

Curriculum Vitae  
Of  
Thomas L. Peterson, Esq.

May, 2021

**INTRODUCTION**

**Mr. Peterson** has been in private law practice for more than 30 years and advises clients in a wide range of legal and business matters. His primary focus is intellectual property: patents, trademarks, copyrights and trade secret causes.

He has represented numerous Fortune 500 companies, including Toshiba Corporation, Scientific-Atlanta, Georgia-Pacific, Nike, Campbell Soup Company, and Bell Atlantic (now Verizon). Over the years, he has also counseled many small and start-up companies from formation through funding, launch and operations.

In addition to advising clients, Mr. Peterson has taught as an adjunct professor of law at the George Mason University School of Law and the Howard University School of Law. He has also participated in many panel discussions before law and business groups related to intellectual property. In addition to his law practice, he is an Assistant Professor in the field of business law at the Northern Virginia Community College in Annandale, VA.

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**PRACTICE AREAS**

All areas of intellectual property law.

**EDUCATION**

J.D., Cleveland-Marshall College of Law  
B.S., Youngtown State University, Electrical Engineering

## **BAR ADMISSIONS**

United States Supreme Court  
US District Court for the District of Columbia  
District of Columbia Court of Appeals  
United States Patent and Trademark Office

## **SUMMARY OF PROFESSIONAL ACTIVITIES AND AFFILIATIONS**

1. **Electrical Engineer**  
Packard Electric Division  
General Motors Corporation
2. **Patent Examiner**  
United States Patent and Trademark Office
3. **Of Counsel**  
Burgher Gray LLP  
New York, NY
4. **Assistant Professor**  
Northern Virginia Community College (Annandale Campus)

Please see the attached addendum for information on Mr. Peterson's experience in intellectual property law areas that may be of specific interest to you.

## Addendum to Curriculum Vitae of Thomas L. Peterson

### Copyright Practice

Copyrights protect the expression of an idea by granting certain exclusive rights to the author that allows the author to protect his or her creative work against theft.

A copyright entails two types of rights: economic rights and moral rights. Economic rights are the ones that matter in most cases and form the majority of a copyright holder's rights. In U.S. copyright law, they are set out at 17 U.S. Code §§ 107 – 122. It is ownership of the economic rights that allow one to profit from copyrighted works, such as the protection of computer software.

Moral rights protect an author's honor and reputation. In the U.S., these rights are set forth in 17 U.S. Code § 106A. By definition moral rights cannot be transferred from the original author, i.e., the one who created the work.

#### Computer Software

As economies and business practices move more toward the digital age the importance of computer software cannot be overestimated. In many cases, computer software is relied on to provide a competitive edge. Protecting that edge often falls to copyright law.

#### Works-for-Hire

Today, most software development is “farmed” out to software developments shops as a work-for-hire. Large and more established development shops understand and accept the reality that ownership of the copyrighted works that they create must be transferred to their clients. U.S. copyright law requires that this transfer be in writing. When transferred in this way, the client is presumed to be the author and is thus entitled to the exclusion rights to the software that copyright protection provides.

Complications often arise, however, when free-lance developers are hired to develop a software project. Such developers typically work on their own and are not associated with an entity that provides structure and obedience to legal protocols. This is a common practice in the software development world and in other areas where a particular skill of an individual is the premium being sought and paid for. Typically, such a practice is not burdened by formal engagement contracts and detailed scopes of work that a normal company structure would require. The informality of such a practice usually means that legally sufficient work-for-hire agreements are not entered into that would allow the client to later claim authorship and subsequent copyright protection for the software.

Other works protected by copyrights include:

databases;

literary works;

musical works, including any accompanying words;

dramatic works, including any accompanying music;

pantomimes and choreographic works;

pictorial, graphic and sculptural works;

motion pictures and other audiovisual works;

sound recordings; and

architectural plans, drawings and actual buildings.

Mr. Peterson advises clients in all of the above areas. He focuses a great deal on software related issues, especially with respect to avoiding work-for-hire issues and addressing them when they occur. He also advises clients on copyright registration and infringement matters as well.

### **Patent Practice**

Mr. Peterson has written and prosecuted several hundred patent applications in the U.S. and abroad during the course of his career.

Patents are a tool of business and the award of an effective patent begins with the patent attorney knowing the client's business and understanding the client's business objectives. This is then followed by the attorney gaining a solid understanding of the invention and the prior art. With that background, the process of drafting a patent application can begin.

While the patent application is being prosecuted in the Patent Office, it is important to remain mindful that the value of a patent is its ability to prevent others, for a limited time, from making, using or selling the patented invention without the patent owner's permission. This ability can be severely curtailed during the course of prosecution if care is not taken. For this reason, it is important that the attorney and the client work together during all phases of the patent procurement process.

The component parts of Mr. Peterson's patent practice include:

1. Conducting patentability searches and rendering patentability opinions;
2. Conducting patent validity searches and rendering patent validity opinions;

3. Conducting patent infringement searches and rendering patent clearance opinions;
4. Reviewing and commenting on patent infringement allegations;
5. Drafting and/or commenting on non-disclosure and non-compete agreements;
6. Drafting and/or commenting on patent license agreements;
7. Drafting and/or commenting on work for hire agreements;
8. Conducting patent landscape analysis;
9. Patent ownership disputes; and
10. General client counseling on all patent law issues.

### **Trademark Practice**

The key to effectively protection and growth of a client's trademark portfolio, and more specifically its branding, is to know the client's business and to understand the client's objectives. Based on this knowledge, an effective strategy can be put in place toward that end. Such a strategy should be both proactive and reactive.

The strategy should include:

- a. Aggressive and well-thought out registration of trademark rights that cover all of the client's geographic and commercial markets. The description of goods and services for each mark must encompass a scope that gives the client effective likelihood of confusion arguments against subsequent trademarks and other branding of competitors;
- b. Liberal use of intent-to-use filings where possible;
- c. A diligent pre-filing investigation to uncover trademark-killer issues that might otherwise come up after a mark has been registered and reputation and good will have attached. Such an investigation lessens the likelihood of a successful opposition or cancellation proceeding against the client's mark. Moreover, such an investigation increases the likelihood that the registered mark will qualify for incontestable status after five years;
- d. Engaging a watch service to report the trademark filing activity of third parties where there is the potential of likelihood of confusion issues arising;
- e. Engaging a watch service to monitor domain name registrations of third parties where there is the potential of likelihood of confusion issues arising with respect to the client's trademarks;
- f. Following up on third party activity noted by the watch services;

- g. Periodic review of the client's trademark portfolio to be sure that the client's goods and services have not morphed away from their description in the trademark registration. In other words, be sure that the registered mark still covers the goods and services currently being sold;
- h. Timely payment of trademark renewal fees;
- i. Taking advantage of trademark dilution laws when available;
- j. Registering branding tag lines and other promotional materials as copyrights; and
- k. Seeking patent protection where feasible as an adjunct to trademark and copyright protection.

In assisting clients in carrying out the above noted strategies, Mr. Peterson has extensive experience in:

- a. Pre-filing trademark searches and opinions;
- b. Consultation with respect to selection of trademark filing classes;
- c. Consultation with respect to the actual word mark and/or logo to be registered;
- d. Filing and prosecuting trademark applications in the U.S. Patent and Trademark Office and, with the assistance of associate counsel, in foreign countries;
- e. Calendaring trademark renewal dates;
- f. Attending to payment of renewal fees;
- g. Conducting opposition and cancellation proceedings before the U.S. Patent and Trademark Office Trademark Trial and Appeal Board;
- h. In addition to opposition and cancellation proceedings, assisting in the resolution of other trademark disputes outside of the U.S. Patent and Trademark Office; and
- i. State and Federal trademark and related litigation.

### **Trade Secret Practice**

A trade secret is generally defined as information that is used in a company's business that:

- (a) is not known or readily accessible by competitors,

(b) has commercial value or that provides a competitive advantage in the marketplace, and

(c) the owner of the information protects it from disclosure through reasonable efforts to maintain its secrecy.

Mr. Peterson advises clients on all phrases of trade secret law, including cases of misappropriation of trade secrets.