

Susan B. Montgomery



Executive Professor of Law and Business

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Education

JD Northeastern University School of Law

MAE Rhode Island School of Design

BFA Rhode Island School of Design

Research and Teaching Interests

Professor Montgomery's interests are in the areas of intellectual property (IP) and business transactions, with an emphasis on IP assets, international IP strategies, and business transactions. She also teaches law school courses on trademark law, international IP law, and business transactions practice.

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Awards and Honors

"Best of the Best," Euromoney/Legal Media Group, London UK, 2005, 2009

"Super Lawyers," Corporate Counsel Edition, Law & Politics, Minneapolis MN, 2008, 2009

"International Who's Who of Business Lawyers," Law Business Research, Inc., London UK, 2004-2009

"World's Leading Trademark Law Practitioners," Euromoney/Managing Intellectual Property, London UK, 1996-2008

"Top Attorneys in MA," Boston Magazine, Boston MA, 2008

Contributor to IP Law Award, Suffolk University Law School, Boston MA, 2007

"Outstanding Women in IP," IP Law 360 Newswire, New York NY, 2007

Volunteer Service Award, International Trademark Association, New York NY, 2005

Service and Leadership Award, Rhode Island School of Design, Providence RI, 2000

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Selected Publications

Worldwide Trademark Transfers Law & Practice, Clark Boardman Callaghan/INTA (1992-2007) Co-Edited with Richard J. Taylor

"IP Bad Guys and Good Guys," "The Voice of the ABA," "The Certainty Imperative for Patent Law Reform," and "Doing What is Right: Solving the Problem of Counterfeiting and Piracy," CHAIR'S COLUMN, IPL NEWSLETTER (2006-2007)

Benefits of Timely Copyright Registration, International Bar Association Committee L News (April 2003) Co-Authored with John L. Welch and Thomas M.S. Hemnes

Trademarks and Hyperlinks: Implied Rights and Express Agreements, World e-Commerce & IP Report, BNA International (September 2002)

Intellectual Property Transfers - Holding Companies, Intellectual Property Assets in Mergers and Acquisitions, John Wiley & Sons, Inc. (2002) Chapter Co-Authored with Leonard Schneidman

Security Interests in Intellectual Property, ALI-ABA Business Law Journal (2001)

IP Collateral: an emerging financing tool, Managing Intellectual Property (September 1999) Co-Authored with Carmen Eggleston

Off the Mark: Talking Tax in a Trademark World, Trademark World (May/June 1998) Co-Authored with Leonard Schneidman, and Audrey Nacamuli

UCC 2B Could Result in Ambiguous Intellectual Property Rights, The National Law Journal (May 18, 1998) Co-Authored with Robin Maisashvili

The Bankruptcy Code, The Copyright Act, and Transactions in Computer Software, 1987 Computer/Law Journal 327 Co-Authored with Thomas M.S. Hemnes

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Work in Progress

Professor Montgomery is working on reform of IP laws and regulations affecting business in the U.S. She has provided testimony and advocacy on behalf of the Section of Intellectual Property Law of the American Bar Association (ABA) to members and staff of the Judiciary Committees of the U.S. Senate and U.S. House of Representatives for reform of patent and trademark laws, and to the U.S. Patent and Trademark Office on various rulemaking proposals. She testified on behalf of the ABA before the Judiciary Committee of the U.S. House of Representatives on proposals to reform aspects of Federal law affecting the availability and value of IP for asset-backed financing.

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Selected Presentations

Moderator, "Relationships, Relationships, Relationships," Women in the Law Conference, Northeastern University School of Law, Boston MA, 2009

Speaker, "What Lawyers Say, What Clients Hear," International Trademark Association (INTA) Forum, New York NY, 2009

Plenary Speaker, "New Trademark Initiatives," and Plenary Panelist, "Legislative Agenda for the 111th Congress," American Intellectual Property Law Association (AIPLA), Miami FL 2009

Speaker, "Trademark Essentials for Business Decision Makers," and Panelist, "Transactions That Can Trigger IP Issues," Suffolk University Law School Conference, Boston MA, 2008

Moderator, "Internet Domain Names: A Trademark Practitioner's Point of View," INTA Roundtable, Boston MA, 2008

Speaker, "Brands without Boundaries: Trademark Issues for the Twenty-First Century," IP Conference, Northeastern University School of Law, Boston, MA, 2008

Moderator, "Business Method Patents," Section of Intellectual Property Law's Members Forum, ABA Annual Meeting, San Francisco, 2007

Moderator, "A Historical Perspective on How the Trademark Dilution Revision Act Came to Be and the Effect It Has Had and/or Will Have on the Courts," AIPLA Annual Conference, Boston MA, 2007

Speaker, "Security Interests in Intellectual Property," ALI-ABA Annual Uniform Commercial Code Article 9 Program, various cities, 1999-2007

Speaker, "Choosing the Global Brand," INTA International Strategies Forum, New York NY, 2006

Speaker, "Rights and Rewards of Intellectual Property," Innovation Imperative Forum, University of Cincinnati, Cincinnati OH, 2006

Speaker, "International Harmonization of Trademark Registration Systems," INTA Annual Meeting, Amsterdam, Netherlands, 2003

Speaker, "Managing Your Company's Intellectual Property Assets," New England Corporate Counsel Association (NECCA), Waltham, MA, 2002

Speaker, "Drafting Internet Agreements and Licenses," INTA Annual Meeting, Washington, DC 2002

Co-Chair and Moderator, Trademarks in Business Transactions Forum, INTA, New York NY 2002

Moderator, "The Trademark Office Goes E-Government," Suffolk University Law School, Boston MA 2001

Speaker, "What Transactional Lawyers Should Know About the Interaction of Intellectual Property and Commercial Laws," ABA Annual Meeting, New York NY, 2000

Speaker, "Trademark Transfers and Intellectual Property Holding Companies," Trademarks in Business Transactions Forum, INTA, Arlington VA, 1999

Speaker, "Authorship and Ownership of Copyrights," Lorman Copyright Basics Program, Boston, MA 1999

Speaker, "Intellectual Property in the Internet Era," NECCA, Waltham MA, 1998

Moderator, "Trademark Office Practice," INTA Roundtable, Boston MA, 1998

Speaker, "Security Interests in IP and Proposed Amendments to the Copyright Act, Patent Act and Lanham Act and UCC Article 2B," ABA Section of Intellectual Property Law Conference, 1997

Speaker, "Intellectual Property Due Diligence in International Transactions," International Due Diligence in

Mergers & Acquisitions, Boston Bar Association, Boston MA 1997

Speaker, "Protecting Your Authorship," Boston Alumni Club, Boston MA, 1997

Speaker, "UCC Article 2B: A Guide for the Uninitiated," High Technology in the Twenty-First Century, Suffolk University Law School, Boston MA, 1997

Speaker, "Hot Intellectual Property Issues for Marketers: How to Use the Internet When the Law is Unsettled," Internet Marketing Association, Boston MA, 1996

Chair and Speaker, "International Trademark Issues," NECCA, Waltham MA 1996

Speaker, "Security Interests in Intellectual Property," Hot Issues in Secured Lending, MCLE, Boston MA, 1995

Speaker, "Trademark Rights, Registration and Licensing for Artists," Lawyering for the Arts, MCLE, Boston, MA, 1993

Speaker, "Working With Foreign Lawyers," Massachusetts Bar Association, Boston MA, 1993

Speaker, "Security Interests in Marks," NECCA, Waltham MA, 1992

Speaker, "Frontiers of Software Protection," Lex Mundi Conference, St Louis MO, 1991

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Industry and Academic Experience

Professor Montgomery is Of Counsel to Foley Hoag LLP, where she continues to advise U.S., foreign and multi-national businesses as she has for over 20 years as a Partner (1995-2008) and Associate (1986-1994). Her experience includes strategic planning for development, exploitation and protection of IP assets; counseling U.S. and foreign companies on domestic and international business transactions, including acquisitions, alliances, licenses and professional services contracts; advising owners, lenders and investors regarding the purchase, sale, collateralization and license of IP assets; managing prosecution and enforcement of international trademark portfolios; advising businesses on activities and disputes related to on-line use of IP, clearance of new marks and IP for innovative products; and advertising, packaging, franchising and trade practices compliance. Her experience includes 18 years as outside general counsel to a company in the business of providing critical path software and implementation services in the U.S. and British aerospace industry.

Professor Montgomery is also on the faculty of this university's School of Law, where her courses include Intellectual Property Transaction Practice and International Intellectual Property Law. She was previously on the adjunct faculty at Suffolk University Law School. She serves on the Advisory Council on Intellectual Property at Franklin Pierce Law Center.

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Professional Services

Professor Montgomery is a past Chair of the Intellectual Property Law Section of the ABA and member of the Section's Content Advisory Board. She has served the Section in a variety of leadership positions, including Chair (2006-2007), Officer (2004-present), Council Member (2002-2004) and Content Advisory Board

(2006-2008). She served by appointment of the President on the ABA Working Group on UCITA (Uniform Computer Information Transactions Act) (2001-2003) and as Co-Chair of the ABA Joint Task Force on Security Interests in Intellectual Property (1997-1999).

She is an Advisor to the American Law Institute (ALI) on the Principles of the Law of Software Contracts project and Advisor to ALI-ABA on Intellectual Property Programming. She is a past member of the boards of the International Trademark Association (INTA) and Volunteer Lawyers for the Arts of Massachusetts, Inc.

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