

John X. Garred

Partner



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Practices/Industries

- Patent Prosecution, Drafting & Counseling
- IP Licensing
- Technology Transactions

Education

Gannon University
(B.E.E., 1981)

Cleveland-Marshall College of Law
(J.D., 1984)

Cleveland State University
(M.S.E.E., 1993)

Overview

John has extensive experience counseling domestic and foreign corporate clients with respect to all aspects of intellectual property law, including procurement and enforcement of patents, trademarks and copyrights. He also counsels clients with respect to other areas of intellectual property law including protection of trade secrets, data privacy and security, and technology licensing.

With over 30 years of intellectual property experience, much of John's practice focuses on servicing domestic and foreign businesses in connection with securing U.S. patent protection, designing products to minimize U.S. patent risks and import concerns, providing analysis and opinions concerning patent infringement and validity, and licensing. His practice also focuses on IP due diligence in corporate transactions, invention harvesting, portfolio management, and significant client counseling in connection with identifying, securing and leveraging patents and other intellectual property assets to achieve business and competitive advantages. For example, he has drafted hundreds of original patent applications and has assisted in prosecution of over a thousand U.S. and foreign patent applications in the electrical, mechanical, software, and business method areas, mostly involving high-tech electronics and communications technologies. John has conducted hundreds of face-to-face interviews with patent examiners at the United States Patent and Trademark Office (USPTO).

John has experience servicing foreign businesses in connection with securing U.S. patent protection, product design to minimize U.S. patent risks and import concerns, and drafting legal opinions relative to infringement or validity issues. He has extensive experience overseas, particularly with clients in Japan, China, Taiwan and Europe. John has basic knowledge of the German language.

Experience

- Representation of multinational and foreign-based, Global 500 companies in connection with domestic and international intellectual property matters.
- Completion of a freedom-to-operate analysis and subsequent establishment of a defensive position in connection with an acquisition by a large, northeast Ohio enterprise of a west coast high-tech company.
- Established and grew an invention submission and patent application system for domestic technology for a new U.S. division of a foreign-based, multinational company.
- Significant success in leveraging IP assets to secure funding or merger/acquisition value for small companies.
- Significant success in identifying patent rights to secure more favorable position in connection with acquisitions.

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Presentations

- “IP for Entrepreneurs” guest lecturer at Case Western Reserve University School of Graduate Studies

Publications

- “Reexamination in copyright,” *Intellectual Property Magazine* (April 2015)

Involvement

Professional Affiliations

- Cleveland Metropolitan Bar Association
- Cleveland Intellectual Property Law Association (CIPLA)
- Institute of Electrical and Electronics Engineers (IEEE)
- Intellectual Property Owners Association (IPO)

Honors & Distinctions

- AV Preeminent® Peer Review Rated – Martindale-Hubbell®
- Named to the Ohio Super Lawyers list (2005-2007)
- "Leading Lawyer," *Inside Business Magazine* (top 1% of Ohio attorneys) (2010)

Admissions

- State of Ohio
- State of California
- State of Florida
- U.S. Supreme Court
- U.S. Patent & Trademark Office
- U.S. Court of Appeals for the Federal Circuit
- U.S. District Court, Northern District of Ohio
- U.S. Court of Appeals, Sixth Circuit
- U.S. Court of Appeals, Eighth Circuit