

# Snell & Wilmer

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## Jeffrey D. Morton, Ph.D.

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## Main Bio

Jeff Morton is a partner in our Orange County, Los Angeles and Phoenix offices who represents start-up and large enterprises for their intellectual property and commercial law needs. He serves as external IP counsel to dozens of companies around the world, and also represents numerous leading international law firms to protect their clients' intellectual property rights in the United States.

Jeff has significant patent prosecution and strategic patent counseling experience in a wide range of technology areas including genomics, immunology, molecular biology, and organic chemistry. He also has an active trademark and transactional practice, and has represented clients in numerous intellectual property-related transactions. He is regularly called upon to give timely and cost-effective advice when clients are commercializing their intellectual property assets. Due to his bar admissions in the United States and Canada, Jeff's practice includes providing cross-border advice to Canadian clients operating in the U.S., and vice versa.

## Education

- University of Pennsylvania, Wharton School (Leadership & Management Certificate, 2019)
- University of British Columbia, Faculty of Law (J.D., 2007)
  - Associate Editor, U.B.C. Law Review
- Washington University in St. Louis, School of Medicine (Ph.D., Immunology, 2004)
- University of Victoria, Faculty of Science (B.Sc., Biology and English, with distinction, 1998)

## Professional Memberships & Activities

- American Bar Association
- Licensing Executives Society, USA and Canada
- San Diego Intellectual Property Law Association
- San Diego County Bar Association

## Representative Presentations & Publications

### Speaking Engagements

- [The Phoenix CFO Leadership Council's Law School for the CFO Program](#), Phoenix, AZ (October 17, 2019)

- "Negotiating IP Rights in Industry Sponsored Research Agreements," Co-Presenter, Strafford Webinar (October 16, 2018)
- "From the Lab to the Marketplace," Invited Lecturer, University of Arizona, Tech Launch Arizona (2017)
- "Intellectual Property Bootcamp," Invited Lecturer, University of British Columbia (2015)
- "Intellectual Property Licensing: Key Differences Between Canada and the United States," Invited Lecturer/Co-Presenter, Intellectual Property Institute of Canada (2014)
- "Intellectual Property Protection and Commercialization," Guest Lecturer, Thompson Rivers University Faculty of Law (2014)
- "Protecting Your Client's Intellectual Property: An Overview of the Different Forms of IP Protection," Guest Lecturer, South Asian Bar Association of British Columbia (2013)
- "Intellectual Property Management and Technology Commercialization," Course Instructor, University of British Columbia Faculty of Applied Sciences (2013)
- "Enforcing IP Rights in Canada," Guest Lecturer, USLAW Conference (2013)
- "IP Commercialization and Patent Licensing," Guest Lecturer, University of Victoria Faculty of Law (2013)
- "Commercializing Intellectual Property," Guest Lecturer, British Columbia Association of Institutes and Universities (2013)
- "Provisional Patent Application to Commercialization," Guest Lecturer, British Columbia Inventors Society (2013)
- "Introduction to Patent Licensing," Guest Lecturer, University of Victoria Faculty of Law (2012)
- "Intellectual Property Overview: Trade-marks, Copyrights, Patents and IP Licensing," Guest Lecturer, Edwards, Kenny & Bray LLP (2012)
- "Foundations of Intellectual Property: Trade-marks, Copyrights, Patents and IP Licensing," Guest Lecturer, University of British Columbia Faculty of Applied Sciences (2012)
- "The Role of Patents in Drug Research," Guest Lecturer, Centre for Drug Research and Development (2010)
- "Trade-mark Infringement on Online Auction Sites," Guest Lecturer, University of British Columbia Faculty of Law (2008-2010)

### **Legal Publications**

- "[Ring the changes: New patent legislation is about to come into force in Canada](#)," Co-Author, Intellectual Property Magazine (October 2019)
- "[Approaching Antibody Patents After Amgen V. Sanofi](#)," Co-Author, Law360 (January 30, 2019)
- "[Patent And Copyright Changes In The New NAFTA](#)," Co-Author, Law360 (November 8, 2018)
- "[What To Consider When Crafting Biotech NDAs](#)," Co-Author, Life Science Leader (October 4, 2018)
- "Time after Time," Co-Author, Intellectual Property Magazine (September 25, 2018)
- "[The Medical Device Excise Tax: Three Potential Outcomes](#)," Co-Author, Medical Device and Diagnostic Industry (September 7, 2018)
- "[Amendments to Rights of Federally Funded Inventions and Government Owned Inventions](#)," Co-Author, Snell & Wilmer Legal Alert (April 23, 2018)
- "[Supreme Court Decision Limits Post-Sale Restrictions by Patent Owners](#)" Author, SWIPLit Blog (May

30, 2017)

- "[Improving the Prognosis for Your Diagnostic Method Patents](#)," Co-Author, Bloomberg BNA's Patent, Trademark & Copyright Journal (March 3, 2017)
- "Patent Prosecution Highway Revisited," Author, Knowledge Bytes (March 2014)
- "Key Differences Between Canada and the United States in Licensing Intellectual Property," Co-Author, IPIC Bulletin (January/February 2014)
- "Combating Counterfeiting in Higher Learning Environments," Author, Campus Counsel (October 2013)
- "Patentability of Computer-Implemented and Medical Use Inventions in Canada," Author, Knowledge Bytes (September 2013)
- "Navigating the New Copyright Waters," Author, Risk 101, Vol. 7, Iss. 2 (Spring 2013)
- "Patent Due Diligence in M&A Transactions," Author, Business Matters (April 2013)
- "Declaring Control in Expungement Proceedings," Author, Canadian Trademark Blog (2013)
- "2013 – A New Year Rings in with a New Copyright Landscape in Canada," Author, Knowledge Bytes (February 2013)
- "Navigating the New Copyright Waters," Author, Campus Counsel (February 2013)
- "No Quid Means No Quo – Supreme Court of Canada Invalidates Patent," Author, Knowledge Bytes (December 2012)
- "Engineering a Successful Trademark Opposition: Canada's Federal Court finds that KELLY ENGINEERING RESOURCES mark is deceptively misdescriptive," Author, Canadian Trademark Blog (2012)
- "The Sound Prediction Test in Canada: Where did it come from and where is it going?," Co-Author, Intellectual Property, R. Dimock Ed. (2012)
- "CoreLogic, Inc. v. MLXjet Media Corp.," Author, Case Brief in Canadian ReMARKS (June 2012)
- "Federal Court of Appeal upholds irrevocable abandonment of patent application," Author, International Law Office Intellectual Property Newsletter (January 9, 2012), Lexology (November 17, 2011), IP Perspectives (Autumn 2011)
- "Kost Klip Manufacturing v. BGI Holdings Inc.," Author, Case Brief in Canadian ReMARKS (July/August 2011)
- "A 'Bright Line' for the Patentability of Stem Cells?," Co-Author, Intellectual Property, R. Dimock Ed. (2010)
- "Canadian Intellectual Property Office news," Co-Author, International Law Office Intellectual Property Newsletter (November 2010), IP Perspectives (Autumn 2010), World Trademark Review Daily (October 2010)
- "CIPO proposed changes to post-Final Action procedures," Author, International Law Office Intellectual Property Newsletter (November 2010), IP Perspectives (Autumn 2010)
- "Federal Court clarifies Final Action and post-appeal procedures," Author, International Law Office Intellectual Property Newsletter (September 2009), IP Perspectives (Summer 2009)
- "Copyright Board of Canada Issues Revised Tariff Schedules," Author, World Media Law Report (May 2008)
- "Canada's proposed amendments to the Copyright Act," Co-Author, IP Connections (March 2008)

## **Community Involvement**

- Flinn Foundation Bioscience Roadmap Steering Committee, Member (2019)
- i9 Sports, Baseball Coach, Volunteer
- Phoenix Chamber of Commerce Bioscience Leadership Council, Board Member
- TGen Foundation, Ambassador
- University of Victoria Alumni Association
  - Arizona Branch Contact

## **Other Professional Experience**

- Wilson Sonsini Goodrich & Rosati, Associate (2014-2016)
- Clark Wilson LLP, Associate (2012-2014)
- Smart & Biggar/Fetherstonhaugh & Co., Associate (2008-2012)

## **Bar Admissions**

- Arizona
- California
- United States Patent and Trademark Office
- British Columbia
- Canadian Intellectual Property Office

## **Court Admissions**

- Supreme Court of Arizona
- Supreme Court of California
- Supreme Court of British Columbia