



John L. DuPré

PRINCIPAL

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HAMILTON
BROOK SMITH
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Intellectual Property Law

PRACTICE AREAS

- Trademarks
- IP Litigation
- Trademark Opposition and Cancellation Proceedings
- Copyrights
- Counseling
- Licensing
- Agreements
- Trade Secrets

EDUCATION

- Williams College, B.A. in Mathematics, *cum laude*
- Fordham University School of Law, J.D.

PROFESSIONAL ASSOCIATIONS

- American Bar Association
- Boston Intellectual Property Law Association, Past-President; Past Board of Governors
- International Trademark Association
- New Hampshire Bar Association
- The New England Center for Children, Inc., Member Board of Advisors

For over 40 years, John has practiced primarily in the areas of intellectual property litigation and trademark prosecution. Since joining the firm in 1986, he has been involved in patent litigation, patent interferences, International Trade Commission proceedings, trademark and trade dress litigation, trademark oppositions and cancellation proceedings, and copyright litigation. He also has experience in licensing matters and IP counseling.

In addition, John's legal expertise also includes IP portfolio strategy and counseling, due diligence studies and opinions, audits, trade secret advice, alternative dispute resolution, nondisclosure agreements, technology transfer, consulting, employment, and community interest agreements.

John works with start-up, emerging and small companies as well as mid-sized corporations. He has been involved in contested patent matters in the electronic, chemical, and biotechnology fields involving technologies as diverse as Recombinant Protein A, monoclonal antibodies, components for printed circuit boards, chemical compositions for stripping metals, electronic diamond testers, neural network facial recognition systems, acoustic wave analysis and synthesis systems, filtration systems for semiconductor processing, and athletic footwear.

John's copyright matters have included works of art, computer game software, and architectural plans.

The World Trademark Review (WTR) 1000 - The World's Leading Trademark Professionals has hailed John as exceptional:

"The 'exceptional' John DuPré has a particular affinity with emerging and small to mid-sized entities: 'John gets straight to the nub of the problem and has an astounding breadth of experience helping a range of different clients. He is extremely practical, responsive and deliberate. It also helps that we don't have to translate what he says for the board.'"

John is also a Martindale-Hubbell featured AV Peer Review rated lawyer. For 16 years, he has been named to Super Lawyers, which is a rating of outstanding lawyers who have attained a high-degree of peer recognition and professional achievement.

ADMISSIONS

- U.S. Court of Appeals for the Federal Circuit
- U.S. Court of Appeals for the First Circuit
- U.S. District Court, District of Massachusetts
- U.S. Supreme Court
- Massachusetts
- New Hampshire
- New York

INDUSTRY ACKNOWLEDGEMENTS

- Best Lawyers in America® 2024 - Trademark Law
- WTR 2023 ranks John in the Gold category for trademark prosecution and strategy and in the Silver category for handling trademark enforcement and litigation matters.
- Best Lawyers in America® 2023 - Trademark Law
- 2022 - For the fifth consecutive year, World Trademark Review ranks John in the Gold category for trademark prosecution and strategy
- Best Lawyers in America® 2022 - Trademark Law

REPRESENTATIVE EXPERIENCE

- Represented a client in an online trademark and copyright infringement action relating to collectible sculptural works. We secured a successful result with the infringers' ceasing infringing activities on the eBay® website by use of the "take down" procedures.
- Represented major digital marketing client in copyright dispute relating to a marketing information document. We prepared and sent a cease-and-desist letter resulting in infringer ceasing all infringing activity without the expense of a lawsuit.
- Represented a plaintiff in successive patent jury trials in the Northern District of California involving components for printed circuit boards. The first trial resulted in a finding of validity and infringement in the liability phase and subsequent contempt citations against the defendant for new designs. The case settled prior to the damage phase with the defendant agreeing not to market any infringing product. The second trial resulted in the jury finding willful infringement of a redesigned product, with increased damages and attorneys' fees awarded by the Court.
- Represented an academic institution in a patent case against a major technology corporation for infringement of a patent related to speech analysis, compression and transmission. We developed a successful cost-saving strategy of inducing the court to change its usual practice for the timing of Markman hearings, thereby achieving an early summary judgment hearing after only limited discovery.
- Defended a manufacturer of telecommunications hardware in a multi-defendant action filed in the Eastern District of Texas by a "Non-Practicing Entity." We succeeded in obtaining dismissal with prejudice of our client from the action with no payment to the plaintiff.
- Defended an action in the District of New Hampshire involving alleged infringement of several patents directed to a chemical composition for stripping metal brought by the industry leader. The action successfully concluded with a reformulation of the compounds to avoid any infringement and without any payment by our client to the patent holder.
- Defended an International Trade Commission action that involved inline skates. We represented a U.S. based skate importer and successfully concluded the proceeding with a negotiated license at a minimal royalty. The client was able to continue to import with minimal impact on its business.

INDUSTRY
ACKNOWLEDGEMENTS

- World Trademark Review 1000 2021 Recognizes John in Gold and Silver Categories
- Recognized as a Global Leader by World Trademark Review for 2020
- *World Trademark Review* 1000 2020 Calls John DuPré a “veteran trademark and copyright protector and litigator”
- Recognized as a Global Leader by *World Trademark Review* for 2019
- Best Lawyers in America® 2020 - Trademark Law
- Recognized by *World Trademark Review* 1000 2019 in the gold category in for trademark prosecution and strategy
- Best Lawyers in America® 2019 - Trademark Law
- *World Trademark Review* 1000 2018 Recognizes John in gold category for trademark prosecution & strategy

REPRESENTATIVE EXPERIENCE (CONTINUED)

- Defended a start-up company in two separate actions filed in the Central District of California based on patents related to hinge and latch designs. The actions were successfully resolved with dismissal of the infringement claims with prejudice and no payments by our client to the patent owner. In addition, our client received royalty-free licenses.
- Represented a Taiwan-based manufacturing firm against infringement claims under two patents asserted by a multinational company. We succeeded in obtaining summary judgment of noninfringement on one of the patents, which led to successful mediation that resolved the claims under the other patent.
- Defended against allegations of infringement of patents in the semiconductor manufacturing field by taking the offensive to enforce our client’s own patent on related technology. We carried out strategic discovery that resulted in a resolution that was favorable to our client.
- Represented the owner of a patent relating to semiconductor manufacturing in an infringement action in which we were successful in securing a preliminary injunction against the defendant’s continued infringement. Thereafter, we succeeded in having the defendant found in contempt and were awarded attorneys’ fees even though the injunction was dissolved based on newly discovered prior art.
- Defended a manufacturer of oxygen flow valves in a trade secret, trade dress and unfair competition action in the District of Indiana. After a two-day evidentiary hearing, the judge refused to enter a preliminary injunction, as a result of which the plaintiff voluntarily dismissed all of its claims, thereby enabling our client to continue in business and become the leading company in the field.
- Represented a leading international research institution as the junior party in a patent interference involving nucleic acids and proteins. We were able to have the PTO determine priority as to a number of interfering inventions and were successful in requesting that the Patent Office redeclare the interference to add multiple patent applications and counts. As a result, a patent issued to our client.
- Represented a biotechnology company as the junior party in a patent interference involving a crosslinked protein composition. After the interference was declared, we were able to negotiate a favorable settlement under which our client obtained a license with only a nominal royalty.

**INDUSTRY
ACKNOWLEDGEMENTS**

- *Best Lawyers in America*® 2018 - Trademark
- *Best Lawyers in America*® 2017 - Trademark Law
- *World Trademark Review* 1000 2016 Recognizes John DuPré for Enforcement and Litigation, as well as Prosecution and Strategy
- *World Trademark Review* 1000 2015 Hails John DuPré as "Exceptional"
- *World Trademark Review* 1000 2013 Calls John DuPré a "Key Figure"
- *World Trademark Review* 1000 2012 Recognizes John DuPré as a "Seasoned Trademark Practitioner"

REPRESENTATIVE EXPERIENCE (CONTINUED)

- Represented the junior party, a startup biotech company, against an international pharmaceutical company in an interference involving a recombinant protein. We established the priority rights of our client and obtained the patent for them despite having the second filing date and the second invention date.
- Defended a computer hardware provider in a trademark opposition brought by a major data processing company. We were successful in an appeal before the Court of Appeals for the Federal Circuit in upholding the dismissal of the opposition against our client's application, and our client's trademark became registered.
- Represented a real estate developer to enforce copyright in architectural plans against an architectural firm, another developer and real estate developer. We successfully resolved the matter with each of the defendants prior to trial, resulting in a recovery for our client based on the defendants' profits from the sale of infringing units.
- Represented a nationwide retailer accused of trademark infringement in a state court action. We succeeded in obtaining summary judgment in favor of our client by showing, through the plaintiff's own testimony, that the channels of trade were not the same.
- Represented a trademark owner in an infringement action for electronics products in which we obtained a preliminary injunction that forced a settlement that included a permanent injunction and payment of our client's attorneys' fees.
- Represented a renowned research institution in a trademark infringement action against a publisher. We quickly reached settlement on terms favorable to our client, including a change of the defendant's corporate and domain names and cessation of its use of our client's trademark and the entry of a consent judgment against the defendant.
- Represented a brand manufacturer of communication and computer peripheral hardware against a new retailer that adopted a similar name. We developed a strategy to send a cease-and-desist letter at the same time we filed an infringement action, which led to a quick settlement in which the infringer stopped all use of the infringing name and phased over to a new identity.

REPRESENTATIVE EXPERIENCE (CONTINUED)

- Represented the owner of a social networking, media, and thought exchange website in a trademark dispute with an internet forum of similar scope and purpose, and were successful in securing an injunction. The defendant attempted to dissolve the injunction and to move the case out of Massachusetts. Against a barrage of motions, we succeeded in keeping the defendant from dismissing the case or moving it. We were also successful in keeping the injunction in force, resulting in a finding of contempt against the defendant for violating the injunction. The case ended with the defendant changing its name.

ARTICLES

- Controlling Costs in Patent Litigation, *2013 IP Value (IAM Magazine)*, January 2013
- Worldwide trademark protection: coverage versus costs, *IAM magazine*, January 2012
- Battling infringement, *Nature Biotechnology*, January 2011
- When to Choose Trade Secret Protection Over a Patent, *IAM magazine*, January 2011

IP NEWS ALERTS

- Implementation of the Trademark Modernization Act of 2020, *Hamilton Brook Smith Reynolds Alert*, January 6, 2022
- United States Supreme Court Decision in Arthrex Finds a Constitutional Remedy for the Structure of the Patent Trial and Appeal Board in Post Grant Patent Challenges, *Hamilton Brook Smith Reynolds Alert*, June 25, 2021
- Justices Say Willfulness Not Needed For Trademark Profits, *Hamilton Brook Smith Reynolds Alert*, April 24, 2020
- The Federal Circuit Confirms a Return to Restrictive Patent Venue Requirements, *Hamilton Brook Smith Reynolds Alert*, September 29, 2017
- Under the Defend Trade Secrets Act (DTSA) of 2016, Federal Trade Secret Protection is Now Available, *Hamilton Brook Smith Reynolds Alert*, March 3, 2017
- Federal Circuit Clarifies Interstate Use-In-Commerce of Trademarks, *Hamilton Brook Smith Reynolds Alert*, November 30, 2016
- IP Pirates and Other Willful Infringers: Beware, the Supreme Court Eases Standards for Awarding Enhanced Patent Damages, *Hamilton Brook Smith Reynolds Alert*, June 14, 2016
- Supreme Court Determines Trademark Tacking is Jury Issue - Reconfirms Markman Claim Construction is for the Judge, *Hamilton Brook Smith Reynolds Alert*, January 29, 2015
- Colombia and Mexico Enter the Madrid Protocol for the International Registration of Marks, *Hamilton Brook Smith Reynolds Alert*, February 13, 2013
- Renewing Trademark Registrations, *Hamilton Brook Smith Reynolds Alert*, November 2009

SPEAKING ENGAGEMENTS

- “Protecting Brands for Virtual Currencies,” Hamilton Brook Smith Reynolds Webcast, June 21, 2018
- “Protecting Your Brewery’s Brands with Trademarks,” Hamilton Brook Smith Reynolds Webcast, April 27, 2018
- Blockchain and Cryptocurrency Forum, Boston Bar Association, Boston, MA, March 28, 2018
- “Using Coexistence Agreements to Secure and Confirm Trademark Rights,” Hamilton Brook Smith Reynolds Webcast, September 14, 2016
- “Think Your Company’s Trademark Will Be Difficult to Protect?” Hamilton Brook Smith Reynolds Webcast, June 24, 2014
- “Patent Damages, the New Economic Realism and Early Case Assessments,” Hamilton Brook Smith Reynolds Lecture, Boston, MA, January 29, 2014