



Paul J. Sutton

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Paul J. Sutton, a registered patent attorney, enjoys over five 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. 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, Patent Trial and Appeal Board, and the U.S. Court of Appeals for the Federal Circuit

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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 Digest, 2008
- Author, "Win Patent Disputes without Losing your Shirt," published by World Intellectual Property Review, 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 World Intellectual Property Review, 2009
- Author, "Are Your International IP Disclosures Illegal?", published by World Intellectual Property Review, 2009
- Author, "Unsettled U.S. Law: Infringement of Product-By-Process Patents", published by World Intellectual Property Review, 2009
- Author, "Clarity On Product-By-Process Patents", published by World Intellectual Property Review, 2009
- Author, "Smartphone Patent Wars Escalate", published by World Intellectual Property Review, 2010
- Author, "Business Method Patents Remain Alive After Bilski", published by World Intellectual Property Review, 2010
- Author, "Judge Invalidates Human Gene Patents", published by World Intellectual Property Review, 2010
- Author, "The Surge in Medical Patent Activity", published by World Intellectual Property Review, 2010

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- Author, “Contingency Fees in Patent Lawsuits”, published by World Intellectual Property Review, 2010
- Author, “Avoid False Patent Marking Pitfalls”, published by World Intellectual Property Review, 2010
- Author, “High-Tech Patent Wars: A New Front”, published by World Intellectual Property Review, 2011
- Author, “Patent Reform Means Far-Reaching Consequences for Inventors”, published by World Intellectual Property Review, 2011
- Author, “Proper patent inventorship”, published by World Intellectual Property Review, 2011
- Author, “Provisional patent applications”, published by World Intellectual Property Review, 2011
- Author, “The NDA: A Valuable IP Tool”, published by World Intellectual Property Review, 2011
- Author, “Avoid Patent Co-Ownership Pitfalls”, published by World Intellectual Property Review, 2011
- Author, “2010 Federal Circuit Patent Rulings”, published by World Intellectual Property Review, 2011
- Author, “Patent Prosecution Bars in Litigation”, published by World Intellectual Property Review, 2012
- Author, “2011 Federal Circuit Patent Rulings”, published by World Intellectual Property Review, 2012
- Author, “Are The Patent Trolls Getting Hungrier?”, published by World Intellectual Property Review, 2012
- Author, “Tech Patent Arms Race Escalates”, published by World Intellectual Property Review, 2012
- Author, “Will Apple Derail Kodak’s Patent Sale?”, published by World Intellectual Property Review, 2012
- Author, “Patent Trolling at the USITC”, published by World Intellectual Property Review, 2012
- Author, “AIA Patent Law Reform Is Effective”, published by World Intellectual Property Review, 2012
- Author, “Surprise Patent Setback Stuns Biotech”, published by World Intellectual Property Review, 2012
- Author, “Patent Joint Defence Agreements: Hidden Pitfalls”, published by World Intellectual Property Review, 2013
- Author, “Patent Declaratory Judgment Actions”, published by World Intellectual Property Review, 2013
- Author, “Future Pain For Patent NPEs”, published by World Intellectual Property Review, 2013

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- Author, “Obama Administration Unsettles Patent Bar”, published by World Intellectual Property Review, 2013
- Author, “Federal Patent Malpractice Cases Bounced”, published by World Intellectual Property Review, 2013
- Author, “2012 Federal Circuit Patent Rulings”, published by World Intellectual Property Review, 2013
- Author, “Newest Forms Of Attack Against Patent NPEs”, published by World Intellectual Property Review, 2013
- Author, “On The Slate: Patent Decisions In 2013”, published by World Intellectual Property Review, 2013
- Author, “Surprise Twin High-Octane Patent Decisions”, published by World Intellectual Property Review, 2014
- Author, “The Patent Pay-For-Delay Scam”, published by World Intellectual Property Review, 2014
- Author, “AIA’s Patent Impact Upon Small Businesses”, published by World Intellectual Property Review, 2014
- Author, “Has Alice Put Your Patent Portfolio At Risk?”, published by World Intellectual Property Review, 2014
- Author, “2014 Post-AIA Patent Reform Is Dead”, published by World Intellectual Property Review, 2014
- Author, “The Increasing Impact of ‘Patent Trolls’”, published by World Intellectual Property Review, 2014
- Author, “Patent-FTO Caveats”, published by World Intellectual Property Review, 2014
- Author, “The Novelty Patent Search”, published by World Intellectual Property Review, 2015
- Author, “A Valuable Risk Management Tool”, published by World Intellectual Property Review, 2015
- Author, “The Co-Existence Of Design Patents And Trade Dress”, published by World Intellectual Property Review, 2015
- Author, “The Expired Patent Royalty Ban”, published by World Intellectual Property Review, 2015
- Author, “The Underappreciated Design Patent”, published by World Intellectual Property Review, 2015
- Author, “Getting The Best Deal”, published by World Intellectual Property Review, 2016
- Author, “Cuozzo Case: Weak Patents Suffer A Blow”, published by World Intellectual Property Review, 2016
- Author, “Avoiding A Startup Patent Catastrophe”, published by World Intellectual Property Review, 2016

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- Author, “Narcissistic CEOs: Handle Patents With Care”, published by World Intellectual Property Review, 2016
- Author, “A Matter Of Trust”, published by World Intellectual Property Review, 2016
- Author, “Inappropriate Outsourcing May Invalidate Patents”, published by World Intellectual Property Review, 2016
- Author, “Rotten Patent Result For Apple”, published by World Intellectual Property Review, 2016
- Author, “The Design Patent For The World”, published by World Intellectual Property Review, 2016
- Author, “The Dangers Of Misnaming Patent Inventors”, published by World Intellectual Property Review, 2016
- Author, “Patent Eligibility After Alice”, published by World Intellectual Property Review, 2017
- Author, “Patent Exculpatory Opinions Post-Halo”, published by World Intellectual Property Review, 2017
- Author, “Understanding The Patent Exhaustion Doctrine”, published by World Intellectual Property Review, 2017
- Author, “TC Heartland: The Patent Venue Bombshell”, published by World Intellectual Property Review, 2017
- Author, “The Benefits Of The Provisional Patent Application”, published by World Intellectual Property Review, 2017
- Author, “Risky Business: The Challenge Of Patent Contingency Claims”, published by World Intellectual Property Review, 2017
- Author, “Patent Clash Of The Titans Continues”, published by World Intellectual Property Review, 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