



MARK A. TIDWELL

Partner

mark.tidwell@haynesboone.com

PRACTICES: Intellectual Property, Technology Transactions, Patent Prosecution and Counseling, Patent Office Trials, Trademarks, Intellectual Property Litigation, Outsourcing Transactions, Copyright, Energy, Power and Natural Resources, Oil and Gas, Oilfield Services, Mechanical, Trademark Prosecution; **INDUSTRIES:** Technology Mergers and Acquisitions, Domain Name Disputes, Vehicle Electrification; **TRENDING ISSUES:** Environmental, Social and Governance (ESG)

HOUSTON

1221 MCKINNEY STREET
SUITE 4000
HOUSTON, TX 77010
T +1 713.547.2551
F +1 713.236.5587

Mark A. Tidwell is a partner in the Intellectual Property Practice Group in the Houston office. He focuses his practice on prosecution, acquisition, licensing, divestiture and enforcement of patent rights, trademark rights, trade secrets and copyrights. Mark has filed and prosecuted hundreds of patent, trademark and copyright applications. He was honored in Intellectual Asset Magazine's Patent 1000: The World's Leading Patent Practitioners, Globe White Page Ltd, 2014, 2016-2020 for patent prosecution and IP transaction work. Mark often guest lectures at the Texas A&M Mays School of Business on Intellectual Property.

EDUCATION AND CLERKSHIPS

- J.D., South Texas College of Law Houston, 1993
- B.S., Mechanical Engineering, Texas A&M University, 1989

ADMISSIONS

- Texas
- Wisconsin
- U.S. Patent and Trademark Office

COURT ADMISSIONS

- U.S. District Court for the Southern District of Texas

Representative Experience

Technical Focus:

Mark has experience in oil field exploration and production tools and equipment, power generation systems, medical and biomedical devices, nanotechnology, engines, data communications, heat transfer equipment, computer software and business methods, fuel cells and renewable energy systems, agricultural equipment, sports equipment, safety and security equipment, food preparation equipment, ultrasound equipment, seismic equipment, and ornamental designs, as well as other mechanical, electro-mechanical and chemical-mechanical devices.

Intellectual Property Transactions:

His intellectual property transactions experience includes technology development and distribution agreements, marketing agreements, software and hardware agreements, outsourcing agreements, IT services agreements, branding/private labeling agreements, IP license agreements, IP assignments and transfer agreements, Internet agreements (Access, Terms of Use, Privacy Policy, Linking Agreements, Hosting Agreements, E-commerce Agreements, Web Site Development), stadium naming rights agreements, sponsorship agreements, intellectual property and software escrow agreements, employee confidentiality and assignment agreements, and confidentiality agreements. Mark also handles intellectual property due diligence for mergers, acquisitions, technology transfers and other corporate transactions. He has expertise in U.S. Dept. of Energy Acquisition Regulations and Federal Acquisition Regulations.

Intellectual Property Prosecution/Protection:

Mark's intellectual property prosecution and protection experience includes the management of domestic and foreign patent and trademark portfolios based on a strategy for maximizing his clients' key intellectual property and technology assets.

Patents - Preparation and prosecution of domestic and foreign patent applications, reissue applications, infringement opinions, patentability opinions, clearance opinions, validity opinions, interferences, and appeals to the Board of Patent Appeals.

Trademarks - Trademark selection, development, licensing and protection, preparation of domestic and foreign trademark, service mark, trade dress and product configuration applications, trademark registration oppositions and cancellations, and trademark clearance opinions.

Copyrights, Trade Secrets and Internet - Intellectual property rights counseling and assessment of Internet web sites and businesses, including Digital Millennium Copyright Act compliance, copyright of web site materials, web site use of third party materials, web hosting, patenting Internet technology, software and methods/processes, issues relating to trademark infringement and dilution over the Internet as well as disparaging and knock-off sites, meta-tag and other index use issues, and linking issues.

Intellectual Property Litigation:

Mark's intellectual property litigation experience includes complex patent litigation involving patent infringement, patent invalidity, and technical aspects of patent prosecution procedures. He also handles trademark infringement, unfair competition, copyright infringement and breach of contract involving intellectual property. His technical background and experience in filing and prosecuting hundreds of patent, trademark and copyright applications provides his clients with a significant advantage in intellectual property litigation disputes.

Industry Experience:

Mark was formerly employed as a research and development engineer designing downhole oil field tools for Western Atlas International, Inc. in Houston, Texas. In addition to his law degree, Mark holds a B.S. in mechanical engineering.

Professional and Community Activities

- American Bar Association
- Houston Bar Association
- Houston Intellectual Property Law Association
- American Intellectual Property Law Association
- Member, Rice Alliance for Technology and Entrepreneurship Advisory Board, Rice University

Selected Publications and Speeches

- "Crafting an Aligned Patent Prosecution Strategy," panelist, 2nd Annual IP Strategy

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- Summit, Houston, TX, October 4, 2017.
- “Technology Development in a Low Cost Environment - Traps of Collaborative Technology Agreements,” panelist, The Center for American and International Law Energy Industry IP Law Conference, Plano, TX, March 28, 2017.
 - “Intellectual Property Law,” guest lecturer, Texas A&M University - Mays Business School, 2013 – present.
 - KSR v. Teleflex: Supreme Court Fine-Tunes the "Obviousness Standard" for Patentability and Invalidity.