



John M. Vassiliades

PARTNER

Phoenix

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RELATED SERVICES

- Intellectual Property Litigation
- Technology Litigation
- International Law
- Advertising & E-Commerce
- Privacy & Data Protection
- Business Transactions
- Cyber, Privacy & Data Security
- Government Investigations & Enforcement Defense
- Artificial Intelligence
- Intellectual Property Transactions

OFFICES

- Phoenix

OVERVIEW

John Vassiliades is a partner in the Phoenix office of GRSM. He concentrates his practice on intellectual property, technology transactions and general business law for private and public technology-based companies.

A registered patent attorney, John has negotiated hundreds of business transactions that develop and monetize IP rights, including patent, trademark, copyright and trade secret licensing, artificial intelligence, R&D, M&A, IT, software, E-Commerce, Biotech/pharma, EdTech, energy, medical device, commercial OEM/VAR product distribution deals, strategic alliances, corporate technology collaborations, equity joint ventures, IP due diligence, patent strategy, risk assessments, among many other structures and projects, both domestic and international. He has also served on litigation teams as

an IP advisor on cases involving computer software infringement, trade secret misappropriation, biotech patent infringement, Lanham Act trademark counseling and infringement and infringement involving mechanical/medical device inventions.

REPRESENTATIVE EXPERIENCE

- Advised on clinical research trial agreements for a multi-site clinical study involving the testing of a new POC diagnostic device
- Advised a U.S. based medical university on a clinical study agreement with one of the country's largest pharmaceutical companies in connection with a randomized, double-blind controlled Phase 3 clinical trial study to assess the efficacy and safety of a new oral administered drug in over 3,000 human subjects
- Successfully completed an AI development deal with an international subscription-based content streaming service provider for the creation of a fully integrated proprietary AI model and data science solution
- Advised a well-known open-source repository on a potential software copyright infringement matter under the GPL
- Co-founded a medical device start-up that after its initial public offering is being publicly traded on the NASDAQ stock exchange
- Structured and drafted a pro-vendor technology platform development services agreement where the custom-built platform and artificial intelligence agents utilized AI techniques and methods to train proprietary algorithms on a large influx of customer data
- Represented US based component supplier in the re-negotiation of its continued manufacturing and supply arrangement with Europe's largest manufacturer of lithography systems for artificial intelligence semiconductor chips
- Structured, drafted and negotiated domestic and international product development and commercial license agreements for the worldwide commercialization of various types of diagnostic assay devices that use and incorporate proprietary monoclonal antibodies
- Structured, drafted and negotiated software licenses for algorithmic trading platforms
- Prepared annotated collaborative and sponsored research agreements for well-known medical and health sciences university based in California
- Closed an international research, development, manufacturing and partial global distribution deal between a US based biotech company and an Asian based vaccine manufacturer
- Provide ongoing compliance counseling on new comprehensive state data privacy protection laws for companies that do business nationally
- Developed the rules for a new recurring revenue premium corporate partner referral program (superseding the company's legacy program) for a multi-million dollar e-commerce omni-channel platform and solutions company

- Completed a worldwide in-licensing deal with a global non-profit institution created by Congress that advances the worldwide commercialization of a new type of patented vaccine technology developed by the U.S. Department of Defense
- On behalf of a foreign publicly traded corporation, conducted the due diligence, legal analysis and buyer documentation for the purchase of US based intellectual property rights, software and data assets supporting a digital media business
- Prepared customer facing digital currency services and hardware sale agreements for crypto mining company
- Structured the sale of a proprietary cosmetic product formula to a well-known cosmetic product distributor in exchange for cash and exclusive contract manufacturing rights
- Prepared customer facing agreements and data privacy disclosures for new Internet Of Things service launch by a leading manufacturer of water conservation products for commercial buildings
- Technology spin-out transaction involving biotechnology assets and data involving one of the country's largest manufacturer/supplier of blood products
- Closed a patent license and manufacturing process supply agreement with one of the largest global manufacturers of semiconductor chips
- Conducted the intellectual property, software and data rights due diligence for the sale of a business data platform company to one of the world's largest credit reporting agencies
- Designed and drafted a new kind of supplier product formulation development agreement for one of the largest cosmetics companies and multi-billion dollar beauty brands in the world
- CCPA compliance and commercial law counseling for the US subsidiary of one of the world's largest international manufacturer of automobiles
- Negotiated and structured multiple in-licensing deals with universities on behalf of various companies in the biotech, medical device and IT/software industries
- Advised multiple companies on the proper and legal use of open source software and defended multiple companies across various industries against software license compliance audits
- Negotiated and structured the granting of a multi-million dollar life sciences freedom to operate license to one of the world's largest and most well-known global pharmaceutical company
- Advised a multi-billion dollar transportation company with the system integration and legal implementation of a custom built Industrial Internet of Things architecture platform for the deployment of an artificially intelligent automated system for passenger train travel
- Advised an E-Commerce market leader on multiple Big Data deals for data visualization, reporting and analytics involving over 800 universities in the US and Europe
- Advised various US based companies across various industries on GDPR data compliance
- Implemented the commercialization strategy for a Block chain invention that facilitates GDPR data compliance

- Closed a \$25 million technology development, data management, and asset acquisition deal that included the hiring of more than 50 new employees
- Created an international equity joint venture that established the formation of a new medical device company
- Negotiated one of the “Top 50” Merck deals in the biopharmaceutical industry
- Successfully concluded the operational transfer of a CoLo Facility and Data Center
- Handled numerous high-tech asset purchase/acquisition transactions involving public, private, and not-for-profit organizations in conjunction with a private-equity offering
- Negotiated patent licensing, collaboration, and strategic alliance deals with emerging and established companies in a wide variety of high-tech industries, including sponsored research and clinical trial agreements with major educational research institutions
- Served as a member of the litigation team that successfully dismissed a multimillion-dollar computer software copyright infringement case, and supported a litigation team that sued and defended biotech patent infringement cases
- Successfully closed the forward triangular merger of a foreign public biotech company with a privately held domestic biotech company

PUBLICATIONS

- “Protecting IP Rights before a Bankruptcy Filing,” *Law360*, August 11, 2009
- “Must Med Immune Breach Before It Sues?” *Legal Times*, Vol.29; No.15, ALM Properties, April 2006
- “Investors Turn to Trade Secrets: Patents and Copyrights Often Fail to Protect Foreign Technology,” *IP Worldwide*, New York Publishing Co., 1996
- “The Protection of Trademarks and Copyrights,” *Global Trademark and Copyright Course Book*, Practising Law Institute, 1995

PRESENTATIONS

- Speaker, Protecting Your Brand, Society of Independent Gas Marketers Association (2021).
- Speaker, California’s Consumer Privacy Act (CCPA) and implementing regulations, ARMA International Conference (2019).
- Panelist Chair, Intellectual Property Strategy, co-sponsored by the National Institutes of Health and LARTA (Los Angeles, 2018)
- Speaker, Intellectual Property Strategy, webinar sponsored by the US Department of Energy and LARTA (2019)
- “The Business of Commercializing Intellectual Property,” Los Angeles Technology Association, March 2014
- “Licensing Technology Rights,” Los Angeles Technology Association, December 2012

- “Strategic Alliances and Corporate Partnerships,” National Science Foundation Commercialization Training Workshop, August 2011 and 2012
- “Negotiation Strategies for Effective Deal-Making,” National SBIR/STTR Conference, November 2009
- “Building Strategic Alliances,” National Council of Entrepreneurial Technology Transfer, August 2009
- “Licensing Technology Rights from Universities,” National Council of Entrepreneurial Technology Transfer, July 2009
- “Fundamentals of IP Management, Development and Strategic Planning,” National Institute of Health Commercialization Assistance Program, July 2009
- “Conducting a M&A Transaction,” The Mergers & Acquisitions Forum, Fulcrum Information Services, 2001
- Program Co-Chair: “Advanced Forum on Software Licensing and Distribution,” American Conference Institute, 2000
- “International Technology Transfers,” American Conference Institute, 2000
- “E-Commerce Law” and “Cyberspace Licensing in the Electronic Age,” Glasser Legal Works, 2000

CREDENTIALS

Admissions

- Arizona
- New York
- District of Columbia
- Virginia
- U.S. Patent and Trademark Office (Reg. No. 57,382)

Memberships

- Larta Institute

Community Involvement

- Business Mentor and Strategic Business Consultant for high tech companies selected to be mentored in the accelerator programs funded and sponsored by the National Institutes of Health, the National Science Foundation, and the U.S. Department of Agriculture.

Education

- M.B.A., University of Southern California
- Member, Beta Gamma Sigma
- M.S., Biotechnology, Johns Hopkins University
- J.D., University of North Carolina School of Law
- B.A., *cum laude*, Economics, Duke University

- Certification, Artificial Intelligence – Business Strategy, MIT Sloan School of Management
- Technical Certification, Building AI Models and Data Science Solutions, MIT Computer Science and AI Lab

Honors

- Special Intellectual Property Advisor for SBIR-funded companies enrolled in the accelerator programs funded by the National Institutes of Health, the National Science Foundation and the U.S. Department of Energy
- Top Lawyer, *Phoenix Magazine* (2022)