

**JOHN B. MOETTELI, Esq., M.A., J.D., P.E.**

U.S. and Swiss Patent and Trademark Attorney, Attorney-at-law (EU and US); principal of Da Vinci Partners<sup>LLC</sup>

**SUMMARY:**

For about twenty years, John Moetteli has been a practicing patent practitioner/attorney-at-law, licensed before the US and Swiss Patent Offices. He's also admitted to practice before the United States Court of Appeals for the Federal Circuit, the District of Columbia Bar (Washington DC). Further, he's a registered Professional Engineer, currently on inactive status. Since 1997, Mr. Moetteli has been based in Europe and has represented individuals as well as U.S., European and Asian corporations, both small and large, before the US, Swiss and International patent and trademark authorities.

He holds an Engineering degree, a Doctor of Jurisprudence degree, and a Masters in International Management (with emphasis on Doing Business in China). In addition, he's followed courses on Chinese Patent Law, including co-editing a well-known manual on industrial property. He is also trained in mediation and arbitration through WIPO courses.

His technical specialty is mechanical, IT, software, medical devices, and sports products. He is particularly specialized in preparing freedom to operate, invalidity and unenforceability opinions on US patents, as well as preparing 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 help in mediation efforts as well.

Mr. Moetteli is a member of the Association of International Business Lawyers (AIBL), the American Intellectual Property Law Association (AIPLA), and the International Association for the Protection of Intellectual Property (AIPPI). He's been inducted into the Order of the Barons and Order of the Coif, honorary legal fraternities. He's also the founder of the North American Attorney's Association in Geneva and a former member of the managing committee for the Association of

International Business Lawyers. He's lectured for the Da Vinci School of Intellectual Property, the Swiss Patent Office, WIPO (as a designated WIPO Patent Expert) and the European Commission, and has served as IMD faculty for the Program for Executive Development (PED). He's published several articles on the subject of intellectual property law as well.

Prior to moving to Switzerland, Mr. Moetteli worked in the intellectual property section of Haynes & Boone LLP, a large general litigation firm with offices in Texas, Washington D.C. and Mexico City. He earned his Doctor of Jurisprudence *magna cum laude* from the University of Houston Law Center, a highly ranked law school. Prior to his experience with Haynes & Boone, Mr. Moetteli worked at NASA where his responsibilities included technology management. During this time, his work was featured on the Discovery Channel's Invention Series cable television program.

Mr. Moetteli speaks fluent English, 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 its 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: Int'l Business Transactions, Professional Responsibility, International Law, and Administrative Law. Member - *Order of the Barons* and *Order of the Coif*.

*Master of Arts* --International Management Studies (Business Master's with emphasis on challenges of international operations) - University of Texas (Dallas), 4.0 GPA (perfect marks).

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

#### WORK EXPERIENCE:

In Switzerland from Oct. 1, 1997 to the present – U.S. and Swiss Patent and Trademark Attorney. Prosecute patent applications before the EPO, WIPO, the

Swiss Patent Office, and directly before the US Patent and Trademark Office and Copyright Office. Specializing in prosecuting US patent applications and preparing non-infringement, validity, and unenforceability opinions on US patents, to help Swiss clients assess the risks of entering into the US market when competitors have patents on similar technology. Also handle trademark licensing negotiations. Prepare, prosecute and provide opinions regarding trademark applications and licenses. Negotiate licenses and joint development arrangements.

Prepared and gave presentations at INTA Roundtables and at client facilities; adjunct instructor in the PED program, IMD, Lausanne, teaching Intellectual Property Strategy, guest speaker at the Swiss Patent Office and University of Neuchâtel, University of Konstanz, and University of St. Gallen. Seminar speaker, in French, German and English, on US patent law changes (the AIA) for the Swiss Patent Office. Offered seminars for WIPO and the European Commission as a patent expert.

Haynes & Boone, L.L.P. ([www.haynesboone.com](http://www.haynesboone.com)) - Patent Practitioner/Patent and Trademark Attorney; '95 to '97. Responsible for international oil field exploration company's international patent docket. Prepared, filed and prosecuted U.S. and international patent applications in the software, telecommunications, as well as mechanical and electromechanical arts. Prepared patentability opinions. Prepared, filed and prosecuted trademark applications. Dealt with copyright, trademark, trade secret and unfair competition issues.

NASA (Lockheed Engineering and Sciences Company) from April '91 to '96 (educational leave of absence '95-'96). Senior Engineer/New Technology Coordinator-Patent Agent. Responsible for the design/development of hardware for International Space Station Alpha. Activities included brainstorming, solid modeling, mass and stress analysis, tradeoff studies, presentations to NASA tech monitors and integration teams, and participation in cost and operational studies. Also responsible for indoctrination of employees in requirements for new technology reporting including writing and filing new technology disclosures with the NASA Patent Department. Performed patent searches and prepared patent applications on a project basis. Recipient of NASA Tech Brief Award, Lockheed Disclosure of Invention Award, NASA Patent Application Award, and NASA Programs and EVAS Team of the Month awards.

Prior to NASA, Mr. Moetteli was in private practice as a US Patent Practitioner – preparing, filing and prosecuting patent applications for independent inventors and

small businesses. Performed patent searches, provided patentability opinions, drafted patent drawings, wrote, filed and prosecuted patent applications before the U. S. Patent and Trademark Office.

As an engineer, Mr. Moetteli worked for Harris Graphic Corporation, Ravenscrest Tool Company and Airborn Connectors Inc.

At AirBorn Connectors Inc., Mr. Moetteli was a manufacturing engineer, project manager, and patent specialist. Responsible for the design and development of electronic connector assembly equipment. Evaluated manufacturing processes, designed tests and fixtures, machinery components. Contributed significantly to new product design through brain-storming. Initiated and performed informal patent searches on competitor's equipment. Awarded U.S. patent 5,203,813.

At Ravenscrest Tool Company, he was president and project manager for the production of a unique hand tool system. Reported to managing board. Responsible for conception, design, development and production of hand and power tool systems. Supervised 13 employees. Accomplishments include design, drafting and sourcing of component parts for ease of manufacturing and to yield competitive products; plant layout, machinery selection to accomplish same. Awarded U. S. patent no. 4,520,697, 4,602,534, 5,347,892, 5,172,823 and foreign patents. Received "Invention of the Year Award" from Congressman Jake Pickle of Austin, Texas (Products currently sold through Sears department stores nationwide).

Harris Graphics Corporation (now Heidelberg Harris). Project leader/designer of ink metering blade system for printing presses, in implementation of which enabled significant cost reduction. Awarded U.S. patent 4,773,327. Reported to V. P. of R & D, Director of Engineering, and Director of New Product Development.

PERFORMANCE AND LICENSES: Bar results: MPRE 143/150; MBE 158; Registered Patent Practitioner (Reg. No. 35,289, via 1991 Patent Bar Exam); Attorney-at-law (Texas, TBA # 00795536); Registered Professional Engineer (Texas, 68980). Admitted to practice before the Federal Circuit Court of Appeals and the bar of the District of Columbia (Reg, No. 489310). Admitted before an International Bar of a European Union member state (Bucharest Bar, Reg. No. 3555/C).

SPECIAL SKILLS: Foreign language skills: English, French and German. Proficient with PCs, AUTOCAD and UGII. Certified in Geometrics.

ARTICLES:

*Should We Believe in a Little Injustice? The Case for Patent-Integrated Arbitration Terms*”; currently drafting together with Professor Chris Gibson, with review by former Federal Circuit Court of Appeals Chief Judge Randall Rader.

*Why file in the U.S. First*, chapter 7.7 of book entitled Intellectual Property Management Guide, published by Kogan Page and the European Patent Office, 2009.

*The Patentability of Software in the U.S. and Europe*, invited speaker, 9. St.Galler Internationales Immaterialgüterrechtsforum - Conference –Speech Transcript, January 16, 2006.

*Software Intellectual Property Strategy*—Start-ups must first preserve their rights, *Createurs* Vol. 20, December 2001, Genilem.

*Financial Services using New Business Methods Enabled by Software are Now Patentable in the U.S.—with Extraterritorial Effects*, *Journal of World Intellectual Property*, May 1999.

*Barbed Wire Goes Up on the Cyber Frontier*, May 1999, on Bottom-Up web site on World Wide Web.

*Copyright of Visual Art*, 1996, published on the World Wide Web.

*The Patent FAQ* in German and English, published on the World Wide Web.

*Stepping into Magic*, book, 1997, contributing author, chapter on U.S. patents.

ACTIVITIES/PERSONAL: Recipient of Educational Enrichment Award from Partners in Space (nonprofit educational organization). Featured on Smithsonian Institution's *Invention Series*, produced for the Discovery Channel, '95-'96. Married, father of three children. Enjoy boating, jogging, and hiking.