



Peter S. Sloane

PARTNER

Peter Sloane handles all aspects of trademark and copyright counseling, prosecution, and litigation. Together, Peter and his team manage global trademark portfolios for some of the world's largest corporations and enforce intellectual property rights in courts and before tribunals around the globe. Their work includes anti-counterfeiting, handling domain name disputes, conducting due diligence, and negotiating license agreements. Peter has worked as a seconded attorney at Colgate-Palmolive, served as an expert witness, written amicus briefs, and been appointed to provide pro bono representation through the Office of Pro Se Litigation of the Southern District of New York.

Outside the firm, Peter has served as the founding Chair of the Intellectual Property Committee of the Federal Bar Council. He is a recent past Chair of the Law Firm Committee of the International Trademark Association (INTA). He has had the honor of guest lecturing at events for INTA, the Intellectual Property Owners Association (IPO), the Association of Intellectual Property Firms (AIPF) and the New York State Bar Association (NYSBA) among others. In addition to committee involvement and speaking engagements, he has also authored over 30 professional articles. Peter received his B.S. from Cornell University and his J.D. from the Benjamin N. Cardozo School of Law. He also attended New York University School of Law as a Visiting Student during his third year of law school and as a post-graduate in its LLM program for Trade Regulation.



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Education

- New York University School of Law, Attended LL.M. Program in Trade Regulation, 1995–1997
- New York University School of Law, Visiting Third Year Law Student, 1993-1994
- Benjamin N. Cardozo School of Law, J.D., 1994
- Cornell University, B.S., 1991

Bar Admissions

- New York

Court Admissions

- 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 Northern District of New York
- U.S. Second Circuit Court of Appeals
- U.S. Ninth Circuit Court of Appeals

Selected Articles

- "INTA: IP Law Firm of the Future Think Tank Report," *The Trademark Lawyer*, Issue 1, 2022
- "The Trademark Modernization Act: What Does it Do and Why Should Brand Professionals Care?," *The Brand Protection Professional (BPP)*, March 2021
- "Running a Lean, Mean Trademark Portfolio in Cost-Conscious Times," *Law360*, May 5, 2020
- "Trademark Vigilance in the Twenty- First Century: An Update," *Fordham Intellectual Property, Media and Entertainment Law Journal*, April 2020
- "A Growing Market," *Chartered Institute of Trade Mark Attorneys (CITMA) Review*, September 2019
- "UL Certification at Issue in Second Circuit Decision," *Federal Bar Council Quarterly*, July 1, 2018
- "Proof of Use Programs at the United States Patent and Trademark Office and the Relation to Foreign-Based Trademark Regulations," *Euromoney Expert Guides*, June 2018
- "Decisions- It's All About Who- Fair Use in Copyright Law," *Federal Bar Council Quarterly*, November 28, 2017
- "The State of the IP Boutique- Don't Forget Copyrights and Trademarks," *IPLaw360*, April 11, 2017
- "Trademarks: A Closer Look at Common Misconceptions," *Westchester County Business Journal*, March 21, 2016
- "Trademark Scams: It's Time for PTO Action," *Westlaw Journal on Intellectual Property Law*, February 2015
- "The Ongoing Battle Against Trademark Scammers," *Corporate Counsel*, December 2014
- "Drafting the Trademark Application," *Lexis Practice Advisor*, March 2014
- "Advertising Country Questions: US," *Practical Law Company*, June 2013
- "Trademark Bullying: Legitimate Problem or Passing Fad?," *World Trademark Review*, April 2013
- "Interview with an Investigator," *BNA's Patent, Trademark & Copyright Journal*, January 3, 2012
- "The Role of Prefatory Language in the Identification of Goods and Services in U.S. Trademark Applications and Registrations," *Intellectual Property Today*, October 2011
- "Defining the Claims of U.S. Trademark Protection: The Metes and Bounds of Trademark Registration," *Intellectual Property Today*, October 2010
- "Legalization of Documents in International Trademark Practice: A Primer," *Bright Ideas, Intellectual Property Law Section of the New York State Bar Association*, October 2010

Experience

- Ostrolenk, Faber, Gerb & Soffen, LLP, Partner, 2000-2009
- Fross Zelnick Lehrman & Zissu, P.C., Associate, 1998-2000
- Nims, Howes, Collison, Hansen & Lackert, Associate, 1995-1997

Memberships

- International Trademark Association, Leadership Development Committee, Member
- International Trademark Association, Law Firm Committee, Chair, 2020-2021
- International Trademark Association, Law Firm Committee, Vice-Chair, 2018-2019
- International Trademark Association, Programs Sub-Committee, Law Firm Committee, 2016-2017
- Federal Bar Council, Chair, Intellectual Property Committee, 2014-2019
- Pharmaceutical Trade Marks Group, Member
- Association of Patent Law Firms, Board Member, 2006-2007
- NameProtect Executive Business Advisory Board, 2006
- New York State Bar Association, Co-Chair, Trademark Law Committee, 1996-2000

Selected Articles (continued)

- "How Do You Start a Trademark Prosecution Practice at an Existing Law Firm," INTA Bulletin, October 1, 2010
- "Incontestability: Does Anybody Really Understand It?," INTA Bulletin, August 2009
- "Trademarks and Copyrights as Growth Opportunities Even in a Recessionary Economy," Intellectual Property Today, May 2009
- "Reviewing U.S. Copyright Law and the Internet in 2008," Computer Law Review International, May 2009
- "A Prescription for Proving Use of Trademarks for Drug Names in the U.S.," BNA's Patent, Trademark & Copyright Journal, February 15, 2009
- "The Benefits of Local Expertise," Trademark World, November 2008
- "What's in a Name? Everything," Entrepreneur.com, September 2008
- "Commentary, Trademark Dilution Revision Act of 2006," Trademark Insider, 2006
- "A Review of 2004 Case Law: Is the Internet Changing Copyright Law or is Copyright Law Changing the Internet?" Andrews Litigation Reporter, Computer & Internet, December 28, 2004
- "U.S. Customs Service Enacts Final Rule on Affiliate Exception to Gray Market Goods Imports," Bright Ideas, 1999
- "Statutory Damages in Copyright Law: A Plaintiff's Point of View," Law Works, July 1996

Selected Speaking Engagements

- Strafford Webcast, "Trademark Licensing: Key Provisions, Practical Considerations to Maximize and Protect IP," 2022
- International Trademark Association Leadership Meeting, "Ethical Considerations for Advertising in the Wild Wild West of Social Media," 2021
- USPTO and China National Intellectual Property Administration, U.S.-China Industry Seminar, "Practices for Protecting Trademarks," 2020
- International Trademark Association, Annual Town Hall Meeting, "IP Practice of the Future - A View from Intellectual Property Offices, In-House, and Law Firm Leaders," 2020
- American Intellectual Property Law Association, "Tackling Counterfeiting with the Government in on the Blitz," 2020
- Nassau County Bar Association, Intellectual Property Committee, "Counterfeiting and Strategies to Tackle it," 2020
- New York Intellectual Property Law Association, "The Growing Scourge of Counterfeiting and Strategies to Tackle it," 2020
- International Trademark Association, Annual Meeting, "The Foreign Associate Relationship: Choosing and Working with the Best Local Counsel Around the World," 2016

Honors

- The Trademark Lawyer, Editorial Board
- World Trademark Review, WTR 1000
- Who's Who Legal, The World's Leading Trademark Professionals
- Trademark Expert Guide, Euromoney
- Super Lawyers
- IP Stars, Managing IP
- World Intellectual Property Review (WIPR) Leaders
- Practical Law, Cross-Border Expert Panel
- International Trademark Association, IP Law Firm of the Future Task Force Member
- WTR Trademark Elite Panelist
- Best Lawyers in America

Selected Speaking Engagements (continued)

- Strafford Webcast, "Trademark Applications Pre-Filing Strategies: Overcoming the Obstacles," 2014
- Intellectual Property Law Section of the New York State Bar Association, Annual Meeting, "Initiatives to Address Trademark Bullying," 2012
- Intellectual Property Owners Educational Foundation, 21st Annual Conference, "USPTO Law and Practice, Signature Requirements before the Trademark Office," 2010
- The Association of Patent Law Firms, Annual Meeting, "Managing the Intellectual Property Law Department," 2007
- International Trademark Association, Roundtable Event, "Developments in Fraud Upon the U.S. Patent and Trademark Office," 2006
- Cardozo Law School, CTM Update, "Enlargement of the European Community and its Effect on European Community Trademark Practice," 2005
- New York State Bar Association, Intellectual Property Law Section Fall Meeting, "The Anatomy of a Grey Market Case," 2003
- International Trademark Association, Basics of International Trademark Practice, "A World Overview of Filing and Prosecuting Trademark Applications," 2000
- New York State Bar Association and Fordham Law School, "Trademark Vigilance in the Twenty-First Century: A Pragmatic Approach," 1999
- New York State Bar Association and Fordham Law School, "Trademark Prosecution in the Patent and Trademark Office and Litigation in the Trademark Trial and Appeal Board," 1998

Selected Cases & Matters

- In re Jonathan Sibony, 2021 WL 4812119 (T.T.A.B. 2021)
- New York Quality Healthcare Corporation d/b/a Fidelis Care v. Fiodor Kostrovitsky, FA2005001897449 (N.A.F. 2020)
- In re Don't Run Out, Inc., Serial No. 87344127 (T.T.A.B. 2019)
- Leason Ellis LLP v. Patent & Trademark Association Inc., 7:17-cv-05185 (S.D.N.Y. 2017)
- Zealot Productions Inc. v. Zealot Networks Inc., 1:15-cv-03928 (S.D.N.Y. 2015)
- Honeywell International Inc. v. KKT Commercial Vehicle Systems LLC, Case No. DIR2015-0014 (WIPO 2015)
- The Gameologist Group, LLC v. Scientific Games International, Inc., 838 F.Supp.2d 141 (S.D.N.Y. 2011), *aff'd.*, 508 Fed.Appx. 31 (2d Cir. 2013)
- SDI Technologies Inc. v. Kim Cook, FA1203001436742 (N.A.F. 2012)
- Honeywell International Inc. v. Celeris Controls, FA1010001351938 (N.A.F. 2010)
- Novartis AG v. Cera Products, Inc., 2009 WL 871661 (T.T.A.B. 2009)
- Intersearch Worldwide Ltd. v. Intersearch Group, Inc., 544 F.Supp.2d 949 (N.D. Cal. 2008)
- Odegard, Inc. v. Safavieh Carpets, Inc., 398 F. Supp. 2d 275 (S.D.N.Y. 2005)
- Novartis International Pharmaceutical Ltd. v. Genetic Immunity, LLC, 2004 WL 390941 (T.T.A.B. 2004)
- In re Iberia, Lineas Aereas de Espana, S.A., 2001 WL 984581 (T.T.A.B. 2001)
- In re Ziff-Davis Publishing Company, 2000 WL 574604 (T.T.A.B. 2000)
- Ermenegildo Zegna Corporation v. Lanificio Mario Zegna S.P.A., 1996 WL 721079 (S.D.N.Y. 1996)