

Anthony F. Lo Cicero Partner



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An engineer by training, Anthony Lo Cicero has represented companies in patent and trademark litigation involving product areas as diverse as e-commerce platforms, angular rate sensors, camcorders and flat panel displays. He conducts due diligence of IP portfolios and provides strategic patent counseling to companies in a wide range of industries from recorded and published music to consumer electronics. Most recently, he was the President of the New York Intellectual Property Association.

Very sophisticated technology competes with style and price as key aspects of the customer experience in the fashion industry. Mr. Lo Cicero represents some of the most prominent brick-and-mortar and on-line retailers in the country in patent disputes relating to the enterprise's e-commerce, mobile and point of sale systems. The retail industry regularly confronts patent assertions involving mobile platforms, electronic merchandise presentation, billing, marketing, inventory management and other features of the 21st century marketplace. Mr. Lo Cicero evaluates and responds to these assertions in a practical, business-oriented manner. Mr. Lo Cicero also evaluates contractual terms with vendors and suppliers to mitigate liability and works with retailers to identify and obtain protection for their own innovations. He has assisted retailers in successfully pursuing indemnification claims ranging to seven-figure settlements.

Restaurants, financial institutions, insurance companies, health care institutions, consumer product manufacturers and other businesses likewise rely on technology to bind customers, improve the customer experience, differentiate themselves and stimulate demand. Mr. Lo Cicero advises clients on freedom to operate issues, prosecutes patents and defends them in litigation.

Many of the most prestigious apparel manufacturers and retailers in the world, along with financial services, food products, computer, consumer electronics, home products, and toy companies also turn to Mr. Lo Cicero for trademark protection. He advances brand development and enforcement strategies ranging from anti-counterfeiting and trademark infringement protection to trade dress and Internet domain matters. For example, he overcame significant legal obstacles to protecting a name and symbol for what is now one of the best-known prestige brands in the country. On many occasions, he has been called upon to enforce trademark rights for entities that do not have the advantage of a federal trademark registration.

In the public sector, Mr. Lo Cicero has been active in advocating responsible patent reform and he was actively involved in shaping the Trademark Anti-counterfeiting Act of 1984, and served on the board of the International Anti-counterfeiting Coalition during seminal efforts to strengthen the protection of federal and state laws, including Customs laws, to counteract counterfeiting. He is also effective at marshalling law enforcement agencies in

the United States and other countries to disrupt and dismantle counterfeiting operations harming his clients' rights. For example, counterfeit toner cartridges were adversely impacting the profitability of a major printer manufacturer; he coordinated Customs and law enforcement in the United States and abroad, obtained seizure orders and mitigated the problem. Similarly, he represents companies based in Europe, Asia and Latin America in protecting their trademark rights in the United States.

An important element of Mr. Lo Cicero's work is transactional and results in monetizing a client's IP through a sale or license agreement. Knowledgeable of customs and terms in a wide variety of industries, he counsels clients on structuring and pricing transactions when the IP is the key value of an enterprise.

Mr. Lo Cicero is immediate past President of the New York Intellectual Property Law Association. He also serves on the Board of Directors of Education for Music, a not-for-profit institution bringing music education and its attendant benefits to inner city children. He is a frequent speaker on issues of patent infringement, trademark dilution, anti-counterfeiting, arbitration, intellectual property damages and recovery, domain name disputes and Internet-related issues. He has been named a "Super Lawyer" for Intellectual Property and is included in IP Stars.

EDUCATION

- Brooklyn Law School, Brooklyn, NY, J.D., cum laude, 1975
- Polytechnic University, Brooklyn, NY, B.S.E.E., cum laude, 1972

CERTIFICATION AND SPECIALTIES

- Registered Patent Agent, United States Patent and Trademark Office, 1977

PROFESSIONAL ASSOCIATIONS & MEMBERSHIPS

- New York Intellectual Property Law Association (Current President; Board Member 2007-10; Chairman, Patent Litigation Committee 2010-11, Officer (2011-2014), President (2014-2015))
- International Anti counterfeiting Coalition (Member, Board of Directors 1993-2005)
- New York State and American Bar Associations
- Education Through Music (Member, Board of Directors 2008-2012)

AWARDS & HONORS

- Intellectual Property, *Super Lawyer*, 2011, 2012, 2013, 2014
- IP Star
- Highest AV Preeminent Professional Rating (5 out of 5), *Martindale-Hubbell Law Directory*

REPRESENTATIVE CASES

- In re Application of LPKF Laser & Elecs. AG for an Order to Conduct Discovery for Use in a Foreign Legal Proceeding pursuant to 28 U.S.C. §1782, 2015 U.S. Dist. LEXIS 4748 (N.D. II. 2015)
- *Perfect Pearl v Majestic Pearl Store, Inc.*, (SDNY 2012)
- *Barnhart v. Federated Department Stores, Inc.*, 715 U.S.P.Q.2d (BNA) 1184, (SDNY 2005)
- *BEI Techs. v. Matsushita Electric Industrial Co.*, 268 F.Supp.2d 782, (SDNY 2005)
- *Paco Sport, Ltd. v. Paco Rabanne Perfumes*, (2nd Cir. 2000)
- *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, (5th Cir. 2000)
- *Polo Ralph Lauren, L.P. v. Schuman*, 46 U.S.P.Q.2d (BNA) 1046, United States District Court for the Southern District of Texas, Houston Division, 1998

REPRESENTATIVE CASES CONT.

- *Westchester Media Co. L.P. v. PRL USA Holdings, Inc.*, 1998 U.S. Dist. LEXIS 11737, United States District Court for the Southern District of Texas, Houston Division, 1998
- *Hoechst Celanese Corp. v. Nylon Eng'g Resins*, 1997 U.S. Dist. LEXIS 16339, (M.D. Fla 1997)
- *United States Polo Assn., Inc. v. Polo Fashions, Inc.*, 1984 U.S. Dist. LEXIS 21908, (SDNY 1984)
- *Mattel, Inc. v. Azrak-Hamway International, Inc.*, 724 F.2d 357, United States Court of Appeals for the Second Circuit, 1983

BAR ADMISSIONS

- U.S. Supreme Court, 1982
- U.S. Court of Appeals for the Federal Circuit, 1982
- New York, 1976
- U.S. District Court Southern District of New York, 1976
- U.S. District Court Eastern District of New York, 1976
- U.S. Court of Appeals for the Second Circuit, 1979

AMICUS BRIEFS

- Brief Of Amici Curiae, In re Cuozzo Speed Technologies, LLC, V. *Michelle L. Lee, Director, U.S. Patent and Trademark Office.* (U.S. April 16, 2015)
- Brief Of Amici Curiae, In *Stephen Kimble And Robert Michael Grabb V. Marvel Interprises, Inc.,* (U.S. February. 04, 2015)
February 4, 2015
- Brief of Amici Curiae, in *B & B Hardware, Inc. v. Hargis Industries, Inc.,* (U.S. October. 31, 2014)
October 31, 2014
- Brief of New York Intellectual Property Law Association as *Amicus Curiae* in Support of Neither Party, Alice Corporation PTY. LTD., v. CLS Bank International, et al., (U.S. Jan. 29, 2014)
January 29, 2014
- Brief of New York Intellectual Property Law Association as *Amicus Curiae* in Support of Neither Party: Highmark Inc., v. Allcare Health Management Systems, Inc., (U.S. Dec. 09, 2013)
December 9, 2013
- Brief of New York Intellectual Property Law Association as *Amicus Curiae* in Support of Neither Party: Octane Fitness, LLC., v. Icon Health & Fitness, Inc., (U.S. Dec. 09, 2013)
December 9, 2013
- Brief for *Amicus Curiae* New York Intellectual Property Law Association in Association for Alice Corporation PTY. LTD. v. CLS Bank International, *et al.,* (U.S. Oct. 07, 2013)
October 7, 2013

AMICUS BRIEFS CONT.

- Brief for *Amicus Curiae* New York Intellectual Property Law Association in Association for Molecular Pathology v. Myriad Genetics, Inc. (U.S. Mar. 14, 2013)
March 15, 2013
- Brief for *Amicus Curiae* New York Intellectual Property Association in CLS Bank International v. Alice Corp. Pty. Ltd. (Fed. Cir. December 07, 2012)
December 7, 2012
- Brief for Amicus Curiae New York Intellectual Property Law Association in Support of Neither Party in Association for Molecular v. PTO (Fed. Cir. June 15, 2012)
June 18, 2012
- Brief of Amicus Curaie NYIPLA in Mayo Collaborative Services (D/B/A Mayo Medical Laboratories) and Mayo Clinic Rochester, Petitioners, v. Prometheus Laboratories, Inc., (Sup. Ct. September 8, 2011)
September 8, 2011
- Brief for Amici Curiae Double Rock Corporation, Island Intellectual Property LLC, LIDs Capital LLC, Intrasweep LLC, Access Control Advantage, Inc., Ecomp Consultants, Pipeline Trading Systems LLC, Rearden Capital Corporation, Craig Mowry and PCT Capital LLC in Support of Petitioners, Bernard L. Bilski and Rand A. Warsaw v. John J. Doll, Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office, Docket No. 08-964, (Sup. Ct. Aug. 6, 2009)
August 6, 2009

AMICUS BRIEFS CONT.

- Brief For Amici Curiae Reserve Management Corporation, PCT Capital LLC, Rearden Capital Corp. And Sales Optimization Group In Support Of Maintaining State Street and AT&T in In Re Bernard L. Bilski and Rand A. Warsaw, Appeal No. 2007-1130 (Fed. Cir. Apr. 4, 2008)
April 1, 2008

PUBLISHED WORKS

- ARE Trademark Law Alert: Supreme Court Holds TTAB Decisions May Have Preclusive Effects
- ARE Patent Law Alert: International Trade Commission ALJ Finds No Standing For Non-Practicing Entity With Only Revenue Driven License Agreements
- ARE Patent Law Alert: Supreme Court Finds Alice's Computer Implemented Claims To Be Patent-Ineligible Under 35 U.S.C § 101 As An Abstract Idea
- ARE Patent Law Alert: Supreme Court Relaxes Standards for Awarding Attorney Fees Under 35 U.S.C. § 285 in Patent Cases
April 29, 2014
- ARE Patent Litigation Alert: Judge Robinson of District of Delaware Implements Revised Patent Case Scheduling Order
April 2, 2014
- ARE Patent Litigation Alert: Eastern District of Texas Adopts An Optional Track B Case Management Procedure
March 3, 2014

PUBLISHED WORKS CONT. PUBLISHED WORKS CONT.

- **ARE Copyright Law Alert: Second Circuit Clarifies Digital Millenium Copyright Act's Safe Harbor Provisions In *Viacom International, Inc. v. Youtube, Inc.* Decision**
April 18, 2012
- **ARE Trademark Law Alert: Fourth Circuit Revives Rosetta Stone Case Against Google's Keyword Searching**
April 13, 2012
- **ARE Patent Litigation Alert: NYIPLA Files Amicus Brief in *Mayo v. Prometheus***
September 8, 2011
- **ARE Patent Litigation Alert: *Centillion v. Qwest Communications*: Federal Circuit Held That "Use" of a System Means Use as a Whole and the User Must Derive Benefit From It**
January 31, 2011
- **ARE Trademark Law Alert: Facebook To Offer Personalized URLs**
June 9, 2009
- ***Tiffany (NJ) Inc. v. eBay Inc.*: Guidelines for Online Retailers to Police Third Party Sales of Counterfeit Goods**
Common Law Journal, July 29, 2008
- **HearSay: I Got it on eBay...(Audio interview excerpt)**
HearSay with Cathy Lewis, July 18, 2008, WHRV
- ***Tiffany v. eBay*: Trademark Owners Beware**
IP Law360, July 16, 2008
- **Q&A With Amster Rothstein & Ebenstein's Anthony F. Lo Cicero**
IP Law360, September 21, 2007
- **Refining In U.S. Patent Law For Software**
IP Law360, May 7, 2007

- **Courts Write History on Permanent Injunctions In Patent Actions**
IP Law360, August 22, 2006, Guest Column

IN THE PRESS

- **In The Press: 5 ARE Attorneys Named *Super Lawyers* Again**
- Super Lawyers, October 8, 2014
- **In The Press: Amster, Rothstein & Ebenstein LLP is pleased to announced that partners Daniel Ebenstein, Anthony F. Lo Cicero and Charles R. Macedo have been named IP Stars by Managing IP for 2013**
Managing Intellectual Property IP Handbook, www.miphandbook.com
- **In the Press: Super Lawyers names partners Anthony F. Lo Cicero and Charles R. Macedo for 2012**
New York — Metro 2012 Intellectual Property Super Lawyers
- **In the Press: 'T-minus' Buffet enters the private placement biz**
- Investment News, December 2, 2011
- **In the Press: Super Lawyers names partners Anthony F. Lo Cicero and Charles R. Macedo**
New York — Metro 2011 Intellectual Property Super Lawyers