

John M. Griem, Jr.

Partner

Chair, Intellectual Property Department, Practice Group Leader,
Cybersecurity and Data Privacy



contact

28 Liberty Street
New York, New York 10005
D / 212-238-8659
griem@clm.com

John “Jack” Griem concentrates his practice on intellectual property disputes and related litigation. With a highly regarded ability to balance practical, legal, and financial issues, he advocates for clients in cases involving the pharmaceutical, diagnostic testing, medical products, consumer electronic, and semiconductor industries, among others. His clients are based across the United States and around the world, and he advises on cross-border matters in such countries as Israel, China, and Canada.

Jack Chairs the firm’s Intellectual Property department and brings a rare depth of experience in every kind of intellectual property – patents, trademarks, copyrights and trade secrets – to the table.

Jack represents clients in every phase of a dispute, from pre-suit investigation through trial and appeal, as well as in parallel or separate U.S. Patent and Trademark Office proceedings. He brings and defends against claims for damages and injunctive relief, and pursues recovery of attorneys’ fees where appropriate. Jack’s skill at thinking practically and predicting where matters are likely headed helps clients save money and get their cases resolved efficiently.

With more than 25 years of experience, Jack also uses all the tools in his arsenal to help clients protect their intellectual property by obtaining patents and trademark and copyright registrations. Working with Carter Ledyard’s full-service prosecution team, he provides his litigation experience to obtain registered rights that he would be happy to enforce in court.

Jack served as a Special Professor of Law at his alma mater, the Maurice A. Deane School of Law at Hofstra University, where he taught “Biotechnology and the

Law." He also publishes Client Alerts and articles on topics of interest and speaks at selected conferences and events.

Patent and Technology Experience

- Represent perimeter security company in patent infringement action asserting five patents directed to attribute-weighted perimeter alert systems.
- Represent start-up companies developing classic psychedelics and derivatives as pharmaceutical products in patent licensing, prosecution and strategy.
- Represent clinical trial validation company in patent strategy and prosecution.
- Represent personal products retailer in arbitration against software integrator for fraudulent inducement and failure to meet specifications.
- Represent electronic art museum against allegations of copyright infringement directed to 3D interactive artworks brought by foreign competitor.
- Represent not-for-profit foundation seeking to protect psychedelic medicine development from bad patents by filing Post Grant Review petitions in U.S. Patent and Trademark Office.
- Represented major electronics component distribution and services company in enforcing patent directed to internet-enabled method of designing and simulating circuits.
- Represented innovator specialty pharmaceutical company in Hatch-Waxman patent litigation against multiple generic companies and parallel Inter Partes Review proceedings.
- Represented hair care products company in patent and trademark litigation against major online retail platforms.
- Represented diagnostic testing company in patent infringement and antitrust counterclaims relating to high-risk HPV DNA testing systems and methods.
- Represented global pharmaceutical companies in ANDA litigation against multiple applicants seeking to sell generic versions of blockbuster drugs, seeking injunctions and damages.

Trademark, Copyright and Entertainment Experience

- Represent music entertainment brand in trademark prosecution, protection and licensing matters.
- Represent real estate developers in trademark prosecution and enforcement matters.
- Represent electronic art museum in defending against allegations of copyright infringement by foreign competitor.
- Represent global advisory firm in trademark prosecution and brand protection strategy.
- Provide advice to not-for-profit library regarding bequest of a famous author's literary rights, including assignment of rights, determination of copyright terms and advice on publishing contracts.
- Provide advice to bank trustee of famous author's estate in connection with literary rights licenses and ancillary theatrical licenses.
- Represent news publisher against copyright infringement claims arising out of use of social media posts in news story.
- Provide advice to global investment management group in adversarial brand protection matters.
- Provide advice to owner of copyright rights to famous painter's works on scope of assignment agreement and term of copyrights.
- Advice to foundation that owns iconic artistic work on scope of copyright rights in federal court litigation brought by former employee.
- Represented originator of revolutionary trauma therapy in enforcing nondisparagement provisions of trademark settlement agreement against competitor.
- Advice to not-for-profit foundation on ownership and scope of rights in vintage radio broadcasts.
- Advice to artist's heirs on registration of trademark rights and enforcement of trademark rights in federal court litigation.
- Represent owner of trademark rights in musical concert series on registration and enforcement of rights used under license by for concerts and clothing.
- Representation of pseudonymous authors of series of mystery books in asserting copyright rights against producer of infringing movies.

Presentations

- Presenter, NYC Bar Association, "Hot Topics in Not-for-Profit Law: Managing Data Privacy & Cyber Risks for Nonprofits," November 6, 2023
- Presenter, Managing IP Intellectual Property & Innovation Summit USA, "Protecting Against Trade Secret Leakage," September 22, 2023
- Presenter, Horizons New York Psychedelic Conference, "Patents, commons, innovation, and competition," October 12, 2022
- Presenter, ACC Online Education, "Commerce in the Internet Age: How One Company Website Can Present So Many Legal Issues," September 23, 2019
- Panelist, 4th Annual Paragraph IV Disputes Master Symposium, "Assessing the True Measure of Damages in an At-Risk Launch Scenario," September 19-20, 2016
- Moderator, Intellectual Property Owners Association, "Trade Secret Enforcement," September 17, 2013
- Panelist, American Conference Institute Orphan Drugs and Rare Diseases, "Maximizing Opportunities and Overcoming Stumbling Blocks in the Designation and Development Process," November 28-29, 2012
- Speaker, Intellectual Property Owners Association webinar, "Cross Winds in the Safe Harbor: Classen v. Biogen and Momenta v. Amphastar," September 27, 2012
- Moderator, the Intellectual Property Owners Association webinar, "Update on Reverse Payment Settlements in Hatch-Waxman Litigation," July 19, 2012
- Panelist, New York State Bar Association, "A Review Of Supreme Court Patent Law Decisions From 2011 & Their Impact On Your Practice" October 12, 2011
- Speaker, American Conference Institute 12th Annual Maximizing Pharmaceutical Patent Life Cycles Conference, "CAFC and Supreme Court Watch: Three Cases that May Have Radical Impact on Pharmaceutical Patent Life Cycle Strategies," October 4-5, 2011
- Presenter, IPO Discovery Committee ½ Day Roundtable, "What is Discoverable and Admissible for Damages, Willfulness, and Other Purposes," March 2011

Outside the Office

I am proud to serve on the Board of the Conrad Foundation. The Foundation runs one of the top annual worldwide high school entrepreneurship contests. In the Conrad Challenge, hundreds of teams of high school students create inventions and prepare technical and business plans to win a chance to pitch them to a panel of industry judges and investors at a Summit held at Space Center Houston. The Foundation is a perfect fit for my love of new technology and working with innovators to commercialize their inventions and grow their businesses.

Practices

Antitrust
Cybersecurity and Data Privacy
Litigation and Disputes
China Cross-Border
Art Law

Admissions

Bar Admissions

New York
U.S. Patent and Trademark Office

Court Admissions

U.S. Court of Appeals, Federal Circuit
U.S. Court of Appeals, Fourth Circuit
U.S. Court of Appeals, Second Circuit
U.S. District Court for the Eastern District of New York
U.S. District Court for the Southern District of New York
U.S. Supreme Court

Affiliations

Board of Directors, Conrad Foundation
Board of Directors, New England Society in the City of Brooklyn

Education

Hofstra University (JD, 1994)

- Associate Editor, *Hofstra Law Review*

Dartmouth College (AB, 1991)

Awards/Honors

IP Star, Managing Intellectual Property