



JASON SAUNDERS
CURRICULUM VITAE

PROFESSIONAL SUMMARY

Seasoned Intellectual Property attorney with over 20 years of experience in patent, trademark, copyright, and trade secret law. Skilled in managing diverse portfolios and advising businesses from startups to established enterprises. Strong background in physics and mathematics enhances technical patent expertise. Proven track record of guiding clients through complex issues, including:

Lead Counsel in litigation asserting IP rights and defending against such assertions

Developing and managing patent and trademark portfolios

Risk management (including evolving/growing business/product risk and due diligence in the acquisition of IP)

Negotiating and preparing joint development, assignment, non-disclosure/confidentiality, license, and master services agreements.

EXAMPLE TRANSACTIONAL MATTERS

- Building and maintaining portfolio of over 250 issued patents for an oilfield tool company
- Building and maintaining portfolio of over 30 issued patents and filed applications for a seabed mining company
- Building and maintaining portfolio of over 20 trademarks and over 130 copyright filings for a business consulting group
- Building and maintaining portfolio of over 40 trademarks for an oilfield tool company
- Counsel and assist many start-up companies in developing and implementing intellectual property strategies to meet identified business goals efficiently
- Representing genetically modified therapy client in negotiating business resolution with leading medical school/hospital group
- Counsel and assist clients through evaluating and negotiating acquisitions of outside innovation from small businesses, major corporations, and defense contractors
- Counsel and assist clients through evaluating and negotiating joint technology development agreements, including in the oilfield, high tech, and consumer goods spaces
- Counsel and assist clients through evaluating risk and negotiating master services agreements with major oil production companies
- Counsel clients through evaluation of potential assertion of IP rights against competitors, including evaluation of risk and budgeting

EXAMPLE LITIGATION MATTERS

- Representing offshore engineering client in defending patent infringement allegations, including appeal to Federal Circuit
- Representing oil tool client defending patent infringement allegations through verdict of no infringement at trial
- Lead counsel on appeal to Federal Circuit Court from Precedential Opinion Panel of the Patent Trial and Appeal Board
- Lead counsel on appeal to the Precedential Opinion Panel of the Patent Trial and Appeal Board
- Lead counsel in Inter-Partes Reexam before the Patent Trial and Appeal Board invalidating all claims of a downhole oil tool patent
- Lead counsel successfully defending downhole oil tool company against patent infringement allegations
- Lead counsel on appeal to the Federal Circuit successfully defending patent invalidation by the Patent Trial and Appeal Board
- Lead counsel in Inter-Partes Reexam before the Patent Trial and Appeal Board invalidating an oilfield expandable tubular patent
- Managing international trademark litigation defense for oilfield client
- Lead counsel defending numerous clients against non-practicing entity patent assertions in various Texas federal courts, including in SASS, LED lens, consumer goods, and other fields
- Representing genetically modified therapy client in defense of patent infringement allegations

EXAMPLE LITIGATION MATTERS (CONT.)

- Representing oilfield tool company in successfully defending and resolving patent infringement allegations through trial
- Representing telecom infrastructure client in defending patent infringement allegations through bankruptcy estimation
- Representing seismic industry client in successfully defending and resolving patent infringement allegations, including managing massive multinational discovery scope and spending a week on a seismic survey vessel with expert witness
- Lead counsel representing oilfield tool company in successfully defending and resolving patent infringement allegations
- Lead counsel representing safety equipment seller in successfully defending and resolving trademark infringement and cybersquatting allegations
- Lead counsel successfully defending UDRP proceeding
- Represent business owner in successful corporate IP theft enforcement action, including discovering and building evidence of falsification of documents
- Local counsel in many cases in the Eastern District of Texas
- Lead counsel representing telecom client in enforcing and licensing patent rights
- Represent navigation systems client in enforcing patent rights
- Represent encryption client in enforcing patent rights
- Represent electrical signal processing client in enforcing patent rights

PROFESSIONAL EXPERIENCE

Partner

Saunders McKeon PLLC (previously Arnold & Saunders, LLP)— Houston, TX
April 2008 – Present

- Lead strategic development and implementation of IP solutions for clients across a range of industries.
- Oversee preparation and prosecution of patent, trademark, and copyright applications.
- Represent clients in litigation concerning infringement and misappropriation of IP rights.
- Advise clients on IP asset acquisition, development, management, licensing, and enforcement.
- Built and managed long-term client relationships through tailored legal strategies and advice and consistent results.
- Mentored junior attorneys in patent and trademark law and litigation practices.
- Developed business accounting and docket management systems

Associate Attorney

Goldstein, Faucett & Prebeg, L.L.P. — Houston, TX
2003 – 2007

- Conduct patent litigation, including pre-litigation investigations, written and deposition discovery, claim construction briefing and hearings, motion practice, including motions for summary judgment and appeal, trial support.
- Draft Federal Circuit Court of Appeals briefs.
- Support clients in enforcing and defending IP rights, particularly in electrical, mechanical, and software fields.

EDUCATION

University of Houston Law Center — Houston, TX
Juris Doctor (J.D.), Intellectual Property Law
2000 – 2003
Activities: Moot Court, Mock Trial

Baylor University — Waco, TX
Bachelor of Science, Physics and Mathematics
1996 – 2000

BAR ADMISSIONS

- State Bar of Texas
- United States Patent and Trademark Office (USPTO)
- United States District Court of Appeals for the Federal Circuit
- United States District Court of Appeals for the Fifth Circuit
- United States District Court for the Southern District of Texas
- United States District Court for the Eastern District of Texas
- United States District Court for the Western District of Texas

ADDITIONAL AFFILIATIONS/EXPERIENCE

Member

- The Honorable Nancy F. Atlas Intellectual Property American Inn of Court
- Houston Intellectual Property Law Association
- International Trademark Association
- American Intellectual Property Law Association
- Advisory Board member for Rice University Professional Science Masters program, focused on Bioscience and Health Policy track.
- Conference speaker on advanced patent litigation topics
- Regular guest lecturer on intellectual property for Rice University engineering graduate students
- Regular speaker on IP for startup accelerators
- Rice Business Plan Competition judge
- Moot Court judge
- Technical research at railgun laboratory
- R&D on light gas gun range project for space physics laboratory
- Technical writing at digital imaging technology company
- Marketing and coding work at dot com legal business
- Contract review work with defense contractor
- Elected board member for utility district
- BSA volunteer leadership including as cubmaster and scoutmaster
- Youth sports coach, positive coaching alliance
- Hands-on science program volunteer at schools
- School campus improvement team member