

## ROBERT F. HELD

### *Over 20 Years in Intellectual Property & 30 years in Business Development*

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#### **EXPERIENCE:** HELD IP, LLC ([www.heldip.com](http://www.heldip.com))

- 14506 Monticello Drive, Cooksville, MD 21723

February 2016

#### **President**

- ◆ With over 20 years of experience as a licensing executive, Bob Held has extensive experience in many facets of intellectual property (IP), including monetization, strategy, management, acquisitions, expert witness, contracts, negotiations, IP in government contracting & the FAR/DFAR, people management, budgets, IP infringement damage estimate, including reasonable royalty determination and lost profit analysis, valuation, marketing, strategic agreements, university & government agreements, IP issues in M&A, IP training & public speaking and strategic and tactical input on IP matters. ([www.linkedin.com/pub/robert-bob-held-clp/1a/8b1/268/](http://www.linkedin.com/pub/robert-bob-held-clp/1a/8b1/268/))
- ◆ Recognized as a thought leader and frequent speaker at licensing forums worldwide
- ◆ Certified Licensing Professional (CLP) and Recognized as an IAM 300 – World’s Leading IP Strategist
- ◆ Active DOD Security Clearance

#### LICENSING EXECUTIVES SOCIETY (USA & CANADA), INC.

([www.lesusacanada.org](http://www.lesusacanada.org)) Reston, VA

Oct. 2019 to Oct. 2020

#### **Past President and Chairman of the Board of Directors**

Oct. 2018 to Oct. 2019

#### **President and Chairman of the Board of Directors**

- ◆ Serving on the Board from 2012 to 2020 in roles with increasingly greater responsibility for this 50-year old Society of around 1800 intellectual property licensing executives from around the world

#### TELECOMMUNICATION SYSTEMS, INC. ([www.telecomsys.com](http://www.telecomsys.com))

- 275 West St., Annapolis, MD 21401

2011 to February 2016

#### **Vice President, Intellectual Asset Management**

- ◆ All assets of TeleCommunication Systems, Inc. were purchased in February 2016 by Comtech Telecommunications Corporation.
- ◆ Reported to the SVP & General Counsel, had overall responsibility for all intellectual asset management (IAM) activities including capture, management, monetization, training, and offensive and defensive litigation involving patents, trademarks, copyrights, etc. for this \$400M operating company.
- ◆ Since 2011 built the IAM organization into a multi-million dollar profit center.
- ◆ Proven track record generating significant revenues from business development & strategic licensing of advanced technology in the fields of semiconductors, navigation, wireless, commercial electronics, advanced semiconductor fabrication processes, medical devices, and various other technologies.
- ◆ Proven track record negotiating and closing high-value, highly complex & highly political transactions (university sponsored research, patent, technology, know-how, foundry, software, agency agreements, MOA’s, acquisitions, investments, etc) with global companies, universities, government organizations, and individual inventors.
- ◆ Extensive experience assessing the commercial significance of inventions and technology, conducting due diligence, developing a strong and enforceable intellectual property portfolio, building and analyzing financial models, and developing marketing programs.
- ◆ Skilled in the development of long-lasting interpersonal relationships with inventors from operating companies, university professors and TTO’s, and individual inventors.
- ◆ Extensive contact list in key industries
- ◆ Certified Licensing Professional - CLP™
- ◆ Experienced in ITAR, Export, etc.

**NORTHROP GRUMMAN CORPORATION, ELECTRONIC SYSTEMS**  
([www.ngc.com](http://www.ngc.com))

· 7323 Aviation Blvd, MS 1105, Baltimore, MD 21240

2003 to 2011

**Director, Intellectual Property & Strategic Technology Agreements Group, Electronic Systems Sector**

- ◆ Reported to the Chief Technology Officer with overall responsibility for the strategic and tactical challenges associated with optimizing the company's IP portfolio, including the management of this portfolio for the purposes of competitive advantage, monetization, and profit & loss for the Electronic Systems' Sector, an \$8B business sector of Northrop Grumman.
- ◆ Responsible for strategic engineering development agreements (supplier, university) and other cooperative ventures for advanced military programs. e.g. Sponsored research agreements with PSU, JHU, Chesapeake Innovation Center, Texas A&M, Columbia University, etc.

**BTG INTERNATIONAL INC** ([www.btgplc.com](http://www.btgplc.com) [FTSE:BGC])

· Five Tower Bridge, 300 Barr Harbor Drive, 7<sup>th</sup> Floor, West Conshohocken, PA 19428

1998 to 2003

**Associate Vice President, Technology Commercialization, Semiconductors**

- ◆ Led the US Semiconductor Licensing Team, responsible for the licensing and commercialization of high technology in the fields of semiconductors, multi-media, data compression, medical devices, and various other electronics technologies.
- ◆ Proven track record generating revenues by protecting and licensing new technologies acquired from academic and corporate sources worldwide.
- ◆ Experience in assessing the commercial significance of inventions and technology, conducting due diligence, developing a strong and enforceable intellectual property package, building and analyzing financial models, developing marketing programs, and taking the product to market via various commercial routes, i.e. licensing, new ventures, start-ups, and patent assignments.

**ASTM - AMERICAN SOCIETY FOR TESTING AND MATERIALS**

· 100 Barr Harbor Drive · West Conshohocken, Pennsylvania 19428-2959

1990 to 1998

**Manager, Technical Committee Operations Division**

- ◆ Proven track record managing technology transfer activities, including the coordination of over 1000 senior technical clients from industry, government & academia, in five international industries dealing with various emerging technologies and standards development within a not-for-profit environment.
- ◆ Responsible for the analysis, development, sales, marketing strategy and promotion, for hundreds of new industry standards along with related products.
- ◆ Proven track record coordinating industry/government strategy involving highly diverse and controversial topics.

**HEWLETT-PACKARD COMPANY** · Valley Forge, Pennsylvania

1989 - 1990

**International Electronic Components Sales Force**

- ◆ Inside/Outside field sales covering military, telecommunications, and general industrial applications.

**EDUCATION:**

**DREXEL UNIVERSITY** · Philadelphia, Pennsylvania

**LeBow College of Business and Administration**

1999

◆ Masters in Business Administration (MBA) – Marketing Management; focusing on International Marketing, International Business, and International Finance.

- GPA: 3.75, Magna Cum Laude.

◆ *Curriculum Sampling:* New Product Planning/Strategy and Development, International Marketing & Finance, International Business Management, Investment Management, Marketing Management, Marketing Strategy and Planning, International Economics.

**VILLANOVA UNIVERSITY** · Villanova, Pennsylvania

**College of Engineering**

1988

◆ Bachelor of Science in Electrical Engineering (BSEE)

## **PROFESSIONAL CERTIFICATIONS:**

- ◆ Certified Licensing Professional (CLP) with the Licensing Executives Society USA and Canada since 2008
- ◆ Intellectual Asset Management (IAM) 300 World's Leading IP Strategists since 2015
- ◆ Prior Member of the Gathering 2.0 – Leading Worldwide IP Strategists

## **EXPERT WITNESS CASES:**

- ◆ Fact Witness TeleCommunication Systems, Inc. in the TeleCommunication Systems, Inc. vs IPCube Partners (2016). Case settled after my deposition.
- ◆ Fact Witness for TeleCommunication Systems, Inc. in the TeleCommunication Systems, Inc. vs Smith, Gambrell & Russell, LLP (2018)
- ◆ Licensing expert for Nuance Communications, Inc. in the Nuance Communications, Inc., Agnitio Corp. & Agnitio S.L. vs. Pindrop Security, Inc. Civil Action No: 1:17cv1193 (2018). Case settled on behalf of my client after my report was filed.
- ◆ Damages from lost patent rights, Case No. 01-20-0005-3647, American Arbitration Association. Reports filed, deposed, testified July 2021. Case settled on behalf of my client after my testimony.

### **Open Cases:**

- ◆ Licensing Expert for defendant in a civil action for misuse of trade secrets.
- ◆ Damage Expert, rebuttal report about patent infringement, product delisting, and injunction. Report filed in March 2021.
- ◆ Damage Expert, patent infringement damage. Report filed in May 2021.
- ◆ Damage Expert, rebuttal report about patent misuse, unfair competition and damages. Ongoing but stayed by the court.
- ◆ Licensing and Damages Expert in two civil actions for damages from use of software outside the bounds of the license

## **PROFESSIONAL SOCIETIES:**

1998 to present

- ◆ Licensing Executives Society (LES) (sample)
  - LES Board of Trustees 2012 to 2020
  - Frequent educational faculty for LES education programs
  - Chair of the Aerospace & Transportation Committee 2006-7
  - Co-Chair of the High Technology Sector (HTS) Comprehensive Royalty Rate and Deal Terms Survey 2012, 2014 & 2017
  - Secretary of the HTS 2011-2012
  - Vice-Chair of the HTS 2012-2013
  - Chair of the HTS 2013-2014
  - Workshop Chair for the HTS Winter 2012 meeting in Anaheim
  - Overall Program Chair for the 2013 LES Annual Meeting in Philadelphia
  - LES Standards Development Organization Board Chair 2017-2018

## **PUBLICATIONS:**

- ◆ LES High Tech Sector Royalty Rate & Deal Terms Survey (2011)
- ◆ LES High Tech Sector Royalty Rate & Deal Terms Survey (2014)
- ◆ LES High Tech Sector Royalty Rate & Deal Terms Survey (2017)
- ◆ LES High Tech Sector Royalty Rate & Deal Terms Survey (2021)

## PRESENTATIONS:

- ◆ Licensing Executives Society (LES) (sample):
  - Workshop entitled Complexities of Commercializing IP in the Transportation, Aerospace & Defense (TAD) Industry
  - Mini-plenary entitled Comprehensive Royalty Rate and Deal Terms Survey
  - Workshop entitled Living with Your Deals - Value Impact and Recognition for Deals Well Done
  - Workshop entitled Comparison of Royalty Rates, Deal Terms, and Best Practices across the CEEM, High Tech, and Life Sciences Sectors
  - Mini-Plenary entitled One Year after the GAO NPE Litigation Report
  - March webinar on the 2014 Royalty Rate and Deal terms Survey
  - Frequent faculty member for LES education courses
  - Webinar March 18, 2015 HTS Deal Terms Survey
  - August 2020 – LES Brazil – Mock Negotiations Panel
  
- ◆ IP Strategy Summit:
  - May 2013 – Panel on Proactive Enforcement
  - November 2013 – Panel on ROI, Value & Monetization
  - January 2014 – Panel on Defending Against NPE’s
  
- ◆ Others:
  - July 2014 – Amsterdam – Invited panelist at Intellectual Property Business Congress (IPBC)
  - September 2014 – Invited panelist for Thomson Reuters/West Law Webinar – New IP Business Model
  - April 2015 – Presentation to the DC Bar entitled “The Art of the Deal”
  - May 2018 PatentSight Business Congress – Bonn, Germany
  - July, September, November – Shanghai IP Education Courses
  - November 2018 – invited speaker at China International Import Expo (CIIE) & Guangdong IP trade Expo
  - May 2019 PatentSight Business Congress – Bonn, Germany
  - November 2019 International Conference on Patents and Inventions, Lima, Peru Sponsored by INDECOPI

\*Deal sheet available upon request