

CURRICULUM VITAE

EDUCATION

Boston College Law School

Newton, MA

J.D., 1992

Student Attorney with Legal Assistance Bureau clinical program
Supervising Editor, *Boston College Uniform Commercial Code Reporter-Digest*

Clarkson College of Technology (now Clarkson University)

Potsdam, NY

B.S., Electrical and Computer Engineering (with distinction), 1982

Teaching Assistant
Presidential Scholar
Tau Beta Pi Engineering Honor Society

LEGAL EXPERIENCE

Skilled patent attorney and former engineer with history of providing practical, client-focused counsel to individuals, start-ups, investors, institutions, and established companies on patents, trademarks, copyright, trade secrets, licensing, domain names, intellectual property portfolio management, and disputed matters.

The Johnson IP Law Firm

Needham, MA

Founder—Registered Patent Attorney (2006–present)

Solo practitioner leveraging large law firm experience to provide high-quality, cost-effective IP counsel.

- Drafting and prosecuting original U.S. and international patent applications covering computer systems (hardware and software), electronics, optics, medical devices, telecommunications, green technologies, pharmaceutical technologies, and mechanical technologies.
- Conducting IP due diligence, preparing IP opinions, and resolving IP disputes.
- Reviewing, drafting, and negotiating licensing, technology transfer, supplier, and customer agreements.
- Reviewing and revising merger and acquisition agreements for IP issues.
- Advising clients on product marketing and IP strategies.

Hamilton, Brook, Smith & Reynolds, P.C.

Concord, MA

Shareholder (1999–2006); *Associate* (1992–1998); *Technology Specialist* (1991–1992)

Progressed from summer intern to shareholder by being efficient and collegial team member.

- Drafted and prosecuted original patent applications in broad range of complex technologies.
- Advised clients during patent committee meetings, conducted IP due diligence, and prepared IP opinions.
- Reviewed and negotiated IP licensing and technology transfer agreements.
- Successful record of appeals to the USPTO Board of Patent Appeals and Interferences.
- Resolved disputes between clients and third parties, including representing clients in state and federal court litigation, in arbitration and mediation, and in International Trade Commission proceedings.

Newsletter Editor (2005); Website Editor (1996–2001).

LEGAL ADMISSIONS

U.S. Patent and Trademark Office (Reg. No. 36,558)

Federal Courts: U.S. District Court for the District of Massachusetts (1993); U.S. Court of Appeals for the Federal Circuit (2001); U.S. Supreme Court (2001)

State Bars: Massachusetts (1992) and Pennsylvania (1992)

PROFESSIONAL RECOGNITION

Massachusetts/New England *Super Lawyers* (Thomson Reuters): 2004-2007, 2010-2021

TEACHING EXPERIENCE

International Patent Drafting Training Program, WIPO Academy (United Nations, Geneva, Switzerland) (March 2022–present)

- Distance learning tutor for select international participants from industry, institutions, and government.
- Duties include editing course materials, video lectures on patent claim drafting and interpretation, forum discussions on various patent topics, reviewing of assignments, preparing final examination exercises, and grading final examination exercises.

Advanced Course on Basics of Patent Drafting, WIPO Academy (United Nations, Geneva, Switzerland) (September 2021–January 2022 || April 2021–August 2021 || September 2020–January 2021 || April 2020–August 2020 || September 2017–January 2018 || May–September 2016 || June–September 2014 || June–October 2013 || July–November 2012)

- Distance learning tutor for international participants from industry, institutions, and government; including personal tutor for typically about 40 participants per session.
- Duties included video lectures on patent drafting, forum discussions on various patent topics, reviewing of assignments, preparing final examination questions, and grading final examination claim drafting exercises.

WIPO-ARIPO Regional Workshop on Patent Drafting (Victoria Falls, Zimbabwe (October 2011) & Distance Learning (April–June 2012)) || (Harare, Zimbabwe (October 2009) & Distance Learning (May–July 2010))

- Instructing scientists, engineers, attorneys, and government officials during intensive five-day workshop, covering basic patent law principles, relationships between patents and other IP protections, and practical aspects of patent prosecution, including patent application preparation and claim drafting exercises.
- Workshop followed by distance learning exercises to further improve participants' patent claim drafting skills.

Basics of Patent Protection, MCLE Computer and Telecommunications Law Institute (Boston, MA (March 1999))

- Presented overview of patent law and business needs for patent protection to general practice attorneys.

Patent Searching, Franklin Pierce Law Center (Concord, NH (1995–1999))

- Guest speaker to summer students on novelty and infringement searches.

In-house seminar presentations to staff and clients:

- Procedures for appealing to the USPTO Board of Patent Appeals and Interference.
- USPTO guidelines on computer-related inventions.
- Sham sales and the on-sale bar.
- Relationship between patent and antitrust law, particularly illegal tying arrangements and patent misuse.

INDUSTRY EXPERIENCE

GTE Government Systems

Waltham, MA

Software Consultant (1986–1989)

- Responsible for aspects of U.S. government's secure telephone system, including crypto-key information management software.
- Prepared technical documentation for government contract proposals.
- Prepared and presented technical details of system to government representatives.

Litton-Itek Optical Systems

Lexington, MA

Systems Software Engineer (1984–1986)

- Responsible for adaptive optics control software for a space-based deformable mirror to be used with a high-energy laser device.

Raytheon Company, Equipment Division

Wayland, MA

Software Engineer (1982–1984)

- Responsible for software development and for hardware-software integration testing of various radar systems, including:
 - Diagnostic software for emergency landing radar system and radar targeting systems.
 - Software for experimental radar to determine target position in three dimensions.
 - Software for ship-based radar surveillance system gathering technical intelligence data on in-flight ballistic missiles, including radar control and target tracking software.
- Prepared technical documentation for government contract proposals.
- Prepared and presented technical details of systems to government representatives.

IBM, Federal Systems Division

Owego, NY

Custom Circuit Board Fabricator & Product Expediter (Summer 1981)

U.S. Air Force, Rome Air Development Center

Griffiss AFB, NY

Engineering Technician (Summer 1980)

PATENT TECHNOLOGY EXPERIENCE

COMPUTERS:

- Business methods
- Database systems
- Data compression
- Digital signal processing
- Hardware architecture
- Image processing
- Internet hardware and software
- Logic systems
- Memory and caching systems
- Multimedia systems
- Neural networks
- Software applications
- User interfaces

ELECTRONICS:

- Analog and digital circuits
- Control systems
- Manufacturing systems
- Matrix display panels (LCD and LED)
- Radar systems
- Semiconductor device fabrication

OPTICS:

- Digital imaging
- Lasers
- Optical circuits
- Optical lenses (refractive and diffractive)

MEDICAL DEVICES:

- Diagnostic systems
- Imaging systems
- Oxygen regulators and conservers
- Surgical devices and procedures
- Telemedicine

TELECOMMUNICATIONS:

- Analog and digital telephony
- Electronic commerce
- Network protocols
- Video conferencing
- Wireless communications

GREEN TECHNOLOGIES:

- Energy optimization
- Energy storage
- Motor vehicle technologies

PHARMACEUTICAL TECHNOLOGIES:

- Biologically active compounds
- Manufacturing systems and processes

OTHER MECHANICAL DEVICES AND DESIGNS:

- Chambers and conduits
- Product integration and packaging
- Rapid prototyping machines (3-D printers)
- Tools
- Toys

PUBLICATIONS

BPLA Members Teach Patent Drafting in Zimbabwe (BPLA Newsletter (February 2010))

Co-authored article discussing the 2009 WIPO-ARIPO Regional Workshop on Patent Drafting (*see* Teaching Experience).

Product Design —The Power of Aesthetics (HBSR Newsletter (Fall 2003))

Discussed the value of design patents in a patent portfolio.

REPRESENTATIVE DISPUTED MATTERS

Inovo, Inc. v. Precision Medical, Inc., 2:03-cv-522-FtM-29DNF (M.D. Fla.)

- Successfully defended medical device company against patent infringement claims through declaratory judgment action.
- Defeated motion to dismiss by patent owner seeking to assert later-filed infringement action in its home forum.
- Defeated motion for summary judgment.

Smart Kids' Company v. Patrick W. Nee, 3:99-CV-1189(AVC) (D. Conn.)

- Negotiated favorable settlement for individual in suit alleging trademark infringement and unfair competition by client's website.

Flotec, Inc. v. Southern Research, Inc., 16 F. Supp. 2d 992 (S.D. Ind. 1998)

- Successfully defended start-up medical device company against copyright infringement, trade dress infringement, and trade secret misappropriation claims brought by established competitor.
- Litigation included two-day hearing with live witnesses and fruitful cross-examination of competitor's expert witness.
- As a result of the victory, suit was dismissed and client quickly became market leader in the manufacture of oxygen regulators.
- Published court opinion clarified role of reverse engineering as defense to trade secret misappropriation.

Infiltrator Systems Inc. v. PSA, Inc., 3:97-CV-00822(JCH) (D. Conn.)

- Defeated patent infringement claims on behalf of plastic conduit manufacturer by invalidating family of patents during court-ordered arbitration based on inequitable conduct and prior public use and sales.