



John T. Johnson

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Overview

John T. Johnson's practice focuses on utility patent, design patent, trademark, and copyright litigation. For the past 25 years, he has been litigating disputes in U.S. courts at the trial and appellate level, as well as matters before the Patent Trial and Appeal Board.

John has tried patent cases (both utility and design) before both judges and juries, as well as having argued *Markman* hearings in various U.S. District Courts, including the Eastern District of Texas, the Southern District of New York, the Southern District of California, the District of Maryland, and the Western District of Texas.

He has represented clients in diverse industries, including automotive, banking, business methods, cellular standards, computer, electrical equipment, flatware, furniture, gaming, pharmaceutical, semiconductor, software, and telematics. In addition, he has experience litigating patent and trademark disputes outside of the U.S. in both Europe and Asia.

John also represents clients in connection with pre-litigation counseling, IP licensing and portfolio management, and strategic due diligence. He is an active participant in bar association activities and formerly served as a member of the board of directors of the American Intellectual Property Law Association from 2006 to 2009. He currently is a member of the AIPLA's amicus committee and was elected as an AIPLA fellow in 2015.

Experience

Embrava Pty Ltd v. Plenom A/S et al. S.D.N.Y.1:19-cv-11305-JGK – Represented plaintiff software copyright holder in an infringement and breach of contract action in U.S. District Court. Asserted non-U.S. (Australian) unregistered copyrighted source code against Danish and U.S. subsidiary defendants pursuant to the Berne Convention for the Protection of Literary and Artistic Works.

American Calcar, Inc. v. American Honda Motor Co., Inc. and Honda of America Manufacturing, Inc. (Eastern District of Texas, transferred to Southern District of California) – patent infringement action involving vehicle telematics.

American Honda Power Equipment Mfg., Inc. v. Woodhouse and Tickner (Dist. of Columbia) and *Woodhouse and Tickner v. Honda Motor Co., Ltd. et al.* – (High Court of Justice, Chancery Division, Patents Court, Royal Court of Justice) multi-national patent infringement actions involving engine lubrication systems.

Changzhou Kaidi Electrical Co., Ltd. et al. v. Okin America, Inc. et al. (D. Md.) – patent infringement and unfair competition action on linear actuators.

Clear With Computers, LLC v. Terex Corporation (E.D.Tex.) – patent infringement action.

Deckers Outdoor Corporation v. Cheng's Enterprises, Inc. (C.D. Cal.) – copyright/trademark/trade dress action relating to footwear.

Deltrans v. American Honda Motor Co., Inc. – (D. Del.) patent infringement action involving automatic transmissions.

Energy Intelligence Group, Inc. et al. v. Barclays Capital Inc. (S.D.N.Y.) – copyright infringement action.

Fulhorst v. American Honda Motor Co., Inc et al. – (D. of Del.) patent infringement action involving wireless alarms.

Gagan B Patnaik v. The Hearst Corp. et al. (C.D. Cal.) – copyright infringement action relating to a digital mailbox system.

Honeywell et al. v. Casio Computer Co., Ltd. and Casio Inc. et al. – (D. Del.) patent infringement action relating to LCD modules.

Imagineering v. Van Klassens, Inc. – (S.D.N.Y.) trade dress and design patent infringement action involving furniture.

In re Certain Foam Footwear, ITC Inv. No. 337-TA-567 (2006) – ITC action involving patent/trade dress relating to footwear.

Joao Control and Monitoring Systems of California LLC v. ACTI Corporation Inc et al. (E.D.Tex. and C.D.Cal.) – patent infringement action related to control systems.

Kaneka Corporation v. Zhejiang Medicine Co., Ltd. et al. (C.D. Cal.) – patent infringement action related to a process for producing oxidized coenzyme Q10 (“CoQ10”).

L. & J.G. Stickley Furniture, Inc. v. Wood Classics, Inc. – (N.D.N.Y.) trade dress infringement action involving Mission style furniture.

Landscape Forms, Inc. v. Columbia Cascade Co. – (S.D.N.Y.) trade dress infringement action involving landscape furniture.

Levi Strauss & Co. v. Wicked Fashions Inc. – (N.D. of California) trademark infringement and dilution action.

Luv N' Care, Ltd. et al. v. Regent Baby Products Corp. (S.D.N.Y.) – design patent, trade dress and unfair competition action relating to baby products.

Margaritis v. Industrial Enterprises, Inc. – (M.D. of Florida) patent infringement action involving containment systems for bridges.

Michael “Wildstyle” Tracy v. Wicked Fashions, Inc. – (S.D.N.Y.) trademark infringement.

Oneida Ltd. v. Bon Chef, Inc. (N.D.N.Y.) – design patent and false advertising action concerning flatware.

Phoenix Licensing, L.L.C. et al. v. CenturyLink, Inc. (E.D. Tex.) – patent infringement action on patents related to marketing methods.

Rocawear Licensing LLC et al. v. Pacesetter Apparel Group et al (C.D. Cal.) – trademark infringement action on wearing apparel.

Ryobi Outdoor Products v. American Honda Motor Co., Inc. and Honda Motor Co., Ltd. – (Dist. of Arizona) patent infringement action involving four-cycle engines.

Solaia Technology LLC v. American Honda Motor Co., Inc. et al. – (N.D. of Illinois) patent infringement action involving automated control systems.

Tough Traveler, Ltd. v. Outbound Products – (N.D.N.Y.) trade dress infringement action involving child and baby carriers.

Skee Ball, Inc. v. Full Circle United, LLC (E.D.N.Y.) – trademark and unfair competition action.

Transcend Technologies Group, Inc. v. Mass Group Marketing, Inc. et al. (E.D. Cal.) – copyright infringement and breach of contract action concerning benefits administration software.

Turn-Key Tech. v. American Honda Motor Co., Inc. and Honda Motor Co., Ltd. – (S.D. of California) patent infringement action

involving methods of injection molding.

U.S. Philips Corporation v. Iwasaki Co., Ltd. –(S.D.N.Y) patent infringement action on very high pressure mercury vapor discharge lamps

Varian Semiconductor Equipment Assoc., Inc. v. Nissin Ion Equipment Co., Ltd. –(W.D. Texas) patent infringement action on ion implanters for semiconductor processing.

Wicked Fashions, Inc. v. Sonal Sportswear, Inc. –(S.D.N.Y.) trademark infringement.

Recognitions & awards

Super Lawyers

Super Lawyers 2008-2012, 2014-2023

New York Metro Super Lawyer

Super Lawyers

Professional associations

Co-Chair, IP Practice in Japan Committee, American Intellectual Property Law Association

New York Intellectual Property Law Association

New York State Bar Association IP Section

Federal Circuit Bar Association

United States Bar Association/Japan Patent Office Liaison Council

AIPPI

Insights

Webinar | December 15, 2016

Minimizing Willful Infringement Post-*Halo*

News

September 30, 2021

Fish & Richardson Attorneys Named to 2021 New York Metro *Super Lawyers* List

January 20, 2017

Fish & Richardson's Pro Bono Efforts Yield Five Clemency Grants by President Obama

December 20, 2016

Fish Files Amicus Brief on Behalf of 26 Members of Congress

July 15, 2014

Skyhorse Publishing and Author Fred Stoller Win Seinfeld Related Defamation Lawsuit Brought by Real Life "Cosmo Kramer"

May 6, 2014

Skee-ball League Launches Crowdfunding Campaign, 'Skee the People,' to Defend Against Trademark Lawsuit Brought by Skee-Ball, Inc.

Events

January 28, 2020

AIPLA Mid-Winter Meeting: IP Practice in Japan

November 12, 2019

Japanese Intellectual Property Association (JIPA) Mock Trial

January 27, 2017

JETRO: An Overview of US and World IP Developments in 2016-2017

October 25, 2016

AIPLA IP Practice in Japan Pre-Meeting

October 23, 2014

AIPLA 2014 Annual Meeting

October 29, 2013

Association of Pro Bono Counsel IMPACT NY Project: Small Business Legal Academy

April 8, 2013

AIPLA - IP Practice in Japan committee meeting

February 8, 2013

U.S. Patent Law Developments 2009

November 12, 2012

Recent Developments in U.S. Patent Law 2012

August 23, 2012

Osaka Seminars

October 24, 2011

U.S. Patent Law Developments 2011

April 7, 2011

Tokyo (AIPPI) Seminar 2009

March 9, 2011

US and European Patent Law Conference 2008

November 17, 2010

22nd Annual NAPABA INSPIRE Convention

November 9, 2010

U.S. Patent Law Developments 2010

November 9, 2010

U.S. Patent Law Developments

October 19, 2010

AIPLA Annual Meeting, Japan Practice Committee Meeting

April 20, 2010

Open Seminar of the Japan Patent Attorneys Association

April 19, 2010

AIPLA IP Practice in Japan Committee, Delegation Trip 2010

May 19, 2009

Patent Litigation in the United States: What Japanese Companies Need to Know to Protect their Most Important Assets

April 20, 2009

AIPLA IP Practice in Japan Committee, Delegation Trip 2009

April 14, 2008

AIPLA IP Practice in Japan Committee, Delegation Trip 2008

April 12, 2005

AIPLA IP Practice in Japan Committee, Delegation Trip 2005

April 19, 2004

AIPLA IP Practice in Japan Committee, Delegation Trip 2004

Additional insights

Publications

- “Employers Beware: Employee-inventor Compensation Requirements in China, Japan, Korea, and Germany,” *Asian Briefings* (A Supplement to the Association of Corporate Counsel Docket) (November 2010)
- “Japan Rethinks Whose Idea Is It Anyway?” *Legal Times* (April 2005)
- “Employee Inventor Litigation Hits Japan,” *New York Law Journal* (January 2005)
- “Courtroom Technology in the United States,” *International Legal Strategy Magazine* (December 2000)
- “Communication by E-mail: Discovery and Privilege in U.S. Litigation,” *International Legal Strategy Magazine* (November 1999)
- “The Crime-Fraud Exception to the Attorney-Client Privilege and Work Product Immunity — An Important Discovery Tool in Patent Infringement Litigation,” *IP Worldwide* (March/April 1998)

Speaking engagements

- “IP Landscape Under the Second Trump Administration,” *American Intellectual Property Law Association (AIPLA) 2025 IP Practice in Japan Pre-Meeting* (January 28, 2025)
 - “The ‘Halo Swing — The Law of Willful Infringement Changes Again,” *American Intellectual Property Law Association* (October 2016)
 - “The UPC in the European Patent Litigation Landscape,” *American Intellectual Property Law Association* (October 2014)
 - “Mock Markman Claim Construction Hearing,” *Japan Patent Attorneys Association (JPAA) Seminar* (April 2002)
 - “Copyright Protection for Computer Software,” *Lorman Education Services CLE Program* (June 2001)
 - “Courtroom Technology in the U.S.,” *Tokyo High Court, IP Judges* (April 2001)
 - “Patent Litigation Practice,” *Japan Intellectual Property Association (JIPA) Bi-Annual Seminar* (October 2000)
 - “Business Method Patent Infringement Litigation in the U.S.,” *Diamond Corporation Legal Education Program* (June 2000)
 - “The Attorney-Client Privilege/Work-Product Immunity and Japanese Patent Attorneys,” *Japan Patent Attorneys Association (JPAA) Meeting* (May 1999)
 - “The Doctrine of Equivalents After Hilton-Davis,” *Japanese Patent Attorneys Association (JPAA) Seminar* (May 1998)
 - “Copyright Considerations for Medical Illustrators: Registration and Enforcement,” *52nd Annual Meeting of the Association of Medical Illustrators* (July 1997)
 - “How to Protect Product Configuration Using Copyright,” *NYS Bar Association 119th Annual Meeting* (January 1996)
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Services

Litigation

Patent Litigation

Trademark, Copyright & Media Litigation

Trademark & Copyright Counseling & Prosecution

TTAB Oppositions & Cancellations

Industries

Electrical & Computer Technology

Hardware

Semiconductors

Telecommunications

Manufacturing

Admissions

U.S. Patent and Trademark Office

Supreme Court of the United States

U.S. Court of Appeals for the Federal Circuit

U.S. Court of Appeals for the Second Circuit

U.S. Court of Appeals for the Ninth Circuit
California
U.S. District Court for the Central District of California
U.S. District Court for the Eastern District of California
New York
U.S. District Court for the Southern District of New York
U.S. District Court for the Eastern District of New York
U.S. District Court for the Northern District of New York
U.S. District Court for the Western District of New York
U.S. District Court for the District of Arizona
U.S. District Court for the District of Colorado
U.S. District Court for the Eastern District of Michigan

Education

J.D. *cum laude*, Union University, Albany Law School (1993) Managing Editor of Research and Writing, *Albany Law Journal of Science and Technology*
B.S., Mechanical Engineering, Union College (1989)