

**Hussein Akhavannik | Partner**

Intellectual Property

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## CO-CHAIR, INTELLECTUAL PROPERTY & TECHNOLOGY PRACTICE GROUP

Hussein Akhavannik merges his engineering background with insight as a technologist to strengthen his patent prosecution and portfolio management practice. The patent applications he prosecutes in technologies related to the software, electrical, computer, medical, and mechanical arts are wide-ranging, from surgical robots and video surveillance to anti-coagulants and vascular placement devices.

Hussein's diverse work reflects his broad knowledge and facilitates a comprehensive approach with clients. His services include managing international patent portfolios, institutionalizing patent programs, optimizing patent portfolios for sale, conducting intellectual property due diligence, and performing freedom-to-operate studies.

Hussein spent almost four years at the U.S. Patent and Trademark Office ("USPTO") as a patent examiner and served as a legal intern for the Patent Trial and Appeal Board and the Office of the Solicitor. His understanding of the inner workings of the USPTO is just one more tool that Hussein leverages to develop creative, cost-effective solutions for clients.

## Select Engagements

### *International Portfolio Manager*

- Extracts inventions from engineers within corporations, manages preparation and filing of patent applications, develops international protection strategies,

and works with in-house counsel to manage the prosecution of those patents worldwide in an efficient manner.

- Developing a patent portfolio for an international medical device company covering drug storage and delivery.
- Developing a patent portfolio for an international pharmaceutical company covering drug delivery systems.
- Developing patent portfolios for an international therapeutics corporation's massagers, muscle stimulation, and therapeutic oils.
- Developing a patent portfolio for a start-up corporation covering automated parking systems.

### *Due Diligence*

- Performs intellectual property due diligence for mergers and acquisitions, and leverages USPTO experience to perform internal searches as part of freedom-to-operate analyses for medical devices, software packages, hardware, pharmaceutical drugs, and more. Also drafts invalidity opinions and non-infringement opinions.
- Assisted in the purchase of a large medical device corporation by examining the portfolio of the corporation to identify its strengths and weaknesses. Also, analyzed the intellectual property landscape of the corporation's technology to predict risks for the purchaser and developed strategies to protect against potential future disputes.

### *Deal Work*

- Optimizes patent portfolios for sale. Identifies patents in various high-tech sectors for companies that want to inorganically build a patent portfolio around a specific industry, negotiates pricing and prepares agreements for patent acquisition.
- Responsible for over \$150 million in patent acquisitions.
- Negotiates and drafts patent licensing agreements.

### *Technical Experience*

- *Medical Devices*: surgical robots, autoinjectors, powered injectors, syringes, pumps, vascular and urological catheters, vascular placement devices, dilators and sheaths, surgical clips, and inhalers.
- *Pharmaceuticals*: anesthetics, bronchodilators, steroids, and anti-coagulants.
- *Industrial Machinery*: fluid-dispensing systems, polymer extrusion, soldering systems, and inspection systems.
- *Software*: digital health platforms, big data analytics, control systems, closed-loop feedback, algorithms, user tracking and monitoring, video compression, and video surveillance.

## **Admissions**

- District of Columbia
- U.S. Patent and Trademark Office

## Education

- George Washington University Law School, JD, with honors
- Johns Hopkins University, MS
- Johns Hopkins University, BS, with honors

## Recognitions

- 2024, Global Leader, listed in *IAM Strategy 300*
- 2020–2022, Patent Prosecution, D.C. Metro Area, listed in *IAM Patent 1000*
- 2019, 2021, Patent Prosecution, listed in *The Legal 500 United States*
- 2017, Rising Star, Washington, D.C., listed in *Super Lawyers*