



Kaplan IP Law

Your ideas. Your business.

831-440-7282

jonathan@kaplan-iplaw.com
www.kaplan-iplaw.com



“I worked with Jonathan as part of our business steering team. He always showed significant interest in growing the business and how a successful legal strategy could be one foundational pillar for future success.”

*Aaron Kelley, Director, Business Development,
Genencor, A Danisco Division*

***Jonathan M. Kaplan, Ph.D., J.D.* is a Patent Attorney and Intellectual Property Counsel for biotechnology, pharmaceutical, green technology and medical device clients. He provides patent prosecution, portfolio management, opinions, due diligence, and litigation support as well as other services for in-house legal departments.**

Jonathan served as in-house IP counsel for two companies and served many more in private practice. He knows that the IP needs of his clients are more than just legal matters. IP plays a critical role in business models, business valuations, decision-making, and risk management. IP can define what products are brought to market, drive licensing opportunities, generate revenue streams, and provide leverage over competitors.

Thus, Jonathan strives to be viewed by his clients as a business partner. He learns about his clients from both a technical and business perspective. He integrates their IP matters with their needs and business goals. Jonathan provides the kind of “big-picture” counseling that helps decision-makers meet those needs and goals. As a small firm practitioner, he provides efficient and cost-effective services.



“Jonathan is a great strategic thinker who brings his superior technical knowledge and understanding of the concerns of business together to craft the best resolutions for clients”

Erica Wilson, Partner, Goodwin Proctor LLP

Jonathan's private practice has focused on patent prosecution, opinions, and diligence matters on behalf of pharmaceutical, medical device, and financial institutions. He also worked on major patent litigations on behalf of biotechnology, pharmaceutical, interactive telephone and digital jukebox network companies. Jonathan has represented Biogen, Pfizer, AstraZeneca, Aventis, Purdue Pharma, Bayer, The Regents of the University of California, and Ecast Inc.

Jonathan practiced in-house where he managed patent portfolios and invention disclosures. He also provided freedom to operate guidance, patent landscape analyses, and cleared publication requests. Furthermore, he assisted with patent licenses, material transfer agreements, and non-disclosure agreements. Moreover, he served on in-house litigation and investigation teams and provided other general corporate legal services.

ACADEMIC BACKGROUND

FORDHAM UNIVERSITY SCHOOL OF LAW

Juris Doctor (2001)

COLUMBIA UNIVERSITY, COLLEGE OF PHYSICIANS AND SURGEONS

Doctor of Philosophy, Microbiology (1997)

Master of Philosophy, Microbiology (1994)

Master of Arts, Microbiology (1992)

CALIFORNIA POLYTECHNIC STATE UNIVERSITY, SAN LUIS OBISPO

Bachelor of Science, Microbiology (1991)

BAR ADMISSIONS

United States Patent and Trademark Office, 2000

New York, Second Judicial Department, 2002

California, 2003

United States District Court for the Southern District of New York, 2002

United States District Court for the Eastern District of New York, 2002

United States District Court for the Northern District of California, 2003

LEGAL BACKGROUND

DANISCO US, GENENCOR DIVISION, Palo Alto, California,

Director, Senior Intellectual Property Counsel (2010-2011)

MEDAREX, INC., Milpitas, California,

Intellectual Property Counsel (2007-2010)

MORRISON & FOERSTER, Palo Alto, California

Patent Litigation Attorney (2003-2007)

FISH & NEAVE, New York, New York

Patent Attorney (2001-2003)

Patent Agent/Technical Advisor (1997-2001)

“Jonathan brings a sharp and quick mind to any problem and a bulldog mentality to see it through. He is a pleasure to work with, enthusiastic at all times and extraordinarily helpful.”

**Saul Silverstein, Professor
Columbia University Medical Center**

TECHNOLOGIES FROM PRIOR MATTERS

Industrial microbiology, industrial enzyme production and applications, first and second generation fuel ethanol

Molecular Immunology, human monoclonal antibodies, antibody engineering and production

Biotechnology, recombinant DNA technology, protein production, cell-based assay systems, knock-out and transgenic animal technology

Pharmaceuticals, including drug formulation and delivery

Stent implant technology

Interactive telephone technology

Digitally downloading jukeboxes and computer networking

PUBLICATIONS

Flattmann and Kaplan, Licensing Research Tool Patents, Nature Biotechnology 20:945-947 (2002);

Flattmann and Kaplan, Patenting Expressed Sequence Tags and Single Nucleotide Polymorphisms, Nature Biotechnology 19:683-684 (2001) (Part 1)

Flattmann and Kaplan, Patenting Expressed Sequence Tags and Single Nucleotide Polymorphisms, Nature Biotechnology 19:777-779 (2001) (Part 2)

Kaplan & Calame, "The ZiN/POZ Domain of ZF5 is Required for Both Transcriptional Activation and Repression," Nucleic Acids Research 25:1108-1116 (1997)

Numoto et al., "Transcriptional Repressor ZF5 Identifies a New Conserved Domain in Zinc Finger Proteins," Nucleic Acids Research 21:3767-3775 (1993)

Kaplan IP Law provides high-quality, flexible legal services to meet your particular needs. Whether you seek holistic IP counseling or help with specific matters, Jonathan will be personally committed to assuring that you have an excellent experience.



Patent Prosecution: Jonathan provides U.S. patent prosecution services and directs the prosecution of foreign applications. He helps his clients manage their patent portfolios. He helps with application appeals and other post-grant proceedings.



Patent Landscapes: Jonathan identifies third party patents and applications that are relevant to his clients' businesses and technologies. He provides his view of claim scope and the likelihood of relevant claims issuing from pending applications. Patent landscapes help with risk analyses within Jonathan's clients' technology areas.



Opinions: Jonathan provides patent enforceability, validity, and infringement opinions. The opinions might be rendered for early innovation guidance, generic or follow-on product development, pre-investment or acquisition due diligence, or defenses against willful infringement allegations.



Corporate IP Services: Jonathan manages patent portfolios and invention disclosures, clears publication requests, and identifies licensing opportunities. He also helps with material transfer agreements and non-disclosure agreements. Moreover, he conducts internal investigations and helps ensure that other legal issues are properly addressed – either by him or other competent counsel.



Litigation Support: Patent litigation is complex. Jonathan works with litigation counsel to protect his clients' interests. He participates in litigation strategy, reviews work product, and liaises between his clients and litigation counsel. He helps with internal investigations, document retention policies, and document collection. He also helps with settlement negotiations.

Kaplan IP Law

PO Box 66744
Scotts Valley, CA 95067

831-440-7282

jonathan@kaplan-iplaw.com
www.kaplan-iplaw.com

Photographs are the property of Kaplan IP Law.
All rights reserved.