

Jon Grossman | Senior Counsel
Intellectual Property

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For over 34 years, Jon Grossman has practiced in the areas of patent law, licensing work, and copyright with an emphasis on computer software issues, including:

- Significant commercial licensing experience encompassing all aspects of contracting, including inbound and outbound licenses, development agreements, Internet contracting, and copyright related agreements
- Significant government contract licensing experience concerning issues regarding technical data rights and subject inventions
- Working closely with corporate teams on the IP side of M&A transactions and handling the transfer of intellectual property rights for business acquisitions
- Providing clients a full range of IP counseling with a business-oriented focus in the areas of strategic acquisitions, technology development, and joint ventures and enforcement strategies
- Assisting clients on all aspects of computer software intellectual property problems, including software-related contract performance and ownership related disputes
- Assisting patent clients overcome subject matter eligibility rejections at the U.S. Patent Office in the *post-Alice* context

Jon also has extensive experience regarding Internet legal issues including IP enforcement and defense issues.

Jon is recognized as a leader in issues concerning business method patent protection and intellectual property opinion making. He co-authored *Intellectual Property Legal Opinions, Second Edition* (Wolters Kluwer Law & Business), the leading treatise on IP opinion counseling, which has been updated annually since

1999.

Outside The Firm

Jon was Co-President of the Adat Shalom Reconstructionist Congregation in Bethesda, MD (2016–2018) and was a Board Member from 2014 to 2016.

He enjoys section hiking the Appalachian Trail. He is an avid runner and enjoys bike commuting.

Select Engagements

- Led negotiations with the U.S. Army and U.S. Postal Service concerning IP technical data and subject invention licenses in acquisitions collectively exceeding \$12 billion.
- Represented private equity clients in the purchase and sale of portfolio companies having multinational IP assets and ongoing IP litigations.
- Assisted *Fortune* 50 manufacturer in negotiating successful international joint development arrangement with leading consumer products company.
- Developed and negotiated licensing program for medical software company (concerning AIA compliance) with large insurance and hospital systems.
- Works with numerous U.S. and international software developers in overcoming subject matter eligibility rejections by the USPTO.
- Develops intellectual and commercialization strategies for clients.

Admissions

- Pennsylvania
- Supreme Court of the United States
- District of Columbia
- U.S. Patent and Trademark Office

Education

- University of Chicago, BA
- American University, Washington College of Law, JD
- Johns Hopkins University, MS

Recognitions

- 2011–2024, Patent Law in Washington, D.C., listed in *Best Lawyers in America*©
- 2011–2021, Copyright Law in Washington, D.C., listed in *Best Lawyers in America*©
- 2013–2021, “IP Star,” listed in *Managing IP (“MIP”) Magazine*
- 2017–2021, listed in Capital Pro Bono Honor Roll

- 2013–2016 and 2020, Washington, D.C., “Super Lawyer” in Intellectual Property, listed in *Super Lawyers*
- 2012–2015, and 2017–2019, listed in *IAM Patent 1000*

Professional Activities

- Adjunct Professor, Washington College of Law, American University, teaching IP classes, including IP Protection of Mobile Apps.
- Co-Author, *Intellectual Property Legal Opinions*, Second Edition
- Lecturer, DC Bar on various intellectual property topics