western District of Tennessee	2 of 6	44	9	6	29.9%	92.5%

What is a Patent Worth?

Value of Exclusivity

- Confers monopoly for a limited time
 - 20 years from filing
 - Plus time (in US only) for delays by patent office and for some pharmaceutical patents
- Monopoly = More Profit

What Someone Else Will Pay

- Licensing
 - Up-front payments, milestone payments, running royalties
- Sale or Assignment
 - Outright or with claw-back clause
- Reputation / Credibility
 - Startups and large companies

Patents Are Investments

- Every business, especially a startup, needs an intellectual property investment strategy
 - Patents are only one component
- Patents cost a lot
 - Only about 10% make back the investment
- Patenting “smart” begins by drafting the provisional with licensing & litigation in mind

High-value Patents Are Enforceable

- Patents your business relies on should be strong
 - Valid beyond reproach
 - Able to stand up to multiple examinations
 - Claim what you invented and want to protect
- Infringement should be easy to see
 - Compositions and articles of manufacture
 - Methods and processes

The AIA Redefined Patent Rights

- AIA—H.R. 1249 Signed Into Law September 16, 2011
 - Pub. L. No. 112-29, 125 Stat. 284-341.
 - “An Act to amend title 35, United States Code, to provide for patent reform”
- Effective dates of AIA provisions ranged from 9/16/2011 through 3/16/2013
 - For years to come, the courts will be dealing with a dual patent law system because some patents and disputes involving them will be subject to pre-existing law, while others will be subject to the new law
 - This duality is nowhere more evident than in “first-to-invent-and-reduce-to-practice” cases under the 1952 Act versus “first-inventor-to-file” cases under the AIA

The AIA Expresses the “Sense of Congress”

- Legislative Intent
 - Fix flaws in America’s patent system to promote industries to continue to develop new technologies that spur growth and create jobs across the country
 - Improve US patent quality to “protect the rights of small businesses and inventors from predatory behavior that could result in the cutting off of innovation”
 - Enhance court adjudication of patent infringement, validity, and enforcement actions and proceedings
 - Increase the PTO’s role as an arbiter of patent validity
 - Facilitate harmonization of the US patent system with the patent systems of other countries

How the AIA Affects Validity

- §3 First Inventor to File
 - Prior Art
 - Novelty exceptions
- §6 Post-grant Review (PGR) and Supplemental Examination
- §15 Best Mode Requirement
- §18 Covered Business Methods (CBM)

First to Invent & Reduce to Practice

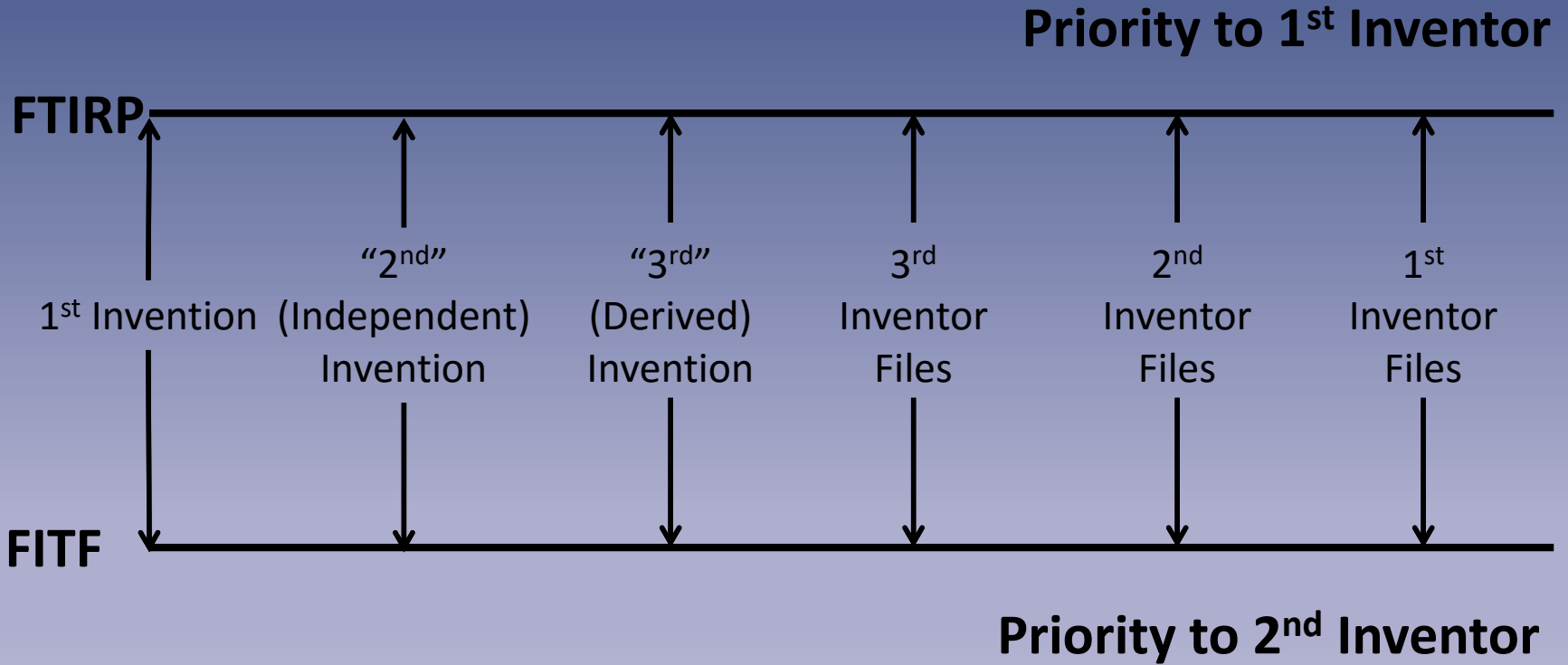
- Patent goes to the first inventor(s) (only)
- Invention
 - Conception
 - Reduction to Practice
- Interferences turn on diligence in reduction to practice
 - Can be accomplished by filing patent application

First Inventor to File

The fundamental change in the AIA on novelty,
redefining the right to a patent

- Right to the patent goes to the first inventor to file (FITF)
 - No more patent interferences
- Institution of derivation proceedings
- “Prior Art” is redefined

FTIRP vs. FITF



Prior Art Redefined

- Now determined by effective filing date, not invention date
 - No more “swearing behind” references
- Public use or sale worldwide, not only in US
- Adds “otherwise available to the public”
- One-year grace period for disclosure by inventor or someone who derived invention
- Joint research agreements—joint inventors’ disclosures

Derivation Proceedings(I)

- Petition must be filed within 1 year after publication of a patent application claiming substantially the same invention
 - For proceedings between patentees, petition within 1 year from issuance of first patent
- Petition must be supported by substantial evidence
- Determination whether to initiate proceeding is made by PTO Patent Trial and Appeal Board (PTAB)

Derivation Proceedings (II)

- Parties can resolve the contest through alternative dispute resolution (ADR)
 - Settlement terms must be approved by the PTO.
- Appeals of derivation proceedings venued in the US District Courts and the Federal Circuit
- Judicial Recourse

HOW THE AIA AFFECTS PATENT LITIGATION

Jurisdiction and Venue

- §9 Venue
 - Civil actions for *de novo* review of PTO decisions must now be brought in the EDVA (PTO venue)
- §19 Jurisdiction and Procedural Matters
 - Suits against multiple accused infringers (joinder)

§9 *De Novo* Review

- Non-Contested Cases:
 - 35 USC § 32 – Practitioner disciplinary proceedings
 - 35 USC § 145 – PTAB decisions on patent applications
 - 35 USC § 154(b)(4)(A) – PTO decisions on patent term adjustments
 - 35 USC § 156 – PTO decisions on patent term extensions
 - 15 USC § 1071(b)(1)-(2) – TTAB trademark decisions
- Contested Cases:
 - 35 USC § 146 – PTAB decisions in derivation proceedings wherein adverse parties reside in different countries or in different districts not within the same state

§9 EDVA Venue

- Suits under 35 USC § 291 between owners of interfering patents are now venued in EDVA
 - Venue specified by reference to 35 USC § 146
- Suits Against Non-US-Resident Patentees are now venued in EDVA
 - 35 USC § 293
 - Designation of agent for service can be filed by patent owner (PO) in PTO
- Federal Circuit retains appellate review jurisdiction of EDVA Decisions
 - 28 U.S.C. § 1295(a)(1) & (4)(C)

§19 Joinder

- Suits against multiple accused infringers
- Intended to make it more difficult for non-practicing entities (NPEs) to bring a single suit against multiple alleged infringers

§19 Implications (I)

- The new rule should reduce the number of defendants in a patent case and will likely increase the number of patent cases filed
 - Patentee will have to pay a filing fee for each defendant and deal with maintaining separate actions later
- Venue transfer should become easier
 - No longer can patentee join a few defendants from within the district to maintain jurisdiction over out-of-district defendants
- Consolidation for pre-trial
 - Patentees will probably seek to consolidate individual cases for pre-trial matters (discovery, *Markman* hearings, multi-district litigation)
- Defendants can still waive the limitations of the new rule in order to pool their resources for joint trial

§19 Implications (II)

- Patentees may seek out a venue with wide-ranging jurisdiction, *e.g.*, Delaware where a large number of companies are incorporated
- Patentees may resort to ITC proceedings where all parties alleged to import infringing products may be included as respondents in a single investigation
 - While previously viewed as a poor choice for NPEs, recent case law allows for complainants whose only domestic industry in the patents is a licensing program

§19 Implications (III)

- The new rule may have the unintended consequence of unfairly limiting the ability of practicing entities, especially small companies, to efficiently seek a remedy against multiple infringers because of the increased cost of suing, and maintaining actions against, each infringer separately
- Maintaining judicial efficiency and economy
 - Multiple lawsuits involving the same patents in different venues across the country could result in duplicative activities and inconsistent rulings

Challenges to Validity

- §6 Post-grant Review Proceedings
- §15 Best Mode Requirement
- §18 Transitional Program for Covered Business Method Patents

§6 Post-grant Review Proceedings

- *Inter Partes* Review (“IPRv”)
- Post-Grant Review (“PGRv”)
- Citation of prior art and written statements (CPAWS)
- Reexamination (“Reex”)

Comparison of Reviews

	Reexamination	<i>Inter Partes</i>	Post-grant	TPCBM
Conducted By	Central Reexamination Unit (CRU)	PTAB	PTAB	PTAB
Filing Timing	Any time during enforceability	After 9 months post-issuance	Before 9 months post-issuance	After patent assertion
Threshold Question	Substantially new question	Reasonable likelihood	More likely than not	More likely than not
Duration	Indeterminate	Within 12/18 months	Within 12/18 months	Within 12/18 months
Grounds for Challenge	Patents / printed publications	Patents / printed publications	35 USC §§ 101–112	35 USC §§ 101–112
Recourse from PTO	From CRU to PTAB to Federal Circuit or D. Ct	From PTAB to Federal Circuit or D. Ct	From PTAB to Federal Circuit or D. Ct	From PTAB to Federal Circuit or D. Ct
Estoppel: Petitioner & Privies	None	Issues raised or reasonably could have been raised	Issues raised or reasonably could have been raised	Issues actually raised
Estoppel: Patent Owner	None	None	None	None

Judicial Recourse

- Two non-redundant, mutually exclusive routes for seeking judicial relief from adverse PTAB decisions on the merits:
 - Direct appeal to the Federal Circuit
 - Civil action by losing party against prevailing party for *de novo* adjudication in district court venue where both parties reside, e.g., EDNY, or in EDVA (venue of the PTO)

§15 Best Mode Requirement

- AIA eliminates the failure to disclose best mode in a patent as a basis for an invalidity defense
- 35 USC § 112 was not changed by AIA
 - Disclosure of best mode is still an administrative (PTO) requirement in patent applications
- Might signal Congress' desire to completely eliminate Best Mode in the future or to shift burden to PTO

§18 Transitional Program for Covered Business Method Patents

- Uncodified procedure in PTAB for revocation of CBMPs
 - What is a CBMP?
 - “A patent that claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.”
 - Applicable only to abstract business concepts and their implementation, not to inventions relating to computer operations for other uses or the application of the natural sciences or engineering
 - “Technological invention” defined by PTO rulemaking for case-by-case consideration

TPCBMP

- Only available to a real party-in-interest (RPI) who is “sued for infringement” or “has been charged with infringement” such that a DJ action could be brought
- Grounds for revocation of CBMPs
 - For first-inventor-to-file patents: any ground
 - For first-to-invent patents: prior art in old § 102(a)

Why TPCMBP?

- Aimed at reducing the burden of litigating patents of dubious validity that are presumptively intended to cover long-standing banking practices
- Key Provision—allows use as prior art non-published evidence of knowledge or use of the alleged invention before the patent application filing date
 - Such evidence not allowed in reexaminations (prior art is limited to patents and printed publications)

Defenses

- §5 Defense to Infringement Based on Prior Commercial Use ("PCUD")
- §12 Supplemental Examination
- §16 Marking
- §17 Advice of Counsel

§5 PCUD

- Amends 35 USC § 273 to expand the PCUD beyond business method patents to include any type of patent that was “used in manufacturing or other commercial process”
- Intended to promote manufacturing in the US
- Must be based on “good faith *commercial use*”
- Defendant must clearly and convincingly demonstrate commercial use in the US

PCUD and Trade Secrets

- A PCUD enhances the value of trade secrets
- Evidence supporting a PCUD includes contemporaneous documentation of the prior user's invention and development
 - Therefore, invention records and records of internal commercial activities may still be necessary despite change from first-to-invent to first-to-file

§12 Supplemental Examination

- “SExam” intended to mitigate the inequitable conduct defense
- Only the patent owner can request and participate in SExam whereby the PTO will “consider, reconsider, or correct [any] information” [35 U.S.C. §§ 101-103; 112] believed by the patentee to be relevant to each claim such that it might have affected the allowability of the patent application.
 - Up to 12 items per request
 - No limit on the number of SExams that can be filed
- SExams are non-contested cases

§16 Marking

- Intended to mitigate *qui tam* actions for false patent marking
- Applies to all federal district court cases pending after 9/15/11
 - Virtually every pending false marking case has been or will be dismissed
- “Virtual Marking” – Amend 35 USC §287(a)
 - Can now mark with “Patent” or “Pat.” and a website address that associates the patented article with the patent number(s)
- “False Marking” – Amend 35 USC §292(a)-(b)
 - Henceforth actionable only by Federal Government (\$500/article)
 - A party who suffered “competitive injury” from false marking may only claim *actual damages*
 - Marking with an expired patent is not a violation

§17 Advice of Counsel

- Relates to Willful Infringement
- Applies to patents granted after 9/15/12
- New 35 USC § 298
 - “The failure of an infringer to obtain the advice of counsel with respect to any allegedly infringed patent, or the failure of the infringer to present such advice to the court or jury, may not be used to prove that the accused infringer willfully infringed the patent or that the infringer intended to induce infringement of the patent”

What Today's Inventors, Investors, and Entrepreneurs Need to Know
about the New Patent Act

TAKE-AWAYS

Patent Strength

- File early and (perhaps) often
 - Multiple provisionals if invention changes or improves
- ***Always*** include claims
 - Even in provisional applications
- Support claims fully in description
- Know your prior art
 - Address the best in your application

Proving Infringement

- Review validity requirements
- Address any potential inequitable conduct issues before the USPTO in SExamination
- Claim physical things when possible
- Claim so that only a single actor is required for infringement
- Include a range from broad to narrow, “picture” claims

Forum Considerations

- Where do I have standing?
- Where do I have jurisdiction over the other party?
- Can this forum provide the relief I am seeking?

Pre-filing Considerations

- Initial Pleadings
 - Patent Owner
 - Alleged Infringer
- Venue
 - District Court
 - International Trade Commission
 - *Inter Partes* review (IPR) or CBM review in PTO
- Joinder

Initial Filing: Accused Infringer

- Accused infringer files preemptively or in response
- Where to file
 - Counterclaim / defense in District Court or ITC
 - *Inter Partes* review (IPR) or Covered Business Methods (CBM) review in US Patent and Trademark Office (USPTO) Patent Trial and Appeal Board (PTAB)

Party Considerations

- Who are proper parties to suit?
- New joinder considerations

Post-filing Considerations

- Stays
- Contentions
- *Markman* (Claim Construction)

Contentions

- Are pleadings enough?
- What limits do local court rules place on contentions?

Claim Construction Standards

- PTAB
 - “broadest reasonable construction in light of the specification of the patent in which it appears”
- District Court
 - “ordinary and customary meaning ... the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention”

Litigation Plan

- Obtain advice of counsel early in the process
- Consider possible litigation strategies and goals during patent drafting or designing around
- Determine if a PCPP Court is in play
- Address any weakness at the USPTO level in Reexam or SExam proceedings
- Review local rules
- Get your Technical Expert on board and involved early in the process
- Choose the forum, venue and parties wisely
- Plan your e-discovery early, before filing, if possible

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QUESTIONS?

BIOGRAPHIES



Alan M. Sack, Esq.

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Experience

Alan Sack is a Registered Patent Attorney and an experienced intellectual property attorney. A graduate of MIT and the Benjamin N. Cardozo School of Law, Alan helps his clients protect their patents, copyrights, trademarks and trade secrets in disputes before district courts across the United States, the United States Patent and Trademark Office (US PTO), as well as before the United States International Trade Commission (US ITC). He has served as lead and associate counsel in numerous patent, trademark, unfair competition and copyright litigations and has also mediated intellectual property disputes.

In the realm of patent law, Alan handles patent and design patent litigation matters before U.S. district courts, and *inter partes* matters before the US PTO, including patent appeals, reissues, reexaminations, and post-issue review proceedings. He also counsels clients on patent preparation and infringement matters, and has extensive experience in the preparation, prosecution, and appeals of patent applications before the US PTO in a broad spectrum of technologies and designs. He is experienced in patent and copyright protection of technologies relating to computer sciences and business methods, as well as nanotechnology, biotechnology, medical devices, imaging, LED lighting, mechanical devices, energy storage, radiation detection, superconductors, computer sciences, signal processing, iontophoresis and chemical technologies, waste treatment, polymer molding and processing, chemical engineering, petroleum processing, films, fluid handling, and business methods. Alan also has successfully overseen opposition proceedings before the European and Japanese Patent Offices, and handles licensing negotiations and preparation of license agreements.

Alan is experienced in trademark, unfair competition, and trade secret litigation in the U.S. district courts, and opposition and cancellation proceedings before the US PTO. He routinely counsels clients in adoption and clearance of trademarks and service marks and the protection of trade secrets, as well as U.S. and foreign trademark filing, prosecution, opposition, and appeals. His practice also encompasses counseling and negotiation of branding and advertising transactions. He advises clients regarding protection and use of trademarks in advertising and product packaging, advertising claims, and the use of appropriate marking of patents and registered trademarks on product packaging and brochures. Alan has extensive Trademark, Copyright, Trade Secret & UC protection, Counseling, Licensing, and Litigation experience in the Apparel, Banking, Entertainment, Fabrics, Food, Footwear, Gaming, Music, & Restaurant industries. Alan has been a longtime member of the International Trademark Association (INTA) and an active member of the Trade Name Subcommittee of the Trademark Enforcement Committee of INTA. Alan has also handled a variety of copyright and entertainment related litigation, registration and counseling matters, and has litigated software and television copyright infringement actions in U.S. district courts and before the US ITC.

Alan M. Sack

In a recent US ITC investigation, Alan and his team prevailed on summary determination in an investigation involving a children's television show. The ITC's Administrative Law Judge (ALJ) found lack of substantial similarity between the accused television show and the copyrights asserted in the investigation. Alan has also handled matters related to copyright infringement actions in the music industry and been successful in taking down infringing content for music posted on various Internet websites under the Digital Millennium Copyright Act. (DMCA). He has also successfully conducted arbitrations under ICANN's Uniform Domain-Name Dispute-Resolution (UDRP) arbitration procedures.

Alan is a member of the Federal Bar Association and is part of a team of three senior patent litigators that has taken on an initiative to provide the district courts designated to participate in the Patent Cases Pilot Program (PCPP) with a series of in-depth and interactive multi-session presentations on the relevant substantive and procedural aspects of the Leahy-Smith America Invents Act. The sessions look at the how the new patent act affects the conduct of patent litigations before the U.S. district courts and the interplay between district court litigation and the new post-registration proceedings before the USPTO. Alan and his colleagues have presented before the judges, magistrate-judges and law clerks of the Southern District of New York, and the Eastern District of New York and have contributed to the drafting of the local patent rules that are shared by these courts.

Before SACK IP

During his career, Alan has been a partner at the law firms of Fox Rothschild, LLP and Hoffmann & Baron, LLP, as well as of counsel at Morgan & Finnegan, LLP and Locke Lord, LLP.

Alan was an Alexander Fellow at the U.S. Court of Customs and Patent Appeals and the U.S. Court of Appeals for the Federal Circuit in 1982.

Recent Speaking Engagements and Presentations

- Panelist, "Discussion on Local Patent Rules, Discrete AIA Litigation Issues, Interplay of Different Fora in which to Litigate Patent Disputes," New York Intellectual Property Law Association: The Rapidly Changing Patent Law Landscape: What Entrepreneurs, Investors, Inventors, Lawyers and Judges Need To Know, Troy, NY (April 15, 2015)
- Lecturer, "AIA and PCPP Legislation and Impact on District Court Patent Litigation," Before the Southern District of New York (2013)
- Lecturer, "AIA and PCPP Legislation and Impact on District Court Patent Litigation," Before the Eastern District of New York (2013)
- Speaker, "Internet Advertising Law Green Deceptive Advertising Law," The Essentials of Advertising & Marketing Law, Chicago, IL (September 13, 2010)
- Speaker, "2010 Advertising and Marketing Law: Emerging and Hot Topics," New York, NY (May 13, 2010)



Kimberley Elcess, PhD, MBA

Registered Patent Agent and Licensing Professional

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Experience

As a registered patent agent, Dr. Elcess works with innovators to define and protect their inventions. From the initial stages of drafting a patent application, through prosecution before the United States Patent and Trademark Office (US PTO) and the World Intellectual Property Organization (WIPO), she secures exclusive rights to the invention for our clients.

Kimberley's areas of technical expertise include nanotechnology, biotechnology, medical devices, imaging, mechanical devices, energy storage, electrochemistry, radiation detection, superconductors and superconducting devices, thermoelectric materials and devices, and other fields of solid state physics and chemistry.

Dr. Elcess is also a Certified Licensing Professional (CLP) who is experienced in licensing transactions for our clients, monetizing their intellectual property assets.

She has lived, worked, and studied in more than ten countries on four continents. A native speaker of English, Kimberley can also conduct business in French and Spanish.

Before SACK IP

Most recently, Dr. Elcess was a licensing specialist and patent agent for the US Department of Energy's Brookhaven National Laboratory where she drafted and prosecuted patent applications, negotiated patent licenses, and supported local entrepreneurship.

Prior to her experience at Brookhaven, Dr. Elcess worked for a boutique intellectual property firm in Austin, TX.

She also spent a decade after business school as a strategic management consultant, gaining business valuation, negotiation, and leadership skills. Working largely in international and intercultural environments, she helped clients make better investments by applying the principles and techniques of decision analysis. Many of her clients were pharmaceutical companies managing intellectual property assets and drug pipelines.

Early in her career, Dr. Elcess worked as a scientist studying the surface properties of compound semiconductors useful for optical communications and developing methods for producing thin films of high-temperature superconductors. She is also a veteran of a Silicon Valley startup that went public.

Kimberley Elcess

Publications

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