

# JOHN M. WHITE

**SPECIAL COUNSEL / WASHINGTON, D.C. METRO OFFICE**

John focuses on giving his clients a strategic understanding of patents and the role they can play in achieving tangible business outcomes. Because any good IP strategy should complement and bolster the goals of the business, John organizes and advises on implementing that strategy via filings, licensing, and worldwide enforcement efforts. John has broad expertise in all aspects of intellectual property law, including patent and trademark prosecution, litigation, infringement and validity analysis, and opinion writing. He has successfully argued before the Court of Appeals for the Federal Circuit and the Patent Trial and Appeal Board. John further supports clients and other companies as an expert witness in USPTO procedure in District Court litigation.

Known as the “Dean of Patent Law,” John has helped prepare more than seventy percent of active U.S. patent attorneys and agents for their careers as patent practitioners. Since 1995, John has been the creator, author, and principal lecturer for PLI’s Patent Exam Course and has taught 1200+ would-be patent attorneys and agents annually. He has also taught 400+ U.S. patent examiners Law & Evidence.

## PRACTICE AREAS

Patents; Trademarks & Service Marks; IP Litigation; PTAB Proceedings; Copyrights; IP Transactions; International

## INDUSTRIES

AgriFood Tech; Automotive & Autonomous Vehicles; Clean & Green Technology; Consumer Electronics; Consumer Products; Electrical, Computer & Internet; Energy Production & Delivery; Image Processing, Lasers & Optics; Manufacturing; Medical Devices; Pharmaceutical & Biotechnology; Semiconductor Processing & Devices; Software & Information Technology

## KEY MATTERS

## REPRESENTATIVE PATENT & TRADEMARK MATTERS

- Advised an individual medical device inventor to a multi-million-dollar, multi-year licensing arrangement.
- Negotiated ongoing manufacturing- and patent-based cross-licensing agreement between Tier 1 automotive suppliers.
- Created and enforced anti-copying program for several top line, high



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performance aftermarket wheel manufacturers.

## REPRESENTATIVE LITIGATION MATTERS

- Obtained the highest dollar amount (at that time) for a default patent judgement against a fabric infringer in the Eastern District of Virginia.
- Advised in obtaining the highest (at the time) dollar amount for a patent and trade dress infringement judgement in the Southern District of Florida.
- Hired as Expert in several favorable settlements/judgments relating to Expert Witness services as to USPTO procedure.
- Filed and pursued medical method lawsuit resulting in Act of Congress to cease enforcement action.

## NEWS/EVENTS

### Speaking Engagements

- *Patent Office Exam Course* – PLI, November 2021
- *Time to Board the PCT Train* – Elevate your Prosecution, Salt Lake City, September 2021.
- *Hague System Best Practices and Common Mistakes* – IPWatchdog, June 24, 2021.
- *An Hour on PCT* – IPWatchdog, March 2, 2021
- *Patent Eligibility, Prior Art, Obviousness and Disclosure 2021: Current Trends in Sections 101, 102, 103 and 112* – PLI, May 2021
- *Patent Law Institute 2021: Critical Issues & Best Practices* – PLI, April 2021.

## IN THE NEWS

- “A New and Improved and Expanded Patent Bar: It’s About Time,” IPWatchdog
- John White Tapped for Virginia Lawyers Hall of Fame
- John White Quoted in Law360 Article about his Move to Harness IP

## EVENTS

- Metro D.C. Patent Attorney to Chair and Participate in Upcoming Practising Law Institute’s May 2022 Program
- Attorney John White to Co-Chair Upcoming PLI Patent Law Institute
- Attorney John White to Discuss Challenges of Obtaining Life Science Patents in IPWatchdog Webinar

## PUBLICATIONS

### ARTICLES

- “The US Patent System is Still Worth Saving,” *IPWatchdog*, Nov. 23, 2021
- “Why It’s Time to Board the PCT Train,” *IPWatchdog*, Nov. 22, 2020
- “Time to Think PCT!,” *IPWatchdog*, August, 6, 2020

### ARTICLES

- “Why The Patent Eligibility Restoration Act Can Spur Progress,” *Law360*

## BACKGROUND

In addition to his patent practice, John is the CEO of the PCT Learning Center, a resource for Patent Cooperation Treaty (PCT), Hague, and Madrid Protocol training. He is also Chair of the Patent Exam Course for the Practising Law Institute (PLI), a nonprofit learning organization dedicated to keeping legal professionals at the forefront of knowledge and expertise and is their Director of Patent Professional Development.

Before joining Harness IP, John founded and ran two highly successful IP law firms as well as an international patent search and translation firm, an IP publication company, and a patent illustration company. John also has previous experience serving as a Patent Examiner and Speech Writer for the Commissioner of Patents while he attended law school and, before that, working as a Civil Engineer for the Federal Highway Administration.

Outside of the office, John is a downhill skiing and auto enthusiast. He enjoys repairing and restoring exotic and classic automobiles, travelling with his wife, visiting his children and grandchildren, and collecting single malt Scotch.

### MEMBERSHIPS

- Ferrari Club of America
- BMW CCA
- Porsche Club of America

### CIVIC & CHARITABLE

- Waterford Presbyterian Church, Member of Session/Deacon
- Waterford Foundation, Director of Development, 2000-2006
- Assistant Soccer Coach, 2000-2010

- Whitetail Resort, Pennsylvania, Mountain Host, 2000

## **AWARDS & DISTINCTIONS**

- Pro Bono Lawyer of the Year, Journey Through Hallowed Ground, Waterford, Virginia 2008
- Department of Commerce, Gold Medal Performance Award, 1986
- Civil Engineering Honor Society
- Cooperative Education Honor Society, Virginia Tech

## **EDUCATION**

J.D., George Washington University, 1987

B.S., Civil Engineering, Virginia Polytechnic Institute and State University, 1983

## **BAR & COURT ADMISSIONS**

Virginia

Pennsylvania

District of Columbia

U.S. Patent and Trademark Office