

John de la Rosa, Esq.
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Montclair, NJ 07043
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(973) 233-0420

SKILLS

Excellent verbal and written communication, interpersonal and computer skills
Strong analytic legal, scientific and organization skills
15+ Years of combined in-house and law firm experience in IP law
Litigation experience
Patent Bar License

EXPERIENCE

Law Offices of John De La Rosa, 1995 - Present

Represent a wide range of clients in the acquisition, protection and litigation of their intellectual property rights, including patents, trademarks, copyrights, and trade secrets in such areas as E-commerce, physics, electrical engineering, mechanical engineering and chemistry:

- Draft patent applications, including suggesting modifications to broaden the scope of the inventions
- Assess and develop intellectual property portfolio to facilitate timely launch of products
- Advise clients and oversea agents on applications filed abroad
- Ensure applications and renewal deadlines are met
- Negotiate license agreements & technology transfer, including advice on infringement and enforcement rights
- File Trademark & Copyright registrations in implementing IP strategies to protect client's products
- Conduct freedom to operate studies relevant to clients' core business
- Handle patent infringement lawsuit, including arbitration, from initial complaint to trial
- Develop company IP policies & procedures

Pennie & Edmonds - New York, NY 1991 - 1995

Associate

Involved in the licensing and litigation of intellectual property matters by performing the following:

Reviewing documents to identify relevant information affecting key legal issues; identifying and researching legal issues in drafting pre-trial motions; preparing witnesses for taking deposition or testifying at trial; studying and evaluating products and patents in drafting infringement & invalidity opinions; and performing prior art searches.

Notable Litigation Experience

Worked on Teradyne v. Hewlett Packard, Inc., representing HP in a patent infringement case involving testing of integrated circuit designs.

Worked on appeal to the Federal Circuit in Litton v. Honeywell representing Litton after erroneous JMOL and summary judgement.

AT&T Bell Laboratories - Princeton & Holmdel, NJ 1980 - 1991

Member of Patent and Legal Staff 1989 - 1991

Member of Research Staff 1980- 1989

As member of legal staff, responsible for the various phases of patent work for several of Bell Laboratories' basic research departments in photonics and device physics.

As member of research staff, developed laser based systems for inspecting and identifying defects within and on semiconductor wafers used in manufacturing photonic devices, such as lasers.

PUBLICATIONS De La Rosa et al., "Wafer Inspection With a Laser Scanning Microscope", AT&T Technical Journal, vol. 65, No. 1, Jan./Feb. 1986, pp. 68-77, Short Hills, New Jersey, US.

EDUCATION Juris Doctor - June, 1991
Rutgers School of Law - Newark, New Jersey
While Concurrently Employed by AT&T Bell Laboratories

Master of Science (Electrical Engineering) - 1985
Columbia University - New York, N.Y.
While Concurrently Employed by AT&T Bell Laboratories

Master of Science (Optics) - 1981
University of Rochester - Institute of Optics -Rochester, N.Y.
AT&T Bell Laboratories Fellowship Grant Recipient

Bachelor of Electrical Engineering with Honor - 1980
Stevens Institute of Technology - Hoboken, New Jersey

BAR Admitted to the New York & New Jersey Bars, U.S. District Courts, Eastern and Southern Districts of New York, District of NJ and the U.S. Court of Appeals for the Federal Circuit.

LICENSE Registered to practice before the PTO (Reg. No. 34,317).

**HOBBIES,
INTEREST** Enjoy tennis, skiing, and running