

## Peter L. Michaelson



Peter Michaelson serves, since 1991, as an ADR neutral primarily involving Intellectual Property (patent, trademark, trade secret), IT and other technology related disputes encompassing a wide range of technologies and industries, e.g., aviation, electronics (hardware and software), energy, medical devices, pharmaceuticals, telecommunications and infrastructure (including investment); and secondarily other commercial disputes.

He also served, from 1979-2012, as an active IP practitioner concentrating in patent matters (primarily complex electronic, communications and computer-related and mechanical technologies) and trademark matters; and from 2010-2012 as General Counsel (virtual) for Direct Grid Technologies, LLC. From 1984-2012, he was in private practice as founding partner of Michaelson & Associates and predecessor firms and in that capacity represented clients ranging from Fortune 50 companies to technology start ups in IP matters both contentious and non-contentious, particularly involving patent and trademark issues. From 1982-1984, he was an associate attorney at Pennie & Edmonds in New York City. From 1979, when he commenced his legal career, through mid-1982, he was a Member of the Legal and Patent Staff at Bell Telephone Laboratories (Bell Labs) in Holmdel, New Jersey.

His experience, gained through several decades of active legal practice and service as a neutral handling complex matters, makes him extremely well-qualified to arbitrate and mediate complex disputes not only involving IP, IT and technology related-issues but also those involving a wide range of other substantive areas.

### Areas of Expertise:

- COMMERCIAL DISPUTES
- COMPLEX LITIGATION
- CONTRACTS
- ELECTRONIC DISCOVERY
- INTELLECTUAL PROPERTY
- INTERNATIONAL ARBITRATION
- LICENSING (SOFTWARE & TECHNOLOGY)
- PATENT
- PHARMACEUTICALS
- TELECOMMUNICATION
- TRADE SECRET
- TRADEMARK & COPYRIGHT

### ADR Experience:

**Arbitrated:****a) International and domestic:**

- (i) intellectual property (IP) disputes (including patent disputes spanning a wide range of technologies; trademark, domain name and trade secret disputes),
- (ii) information technology (IT), and
- (iii) technical and technology-related disputes across many industries and industrial sectors, including, e.g., aviation, defense contracting, energy, general manufacturing, infrastructure (including investment), electronics (hardware and software), lighting, major appliances, medical devices, telecommunications and pharmaceuticals.

b) International and domestic commercial disputes across a wide range of other substantive areas including, e.g.: antitrust (merger), breach of contract, consumer credit, consumer fraud, consulting, joint ventures and partnerships, licensing (including university technology transfer), mergers & acquisitions, securities and financial, and telecommunications (including reciprocal compensation).

Served as a Court-appointed expert in patent law in patent litigations in the U.S. District Courts involving complex technology across various industries. Mediated, on a Court-annexed basis, Hatch-Waxman based pharmaceutical disputes. Also mediated trademark litigations in the U.S. District Courts.

Mediated disputes across a wide range of other substantive areas including, e.g.: breach of contract, credit and financial, employment discrimination, franchises, healthcare, insurance coverage and liability, intellectual property (including validity, infringement and misappropriation), licensing (including university technology transfer), professional malpractice and fee disputes, real property (including leases), technology and warranties.

Collectively, I have arbitrated over 500 disputes and mediated over 200 disputes with amounts in contention extending from a few thousand dollars to \$ 400-800 Million.

I served on single- and three-person arbitration panels, as chair of three-person panels, as emergency arbitrator, and as mediator and co-mediator.

**The significant matters I have handled illustratively include:****Arbitration:**

- As a member of a three-person panel and under the ICDR, an international patent licensing dispute concerning hot-wall vertical furnaces used in atomic layer deposition processing in semiconductor fabrication with upwards of US \$130 Million in contention.
- As Chair and under FINRA, a contractual dispute between a major investment company, as Claimant, and a major international securities broker dealer as Respondent. The dispute concerns the sale to the Claimant by the Respondent of notes issued by a foreign oil and gas exploration and production company for financing development and exploitation of a foreign oil field.

The Claimant alleges the Respondent engaged in fraud and misrepresentation in the sale and seeks more than US \$ 65 Million in damages from the Respondent.

- As Chair and under the ICDR, an international contract dispute involving an alleged breach of confidentiality concerning the unauthorized manufacture and sale of remote control units for cable television set-top boxes, with approximately US \$10 Million in contention.
- As sole arbitrator and under the ICC, a software licensing dispute involving automated spend analysis software provided online as a service.
- As Chair and under the ICDR, a contractual dispute concerning indemnification under a stock purchase agreement, underlying a US \$ 425 Million corporate acquisition, with approximately US \$30 Million in contention.
- As a sole panelist and under the ICDR, a contractual dispute concerning a joint development agreement involving network connected, interactive, 4K-resolution, touch-screen based displays and whiteboards.
- As a member of a three-person panel and under the ICC, an international patent licensing dispute concerning haptic technology used in mobile telecommunications devices with approximately US \$ 60 Million in contention and requested injunctive relief potentially prohibiting at least hundreds of millions of dollars of future device shipments to the US.
- As a member of a three-person panel and under the ICDR, a contractual dispute concerning an international IT supply/consulting agreement involving licensed resale of commodity trading and risk management software for intended use by a national electric utility.
- As a sole arbitrator and under the ICDR, a dispute involving alleged trade secret misappropriation and patent infringement of a critical component of astronautic launch vehicles.
- As an emergency arbitrator and under the ICDR, a contractual dispute, between the Internet Corporation for Assigned Names and Numbers (ICANN) and a domain name registrar, involving a suspension, imposed by ICANN on the registrar, of new generic top level domain (gTLD) name registrations and inbound name transfers for non-compliance with its Registrar Accreditation Agreement with ICANN (the award, which is publicly available, is accessible below in the “Reported Decisions” section of this CV).
- As a sole arbitrator and under the ICDR, a contractual dispute concerning a reciprocal international telecommunications carrier service agreement.
- As a sole arbitrator and under the ICDR, an international contract dispute regarding a failed software development project.
- As a sole arbitrator and under the ICDR, an international patent licensing dispute concerning negative pressure wound care technology with approximately US \$10 Million in contention;

- As a sole arbitrator and under the ICDR, an international biotechnology licensing dispute involving technology, including cytometers, and related confidential technical information for use in sex selective breeding of cattle and other livestock with damages claimed of approximately US \$ 72 Million.
- As a member of a three-person panel and under the AAA, a domestic patent licensing dispute concerning high frequency ventilators primarily used for respiratory support.
- As a member of a three person panel and under the ICC, an international patent licensing dispute involving wireless mobile technology with approximately US \$ 25 Million in contention.
- As a member of a three-person panel and under the ICDR, an international patent licensing dispute also involving wireless mobile technology.
- As a member of a three person panel and under the ICDR, an international patent licensing dispute involving several US patents concerning compact fluorescent lamps with approximately US \$ 100 million in contention.
- As a sole arbitrator and under the AAA, a domestic patent licensing dispute involving magnetic resonance imaging (MRI) technology with approximately US \$ 25 Million in contention;
- As member of three-person panel and under the ICDR, a technology development contract and patent infringement dispute involving spinal fixation devices with approximately US \$ 25 Million in contention;
- As a sole arbitrator and via a CPR referral, a domestic dispute, involving allegations of breach of confidentiality, and trademark infringement, concerning manufacture and distribution of a web-based, demand-side energy load management system with damages claimed of US \$107 Million.
- As sole arbitrator and under the AAA, a multi-million dollar US patent infringement dispute concerning integrated circuit digital signal processors. Arbitration was handled on an expedited basis after transfer out of USDC-ED Texas (Marshall Division). Entire arbitration, including evidentiary hearing and rendition of reasoned award, consumed approximately 7 weeks.
- As a member of a three person panel and under the AAA, a domestic patent dispute involving air bag technology including, among other issues, inventorship of each of approximately 20 US patents.
- As panel chair and via a CPR referral, a domestic patent infringement dispute, involving a genetically-engineered, monoclonal-antibody based pharmaceutical drug with approximately \$100 Million claimed. Drug had cumulative sales through 2006 of approximately US \$4.4 Billion and annual sales then of approximately US \$2.5 Billion and expected additional sales throughout the remainder of the terms of the patents in dispute of approximately US \$22 Billion.

- As a party-appointed arbitrator, an investment dispute, under the UNCITRAL rules and through the London Court of International Arbitration (LCIA), between a US telecommunications company and a foreign government as respondent, involving alleged governmental expropriation of a national wireless mobile telecommunications network, with damages being claimed by the telecommunications company of approximately US \$150 Million.
- As a member of a three person panel and under the AAA, a domestic patent infringement dispute involving reverse geometry contact lenses, and, in conjunction therewith, conducted along with my co-arbitrators, a Markman (claim construction) hearing.
- As a member of a three-person panel and under the AAA, a contract dispute involving a very large semiconductor manufacturer and concerning development of specialized integrated circuits for DSL (digital subscriber line) equipment with liabilities being claimed amounting to several tens of millions of US dollars.
- As a member of a three-person panel and via a CPR referral, a domestic patent infringement dispute involving coronary arterial stents, with multiple US patents at issue, between two major multi-national competing medical device manufacturers with liability estimated to be between US \$400-800 Million, and in conjunction therewith conducted, along with my co arbitrators, a Markman hearing.
- As a member of a three person panel and under the AAA, a contract dispute resulting from alleged failures arising from an installation of enterprise resource planning (ERP) software and involving a large international accounting/IT consulting firm, with liabilities claimed between US \$25-40 Million.
- As a member of a three person panel and via a CPR referral, a telecommunication dispute concerning payment of reciprocal compensation between a large incumbent local exchange carrier (ILEC) and a competitive local exchange carrier (CLEC) with a total amount of compensation impacted at the ILEC estimated at approximately US \$50 Million.
- Multiple software development disputes through the AAA, mostly international, arising between “freelance” developers and their customers, both transacting with each other through an online staffing platform.
- Domain name disputes for ICANN accredited dispute resolution service providers (including: WIPO, AAA, CPR, HKIAC-ADNDRC, BCICAC, NAF, eResolution). For all my web-published domain name arbitration decisions, see <http://www.mandw.com/decisions.htm> (approximately 270 decisions thus far).

**Mediation:**

- Under the AAA, a patent licensing dispute involving a monetization agreement and which the parties were unable to resolve after approximately 1 1/2 years of direct negotiations.
- On an ad hoc basis, a domestic patent infringement dispute involving database technology with approximately US \$ 16 Million in contention.

- Via a WIPO referral, an international patent licensing dispute involving automotive structural technology and with several US patents in contention.
- On a court-annexed basis for the United States District Court – Eastern District of New York, four separate Hatch-Waxman patent infringement litigations involving a common prescription drug then having annual sales of approximately US \$350-400 Million. These litigations were consolidated, at my request for purposes of mediation, and collectively involved three innovator pharmaceutical companies and three generic pharmaceutical companies.
- Via a WIPO referral, an international patent infringement dispute involving both mechanical and electronic aeronautical technology, with multiple US patents at issue, with potential liability to the parties involved of approximately US \$600 Million. Through this mediation, the parties not only settled their existing disputes — which had entailed some ten years of international patent litigation, but also agreed on establishing a framework to avoid future patent disputes going forward.
- An international patent infringement dispute between two large US appliance manufacturers that successfully ended five years of foreign patent litigation with liabilities claimed of approximately US \$30 Million.
- A US patent infringement dispute involving personal digital assistants (PDAs) which successfully ended US patent litigation and formed a framework for future business co-operation between the disputants.
- Disputes covering a wide range of substantive legal areas for the New Jersey Superior Court system.

### **Publicly Available (Published) Arbitration Decisions:**

- OpenTLD, B.V. v. Internet Corporation for Assigned Names and Numbers (ICANN), case no.: 01-15-0004-1379 (ICDR, August 24, 2015) (Emergency Arbitrator)
- Hawaii Community Federal Credit Union v. Texas International Property Associates – NA NA, 88 USPQ2d 1761 (Nat. Arb. Forum, September 3, 2008) (Sole Panelist)
- 322 West 57th Owner LLC v. Administrator, Domain, C/O Mecca Hosting, 88 USPQ2d 1491 (WIPO, August 6, 2008 (Sole Panelist)
- Marvel Manufacturing Co. v. Koba Internet Sales LP, 87 USPQ2d 1276 (WIPO, May 5, 2008) (Sole Panelist)
- Paxar Americas Inc. v. eNom Inc., 84 USPQ2d 1730 (Nat. Arb. Forum, June 22, 2007 (Sole Panelist)
- Shaw Industries Group Inc. v. Arcadia Publishing Inc., 84 USPQ2d 1574 (WIPO, March 20, 2007) (Sole Panelist)
- SPX Corp. v. Hevun Diversified Corp., 81 USPQ2d 1621 (Nat. Arb. Forum, November 13, 2006) (Sole Panelist)



- Beat the Bookstore, LLC v. May Enterprises, 79 USPQ2d 1360 (Nat. Arb. Forum, December 19, 2005) (Sole Panelist)
- Estate of Marlon Brando v. Whois Guard, 77 USPQ2d 1229 (Nat. Arb. Forum, August 29, 2005) (Sole Panelist)
- Sound Unseen Ltd. v. Vanderhorst, 77 USPQ2d 1585 (WIPO, August 18, 2005) (Sole Panelist)
- Ringling Bros.-Barnum & Bailey Combined Shows Inc. v. Lima, 74 USPQ2d 1887 (Amer. Arb. Assoc., May 13, 2005) (Sole Panelist)
- Lockheed Martin Corp. v. Skunkworx Custom Cycle, 74 USPQ2d 1486 (WIPO, January 18, 2005) (Sole Panelist)
- Mess Enterprises v. Scott Enterprises Ltd., 74 USPQ2d 1289 (WIPO, January 25, 2005) (Presiding Panelist)
- True Blue Productions Inc. v. Hoffman, 73 USPQ2d 1512 (WIPO, December 22, 2004) (Sole Panelist)
- National Collegiate Athletic Association v. Brown, 72 USPQ2d 1319 (WIPO, August 30, 2004) (Sole Panelist)
- Register.com Inc. v. Reile, 70 USPQ2d 1351 (Nat. Arb. Forum, January 27, 2004) (Sole Panelist) Office of Personnel Management v. MS Technology Inc., 70 USPQ2d 1333 (Nat. Arb. Forum, December 9, 2003) (Presiding Panelist)
- Cable News Network LP v. Khouri, 68 USPQ2d 1570 (Nat. Arb. Forum, December 16, 2002) (Presiding Panelist)
- National Association of Professional Baseball Leagues, Inc. v. Zuccarini, 67 USPQ2d 1315 (WIPO, January 21, 2003) (Co-Panelist)
- Kalaydjian v. Steinle, 64 USPQ2d 1576 (Nat. Arb. Forum, August 27, 2002) (Sole Panelist)
- Princeton Linear Associates Inc. v. Copland, 61 USPQ2d 1895 (Nat. Arb. Forum, February 8, 2002) (Sole Panelist)

### **Non-ADR Legal Experience:**

Served as General Counsel (on a virtual basis) for Direct Grid Technologies, LLC handling wide variety of general corporate issues, including intellectual property.

Conducted intellectual property and unfair competition litigation in the U.S. Courts; and inter-parte and ex-parte proceedings in the U.S. Patent and Trademark Office involving patents and trademarks, including, e.g. patent appeals, patent reissues, patent interferences and trademark oppositions; and (with foreign counsel) overseas patent and trademark oppositions.

**Specifically, my experience includes having:**

- (a) acted as counsel in patent infringement cases involving, e.g., software-based systems, electronic hand-held calculators, video equipment, electronic instruments, and electronic point of sale terminals and computer systems utilizing these terminals;
- (b) prepared patent validity and infringement opinions involving complex electronic technology; prepared trademark validity and infringement opinions;
- (c) counseled in intellectual property, antitrust, unfair competition, and privacy law;
- (d) prepared/prosecuted several hundred patent applications, both U.S. and foreign, covering a wide range of electronic and mechanical technologies, e.g.; microprocessor and computer hardware and software including massively parallel processing systems; operating systems; cryptography; business methods; decision-theoretic processing; complex electronic systems (both computer and non-computer based) in the technical areas of, e.g., industrial process control and measurement, digital data transmission, communications including radio, wireline and mobile wireless, digital transmission and ISDN, VoIP, asynchronous transfer mode (ATM) and general packet and circuit switching, networking, high definition television (HDTV), video and image processing including image compression and enhancement, video cameras, avionics, speech recognition and processing, radar and medical electronics; semiconductors and semiconductor fabrication; fiber optics; photographic apparatus; displays, including liquid crystal displays (LCDs); electronic circuitry; and mechanical devices and metallurgy; and
- (e) prosecuted many U.S. and foreign trademark applications.

I am also experienced in patent and trademark licensing, including F/RAND licensing.

Between July 1984 – April 2012 (approximately 28 years), I owned and successfully operated my law firm, Michaelson and Associates (and its predecessor firms). In so doing, I was responsible for: marketing, finance, purchasing (including capital asset acquisition and long-term leasing of office space and certain equipment), IT and office automation, personnel (both professional and administrative, including: hiring, termination, supervision, benefits and compensation), billing and all other functions attendant to running a small business. During that time, I had complete and sole “bottom line” profit/loss responsibility.

**ADR Panel Memberships (including accreditations):**

ICDR (including ICDR ICANN String Confusion Objections (SCO) panel) and AAA (Commercial Panel (patent, trademark and technology rosters; and IP specialty rosters, including pharmaceutical, biotech, SEP-FRAND (standard essential patents — fair, reasonable and non-discriminatory terms) and others; Large Complex Case (LCC), E discovery/Special Master, M&A and Joint Venture, Consumer Account, e commerce and Domain Name Dispute Panels)



WIPO (Approved Mediator and Arbitrator in Intellectual Property Disputes and Arbitrator for ICANN Domain Name Disputes, Legal Rights Objections (LRO) and Trademark Post-Delegation Dispute Resolution Procedure disputes)

Member of arbitration and mediation panels of other well-respected and well-known institutions including: SIAC, HKIAC, KLRCA, CPR, BCICAC, FINRA and others.

Member of the “TECH LIST” of the Silicon Valley Arbitration and Mediation Center (SVAMC).

Arbitration and mediation panels of the US District Court – EDNY.

CEDR Accredited Mediator.

**Education:**

- New York University School of Law, New York, New York – June 1985 – Masters of Law (LLM) – Trade Regulation
- Duquesne University School of Law Pittsburgh, Pennsylvania June 1979 – Juris Doctor (JD)
- Senior Staff Member – Duquesne Law Review
- Carnegie-Mellon University, Pittsburgh PA – May 1975 – Master of Science (MS) – Electrical Engineering
- Carnegie-Mellon University – May 1974 – Bachelor of Science (BS) – Electrical Engineering and Economics

**Admitted to Practice:**

- Alaska (2000)
- New York (1986)
- New Jersey (1980)
- U.S. Patent and Trademark Office (1980) (Registered Patent Attorney 30,090)
- Pennsylvania (1979)
- Various Federal District Courts and Courts of Appeal, including U.S. Supreme Court (1986), U.S. Court of Appeals for the Federal Circuit (1983) and U.S. Court of Appeals for the Third Circuit (1981)

**Professional Associations:**

- College of Commercial Arbitrators (Fellow);
- American College of e Neutrals (Fellow);
- Chartered Institute of Arbitrators (Fellow, Chartered Arbitrator, Chair Emeritus and Co-Founder – New York Branch, and Past Trustee (Americas Region));
- Silicon Valley Arbitration and Mediation Center;



- Member – National Academy of Distinguished Neutrals;
- International Arbitration Club of New York;
- American Bar Association;
- New York International Arbitration Center;
- Alaska Bar Association;
- New Jersey State Bar Association;
- New York State Bar Association.