

chapman | spingola

Peter M. Spingola
Phone | (312) 606-8754
E-mail | pspingola@chapmanspingola.com

“ Peter is a sharp, aggressive trial lawyer who does not pay lip service to the job. I know I can count on him to provide me with clear advice and secure the result that meets Accel-KKR's business objectives.”

- Rob Palumbo, Managing Director
Accel-KKR

Peter M. Spingola | Partner



My team and I handle sophisticated matters and complex litigation at the highest level against adversaries from some of the largest national firms. We offer clients the best of working with a boutique firm, with unmatched responsiveness, an intense focus and a custom approach to every matter.

While we work to avoid litigation, we are skilled advocates in the courtroom and will aggressively defend our clients' interests.

My practice includes intellectual property litigation and transactions, as well as high-stakes complex commercial litigation. I have also developed a niche in legal malpractice actions that arise out of mishandled intellectual property.

Representative IP Cases

I have obtained important results for clients in high-stakes intellectual property litigation and transactions. Regardless of whether we represent the plaintiff or the defendant, our approach on each case is to get ready for trial as quickly as possible. Our team has an outstanding record of obtaining plaintiff-client objectives, either creating a revenue stream from licensing out their technology or protecting their assets by stopping the infringement. We have been equally successful representing defendant-clients accused of violating intellectual property rights. While our plaintiff-clients have enjoyed settlements and judgments totaling millions of dollars, our defendant-clients have saved many millions of dollars as well.

- Successfully defended client software company from claim that the company was obligated to indemnify customer for patent infringement. The patent infringement and

indemnity claims were resolved **without our client having to contribute any money towards resolution.**

- I first chaired a bench trial in Delaware Chancery Court at which our intellectual property trial team prosecuted claims of misappropriation of intellectual property, breach of fiduciary duty and aiding and abetting breach of fiduciary duty. We secured judicial findings of breach of fiduciary duty, aiding and abetting, fraudulent misappropriation of intellectual property and conspiracy to defraud and fraudulent accounting of funds. The Vice Chancellor ordered the **imposition of a constructive trust** over the stolen assets and an unwinding of the fraudulent transfer.
- I first chaired an arbitration in which our client, a software licensee, sought an injunction forcing the software developer to comply with his obligations under a software development agreement to escrow the developed source code. The Arbitrator **ordered the software developer to execute a software escrow agreement and to deposit the source code into escrow.**
- Chapman Spingola was hired to take over the handling of emergency injunction proceedings concerning a federal trademark lawsuit pending in the United States District Court for the Northern District of Illinois. Through a creative litigation and transactional strategy, our team was able to **quickly secure important trademark rights** for our client that assured **continued market share** without the need for protracted and expensive litigation.

- Our patent infringement team recently reached settlement on behalf of a software company accused of infringing a series of patents asserted by a non-practicing entity. Our team **quickly dissected the issues of infringement and validity** which created momentum for **quick resolution** for our client before the expenditure of material attorney's fees in a case pending in the District Court of Delaware.
- Defeated summary judgment on the issue of lack of personal jurisdiction based on the conspiracy theory of jurisdiction in a case pending before a Delaware Chancery Court.
- Our team designed and executed a litigation strategy and settlement structure for technology genius Swift Engineering, Inc. that **netted Swift \$22 million** in an infringement dispute concerning two Fortune 500 defense contractors.
- Our team was hired to defend the industry-leader in industrial storage equipment design (used by big-box stores like Home Depot and Lowes) against a claim that certain industrial equipment infringed the patent of a Canadian company. After obtaining favorable claim construction rulings, we were able to construct a solid non-infringement defense through expert testimony, and uncovered other defense theories that threatened to render the asserted patent unenforceable and allow our client to recover its attorney's fees in the face of plaintiff's \$63 million claim for damages. After several years of litigation, the case was dismissed with prejudice – **no injunction ever issued and no money damages were awarded.**
- Our firm **successfully defended a technology company against an opposition action** before the **Trademark Trial and Appeal Board**. Following the parties' completion of written discovery, we negotiated a settlement whereby our client made nominal, nonmaterial changes to the description of its product in exchange for petitioner's **dismissal of its opposition action with prejudice.**
- Chapman Spingola successfully represented a technology company in bringing suit against the dominant companies in its industry for **antitrust violations, civil conspiracy** and **unfair competition** in the United States District Court for the Northern District of Texas. After one year of litigation, we were able to obtain favorable settlements with each defendant, which included lucrative services contracts on a going-forward basis between our client and one of the defendants.
- Wholesale stamp manufacturer and distributor selected the Chapman Spingola intellectual property group to vigorously prosecute a series of patent infringement claims against competitors in the industry. After sending a series of cease and desist letters and filing three separate suits in the Northern District of Illinois, we were able to effect a **global resolution of claims** that resulted in a favorable settlement for our client.

- Our litigation team was recently hired to defend a **software company** against claims that its **image recognition technology infringes one or more patents**. The case was brought in the Eastern District of Texas. After one year of litigation, the case settled for a nominal amount.
- We defended a **government subcontractor** against claims for breach of contract and declaratory judgment before the American Arbitration Association. We asserted counterclaims for **breach of contract, misappropriation of trade secrets, trademark infringement** and **unfair competition**. After less than one year of litigation and approximately 3 weeks prior to hearing, we were able to obtain a \$1 million settlement in our client's favor.
- A well-known online retailer hired our team to defend against copyright infringement, trademark infringement, unfair competition and trade dress claims asserted in a federal district court in Tampa, Florida. After one year of litigation, **the case was settled for a nominal amount**.
- A well-known international jewelry manufacturer and supplier hired Chapman Spingola to assert patent infringement claims against competitors who were using patented diamond settings without authorization to do so. We filed the first of these infringement claims in the Northern District of Illinois, and within a few months and after a day-long presentation of evidence, the **defendant agreed to cease and desist** from further infringement, in addition to other confidential terms of settlement.
- I represented a Fortune 100 investment bank accused of multi-million dollar patent and copyright infringement by a Fortune 100 computer giant in developing a litigation and settlement strategy designed to induce the patent holder to resolve claims through a license agreement. After twelve months of intense negotiations concerning the asserted claims of seven different patents, **the case was amicably resolved** through a global settlement of all claims.
- A former officer of catalog-giant Spiegel hired our team to defend against claims of copyright infringement and RICO violations asserted in a Chicago federal court. After filing several motions to dismiss that narrowed the scope of the asserted claims, and after presenting the defendant officer for deposition, the **defendant officer was voluntarily dismissed** from the case.

Intellectual Property Issues that Collide with Bankruptcy, Antitrust or Malpractice Claims

One of the unique aspects of my practice is advising on the intellectual property issues that arise at the intersection of bankruptcy law, antitrust law and legal malpractice litigation. The unique combination of my partner Bob Chapman's legal malpractice experience and my intellectual property practice has positioned our firm as the "go-to firm" for legal malpractice actions that arise out of mishandled intellectual property litigation and transactions.

- We were retained as successor counsel to litigate a plaintiff's legal malpractice claim against one of the most successful IP firms in the country. The malpractice case arose out of an allegedly mishandled patent infringement trial where a \$12 million verdict was knocked down to \$2 million. After dissecting the trial testimony and closing arguments, we developed a theory of **trial negligence and damages (in excess of \$12 million)** that caused the case to settle for a confidential amount.
- A family-owned technology business hired our team six months prior to trial of its legal malpractice claim in a Madison, Wisconsin state court. The claim arose out of the defendant patent law firm's failure to timely pay the required fees to the United States Patent and Trademark Office in order to maintain the enforceability of the technology business' key patents. After opening statements and one day of testimony, the case **settled for a confidential amount**.
- The world's largest manufacturer of projection screens hired our team to bring a legal malpractice action against a large Indiana law firm arising out of an allegedly mishandled cease and desist letter that resulted in an expensive patent infringement litigation. We filed the case in Indiana federal court, and **the dispute was amicably resolved** before the parties served their initial discovery requests.
- A Fortune 100 tool manufacturer hired me to **advise on the interplay of various patent infringement, patent licensing and antitrust issues** in order to avoid impending litigation.
- ISBA Mutual recently retained me as an **expert witness** for the defense in a legal malpractice claim brought against a Chicago firm who allegedly mishandled the prosecution of a **copyright infringement action** against Northwestern University concerning the construction of the Ford Engineering Design Center.

Heavy Weight Litigation

I am fortunate to have honed my trial skills after years of working alongside (and against) some of the nation's most experienced and successful trial lawyers, including Chapman Spingola's Senior Trial Counsel James P. Chapman, a member of the American College of Trial Lawyers. I have substantial brief writing and oral argument experience at the appellate court level, and have arbitrated claims before all the major arbitration tribunals, including the American Arbitration Association, FINRA (formerly NASD) and the National Futures Association. Once again, our results speak for themselves:

- We recently represented a **private equity firm** in bringing suit in the Commercial Division of New York County state court for **breach of contract** and **fraud** against the buyer of a software company. After eight months of litigation, we obtained a confidential **favorable settlement** on the client's behalf.
- I was retained to represent two high-net worth investors who lost millions in an elaborate scheme of unauthorized wire transfers and futures trading that was perpetrated through one of the largest clearing firms in the world. Through years of

hard-fought litigation, **we prepared the case for trial in such a way that caused the defendant to capitulate on the courthouse steps** one day before the opening statements were scheduled to begin at the National Futures Association. The case settled for a confidential amount.

- A defendant national real estate brokerage hired us to litigate several novel secured transaction issues arising out of a Master Assignment and Security Agreement that was being enforced against the real estate brokerage to recover the commissions of the brokerage's bankrupt independent contractor agents. We **obtained summary judgment on these issues at the trial court level**. I then **successfully argued the appeal** before a panel of the Illinois Appellate court, which affirmed the entry of summary judgment.
- An insurance giant settled a medical malpractice claim brought against one of its physician-insureds. After the settlement, this insurer pursued a subrogation claim against the physician seeking to recover the proceeds that had been paid out to settle the underlying malpractice case. We were retained exclusively to handle the subrogation claim. I prepared a motion for summary judgment, which was granted and upheld upon rehearing. The entire subrogation matter took **less than one year to resolve, and the defendant physician had zero liability to the insurer**.
- We brought and **obtained a temporary restraining order** in the Circuit Court of Cook County on behalf of international residential real estate brokerage which helped restrict investors from a hostile takeover of the business, lockout of controlling officers and directors and misappropriation of dozens of real estate agents.
- We recently won a **precedent-setting** motion for summary disposition in defense of **various statutory claims of unlawful debt collection** brought as a class action in the Circuit Court of Wayne County, Michigan.

Transaction Negotiations That Bring Liquidity to Litigation

In conjunction with my IP litigation practice, I have helped hundreds of private equity and Fortune 500 corporate clients with the intellectual property aspects of their multi-million dollar corporate transactions and commercial agreements. These transactions have included:

- Asset purchase agreements
- Merger agreements
- Patent, trademark, copyright, know-how and software licenses
- Information technology agreements
- Non-compete agreements
- Non-disclosure agreements
- Technology transfer agreements

- Transition services agreements
- Joint venture agreements
- Sponsorship agreements
- Distribution agreements
- Supply agreements
- Development agreements
- Outsourcing agreements
- Operating agreements
- Website development and hosting agreements
- Telecommunications contracts
- Manufacturing and installation agreements

Illinois Super Lawyers/Illinois Attorneys under 40 to Watch

- *Thomson Reuters* and the publishers of *Chicago Magazine* have selected me to the 2012, 2013, 2014, 2015 and 2016 Illinois Super Lawyers list. Super Lawyer selections are based on a rigorous, multi-phase selection process which includes peer nominations and evaluations combined with independent research.
- In 2009 the publisher of the *Chicago Daily Law Bulletin* and *Chicago Lawyer* selected me as one of the “2009 40 Illinois Attorneys under 40 to Watch.” I was one of 800 lawyers in Illinois nominated for this prestigious group, and was chosen as one of the top 40 based upon detailed peer reviews submitted to the publishing company by, among others, co-counsel, opposing counsel, judges, mediators and general counsel.

Professional Activities

- Member of the Honorable Richard Linn IP Inn of Court
- Member of the Chicago Bar Association’s Committee on Intellectual Property (2006 Chair of that committee)
- Member of the ISBA Committee on Intellectual Property

Articles

- “Assignability of IP Licenses: Is Silence Really Golden,” 3:2 HASTINGS LAW JOURNAL 197 (Spring 2007)
- “After the Fall: What Happens to IP Licenses During Bankruptcy,” *IP Worldwide*, (August 2002)
- “Assignability of IP Licenses in Bankruptcy: Navigating the Murky Waters of Section 365,” *ABA Intellectual Property Law Newsletter*, (Fall 2002)

Speeches

- Defending Against IP “Non-Practicing Entities,” 2012 Honorable Richard Linn IP Inn of Court
- Protectability of Color by Trademark, 2012 Honorable Richard Linn IP Inn of Court
- Issues in Social Media, 2011 Honorable Richard Linn IP Inn of Court
- Preventing Legal Malpractice, 2011 Chicago Bar Association
- Conflicts of Interest in IP, 2010 Honorable Richard Linn IP Inn of Court
- Issues Concerning the Licensing of Intellectual Property, Chicago Bar Association

Education

- J.D., Chicago-Kent College of Law (Order of the Coif, *Chicago-Kent Law Review* and National Trial Advocacy Team)
- B.A., Dartmouth College

Community Service

- Governing Board of Boys Hope Girls Hope of Illinois
- Membership Committee of Park Ridge Country Club
- Programming Committee of First Tee of Greater Chicago
- Executive Committee of Saint Mary of the Angels School