



Joshua A. Lorentz

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Joshua Lorentz is Dinsmore's Managing Partner and Chair of its Executive Committee and Board of Directors. Josh joined Dinsmore in 2001 and served in a variety of leadership roles including Chair of Dinsmore's Intellectual Property Department and Finance Committee. In his role as Managing Partner, Josh is responsible for establishing and executing Dinsmore's strategic priorities, including advancing business initiatives and promoting a culture of excellence, community and collegiality.

Josh helps companies in a variety of industries make intelligent decisions about their intellectual property rights and protect the ultimate value of their business — from IP audits/due diligence to IP litigation and licensing. He has tried IP litigation matters to decision, conducted claim construction (Markman) hearings, led and consulted in post grant proceedings and represented clients before the U.S. Court of Appeals for the Federal Circuit. He also has unique experience in licensing matters, negotiating hundreds of technology agreements for multiple clients, including dozens of Cooperative Research and Development Agreements with National Laboratories and Research Agreements with Universities.

Josh's experience has led to exciting work, including being entrusted to handle a variety of matters for international clients, such as LexisNexis (a division of RELX Group). In fact, he has served as acting patent counsel for RELX Group, a global publisher and provider of workflow and business solutions. In his role as "in-house counsel," Josh gathered a unique perspective of the challenges faced by multi-national corporations, which has solidified his practical approach to problem solving and enhanced the quality of service to clients.

Josh has been a driver behind the growth of the firm's IP Department, which boasts more than 100 attorneys today. Through aggressive recruiting and focused mentoring, he has increased the number of attorneys through mergers and by bringing in partner and associate laterals from local, regional and national firms that strengthen the services offered by Dinsmore. Josh continues to be a strong proponent of building diverse teams, helping recruit and mentor the next generation of diverse Dinsmore attorneys and is a strong advocate for their professional development.

Aside from his leadership and legal practice, Josh enjoys competitive running, competing in local and regional running events each year.

Services

- Intellectual Property
- Intellectual Property Acquisitions
- Intellectual Property Litigation
- Patent Procurement & Management

Education

- University of Dayton School of Law (J.D.)
- Ohio University (B.S.)
- Ohio University (B.A.)

Bar Admissions

- Ohio
- U.S. Patent & Trademark Office

Court Admissions

- U.S. Court of Appeals for the Federal Circuit
- U.S. Court of Appeals for the Sixth Circuit
- U.S. District Court for the Southern District of Ohio
- U.S. District Court for the Northern District of Ohio

Affiliations/Memberships

- Cincinnati Zoo
 - Board of Directors
 - Executive Committee
 - Chair, Finance Committee
 - Vice chair, Visitor Engagement Committee
- Commercial Club of Cincinnati
- Cincinnati Art Museum
 - Board of Trustees
 - Finance Committee, Vice Chair
 - Marketing Committee
- ArtsWave Cabinet Member
- The Summit Country Day School

- Board of Trustees
 - Coordinating Committee
 - Chair, Development Committee
 - Business Affairs Committee
- Leadership Cincinnati, Class 38
- Cincinnati C-Change (2010 Class 5)
- Hamilton County Central Committee, precinct chair
- United Way of Greater Cincinnati, Tocqueville Society
- Cincinnati Area Senior Services, Board of Directors
- American Heart Association, Heart Ball Executive Leadership Team
- Cincinnati Bar Association, Intellectual Property Litigation Section
- Cincinnati Intellectual Property Law Association
- Ohio State Bar Association
- American Intellectual Property Law Association
- Intellectual Property Owners Association
- PTAB Bar Association
- Licensing Executives Society
- International Trademark Association

Distinctions

- Peer Review Rated AV in *Martindale-Hubbell*
- Ohio *Super Lawyers*®
 - Highlighted in *Super Lawyers* magazine (2013)
- University Of Dayton Francis J. Conte Special Service Award (2013)
- *Chambers USA*®: *America's Leading Lawyers for Business*, Intellectual Property
- Leading Lawyers Power 100, *Cincy Magazine*
- *Best Lawyers*®
 - Litigation – Intellectual Property

Languages

- Spanish

Experience

Patent Preparation and Prosecution

Our firm works with a large company in the medical device industry in the preparation and prosecution of patent applications related to numerous technologies in its IP portfolio.

Quality Service. Quality Relationships.

For the past 15 years, Dinsmore has been the acting patent counsel for RELX Group, while also advising the company's outside counsel in patent matters. In addition, we advise on general intellectual property (IP) and labor matters.

"There are three reasons we continue working with Dinsmore," said Kenneth Thompson II, General Counsel at RELX Group. "The quality of legal work is outstanding; the relationships we've developed with the IP group makes it feel like they're part of my internal team, and relationships are very important to me; and frankly, it's the same quality of legal advice and relationships at a discounted fee structure compared with global markets."

RELX, which employs roughly 30,000 people, was founded in 1993 and based in London, UK. The company sells information-driven services and solutions to scientists, lawyers, teachers and business professionals.

"It's exciting for me as general counsel based in Southwest Ohio for a global company to work with resources also headquartered in Southwest Ohio," added Thompson. "The depth of our relationship is something that can't be replaced. I hold the firm and the people in high regard."

Throughout our history together, we've been able to solidify the company's global patent program, establish processes and procedures for outside counsel and obtain wins on IP cases involving trolls.

Counseled our Client on Export Control Concerning Multiple Research Projects

We provided advice on export control classifications for over 100 research projects for a large company in the automotive industry. We provided guidance on export control provisions in licensing and technology transfer agreements.

Ohio Willow Wood v. Alps South

John Luken served as lead appellate counsel for The Ohio Willow Wood Company (OWW), a manufacturer of prosthetic products, which came to Dinsmore after it had lost an infringement trial against a competitor, been enjoined from selling new products, held in contempt of the injunction, and ordered to pay nearly \$20 million in damages to its chief competitor.

On behalf of OWW, Mr. Luken and the Dinsmore appellate team successfully obtained a stay of the contempt order from the Federal Circuit, which allowed OWW to begin selling its products again. After briefing and argument, the Federal Circuit reversed the lower court's judgment and dismissed the complaint for lack of standing, thereby overturning the judgment against OWW. Mr. Luken also successfully opposed a petition for rehearing and rehearing *en banc*.

Helping the Cincinnati Reds Protect Its Brand Integrity

The name of the game

Dinsmore provides Reds trademark protection

From the regal, stark-white “C” against a red background to the distinctive handlebar mustache of Mr. Redlegs, the Cincinnati Reds own a number of unique brands, labels and mascots that contribute to its status as one of Major League Baseball’s most popular teams. Marketing and brand recognition play an integral role in the growth and success of any professional sports franchise and the Reds trust Dinsmore to protect an important part of its identity.

Leveraging extensive trademark experience and a thorough understanding of MLB licensing regulations, Dinsmore attorneys work to support the Reds proactive approach to merchandising, licensing and broadcasting. Dinsmore is adept at searching federal, state and local registries, as well as performing availability and clearance searches, to help the Reds aggressively promote and expand its brands without exposing the Club to unnecessary risk. Conversely, Dinsmore also helps the Reds protect its brand integrity by ensuring that merchandise and broadcasting rights are registered and cleared through the proper channels. Should unauthorized use of the team name or marks be detected, Dinsmore also serves as local enforcement counsel.

Protecting the brands of a team that simultaneously competes against and cooperates with other clubs under MLB marketing and licensing ventures is challenging. Through collaboration with MLB officials on league-wide licensing matters, Dinsmore is able to shepherd the Reds through the trademark registration process in a timely and cost-efficient manner.

Whether it’s clearing new uniform designs, acquiring domain names or safeguarding fan-favorite mascots, Dinsmore works hand-in-hand with the Reds to strengthen and grow its brands. Marketing and merchandising revenue are vital to driving future club revenue and Dinsmore is committed to searching, clearing, registering and protecting the marks fans identify as uniquely Reds.

IP Licensing/Agreement Experience

Our attorneys have drafted a wide variety of agreements for clients to help them protect their intellectual property. Since 2011, we have drafted more than 575 total agreements, which can be broken down as follows:

Development Agreements (70)

- Independent Contractor Agreements (15)
- Talent Agreements (15)
- Presenter Agreements and Content Provider Agreements (10)
- Joint Ownership Agreements (10)
- Production Agreements (10)
- Employee Invention Policy and Agreements (5)
- Joint Development Agreements (5)

Litigation-related/Dispute Agreements (55)

- Pre-Litigation Settlement Agreements (15)
- Trademark Trial & Appeal Board Settlements (15)
- Co-Existence Agreements (10)
- Litigation Settlement Agreements – Patent Disputes (5)
- Litigation Settlement Agreements – Trademark Disputes (5)
- Joint Defense Agreements (5)

License Agreements (155)

- Software License Agreements (35)
- Patent License Agreements (35)
- Trademark License Agreements (20)
- End User License Agreements (15)
- Subscription Agreements (10)
- Software as a Service (SaaS Agreements (10)
- Channel Partner Agreements (10)
- Pilot Agreements (10)
- Copyright License Agreements (5)
- OEM License Agreements (5)

IT-related Agreements (170)

- Terms of Use and Privacy Policy (35)
- Healthcare-related IT Agreements (30)
- Software IT Agreements (25)
- Hardware IT Agreements (25)
- Master Client/Service Agreements (25)
- Support and Maintenance IT Agreements (15)
- Reseller Agreements (15)

Research Agreements (55)

- Advanced Research Agreements (25)
- Materials Transfer (20)

- Cooperative Research and Development Agreements (10)

Misc. Agreements (55)

- Non-Disclosure Agreements (25)
- Participant Agreements (10)
- Exclusive Sales Representation Agreements (5)
- Termination Agreements (5)
- Domain Purchase Agreements (5)
- Domain Escrow Agreements (5)

NPE Experience

We have defended clients in challenges to their patents from a wide variety of NPEs. Several representative examples of patents we have defended are below:

- **Cascades Publishing Innovation, LLC:** U.S. Patent 8386484
- **Data Speed Technology LLC:** US Patent 5,867,686 – High speed real-time information storage system
- **eTagz:** US Patent 7,503,502 – Computer readable hang tag and product
- **eTagz:** US Patent 7,703,686 – Consumer computer-readable product label apparatus and method
- **eTagz:** US Patent 6,298,332 – CD-Rom product label apparatus and method
- **eWatch:** US Patent 6,970,183 – Multimedia surveillance and monitoring system including network configuration
- **Helfrich Patent Licensing:** Various US Patents related to mobile device technology
- **Honeywell International, Inc.:** Various US Patents related to bar code and QR code technology
- **Infinite Data, LLC:** US Patent 5,790,530 – Message passing multiprocessor system)
- **Innovatio IP Ventures:** Various US Patents related to local area network radio frequencies and multiple channel wireless access
- **Lemolson Foundation:** Various US Patents relating to bar code technologies
- **Lodsys:** US Patent 7,222,078 – Interactive applications (smartphone apps)
- **Mobile Logistics:** Various US Patents related to transportation yard management systems

- **MPHJ (formerly Project Paperless):** Various US Patents related to computer architecture and document management
- **Pragmatus Telecom, LLC:** US Patent 6,322,231 – Method and system for coordinating data and voice communications via customer contract channel changing system using voiceover IP)
- **Round Rock:** Various US Patents related to radio frequency identification
- **TPQ Development LLC:** US Patent 5,412,730 – Encrypted data transmission system employing means for randomly altering the encryption keys)
- **US Ethernet Innovations:** Various US Patents related to Ethernet connections and point of sale
- **Wireless Media:** Various US Patents related to transportation yard management systems
- **You Technology, Inc.:** Various US Patents related to biometric technology

Daws Mfg. Co., Inc. v. Dee Zee, Inc.

Counsel for Dee Zee which was accused of infringing a patent related to truck storage bins. The case settled.

Patent Applications

Protecting your organization's competitive advantage is key to its success in the business world. That's why one of the world's leading automobile manufacturers turns to Dinsmore for their patent needs. We have guided the client through a multitude of patent applications for products ranging from automotive electronics to mechanical systems. We guide the client through the entirety of the patent process, from reviewing the invention disclosure documents and determining the patentability of the product to the drafting and filing of the patent application. We also represent our client in dealing with the patent office, filing written responses and initiating examiner investigations to ensure the patent is issued and our client's business innovations are fully protected.

Patent Infringement Litigation

On behalf of our client, we developed and implemented cost-effective strategies for defending a patent enforcement suit.

Patent Infringement Litigation

Under Section 337 of the Tariff Act of 1930, the ITC investigates claims of unfair trade practices occurring in import trade. An increasing number of intellectual property lawsuits are tried before the ITC because ITC cases proceed faster than cases litigated in federal district courts, where most IP litigation takes place. The ITC also offers a unique set of remedies to companies engaged in patent disputes. The ITC has become a global forum for high-stakes patent cases brought by both U.S. and foreign companies intent on protecting valuable U.S. based IP rights. Dinsmore & Shohl LLP has a great deal of experience successfully representing parties in 337 investigations. For example, on behalf of our client, a \$1 billion industrial machinery manufacturer, we reached successful settlements against multiple respondents importing industrial machinery from China, Germany, Italy and France.

Patent Preparation and Prosecution

Our firm worked with a large company in the high technology industry in the preparation and prosecution of patent applications related to numerous technologies in its IP portfolio.

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Protecting New Corporate Identity and Innovative R&D

Protecting the Future

Innovation is the driving force behind the growth and sustainability of any business, especially one within a specialized industry. Growing your brand and reputation, as well as protecting your ideas, is an ongoing challenge that requires a thorough understanding of not only the law, but also the industry and the marketplace.

As a former subsidiary of BP Company North America, Tri-Arrows Aluminum faced plenty of challenges in building and safeguarding their new identity after being purchased by a consortium of five Japanese companies in 2011. Following the sale, they turned to Dinsmore, who assumed responsibility for managing existing patent applications and prosecution through the U.S. Patent Office. We have also teamed with Tri-Arrows to begin trademark efforts, working with the U.S. Trademark Office to establish and protect their name and brand in the marketplace. Our attorneys have worked exhaustively to learn the aluminum industry, including the market, price points and competition, in order to strategically place Tri-Arrows on a path to long-term success.

Beyond patents and trademarks, we also have steered Tri-Arrows through a number of research and development agreements, protecting their exploration into ventures that have the potential to impact the aluminum industry. Tri-Arrows' forward-thinking mentality, combined with Dinsmore's support and guidance, has enabled them to focus their R&D efforts on both the materials used and the processes employed as they search for competitive advantages.

Working in an industry where significant steps are sometimes hard to come by, Tri-Arrows has employed an aggressive mindset toward protecting their technology and intellectual property, knowing that any competitive advantage could be the determining factor in their success. Dinsmore has become a true partner of Tri-Arrows in this effort, building a level of trust that has paved the way for their continued growth.

Representative IP Litigation Cases

Cascades Publishing Innovation, LLC v. Reed Elsevier, Inc., [3:13-cv-00422-WHR](#) (SD OH 2013)

Cirrex Systems, LLC v. Ocean Optics, Inc., 1:12-cv-1769 (ND GA 2012)

Milacron, LLC, et al. v. Stough Tool Sales, et. al., 1-12-cv-119 (SD OH 2012)

Ball Metal Beverage Container Corp. v. Crown Packaging Technology, Inc., et al., 3:12-cv-0033 (SD OH

2012)

Diba Industries, Inc. v. IDEX Health & Science, LLC, 3:12-cv-01248 (DCT 2012)

AOK Global Products, LTD, et al. v. Ferno-Washington, Inc., 1-12-cv-267 (ED VA 2012)

Paducah River Painting, Inc. v. McNational, Inc., 5:11-cv-135 (WD KY 2011)

Ionic Communications Group, Inc v. Ionic Collective, LLC, 1:11-cv-00766 (SD OH 2011)

Chikezie Ottah v. First Mobile Technologies, 1:10-cv-07296 (SD NY 2010)

L.F.P. IP, LLC, et al. v. Hustler Cincinnati, Inc., 1:09-cv-913 (SD OH 2009)

T. Marzetti Company v. Roskam Baking Company, 2:09-cv-584 (SD OH 2009)

The Container Store, Inc. v. Schulte Corporation, et al., 4:08-cv-00410 (ED TX 2008)

Alps South, LLC v. The Ohio Willow Wood Company, 8:08-CV-1893-T-35MAP (MDFL 2008)

Stiefel Laboratories, Inc. v. Pracso, LLC, 07-0781, (SD OH 2007)

Prasco, LLC v. Stiefel Laboratories, Inc., 07-0135, (SD OH 2007)

NCR Corporation v. Abercrombie & Fitch Co., 06-0919, (SD OH 2006)

NCR Corporation v. The ATM Exchange, 05-0383, (SD OH 2005)

Daniel F. Fitzgibbon, Jr. v. Martin County Coal Corporation and Sidney Coal Company, Inc., 05-0036, (ED KY 2005)

Crown Packaging Technology, Inc., et al. v. Ball Metal Beverage Container, Corp., 05-0281, (SD OH 2005)

Pisces by OPW, Inc. v. Advanced Polymer Technology, Inc., 04-0178 (SD OH 2004)

Milacron, Inc. v. Graham Engineering Corporation, 02-2142, (SD OH 2002)

Total Containment, Inc. v. Osborne, et al., No. 96 7241 (ED PA 1997)

PISCES By OPW v. Total Containment, No. C-1-01-0063 (SD OH 2001)

Environ Products v. PISCES By OPW, No. 02-865 (ED PA 2002)

PISCES By OPW v. Environ Products, No. C-1-02-292 (SD OH 2002)

PISCES By OPW v. Total Containment, No. CIV-02-0543 (SD OH 2002)

PISCES By OPW v. Advanced Polymer Technology, No. C-1-04-178 (SD OH 2004)

Research and Licensing Agreements

Our firm represented a large company in the automotive industry in the preparation and prosecution of patent applications related to numerous technologies in its IP portfolio, and in preparing and negotiating research agreements with universities. We assisted in implementing cost-effective procedures for conducting patentability analyses and patent preparation for a stream of invention disclosures.

Trademark Portfolio Management

Procurement, maintenance and management of worldwide trademark portfolios for various clients in numerous industries.

University Advanced Research Agreements

We represent an automotive manufacturer in negotiating and completing numerous university advanced research agreements and cooperative research and development agreements, in which we leveraged a unique combination of Intellectual Property and Corporate transactional experience.

Publications

October 31, 2012

TROLLS: Unlike Zombies, They Want Your Money Not Your Brains

June 4, 2012

Post Grant Review: Is Your Business Prepared?

Intellectual Property Today