



Mark B. Mondry

Partner

Phase M LLP

205 De Anza Blvd., Suite 212

San Mateo, CA 94402-3989

(303) 919-4870 (direct)

(650) 349-3521 (fax)

mmondry@phaseM.com

Practice Focus & Expertise:

- Intellectual Property Strategy.
- New Product Development.
- IP Portfolio Optimization.
- Early-Stage Company Strategy.
- Complex Licensing & Corporate Partnering Agreements.
- Open Innovation, M&A and IPO's.

Education:

- UC Berkeley Haas School of Business, B.A.M.P.
- University of Maryland JD, 1989.
- Johns Hopkins University MAS (Management), 1986.
- Miami University (Ohio) B.S. 1983 (Mfg. Engineering).

Bar Admissions:

- California
- Colorado
- District of Columbia (inactive)
- U.S. Patent & Trademark Office

Court Admissions:

- U.S. Court of Appeals, Federal Circuit.
- U.S. Court of Appeals, 9th Circuit.
- U.S. Court of Appeals, D.C. Circuit
- Northern District of California.

Professional Certifications:

- Certified Licensing Professional (CLP) - Licensing Executives Society (LES).
- Certified New Product Development Professional (NPDP) - Product Development and Management Association (PDMA).

Mark Mondry is a registered patent attorney specializing in intellectual property value optimization, including strategic intellectual property generation, procurement, commercialization and monetization. He has over twenty years of legal and business experience in the medical device, biotechnology, and renewable energy, software, and consumer electronics industries.

Mr. Mondry brings goal oriented executive management experience to his legal services, incorporating a global perspective. His clients have ranged from early stage companies to large publically traded companies, all innovation focused. His expertise includes optimizing complex ip portfolios, providing value based business development and licensing representation, and developing litigation avoidance and technology leveraging strategies in a wide range of industries. His specific skills encompass a broad range of ip and technology value extraction techniques, including opportunity identification, ip landscape analysis, technology scouting, structuring and negotiating complex transactions, open innovation initiatives, new product development strategies, brand optimization, technology acquisitions and spin-outs, and other corporate transactional work including M&A's and IPO's. His patent background includes extensive domestic and foreign patent prosecution, patent interferences, and general client counseling across the entire patent lifecycle.

Prior to co-founding the Phase M law firm, Mr. Mondry founded Phronesys LLC, a business advisory firm directed to strategy and innovation consulting. He has served in a variety of legal and executive management roles, including as President and CEO of LSDI, a privately held design and manufacturing company in the consumer electronics installation industry. He has also served as VP and General Counsel, and as VP New Business Development, for Healthetech Inc., a dynamic medical device company he helped grow to a successful IPO.

Before Healthetech, Mr. Mondry was Patent Counsel for Origin Medsystems Inc., a subsidiary of Eli Lilly & Company, and subsequently was Patent Counsel for Guidant Corporation following its spin-out from Lilly. At Guidant, his responsibilities included building international patent portfolios, business development initiatives around emerging technologies and a variety of activities for Guidant's in-house venture capital organization. In addition, Mr. Mondry served as Director of Operations for Guidant's \$1bil Vascular Intervention Division, successfully managing numerous facilities and staff in multiple geographies inside and outside the U.S.

Mr. Mondry's legal career began in private practice with the intellectual property law firm Stern, Kessler, Goldstein & Fox in Washington D.C., and later with the San Francisco law firms Townsend & Townsend & Crew and Graham & James LLP, where his practice focused primarily on global patent prosecution, licensing and general intellectual property related client counseling. He began his career as an engineer with the Defense and Electronics Systems Division of Westinghouse Electric Corporation where we worked on advanced airborne radar systems

Education:

Mr. Mondry received a B.S., from Miami University (Ohio) in 1983 with a major in Manufacturing Engineering, his Master's degree in management (M.A.S.) from the Johns Hopkins University in 1986 and his J.D. from the University of Maryland in 1989, where was an Editor for the *Maryland Law Review*. Additionally, he has completed the Berkeley Advanced Management Program (BAMP) at the Haas School of Business at U.C. Berkeley.

Activities:

Mr. Mondry is a member of the Association of Corporate Counsel (ACC), the Licensing Executives Society (LES), the Product Development and Management Association (PDMA) and the American Bar Association (ABA). He serves as the Programs Chair for the Rocky Mountains Chapter of LES and is active in several committees of the PDMA. Among his many activities in the business community, Mr. Mondry is the 2010 Executive in Residence for the Colorado School of Mines Engineering and Technology Management (ETM) Master's Program in the Division of Economics and Business. He also served as a Finalist Judge for the University of Colorado Denver Business School's Bard Center for Entrepreneurship 2008 Business Plan Competition.

Professional Activities and Publications:

Mr. Mondry is a frequent speaker at various business and legal organizations, including the Licensing Executives Society, the Product Development and Management Association and American Chemical Society. His publications include co-author of *Sneakers, Design Patents and Summary Judgments: Opening a New Era in the Protection of Consumer Designs* Journal of the Patent and Trademark Office Society, vol. 71, p. 524 (1989) and *Survey of Developments in Maryland Law - Property* Maryland Law Review, vol. 47, p. 899 (1988). Mr. Mondry is a co-inventor of U.S. patent application 20080221482 A1 (published Sept. 11, 2008) directed to electrical installation components.

Sample Litigation Representations:

Hess v. Advanced Cardiovascular Systems, Inc.

Mr. Mondry represented Advanced Cardiovascular Systems (as Of Counsel, serving as in-house Patent Counsel for ACS) as the patent owner in the appeal before the Federal Circuit challenging a decision in the lower federal court that Hess was not a co-inventor of the balloon angioplasty catheter at issue. The decision was affirmed, and ACS retained full rights and ownership of the subject patent.

Allanz Insurance Co. v. Guidant Corporation

Mr. Mondry represented Guidant Corporation in this trademark infringement action (as in-house Counsel for Guidant) over the trademark Guidant. Guidant obtained a preliminary injunction against infringer Allanz Insurance, and the injunction was upheld on appeal.

General Surgical Innovations Inc. v. Origin Medsystems Inc.

Mr. Mondry represented Origin Medsystems (as in-house Patent Counsel) in this multi-issue dispute that included trade secret, patent infringement, and patent interference matters as well as a corresponding patent interference in the U.S. Patent and Trademark Office. The issues were ultimately resolved through settlement and an ultimate merger under an acquiring entity.

U.S. Surgical Corp. v. Origin Medsystems Inc.

Mr. Mondry represented Origin Medsystems (as in-house Patent Counsel) in this patent infringement matter, which included a TRO hearing, and summary judgment proceedings, as well as an appeal to the U.S. Court of Appeals for the Federal Circuit.

Selected IP Related Transactions:

- Spin-out of Guidant Corporation from Eli Lilly & Co. and subsequent Guidant IPO.
- Negotiated early technology licensing and development agreements for technology that became Gynecare, Inc. (NASDAQ)
- Prepared IP analysis on robotic surgery technology developed at SRI that became Intuitive Surgical, Inc.
- Performed IP due diligence for Guidant acquisition of Endovascular Technologies (EVT).
- Technology Transfer of nutritional database technologies from U.S. Dept. of Health to Healthetech Inc.
- Acquisition of infant products company by Healthetech Inc.
- Acquisition and integration of a software informatics company by Healthetech Inc.
- Investment and co-development agreements between Proctor & Gamble Co. and Healthetech Inc.
- Software development and distribution agreements between Palm Inc. and Healthetech Inc.
- Commercialization agreements between Bally's Total Fitness and Healthetech Inc.
- Numerous multi-party technology development agreements on behalf of Healthetech Inc.
- Commercialization agreements between Jenny Craig Inc. and Healthetech Inc.
- Distribution agreements between Microlife Inc. and Healthetech Inc.
- Series C private investment funding, and IPO SEC registration process for Healthetech Inc.