

# GERALD T. WELCH

PRINCIPAL / DALLAS METRO OFFICE

Jerry is known and valued for legal counsel that supports his client's vision and is delivered both *on time* and *on budget*. Persistent and dedicated to establishing and maintaining a foundation of trust with each client, Jerry continuously cultivates the right team of lawyers needed to deliver *ongoing and complete client satisfaction*.

Jerry prepares and prosecutes complex patent applications, negotiates and documents technology-related transactions, and is involved in a variety of litigation matters. With more than three decades of experience advising corporations at all levels of activity in the U.S., Asia and Europe, Jerry develops strategies that integrate his clients' IP into their overall commercial agenda.

## PRACTICE AREAS

Patents; IP Litigation; IP Transactions; PTAB Proceedings

## INDUSTRIES

Medical Devices; Energy Production & Delivery; Image Processing, Lasers & Optics; Semiconductor Processing & Devices; Telecommunications & Wireless Technology

## KEY MATTERS

- Kodak's "Battery Tester" on Duracell Batteries: Represented Kodak in an exclusive license offering to battery manufacturers to manufacture a battery label with an integrated tester that culminated in the grant of an exclusive license to Duracell for a product that became pervasive in the market
- Ethicon's "Gastric Binding" for the Morbidly Obese: Represented inventor in an exclusive license offering of technology relating to laproscopically inserting a "belt" around the stomach and tightening the belt to effectively reduce the size of the stomach; this exclusive offering culminated in the assignment/sale of the technology to Ethicon (Johnson and Johnson) for consideration including a substantial cash payment (eight figures), assumption of several litigations relating to the patents and comprehensive indemnifications
- Arbitration Related to MRI Licenses: Represented a small medical



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company regarding the prior divestiture of its MRI division to one of the major medical equipment manufacturers under a contract that included an indemnification provision being disputed in the arbitration; a key issue was the scope and value of the patents covering the MRI technology developed by others in the industry that required a review of many of the patents, related licenses and other documents. After the discovery of key undisclosed licenses based on the email message which established the market value of the relevant patents, the arbitration proceeding was dismissed on the same day that senior managers were to be deposed

- Conducted a patent audit and analysis of a patent portfolio of 200 patents relating to spatial light modulator technology in conjunction with a potential acquisition by the client
- Evaluated the strength of semiconductor patents to be asserted against client's competitor so that the client was prepared to handle defenses of invalidity and unenforceability
- Conducted a clearance study of over 150 optical mouse patents within a two-month period to clear the potential introduction of a new project on a worldwide basis
- Out-license "lens-molding" technology and related trade secrets to Japanese company for manufacturing glass lens for cameras and other products to be distributed worldwide
- Out-license new "synthetic fuel additive" technology with option for exclusive rights after technology is further developed and evaluated for commercial feasibility
- Technology development of "tungsten composite" material as a substitute for lead, which culminated in the manufacturing of "green" bullets for sale to the U.S. Army so that target ranges would be friendly to the environment
- Technology development of "light-emitting diode" devices for use in printers so that they emit a specific frequency of light more closely matching that required for the printer paper

## NEWS/EVENTS

### PRESENTATIONS

- "Patent Prosecution," Module Chair, 54th Annual Conference on Intellectual Property Law, Institute for Law and Technology, November 2016
- "IP Compliances With Sarbanes-Oxley," Speaker, 21<sup>st</sup> Annual IP Law Course, State Bar of Texas, Austin, TX, March 2008
- "IP in Mergers and Acquisitions," Panelist, 5<sup>th</sup> Annual Rocky Mountain Intellectual Property and Technology Institute, Westminister, CO, June 2007
- "Developing New Technology Outside the Company," Speaker, 4<sup>th</sup>

Annual Rocky Mountain Intellectual Property and Technology Institute, Westminister, CO, June 2006

- “Technology Development Strategies,” Speaker, 12<sup>th</sup> National Conference on Licensing Intellectual Property, Chicago, IL, June 2000
- “Technology Development Agreements,” Speaker, Dallas LES Meeting, Dallas, TX, March 1999
- “International Technology Development Agreements,” Speaker, 12<sup>th</sup> Annual Computer and Information Law Group, Dallas, TX, September 1998
- “The Future of Private Practice: Is Specialization the Way to Go?” Speaker, AIPLA Annual Meeting, Washington, D.C., October 1997

## **IN THE NEWS**

- Harness Dickey Launches Dallas Office Led by New Principal Gerald Welch, March 12, 2015

## **PUBLICATIONS**

- “Spring Institute: IP Due Diligence in Joint Ventures,” *American Intellectual Property Law Association*, 2003
- “Mid-Winter Institute: Protection of Technology Developed Outside the Company,” *American Intellectual Property Law Association*, 2002
- “The Federal Circuit Further Narrows the Scope of Patents,” *Corporate Counsel*, June 2001
- “Outsourcing Technology Development — for Profit,” *Dallas Business Review*, September 1995

## **ARTICLES**

- Jerry Welch Provides Keys to a Successful Technology Development Partnership in Licensing Journal Article
- Jerry Welch Emphasizes Need for Development Agreements in New Article
- “Challenges of 2004 — Opposition to Patent Peddlers Grows,” *Intellectual Asset Management*, 2004

## **BACKGROUND**

Jerry develops patent portfolios based on internal invention and external development programs. He negotiates and prepares a variety of technology transactions, such as agreements involving

evaluation, consulting, technical service, R&D, website hosting, supply and distribution, outsourcing and asset purchasing, joint ventures and software licensing. Additionally, Jerry advises on the establishment of IP systems, reporting structures and “standard agreement” packages to help clients better comply with the requirements of Sarbanes-Oxley.

Jerry is also involved in conducting technology audits and evaluations of target and third-party assets for M&A, licensing and similar transactions, as well as structuring and conducting worldwide licensing-out programs to generate *millions of dollars* from idle technology, including the licensing of patents, trade secrets and proprietary know-how. In addition to advising large, international companies, Jerry works with emerging companies regarding their strategic creation, exploitation and management of IP assets, and in creating programs to implement such objectives.

### **PRIOR EMPLOYMENT**

Jerry previously served as the Director of Licensing and Technology Development at Eastman Kodak Company, and prior to that as Vice President and General Counsel of M&SD Corp., which was acquired by EDS.

He also served in the U.S. Air Force (1971-1977) as an Avionics Engineer on the B1-A program, and later in the Office of the Judge Advocate General.

### **AWARDS & DISTINCTIONS**

- *Best Lawyers*, Patent Law “Lawyer of the Year” in Dallas-Fort Worth, 2019
- *Best Lawyers*, Litigation — Intellectual Property, 2012-2019
- *Best Lawyers*, Patent Law, 2019
- *Texas Super Lawyers*, Intellectual Property, 2005-2018
- *Best Lawyers*, “Copyright Lawyer of the Year” in Dallas, 2015
- Martindale AV Rating
- Dallas Bar Foundation, Sustaining Life Fellow
- Distinguished Law School Alumni, Toledo Transcript, June 2001

### **MEMBERSHIPS**

- Institute for Law and Technology, Conference Planning Committee
- Licensing Executives Society, Dallas Chapter, Founder
- American Bar Association, IP Section
- American Intellectual Property Law Association, Management of Intellectual Property Assets Committee, Chair, 2001-2003
- University of Toledo, College of Law, Dean’s Advisory Council
- Dallas/Fort Worth USO, Advisory Committee

**EDUCATION**

J.D., University of Toledo, 1979

M.B.A., *magna cum laude*, University of Utah, 1974

B.S.E.E, University of Notre Dame, 1971

**BAR & COURT ADMISSIONS**

New York

Texas

U.S. Court of Appeals for the Federal Circuit

U.S. District Court for the Eastern District of Texas

U.S. District Court for the Northern District of Texas

U.S. Patent and Trademark Office