

THEODORE K. CHENG

New York ♦ New Jersey ♦ Pennsylvania ♦ Connecticut



Theodore K. Cheng is a mediator and arbitrator, focusing on commercial, intellectual property (IP), entertainment, technology, and labor/employment disputes. He is a member of Resolute Systems' Employment and Commercial panels of arbitrators and mediators. Additionally, Mr. Cheng is a member of the Commercial and Large, Complex Case mediation and arbitration rosters of the American Arbitration Association (AAA), the Panel of Distinguished Neutrals of the CPR Institute, a FINRA arbitrator, and an arbitrator and mediator for several federal and state courts. He was also appointed to the Silicon Valley Arbitration & Mediation Center's List of the World's Leading Technology Neutrals. Mr. Cheng serves on the Council of the AAA and the Boards of the Justice Marie L. Garibaldi American Inn of Court for ADR, the New Jersey State Bar Association

Dispute Resolute Section, and the Association for Conflict Resolution—Greater New York Chapter. He is the Vice-Chair of the New York State Bar Association (NYSBA) Dispute Resolution Section and co-chairs its Mediation Committee. The *National Law Journal* named him a 2017 ADR Champion.

As a neutral, Mr. Cheng has conducted nearly 500 arbitrations, mediations, settlement discussions, and inquests involving commercial and business disputes, breach of contract and negligence actions, trade secret theft, employment discrimination claims, wage-and-hour disputes, and IP infringement contentions.

Representative matters as a MEDIATOR include:

- Wrongful discharge claims brought under an internal dispute resolution process maintained by a company in the food and hospitality industry
- Claim for unlawful termination based upon disability discrimination and retaliation brought by an executive in a financial services organization
- Claim for failure to reimburse advanced sales commissions pursuant to an employment contract
- FLSA claims for failure to pay minimum wage and overtime brought by a supermarket employee
- Claim for breach of a restrictive covenant in an employment agreement and counterclaim for tortious interference with economic advantage
- Patent infringement claims arising from the manufacture and sale of a competing furniture product
- Claims for trademark infringement and unfair business practices arising from the breach of a settlement agreement between two pharmaceutical companies relating to their competing skin cream products
- Breach of distributorship agreement for hair care products and accompanying claims of trademark infringement
- Trademark infringement claims brought by a Chinese restaurant against a competing restaurant opened by a departing chef
- Dispute between members of a limited liability company regarding continued funding for the entity and ownership of intellectual property
- Fair Debt Collection Practices Act claim relating to a foreclosure proceeding
- Miller Act claim brought by a subcontractor for failure by the contractor to pay for dredging work performed in the intercoastal waterways in New York Harbor

Representative matters as an ARBITRATOR include:

- Sole arbitrator on a \$10 million dispute over alleged unpaid licensing fees brought by vendor of software trading platform against a broker-dealer
- Sole arbitrator on a \$1.4 million dollar dispute brought by a record company executive for breach of an employment agreement, racial discrimination, and other related claims
- Sole arbitrator on a dispute alleging FLSA claims for failure to pay minimum wages and for compensable time brought by individual truck drivers
- Sole arbitrator on a dispute over the breach of a settlement agreement and trademark infringement and dilution claims pertaining to a collaborative venture to produce and promote a film in the health care industry
- Sole arbitrator on a \$400,000 dispute alleging breach of e-commerce services agreements
- Sole arbitrator on a dispute over the sale of a limited liability company interest in a restaurant
- Sole arbitrator on a dispute over the breach of an advertising insertion order
- Wing arbitrator on a multi-million dollar patent license dispute pertaining to the manufacture and sale of in-vehicle entertainment systems for cars
- Wing arbitrator on a \$14 million dispute alleging breach of a consulting agreement relating to a licensing arrangement in the jewelry industry
- Wing arbitrator on a \$8.5 million dispute alleging breach of confidentiality and theft of trade secrets arising from a distributorship arrangement and joint venture and sales relationship

Representative matters as an ADVOCATE include:

- Commenced a multi-million dollar FINRA arbitration on behalf of a broker-dealer against another broker-dealer over co-brokered initial public offerings
- Represented a Chinese manufacturer of machine parts and tools in a multi-million dollar ICDR arbitration over breach of contract, warranty, product liability, and other tort claims
- Provided research and analysis support to an ICC arbitrator in a \$130 million dispute over breach of a commercial contract
- Represented parties in numerous mediations before magistrate judges, special referees, and private neutrals in connection with commercial/business, intellectual property, and technology litigation matters

For over 20 years, Mr. Cheng was an IP and general commercial litigator with a focus on trademarks, copyrights, patents, and trade secrets, as well as entertainment, labor and employment, corporate investigations, securities, and bankruptcy. He has handled a broad array of business disputes in federal and state courts in industries as varied as high-tech, telecommunications, entertainment (music and motion pictures), consumer products, food and hospitality, retail, and financial services. Mr. Cheng serves as a Trustee of the Copyright Society of the U.S.A. and formerly co-chaired its New York Chapter. In 2007, he was named one of the Best Lawyers Under 40 by the National Asian Pacific American Bar Association.

Representative LITIGATED matters include:

- Tried fraud and breach of contract claims on behalf of an exploited investor, resulting in a \$2.4 million compensatory and punitive damages jury verdict
- Tried patent damages claim on behalf of a pharmaceutical company over an infringing animal vaccine, resulting in a favorable jury verdict
- Litigated copyright infringement actions brought by classes of songwriters and music publishers against unlicensed Internet file-sharing companies Grokster, Napster, Aimster, and Audiogalaxy, including proceedings in the federal circuit courts and the U.S. Supreme Court

- Briefed and argued a successful appeal before the Guam Supreme Court of a commercial lease dispute involving a worldwide restaurant franchisee
- Defended a test preparation company in resolving a copyright infringement suit brought by a trade association
- Defended a cell phone manufacturer in resolving a lawsuit alleging infringement of a copyrighted ringtone
- Defended and successfully resolved accusations of selling counterfeit goods over the Internet against an on-line retailer
- Successfully defended a software company against allegations of trademark infringement, dilution, and unfair competition brought by a purported senior mark owner
- Represented a manufacturer of a high-end household appliance in a lawsuit against competitor's false television infomercial
- Represented the patentee in industry-wide infringement lawsuits relating to pioneering methods for locating available real estate properties on a computer
- Represented a telecommunications company in a litigation campaign to enforce a patent relating to data compression algorithms
- Represented a defendant in a suit alleging claims for patent infringement, trademark infringement, copyright infringement, and theft of trade secrets over the design, development, and sale of a mass-marketed medical device

Representative NON-LITIGATED matters include:

- Apply for and secure trademark registrations on numerous well recognized brands for clients in a variety of industries, such as fashion, jewelry, physical fitness, health care products, automobile parts and accessories, accounting, consulting, legal services, software, and web-based businesses
- Conducted trademark portfolio due diligence in connection with the acquisition of a pharmaceutical company
- Advice regarding the transfer of patent and trademark assets in connection with the negotiation of a sales and distribution agreement regarding textile and garment products
- Conducted pre-publication review of a book for potential violations of non-disclosure agreements
- Drafted and negotiated a non-exclusive licensing agreement of patent rights owned by a major U.S. technology university (pertaining to ligands for metals and metal-catalyzed processes) to a Japanese commercial manufacturer to develop and sell licensed products and processes
- Drafted and negotiated a joint research and development agreement between German and U.S. manufacturers of scientific instruments
- Drafted and negotiated a sponsored research agreement between a German manufacturer of scientific instruments and a major North American university pertaining to certain licensed patented technology
- Drafted and negotiated a research and testing agreement between a U.S. technology university and a Japanese importer and distributor of specialty chemicals products manufactured by itself and its affiliated companies in Japan

Mr. Cheng was previously a marketing consultant at MetLife Insurance Company, with experience in life and health insurance, annuities, brokerage sales, structured settlements, and investments. During his tenure, he obtained his Chartered Life Underwriter, Chartered Financial Consultant, and Series 7 General Securities Representative designations. Mr. Cheng also previously served as a law clerk to the Honorable Julio M. Fuentes of the U.S. Court of Appeals for the Third Circuit and the Honorable Ronald L. Buckwalter of the U.S. District Court for the Eastern District of Pennsylvania.

Mr. Cheng is a member of several bar and professional associations, for which he serves on various ADR, litigation, and intellectual property sections and committees. He frequently writes and speaks on ADR and IP issues. Mr. Cheng has a regular column called *Resolution Alley* in the *NYSBA Entertainment, Arts and*

Sports Law Journal, which addresses the use of ADR in those industries. He also writes the quarterly column *The ADR Mosaic* in the Minority Corporate Counsel Association's *Diversity & the Bar Magazine*, which addresses ADR and diversity issues. Additional information is available at www.linkedin.com/in/theocheng.

Selected Publications

- “Merits-Based Review of Arbitration Awards: A Potentially Appealing Option,” NYSBA New York Litigator (Fall 2017)
- “Resolving Fair Use Disputes Through Mediation and Early Neutral Evaluation,” FBA The Resolver (Fall 2017)
- “Maintaining Confidentiality in Arbitration,” NYSBA EASL Journal, Vol. 28, No. 2 (Summer 2017)
- “Making an Appearance: Being Present and Engaged at the Mediation Session,” FBA The Resolver (Winter 2017)
- “Appellate Mediation: A Dispute Resolution Process Worth Considering,” NYSBA EASL Journal (Fall 2016)
- “Words Matter: Being Mindful of Language in Mediation,” The Federal Lawyer (Oct/Nov 2016)
- “Opening the Door to Racier Marks? *In re Tam* and its Impact on Trademark Registration and Business Marketing,” NYSBA Inside (Spring/Summer 2016)
- “Developments on Judicial Review Under the FAA After *Hall Street*,” ABA Alternative Dispute Resolution (Jul 30, 2015)
- “Using Alternative Dispute Resolution to Address Your Entertainment Disputes,” NYSBA EASL Journal (Spring 2015)
- “Discerning the Boundaries of an Arbitrator’s Power to Fashion Appropriate Remedies,” FBA - The Resolver (Spring 2015)
- “*Already* and *Kirtsaeng*: Lessons for Prospective Intellectual Property Enforcement,” NYSBA Inside (Winter 2013)
- “*Golan* and *Mayo*: Practical Tips for Intellectual Property Owners and Users,” NYSBA EASL Journal (Fall/Winter 2012)

Selected Speaking Engagements

- Panelist, “Drafting Arbitration Clauses to Ease Preparing for the Hearing,” ABA DRS Webinar (Dec 13, 2017)
- Panelist, “Power and Pitfalls: Best Practices to Select the Right ADR Professional,” MCCA Pathways to Diversity Conference (Oct 3, 2017)
- Panelist, “When Experts Come From Different Planets,” AAA Webinar (Jun 14, 2017)
- Panelist, “Pleadings in State Court, Federal Court, and Arbitration,” NYSBA Commercial Litigation Academy (May 4, 2017)
- Panelist, “The Arbitration Management Conference: A Blueprint for an Orderly Hearing,” Lawline Webinar (Feb 21, 2017)
- Panelist, “How Solo and Small Firms can Leverage Arbitration’s Tools and Flexibility to Manage Cost and Efficiency,” NAPABA Convention (Nov 3, 2016)
- Moderator, “Lost in Translation? – Navigating the Cross-Cultural Divide in Mediation,” NYSBA Dispute Resolution Section Fall Meeting (Oct 28, 2016)
- Panelist, “Emerging Importance of Cross-Cultural Competency in ADR,” AAA/ICDR Neutral Conference (Feb 19, 2016)
- Moderator, “Fresh Perspectives: Insights from In-House/Corporate Counsel on Arbitration and Mediation,” ACR-GNY 14th Annual Conference (Jun 18, 2015)
- Panelist, “ADR Choices Have Consequences,” NYSBA Dispute Resolution and Corporate Counsel Sections Annual Meeting (Jan 29, 2015)

- Panelist, “An Arbitration Overview: Analysis of Best Practices, Tips, and Mistakes to Avoid,” NAPABA Central Regional Conference (Apr 5, 2014)
- Panelist, “Effective Techniques in Mediation Advocacy,” JAMS/AABANY (Apr 17, 2013)

Education

- J.D., New York University School of Law
- A.B. *cum laude* in Chemistry and Physics, Harvard University

Bar and Court Admissions/Professional Licenses

- New York, New Jersey, District of Columbia (inactive)
- Supreme Court of the United States
- U.S. Courts of Appeals: Second, Third, Sixth, Seventh, Ninth, and Federal Circuits
- U.S. District Courts: E.D.N.Y., N.D.N.Y., S.D.N.Y., D.N.J., W.D. Mich.
- Chartered Life Underwriter (CLU) (1993-present)
- Chartered Financial Consultant (ChFC) (1994-present)
- Series 7 General Securities Representative (1993-1994)

Professional Affiliations and Memberships

- American Arbitration Association (Council Member, 2016-present; Board Member, 2015-2016)
- American Bar Association (Dispute Resolution Section)
- American Intellectual Property Law Association
- Asian American Bar Association of New York (Recording Secretary and Director, 2004-2007; Chair, ADR Subcommittee (2014-present); Co-Chair, Judiciary Committee (2011-2014); Chair, Federal Judiciary Subcommittee (2009-2011); Co-Chair, Litigation Committee (2001-2004))
- Asian Pacific American Lawyers Association of New Jersey (Director, 2016-2017; President, 2015-2016; President-Elect, 2014-2015)
- Association for Conflict Resolution Greater New York Chapter (Director, 2016-2019)
- The Copyright Society of the U.S.A. (Trustee and Executive Committee Member, 2016-2019; Co-Chair, New York Chapter, 2015-2017)
- Federal Bar Association (Alternative Dispute Resolution Section)
- Federal Bar Council (Second Circuit Courts Committee, Secretary, 2010-2013)
- Justice Marie L. Garibaldi American Inn of Court for ADR (Secretary/Treasurer, 2017-2019; Board Member, 2016-2017)
- National Asian Pacific American Bar Association
- New Jersey Association of Professional Mediators
- New Jersey State Bar Association (Dispute Resolution Section, Director, 2016-2019)
- New Jersey Supreme Court Arbitration Advisory Committee (2014-2017)
- New Jersey Supreme Court Committee on Complementary Dispute Resolution (2014-2017)
- New York City Bar Association (Federal Courts Committee, 2013-2016; Copyright & Literary Property Committee, 2010-2013)
- New York Intellectual Property Law Association (2007-2016)
- New York State Bar Association (Dispute Resolution Section, Vice-Chair, 2017-2018; Co-Chair, Mediation Committee, 2016-2017)
- Silicon Valley Arbitration & Mediation Center
- S.D.N.Y. Mediator Advisory Committee (2013-2015)

To schedule a mediation or arbitration with Mr. Cheng, please call Michael Weinzierl at (800) 776-6060 ext. 125 or mweinzierl@resolutesystems.com by e-mail.