

Susan Barbieri Montgomery

Executive Professor of Law and Business Northeastern University 400 Huntington Ave., 25 Cargill Boston, MA 12115 617 373 7071 s.montgomery @neu.edu	Of Counsel Foley Hoag LLP 155 Seaport Blvd. Boston MA 02210 617 832 1222 sbm@foleyhoag.com
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ACADEMIC EXPERIENCE

Northeastern University, Boston MA

Executive Professor of Law and Business, College of Business Administration & School of Law (2008 – present)

Courses: Executive Understanding of Business Law and Intellectual Property, Innovation Workshop, Intellectual Property for International Business, Intellectual Property Transactions Practice and International Intellectual Property Law and Practice, and modules for Innovation, New Product Development, Global Strategies and Global Enterprises courses

Faculty Advisor: JD/MBA Dual Degree Program (2008 – present), INTA Moot Court competition Team (2009 - present) and Husky Innovation Challenge (2009 - present), IDEA Legal Co-op (2011 – present)

Faculty Committees: Upper Level Writing Requirement Committee (2010 - present); Institute for Global Management (IGIM) (2011- present), Law Curriculum Committee (2008-9), Alumni Forum Planning Committee (2008 – 2010), Business and Law Committee (2009-2010) and Student Affairs Committee (2009-10)

Service: Faculty Interdisciplinary Roundtable in Law and Business (Organizer & Moderator, 2008 – present) and ABA Judicial Intern Opportunity Program (Interviewer, 2008 – present)

Guest Lecturer, School of Law (1997)
Course: Intellectual Property Law

Suffolk University Law School, Boston MA

Adjunct Faculty (1999-2008)
Courses: Trademark Law and International Intellectual Property Law Seminar

Guest Lecturer (1998)

Course: Professor Janice Meuller's International Intellectual Property Law

Franklin Pierce Law Center, Concord NH

Member, Advisory Council on Intellectual Property (2005-2011)

Harvard University Law School, Cambridge MA

Guest Lecturer (1994)

Course: Professor David Kennedy's Developing European Law

EDUCATION

Northeastern University School of Law, Boston MA

J.D., 1986

Coop Employment: Massachusetts Inspector General's Office (Fall 1984); Beveridge & Diamond, Washington DC (Spring 1985); Foley, Hoag & Elliot, Boston MA (Fall 1985); and Clerk for Justice J. Harold Flannery, Superior Court of Massachusetts (Spring 1986)

Teaching Assistant (1984-1985) and Head Teaching Assistant (1985-1986), Legal Practice Course

Rhode Island School of Design, Providence RI

Masters of Arts in Education (MAE), 1978

Studios: Textiles, Ceramics and Flat Glass

Rhode Island School of Design, Providence RI

Bachelor of Fine Arts (BFA), 1971

Majors: Photography and Education

LAW-RELATED EMPLOYMENT

Foley Hoag LLP

Of Counsel (2008 – present), Partner (1995-2008), Associate (1986-1994)

Business Department, Intellectual Property Department and Intellectual Property Practice Groups

Practice includes strategic planning for development, exploitation and protection of intellectual property (IP) assets; counseling U.S. and foreign companies on domestic and international business transactions, including acquisitions, alliances, licenses and professional services contracts; advising on the purchase, sale, collateralization and license of IP assets; managing prosecution and enforcement of international trademark

portfolios; and advising companies on trademark clearance, online use of IP and advertising, packaging, franchising and trade practices compliance; such as:

- Advising a Canadian company on establishment and operation of franchise operations in the U.S.;
- Counseling a variety of foreign companies acquiring or selling businesses in the United States, such as a Belgium company purchasing the assets of its bankrupt U.S. licensee, an Australian company establishing U.S. operations with several online media acquisitions, and a British software company selling its U.S. business operations;
- Advising a multinational client in its worldwide corporate reorganization, the related strategic restructuring and consolidation of the client's IP holdings, and its subsequent use of IP assets in worldwide operations, including acquisition, sale and licensing of patents, trademarks, copyrights and know-how in over 200 countries; and
- Serving as outside general counsel to a company providing critical path software and implementation services in the U.S. and British aerospace industry.
- Expert witness on business transactions in *General Mills, Inc. v Kellogg Company, et al*, Civil No 06-3686 (D. Minn)

HONORS AND AWARDS

“Who's Who in North American Education” (2010-2011 Edition)

“World's Leading Women in Business Law,” Legal Media Group, London 2010 Inaugural Edition

“World's Leading Trademark Law Practitioners,” Euromoney/Managing Intellectual Property, London 1996-2012 Editions

“Super Lawyers,” Corporate Counsel Edition, 2008 - 2011

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

“International Who's Who of Business Lawyers,” Law Business Research, Inc., London 2004-2011 Editions

“Outstanding Women in IP,” IP Law 360 Newswire, 2007

“Best of the Best,” Euromoney/Legal Media Group, London 2005, 2009

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

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

BOOKS AND ARTICLES

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.
Hennes

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. Hennes

PROFESSIONAL AND CIVIC SERVICE

RISD (Rhode Island School of Design)

Member, Board of Trustees (2009 – present)

Chair, Academic Affairs Committee (2010 – present)

Member, Executive Committee (2010 – present), Committee on Trustees and
Governance (2010 – present), Academic Affairs (2009 – present), Investment
Committee (2009 – 2010), and Student Life Committee (2009 – 2010)

American Bar Association (ABA)

Delegate, ABA House of Delegates (2009 - present); Member, ABA Working Group on UCITA (Uniform Computer Information Transactions Act) (2001 - 2003); Co-Chair, ABA Joint Task Force on Security Interests in Intellectual Property (1997 - 1999)

Testimony on Federal IP law reforms on behalf of the ABA before the Judiciary Committee of the U.S. House of Representatives (1999, 2006)

ABA Section of Intellectual Property Law leadership service:

Chair (2006 - 2007); Officer (2004 - present); Member, Section Council (2002 - present); Content Advisory Board (2007 - 2008)

Chair, Famous Marks Subcommittee (2008 - 2010); Member, Patent Law Reform Task Force (2008 - 2011); Past Chair and Member of various committees (1989 - present)

Testimony and advocacy of patent and trademark law reforms on behalf of the IP Law Section to members and staff of the Judiciary Committees of the U.S. Senate and House of Representatives (2004 - present), and to the U.S. Patent and Trademark Office on various rulemaking proposals (2005 - 2007)

American Law Institute (ALI)

Principles of the Law of Software Contracts, Advisor (2004 - 2010)

ALI-ABA

Program Committee: Advisor on Intellectual Property (2006 - 2009)

Intellectual Property Owners (IPO)

IP Licensing Committee (2011 - present); Trademark Law and Practice (International) Committee (2010 - 2011)

International Trademark Association (INTA)

Member, Academia Committee (2010 - present); Member, Board of Directors (1995-1997); Chair, Publishing Boards (1988 - 1995); Committee Chair (2001 - 2003); Member, Emerging Issues Subcommittee (2001 - 2009)

Lex Mundi

Chair, Intellectual Property Practice Group (2000 - 2003)

Volunteer Lawyers for the Arts of Massachusetts, Inc. (VLA)

Member, Board of Trustees (1992 - 1998); Panel Attorney (1991 - present)

CLE AND OTHER PRESENTATIONS

Program Co-Organizer (with Dimitri Vlassis and Nikos Passos) and Drafter/Presenter of "Themes for Anticorruption Law Syllabus," OECD & Northeastern University

International Workshop on the Development of Academic Anti-Corruption Programme, Boston 2011

Speaker, "IP Strategies for Global Brands," Recent Developments in International Commercial Law, Suffolk University School of Law, Boston MA, 2011

Moderator, "Tinkering with IP: Adjustments for Optimum IP Effect," IP/Innovation Connection, Northeastern University, Boston MA 2011

Moderator, 'Genetically Modified Foods in U.S. Courts,' From Seed to Stomach: Food and Agriculture Law Symposium, Northeastern University Law Journal, Boston MA 2011

Moderator, "Functionality: Not Just for Plaintiffs Anymore?" INTA Annual Meeting, San Francisco CA 2011

Moderator and Commenter, INTA Trademark Symposium, 2011, 2012

Moderator, "Challenges for Entrepreneurs in the Electronic Games Industry," Global Entrepreneurship Program, Northeastern University, Boston, MA 2010

Speaker & Short Paper, "Alternative Means of Controlling Parallel Imports in the United States," Lex Mundi IP Practice Group Annual Meeting, Boston MA, 2010

Speaker, "Practical Considerations for IP Professors," AIPLA Conference, New York, NY, 2010

Moderator, "Corporate Responsibility," Transactional Law Conference, Northeastern University School of Law, Boston MA, 2010

Moderator, "Global Intellectual Property Issues for Nanotechs," Global Regulation of Nanotechnology Conference, NUSL, Boston, MA, 2010

Speaker, "Critical Thinking & Critical Making," RISD by Design, Providence, RI, 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," Mid-Year Meeting, American Intellectual Property Law Association (AIPLA), Miami, FL, 2009

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

Speaker, "Trademark Essentials for Business Decision Makers" and Panelist, "Transactions That Can Trigger Intellectual Property 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," IP Law Section 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 (UCC) 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 IP Law Section CLE, 1997

Speaker, "Intellectual Property Due Diligence in International Transactions,"
International Due Diligence in Mergers & Acquisitions, Boston Bar Association (BBA),
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,
MCLA, 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 (MBA),
Boston MA, 1993

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

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

BAR ADMISSIONS

Massachusetts

U.S. District Court for the District of Massachusetts

U.S. Court of Appeals, District of Columbia Circuit

OTHER EMPLOYMENT

School Department, Westport MA

Teacher (1975-1983); Department Chair (1981-1983)

School Departments, Fall River MA and New Bedford MA

Substitute Teacher (1974-1975)

School Department, Tiverton RI

Teacher (1971-1973)

Self-Employed Artist

Textiles (1973-1978); Flat Glass (1978-2001)