chapman | spingola



Peter Spingola

Partner

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As the firm's co-founder, my practice focuses largely on intellectual property and technology litigation and transactions, including IP matters that intersect with antitrust, bankruptcy and legal malpractice. I also handle complex commercial litigation involving securities and common law fraud, shareholder appraisal litigation, banking, contract, real estate, and employment matters.

With over 20 years of legal practice, I have extensive experience as trial counsel in both jury and bench trials, as well as arbitrations, and have practiced in various state and federal venues including Delaware, Wisconsin, Utah, Michigan, North Carolina, California, Texas, New York, Pennsylvania, Illinois, Missouri, Indiana, and Kentucky.

I have successfully argued appeals in both the Illinois Appellate Court and the Seventh Circuit United State Court of Appeals and have participated in briefing before the United States Supreme Court.

In high-stakes IP and commercial litigation against adversaries from some of the largest national firms, I have obtained important results for clients. Similarly, I have helped hundreds of private equity and Fortune 500 corporate clients with the IP aspects of their multi-million dollar corporate transactions and commercial agreements.

Clients benefit from the best of working with a boutique firm with unmatched responsiveness, an intense focus and a custom approach to every matter. We are skilled advocates in the courtroom and in the boardroom and will aggressively defend our clients' interests.

I am a member of the United States District Court Trial Bar. I have received the AV Preeminent Peer Review Rating from Martindale-Hubbell and have been recognized as an Illinois Super Lawyer since 2012.

Prior to co-founding Chapman Spingola in 2004, I was a member of the Kirkland & Ellis LLP law firm, where I focused on technology litigation and transactions for Fortune 100 companies.

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

Representative Intellectual Property Cases

- I was retained to represent a manufacturer/distributor of specialty medical equipment in connection with its supplier's breach of an exclusive distribution agreement and various IP infringement claims in an Illinois federal court. After summary judgment on liability was entered against the supplier, I tried the damages case before Judge Robert Dow obtaining a seven-figure judgment, which, after arguing before the Seventh Circuit United States Court of Appeals, was affirmed. We collected the full judgment amount plus interest within a month of the Seventh Circuit's ruling.
- I defended a Fortune 100 automobile manufacturer against claims of patent infringement pending in a Michigan federal court. The defense involved multiple patents, hundreds of claims, and complex litigation impacted by not only IPR proceedings before the United States Patent & Trademark Office but also an administrative hearing before the International Trade Commission. After a few days of trial, the case settled for a confidential amount.

- I designed and executed a litigation strategy and settlement structure for technology company Swift Engineering, Inc. that netted Swift $22 million in an infringement dispute concerning two Fortune 500 defense contractors.

- I defended a software engineer in a partnership dispute that involved alleged violations of the federal Computer Fraud and Abuse Act and the Stored Communications Act and secured a $5.6 million settlement for the client.

- I defended a software as a service ("SAAS") company from a multi-million dollar appraisal claim in the Delaware Court of Chancery arising out of a "going private" merger transaction. The case settled for a confidential amount on the eve of trial.
- I successfully defended a software company from the 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 tried 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 was retained to defend a manufacturer/distributor of medical equipment in a federal lawsuit in which an array of trademark, copyright and common law unfair competition claims were asserted. In connection with various pleading motions, I obtained dismissal with prejudice of all claims.

- I handled an evidentiary hearing before the American Arbitration Association 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.

- I 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.

- I reached a 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.

- I defeated a 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.

- I 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.

- I 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.

- I was selected by a wholesale stamp manufacturer and distributor 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 affect a global resolution of claims that resulted in a favorable settlement for our client.

- I 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.

- I was 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.

- I 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.

- I was hired by a well-known online retailer 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.

- I was hired by a well-known international jewelry manufacturer and supplier 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 daylong 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.

- I was hired by a former officer of catalog-giant Spiegel 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

- I was 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.

- I was hired by a family-owned technology business 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.

- I was hired by the world's largest manufacturer of projection screens 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 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 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 were 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.

- I defended a software company from multi-million dollar appraisal allegations in Delaware Chancery Court that a merger transaction did not provide fair value to the software company's minority shareholders. The case settled for a confidential amount on the eve of trial.

- I was hired by a defendant national real estate brokerage 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-insured's. 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. I was retained 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.

- I 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.

- I 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

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

Awards/Honors

- Martindale Hubbell conducted a peer review of Peter in which he was awarded the AV Preeminent Peer Review Rating, the highest possible rating given to those attorneys who possess the highest level of legal ability and professional ethics.

- Thomson Reuters and the publishers of Chicago Magazine have selected me to the Illinois Super Lawyers list every year since 2012. 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 United States District Court Trial Bar for the Northern District of Illinois, which is required in order to appear as lead counsel at testimonial proceedings and requires me to provide pro bono representation to court-appointed clients (e.g., prisoner's rights cases).

- Member of the Illinois State Bar Association and the Chicago Bar Association and has served on various committees for those groups.

- Member of the Board of Directors of Park Ridge Community Bank (2019 to present).

- Member of the Chicago Bar Association's Committee on Intellectual Property (2006 Chair of that committee)

- Member of the ISBA Committee on Intellectual Property

- Founding member of the Honorable Richard Linn IP Inn of Court and served as the Treasurer on the Board of Directors (2013).

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

Community Involvement

- Board of Directors of Northridge Preparatory School (2017 to present)
- Board of Directors of Embers Academy (2017 to present)
- Advisory Board of Boys Hope Girls Hope of Illinois (2004 to present)
- Executive Committee of Saint Mary of the Angels School (2015 to present)
- Board of Directors of First Tee of Greater Chicago (2012-2014)