

## Peter A. Sullivan

Partner

New York

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Peter Sullivan is a partner in Foley Hoag's Intellectual Property, Litigation, and International Litigation & Arbitration Departments. He focuses his practice on intellectual property and complex commercial matters.

Peter has litigated complex commercial matters in courts throughout the country. These matters include maritime environmental liability disputes, product liability actions, construction disputes, contract disputes and workplace exposure cases. The product liability cases have involved automobiles, pharmaceuticals, industrial machinery, maritime cranes, and construction materials. The workplace exposure cases have involved substances such as asbestos, mercury, benzene and metals such as cadmium and beryllium. He advises clients on litigation matters in tribunals in foreign jurisdictions, teaming up with local lawyers in the jurisdiction.

Peter has also litigated patent and trade secret matters in district courts across the United States, at the ITC and before the U.S. Court of Appeals for the Federal Circuit. A registered patent attorney, Peter also appears on behalf of clients before the U.S. Patent & Trademark Office, including in *inter partes* review (IPR) proceedings before the Patent Trial and Appeal Board (PTAB). He has litigated matters involving video compression technology, medical devices, pharmaceuticals, gas turbine engines, electrical switchgear, RFID tracking technology, portable email communication systems, GPS systems, military simulator technology, agricultural products, specialty chemicals and sunscreen technology. Peter also litigates licensing disputes concerning intellectual property. He is the author of the chapter on licensing litigation in Robert L. Haig's *Commercial Litigation in New York State Courts*, Fourth Edition, published by Thomson Reuters, a leading treatise for commercial litigators in New York.

Peter is an experienced practitioner in international arbitration, focusing on cases involving complex technical subject matter where his technical background allows him to understand quickly the technical and scientific principles involved in the matter. He has acted as counsel in patent and trade secret licensing disputes in the pharmaceutical industry. Peter also has represented clients in complex commercial and construction matters involving pollution control installations, industrial plant facilities, electrical generating facilities, waste treatment facilities and commercial construction projects. He has represented parties before panels of the ICC International Court of Arbitration and the American Arbitration Association, and under the UNCITRAL Arbitration Rules.

Peter advises clients on intellectual property rights in connection with start-up company formation, corporate transactions, licensing arrangements and litigation exposure. He advises owners of famous brands in the luxury goods and food and beverage industries on trademark and design patent issues to help them obtain and enforce these rights. Peter has appeared for trademark clients in court and in proceedings before the Trademark Trial and

### INDUSTRIES

Life Sciences

Energy & Cleantech

Technology

### PRACTICES

Class Action

Privacy & Data Security

Intellectual Property Litigation

Litigation

Trademark, Copyright & Unfair  
Competition

International Commercial  
Arbitration

International Litigation &  
Arbitration

PTAB Proceedings

Product Liability & Complex Tort

Trademark, Copyright & Unfair  
Competition Litigation

Patent, Trade Secrets and Related  
Rights Litigation

### EDUCATION

Brooklyn Law School, J.D., *cum  
laude*, 1992

New York University, B.S. in  
Physics, 1986

Appeal Board (TTAB).

Peter is also very active in professional associations. He has filed amicus briefs on behalf of bar associations on important issues of intellectual property law in the United States Supreme Court, the Federal Circuit and other appellate courts.

## BAR ADMISSIONS

- New York
- New Jersey

## COURT ADMISSIONS

- U.S. Supreme Court
- U.S. Patent & Trademark Office (Agency)
- U.S. Court of Appeals Second Circuit
- U.S. Court of Appeals Federal Circuit
- U.S. District Court for the Southern District of New York
- U.S. District Court for the Eastern District of New York
- U.S. District Court for the Western District of New York
- U.S. District Court for the District of New Jersey

## REPRESENTATIVE EXPERIENCE

### International and Domestic Complex Commercial Arbitration and Litigation

- Counsel for equipment manufacturer in AAA arbitration defending against claims of defective installation and resulting delay damages from the construction of an electricity distribution yard in Colombia.
- Advising marine classification society in a French court expertise proceeding investigating defective inspection and manufacture claims concerning a floating production and storage facility off the coast of Nigeria.
- Counsel for equipment manufacturer in ICC arbitration claiming defective installation of pollution control equipment on a coal-fired power station in Canada.
- Counsel for marine classification society in litigation in the U.S., Spain and France involving an oil spill off the coast of Spain and France by the vessel Prestige.
- Counsel for gas turbine engine technology licensee in ICC arbitration for breach of license agreement with gas turbine engine manufacturer-licensor concerning gas turbine installations throughout Europe.
- Counsel for marine classification society in connection with the Deepwater Horizon Joint Commission investigation and subsequent civil proceedings.
- Counsel for boiler manufacturer in multiparty state court litigation by owner concerning allegedly defective construction of a waste treatment facility.
- Counsel for train engine manufacturer in arbitration with owner over the supply of allegedly defective train engines.
- Counsel for engineering and construction consortium in arbitration under UNCITRAL rules defending claims concerning the construction of a direct reduced iron plant in Venezuela.

- Counsel for general contractor in AAA arbitration against subcontractor for defective performance in several commercial installations.
- Counsel for process equipment manufacturer in ICC arbitration defending against claims of defective installation and resulting delay damages from the construction of a pulp paper facility in Chile.
- Counsel for gas turbine engine manufacturer in several related federal court actions for claims alleging breach of contract, fraud and negligent design in power stations in the U.S.
- Counsel for general contractor in AAA arbitration against owner for claims of defective performance in the renovation of a school.

## Intellectual Property Litigation and Arbitration

- Counsel for two leading medical research institutions in patent infringement action and related PTAB proceeding concerning patent for cancer therapy.
- Counsel for agricultural products company in action before International Trade Commission concerning asserted infringement of patent process to make a particular herbicide.
- Counsel for pharmaceutical company in ICC arbitration over pharmaceutical development agreement involving a license to patents and trade secrets for a drug to treat schizophrenia.
- Counsel for specialty chemical company in patent infringement action and related reexamination proceedings concerning sunscreen technology.
- Counsel for medical device company in patent reexamination proceedings before the Board of Patent Appeals and Interferences concerning device used in diabetes monitoring.
- Counsel for patent holder in infringement actions concerning inventions related to systems and devices used to transmit emails.
- Counsel for pharmaceutical company in ICC arbitration over pharmaceutical development agreement involving a license to patents and trade secrets for a drug to treat HIV.
- Counsel for defendant in a patent infringement action (trial and two appeals) concerning machine technology for consumer products.
- Counsel for database development company in infringement action concerning a database searching patent.
- Counsel for pharmaceutical company in design patent infringement action.
- Counsel for defendant in patent infringement action concerning printing press machinery technology.
- Counsel for forensic services company in a patent infringement action concerning RFID-tagged evidence collection system and methods.
- Counsel for manufacturer in AAA arbitration with clothing designer over the rights to fabric designs created by the designer for the manufacturer.
- Counsel for coffee retailer in trademark infringement and dilution action over trademark for cold beverages.
- Counsel for technology company in trademark dilution and disparagement claim

regarding improper use of company's name in advertising.

- Counsel for media company in threatened suit for copyright infringement and right of publicity claims by a performer shown in a television segment.
- Counsel for pet treat company in trademark infringement action and related TTAB proceedings.
- Counsel for online travel company in trademark infringement actions against competitor related to ad-word purchasing.
- Counsel for on-line video gaming tournament sponsor in trademark infringement and dilution action.
- Counsel for electricity transmission equipment manufacturer in a misappropriation of trade secrets matter against former employee and competitor who hired the employee.
- Counsel for military contractor in misappropriation of trade secrets matter against competitor involving military helicopter simulator technology.
- Counsel for gas turbine engine manufacturer in misappropriation of trade secrets action against former engineering consultant concerning the design of turbine blade and combustor technology.
- Counsel for computer software company in misappropriation of trade secrets action against competitor start-up company formed by former employees of client.
- Advised numerous clients on confidentiality and data privacy issues in connection with ongoing litigation and internal investigations.
- Amicus counsel for technology companies and intellectual property law associations for intellectual property issues before the U.S. Supreme Court.

## Product Defect Litigation

- Counsel for light bulb manufacturer in state court 1000+ plaintiff toxic tort action involving alleged exposures to benzene, mercury, other heavy metals and asbestos at a plant in West Virginia.
- Counsel for pharmaceutical company in product liability action for alleged defective drug to treat HIV.
- Counsel for welding rod manufacturer in product liability actions in federal and state court throughout the United States over alleged exposure to asbestos.
- Counsel for automobile manufacturer in product liability actions in federal and state court throughout the State of New York.
- Counsel for marine crane manufacturer in product liability action over alleged defectively designed marine crane.
- Counsel for machine manufacturer in product liability action for alleged defectively designed die press machine.

## HONORS & INVOLVEMENT

### Involvement

- Past Chair, Patents Committee, Association of the Bar of the City of New York
- Member, Federal Circuit Bar Association

- Member, International Trademark Association
- Member, New York International Arbitration Center
- Member, Federal Bar Council
- Past member of Amicus Committee, American Intellectual Property Lawyers Association
- Member of ITC Committee, American Intellectual Property Lawyers Association
- Member of Anti-Counterfeiting Committee, American Intellectual Property Lawyers Association

## **PUBLICATIONS**

- "No Harm, No Foul? Private and Public Litigation in Cybersecurity Law," *Inside Counsel* (July 7, 2016)
- "Cybersecurity is a Governance and Risk Management Issue," *Today's General Counsel* (April/May 2016)
- "In Cybersecurity, No Harm Does Not Necessarily Mean No Foul," *Law360* (February 17, 2016)
- "Licensing," chapter in Robert L. Haig's *Commercial Litigation in New York State Courts* (Fourth Edition), published by Thomson Reuters (2015)
- "The Economic Duress Doctrine - A U.S. Perspective," Published by International Bar Association (2005)
- "Harmonizing the Civil and Common Law Traditions in Prehearing Document Disclosure in Commercial Arbitration," Published by International Bar Association Construction Section (2004)

## **Foley Hoag Alerts and Updates**

- Federal Circuit Rejects State Sovereign Immunity Defense to Inter Partes Review (June 19, 2019)
- Federal Circuit Nixes PTAB Sovereign Immunity for Saint Regis Mohawk Tribe (July 26, 2018)
- Implications of SCOTUS Opinions on Constitutionality, Scope of Inter Partes Reviews (May 2, 2018)
- Timeliness Determinations for Inter Partes Review Now Subject to Appellate Review (January 17, 2018)

## **SPEAKING ENGAGEMENTS**

- "Protecting Product Configurations, Packaging, and Designs: What In-House Counsel Needs to Know" (2017)
- "Legal Ethics for In-House Trademark and Copyright Attorneys" (2017)
- "Negotiating and Executing a License Agreement, A Case Study," CLE presentation to in-house counsel (2015)
- "Arbitrating Pharmaceutical Licensing Disputes," presentation to in-house counsel (2013)
- "Attorney-Client Privilege as Applied to In-House Counsel," CLE presentation to in-house counsel (2012)

- "Arbitrating Pharmaceutical Industry Disputes," DELVACCA Chapter of American Corporate Counsel (2011)
- "Preparing Company Employees for Depositions, Hearings and Trials," presentation to in-house counsel (2011)
- "Patent Due Diligence, Program on Current Issues in Patent Practice," New York City Bar Association (2009)
- "In re Bilski Roundtable," Bar Association of the City of New York (2008)
- "Assessing the Impact of Seagate," IMS Expert Services Webinar (2007)
- "Preparing for Oral Argument," Federal Circuit Bar Association 8th Annual Bench & Bar Conference (2006)
- "The Economic Duress Doctrine - A U.S. Perspective," International Bar Association Annual Conference (Prague 2005)
- "Harmonizing the Civil and Common Law Traditions in Prehearing Document Disclosure in Commercial Arbitration," Program on Construction Projects from Start to Finish, International Bar Association Construction Section (Brussels 2004)