Da Vinci Partners LLC

Intellectual Property is our middle name



JOHN B. MOETTELI, M.A., P.E., Doctor of Jurisprudence (J.D.)
U.S. and International Patent and Trademark Attorney-at-law; managing attorney of Da Vinci Partners LLC

SUMMARY:

For over 20 years, John Moetteli has been a practicing patent practitioner/attorney-at-law (D.C.), having been authorized to practice before WIPO, the US and Swiss Patent & Trademark Offices, as well as the Liechtenstein IPO. He's also admitted to practice before the United States Court of Appeals for the Federal Circuit, the United States Supreme Court, the Supreme Court of Texas, the District of Columbia Bar (Washington DC), as well as the Bucharest Bar as an international attorney. In addition, after finishing his training under the tutelage of European patent attorneys while based in Geneva, he continues to successfully manage the prosecution of European patent applications. Further, he's a Texas registered Professional Engineer, currently on inactive status.

Since 1997, John has been based in Europe and has represented U.S., European and Asian individuals and corporations, both small and large, before the US, Swiss and International patent and trademark authorities. In 1992, John founded, in the

building that housed the original NASA headquarters in Houston, Texas, what later became Da Vinci Partners LLC, owner of the "Da Vinci" brand for legal services in essentially every industrialized country in the World. With colleagues like Novella Mantelli, David Koris, and Sharon Gobat, Da Vinci Partners counsels primarily European and US clients regarding IP litigation issues and prepares and prosecutes patent applications in the fields of IT, software (including AI applications and business methods), manufacturing process, electro-mechanical, medical device, and sports products fields. In fact. Da Vinci represented Salesforce in oral proceedings that directly resulted in Salesforce obtaining their very first European software patent. Da Vinci's specialty is providing strategic IP advice taking advantage of unique ways of applying US law that extend the protection afforded by trade secrets while reserving US patent rights, and that maximize the protection afforded under US design patent law.

John holds an Engineering degree, a Masters in International Management and a Doctor of Jurisprudence degree which he earned *magna cum laude*. In addition, he's followed courses on Chinese Patent Law, and was co-editor of a well-known international manual on industrial property. He's also a WIPO trained mediator and arbitrator and, formerly, an elected member of the ICC Switzerland Commission on Arbitration and Mediation.

John is particularly specialized in preparing freedom to operate, invalidity and enforceability opinions on US patents, as well as preparing and prosecuting US and International patent and trademark applications. His experience preparing legal opinions has trained him in the ability to objectively assess infringement and validity, all helpful to fair and thoughtful determination in arbitration as well as in providing strategic litigation advice. Knowing where the strengths and weaknesses of a case lie helps in mediation efforts as well.

John has been a member of the American Intellectual Property Law Association (AIPLA), the Licensing Executives Society (LES), the International Association for the Protection of Intellectual Property (AIPPI), and the Association of International Business Lawyers (AIBL) for many years. He's also the founder of the North American Attorneys Association in Geneva and an active member of the ICC's Commission on Intellectual Property, during its existence. He's lectured for the Swiss Patent Office, WIPO (as a WIPO Patent Expert), the European Patent Office, the European Commission, the European Patent Institute, has served as IMD adjunct faculty for the Program for Executive Development (PED), and Zurich University ZHAW and lectured at the University of Modena, to the China Counsil for the Promotion of International Trade, as a guest speaker at startup events such as Startup Days in Bern, and Startup Nights in Winterthur. He has coached startups in

Switzerland and Italy. He's published several articles on the subject of intellectual property law as well (see Publications section below).

Prior to moving to Switzerland, John worked in the intellectual property section of Haynes & Boone LLP, a large litigation firm with offices in Texas, New York, California, Charlotte, Colorado, Illinois, Washington, D.C., Shanghai, London, and Mexico City. Prior to his experience with Haynes & Boone, John worked at NASA as a senior design engineer and technology manager. During this time, the Smithsonian Institute featured his work on the Discovery Channel's Invention Series cable television program.

John speaks fluent English (mother tongue), French and German.

EDUCATION AND HONORS:

Doctor of Jurisprudence -- University of Houston Law Center (ranked in the top five law schools in the US for Intellectual Property specialty), *magna cum laude*. Dean's list. Annual Fund scholarship recipient. AmJur Awards: Constitutional Law and Contracts II. Corpus Juris Secundum Award. Highest grade in his class: Int'l Business Transactions, Professional Responsibility, International Law, and Administrative Law. Member - *Order of the Barons* and *Order of the Coif*, well-known honorary legal fraternities.

Master of Arts -- International Management Studies (Business Masters with emphasis on challenges of international operations) -- University of Texas (Dallas), including MBA programs at the University of Houston School of Business and University of Houston Clear Lake, 4.0 GPA (perfect marks).

Bachelor of Science in Mechanical Engineering -- University of Texas (Arlington), cumulative GPA 3.3+, Honor Roll; Elected to *Tau Beta Pi* and *Pi Tau Sigma*, national engineering honor societies.

Note: After freshman year, employed full-time while pursuing all University degrees, May '83 through May '95.

WORK EXPERIENCE:

In Switzerland from Oct. 1, 1997 to the present – first as an IP attorney for Katzarov SA and then Bugnion SA, both in Geneva, and later as managing attorney of Da Vinci Partners LLC, now in Arbon, Switzerland. John specializes in prosecuting US

patent applications and preparing non-infringement, validity, and unenforceability opinions on US patents, thereby helping Swiss clients assess the risks of entering into the US market, particularly when competitors have patents on similar technology. He also handles patent and trademark licensing negotiations, as well as prepares, files, and prosecutes patent and trademark applications in various strategically important jurisdictions. He also mediates IP rights disputes.

From 1994 to 1997, John was an IP attorney with Haynes & Boone, L.L.P. (www.haynesboone.com). Here he was responsible for an international oil field exploration company's international patent docket. John regularly prepared, filed and prosecuted U.S. and international patent applications in the software, telecommunications, as well as mechanical and electromechanical arts. He also prepared patentability opinions as well as prepared, filed and prosecuted trademark applications. Still further, he dealt with copyright, trademark, trade secret and unfair competition issues.

From 1991 to 1996, John worked at Johnson Space Center (JSC), for NASA's EVAS team. Licensed as a US Patent Agent, he finished his tenure at JSC as a Senior Design Engineer, and New Technology Coordinator. At NASA, he was responsible for the design/development of certain tools for use on the International Space Station. His regular activities included brainstorming, solid modeling, mass and stress analysis, trade studies, presentations to NASA tech monitors and integration teams, and participation in cost and operational studies. As new technology coordinator, he was responsible for indoctrination of employees in requirements for new technology reporting including writing and filing new technology disclosures with the NASA Patent Department. He performed patent searches and prepared patent applications on a project basis. He was the recipient of NASA Tech Brief Award, Lockheed Disclosure of Invention Award, NASA Patent Application Award (awarded US Patent No. 5,924,329), and NASA Programs and EVAS Team of the Month awards.

From 1992 to 1994, while studying law, John was a practicing US Patent Practitioner, specialized in the preparation, filing and prosecution of patent applications for independent inventors and small businesses. During this time, he performed patent searches, provided patentability opinions, drafted patent drawings, and wrote, filed and prosecuted patent applications before the U. S. Patent and Trademark Office.

From 1989 to 1991, John worked as a manufacturing engineer, project manager and patent specialist for AirBorn Connectors Inc. in Addison, Texas. He was primarily responsible for the design and development of electronic connector assembly equipment. He evaluated manufacturing processes, designed tests and fixtures, and

machinery components. He contributed significantly to new product design through brainstorming. He also initiated and performed informal patent searches on competitor's equipment. He was a named co-inventor in U.S. patent 5,203,813.

From 1985 to 1987, John was a research engineer with Harris Graphics Corporation (later renamed Heidelberg Harris). He reported directly to Marshall Gaffney, the V. P. of R & D and Director of Engineering. He was project leader/designer of ink metering blade system for printing presses, the implementation of which enabled significant cost reduction. He was awarded U.S. patent 4,773,327.

From 1983 to 1985, John was president and project manager for Ravencrest Tool Company of Richardson, Texas. He reported to a managing board. John was solely responsible for conception, design, development and production of hand and power tool systems. He supervised 13 employees. His accomplishments include design, drafting and sourcing of component parts for ease of manufacturing and to yield more competitive products. He designed the plant layout, and selected and supervised the installation of machinery. He was awarded U. S. patent nos. 4,520,697; 4,602,534; 5,347,892; 5,172,823 as well as related foreign patents. In 1986, he received the "Invention of the Year Award" from Congressman Jake Pickle of Austin, Texas (products were sold through Sears department stores nationwide).

PERFORMANCE AND LICENSES: Texas State Bar results: MPRE 143/150; MBE 158; Registered US Patent Attorney (No. 35,289); Attorney-at-law (Texas 00795536, Washington DC 489310); Registered Professional Engineer (No. 68980);. Admitted to practice before the Federal Circuit Court of Appeals and the bar of the District of Columbia as well as US Supreme Court (Bar No. 315244) Admitted before an International Bar of a European Union member state (Bucharest Bar 3555/C/26.03.2012).

ACTIVITIES/PERSONAL: John is recipient of the Educational Enrichment Award from Partners in Space (nonprofit educational organization) and was featured on Smithsonian Institution's *Invention Series*, produced for the Discovery Channel, '95-'96. He is a citizen of the United States, Switzerland and Italy. John is married and is the father of three children. He is a member of the executive committee of the American International Clubs of Zurich and Geneva, and has served as Consul of Internations, St. Gallen chapter, for over seven years. John enjoys fine food, foreign language, boating, fast walking, and hiking.

John's online profile is available at Profile: https://davincipartners.com/personnel/john-moetteli/

PUBLICATIONS:

Early and Pioneering Work

John B. Moetteli, "The Patent FAQ." The World Wide Web (davincidesign.com/patentfaq), supported by Webvertising Inc., August 1992. The first Patent FAQ published on the World Wide Web.

Book Chapters and Articles

- John B. Moetteli, "The Patent FAQ, Chapter IV." In Neal J. O'Farrell (ed.), Stepping Into Magic: A Handbook for the High Tech Start-Up, 1998, pp. 76–89. Print adaptation of the Patent FAQ.
- John Moetteli, "Reserving Patent Rights for Your Secret Processes." Growing Business Innovation. London: Kogan Page, 2017, pp. 169–175.
- John Moetteli, "Putting Out a Patent Fire." In Adam Jolly (ed.), The Handbook of European Intellectual Property Management: Developing, Managing and Protecting Your Company's Intellectual Property, 3rd ed. London, Philadelphia and New Delhi: Kogan Page, 2015, pp. 189–193.
- John Moetteli, "Why File in the United States First?" In Adam Jolly (ed.), The Innovation Handbook: How to Profit from Your Ideas, Intellectual Property and Market Knowledge, 3rd ed. London, Philadelphia and New Delhi: Kogan Page, 2013, pp. 291–294.
- John Moetteli, "What Your US Competition Doesn't Want You to Know About US Patent Law." In Adam Jolly (ed.), The Handbook of European Intellectual Property Management, 3rd ed. London, Philadelphia and New Delhi: Kogan Page, 2012, pp. 180–184.

- John Moetteli, “Patent Filing Strategy to Minimize Litigation Risk.” In Jonathan Reuvid (ed.), Managing Business Risk: A Practical Guide to Protecting Your Business, 7th ed. London: Kogan Page, 2010, pp. 257–263.

- John Moetteli, “Why File in the United States First?” In Adam Jolly and Jeremy Philpott (eds.), The Handbook of European Intellectual Property Management, 2nd ed. London and Philadelphia: Kogan Page, 2009, pp. 282–288.

- John B. Moetteli, “The Patentability of Software in the U.S. and Europe.” Internationales Immaterialgüterrechtsforum, Band 7: Neueste Entwicklungen im europäischen und internationalen Immaterialgüterrecht. Helbing & Lichtenhahn, 2005, 24 pp.

Articles

- John Moetteli, “Reserving Patent Rights for Your Secret Processes.” *Lawyer Monthly*, October 2019, pp. 74–75.
- John Moetteli, “Financial Services Using New Business Methods Enabled by Software Are Now Patentable in the United States, with Extraterritorial Effects.” *The Journal of World Intellectual Property*, 1999, 8 pp.
- John B. Moetteli, “Torque-Limiting Manipulation Device.” *NASA Tech Briefs*, 1999, p. 13.

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