

GORDON G. WAGGETT, P.C.

Intellectual Property Law

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Firm Profile – Gordon G. Waggett, Shareholder

EDUCATION

- J.D. **South Texas College of Law**, Houston, TX, 1988.
Research Editor SOUTH TEXAS LAW REVIEW.
- M.S. **Rice University**, Houston, TX, 1984.
Major: Environmental Science and Engineering
Graduate thesis and post-thesis research and publications included groundwater contamination studies and oil field scale and corrosion inhibition studies.
- B.A. **Southern Methodist University**, Dallas, TX, 1980.
Major: Chemistry and Biology.

BAR ADMISSIONS

State Bar of Texas; U.S. Patent and Trademark Office; U.S. Court of Appeals for the Fifth and Federal Circuits; U.S. District Court for the Southern District to Texas.

PROFESSIONAL EXPERIENCE

Dec. 2003 – present: **Shareholder, Gordon G. Waggett, P.C., Houston, Texas**

Mr. Waggett is the founding shareholder of this law firm bringing over 23 years of diverse experience in intellectual property and corporate legal and business matters (domestic and international), and continues to focus his practice on the protection, enforcement, licensing and commercialization of intellectual property assets through the effective use of patents, trademarks, trade secrets, and copyrights. Mr. Waggett also maintains broad experience in intellectual property litigation including, infringement of patents, trademarks and copyrights, misappropriation of trade secrets, unfair competition, non-competition and other intellectual property law matters.

Jun. 2012 – present: Also Of Counsel to Adair & Myers PLLC.

Oct. 2000-Dec. 2003: **M-I L.L.C., a Smith International/Schlumberger Joint Venture Company, Houston, TX**

Managing Counsel Intellectual Property. Mr. Waggett founded and managed all aspects of the intellectual property management function for M-I (now wholly owned by Schlumberger) including: creating and organizing in-house intellectual property legal section within company's law department; identifying and protecting intellectual property for worldwide operations, including research centres, joint ventures and new acquisitions; managing U.S. and non-U.S. intellectual property-related litigation (through trial and appeal, and through pre-trial alternate dispute resolution settlement negotiation) and pre-litigation risk assessment and dispute resolution; Mr. Waggett's responsibilities also included overseeing and/or conducting acquisition and divestiture due diligence from intellectual property perspective (team approach with other counsel); implementing internal patent/trademark/agreement/litigation docketing system and intellectual asset management database; drafting and negotiating contracts, including joint development, licenses, acquisitions, divestitures, joint ventures, alliances, consultancy, secrecy and non-analysis agreements; implementing standard contract formats; handling opinion matters relating to intellectual property infringement and validity; conducting trademark clearance searches and prosecuting trademark applications; managing outside counsel handling extensive worldwide patent prosecution dockets; instituting and chairing patent and paper

review committees for strategic decision making relating to patents, trademarks and other technical publications; participating as member of Product Line Council and Product Development Committee; working with executive management teams on strategic matters; working from time to time with research centre managers in areas of ISO certification compliance, environmental and other QHSE issues, tax matters and general supplier relations issues; coordinating with legal department on handling of numerous general legal and departmental issues. Mr. Waggett reported directly to General Counsel and functionally with management.

Nov. 2000-Dec. 2003: **MASI, L.L.C., an M-I L.L.C. / ActiSystems Inc. Joint Venture Company, Houston, TX**

Secretary and Managing Counsel Intellectual Property. Mr. Waggett managed all aspects of the intellectual property of this newly formed Joint Venture, including domestic and international patent portfolio and trademark matters. He served as Secretary since May 2002, attended Board meetings, and maintained Board meeting minutes. Mr. Waggett was involved with the intellectual property due diligence associated with formation of the Joint Venture and reported to the Board and MASI General Manager.

Jan. 1997 – Oct. 2000: **Schlumberger (Houston, TX; Paris, France)**

• Jan. 2000 – Oct. 2000. **Legal and Intellectual Property Counsel.** Reservoir Development/Well Intervention and Stimulation Business Segments, Sugar Land Technology Center, Sugar Land, Texas. In this capacity, Mr. Waggett managed the Intellectual Property Law Department, including technology groups located at two research centres. His responsibilities included: managing extensive worldwide patent and trademark prosecution docket with use of in-house legal and paraprofessional staff and outside counsel; negotiating supplier and joint venture relationships, licenses and contract matters; license negotiations; patent and trademark opinion work; monitoring and optimizing intellectual property expenditures; creating intellectual property strategic platforms; supervising litigation; actively participating in business segment management team.

• Feb. 1998 – Jan. 2000. **Legal Manager/General Counsel.** Wireline & Testing Headquarters, Paris, France. Mr. Waggett handled, supervised and managed Wireline & Testing product line legal issues, including, evaluation, monitoring and settlement of litigation, patent licenses, acquisitions and due diligence, joint ventures, alliances, employment issues, supplier and manufacturer issues, intellectual property and technology matters, risk management, services contracts, safety, export control compliance and other product-line business issues. He actively worked with and visited worldwide field and product centre locations. Mr. Waggett extensively travelled to conduct negotiations and make numerous presentations to worldwide Oilfield Service Management and staff (multi-product line) on issues of intellectual property protection and legal compliance. He reported to Wireline & Testing Headquarters' President and was actively involved as part of this executive management team.

• Jul. 1997 – Jan. 1998. **Intellectual Property Counsel and Legal Manager.** Perforating & Testing Center, Rosharon, Texas. Mr. Waggett founded and managed the Centre's Intellectual Property Law Department. He handled all intellectual property issues, including, managing worldwide patent portfolio, litigation support, contracts, joint ventures, and serving as liaison for addressing Centre's general legal issues. Mr. Waggett reported to the Centre's General Manager.

• Jan. 1997 – Jun. 1997. **Patent Attorney.** Sugar Land Product Center, Sugar Land, Texas. In this role, Mr. Waggett was involved in patent prosecution and agreement work for Wireline & Testing oilfield service area. He reported to the General Patent Counsel.

1992-96: **Fish & Richardson P.C.,** Houston, Texas.

Associate. Involved in a variety of intellectual property litigation, prosecution and transactional matters.

1988-92: **Arnold, White & Durkee (most recently called Howrey LLP),** Houston, Texas.

Associate. Involved in a variety of intellectual property litigation, prosecution and transactional matters.

1986-88: **Fulbright & Jaworski,** Houston, Texas.

Law Clerk. Involved primarily in environmental and energy litigation.

1984-85: **Rice University,** Houston, Texas.

Research Scientist. At Rice University, Mr. Waggett's research was focused on groundwater chemistry and geochemistry areas. He worked under research grants from, *e.g.*, The U.S. Environmental Protection Agency, U.S. Department of Energy and The Gas Research Institute.

Litigation Examples

Mr. Waggett has extensive experience handling litigation matters, including the following:
(past results are no guarantee of similar future results)

- Lead counsel in trademark/copyright/trade secret/copyright infringement and unfair competition case relating to spray-on asphalt emulsions. Obtained preliminary injunction on behalf of plaintiff; obtained award of \$1.8 million in civil contempt damages for defendants' repeated violations of the preliminary injunction; obtained \$12 million damages award and permanent injunction after bench trial.
- Lead counsel in trademark, unfair competition and/or patent litigations regarding: restaurant trademarks (TRO obtained, case settled favorably with agreed permanent injunction); clothing marks (oppositions); oilfield service mark (opposition); national retailer's marks; competitive cheerleading programs; infant clothing; pipe notch cutters; bulk cargo bags; bulk cargo container liners; and miniature horses. Handled numerous injunction hearings.
- Co-counsel in patent litigation in areas including: superconductivity inventorship; telecommunications equipment support structures; welding masks; clothing designs; drywall stilts; water and wastewater purification; steam cleaning of pipelines; oilfield chemical drilling fluid and fracturing fluid formulations; purge & trap devices for use with gas chromatography and mass spectroscopy; furnace heat exchangers; oil field packers; blood clot dissolvers; cookies; and math coprocessor licenses.
- Co-counsel in trademark, trade secret, unfair competition, copyright and/or non-competition agreement litigation in areas including: geomechanics software; clothing design; educational software; retail and commercial flooring (settled after mediation); steam cleaning of pipelines (settled after mediation); water and wastewater treatment; oriental food manufacturing (jury trial); production of coiled tubing (jury trial); oil field thread protectors; business competitive analysis software; diesel engines (settled after obtaining preliminary injunction for client); petrochemical storage tank leak detectors; soft drinks; oilfield pipe cutters; plastic bag manufacturing; hydrogen sulfide gas removal; and oilfield shaker screens.
- Co-counsel in copyright infringement case regarding architectural designs (jury trial).
- Prelitigation advice including: preparation and response to cease and desist letter (patent, copyright, trademark, domain name, rights of privacy disputes); risk management; trademark counterfeiting investigations; internet issues; fact and evidence gathering; witness interviewing; and opinion work.
- Prepared and negotiated settlement of litigation and technology issues; experienced in mediation and arbitration as an alternative dispute resolution technique and general settlement negotiation.
- Appellate experience before the Texas Court of Appeals (on briefs and oral argument – breach of covenant not to compete), and Federal Circuit Court of Appeals (on briefs – patent infringement; inventorship).
- Coordinated and managed non-U.S. patent and trademark litigation, including *ex parte seizure* (saisie-description).
- Monitored and supervised U.S. patent interference procedure and other matters handled by outside counsel.
- Experienced with interplay between U.S. Bankruptcy laws and intellectual property litigation.

Transactional Examples

- Preparation and negotiation of strategic alliance agreements, joint development agreements, manufacturing agreements, joint ventures, patent and trademark licenses, distributorship agreements, acquisition and divestitures due diligence (intellectual property issues), asset purchases, licenses, confidentiality agreements, non-competition agreements, book publishing contracts, musical production arrangements, promotion of art exhibits, and other business contracts.
- US and/or international patent application preparation and/or prosecution directed to: solids removal system and method; separation and recovery of NGLs from hydrocarbon streams; separation and recovery of ethane and heavier hydrocarbons from LNG; method and apparatus for separating and drying solids from a solids laden wastewater stream; laser beam system for golfer alignment; one-piece garments; air compressors; painting equipment; method of treating concussions; hub caps; athletic apparel; notebooks; jumper apparatus; escutcheon device; method of setting tile; front flow lavatory; drawer containing sink; intelligent management of oil and gas platform equipment; anchor system for a kayak; undersea leak remediation device and method; method of treating the near-wellbore zone of the reservoir; pneumatic apparatus for use in lifting and installing garbage disposers; utilizing electromagnetic radiation to activate filtercake breakers downhole; oil-based hydraulic fracturing fluids and breakers and methods of preparation and use; methods for controlling temperatures in the environments of gas and oil wells; tooth protector; quick attaching and detaching nut; combined pet food and water dispenser; metal baluster with ornamental ends; system for displaying advertisements on a monitor at traffic signals; pipe repair systems and methods; vacuum separators; fluid additive calibration; water-based asphalt emulsion-based coatings; method for simulating reservoir performance; portable exercise device; building system for roofing and siding; photo and memorabilia albums; stage play advertising and distribution methodology; energy generation; bed sheets; medical devices, including endotracheal intubation devices; water and wastewater purification; reusable template for creating thin films for use in electron-beam specimen analysis; decorative lights; gift packaging; light hanging devices; tanning booths; sludge dewatering; various chemical formulations and synthesis methodologies; athletic training; methods of teaching; electronic trading cards; novel guitar strings; drilling fluid and well completion fluids compositions and methodologies; fluids/solids handling and separation equipment; oilfield environmental remediation technologies; fracturing fluids and methodologies; well treatment methodologies and chemistries; oil field completion tools; oilfield centralizers; production chemistry; well cementing; coiled tubing; method of processing seismic data; well completion apparatus for use under pressure; well casing

seals; dual action valve; phased perforating guns; formation isolation valve; small hole retrievable perforating system for use during extreme overbalanced perforating; zonal isolation method and apparatus; microprocessor implemented wellbore tools; packer locking apparatus; highshot density perforating gun; kitty litter compositions and manufacturing technologies; genetic engineering (baculovirus expression vectors and gene promoters, recombinant DNA technology, adipokinetic precursor signal sequences, improvements to the insect signal sequences useful to improve the efficiency of processing and secretion of foreign genes in insect systems); oil spill and snow removal devices; waste disposal and incineration; water purification systems; sludge treatment systems; oil separation devices; liners for hazardous waste storage; rail mounted crane brake systems; writing instruments; treatment of obesity; and various designs (cars, motorcycles, pens, lights, balusters, weighted exercise pants, pet food dispensers, etc.).

- Supervised foreign counsel on strategy for handling prosecution of patent and trademark applications.
- Experienced in preparation of opinions directed to patentability, patent validity and infringement issues.
- Trademark prosecution, Madrid System filings; clearance searches, re-branding, opinions, applications, renewals, and experience in opposition and cancellation proceedings; domain name protection and enforcement. Experienced in electronic filing procedures for trademark applications.
- Experienced in copyright issues, including architectural plans, sculptural works, protection of software, logos, graphic designs, musical operas, photographs, books, operations manuals, art collections, film projects, handbag design, publishing contracts, rights of publicity and privacy.

Other

- AV® Preeminent Peer Review Rated – the highest possible rating in both legal ability and ethical standards. AV® Preeminent is a certification mark of Reed Elsevier Properties Inc., used in accordance with the Martindale-Hubbell® certification procedures, standards and policies.
- Speaker, “Paperless Litigation”, Texas State Bar Convention (Austin, Texas, June 1994).
- Drafted and testified on behalf of legislation passed in the Spring 1995 Session of the Texas Legislature.
- 2001-2008. Texans for Alternatives to Pesticides. Member of Board of Trustees of this Texas non-profit corporation involved in environmental educational activities. Positions held: Secretary 2002; President 2003 - 2007.
- 2004-2008. Member, Business Networking International, Downtown Houston Chapter, Positions held: President; Vice President; Visitor Host.
- Held appointed position for years on UNICEF’s Advisory Panel regarding The U.S. Baby-Friendly Hospital Initiative.
- Assisted teaching at a local church in Paris, France and in Houston, TX.
- Assisted with coaching of a French boys basketball team in Paris, France; coached boys basketball teams in Houston; assisted in running, coaching, and officiating soccer matches for Houston inner city soccer league.
- Languages: English, some French and some Spanish.

Personal

Married (Regá) with two children, Cameron and Hannah. Hobbies include: family activities, traveling, outdoor activities, various sports (including tennis, basketball and running), international folk dancing; playing in folk dance and polka band; gardening, hiking and camping.