

## Contact

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## Top Skills

Life Sciences  
Legal Matters  
Strategic Thinking

## Languages

Hindi  
English (Full Professional)

# Kumar Maheshwari

Patent attorney and helps entrepreneurs achieve excellent results.  
Irvine, California, United States

## Summary

Mr. Maheshwari counsels and represents clients in various areas of law, including Patents, Trademarks, Trade Secret, Litigation, Employment, Commercial Contracts, Clinical Trial Agreements. In addition, his legal experience includes licensing, infringement risk assessment, avoidance, and other intellectual property counseling.

Practice in the medical, mechanical, electrical and computer arts including patent prosecution, due diligence, clearance, invalidity, infringement and related opinion work, in the fields of medical devices and software.

- Provided representation to companies such as SAP, Medtronic, Large financial institution, Endologix, Qualcomm, Roland USA and Mattel.
- Patent litigation.
- Prosecute patent applications related to electrical, electromechanical, catheter/ stent deployment and drug-eluting stent mechanisms.
- Client counseling in various areas such as, medical device, software, electronic companies to include IP portfolio strategies and identifying licensing opportunities.
- Drafting freedom to operate, clearance opinions and IP licensing documents.
- Performing a comprehensive risk assessment mapping competitor patents against product landscape.
- Draft Inter Partes Review requests, patent and trademark licensing agreements, non-disclosure agreements, pleadings, claim charts for infringement and invalidity contentions.

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## Experience

Mahesh Law Group  
Patent Attorney  
November 2018 - Present (5 years 6 months)  
Irvine, CA

Quality Above All Else!

I am a registered Patent Attorney and decided to start my own firm because I am on a mission to produce high-quality patents and provide personal client support. We are a California intellectual property law firm with offices in Orange County.

Former clients at a former large law firm (800+ attorneys) included various companies such as, but not limited to, Google, SAP, Medtronic, Large financial institution, Endologix, Qualcomm, Roland USA, MSC Software and Mattel.

Besides provide various corporate law services, our practice involves patent procurement, patent portfolio management, IP due diligence and IP monetization. I have experience working with clients on representative matters in a wide variety of technologies including business method patents, medical devices, IOT, Blockchain, gas flow controllers, software, mobile communication systems, e-commerce, analog circuits, electromagnetic, computer networks, digital signal processing, computer architecture, data storage, and others.

Mr. Maheshwari counsels and represents clients in various areas of law, including Patents, Trademarks, Trade Secret, Litigation, Employment, Commercial Contracts, and Clinical Trial Agreements. In addition, his legal experience includes licensing, infringement risk assessment, avoidance, and other intellectual property counseling.

Arc.dev

Investor

October 2022 - Present (1 year 7 months)

United States

Investor in Arc.dev

American Society of Engineers of Indian Origin

Board Member SoCal

January 2019 - June 2019 (6 months)

Orange County, California Area

Organize events with interesting presenters, volunteer time on a weekly basis to plan and strategize events, and seek donations for events.

Endologix, Inc.

Patent Counsel

August 2014 - November 2018 (4 years 4 months)

Irvine, CA

Responsible for all IP matter (Patents, Trademarks and Trade Secrets).

Litigation, prosecution, and employee training related to IP.

Reduce IP budget year over year.

Reduced IP spend by 40% in 2018.

Supervise product liability cases.

Debt financing for \$160M.

Asset Backed loan.

S3 ATM shelf registration.

Draft, edit and negotiate clinical trial agreement.

## Foley & Lardner LLP

Associate

November 2006 - August 2014 (7 years 10 months)

Los Angeles, Ca

Kumar Maheshwari has more than several years of intellectual property experience in medical device, electronic patent prosecution, trademark acquisition, licensing, technology contracts and various litigation matters. Practice in the software, business method patents, mechanical, electrical, medical and computer arts including patent prosecution, due diligence, clearance, invalidity, infringement and related opinion work, in the fields of medical devices and software.

- Provide representation to various companies, such as, Medtronic, Google, Wells Fargo, and Qualcomm, and various startup companies.
- Draft patent applications and responses related to financial institution related patents, software and hardware patents.
- Prosecute patent applications related to electrical and mechanical patents.
- Client counseling to software, financial institutions, medical device and software companies to include IP portfolio strategies and identifying licensing opportunities.
- Drafting patentability, clearance opinions and IP licensing documents.
- Performing a comprehensive risk assessment mapping competitor patents against product landscape.
- Conduct IP due diligence for an acquisition of a \$250M company
- Draft 200+ new patent applications from disclosure meeting stage.
- Draft 500+ office action responses to USPTO for both domestic and foreign patent applications.
- Draft Inter Partes Review requests, patent and trademark licensing agreements, non-disclosure agreements, pleadings, claim charts for infringement and invalidity contentions.

- Prepare cease and desist letters for patent litigation cases.

#### Law Office of J. Curtis Edmondson

##### Law Clerk

January 2005 - September 2006 (1 year 9 months)

Drafting portions of the patent prosecution application, prior art, claims, and specification. Analyzing and evaluating invention disclosures. Preparing, filing, and prosecuting applications for patents; handling trademarks and copyrights matters; and developing technical and legal evidence to demonstrate the novelty and patentability of a device, design or process. Evaluate intellectual property needs for small businesses and help prepare copyright, trademark, or patent applications. Write and edit motions, briefs and requests for discovery during civil litigation.

#### Balboa or Countrywide

##### Law Clerk Insurance company QBE

February 2005 - January 2006 (1 year)

Tracking new legislative insurance laws of 50 states under the direct supervision of the Compliance Officer, using Lexis, PCI, ODEN, NILLS and in-house bill tracking database. Determining whether the new/proposed statute/bill/regulation has impact on Countrywide's insurance business practices. Performing a thorough review of the case law/regulation/statute and informing the appropriate business unit via published compliance bulletins of the necessary changes needed to business practices.

#### University of La Verne College of Law Library

##### Student Worker

July 2004 - September 2005 (1 year 3 months)

Assist customers in locating reference materials. Update library volumes.

#### Microsoft Inc.

##### Program Manager

July 2001 - September 2001 (3 months)

Integrate error protection software into Internet Explorer in order to eliminate system crashes. Communicate with developer and test engineer teams to establish an application program interface and deliver two features by milestone deadline for the Internet Explorer group.

#### Agilent Technologies

##### Software Test Engineer

June 2000 - June 2001 (1 year 1 month)

Write software test programs using Unix and Shell scripting to ensure appropriate functionality for digital hardware components for a CAD tool software.

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## Education

University of La Verne

Juris Doctor (ABA Approved Accredited), Intellectual Property  
Law · (2003 - 2006)

University of California, Davis

B.S., Computer and Electrical Engineering · (1996 - 2001)