

IP, IT and Data Protection

Interviews Series

A professional portrait of Jack Griem, a man with dark hair, a beard, and glasses, wearing a dark blue plaid suit jacket, a white shirt, and a blue tie. He is looking directly at the camera with a slight smile.

Jack Griem

Carter Ledyard & Milburn
N.Y. - U.S.A.



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NEW YORK



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IP, IT and Data Protection

1. Which areas of IP/IT is your firm active in?

Can I say all of them? Carter Ledyard is somewhat unique in that it is relatively evenly balanced between patents, trade secrets, trademarks and trade dress, and copyrights. Our IP Department helps clients with licensing, patent prosecution, compliance, managing exposure, and avoiding litigation or settling disputes expeditiously. When clients have had their IP rights violated and litigation proves to be the best course of action, we pull in our litigation department (a third of the firm) to help us advocate for them in court.

On the IT side, we have full service cybersecurity and privacy groups that do all of the usual things - development of cybersecurity, data protection, and privacy policies; Compliance counselling; Corporate governance (this is an important issue often overlooked); Risk assessment and management in corporate transactions; Incident response and related investigations, working with forensic experts; Incident reporting and disclosure in accordance with regulatory requirements (more every day, unfortunately); and Cybersecurity and data privacy insurance assessment (policies must be read carefully!).

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2. Who in your firm is dedicated to which areas of IP/IT?

I am the Chair of our Intellectual Property practice and work with Gerry Griffin and Len Trivigno (and many others) in litigation and Jodutt Basrawi, John Driscoll, and Danielle Sullivan on prosecution and pre-litigation matters. More information about the firm's IP department can be found [here](#).

Matt Dunn is the Chair of the firm's Cybersecurity and Data Privacy department. I support him on those matters, and we have a cross-functional team that works on the myriad types of cyber and data privacy matters clients bring to us. More information about the firm's cyber department can be found [here](#).

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3. Please mention some recent IP/IT matters that you and your colleagues have been working on.

It's hard to pick highlights. On the IP side, one of the more notable litigation matters is representing Kaneka Corporation in a patent infringement action against

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efendants Designs for Health, Inc. and American River Nutrition LLC in the United States District Court for the District of Delaware. Kaneka Corporation alleges infringement of one of its patents directed to a composition including a significant weight-percentage of reduced coenzyme Q10. Reduced coenzyme Q10 is a useful compound in many health settings.

In addition, Carter Ledyard continues to represent defendant Lifescan, Inc., a customer of client Asahi Polyslider, in a patent infringement action brought by Facet Technologies, LLC in the United States District Court for the Central District of California. Facet alleges infringement of a patent directed to a technology for blood glucose monitoring.

We are also counsel for investors in a biopharmaceutical startup bringing derivative and minority oppression claims to recover intellectual property and other property improperly taken by the majority of investors and managers.

We have hundreds of pending and issued trademarks on our docket. One client I love is Textile Exchange, a not-for-profit organisation helping to set global standards for renewable and responsible materials. We manage their worldwide trademark portfolio.

We are patent counsel to many exciting start-ups and growth stage companies, in areas including psychedelic medicines, exercise equipment, clinical trial verification systems, and endoscopic medical devices.

I also have to mention the work we do with our well-known Art Law group and our Tax-Exempt Organizations practice, providing advice on copyright issues and licenses, trademark issues, and others in collaboration with Judith Wallace, Pamela Mann, Jeremy Steckel and others in those departments.

On the IT/Cyber/Privacy side, we really can't mention specific clients, but our clients are coming to us almost every day with new matters, and we have published a lot of client alerts in this area, as New York and US law have evolved and grown. I want to mention our publications (here, here and here) on the very important issue of a consumer's right to access information and tools needed to repair digital goods. New York passed a groundbreaking law in this area, and there are a lot of issues for manufacturers to manage. We also advised a New York non-profit in connection with a cybersecurity breach incident involving the hacking of an employee email account and theft of funds induced by fraud. We guided the client through a forensic investigation and assisted the client in obtaining recovery of the funds. We also regularly advise U.S. and foreign issuers on their cyber and data privacy disclosure obligations in connection with SEC reports.

4. Can you name an example of your cooperation with other Legalink members?

We have worked with Legalink firms for some IP prosecution matters and New York data privacy questions. Carter Ledyard is a proud member of Legalink, providing counsel on New York law to member firms across the country. The relationships and connections our firm has built through Legalink continue to facilitate and strengthen our relationships internationally and our understanding of legal issues on the global stage.

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5. What are your firm's future expectations and plans in the area of IP/IT?

We plan to continue to try and flag issues for client attention in 2024 and beyond. We will continue to provide the kind of client-focused, efficient and problem-solving advice we are known for, including exploring how AI-assisted tools can allow us to improve our level of service.

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6. What are some emerging IP and IT law trends, and how do you see the legal landscape evolving in these areas over the next few years?

Artificial intelligence (AI) is one of the most rapidly developing technologies, and it is already having a major impact on the IP landscape. For example, AI-generated works are raising questions about copyright ownership and infringement. As AI becomes more sophisticated, we expect to see new challenges and opportunities in the area of IP law.

Blockchain is another emerging technology that is likely to have a significant impact on IP. Blockchain can be used to create secure and transparent records of ownership, which could be used to manage IP rights. For example, blockchain could be used to track the ownership of copyrighted works or to manage patent licensing agreements.

The Internet of Things (IoT) is a network of physical objects that are embedded with sensors, software, and other technologies that allow them to collect and exchange data. The IoT is raising a number of IP issues, such as who owns the data collected by IoT devices and how that data can be used.

Carter Ledyard has dedicated a team of Industry Group practitioners to focus closely on these issues and to ensure that our clients receive the best possible representation tailored to their needs.

