

PATENT OWNER EXHIBIT 2007

PERCIPIENCE

WHENEVER IP IS CENTRAL

Expert Declaration and Report of Suzanne Harrison

May 18, 2021

I. INTRODUCTION

A. Engagement

I, Suzanne Harrison, being competent to testify and having personal knowledge of the facts recited below, or otherwise able to form opinions based on facts provided by others as discussed below, declare as follows. I have been engaged by Flachsbart & Greenspoon, LLC, counsel for 10Tales, Inc. to prepare a report on whether there is economic justification for the United States Patent & Trademark Office (USPTO) Director to 35 utilize U.S.C. § 316(b) to consider discretionary denial of this Patent Trial & Appeal Board (PTAB) proceeding.

B. Qualifications & Compensation

I am the Founder of Percipience, LLC which is an advisory firm focused on intellectual property (“IP”) strategy and management, quantifying and mitigating IP risk, and increasing IP value. I have over 30 years of experience in the field of IP management (“IPM”), IP management decision making and IP valuation. My work as a consultant has included designing IPM decision systems, IP valuation, negotiating and conducting IP transactions, assessing technology commercialization options, and helping to improve IP management decisions. My work has been conducted for companies (both large and small companies and both public and private companies). All of my consulting work for companies has been focused on increasing the realized value of their IP assets and decisions.

In addition to consulting with companies, I have also worked for several International Patent & Trademark Offices (“PTOs”). For example, I led a project to create a valuation methodology to allow banks to collateralize intellectual property for the Malaysian Patent & Trademark Office (“PTO”). This required working knowledge of banking and financial regulations as well as International Financial Reporting Standards (IFRS). For the Danish PTO, I interviewed a number of small international patent offices and created a set of best practices and strategies for International PTO’s to more effectively help small to medium enterprises (“SMEs”) compete in the global marketplace through better utilization of their IP.

In addition to IP valuation, I have a deep background in finance and am well versed in accounting principles. Prior to Percipience, I worked at Inflexion Point Strategy, the first IP investment bank, providing IP transaction assistance. Before that job, I was the CEO of Gathering2.0, a start-up platform looking to make IP transactions more efficient and transparent. Prior to Gathering2.0, I co-founded the first IP management consulting firm, Intellectual Capital Management Group (“ICMG”), which had a four-year exclusive alliance with the accounting firm Arthur Andersen. During that time, I routinely conducted IP valuation and IP management consulting projects. Prior to ICMG, I worked in the Mergers & Acquisitions (“M&A”) group at Coopers & Lybrand. Prior to that position, I was a Financial Analyst for Hewlett Packard where I was responsible for providing financial guidance in Research & Development (“R&D”) decision-making.

I am also the co-founder of the *Gathering*, an IP management best practices group consisting of senior IP thought leaders (individuals are generally executives in the legal, R&D, licensing, and other business functions of their companies) from 15-plus major companies all of which are actively engaged in increasing the value of their IP and Intellectual Assets (“IA”). The *Gathering* stories and IP best practices have been codified in the “*Edison in the Boardroom*” series of books as well as another book “*Einstein in the Boardroom*”. The *Gathering* is responsible for identifying and creating numerous best practices in the areas of IP management, IP valuation, IP risk quantification and mitigation, and IP monetization. The *Gathering* has been meeting continuously since 1995.

I have written two books on how to get more value out of intellectual property assets, *Edison in the Boardroom* and *Edison in the Boardroom Revisited*. I have also written a book on how to get more value out of non-IP intangible assets entitled *Einstein in the Boardroom*. I have also been a visiting lecturer on IP Management at the Haas School of Business at U.C. Berkeley.

A substantial part of my work experience as a thought leader in intellectual property management has been the creation of the underlying principles of IP valuation and the intersection between IP management and accounting. For ten years the Canadian

Institute of Chartered Accountants (CICA) was a member of the ICM Gathering, and, during that time, I worked with them to create and explain the notion of value streams and context in IP valuations. A large part of my work with the CICA was around the exploration of how best to reflect intangibles on a company's balance sheet.

Accounting looks backward at historical costs, while intangibles are about value realization in the future. These two concepts are inherently at issue with each other. Yet as more and more of a firm's value was derived from intangible assets, as opposed to tangible assets, it became imperative that financial statements reflect this new value to give stakeholder's a more accurate view of company value and risk. I participated in a U.S. Securities and Exchange Commission ("SEC") hearing on the matter, and also helped the CICA structure and provide guidance to international accounting standards bodies on the matter.

I have also served as an expert witness in cases in federal, state, tax and bankruptcy courts. My testimony has covered damages, IP valuation, IP management processes, and organizational design.

- *Heather Alisha Davis vs. Brouse McDowell*, Case No. 2008-01-0311 in the Court of Common Pleas, Summit County, Ohio. Provided expert report and deposition testimony related to calculating patent damages on behalf of Heather Alisha Davis.
- *ASML U.S. Inc. vs. Xtal Inc.*, Case No. 16-CV-295051 in Superior Court of California, Santa Clara. Provided expert report, deposition testimony, and jury trial testimony, related to trade secret damages and intellectual property management processes on behalf of Xtal Inc. Trial date was November 2018.
- *Gore Enterprise Holdings Inc (Petitioner) vs. Comptroller of the Treasury (Respondent)*, in Maryland Tax Court October 2008. Case No. 07-IN-00-0084. Provided expert report, deposition testimony, and bench trial testimony relating to IP management processes and differentiating between patent management companies that are shams from those having economic substance on behalf of Gore Enterprise Holdings Inc.

- *David E. Lewis, Chapter 7 Trustee vs. Health Trio, LLC; Malik M. Hasan; and Seeme Hasan*, Case No. 09-34404 HRT in Colorado Bankruptcy Court. Provided expert report and deposition testimony related to patent application transactions and valuation on behalf of Malik M. Hasan.
- *Just Goods, Inc vs. Just, Inc. F/K/A Hampton Creek, Inc.*, Case No. 18-CV-02198-WHO, I.S. District Court, San Francisco Division. Provided expert report and deposition testimony related to financial statement analysis regarding profitability for disgorgement on behalf of Just, Inc.

My curriculum vitae, attached as **Appendix A**, provides further details regarding my professional experience, as well as my publications.

I was retained by Flachsbart & Greenspoon, LLC as an expert on an hourly basis. My rate is \$750/hour. My fee is not contingent on any outcome, and I do not have any personal stake in the outcome of this case.

C. Scope of Work

Counsel for 10Tales, Inc. retained me in April 2021 in connection with this matter. The scope of my work has included the following tasks:

- To assess whether there is enough information to reasonably conclude that the Chinese government is currently running an Innovation Warfare strategy against the United States, and whether such a strategy could involve TikTok, Inc.
- Determine whether there is an economic justification for the USPTO Director to invoke a 316(b) discretionary denial based upon the facts of this case.

D. Information Considered

Prior to preparing this report, I reviewed materials produced in connection with this matter, court pleadings, and publicly available information. This includes the Petition, the 10Tales

'030 Patent, and materials cited herein.

E. Summary of Opinions

My opinions, which I hold and express to a reasonable degree of professional certainty as an Expert Witness, are as follows:

1. Based upon my review of a number of publicly available government documents, reports, news stories, and other materials from the White House, Department of Commerce, Intelligence agencies, judicial proceedings, and others, it is clear that the U.S. government is worried that the Chinese government and the Chinese Communist Party (CCP), are currently working to acquire strategic U.S. technologies and associated intellectual properties, through both legal and illegal means in order to destabilize our nation economically, technologically and threaten our national security.
2. Given their commitment to running an Innovation Warfare strategy against the United States, there is reasonable evidence that TikTok, Inc. and its parent company ByteDance Ltd. are instrumentalities for the CCP in this effort and they are not acting as purely private enterprises, but rather acting as agents on behalf of the Chinese government.
3. To help the PTAB ascertain whether there are issues at play in this proceeding beyond invalidity questions, a multi-factor test was created and should be utilized by the Director (through PTAB judges) to address situations where an instrumentality of an Innovation Warfare adversary might be attempting to use the PTAB as part of a "legal" strategy that destabilizes our nation (I address what "Innovation Warfare" is in connection with my co-authored paper below).
4. The outcome of the multifactor test suggests the USPTO Director should discretionarily deny a PTAB proceeding in order to ensure compliance with current U.S. IP policy as clearly articulated from the White House, Department of Commerce, Intelligence agencies, and other federal agencies. The public policy concerns of investing in a federal agency the adjudication of patent validity issues at

the behest of an Innovation Warfare adversary has economic, technological, and national security concerns for our citizens and nation. The nature of this decision, is larger than mere validity as such, so that this matter should yield to an Article 3 court who can more effectively utilize judicial processes to balance more fully the actions and objectives of the CCP versus the general public policy in favor of removing the economic force of potentially invalid patents from the market economy. That is, in the case of TikTok and its parent, a court (but not the PTAB) can better ensure through its sanction and evidentiary exclusion power that TikTok brings its invalidity contentions as a good faith actor in our economic system, willing to participate in full discovery as a party in federal court, complying with all discovery obligations to plumb the truth of whether infringement liability should attach.

II. PATENTS AS A BUSINESS VALUE DRIVER

For many companies' intellectual property, and specifically patents, are a strategic element of their business. For these companies, the Chief Intellectual Property Officer (CIPO) has two primary objectives. The first is to maximize the value of the company's patents to its business; the second is to mitigate the risks associated with ownership of patents.

Through my work with the ICM Gathering (an IP best practices group) over the last 30 years, I have learned that there are a wide variety of ways that companies obtain value from their intellectual property. Companies often ascribe several roles for value extraction from their IP. While most people tend to think quickly of the revenue-generating role, there are a range of others that are often employed as well. Table 1¹ represents some of the most often cited ones. In my experience, companies often have several roles for IP at any given time. This ensures that there is attention given to creating both decision processes and organizational structures to ensure that the value for IP is realized as intended. While revenue generation and cost reduction are perhaps two of the more common roles for IP and patents in particular, strategic position is often a bigger driver of value to the firm.

¹ Davis & Harrison, *Edison in the Boardroom*, John Wiley & Sons, 2001, pg. 101

Table 1

Use	Patents	Trademarks	Know-how	Relationships
Conflict Avoidance	- Protection (exclude others) - Design freedom - Cross-licensing (defensive) - Litigation bargaining power	Protection	Protection	N/A
Revenue Generation	- Products and services: sales, licensing, joint venture (JV), strategic alliance, optimization of core technology, non-core technology monetization, integration - Patents: Sales, licenses, litigation - Increased bargaining power - Market penetration - Increased speed to market	- Products and services: sales, licensing, JV, strategic alliance - Trademark: sales, licenses, co-branding, infringement policing	- Sales - Licenses - JV - Strategic alliance - Integration - Increased speed to market	Products and services: sales
Cost Reduction	- Litigation avoidance - Access to technology of others - Improved knowledge transfer - Reduced knowledge gaps	- Litigation avoidance - Access to technology of others	- Litigation avoidance - Improved knowledge transfer	Reduced marketing costs
Strategic Position	- Reputation / image - Competitive blocking (exclusivity) - Barrier to competition - Supplier control - Customer control - Optimization of core technology	- Name recognition - Customer loyalty - Barrier to competition - JV - Strategic alliance	- Reputation / image - Barrier to entry	- Reputation / image - Customer loyalty - Barrier to entry

Many business managers find it much easier to understand and quantify the reward aspect of the risk/reward equation but need help in both understanding patent risks and quantifying them so that Executives can make more informed business decisions. This of course begs the question, “What are the patent related risks”? There are three main types of patent related risks:

1. Innovation risk
2. Intrinsic patent risk
3. Environmental patent risk

Innovation risk is the risk involved in turning an idea into a saleable product or service than can be sold. The commercialization process consists of a number of steps involved in translating the initial product idea into a series of inventions, which then must be seamlessly integrated together into a set of technologies that must be further refined, and ultimately into a product. Examples of the elements of Innovation Risk are:

- Technology Risk – Will the technology ultimately perform as well as expected?
- Alternative/Disruptive Technology Risk – Will competitive commercial alternatives emerge? Will disruptive technology eliminate the need for the solution altogether?
- Adoption Risk – Even if the technology/innovation works, will it be accepted in the marketplace?

- Execution Risk – Will the company be able to commercialize the technology?
- Market Risk – If there is no current market for the technology, will a market evolve?
- Infringement Risk – Will the technology be covered by one or more third party patents

Environmental Patent Risk is the risk that an entity (either Judicial, Legislative or Regulatory) will change the rules of the system in a manner that will negatively impact patents. While environmental risk happens infrequently, it can be very impactful when it does happen. Examples in the patent world often involve Supreme Court patent decisions, Congressional decisions involving USPTO spending or patent reform, or FTC or ITC decisions.

Intrinsic Patent Risk is the legal risk associated with the patent and its prosecution. Here the risks are whether there is something in the patent prosecution history that would render the patent either unenforceable or limit its scope which could impact the potential value streams associated with the patent. A list of the major intrinsic patent risks is below;

- Invalidity Risk – Will previously unknown prior art surface that anticipates the patented invention or renders it obvious?
- Unenforceability Risk – Will a prosecution issue result in an inability to enforce the patent?
- Scope Risk – Will a court construe the claims narrowly or broadly?
- Design-Around Risk – Will competitors find a way to create commercial substitutes that avoid the claims?

Not surprisingly, the USPTO, PTAB and district courts are the ones who are most involved in arbitrating disputes relating to intrinsic patent risk. All three types of intellectual property risk are at play in the market ultimately determining the success or failure of new and emerging technologies. The ability of a company to bring a new product or service to market that utilizes technology and/or intellectual property is crucial to ensuring economic competitiveness of company and if this can happen at scale, for a nation.

III. Patents and Their Relationship to the Economy and National Security

We know that the health and security of nation states relies upon their National Competitiveness, however this term does not have a universal definition. At its most simplified form, the concept of “national competitiveness” examines the ability of a national economy to grow. However academics have had difficulty in agreeing on one overarching definition of this complex concept.

The main reason of the multiplicity of definitions of national competitiveness is the complexity of the term; its composite character; moreover, the system concept of the category itself. Competitiveness is a complex multidimensional concept. It reflects the favourable position of the national economy, mainly in the field of international trade and, at the same time, its ability to strengthen this position. On the other hand, the competitiveness of the national economy is a concentrated expression of economic, scientific, technological, organizational, managerial, marketing and other capabilities that are implemented in goods and services, successfully insuring their competing opposite foreign goods and services at the domestic and foreign markets. The national competitiveness is an ability of a state to achieve high rates of economic growth, ensure a steady increase in real wages, promotion of domestic firms on the world market represented by high-performance clusters that improve the quality of products and services that enable the creation of new jobs in the future. This competitive ability to adapt to changes occurring in the global market is based on following economic factors such as investment volume, innovation ability, manufacturing facilities, and others. However, their performance must be combined with political and social factors that also affect the functioning of the national economy in the world market. It is measured by a set of factors, policies, and institutions that determine a country's level of productivity.²

For purposes of this report, I am defining National Competitiveness as the sum of economic competitiveness, technological competitiveness, and national security. Economic competitiveness is the ability of firms to routinely turn new ideas into cash

² Ganna Kharlamova, Olga Vertelieva, The International Competitiveness of Countries: Economic-Mathematical Approach, *Economics & Sociology*, Vol. 6, No 2, 2013, pg. 41.

flows, thus allowing companies to continue to hire and retain employees and add to the economic health of the nation. Technological competitiveness is the ability to create and control access to new technologies themselves as well as embedded in products and services. Innovation and intellectual property clearly play a role in achieving both economic and technological competitiveness. For many companies, being the technology leader, affords a clear view of possible technology roadmaps and allows that entity to be the one to exert control and influence over the most likely choices and outcomes, increasing their potential future value. While companies want to dominate a technology space so that they can profit financially, countries are more interested in blanketing a technology roadmap with patent options belonging to companies/entities from their home country. For the U.S., being the technological leader in a strategic technology area, affords more opportunities and choices for economic and technological stability within the U.S. economy. Additionally, it also provides security, economic stability and geopolitical risk reduction. If the U.S. and its allies are plotting the possible technology trajectories of strategic technologies, determining the preferred future direction and also determining who will be granted access to the emerging technology, then ensuring National Competitiveness is likely. Disrupting the technological leadership of competing nation states is a primary objective for countries looking to either achieve greater economic and technological competitiveness or better position themselves geopolitically.

I have co-authored a publication (recently cited in the National Security Commission on Artificial Intelligence Final Report (2021)) that addresses National Competitiveness: Jeanne Suchodolski, Suzanne Harrison & Bowman Heiden, *Innovation Warfare*, 22 N.C. J.L. & Tech. 175 (2020). Since it is so germane to the issues at hand, I block quote an extended excerpt concerning the interplay of the economy and national security, where a patent right can support a “control” position that helps a nation’s counterstrategy against an Innovation Warfare adversary.

All forms of intellectual property possess value as a means to prevent others from using innovation without permission. Patents are the strongest and most familiar of these intellectual property rights and are commonly used to build technology-based control positions. Although the following discussion is further limited to patents, the concepts and principles described apply to all

categories of intellectual property. Patents help innovative entities straddle the dimension of time. Savvy entities protect innovation value streams both in the present and in the future via a portfolio of patents. Many leaders think of intellectual property, and patents in particular, as simply a necessary defensive expenditure. But experienced leaders realize that intellectual property is a type of real option that connects current R&D investments to future benefits inclusive of the ability to control and manage outcomes at a later point in time. The difference between these two points of view is significant. Under U.S. law, a patent is a right to exclude others from making, using, or selling the patented invention. These rights mean that others must have the patent owner's permission to practice the invention claimed in the patent. Therefore, the patent owner "controls" how the patented technology is to be utilized and holds the option to exercise that right throughout the life of the patent. Patents are, therefore, real options on control positions, or simply for ease of discussion, control positions.

The real option nature of patents, however, nonetheless provides key insights on their optimum use as control positions. Entities file patent applications hopeful that the resulting patent may prove to be of some use or value in the future. Often one or more of these future anticipated uses of a patent, such as licensing, technology transfer, influencing standards-setting or other technology adoption, or stopping infringement, fails to materialize. In such a case, the patent option is null. But, if one of these uses were to come about, the patent option is "called", and the patent often assumes a significant amount of value through that use. That value, or future return, varies depending on the precise use and may not materialize at all. Thus, not all patents are equally valuable. Entities, therefore, try to file as many patents to obtain as many options to assert a control position in the future as possible. The first and most obvious means of using patents as control positions is to obtain them at all.

Every such control position a U.S. entity obtains is one that its adversaries do not obtain. In the context of Innovation Warfare, patents can be used to own and control relevant technology future(s) for U.S. interests. Either a U.S. company can own and control a relevant patent asset, or the U.S. government

can own and control the patent asset. In either scenario, a U.S. entity, not an adversary, owns and controls the patent asset. Patent portfolio size need not, however, be unbounded. Nor does there exist a magic number to own. In the Authors' experience, different industries and technologies utilize patents differently. For this reason, caution must be exercised when attempting to establish a desired number of patent assets solely by reference to the size of the R&D investment. The right number of patents, or control positions, to own is both a statistical and financial question. In an ideal world, an entity wants to own enough patents so that when they reach into their portfolio in response to a given scenario, they would be statistically likely to find an executable option. Realistically, the size of the portfolio becomes limited by the financial costs of acquiring it and maintaining it.³

We have seen this behavior from nation states throughout our national history, with competitive countries trying to acquire or misappropriate technology from the U.S. to enable their own industrial base and/or achieve their own geopolitical goals. In fact, that is precisely what espionage is attempting to achieve, acquiring information and/or technology through illicit means to achieve the objectives of the “aggressor” nation. Currently, the Chinese government, and several other nation states are employing these “aggressive” tactics to disrupt the economic and technological superiority of the United States using both the illegal and legal means of technology transfer.

The White House labels the collection of China's technology transfer activities as “aggression.” Specifically, the White House notes that much of China's economic growth has been achieved through “aggressive” acts, policies, and practices that fall outside of global norms and rules (collectively, “economic aggression”). These technology transfer behaviors can be seen as a competitive strategy supporting China's grand political strategy, and not merely a form of market competition. The sum of the activities constitutes a particular

³ Suchodolski, Harrison & Heiden, Innovation Warfare, *North Carolina Journal of Law & Technology*, Volume, 22, Issue 2: Decemner 2020, , pg. 238-239

form of competitive strategy targeting America's innovation ecosystem. This newly articulated doctrine, "Innovation Warfare," is defined as follows. An executable competitive strategy:

- a) Reflecting an innovation, intellectual property, and technology strategy articulated and executed by the state (e.g., China).
- b) Using illegal means, political means, and legal economic activities—of the type previously residing solely in the province of commercial enterprise, to achieve the state's objectives.
- c) Employing these economic and innovation activities to achieve both economic geopolitical power and to enhance military capabilities; and
- d) Functioning as a military, national security, and defense doctrine not solely a reflection of the state's economic policy goals nor commercial competition in the ordinary course. Innovation Warfare does not only threaten American jobs and economic prosperity. By simultaneously co-opting and weakening the innovation capabilities of the United States, China seeks to advance its rise to world power. Over the course of history, there have been sixteen such times when one rising power sought to overtake an existing world power. All but four of those historical events provoked armed conflict. China's Innovation Warfare activities risk the type of economic and geopolitical aggression that were a root cause of two World Wars.⁴

Countries compete against each other economically and geopolitical all the time, what differentiates "normal" geopolitical competition from Innovation Warfare activities? A significant factor differentiating normal geopolitical competition from IW activities, is the reach and influence of government activities into the private sector.

Theoretically, private companies should be competing to achieve their own individual economic goals and objectives. However, given the CCP reach into all aspects of the Chinese economy, the government is dictating the actions and objectives of supposedly "private" enterprises to help it achieve its state goals. In the West, where there is more separation between the government and private industry, such a practice would be difficult if not impossible to achieve at scale. While the Chinese government

⁴ Ibid pg. 201-203

is clearly running an Innovation Warfare strategy against the United States, the United States needs to create and implement an IW counter strategy. Such a counter strategy should include ways to slow or stop technology acquisition from both legal and illegal means from the U.S. to the Chinese government and Chinese private entities working on behalf of the nation state.

IV. United States Government Critical & Emerging Technologies List

The first step of any viable counter strategy is to define strategic areas of interest. In October of 2020, the White House released a report entitled “National Strategy for Critical and Emerging Technologies” which laid out the reasoning and strategy for how to maintain the country’s National Competitiveness. Below is an excerpt from that document (italics are added)

Throughout our history, American achievements and leadership in science and technology (S&T) have been a driving factor for our way of life, prosperity, and security. However, American leadership in S&T faces growing challenges from strategic competitors, who recognize the benefits of S&T and are organizing massive human and capital resources on a national scale to take the lead in areas with long-term consequences. The National Security Strategy (NSS) lays out a vision for promoting American prosperity; protecting the American people, the homeland, and the American way of life; preserving peace through strength; and advancing American influence in an era of great power competition. *It calls for the United States to lead in research, technology, invention, and innovation, referred to here generally as science and technology (S&T), by prioritizing emerging technologies critical to economic growth and security. The NSS also calls for the United States to promote and protect the United States National Security Innovation Base (NSIB), which it defines as the American network of knowledge, capabilities, and people – including academia, National Laboratories, and the private sector – that turns ideas into innovations, transforms discoveries into successful commercial products and companies, and protects and enhances the American way of life.*

Our market-oriented approach will allow us to prevail against state-directed models that produce waste and disincentivize innovation, but we will also protect ourselves from unfair competition and prevent the use of our technology for authoritarian activities.

The People's Republic of China (PRC) is not only dedicating large amounts of resources in its pursuit to become the global leader in S&T. It is also targeting sources of United States and allied strength by employing means that include stealing technology, coercing companies to disclose intellectual property, undercutting free and fair markets, failing to provide reciprocal access in research and development (R&D) projects, and *promoting authoritarian practices that run counter to democratic values*.⁵

The report continues and discusses the United States goals and objectives for the National Security Strategy (NSS):

In accordance with the NSS, we will maintain worldwide leadership in critical and emerging technologies (C&ET) by promoting our NSIB and protecting our technological advantage. For the purposes of this strategy, C&ET are defined as those technologies that have been identified and assessed by the National Security Council (NSC) to be critical, or to potentially become critical, to the United States' national security advantage, including military, intelligence, and economic advantages....

The United States will proactively lead in C&ET by leveraging its NSIB, and superior economic system. Proactive choices will enable the United States to seize opportunities to shape and optimally benefit from the technological landscape, stay ahead of strategic competitors, and advance democratic values. The National Strategy for C&ET encourages unity of effort across the United States Government and provides a framework from which deliberate actions will affect multiple

⁵ National Strategy for Critical and Emerging Technologies, *National Security Council*, October 2020, pg. 1

technology areas in a coordinated manner. It is not feasible for the United States to lead in all aspects of every technology area, and there is no single technology that will ensure worldwide C&ET leadership. In fact, many technology breakthroughs occur at the intersection of two or more disparate technologies. Therefore, a holistic approach is required to address the growing convergence of technologies for various applications.

The Critical and Emerging Technologies (C&ET) list reflects the 20 technology areas that United States Government Departments and Agencies identified to the National Security Council staff as priorities for their missions. The list will be reviewed and updated annually via the interagency process coordinated by the National Security Council staff. The technology areas are arranged alphabetically.

- Advanced Computing
- Advanced Conventional Weapons Technologies
- Advanced Engineering Materials
- Advanced Manufacturing
- Advanced Sensing
- Aero-Engine Technologies
- Agricultural Technologies
- Artificial Intelligence
- Autonomous Systems
- Biotechnologies
- Chemical, Biological, Radiological, and Nuclear (CBRN) Mitigation Technologies
- Communication and Networking Technologies
- Data Science and Storage
- Distributed Ledger Technologies
- Energy Technologies
- Human-Machine Interfaces
- Medical and Public Health Technologies
- Quantum Information Science
- Semiconductors and Microelectronics
- Space Technologies⁶

⁶ Ibid, pg. 2, A-1

V. The United States Patent & Trademark Office (USPTO) and the Patent Trial and Appeals Board (PTAB)

The USPTO is the federal agency responsible for granting patents and registering trademarks. The USPTO follows an international process for determining whether inventions meet the criteria of being novel and non-obvious after a defined search and examination process. To ensure that an alternative to post-grant patentability adjudication is available to parties that is potentially quicker and less costly than district court litigation, Congress created the PTAB to review and adjudicate previously granted patents to determine whether they should have their claims canceled.

The USPTO is the only federal agency that can access and view the entirety of the U.S. patent data landscape including granted patents, patent applications (both publicly available and unpublished), as well as published international patents and patent applications. In essence, they are the only federal agency able to determine for any time period, the best estimate of technology control positions within a particular technology area owned by each country. Both the USPTO and PTAB are tasked with ensuring the process of granting U.S. patents is of the highest quality and provides a level of certainty for both inventors and corporations, so that once they receive a patent grant, they may go forth and make investment decisions and spend money to turn those inventions into products and solutions to be sold.

VI. Overview of the '030 Patent and 10Tales, Inc. Technology

I am informed that the '030 Patent is directed to systems for presenting a personalized digital experience for a user, informed by the user's social networking activity.

Claim 1 of the '030 Patent is directed to a system that identifies a first set of digital content for transmitting to a user based on that user's profile. The claimed system acquires additional information about the user based on the user's interaction with a social network. Based upon that additional information, the system identifies a second, more personalized set of digital content to transmit to the user to improve the user's experience.

As explained in the '030 Patent specification, the invention “allow[s] for customizing and personalizing content based on a combination of the user’s demographics, psychodemographics, cognitive states, emotional states, *social placement and group interaction dynamics within an online community*, and/or affinity for certain elements (images, sounds, segments, graphics, video, text, dialog), self-provided narrating content, internal narrative traits preference topology, and expectation level and temporal spacing of assets within the narrative.” (EX. 1001 2:65-3:7, emphasis added).

Does the '030 Patent Relate to the Critical & Emerging Technologies List?

We know that data science and storage is listed by the White House as a critical and emerging technology⁷. In addition, in a recent National Security Commission on Artificial Intelligence (AI) report discusses how AI will impact national security and national competitiveness:

Americans have not yet grappled with just how profoundly the artificial intelligence (AI) revolution will impact our economy, national security, and welfare. Much remains to be learned about the power and limits of AI technologies. Nevertheless, big decisions need to be made now to accelerate AI innovation to benefit the United States and to defend against the malign uses of AI. AI is an inspiring technology. It will be the most powerful tool in generations for benefiting humanity. Scientists have already made astonishing progress in fields ranging from biology and medicine to astrophysics by leveraging AI. These advances are not science fair experiments; they are improving life and unlocking mysteries of the natural world. They are the kind of discoveries for which the label “game changing” is not a cliché. AI systems will also be used in the pursuit of power. We fear AI tools will

⁷ Ibid, p. A-1

be weapons of first resort in future conflicts. AI will not stay in the domain of superpowers or the realm of science fiction. AI is dual-use, often open-source, and diffusing rapidly. State adversaries are already using AI-enabled disinformation attacks to sow division in democracies and jar our sense of reality. States, criminals, and terrorists will conduct AI-powered cyber-attacks and pair AI software with commercially available drones to create “smart weapons.” It is no secret that America’s military rivals are integrating AI concepts and platforms to challenge the United States’ decades-long technology advantage.⁸

The 10Tales technology in the wrong hands can lead to strategic disinformation campaigns, reinforcing and/or creating racial, economic, political, and secular divisions at a time when our nation is already very divided. Ensuring the ‘030 patented technology is owned and controlled by a company (preferably U.S. owned and controlled) that adheres to the norms and values of the United States is important. Going back to the NSCAI Final Report, “Digital dependence in all walks of life is transforming personal and commercial vulnerabilities into potential national security weaknesses. Adversaries are using AI systems to enhance disinformation campaigns and cyber-attacks. They are harvesting data on Americans to build profiles of their beliefs, behavior, and biological makeup for tailored attempts to manipulate or coerce individuals. This gathering storm of foreign influence and interference requires organizational and policy reforms to bolster our resilience.”⁹

VII. TikTok Inc. and the Real Party in Interest

TikTok has disclosed its parent company ByteDance Ltd. as a real party in interest. There are two additional parties that so far have not been mentioned – The Chinese Communist Party (CCP) and the government of the People’s Republic of China (PRC). In the fall of 2020, Donald Trump in his capacity as President of the United States opposed TikTok’s preliminary injunction motion attempting to forestall prohibitions on its business transactions authorized after Presidential emergency declaration, followed by Department

⁸ Natl Security Commission on Artificial Intelligence Final Report, pg. 1-2

⁹ Ibid, pg. 9

of Commerce findings about TikTok's and ByteDance's national security threat.¹⁰ In that document, the U.S. Department of Justice (DOJ) attorneys, clearly stated the government's view of whether TikTok is a truly independent entity.

Federal government officials have long expressed concern about the Chinese government's ability to acquire Americans' private data through its control over Chinese companies that collect information from Americans. It is well-recognized that large Chinese technology firms are not purely private, but in fact are intertwined with and subject to the control and influence of the

Chinese Communist Party ("CCP") and the government of the People's Republic of China ("PRC"). Moreover, Chinese law imposes broad obligations on citizens and companies to cooperate with the PRC by providing data and technological support to security and intelligence agencies and the military. ByteDance Ltd. is a Chinese firm of particular concern for the U.S. Government. ByteDance is headquartered in Beijing, subject to PRC intelligence laws, and contains an internal corporate CCP committee through which the CCP exercises influence at the company. Moreover, its founder and CEO has publicly affirmed that ByteDance is a mouthpiece for the CCP in that it is committed to promoting the CCP's agenda and messaging. One of ByteDance's assets is the social media application TikTok, which collects vast quantities of data from its users including U.S. persons within the United States. When those users submit to TikTok's Terms of Service and Privacy Policy, they agree that their data may flow to ByteDance and (as such) may be turned over to the PRC. The President determined that the PRC's ability to control this data presented an unacceptable threat to the United States' national security and foreign policy.¹¹

¹⁰ I am informed that although the district court granted the preliminary injunction, it did not make any findings contrary to the Department of Commerce findings or the President's emergency declaration. It ruled instead that there was a statutory exclusion for the kind of sanctions imposed ("information materials"). I am told that ruling is currently being appealed by the government.

¹¹ TIKTOK, Inc. et al. vs. Donald Trump, Civil Action No. 1:20-CV-2658-CJN, Dkt. 22, pg.1

The DOJ attorneys stated a compelling case that TikTok is not an independent private company, but rather an arm of both the PRC and CCP, and thus those entities should be considered the real party in interest. Moreover, the DOJ also laid out the case that TikTok is not upholding American values or freedoms such as privacy and freedom of speech and as such American citizens have little to no legal recourse against a nation state actor.

The PRC exercises “authority and supervision over nominally private or non-governmental organizations,” including through Party Committees or Corporate CCP Committees at those entities. Commerce Decision Memo, at 7. “Within private enterprises, the Party Committee implements CCP’s policies” and are a “source of political pressure across the boardroom.” *Id.* Additionally, the PRC Government has enacted several laws increasing its influence “over all Chinese companies, and citizens[.]” Commerce Decision Memo, at 9. Notably, in 2017 the PRC enacted the National Intelligence Law, which “obliges individuals, organizations, and institutions to assist Public Security and State Security officials in carrying out a wide array of intelligence work.” *Id.* at 10. The law expressly “permits Chinese intelligence institutions to request citizens and organizations to provide necessary support, assistance, and cooperation,” as well as “take control of an organization’s facilities, which includes communications equipment.” *Id.* at 10. Other PRC laws likewise require cooperation by company network operators. See *id.* Due to the lack of an independent judiciary in the PRC, there is no meaningful legal recourse for companies to challenge orders or requests from PRC intelligence or security agencies. *Id.*²

When Congress created the PTAB as part of the America Invents Act, it did so to help private companies adjudicate validity issues and to ensure that the USPTO was granting patents at the highest quality level. It was not created nor intended to be used to enable “bad actor” nation states to legally invalidate patents of U.S. firms that were inconvenient or detrimental to the objectives of the nation state. The federal government has several ways to help identify “bad actor” entities and ensure that they do not do business with or enable these entities to achieve their goals and objectives. Federal agencies such as the

Federal Bureau of Investigation (FBI), the National Security Agency (NSA), and the Central Intelligence Agency (CIA) are examples of federal intelligence agencies that often identify and opine on entities that they believe are “bad actors”. Additionally, the Bureau of Industry and Security (BIS), located within the Department of Commerce, is the keeper of the Entity list. Since its initial publication in 1997, grounds for inclusion on the Entity List have expanded to activities sanctioned by the State Department and activities contrary to U.S. national security and/or foreign policy interests. These parties present a greater risk of diversion to weapons of mass destruction (WMD) programs, terrorism, or other activities contrary to U.S. national security and/or foreign policy interests. While the federal government has considered placing both TikTok, Inc. and its parent company ByteDance Ltd. on the Entity list, as of today it still has not happened. While the government was ultimately unsuccessful in employing the International Emergency Economic Powers Act with respect to TikTok, the court found that, “the government has provided ample evidence that China presents a significant national security threat, although the specific evidence of the threat posed by Plaintiffs, as well as whether the prohibitions are the only effective way to address that threat, remains less substantial. At a minimum, the Court cannot adopt Plaintiffs’ argument that ‘the government will not face *any* harm if a preliminary injunction is granted.’”¹² U.S. Intelligence agencies, all continue to monitor the CCP and PRC and their interactions with companies such as TikTok.

IX. What Role Should the USPTO and PTAB Play in Upholding National Competitiveness?

It is clear that the White House and a number of federal agencies are beginning to recognize the interrelationship between National Competitiveness, innovation and intellectual property. As the federal agency responsible for obtaining, maintaining and adjudicating intellectual property rights, the USPTO needs to ensure that it is complying with and upholding the intellectual property policies set by the White House and Congress. Historically, the White House and Congress have viewed intellectual property largely through a trade lens, in essence focusing solely on the economic competitiveness component

¹² TIKTOK, Inc. et al. vs. Donald Trump, Civil Action No. 1:20-CV-2658-CJN, Dkt. 30, pg.17

of National Competitiveness. With that view, the USPTO is merely the arbiter of the intellectual property rights and a subject matter expert regarding international treaties pertaining to intellectual property such as TRIPS, etc. The Director of the USPTO is not a Cabinet level position within the government, and no longer has the responsibility for creating and maintaining the national innovation strategy. During the Obama Administration, the national innovation strategy was moved from the USPTO to the U.S. Chief Technology Officer located within the Office of Science & Technology Policy. Within the U.S. government, there are a number of individuals and offices tasked with the protection of intellectual property rights, such as individuals at the United States Trade Representatives and the Intellectual Property Enforcement and Coordinator (IPEC). Both of these groups are focused on reducing and ultimately halting the illegal and damaging theft of intellectual property. Returning to the NSCAI Final Report, one of the report recommendations was to, "Implement comprehensive intellectual property (IP) policies and regimes. The United States must recognize IP policy as a national security priority critical for preserving America's leadership in AI and emerging technologies. This is especially important in light of China's efforts to leverage and exploit IP policies. The United States lacks the comprehensive IP policies it needs for the AI era and is hindered by legal uncertainties in current U.S. patent eligibility and patentability doctrine. The U.S. government needs a plan to reform IP policies and regimes in ways that are designed to further national security priorities."¹³ While the USPTO has historically taken part in creating and maintaining international IP policies, it has played a lesser role in the last 10 years. So, while the U.S. government is working to reform its current IP policies, what should the USPTO and specifically the PTAB do? To answer that, it is now possible to consider that the PTAB use a multi factor test to determine whether the proceeding before them has any relationship to National Competitiveness.

Such a multi-factor test could include the following;

1. *Are the patents at issue related to the Critical and Emerging Technologies list that reflects the 20 technology areas that United States Government Departments and*

¹³ NSCAI Final Report, pg. 12

Agencies identified to the National Security Council staff as priorities for their missions? The full list of technology areas are arranged alphabetically below.

- Advanced Computing
- Advanced Conventional Weapons Technologies
- Advanced Engineering Materials
- Advanced Manufacturing
- Advanced Sensing
- Aero-Engine Technologies
- Agricultural Technologies
- Artificial Intelligence
- Autonomous Systems
- Biotechnologies
- Chemical, Biological, Radiological, and Nuclear (CBRN) Mitigation Technologies
- Communication and Networking Technologies
- Data Science and Storage
- Distributed Ledger Technologies
- Energy Technologies
- Human-Machine Interfaces
- Medical and Public Health Technologies
- Quantum Information Science
- Semiconductors and Microelectronics
- Space Technologies¹⁴

2. *Is there a likelihood that one or more of the Petitioner real parties in interest involved in the proposed PTAB proceeding is acting as an agent of a nation state?*¹⁵ To assist in assessing this risk, the USPTO can look to U.S. Intelligence agencies (such as the FBI, CIA, and NSA, and others) as well as State Department officials to see if they have provided any opinions or facts regarding the entities in question. If no federal agency or state department official has opined on the subject but there appears to be the potential for a nation state actor to be reaching through a private entity, then the USPTO should default to a Yes.

3. *Any other relevant information that is deemed pertinent to the case.*

¹⁴ National Strategy for C&ET, pg. 2, A-1

¹⁵ Based upon the facts of this case, I am proposing the Petitioner any broader remit is beyond the scope of what I was asked to do.

Based upon the above multi factor test, the PTAB can determine whether the patents or the Petitioner within a specific proceeding warrants further review to ascertain whether or not there are National Competitiveness issues in play. If so, then it would seem prudent to yield the proceeding to an Article 3 court so that use of judicial processes such as discovery, depositions and compulsive sanctions (or threat of them) can be used to fully ascertain the true nature of the issues at hand. For example, if a company like TikTok refuses to disclose its algorithms to permit a fulsome infringement analysis, a district court (but not the PTAB) can ponder default-type sanctions, including barring an invalidity defense as penalty for noncompliance with the truth-seeking function of federal litigation.

X. The Use of 35 U.S.C. §316(b)

35 U.S.C. §316(b) provides, "In prescribing regulations under this section, *the Director shall consider the effect of any such regulation on the economy, the integrity of the patent system*, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter." (italics added) Does this provision apply to this case? There is reasonable evidence that certain "bad actor" nation states are currently employing Innovation Warfare strategies against the United States to destabilize the U.S. both economically and technologically through the acquisition of U.S. technologies and intellectual property through legal and illegal means. A nation state has both the resources and means to run an Innovation Warfare strategy at scale in such a manner and can conscript "private" enterprises to act on behalf of the nation state, such that in totality would have a significant negative effect on the National Competitiveness of the United States. As a federal agency, the USPTO is expected to comply with and uphold activities and efforts that ensure the safety and security of American citizens whether through economic, technological or national security efforts. Only in the last year has information regarding the relationship between innovation, intellectual property and national security been published. Papers and reports on subjects such as Innovation Warfare, the National Strategy for Critical & Emerging Technologies, the National Security Commission on Artificial Intelligence, and the Office of Management and Budget (OMB) FY 2022 Research and Development Budget Priorities, are less than a year old and require

new thinking on how all federal agencies can and should respond to these new and emerging threats. All of these documents clearly and consistently cite the threat to our economic and technological competitiveness and national security being posed by “bad actor” nation states looking to acquire U.S. technologies and associated intellectual property in any way possible, both legal and illegal. The USPTO in particular is on the front lines of this fight as the federal agency in charge of granting and adjudicating intellectual property rights in a fair and transparent manner in accordance with international treaties. Most of the disputes heard by PTAB involve private enterprises looking to maximize the value of the dispute in their individual favor to ensure value for their shareholders. But increasingly, PTAB will see disputes which at first glance appear to involve private enterprises, but at further review, may involve private companies working at the behest of a nation state. In such a case, it is unthinkable that a federal agency would willingly undermine the National Competitiveness of the United States by allowing itself to be used as a pawn in an Innovation Warfare strategy against its own citizens.

Let us review the multi-factor test in relation to the 10Tales, Inc. and TikTok, Inc. dispute.

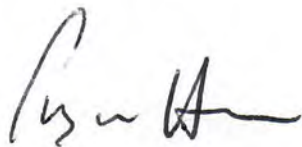
1. *Are the patents at issue related to the Critical and Emerging Technologies list?*
 - i. Yes. The '030 patent falls under the category of Data Science and Storage
2. *Is there a likelihood that one or more of the Petitioner parties involved in the proposed PTAB proceeding is acting as an agent of a nation state?*
 - i. Yes. The White House along with multiple intelligence agencies has laid out in a clear and convincing manner that TikTok, Inc. and its parent company ByteDance Ltd. are not complying with U.S. privacy laws and norms and are not being truthful with U.S. customers about how their user data is being collected and utilized by the Chinese government. In addition, the CCP and PRC have been utilizing AI technologies to organize disinformation campaigns against U.S. citizens. Invalidating the '03 10Tales, Inc. patent would eliminate the ability to exclude TikTok, Inc., and the Chinese government from this engaging in such nefarious activity.
3. *Any other relevant information that is deemed pertinent to the case?*

- i. Yes. TikTok and 10Tales are currently in litigation in the Western District of Texas jurisdiction regarding patent infringement of the '030 patent. The question of patent validity is fundamental to both proceedings.

Using the above multi-factor test, we find that the proceeding in question merits three Yes answers, which places it at high risk of allowing the Chinese government to conscript the PTAB in its innovation warfare efforts to the detriment of U.S. National Competitiveness, thereby harming U.S. citizens, our economy, and national security. Instituting this proceeding is in direct opposition with U.S. IP policy as defined by the White House, Department of Commerce and multiple Intelligence agencies to ensure that the PRC's aggressive use of technology transfer activities is thwarted. The PTAB process was designed by Congress to create an efficient review of validity decisions by the USPTO. It was not Congress's intent that PTAB proceedings would become a tool usable by adversary nation states to wrest control of IP from U.S.-based actors.

I have personal knowledge of the facts recited above, or where I am relying on sources, I have indicated my reference sources. I am competent to testify to the facts and opinions herein. I declare under penalty of perjury that the foregoing is true and correct to the best of my knowledge and belief.

Percipience LLC,

A handwritten signature in black ink, appearing to read 'Suzanne Harrison', written over a horizontal line.

By: Suzanne Harrison

APPENDIX A

Suzanne Harrison, Principal, Percipience LLC

24 19th Avenue
San Francisco, CA 94121
USA
Phone: 415.509.4469
Email: suzanne@percipience-ip.com

Summary

Suzanne Harrison is the Founder of Percipience, LLC, a board level advisory firm focused on intellectual property (IP) strategy and management, quantifying and mitigating IP risk, and increasing IP value capture. Ms. Harrison was previously a Director with Inflexion Point Strategy, an IP Investment bank providing intellectual property transaction assistance. Prior to that position, Ms. Harrison was the CEO and Founder of Gathering2.0, the first online community to increase information transparency and efficiency in the patent transaction market. She was previously a Director with LECG leading their Intellectual Asset Management Consulting practice. She previously co-Founded ICMG, a consulting firm specializing in helping companies extract value from their innovations. Since 1988, she has been helping companies leverage their intangible assets into value. Ms. Harrison is a convenor of the ICM Gathering, a group of 20-30 companies who have been meeting since 1995 to define, create, and benchmark best practices around Intellectual Property Management (IPM) and other intangibles (I-stuff). Ms. Harrison is the recipient of the Licensing Executives Society North America Fellowship. She holds an undergraduate degree in Economics from the University of California at Davis, and an MBA from the University of Chicago. Ms. Harrison has written numerous articles and is a frequent speaker about how companies can extract value from their innovations. She is the co-author of Edison in the Boardroom Revisited published by John Wiley & Sons in 2011, Einstein in the Boardroom published by John Wiley & Sons in 2006 and Edison in the Boardroom also published by John Wiley & Sons in 2001. Ms. Harrison has been a visiting Lecturer at UC Berkeley teaching an MBA course on Intellectual Property Management.

Education

M.B.A., University of Chicago, Concentration in Finance, 1992
B.A., University of California at Davis, Economics, 1986

Professional Experience

Percipience LLC, San Francisco, CA 2010 - present
Founder and Principal

Inflexion Point Strategy LLC, Palo Alto, CA 2010 - 2016
Director

Gathering2.0 San Francisco, CA 2006 – 2010
CEO and Founder

LECG LLC, Emeryville, CA, 2004-2007
Director

Center for Research on China, University of California at Berkeley, 2006-2010
Executive Committee Member and Lecturer

Intellectual Capital Management Group Inc., Palo Alto, CA, 1995-2004
Principal and Founder

Haas School of Business, University of California at Berkeley, 2001 - 2003
Lecturer, Intellectual Property Management

Coopers & Lybrand LLP, San Francisco, CA, 1994 - 1995
Senior Associate

Hewlett-Packard Company, Corvallis, Oregon, 1992 - 1994
Financial Analyst

Sullivan & Associates, Menlo Park, CA, 1988-1990.
Partner

The MAC Group, Menlo Park, CA, 1986-1988
Litigation Support Analyst

Business Analyses: A Representative List of Engagements Includes

Led an engagement to redesign and restructure an Intellectual Property Management (IPM) System for a global Fortune 10 company to include a patent monetization and value capture program.

Led an engagement for a global software company to design a valuation methodology to highlight the value contribution of the patent team to the business. The methodology included value contributions utilizing IP as both a legal and business asset.

Led an engagement for an international Patent & Trademark Office, to create a standard valuation methodology to allow banks to collateralize intellectual property. Worked with commercial banks, investment banks, legal scholars and accountants to ensure acceptance of the valuation methodology and frameworks.

For an International Patent & Trademark office, participated in an engagement to determine how government agencies can enable small to medium enterprises (SME) to compete more effectively in global markets using IP. Also helped solidify data linking invention, innovation and company profitability.

Led an engagement to benchmark and then structure a monetization entity for a large global operating company.

Led an engagement to determine whether NPEs will enter the Chinese market and what effects (if any) this would have on foreign operating companies. Additionally, if NPEs were to enter the market, how would Chinese judges' rule on such cases and would it make a meaningful difference to foreign company patent litigation strategies?

Led an engagement for an Asian electronics manufacturer to find and evaluate several nascent technology areas. As part of the technology evaluation, needed to evaluate both the patent and technology positions of the key market players, ascertain the likely technology trajectories of the technology, and then choose the most likely technology leader. Next we were directed to approach companies and offer a variety of transaction mechanisms based upon the stage of technology development.

As part of an M&A transaction, valued the patents and helped identify their potential monetization value outside of the acquiring entity.

Led an engagement to create an intellectual asset management capability for a large entertainment company. Components of the engagement included creating an intellectual property management strategy, creating a database to manage and prioritize all technology groups for commercialization potential both within and outside the company, valued five intellectual property commercialization opportunities and created an organizational structure within the corporation for managing intellectual assets on a routine basis.

Led an engagement team to determine the commercialization strategy and valuation of an HEV battery technology for an International Automobile manufacturer. Determined the technology applications of the patented technology, the resulting commercial markets and the necessary partners and commercial structures to achieve the commercial goals.

For a global pharmaceutical firm, developed a model to value the impact of upstream activities on drug sales to better allocate resources to these activities. In addition, created an intellectual capital strategy to enable the firm to maximize the value of outside relationships to the firm.

Led an engagement team to determine how best to commercialize gas separation technology for a large Japanese manufacturer. Reviewed the patent portfolios of numerous technology competitors to determine likely commercialization partners and/or licensees.

Assessed the strategic and financial options for commercializing a software division and valued the alternatives. Originally valued internally at \$1 million, valued the division for \$25 million, and it was sold for \$27 million.

Led an engagement to benchmark licensing programs within the computer industry and with best-in-class companies outside the industry to understand how to structure a new licensing office.

Performed a project for a business division to develop a strategic framework to identify, manage and leverage its intellectual assets. The company's most significant type of intellectual property identified was trade secret. The project was used to assist in creating a more cost-effective transfer pricing strategy.

Developed the intellectual property management systems and deployment structure for the creation of a holding company to manage all IP management aspects of the parent company.

Reviewed a chemical company's strategy, organization, work processes and systems for managing intellectual assets and developed recommendations and implementation plan.

Created a patent management strategy that ensures the company's patent portfolio is aligned with its corporate strategy and vision, deployment of a patent management system, and competitive assessment of a particular technology segment within the company.

Created an Intellectual Property Strategy and management process and system design to aid in market share penetration for a telecommunications company.

Testifying Experience:

Gore Enterprise Holdings Inc (Petitioner) vs. Comptroller of the Treasury (Respondent) in Maryland Tax Court October 2008, Case No. 07-IN-00-0084

Client: Gore Enterprise Holdings Inc.

Respondent alleged that Petitioner set up a patent management company with the express purpose of decreasing their tax payments to the State of Maryland. Deposition and testimony involved creating and applying criteria to differentiate between patent management companies that are shams from those having economic substance.

Heather Alisha Davis vs. Brouse McDowell, Case No. 2008-01-0311 in the Court of Common Pleas, Summit County, Ohio

Client: Amin Turocy & Calvin (attorneys for Heather Alisha Davis)

Plaintiff alleged patent malpractice. Deposition related to calculating damages in the case whereby the damage occurred before the plaintiffs company was formed, thereby

eliminating the lost profits calculation.

David E. Lewis, Chapter 7 Trustee vs. HealthTrio, LLC., Case No. 09-34404 HRT in Colorado Bankruptcy Court.

Client: Dr. Malik Hasan, HealthTrio CEO

Plaintiff alleged misconduct in bankruptcy proceedings. Specifically, the undervaluation of patent application assets in, subsequently purchased by Dr. Malik Hasan in bankruptcy. Deposition related to patent application transactions and valuation.

ASML U.S. Inc. vs. Xtal Inc., Case No. 16-CV-295051 in Superior Court of California, Santa Clara. Trial was November 2018.

Client: Xtal Inc.

Plaintiff alleged misappropriation of trade secrets. Deposition and jury trial related to damages and intellectual property management processes.

Just Goods, Inc. vs. Just, Inc. aka Hampton Creek, Inc., Joshua Tetrick, and DOES 1-10, Case No. 3:18-CV-2198-WHO in the Northern District of California, San Francisco Division

Client: Just, Inc.

Plaintiff alleged misappropriation of trademarks. Deposition related to trademark damages.

Publications

Books

Edison in the Boardroom Revisited; with Patrick Sullivan, John Wiley & Sons; November 2011

Einstein in the Boardroom: Moving beyond Intellectual Capital to I-stuff; with Patrick Sullivan, John Wiley & Sons; April 2006

Edison in the Boardroom: How Leading Companies Realize Value From Their Intellectual Assets; with Julie Davis, John Wiley & Sons; June 2001

Articles

Innovation Warfare, with Jeanne Suchodolski and Bowman Heiden, North Carolina Journal of Technology & Law, volume 22, issue 2, (December 7, 2020), pp 175-258.

Measuring Diversity of Invention and Patenting is Easier Said than Done, with Erik Oliver, IAM Magazine, November 24, 2020

Business Mindset and IP Community -Think outside the Box, with Takuya Izumi, IP Management, 145 Intellectual Property Management Vol. 70 No.2, Japan Intellectual Property Association (Feb. 22, 2020).

Gender disparity in patents: taking steps to uncover the “hidden figures” of innovation, with Charu Kurani, Jeremiah Chan and Sandra Nowak, IAM Magazine, winter 2019, pp.64-69.

Managing IP as a Set of Business Assets, with Patrick Sullivan, WIPO Magazine, February 2008 – No.1, pp. 15-17.

The Truth About Non-core Licensing, with Gene Potkay, IAM Magazine, issue 20, October/November 2006, pp9-13.

Presenting I-stuff, with Patrick Sullivan and Sharon Oriel, IAM Magazine, issue 16, February/March 2006, pp23-27.

From sunk costs to sound strategies, Contributing author, IP Review, issue seven, Summer 2004, pp22-23.

IP Tactics in Support of the Business Strategy, with Paul Germeraad and Carl Lucas, les Nouvelles, September 2003, pp120-127.

“IC-based Corporate Carve-outs: Strategy, Structure and Funding,” with Jim Malackowski, Chapter 13 in: The LESI Guide to Licensing Best Practices – Strategic Issues and Contemporary Realities, R. Goldscheider, editor, John Wiley & Sons Inc., May 2002.

Extracting Value From Intangibles by Leading Companies in IC Management, with Patrick H. Sullivan, The Journal of Intellectual Capital, Issue 1, Vol. 1, Spring, 2000.

“Profiting from Intellectual Capital,” contributing author, reprinted in Journal of Knowledge Management, July 2000.

“Profiting from Intellectual Capital: Learning from Leading Companies,” Contributing author, Article in Journal of Intellectual Capital, January 2000.

“Measuring and Monitoring Intellectual Capital,” Contributing author, Profiting from Intellectual Capital, pp. 267-278, John Wiley & Sons, Inc., 1998

“The IP Portfolio as a Competitive Tool,” Contributing author, Profiting from Intellectual Capital, pp. 119-128, John Wiley & Sons, Inc., 1998

“The Importance of Context In The Derivation Of Royalty Rates,” Contributing author; Technology Licensing; John Wiley & Sons; 1996; pp. 177-186.

Extracting Value From Intellectual Capital, DVFinance Report, April 1995, pp.3.

Insights into Commercializing Technology, les Nouvelles, March 1993, pp. 30-35.

Board Positions

United States Intellectual Property Alliance (USIPA), Board Member & Co-Chair of the Diversity & Inclusion Committee, November 2020 - present

Christian Hansen Holdings A/S, IP Advisory Board, Denmark, November 2020 - present

Professional Affiliations

Convenor of the ICM Gathering: 1995-Present

Convenor of the Patent Solutions Forum: 2012 - 2013

Convenor of the Executive Forum: 2007 - 2009

Convenor of the Australasian Gathering: 2003 – 2006

IAM 300: The World's leading IP Strategists, 2008-Present