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NEW BEST PRACTICES FOR OLD CONTRACT PROVISIONS

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Presented By:
Sean Becker
Wes Jones
Marisa Secco
Janice Ta

OVERVIEW

CORPORATE TRANSACTIONS

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Waivers of Consequential Damages

WAIVERS OF CONSEQUENTIAL DAMAGES

LOTS of agreements waive "consequential damages", but many do so incorrectly and without proper thought, such that you may be waiving damages you don't intend to waive.

EXAMPLE

"Notwithstanding anything in this Agreement to the contrary, no party hereto shall be liable to any other person for any consequential, incidental, indirect, special or punitive damages, loss of income or profits, or any diminution in value resulting from a breach of this Agreement."

- What are "consequential damages"?
- *Hadley v. Baxendale* and Rule of Reasonableness: Breaching party is responsible for all damages that are the "natural, probable and reasonably foreseeable result of the breach."
- So if Rule of Reasonableness is the basis for all contractual damages, what are people trying to exclude by including waivers of consequential damages?

WAIVERS OF CONSEQUENTIAL DAMAGES

Let's discuss in order:

- Incidental Damages
- Lost Income or Profits
- Diminution in Value
- Special or Punitive Damages
- Indirect Damages

- So perhaps the best definition of items that most parties are trying to exclude is –

"Losses caused by a contract breach as a result of the special circumstances of the non-breaching party that would not have occurred in the ordinary case of a breach of a similar contract not involving such special circumstances [,unless such special circumstances were communicated to the breaching party]."

Fraud
Carve-outs

FRAUD CARVE-OUTS

Many agreements carve-out “fraud” from limitations of liability and survival periods, but what exactly does that mean?

EXAMPLES

> “Absent fraud, the representations and warranties set forth in this Agreement shall survive for a period of 1 year”

> “Absent fraud, neither party shall have any liability in excess of $_____.”

- What does “fraud” mean?
- Quotes from courts – “fraud is infinite in variety”, “fraud is kaleidoscopic”

FRAUD CARVE-OUTS

- **Equitable Fraud** – Based on principal that it is "fraudulent" for a defendant to hold a plaintiff to a bargain that was induced by representations that were not true

- **Promissory Fraud** – A form of fraudulent inducement, where the existence of a contract does not prevent the introduction of extraneous promises made outside of the four corners of the agreement, to the extent that the promises induced the execution of the contract

- **Unfair Dealings Fraud** – Any time one party is deemed to have taken unfair advantage of the other party in such a manner that the court determines is "fraudulent"

- **Common Law Fraud** –
  - Defendant made a representation that was false
  - Defendant acted with scienter (knew the rep was false or made it recklessly)
  - Plaintiff relied upon the representation
  - Plaintiff suffered damages

FRAUD CARVE-OUTS

LESSONS

1. Always define “fraud” as “the intentional and willful misrepresentation of a material fact [(and does not include any fraud claim based on constructive knowledge, negligent misrepresentation, recklessness or similar theory)]”

2. Always get a “non-reliance” provision such that the other party acknowledges that it is not relying on any representations made other than those set forth in the written agreement


Non-binding
Agreements

NON-BINDING AGREEMENTS

- Usually, non-binding provisions are included in term sheets and LOI's
- Even so, they should still be clearly drafted and synthesized into definitive agreements
- Non-binding provision is usually not included in the provision stating which sections of the term sheet/LOI survive its termination or expiration (BUT SHOULD BE!)
  - Turner Broadcasting v. McDavid (Georgia 2010)
- What about where LOI is in connection with another agreement?
  - *SIGA v. PharmAthene* (Del. 2013)

NON-BINDING AGREEMENTS

LESSONS

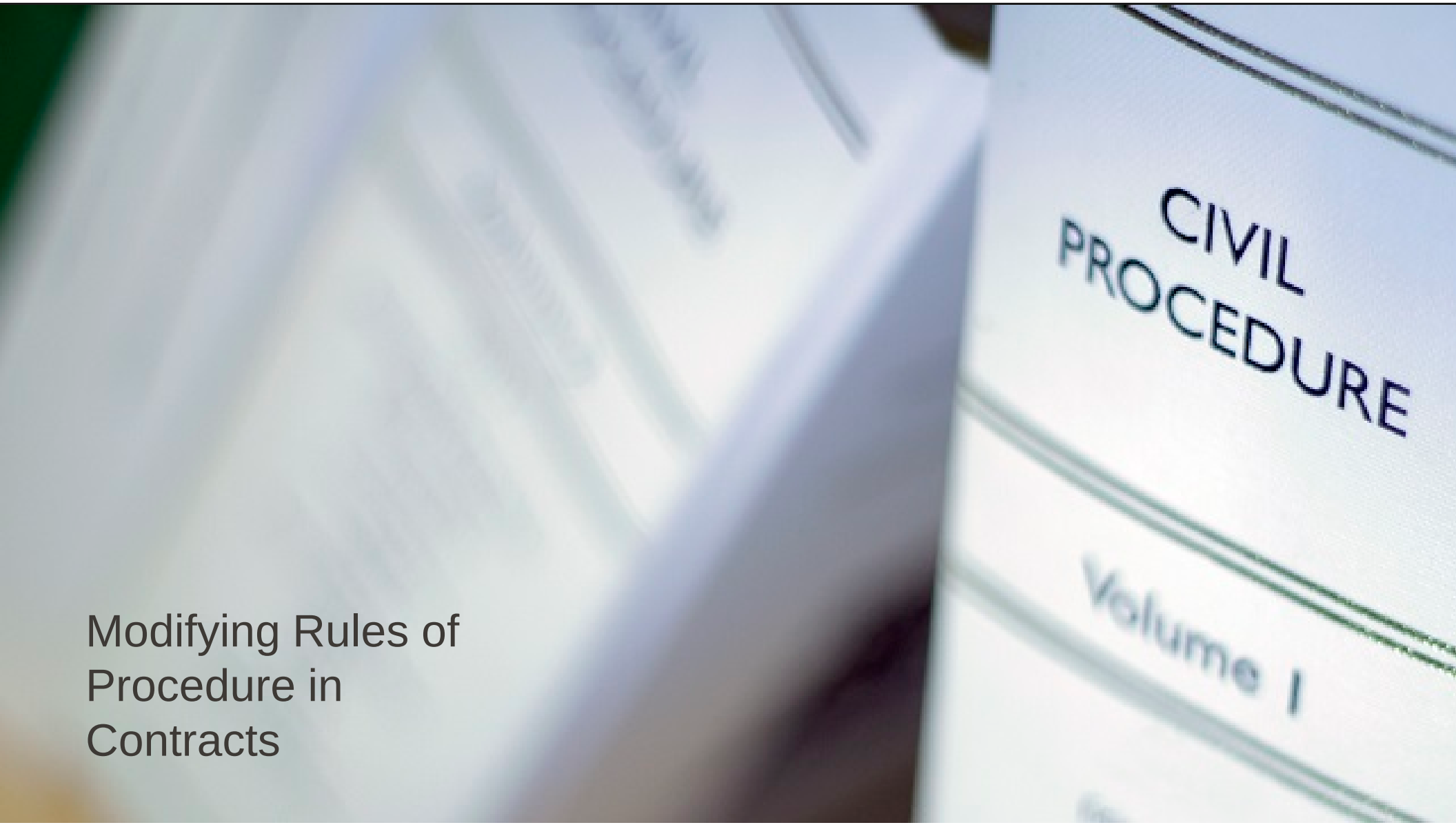
- Avoid contractual obligations to negotiate in good faith
- In addition to stating “This term sheet is non-binding”, make clear that no agreement between the parties will be formed based on course of conduct
- Make clear that agreement will only be reached upon execution of actual definitive agreements
- Ensure that those “non-binding” provision of term sheet expressly survive the expiration or termination of the term sheet


Forum Selection &
Choice of Law
Clauses

FORUM SELECTION AND CHOICE OF LAW

- **BASIC DEFINITIONS**
  - Choice of Law Clauses: Determine *which jurisdiction's law* will apply to disputes arising from the contract.
  - Forum Selection Clauses: Determine *where* disputes arising from the contract will be litigated.
- **BEST PRACTICE**: Align choice of law and forum selection clauses in the same jurisdiction.
  - Texas Law, Texas Courts
  - Delaware Law, Delaware Courts
- **FEDERAL JURISDICTION**: Cannot be created by choice of law or forum selection clauses

EXAMPLE PROVISION: "This agreement and all claims arising out of or relating thereto, shall be governed by and construed and interpreted in accordance with the laws of the State of Delaware, without regard to or application of choice of law rules or principles. The mandatory and exclusive venue in which to resolve any claim(s) arising out of or relating to this agreement shall be the Delaware Court of Chancery, or, if the Delaware Court of Chancery lacks jurisdiction over the claim(s), a state court in Delaware, and each party hereby submits to the exclusive jurisdiction of those courts for purposes of any such proceeding."



Modifying Rules of Procedure in Contracts

MODIFYING RULES OF PROCEDURE BY CONTRACT

TEXAS RULE OF CIVIL PROCEDURE 191.1 ("RULE 191.1")

"Modification of Procedures. Except where specifically prohibited, the procedures and limitations set forth in the rules pertaining to discovery may be modified in any suit by the agreement of the parties or by court order for good cause. An agreement of the parties is enforceable if it complies with Rule 11 or, as it affects an oral deposition, if it is made a part of the record of the deposition."

In re Does, 337 S.W.3d 862 (Tex. 2011) (per curiam)

- Principle: Parties may not modify the rules of procedure in a way that alters the rights of another party without its consent.
- Facts: Plaintiffs sued two anonymous bloggers and Google, which hosted their blogs. *Id*. at 863. The Plaintiffs reached an agreement with Google to modify the requirements of Texas Rule of Civil Procedure 202 regarding depositions, but the anonymous bloggers objected, claiming their rights were affected without their consent. *Id*. at 864-65. The Court agreed and declined to enforce the agreement. *Id*.

MODIFYING RULES OF PROCEDURE BY CONTRACT

FEDERAL RULE OF CIVIL PROCEDURE 29 ("RULE 29")

> "Unless the court orders otherwise, the parties may stipulate that:
>
> (a) a deposition may be taken before any person, at any time or place, on any notice, and in the manner specified—in which event it may be used in the same way as any other deposition; and
>
> (b) other procedures governing or limiting discovery be modified—but a stipulation extending the time for any form of discovery must have court approval if it would interfere with the time set for completing discovery, for hearing a motion, or for trial."

These can also be modified by agreement: service of process (Rule 5) and waiver of jury trial (Rule 39).

Widevine Techs. Inc. v. Verimatrix, Inc., No. 2-07-cv-321, 2009 U.S. Dist. LEXIS 115264 (E.D. Tex. 2009)

- Principle: A Rule 29 agreement meeting the requirements of contract formation will be enforced
- Facts: A written agreement containing all elements of contract formation was enforced to preclude discovery of e-mails outside the time frame specified in the agreement. *Id*. at *7.


Arbitration
Clauses

ARBITRATION CLAUSES

- **FORUM SELECTION: ARBITRATION**
  - Goal: Expedite the litigation process by agreeing to a private dispute resolution procedure.
  - Reality: Often takes as long as court litigation.

- **HOW TO SPEED UP ARBITRATION: CONTRACT PROVISIONS**
  - Provide for dispositive motions

EXAMPLE PROVISION – "After the date the arbitrator[s] are appointed, upon motion of any party, the arbitrator[s] shall hear and determine any preliminary issue of law asserted by a party to be dispositive, in whole or in part, of any claim or defense."

  - Include a time limit on the arbitration

EXAMPLE PROVISION – "The arbitration proceedings will be concluded within 180 days from the date the arbitrators are appointed."

  - Include discovery limitations (i.e., three depositions per side) or prohibit discovery entirely

ARBITRATION CLAUSES

- **ENFORCING ARBITRATION PROVISIONS: LATEST DEVELOPMENTS**
  - *Epic Sys. Corp. v. Lewis*, 138 S. Ct. 1612 (2018): Arbitration provisions including waivers of class action, collective action, and group arbitration are enforceable in employment agreements.
  - *Cullinane v. Uber Techs., Inc.*, 893 F.3d 53 (1st Cir. 2018): An arbitration provision in Uber's Terms of Service was not enforceable because the link to the term appeared on the same page of the app as other, more conspicuous, hyperlinks. The court suggested that a 'click box' would have provided sufficient notice to make the terms enforceable.

#MeToo Provisions

#METOO PROVISIONS

#METOO IN EMPLOYMENT AGREEMENTS

- Severance payments (or threat of litigation regarding unpaid severance) following #MeToo-related executive departures is giving "Cause" clauses new scrutiny

- Employment/Award Agreement "Cause" prongs now expanding

EXAMPLE PROVISION – "Cause shall mean . . . Employee's [material] breach of any law applicable to the workplace or employment relationship, or Employee's [material] breach of any policy or code of conduct established by the Company[, including such laws and policies relating to anti-harassment, anti-discrimination, and anti-retaliation]. . . ."

- Carve-outs often included in "Good Reason" clauses

EXAMPLE PROVISION – "Good Reason" shall mean . . . (x) a material diminution in Employee's authorities, duties or responsibilities. . . ; provided, however, that a material diminution shall not be deemed to have occurred if Employee's authorities, duties or responsibilities are lessened or otherwise affected as a result of Company actions (including any suspension or reassignment of authorities, duties or responsibilities) taken as a result of any complaint or inquiry relating to Employee's alleged non-compliance with any law applicable to the workplace or any Company policy . . . ."

#METOO PROVISIONS

#METOO IN THE TRANSACTIONAL CONTEXT

- #MeToo reps increasingly found in acquisition/merger agreements

EXAMPLE PROVISIONS

"[To the Knowledge of Seller,] in the last [five (5)] years, no allegations of sexual harassment or violation of Company anti-discrimination, anti-harassment, or anti-retaliation policies have been made against any individual in his or her capacity as an employee of the Company [at the level of [Vice President] or above]. . . ."

"Since [DATE], [to the Knowledge of Seller,] the Company has satisfied all obligations with respect to the investigation of, and any remedial steps relating to, any sexual harassment allegations against any employee, officer, or director of the Company of which the Company was aware."

NDA Provisions in Settlement Agreements

NDA PROVISIONS IN SETTLEMENT AGREEMENTS

I.R.C. SECTION 162(q), AS AMENDED BY 2017 TAX CUTS AND JOBS ACT

> (q) PAYMENTS RELATED TO SEXUAL HARASSMENT AND SEXUAL ABUSE. No deduction shall be allowed under this chapter for – (1) any settlement or payment related to sexual harassment or sexual abuse if such settlement or payment is subject to a nondisclosure agreement, or (2) attorney's fees related to such a settlement or payment.

- Applies to all payments made after December 22, 2017.
- What happens when settlement resolves multiple claims?
  - Separate settlement agreements?
  - Allocation of payments within agreement?

DTSA Whistleblower Protections

DTSA WHISTLEBLOWER PROTECTIONS

- Defend Trade Secrets Act (2016) provides a federal cause of action for trade secret theft and allows for monetary damages, injunctive relief, exemplary damages for willful misappropriation, and attorneys' fees.

- **BUT** recovery of exemplary damages and attorneys' fees is contingent on whether the misappropriating employee had notice of certain safe harbor provisions.

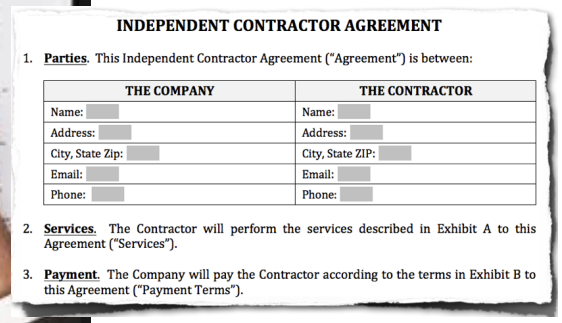
- These safe harbor provisions grant criminal and civil immunity under federal and state law to whistleblowers who disclose trade secrets to attorneys or to government officials in order to report potentially illegal activity.

- **Note**: There is no penalty for *not* providing the required notice, but an employer cannot recover exemplary damages or fees.

DTSA WHISTLEBLOWER PROTECTIONS

Provisions are required in any "contracts or agreements that are entered into or updated after the date of enactment of [the DTSA]:"

- Non-disclosure Agreements
- Offer Letters and Employment Agreements
- Restrictive Covenant and Equity Compensation Agreements
- Employee Severance Agreements
- Employee Handbooks
- Company Policies
- Codes of Ethics
- Independent Contractor and Consulting Agreements (**Note**: Definition of "employee" under DTSA includes "any individual performing work as a contractor or consultant of an employer," and not just employees.)



INDEPENDENT CONTRACTOR AGREEMENT

1. **Parties**. This Independent Contractor Agreement ("Agreement") is between:

THE COMPANY	THE CONTRACTOR
Name:	Name:
Address:	Address:
City, State Zip:	City, State ZIP:
Email:	Email:
Phone:	Phone:

2. **Services**. The Contractor will perform the services described in Exhibit A to this Agreement ("Services").

3. **Payment**. The Company will pay the Contractor according to the terms in Exhibit B to this Agreement ("Payment Terms").

DTSA WHISTLEBLOWER PROTECTIONS

NOTICE OF EMPLOYEE IMMUNITY FOR ANY AGREEMENTS GOVERNING TRADE SECRETS OR CONFIDENTIAL INFORMATION

"Employee shall not be held criminally or civilly liable under any federal or state trade secret law for the disclosure of a trade secret that: (A) is made (1) in confidence to a federal, state or local government official, either directly or indirectly, or to an attorney and (2) solely for the purpose of reporting or investigating a suspected violation of law; or (B) is made in a complaint or other document filed in a lawsuit or other proceeding, if such filing is made under seal.

In addition, an Employee who files a lawsuit for retaliation by an employer for reporting a suspected violation of law may disclose the trade secret to the attorney of the Employee and use the trade secret information in the court proceeding, only if the individual files any document containing the trade secret under seal and does not disclose the trade secret, except pursuant to court order."

Assignment of IP Rights

ASSIGNMENT OF IP RIGHTS

PROMISE TO ASSIGN IP RIGHTS IN THE FUTURE

"I agree to assign/grant..."

"I shall assign/grant..."

"I assign/grant..."

AUTOMATIC ASSIGNMENT OF FUTURE INTEREST

"I agree to assign/grant, and **hereby assign/grant**..."

BEST PRACTICES:

- "Hereby assign" = Magic words that grant rights automatically with no need for additional act.
- Future interest rule using "hereby assign" language creates assignment with priority over another that contains only the word "assigns." *See Filmtec Corp. v. Allied Signal*, 939 F.2d 1568 (Fed. Cir. 1991).
- Not using magic words may result in the loss of patent rights. *See Stanford v. Roche,* 563 U.S. 776 (2011).

IP Indemnity Provisions

IP INDEMNITY PROVISIONS

OVERLY BROAD INDEMNITY PROVISIONS

Boilerplate indemnity provisions may expose licensor to risks and costs that can dwarf the price of the contract

> "Licensor will defend, indemnify, and hold Licensee harmless against a third-party action, suit, or proceeding ("Claim") against Licensee to the extent such Claim is based upon an allegation that a Product as delivered to the Licensee infringes in any manner any intellectual property right of a third party."

BEST PRACTICES:

- Limit Recoverable Damages
- Limit Covered Use
- Limit Covered Entities, Subject Matter, and Geographical Coverage
- Seek Notice & Control of Defense and Settlement

IP INDEMNITY PROVISIONS

LIMIT RECOVERABLE DAMAGES

"We undertake at our own expense to defend you or, at our option and in our absolute discretion, settle any claim or action brought against you by a third party alleging that your possession or use of the Product in accordance with the terms of this Agreement **directly infringes** a third party's intellectual property rights ("Claim") and we **shall be responsible for any reasonable direct losses or direct damages (but not lost profits or any other consequential or indirect damages) awarded against you after a final settlement or final adjudication as a result of or in connection with any such Claim"**

LIMIT COVERED USE

"This section shall not apply where the Claim in question is attributable to your possession or use of the Product **other than in accordance with the terms of this Agreement or use of the Product in combination with any hardware or software not supplied or specified by us if the infringement** would have been avoided by the use of the Product not so combined."

IP INDEMNITY PROVISIONS

LIMIT COVERED ENTITIES, SUBJECT MATTER, GEOGRAPHICAL, AND TIME COVERAGE

"Any indemnities we provide, and any obligation on us to modify, repair or replace the Product, shall not apply if the claim results, in whole or in part, from your conduct or the conduct of someone acting on your behalf or the **conduct of an Outsource Customer, OEM Customer, Sub-licensee, Subsidiary, Outsource Provider, OEM Provider, Successor-in-Interest, Heir, Assign, or someone acting on the behalf of any of these entities**. In particular, but without limitation, we shall have no obligation or liability to you if you **have altered, modified, or amended the Product in any way, produced a derivative version of the Product, used it outside the terms of this Agreement or in combination with any other software not provided by us, or it has not been loaded onto equipment specified by us or suitably configured equipment**. Indemnity from the direct infringement of any patents, trademarks, or copyrights are limited to the indemnity of only such patents, trademarks, or copyrights that are **issued in the United States and territories as of the date of this Agreement**."

IP INDEMNITY PROVISIONS

SEEK NOTICE & CONTROL OF DEFENSE OR SETTLEMENT

"If any third party makes a Claim, or notifies an intention to make a Claim against you, our obligations to indemnify you are conditional on you:
(a) **as soon as reasonably practicable, giving written notice of the Claim to us, specifying the nature of the Claim in reasonable detail**;
(b) not making any admission of liability, agreement or compromise in relation to the Claim without our prior written consent;
(c) giving us and our professional advisers access at reasonable times (on reasonable prior notice) to your premises, officers, directors, employees, agents, representatives or advisers, and to any relevant assets, accounts, documents and records within your custody or control of the Customer, so as to enable us and our professional advisers to examine them and to take copies (at our expense) for the purpose of assessing and/or defending the Claim; and
(d) taking such action we may reasonably request to avoid, dispute, compromise or defend the Claim."

SPEAKER BIOGRAPHY

SEAN BECKER
PARTNER, LABOR & EMPLOYMENT

Houston

+1.713.758.2646

sbecker@velaw.com

Education

- Harvard Law School, J.D. *cum laude*, 1998
- Harvard College, B.A., Government *magna cum laude*, 1994

Recognition

- *Chambers USA,* Labor and Employment (Texas), 2016-2018
- Selected to the Texas Super Lawyers list, *Super Lawyers* (Thomson Reuters), 2012–2018
- *The Best Lawyers in America*©(Woodward/White, Inc.), Litigation - Labor and Employment, 2017-2019

Sean is the head of the Vinson & Elkins' Employment, Labor & OSHA practice. He is board certified in labor and employment law by the Texas Board of Legal Specialization, and advises clients regarding all phases of the employment relationship. His practice incorporates day-to-day advising, employment litigation, and transactional matters. He regularly provides counsel with respect to employee non-competition and non-solicitation matters, including the structuring of restrictive covenant regimes, and the defense and pursuit of non-competition and unfair competition-related claims.

Sean manages employment-related matters for multiple private equity clients, and has litigated a range of complex matters in venues across the country, including disputes relating to employment contracts, class actions, ERISA, and wage-related claims. He has also managed the labor and employment aspects of hundreds of acquisitions, divestitures, and other transactions, and he regularly negotiates and drafts executive employment agreements, severance agreements, and other employment-related contracts.

Representative Experience

- (S.D. Tex.); (5th Cir.) — Obtained summary judgment and Fifth Circuit affirmation of summary judgment on behalf of an international oil company in consolidated ERISA benefits litigation brought by former executive employees
- (S.D. Tex.); (5th Cir.) — Obtained dismissal and Fifth Circuit affirmation of putative class action ERISA claim on grounds of Railway Labor Act preemption
- (Tex. Dist.) — Defeated application for temporary restraining order against our clients, an executive and the start-up company with which he was affiliated, and obtained the prompt dismissal of the underlying breach of contract lawsuit after successfully challenging the enforceability of the non-competition clauses at issue
- Obtained directed verdict on a former chief executive's wrongful termination claim and a successful resolution of breach of contract claim after three-day arbitration
- (Iowa Dist.) — First chair of Iowa state court trial in which the application of employer's drug testing policy was challenged, and employee's requests for reinstatement and damages following positive tests were denied. Obtained affirmation of decision in case of first impression argued before the Iowa Supreme Court
- Obtained summary judgment on all aspects of age discrimination, promissory estoppel, and misrepresentation claims in arbitration brought by a former employee of an international well services company
- Riverstone Holdings in the $9.5 billion formation of Talen Energy Corporation, one of the largest independent power producers in the U.S., through a Reverse Morris Trust spin-off of PPL Corporation's merchant power generation business and the concurrent combination thereof with Riverstone's merchant power generation business and associated debt financings

SPEAKER BIOGRAPHY

J. WESLEY JONES
PARTNER, MERGERS & ACQUISITIONS AND VENTURE CAPITAL

Austin

+1.512.542.8703
wjones@velaw.com

Education

- The University of Texas School of Law, J.D. with honors, 1995 (Secretary of the Chancellors; Order of the Coif; *Texas Law Review*)
- The University of Texas at Austin, B.B.A., Finance, 1992

Recognition

- *Chambers USA*, Technology: Corporate and Commercial (Texas), 2013−2018
- *Legal 500 U.S.*, Technology: Transactions, 2011, 2013, and 2014; Venture Capital & Emerging Companies, 2014–2017

Wes focuses primarily on the representation of publicly traded and privately held companies in corporate transactions, with particular emphasis on private equity and venture capital transactions and mergers and acquisitions.

He has extensive experience representing venture capital firms and their portfolio companies in the software and hardware technology, energy, and life sciences industries. Wes has practiced law for two decades, including as the general counsel of both a privately held and a publicly traded software company.

Representative Experience

- Spredfast in its acquisition of Shoutlet, a social data integration company
- Saudi Aramco Energy Ventures as lead investor in the $25 million Series D financing of ConXtech, a construction technology company that develops and builds mass-customizable, modular, prefabricated and sustainable structural steel building systems
- BMC Software in the acquisition of assets of CDB Software, a mainframe data management company
- SailPoint in the equity investment by Thoma Bravo in the company, a provider of on-premises and cloud identity management software solutions
- Saudi Aramco Energy Ventures in the Series D financing of Novomer, a sustainable chemistry company, pioneering a family of high-performance, environmentally responsible polymers and chemical intermediates
- Pharos Capital Group in its acquisition of Seaside Healthcare, a behavioral health services provider
- iControl Networks in its merger with uControl, a developer of web-based home security systems, combining two market leaders in broadband home management
- JLM-PF Partners in the formation and capitalization of a joint venture formed for the purpose of acquiring Planet Fitness franchises
- YouEarnedIt, a SaaS human resources technology platform, in its $6.5 million Series A financing led by Silverton Partners and IDG Ventures
- Cancer Prevention and Research Institute of Texas in the £16.7 million financing of Cell Medica Limited, a developer, manufacturer, and marketer patient-specific cellular immunotherapy products
- ShippingEasy in the $55 million sale of the company to Stamps.com
- Spredfast in its stock-for-stock acquisition of Mass Relevance, a technology leader in enabling social marketing experiences for brands and media companies
- Cirrus Logic in the $26 million sale of its Apex Precision Power business to a consortium of investors led by Alerion Capital
- FeedMagnet in the $9 million sale of the social media curation company to Bazaarvoice
- Pharos Capital Group in its acquisition of Employee Benefit Solutions, a provider of employee benefit and wellness products for employers

SPEAKER BIOGRAPHY

MARISA SECCO
PARTNER, COMMERCIAL & BUSINESS LITIGATION

Austin

+1.512.542.8781
msecco@velaw.com

Education

- The University of Texas School of Law, J.D. *with high honors*, 2007 (Chancellor; Order of the Coif; *Texas Law Review*)
- The University of Texas at Austin, B.A., Government *with high honors*, 2004

Recognition

- Selected to the Texas Rising Stars list, *Super Lawyers (*Thomson Reuters), 2016 and 2017
- *Texas Lawyer*, Top 20 "Winning Women" litigation and appellate attorneys (Texas), August 2014

Marisa, whose principal area of practice is litigation, represents individuals and entities in a wide range of cases, including commercial disputes, tax controversies, ERISA litigation, intellectual property litigation, restructuring litigation, and civil appeals.

Her experience as the Rules Attorney for the Supreme Court of Texas gives her a unique understanding of Texas procedure and the state appellate process. Marisa was named by *Texas Lawyer* as one of twenty "Winning Women" litigation and appellate attorneys in Texas. She also previously served as a judicial clerk to the Honorable Fortunato P. Benavides of the U.S. Court of Appeals for the Fifth Circuit.

Representative Experience

- Defending Fortune 1000 energy company in expedited lawsuit challenging major commercial transaction in Pennsylvania state court
- Obtained complete dismissal on behalf of four Texas cities of declaratory judgment suit brought by water district in Texas state court
- Defending monetary authority in two adversary proceedings alleging fraudulent transfer in bankruptcy court in the Southern District of New York
- Represented independent oil & gas services company debtor in Chapter 15 bankruptcy proceedings in Western District of Texas and related adversary class action litigation; obtained complete dismissal of adversary proceeding class action
- Defended nutrition company against preliminary injunction sought by dissident shareholders in proxy contest
- First chair trial attorney in US Tax Court case involving the allocation of income between corporate agent and principals
- Prosecuted breach of merger agreement claim with underlying transfer pricing tax issues in Texas federal court and defended related arbitration on behalf of the sellers of an oilfield services company
- Defending a foreign monetary authority in a federal lawsuit relating to the R. Allen Stanford $8 Billion Ponzi scheme
- Representing numerous amici in an appeal pending in the Supreme Court of Texas
- Assisted in obtaining complete dismissal on basis of ERISA preemption of claims by a class of current and former employees against a large insurance company, asserting that the company's long-term disability policy violated state and federal law
- Assisted in representation of a debt-buying entity in a fraud and breach of contract action in federal district court

SPEAKER BIOGRAPHY

JANICE TA
SENIOR ASSOCIATE, INTELLECTUAL PROPERTY

Austin

+1.512.542.8512

jta@velaw.com

Education

- Yale Law School, J.D., 2010
- Stanford University, B.S., Symbolic Systems (concentration in Human-Computer Interaction) and B.A., Art History, 2002

Professional Background

- Judicial clerk to The Honorable Timothy B. Dyk, U.S. Court of Appeals for the Federal Circuit, 2010–2011
- Senior Product Manager and User Experience Designer, 2003–2006

Janice Ta is an intellectual property and technology lawyer who focuses on patent, trade secret, trademark, and complex commercial litigation. She helps clients protect and maximize value from their intellectual property portfolios in a variety of industries and across a broad range of technologies, including computer software, wireless broadband, telecommunications, semiconductors, light-emitting diodes (LEDs), pharmaceutical, chemical, and biotechnology.

Janice's prior work experience as a product manager and user interface designer in Silicon Valley provides her with a deep understanding of the product development and innovation cycle, as well as the business and legal needs of growing technology companies. Janice speaks and writes extensively on IP issues, with a particular interest in recent patent law development. She also writes and speaks frequently on the Defend Trade Secrets Act, and on Section 101 patent-eligibility jurisprudence following the Supreme Court's decision in *Alice v. CLS Bank*. Her litigation practice includes actions in United States District Courts, the International Trade Commission (ITC), state court, and arbitration and mediation tribunals. She also represents clients in briefing appeals before the U.S. Court of Appeals for the Federal Circuit.

Representative Experience

- (W.D. Tex.) — Represented video and telecommunications company in trade secret lawsuit against a former employee that left to join the client's direct competitor, resulting in defendant agreeing to cease use of the asserted trade secrets
- (W.D. Wis.) — Represented a Danish bio-based company in a patent infringement case relating to genetically-engineered enzymes used to make fuel ethanol; the patent was held invalid for lack of written description at the trial court level and affirmed on appeal
- (Cal. Sup. Ct. Santa Clara) — Represented a Silicon Valley company in a software contract and licensing dispute; the team obtained summary judgment in favor of client
- (N.D. Cal.) — Represented one of the world's leading flash memory manufacturers against patent infringement claims involving twelve patents relating to flash memory chips, memory systems, semiconductor processes, and chip packaging patents; after a favorable ruling on the issue of patent exhaustion, all claims were dismissed; defended client's victory in federal circuit appeal
- (S.D. Fla.) — Defended an international Voice-over-IP device and service provider against claims of patent infringement brought by a competitor seeking over $200 million in claimed damages; after obtaining a favorable claim construction and damaging testimony from competitor's CTO, obtained take-nothing judgment for client

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