

Fisher Broyles

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Office: New York

Practice Areas: Intellectual Property; Patent Prosecution; Commercial Transactions; Technology; Technology Transactions and Data Privacy

Bar Admissions: New York; U.S. Patent & Trademark Office

Education: George Mason University School of Law, Patent Track, J.D., 1993; Columbia University, School of Engineering & Applied Science, B.S., Metallurgy & Materials Science, 1988

Experience: Winston & Strawn, LLP; Whitman Breed Abbott & Morgan, LLP; Curtis, Morris & Safford, P.C.

John has been practicing intellectual property law for over 20 years and is registered before the United States Patent and Trademark Office.

John has worked as the Chief Intellectual Property Counsel at private and publicly traded high-tech companies in the biotechnology industry (IGEN International, Inc. and Meso Scale Diagnostic, LLC) and the semiconductor industry (ATMI, Inc.), advising on a myriad of intellectual property and corporate issues.

His current practice focuses on patent counseling, preparation and prosecution as well as patent transactions, IP audits, due diligence evaluations, and patent litigation. John has worked with clients in a wide variety of technologies, life sciences and other industries on developing strategies for patent portfolios and managing patent prosecution, negotiating complex corporate, commercial, technology and intellectual property agreements, and advising on intellectual property aspects of merger and acquisition transactions.

John has worked at various law firms in Manhattan as a patent lawyer and has expertise in all areas of patent law, including transactions, litigation, licensing, prosecution and counseling.

Before entering private practice, John worked at the US Patent and Trademark Office examining patent applications for inventions relating to high temperature oxide superconductors, coatings, ceramics, pigments, piezoelectric materials and dental compositions, while attending law school at night.

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John is also an inventor with several patents to his name and has negotiated IP transaction agreements resulting in the sale of two groups of patent assets to Apple, Inc. in 2010, one relating to targeted advertising and the other relating to online events and location-based networking.

John also successfully litigated breach of contract claims against two companies in an American Arbitration Association hearing, resulting in a damages award.

Presentations & Teaching Experience

- Speaker: Course entitled “Patent Family Analysis”, Certified Patent Valuation Analyst (cpva.info), 2014.
- Conference Chair: Chaired session entitled “Concept to Product: Intellectual Property & Business Development” at The Society for Biological Screening, 10th Annual Conference & Exhibition, September 2004, Orlando, Florida.
- Speaker: Presentation entitled “A Comparison of Patents, Trademarks, Copyrights, and Trade Secrets”, The Society for Biological Screening, 8th Annual Conference & Exhibition, September 22-26, 2002, The Hague, Netherlands.

Publications

- IPwatchdog.com – *The Top 5 IP Mistakes Tech Startups Make* (May 21, 2011)

Certificates

- *English Common Law: Structure and Principles*, University of London (Coursera).
- *An Introduction to Corporate Finance*, The Wharton School of the University of Pennsylvania (Coursera).
- *An Introduction to Marketing*, The Wharton School of the University of Pennsylvania (Coursera).
- *Financial Markets*, Yale University (Coursera).
- *Analyzing Global Trends for Business and Society*, The Wharton School of the University of Pennsylvania (Coursera)