



Jonathan Osha  
Managing Partner  
Houston, Austin

John Osha's practice includes patent prosecution, IP litigation, and IP counseling in a wide variety of technical disciplines. John leads the electronics, optics, and physics group at Osha Liang.

John has extensive experience in all aspects of patent preparation and prosecution. His practice places special emphasis on counseling relative to management and monetization of complex international IP portfolios. John's practice also includes intellectual property litigation, preparation of infringement and validity opinions, post-grant proceedings, and interference proceedings before the U.S. Patent and Trademark Office. John was previously a partner at Fish & Richardson, P.C., and currently serves as assistant reporter general of AIPPI.

## PROFESSIONAL ACTIVITIES AND MEMBERSHIPS

### LEGAL

- AIPPI (Assistant Reporter General)
- American Bar Association
- Austin Intellectual Property Law Association
- Houston Intellectual Property Law Association
- Intellectual Property Owner's Association

### TECHNICAL

- American Institute of Aeronautics and Astronautics
- Society of Automotive Engineers
- Institute of Electrical and Electronics Engineers

## PROFESSIONAL HONORS

- LES "Certified Licensing Professional"<sup>TM</sup>
- Martindale-Hubbell® AV® rated
- "America's Top Patent Prosecutors of 2011," Patent Buddy (2011)
- "Top 100 Professionals of Houston," *H Texas* magazine (2010)
- "Top Lawyer," *H Texas* magazine (2006-present)
- "Texas Super Lawyer," *Texas Monthly* magazine (2004, 2006-present)

## SELECTED APPEARANCES

- Bloomberg Law Radio, discussing the Leahy Smith America Invents Act (2011)
- Bloomberg Law Radio, discussing the *Apple v. Amazon.com* trademark infringement lawsuit (2011)
- Fox 26 News relative to Network Solutions litigation (2008)
- Guest on CNBC television discussing France's attempt to force Apple to open its proprietary music software (2007)
- *Houston Chronicle*, "Moneymakers" (2007, 2005)
- *United Press International* concerning Judge Samuel Alito in "Hi-Tech, The Web: Alito a blank slate on technology" (2006)

- *The American Lawyer* magazine, "Small Firm Business" (2005)
- Carter & Carter Morning Show, Houston BizRadio Network (2005)
- Bloomberg Radio (2005)

## SELECTED PUBLICATIONS

- "MedImmune, Inc. v. Genentech, Inc.: 'The World Turned Upside Down,'" *Corporate Counsel Review*, Vol. XXVI, No. 2, November, 2007 (with Louis Bonham)
- "The Pros and Cons of Drafting Patent Applications in India," *Texas Lawyer*, April, 2005
- Contributor, "Strategic Drafting of Applications for U.S. Patents by Japanese Companies from an Enforcement Perspective." *IIP Bulletin (Japan)* (2003)
- Co-author, "Is Your Opinion Privileged?: Ins and Outs of United States Rules of Privilege Regarding Patent Opinions," *Patent Times Volume 7 (Japan)* (2002)
- Co-author, "Reexamination in the United States," *Patent Times Vol.5 (Japan)* (2002)
- Author, "The Utility of Legal Opinions Regarding Infringement and Validity In The United States," *Patent Times Volume 4 (Japan)* (2001)
- "U.S.A. Patent Situation," *Patent Times (Japan)* (2001)
- Co-author, "Drafting Patent Applications from the Enforcement Perspective," *Chizai Kanri*, Vol. 20, No. 12 (December, 2000)
- "Disputes Without Litigation: The Who, What, and Where of ADR for Intellectual Property Cases on the World Stage," *UIA Congress, Madrid* (September, 1996)
- "GATT and Your Patent Rights: What You Need to Know," *Professional Review* (Spring, 1995)

## SELECTED PRESENTATIONS

- "The Role of Experts in U.S. IP Litigation," *AIPPI, Istanbul, Turkey* (2011)
- "U.S. Patent Prosecution for the European Practitioner: Tips, Tricks, and Pitfalls," *AIPPI, Riga, Latvia* (2011)
- "Intellectual Property: A Primer on Patents, Trademarks, Copyrights, and Trade Secrets," *Houston, Texas* (2009)
- "U.S. IP Issues for Japanese Companies," *Osaka, Japan* (2009)
- "Patent Litigation, Trolls, and Recent Developments," *Cypress, California* (2009)
- "Inventive Step/Obviousness After KSR," *Tokyo, Japan* (2009)
- "Benrishi-Client Privilege in the United States," *Osaka, Japan* (2008)
- "Egyptian Goddess and the Point of Novelty Test," *Tokyo, Japan* (2008)
- "In re Seagate: A New Standard for Willful Infringement," *Tokyo, Japan* (2007)
- "KSR v. Teleflex: Tightening the Obviousness Standard," *Tokyo, Japan* (2007)
- "Effect of MedImmune on the Licensor/Licensee Balance of

- Power," Tokyo, Japan (2007)
- "Drafting Effective Claims for U.S. Prosecution," Paris, France (2006)
- "Foreign Acts and 35 USC 271," Tokyo, Japan (2005)
- "Strategies for Improving Efficiency of Patent Prosecution in the United States," Tokyo, Japan (2005)
- "Insituform, Deering & Honeywell: New Restrictions on Prosecution Practice?", Tokyo, Japan (2004)
- "Knorr-Bremse: Changing the Face of Opinion Practice," Tokyo, Japan (2004)
- "Intellectual Property: A Primer on Patents, Trademarks, Copyrights, and Trade Secrets from a Global Perspective," Paris, France (2004)
- "U.S. Patent Prosecution for non-U.S. Practitioners" (full-day course), A.S.P.I., Paris, France (2004)
- "Preparation, Prosecution, and Enforcement of Design Patents in the United States," Tokyo, Japan (2004)
- "Opinions and Due Care; a Methodical Approach to Warning Letters and other Potential Problems," Tokyo, Japan (2004)
- "Choosing & Using Opinions Wisely: The Who, What, Where, When and Why of Opinions Concerning Patent Infringement and Validity in the United States," AIPPI, Tokyo, Japan (2003)
- "Historical Perspectives on the Doctrine of Equivalents," Tokyo, Japan (2003)
- "Understanding the New 102(e) and its Practical Implication for non-U.S. Applicants," Tokyo, Japan (2003)
- "Practical Implications of Festo," AIPPI, Tokyo, Japan (2001)
- "Business Method Patents: a Phoenix Rises from the Ashes," Tokyo, Japan (2000)
- "U.S. Patent Practice: Drafting the Application and Responding to Office Actions from the U.S. Perspective," (full day course) A.S.P.I., Paris, France (1998)
- "How to Conduct An Effective Interview at the PTO," Intellectual Property Law Institute, San Antonio, Texas (1996)
- "Infringement and Validity Analysis of the United States Patents," Kyoto, Japan (1994)
- "Preparation and Prosecution of United States Patent Applications," Kyoto, Japan (1994)

## EDUCATION

- J.D., George Mason University School of Law (1993)
- B.S., Electrical Engineering, Cornell University (1989)

## ADMISSIONS

- State Bar of Texas
- United States Patent and Trademark Office
- United States Court of Appeals for the Federal Circuit
- United States Court of Appeals for the Eastern District of Texas
- United States Court of Appeals for the Northern District of Texas
- United States Court of Appeals for the Western District of Texas
- United States District Court for the Southern District of Texas

## LANGUAGES

- French (proficient)
- German (basic)
- Japanese (proficient)
- Spanish (intermediate)
- English (native)