



Paul J. Sutton



Sutton Magidoff LLP
INTELLECTUAL PROPERTY

SuperLawyers

Paul J. Sutton



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Lawyer Ratings

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Paul J. Sutton, a registered patent attorney, enjoys over four decades of law firm and corporate experience concentrated in intellectual property law. Prior to obtaining his Juris Doctor degree, while an engineer at Douglas Aircraft's Missiles & Space Systems Division, Paul was a member of the team that designed the Apollo Saturn third stage booster rocket structure which carried the first U.S. Astronauts to the Moon.

Paul served the Greenberg Traurig and Thelen Reid & Priest law firms as Chair of their Patent, Intellectual Property & Technology Practices, and he served Gulf + Western Corp. as its Patent Counsel. After decades of uninterrupted practice of law together, Paul and Barry G. Magidoff have re-established their Sutton Magidoff IP boutique, which was originally formed over forty years ago.

Paul has successfully counseled clients in developing global intellectual property business strategies for generating significant ongoing annual revenues. He is familiar with all aspects of patents, trademarks, copyrights, licensing, trade dress, trade secrets, unfair competition, false advertising, grey market, computers, the Internet, and anti-counterfeiting. Paul enjoys an unmatched track record in patent and trademark litigation, representing clients at the trial and appellate levels before federal and state courts, the U.S. International Trade Commission, administrative tribunals, and in various Alternative Dispute Resolution forums.

Paul serves as an Adjunct Professor at New York University's Tandon School of Engineering, where he teaches courses in Intellectual Property Strategies for Engineers & Scientists and Intersections of Law, Engineering, Business and Psychology. He also serves as a member of the Industry Advisory Board of NYU:Tandon.

Paul is a member of the Editorial Panel of UK-based *World Intellectual Property Review*, for whom he regularly authors publications. As a guest of the Peoples Republic of China, he lectured before the judiciary and legislators to harmonize Chinese and U.S. intellectual property laws.



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Admitted to Practice

- U.S. Supreme Court
- District of Columbia
- New York State
- 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 Eastern District of Michigan
- U.S. District Court for the Northern District of California
- U.S. Court of Appeals for the Federal Circuit
- U.S. Court of Appeals for the District of Columbia Circuit
- U.S. Court of Appeals, Second Circuit
- U.S. Patent and Trademark Office

Education

- B.M.E., Mechanical and Electrical Engineering, New York University, 1962
- Industrial Engineering, Columbia University
- Welding Metallurgy, U.C.L.A.
- Juris Doctor, Brooklyn Law School, 1967

Areas of Concentration

- Global intellectual property counseling
- Complex and high stakes intellectual property litigation
- Intellectual property licensing
- Technology transfers and joint ventures
- Due diligence for mergers and acquisitions
- Patent preparation and prosecution, including interferences
- Trademark protection and brand enforcement
- Copyright protection and enforcement
- Trade dress and trade secrets
- Intellectual property audits
- Information technology strategies
- Appellate practice before the U.S. Patent & Trademark Office, Board of Patent Appeals & Interferences, and the U.S. Court of Appeals for the Federal Circuit



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Significant Representations

Paul has served as lead counsel in the following intellectual property litigation involving patent, trademark and copyright infringement, unfair competition, unfair trade practices, false designation of origin, patent misuse, and other related claims, many of which were resolved on terms highly favorable to his clients:

- Activox vs. Envirotech
- Alue/Manfrotto vs. Matthews Studio Equipment
- Amstar vs. Activox, Inc.
- ASPCC vs. Strum
- Avnet vs. Cable Electric
- Bates vs. Machen Inc.
- Berol Corporation vs. Idea Group, Inc.
- Berol Corporation vs. Long Island Distributing Company Ltd.
- Berol Corporation vs. Yikes!
- Buildex vs. Kason Hardware Corp.
- C&K Electronics vs. Leviton Manufacturing Co., Inc.
- Cabbage Patch Kids vs. The Topps Company, Inc.
- Cable Electric Company vs. Caldor
- Cable Electric Company vs. Casadio
- Cable Electric Company vs. Creative Pioneer Corp.
- Cable Electric Company vs. Genmark Inc.
- Cable Electric Company vs. Home Equipment Inc.
- Cable Electric Company vs. Marshall Field's
- Cable Electric Company vs. Novo
- Cable Electric Company vs. Woods Wire Products
- Caterpillar Inc. vs. Paris Accessories Inc.
- Convers Inc. vs. Paris Accessories Inc.
- Convex Promotions, Inc. vs. Acquire, Inc.
- Crazy glue vs. Super Glue Corporation
- Creative Pioneer vs. Baldwin & Stratton
- Creative Pioneer vs. Cotter & Co.
- Creative Pioneer vs. Edmund Scientific
- Creative Pioneer vs. Hogan Hardware Corp.
- Davidoff vs. JR Tobacco Company, Inc.
- DCNL/Denebeim vs. Conair Corporation
- Dixon Ticonderoga vs. Berol Corporation
- DJR Holdings vs. Go Go Def Recordings
- Ductmate vs. Duro Dyne Corporation
- Eaton Corporation vs. Leviton Manufacturing Co., Inc.
- Echo Corp. vs. Carroll Reed
- Echo Corp. vs. Eagles' Eye
- ECOS Electronics vs. Daniel Woodhead
- Electronic Trading vs. The Chicago Mercantile Exchange
- EOS Technologies, Inc. vs. Leviton Manufacturing Co., Inc.
- Excelsior vs. Leviton Manufacturing Co., Inc.
- Fantasy Sports vs. CBS SportLine.com
- Franklin Telecom vs. Internet Passport
- Gaus vs. Conair Corporation
- Glumen Corp. vs. Stance
- Goldsmith vs. Peter Max
- Hasselblad USA vs. 47th Street Photo
- Hoskamer vs. Leviton Manufacturing Co., Inc.
- Hubbell vs. Leviton Manufacturing Co., Inc.
- Hudsons Bay Company vs. Heilman Brewery
- Hudsons Bay Company vs. Herter's
- Interactive Gift Express vs. Volcaltec Communications Limited
- Internet World vs. Ziff-Davis
- J.D. Smith vs. Nichols
- K-V vs. Hardware Designers Inc.
- LG Chemical Ltd. Vs. Pioneer
- Lalli vs. Lalli
- Lerner/Ellman vs. Melody Bellphone
- Leviton Manufacturing Co., Inc. vs. 3M
- Leviton Manufacturing Co., Inc. vs. Applied Lighting Concepts, Inc.
- Leviton Manufacturing Co., Inc. vs. Arlington Industries
- Leviton Manufacturing Co., Inc. vs. C&K
- Leviton Manufacturing Co., Inc. vs. Carlingswitch
- Leviton Manufacturing Co., Inc. vs. Catalina Lighting Inc.
- Leviton Manufacturing Co., vs. Central Purchasing LLC
- Leviton Manufacturing Co., Inc. vs. Conair Corporation
- Leviton Manufacturing Co., Inc. vs. Control Devices
- Leviton Manufacturing Co., Inc. vs. Eagle Electric
- Leviton Manufacturing Co., Inc. vs. Florida Lighting
- Leviton Manufacturing Co., Inc. vs. General Cable
- Leviton Manufacturing Co., Inc. vs. Grandway/Cheetah USA Corp.



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Significant Representations (cont'd.)

- Leviton Manufacturing Co., Inc. vs. Harbor Freight Tools Inc.
- Leviton Manufacturing Co., Inc. vs. Heath-Zenith
- Leviton Manufacturing Co., Inc. vs. HML Quenqing
- Leviton Manufacturing Co., Inc. vs. Il Shin Electric Co.
- Leviton Manufacturing Co., Inc. vs. Intelectron
- Leviton Manufacturing Co., Inc. vs. Interline Brands
- Leviton Manufacturing Co., Inc. vs. Intermatic
- Leviton Manufacturing Co., Inc. vs. I.T.S. Industries, Inc.
- Leviton Manufacturing Co., Inc. vs. Leen d/b/a Designers Edge
- Leviton Manufacturing Co., Inc. vs. Lights of America
- Leviton Manufacturing Co., Inc. vs. M3 Products
- Leviton Manufacturing Co., Inc. vs. Nicor Lighting & Fans, Inc.
- Leviton Manufacturing Co., Inc. vs. Orbit Electric Inc./Yatai
- Leviton Manufacturing Co., Inc. vs. Potrans
- Leviton Manufacturing Co., Inc. vs. Preferred Industries
- Leviton Manufacturing Co., Inc. vs. Safety Plus, Inc.
- Leviton Manufacturing Co., Inc. vs. Sammax International Ltd.
- Leviton Manufacturing Co., Inc. vs. Skil
- Leviton Manufacturing Co., Inc. vs. Stellar Lighting
- Leviton Manufacturing Co., Inc. vs. Sunland Inc.
- Leviton Manufacturing Co., Inc. vs. Test-Rite
- Leviton Manufacturing Co., Inc. vs. Taiwan Lishin Electric
- Leviton Manufacturing Co., Inc. vs. Taiwan Passive Infrared
- Leviton Manufacturing Co., Inc. vs. Topaz Lighting Corp.
- Leviton Manufacturing Co., Inc. vs. Universal Security Industries Inc.
- Leviton Manufacturing Co., Inc. vs. USI
- Leviton Manufacturing Co., Inc. vs. Visonic Ltd.
- Leviton Manufacturing Co., Inc. vs. Westek Associates
- Leviton Manufacturing Co., Inc. vs. Woods Wire
- Leviton Manufacturing Co., Inc. vs. Zhejiang Dongzheng Electric Inc.
- Lutron Electronics Co., Inc. vs. Leviton Manufacturing Co., Inc.
- Randy Marsh et al. vs. The Topps Company, Inc.
- Mecklermedia vs. Ziff Davis
- Mongiello vs. Pizza Hut/Pepsi
- Norris Communications vs. Simate Corporation
- Novo vs. Cable Electric Company
- Nutramax vs. The Vitamin Shoppe
- New York Gas Group vs. Tubis Golabi
- Orbit Electric vs. Leviton Manufacturing Co., Inc.
- Pacific Electriccord Company vs. Paige
- Phonetel vs. Conair Corporation
- Pirkle vs. Pacific Electriccord Company
- Polylok Corp. vs. Valley Forge
- Porter vs. Galkin Corporation
- Premier Networks vs. Conair Corporation
- Recoton Corporation vs. Leviton Manufacturing Co., Inc.
- S.C. Johnson & Son, Inc. vs. Kiss My Face Corporation
- Salacuse vs. Ginger Spirits, Inc.
- Sales Consultants Corp. vs. Leviton Manufacturing Co., Inc.
- Southwest Laboratories, Inc. vs. Leviton Manufacturing Co., Inc.
- Stormceptor vs. Valley Blox
- Super Glue Corporation vs. Jadow/Crazy Glue
- Super Glue Corporation vs. Loctite
- Super Glue Corporation vs. Pacer Technologies
- Surface Activation, Inc. vs. Ti/Bel
- Tatung Telecom Corporation vs. Arctic International Corp.
- Tenneco Deep Sea Ventures vs. International Nickel
- Thiebierge & Comar vs. Reich Paper
- The Topps Company, Inc. vs. Borden
- Topps vs. Berburg
- Tough Traveler vs. Outbound Corp.
- Tricom SA vs. Ferrera
- Via-Chem Corporation vs. Qualco
- Victor Stanley vs. Urban Accessories
- Warth International Ltd. vs. Metex Mfg. Corporation
- Weber vs. Leviton Manufacturing Co., Inc.
- Yarnell Fabrics Corp. vs. Bloomingdale's
- Zhejiang Dongzheng Electrical Ltd. vs. Leviton Manufacturing Co., Inc.



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Awards & Recognition

- Highest AV Preeminent professional rating
- Recognized as a Super Lawyer by Super Lawyers Magazine after extensive peer nominations, blue ribbon panel review and independent research.
- Listed, Legal 500 US, an internationally recognized client referral guide providing in-depth editorial and recommendations of law firms and lawyers: recommended for Intellectual Property and Patent Litigation, International Trade Commission, and Life Sciences/Chemical.

Published

- Author, "Patent Perils Pitfalls & Pointers"
- Co-author of textbook, "Commercial Law"
- Author, "The Impact of Business Method Patents", published by Oxford University Press, 2000
- Author, "A Year of Significant Patent Law Change," published in World Intellectual Property Review (WIPR) Digest, 2008
- Author, "Win Patent Disputes without Losing your Shirt," published by WIPR, 2008
- Author, "Nanotechnology License Pitfalls," published by Oxford University Press, 2008
- Author, "New Patent Licensing Strategies Required", published by Oxford University Press, 2008
- Author, "Patent Unenforceability and Star Scientific's Impact," published by WIPR, 2009
- Author, "Are Your International IP Disclosures Illegal?", published by WIPR, 2009
- Author, "Unsettled U.S. Law: Infringement of Product-By-Process Patents", published by WIPR, 2009
- Author, "Clarity On Product-By-Process Patents", published by WIPR, 2009
- Author, "Smartphone Patent Wars Escalate", published by WIPR, 2010
- Author, "Business Method Patents Remain Alive After Bilski", published by WIPR, 2010
- Author, "Judge Invalidates Human Gene Patents", published by WIPR, 2010
- Author, "The Surge in Medical Patent Activity", published by WIPR, 2010
- Author, "Contingency Fees in Patent Lawsuits", published by WIPR, 2010
- Author, "Avoid False Patent Marking Pitfalls", published by WIPR, 2010
- Author, "High-Tech Patent Wars: A New Front", published by WIPR, 2011
- Author, "Patent Reform Means Far-Reaching Consequences for Inventors", published by WIPR, 2011
- Author, "Proper patent inventorship", published by WIPR, 2011
- Author, "Provisional patent applications", published by WIPR, 2011
- Author, "The NDA: A Valuable IP Tool", published by WIPR, 2011
- Author, "Avoid Patent Co-Ownership Pitfalls", published by WIPR, 2011
- Author, "2010 Federal Circuit Patent Rulings", published by WIPR, 2011
- Author, "Patent Prosecution Bars in Litigation", published by WIPR, 2012
- Author, "2011 Federal Circuit Patent Rulings", published by WIPR, 2012
- Author, "Are The Patent Trolls Getting Hungrier?", published by WIPR, 2012
- Author, "Tech Patent Arms Race Escalates", published by WIPR, 2012
- Author, "Will Apple Derail Kodak's Patent Sale?", published by WIPR, 2012
- Author, "Patent Trolling at the USITC", published by WIPR, 2012
- Author, "AIA Patent Law Reform Is Effective", published by WIPR, 2012
- Author, "Surprise Patent Setback Stuns Biotech", published by WIPR, 2012
- Author, "Patent Joint Defence Agreements: Hidden Pitfalls", published by WIPR, 2013
- Author, "Patent Declaratory Judgment Actions", published by WIPR, 2013
- Author, "Future Pain For Patent NPEs", published by WIPR, 2013
- Author, "Obama Administration Unsettles Patent Bar", published by WIPR, 2013
- Author, "Federal Patent Malpractice Cases Bounced", published by WIPR, 2013
- Author, "2012 Federal Circuit Patent Rulings", published by WIPR, 2013
- Author, "Newest Forms Of Attack Against Patent NPEs", published by WIPR, 2013
- Author, "On The Slate: Patent Decisions In 2013", published by WIPR, 2013



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Published (cont'd.)

- Author, "Surprise Twin High-Octane Patent Decisions", published by WIPR, 2014
- Author, "The Patent Pay-For-Delay Scam", published by WIPR, 2014
- Author, "AIA's Patent Impact Upon Small Businesses", published by WIPR, 2014
- Author, "Has *Alice* Put Your Patent Portfolio At Risk?", published by WIPR, 2014
- Author, "2014 Post-AIA Patent Reform Is Dead", published by WIPR, 2014
- Author, "The Increasing Impact of 'Patent Trolls'", published by WIPR, 2014
- Author, "Patent-FTO Caveats", published by WIPR, 2014
- Author, "The Novelty Patent Search", published by WIPR, 2015
- Author, "A Valuable Risk Management Tool", published by WIPR, 2015
- Author, "The Co-Existence Of Design Patents And Trade Dress", published by WIPR, 2015
- Author, "The Expired Patent Royalty Ban", published by WIPR, 2015
- Author, "The Underappreciated Design Patent", published by WIPR, 2015
- Author, "Getting The Best Deal", published by WIPR, 2016
- Author, "Cuozzo Case: Weak Patents Suffer A Blow", published by WIPR, 2016
- Author, "Avoiding A Startup Patent Catastrophe", published by WIPR, 2016
- Author, "Narcissistic CEOs: Handle Patents With Care", published by WIPR, 2016
- Author, "A Matter Of Trust", published by WIPR, 2016
- Author, "Inappropriate Outsourcing May Invalidate Patents", published by WIPR, 2016
- Author, "Rotten Patent Result For Apple", published by WIPR, 2016
- Author, "The Design Patent For The World", published by WIPR, 2016
- Author, "The Dangers Of Misnaming Patent Inventors", published by WIPR, 2016
- Author, "Patent Eligibility After *Alice*", published by WIPR, 2017
- Author, "Patent Exculpatory Opinions Post-*Halo*", published by WIPR, 2017
- Author, "Understanding The Patent Exhaustion Doctrine", published by WIPR, 2017
- Author, "TC Heartland: The Patent Venue Bombshell", published by WIPR, 2017
- Author, "The Benefits Of The Provisional Patent Application", published by WIPR, 2017
- Author, "Risky Business: The Challenge Of Patent Contingency Claims", published by WIPR, 2017
- Author, "Patent Clash Of The Titans Continues", published by WIPR, 2017

Lectures & Speeches

- Frequent lecturer in the area of intellectual property law, including the development of global business strategies involving intangible property rights.
- Panelist, "Effectively Managing Your Company's IP Assets," 17th Annual General Counsel Conference, June 2005