

Naresh Kannan

Partner

Albany
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Education

- Albany Law School, *Summa Cum Laude*, JD
- Cornell University, BS, Applied and Engineering Physics

Practices & Industries

- Intellectual Property Litigation
- Patents & Prosecution
- Trademarks, Copyrights & Licensing
- Technology
- Medical Devices
- Communications & Networking Technology
- Emerging Technologies
- Semiconductor

Admitted to Practice

- New York
- US Patent and Trademark Office

Biography

Naresh serves as chair of Barclay Damon's Patents & Prosecution Practice Area and a co-leader of the Technology, Communications & Networking Technology, and Emerging Technologies Teams. A former scientist, engineer, and inventor with research and development and product management experience at leading science and technology innovators including AT&T Bell Laboratories, Naresh concentrates his practice on patent law, including litigation, prosecution, and counseling.

Naresh's patent litigation experience includes district court litigation and contested proceedings before the Patent Trial and Appeal Board (PTAB), such as inter partes reviews (IPRs). He has extensive experience preparing and prosecuting patents before the US Patent & Trademark Office (USPTO) as well as filing international patent applications and coordinating international patent-prosecution activities with country-specific local counsel. Naresh routinely counsels clients on freedom-to-operate (FTO) issues, patent and technology landscapes, the patentability of new products, intellectual property portfolio management, and IP licensing agreements.

Naresh's practice covers a variety of technologies spanning the biomedical, chemical, electrical, optical, computer, software, and mechanical industries. His specific experience includes polymer coatings, composite materials, semiconductor devices and processing, smart wearables, Lidar, photonics, robotics, drones, 3D printing, nanotechnology, vascular devices, glucometry, biomolecular testing, endoscopes, agricultural, detergents, synthetic latex, broadband mobile networks, internet of things (IoT), cloud computing, quantum computing, financial technologies, process automation, big data, cybersecurity, blockchain, voice control, recycling machines, musical instruments, furniture, archery, and more.

Because of his strong industry background, Naresh has assisted clients as embedded and seconded in-house patent counsel,

including for a global consumer-health business and for a leading semiconductor innovation company.

In addition to his legal practice, Naresh is a member of the firm's Opportunity, Inclusion & Belonging Partner Committee and serves as the partner for these initiatives in the Albany office.

Bar Associations

- New York State Bar Association, Intellectual Property Section Member and Former Law, Youth, and Citizenship Committee Member

Selected Memberships & Affiliations

- American Inn of Court, Intellectual Property and Innovation Inn, Executive Committee Member

Representative Experience

Patent Trial and Appeal Board (PTAB) Proceedings

- Successfully invalidated medical-device patents asserted by a competitor in district court litigation.
- Defended patents on wireless-networking technology against invalidity challenges by the defendant in related district court litigation.
- Defended medical-device patents owned by a leading health care company against invalidity challenges raised by a competitor.
- Successfully obtained a reversal of an examiner’s rejections in a photonics-based invention.

Federal Court Patent Litigation

- Defended a global consumer-health company in patent infringement litigation over medical devices involving polymer chemistry.
- Represented a global medical and healthcare company in enforcing patents on pharmaceutical-delivery devices.
- Defended a leading manufacturer of security products in patent-infringement litigation over wireless security systems.

Patent Preparation & Prosecution and IP/Patent Counseling

- Handled biomedical matters involving glucometry, interventional radiology, ultrasonic probes, endoscopes, oncology devices, and disease detection.
- Handled chemical technology matters involving polymer chemistry, cleaning compositions, chemical vapor deposition, and mass spectrometry.

- Handled electrical and optical matters involving semiconductor devices, photonics systems, fiber-optic transceivers and cables, quartz crystal microbalances, sensors and actuators, motion-sensor lighting, liquid crystal displays (LCD), electric motors, and nuclear detectors.
- Handled computer and software matters involving artificial intelligence, machine learning, the Internet of Things, cloud computing, process automation, blockchain, cryptocurrency, quantum computing, logistics systems, document-translation systems, virtual-machine technology, and distributed server systems.
- Handled mechanical matters involving archery crossbows, offshore platform design, oil pipeline management, window sash technology, bed and furniture systems, mattresses and cushions, musical instruments, and product packaging.

Prior Experience

- Heslin Rothenberg Farley & Mesiti P.C., Associate
- Hiscock & Barclay, LLP, Summer Associate
- AngioDynamics, Inc., Law Clerk
- Danaher Corporation, Fluke Networks Division, R&D Associate
- AT&T Bell Laboratories, Technical Staff

Selected Community Activities

- Odyssey of the Mind, Division I Coach

Selected Honors

- *Best Lawyers: Ones to Watch in America*®: Communications Law, 2024–2025; Litigation – Intellectual Property, 2023–2025; Patent Law, 2024–2025
- Selected to *Super Lawyers* Upstate New York Rising Stars: Intellectual Property Litigation, 2022–2024
- New York State Bar Association, Empire State Counsel Honoree, 2018

Selected Speaking Engagements

- CloudEXPO, “Blockchain Law for Technologists”
- Albany Medical Center, “Navigating the Patent Process for Biomedical Inventions”
- American Inn of Court, “Recent Developments in Software Patents”

Selected Media

- *The Daily Record*, “Spider-Man Defeats Inventor at the Supreme Court”
- *The Daily Record*, “Open Source Expands to Kale, Quinoa, and Cars”
- *The Daily Record*, “Ruling on Copyright Protection of Software Designs”

Selected Alerts & Blog Posts

- USPTO Highlights Risks of Using AI for Inventive Process