

Melissa L. Silverstein

Director, UTEP's Office of Technology Commercialization

Patent Attorney

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Experience

The University of Texas at El Paso (UTEP), El Paso, Texas

Director – Office of Technology Commercialization

2014-Present

- **Managing UTEP's Patent Portfolio**: managing 200+ issued patents, active prosecution matters, and new patent applications from UTEP faculty and student inventors for all technology areas; managing marketing of portfolio to locate licensees; managing patent licensing process and variety of contracts surrounding IP.
- **Invention Triage**: developing and implementing invention analysis process to search invention disclosures; performing patent searches using patent analytics software; performing market research; locating potential licensees through assignees on patent search
- **Compliance**: locating and entering federally-funded invention disclosures into iEdison database through NIH; implementing a Patent License Agreement compliance program – diligent commercialization monitoring and fee payment monitoring.
- **Outreach**: education outreach to UTEP and regional community to educate on patent prosecution, marketing, and licensing.
- **Active and Passive Patent Marketing Activities**: implemented use of Flintbox software for passive patent marketing and UTEP patent storefront; re-designing and drafting one-page tech sheet summaries of each of the UTEP technologies available for licensing (100+ technologies).
- **Start-Up Company Assistance**: developing decision tree for licensing v. start-up; interfacing with various tech transfer offices to develop guidelines for start-ups (business plan requirements, entrepreneur qualifications, capital required, milestones, start-up friendly lawyers); working closely with UTEP's Mike Loya Center (student start-up incubator) representative to define start-up policies.
- **Office Management**: Hiring, training, and managing 2 full time employees and 5 undergraduate student interns.

Ortiz & Lopez, PLLC, El Paso, Texas

Patent Attorney

2009 - 2014

- Prepared and prosecuted patent applications in a diversity of technologies areas in the chemical, biological, nanotechnology, mechanical, electrical, computer hardware and software realms.
- Client base included Honeywell, Xerox, IBM, Clear Channel, LSI, Los Alamos National Labs, Fermilab, U.S. Department of Energy, U.S. Department of Homeland Security, U.S. Coast Guard, National Institutes of Standards and Technology, UTEP, and Texas Tech University.
- Drafted 70 first to file patent applications / in excess of 500 office actions.
- Negotiated and drafted licensing and non-disclosure agreements.

Strasburger and Price, San Antonio, Texas

Patent Attorney

2008

Whitaker, Chalk, Swindle & Schwartz, Fort Worth, Texas

Patent Agent Externship

2007

Education

2007 JD, Texas A&M School of Law, Fort Worth, TX (formerly Texas Wesleyan)

2002 BS, Biology, *magna cum laude*, University of Texas at San Antonio

Admissions

2010 United States District Court, Western District of Texas

2008 State Bar of Texas

2006 United States Patent and Trademark Office

Memberships

Association of University Technology Managers (AUTM); El Paso Bar Association