



## J. Derek Mason, Ph.D., CLP

### Partner

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Derek Mason, Ph.D., CLP, uses his organic chemistry background and experience to advise national and international clients in a wide range of intellectual property matters.

As a former chemist in industry with a doctorate in organic chemistry, Derek's thorough understanding of the sciences and technologies surrounding clients' innovations enables him to skillfully represent their interests across the full spectrum of chemical and related technologies, including pharmaceuticals, medical and biotech diagnostic devices, polymers, nanotechnology, textiles, and petrochemicals. His practice focuses on patent preparation and prosecution, licensing, IP issues arising in corporate transactions, client counseling, and opinions on IP issues.

Derek works with both domestic and international clients to advise them over a broad range of IP concerns, including conducting M&A due diligence investigations and risk assessment related to IP ownership, establishing and developing patent portfolios, avoiding infringement when launching products, and crafting and implementing procedures to protect and enhance their inventions and add value. His practice also includes counseling clients on the relationship between patents and the FDA (including Orange Book issues), innovative design-around strategies, the interplay of utility and design patents, trade secret protection, procuring plant patents and plant variety protection (PVP) certificates, and litigation avoidance.

While obtaining his doctorate and undergraduate degrees, Derek studied organometalloid chemistry and conducted research in the area of organic photochemistry, publishing and presenting papers in both of these areas. Before entering his patent law practice, Derek worked as a chemist for a diversified international chemical company.

Derek and his wife, Sarah, are newly obsessed with the fastest-growing sport in the United

States – pickleball – and use it as a vehicle for building community: playing, teaching new players, and organizing events to bring players together. They also enjoy volunteering in local food charities, playing golf, and watching college athletics (in an ACC house divided between UNC and Wake Forest) – when not spending time with their growing family, which includes five adult children, their four spouses, three grandkids, two parents, and a furry kitty named Sudie.

## Education

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- George Washington University National Law Center (J.D., 1996)
- University of Wisconsin (Ph.D. in Organic Chemistry, 1988)
- University of North Carolina at Chapel Hill (B.S. in Chemistry, with highest honors, Phi Beta Kappa, 1983)

## State Admissions

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- Ohio, (Practice Pending Admission)
- Virginia, 1996

## Federal Admissions

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- United States Patent and Trademark Office
- United States Court of Appeals, Federal Circuit
- United States Court of Appeals, Fourth Circuit
- United States District Court, Eastern District of Virginia

## Certifications

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- Certified Licensing Professional (CLP)

## Service Areas

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- Intellectual Property
- Patent Procurement
- Patent Litigation
- Trade Secret Litigation
- Health & Life Sciences
- IP Business Strategy & Agreements
- Technology Transfer

**Industries Represented**

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- Chemical
- Medical Devices
- Pharmaceutical & Medicine
- Textile

## **Publications & Events**

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### **SPEAKING ENGAGEMENTS**

- “Developments in US IP Law Affecting Licensing,” Licensing Executives Society Annual Conference (October 2011)
- “Advanced Patent Licensing 2008: Critical Issues in Joint Development Agreements,” Practising Law Institute (PLI) Seminar (May 2008)
- “Securing IP Rights in Nanotechnology: Best Practices,” Webinar (April 2008)
- “The Growing Importance of IP in Corporate Mergers and Acquisitions,” 7th Annual Intellectual Property Law Symposium, The University of Texas School of Law (February 2006)

### **PUBLICATIONS**

- “Assignor Estoppel and IPRs: Possible Impact of *Arista v. Cisco* on Employment or Assignment Agreements,” *IPWatchdog* (January 2019)
- “Arbitration: A Quick and Effective Means for Patent Dispute Resolution,” *les Nouvelles* (December 2011)
- “Arbitration of Patent Disputes in the United States,” *LES Japan News*, Vol. 52, No. 3 (September 2011)
- *U.S. Patent Litigation: 150 Q&A* (June 2011)
- “Arbitration: A Quick and Effective Means for Patent Dispute Resolution,” *North Carolina Journal of Law and Technology*, Vol. 12, Issue 2 (June 2011)
- “Protecting the Intangible: Managing Intellectual Property Through M&A,” *Acquisition International* (March 2011)
- “The Economic Espionage Act: A New Federal Regime of Trade Secret Protection,” *Journal of the Patent and Trademark Society*, Vol. 79 (1997)

### **MEDIA**

- “Tucker Ellis Nabs Life Sciences IP Pro From Oblon McClelland,” *Law360* (October 2022)
- “Tips for Safeguarding Your Products from Fakes,” *Industrial Equipment News* (August 2019)
- “\$31.6M Award Illustrates Risks in Co-Development Deals, Even Decades Later,” *Technology Transfer Tactics* (January 2019)

### **Honors**

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- IAM Patent 1000 (Washington, D.C. Metro Area) (2016, 2017, 2019-2022)
- IAM Strategy 300: The World’s Leading IP Strategists (2015-2022)
  - » Global Leaders (2023)
- The Best Lawyers in America© (2020-2023)

### **In the Community**

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- American Bar Association
- Virginia Bar Association
- American Chemical Society
- American Intellectual Property Law Association (AIPLA)
- Licensing Executives Society
- Rotary Club of Alexandria
- Local Food Charities Volunteer
- CTC Pickleballerz Co-Organizer