

Michael K. Jones

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As a former engineer with the U.S. Department of Defense, and with two decades of IP law experience, Mike offers business-savvy, practical IP legal counsel to clients in a variety of industries concerning a wide range of technologies.

OVERVIEW

A registered patent attorney, Mike focuses on all aspects of intellectual property, including strategic intellectual property counseling and portfolio management, patent procurement (including domestic and foreign rights), patent opinions (including freedom to operate, non-infringement, invalidity, patentability), IP due diligence, licensing, and enforcing and defending patent rights.

Before earning his law degree, Mike was a patent agent, and prior to that, he was an engineer for more than 10 years with the Naval Surface Warfare Center – Ship Systems Engineering Station. Mike's practical experience as an engineer helps him understand the forces that help drive business decisions and allows him to consult and advise clients on IP legal issues and other day-to-day challenges.

Mike has counseled clients in a variety of industries and in a wide range of technologies, including mechanical and electrical devices, electronics, communication systems, computer hardware, data collection and storage systems, content conditioning and delivery systems, software, artificial intelligence and machine learning, mobile device management and security, electrical power generation, distribution and control, electrical connectors, autonomous vehicles, medical devices, clean technologies, non-destructive testing, consumer products, apparel, biometrics, optics, printing and imaging systems, automotive, vessel design and construction, watercraft propulsion and auxiliary systems, manufacturing techniques, packaging, advanced materials, ecommerce, and business methods in the banking, insurance, investment, and financial services industries.

Mike also advises cannabis clients on intellectual property issues, including patent applications, trademark filings and agreements, including nondisclosure, license, collaboration, joint development, material transfer, and website agreements.

Higher education clients call on Mike to protect and commercialize intellectual property developed by their researchers, faculty and students.

REPRESENTATIVE MATTERS

- Represented defendant Proscia, Inc. in a patent infringement action brought by non-practicing entity Rondevoo Technologies, LLC in the District of Delaware. Rondevoo Technologies alleged infringement of US Patent Nos. 7,088,854, U.S. 7,254,266, and U.S. 8,687,879, all entitled “Methods and Apparatus For Generating Special-Purpose Image” and having claims directed to automating the expert quantification of image data using a product algorithm. The accused system was Proscia’s Concentriq Image Analysis solution. We obtained an early settlement on terms our client found very favorable. *Rondevoo Technologies LLC v. Proscia, Inc.*, Civil Action No. 1:19-cv-2327-RGA (U.S. District Court, District of Delaware).
- Represented defendant Vishay Intertechnology Inc. in a patent infringement action in which U.S. Patent No. 6,792,373, “Methods and apparatus for semiconductor testing” is being asserted. The accused products relate to semiconductor test systems and methods. We obtained summary judgment in the district court in favor of our client, and defended that judgment in the Federal Circuit, resulting in a Rule 36 affirmance. *In-Depth Test LLC v. Vishay Intertechnology, Inc.*, case 1-14-cv-00888 (U.S. District Court, District of Delaware).
- Represented several related parties in the defense of a patent action in which a number of patents directed to measuring optical characteristics of an object (e.g., mobile telephones and sensors for mobile devices) were being asserted. This case settled on the eve of trial under terms favorable to our client. *511 Innovations, Inc. v. Vishay Intertechnology, Inc. and Vishay Capella Microsystems (Taiwan) Limited et al.*, case 2-15-cv-01524 (U.S. District Court, Eastern District of Texas).
- Asserted an action on behalf of the client for infringement of patents directed to thermoelectric air conditioners and thermoelectrically air conditioned transit cases on behalf of plaintiff. Settled case after defendants agreed to stop the manufacture and sale of the infringing products and pay for past infringement. *EIC Solutions, Inc. v. CP Cases, COOL, Bruce Blackway*, case 1:13-cv-03609-WDQ (U.S. District Court, District of Maryland).
- Coordination and management of international patent enforcement and licensing program for patent portfolio directed to cosmetic products, including thermal storage tips for cosmetic applicators.
- *HCT Asia Ltd. v. S.A. JACKEL France*, High Court of Paris [Tribunal de Grande Instance de Paris], 3rd chamber, 3rd section, Docket no.: 13/00816.
- *HCT v. Yonwoo*, multiple patent forums in Korea – plaintiff in patent infringement action before the District Court; patent owner defending Korean patent in an invalidation proceeding before the Korean Intellectual Property Tribunal; and patent owner defending Korean patent in a Confirmation of Scope Action before the Korean Intellectual Property Tribunal; Appellee before the Korean Patent Court in appeal from the Korean Intellectual Property Tribunal upholding the validity of the Korean patent and holding the accused device falls within the scope of the Korean patent in the Confirmation of Scope Action.
- Defending against assertion of a patent directed to liner systems for food service applications – e.g., liners for slow cooker. Successfully obtained a voluntary dismissal for client during the early stages of discovery by showing plaintiff it did not have a case of patent infringement against our client. *KKG, LLC v. The Rank Group, PLC d/b/a Reynolds Kitchens and/or Reynolds Group et al.*, 2-11-cv-00012 (U.S. District Court, Eastern District of Texas).
- Represented seven co-defendants in a joint defense group in a case asserting patents covering encryption software. Successfully negotiated an early settlement, patent license, and covenant not to sue. *The PACid Group, LLC v. Cisco Systems, Inc., et al.* (U.S. District Court, Eastern District of Texas).
- Successfully negotiated a license and settlement of the case involving composition of cream for topical application of medication under term favorable to our client during the initial pleading stage of case. *Ferndale Laboratories, Inc. v. Prugen, Inc., et al.* (U.S. District Court, Eastern District of Michigan (Detroit)).
- Obtained favorable settlement and a monetary award for Trans World Technologies, Inc. in case involving misappropriation of trade secrets, antitrust and patent infringement. Technology involved included physics-based software, mathematical modeling and artificial intelligence. *Trans World Technologies, Inc. v. Raytheon Co., et al.* (U.S. District Court, District of New Jersey).
- Handled three cases involving worldwide assertion of a pioneering patent in the field of biometric iris authentication in which the client was able to successfully prevent and delay several would-be competitors from entering into this field. Helped mediate a settlement and negotiated favorable license agreements for the client. *Iridian Technologies v. Iritech, Inc.* (High Courts of Justice, Chancery Division, Great Britain); *Iridian Technologies, Inc. v. Senex Technologies* (Court of Rome, Italy); and *Iridian Technologies, Inc. v. Iritech, Inc.* (U.S. District Court, District of Delaware).

- Successfully defended client in a patent infringement action through discovery and claim construction, thereafter obtaining a favorable settlement and dismissal. *United States Filter Corporation v. Met-Pro Corporation* (U.S. District Court, District of Delaware).
- Successfully asserted several of client's patents and obtained a successful settlement for client on the eve of trial, thus helping client protect their business interests and extract value from their R&D investment through the procurement and strategic use of the client's intellectual property. *Maritrans, Inc. v. Penn Maritime, Inc.* (U.S. District Court, Middle District of Florida).
- Successfully obtained dismissal of a declaratory judgment action against client for lack of personal jurisdiction over the patentee defendant. *Penn Maritime, Inc. v. Maritrans, Inc.* (U.S. District Court, Eastern District of New York).
- Represented clients in cases involving fan and motor technologies. Helped negotiate a settlement of case at conclusion of trial. *Lakewood Engineering, Inc. v. Lasko Metal Products, Inc.* (U.S. District Court, Northern District of Illinois, Eastern Division); *Lakewood Engineering, Inc. v. Lasko Metal Products, Inc.* (U.S. District Court, Northern District of Illinois).
- Steered case to an early settlement, protecting client's interests and obtaining a favorable license that allowed the client to continue to do business in the particular market. *Holmes Group, Inc. v. Lasko Group, Inc.* (U.S. District Court, Eastern District of New York).

AWARDS

- *Best Lawyers in America*®: Patent Law (2026)

TOP AREAS OF FOCUS

- Educational Institutions
- Emerging Companies + Venture Capital
- Health Care + Life Sciences
- Health Care + Life Sciences Intellectual Property
- Intellectual Property

ALL AREAS OF FOCUS

- Academic + Research Institutions
- Digital Assets + Blockchain
- Educational Institutions
- Emerging Companies + Venture Capital
- Energy
- Financial Services
- Food + Beverage
- Health Care + Life Sciences
- Health Care + Life Sciences Intellectual Property
- Intellectual Property
- Life Sciences Transactions
- Patent Litigation
- Patent Prosecution, Counseling + Portfolio Management
- Post-Grant Patent Review

- Technology

EDUCATION AND CERTIFICATIONS

EDUCATION

- Rutgers Law School, J.D., 1998
- United States Merchant Marine Academy, B.S.M.E., 1987, marine engineering systems and mechanical engineer

BAR ADMISSIONS

- Pennsylvania
- New Jersey
- U.S. Patent and Trademark Office

COURT ADMISSIONS

- U.S. District Court, Eastern District of Pennsylvania

PUBLICATIONS

- Co-author, "USPTO's Guidance on Inventorship of AI-Assisted Inventions Remains True to Fundamental Principles, But May Not Be the Right Test," *Troutman Pepper*, February 28, 2024.
- Co-author, "Court Guidance on Virtual Patent Marking Needs to be Heeded to Protect Products," *IAM*, September 12, 2023.
- Co-author, "What Is a 'Patent Waiver' Anyway? Zooming Out on the TRIPS COVID IP Waiver Debate," *IPWatchDog.com*, August 9, 2021.
- Co-author, "USPTO Announces COVID-19 Prioritized Examination Pilot Program," *Troutman Pepper*, May 19, 2020.
- Co-author, "USPTO Extends Certain Patent Deadlines to Address COVID-19 Delays," *Troutman Pepper*, April 3, 2020.