



AAA Mediation.org™

FN-8473 MN-8473 LN-8473, Esq.

Larchmont, New York



Current Employer-Title The Law Office Of Stephen P. Gilbert

Profession Attorney

Work History The Law Office of Stephen P. Gilbert, 2011 – Present; Partner/ Co-Leader of Intellectual Property Client Service Group (2007 – 2010), Bryan Cave LLP, 1988 – 2010; Partner/Associate, Stiefel Gross & Kurland (and predecessors), 1985 – 1988; Associate, Fish & Neave, 1978 – 1985; Associate, Arthur Dry & Kalish, 1976 – 1978; Consulting Engineer, Chem Systems Inc., 1973 – 1976; Chemical Process Engineer, Scientific Design Company, 1969 – 1973; Computer Programmer, International Paper Company, 1967 – 1969.

Experience Generalist who is also an IP attorney, with over forty years' experience in all aspects of intellectual property law (65-70% patent, 20-25% trademark, and 5-10% copyright) and related areas (unfair competition, trade regulation/antitrust, corporate, employment, etc.), including: litigation; appeals; counseling; opinions; infringement, patentability, validity, state-of-the-art, and registrability searches and studies; oppositions; revocations; transactional and due diligence; licensing; and prosecution. Handled patent matters in many areas, including electrical (e.g., television, radar, RFID, communication satellites), information systems, business methods, Internet, website, software (e.g., financial, medical), mechanical (e.g., rotary filtration equipment, diesel engines, toys, medical devices and prostheses, box manufacturing, valves, airplane winglets), and chemical and biotech (e.g., organic and inorganic chemicals, pharmaceuticals, biologicals, monoclonal antibodies, medical assays, pulp and paper, cosmetics, polymers, and genetics). Patent litigation concerned, e.g., biodegradable plastics, blowing agents for polyurethane foams, cephalosporin antibiotics, surgical devices, sorters/collators for copying machines, wall covering systems, hard and soft contact lenses, palletizing and packaging equipment, clothing, and electrical connectors for batteries. Patent reissue, reexamination, interference, and patent term extension proceedings. Trademark and copyright matters involved, e.g., software, perfume, sporting goods, laboratory equipment, candy, gas stations, motel chains, music, books, advertising, and photographs. Handled matters involving unfair competition, advertising clearance, rights of privacy/publicity, moral rights, theft/misappropriation of trade secrets, confidentiality agreements, disclosure agreements, material transfer agreements, employment agreements, works made for hire, architectural works, US Customs, ITC Section 337, technical data export licenses, antiboycott compliance rules, and valuation of intellectual property.

Pre-Law Technical Experience: Seven years' experience as a chemical process design engineer and

consulting engineer and three years (part-time) as a computer programmer. Most of the work as a chemical engineer concerned petrochemicals (e.g., styrene, ethylene oxide, glycols, maleic anhydride, fluorinated hydrocarbons, nylon), petroleum refinery operations, coal gasification, and cogeneration and included conceptual process design, equipment design (e.g., chemical reactors, distillation columns, heat exchangers), and economic evaluation. Helped design and supervise construction and installation of research laboratory pilot plant for synthesis of methane; designed, built, and installed large high-temperature acoustic muffler needed to permit pilot plant to operate. The work as a programmer involved a variety of languages and various machines.

Mediator Experience

MEDIATOR in provider-administered and self-administered two-party and multi-party commercial, licensing, technology, and intellectual property disputes in which the principal issues concerned, for example, patents (e.g., for explosive devices, illumination apparatus, separation mechanisms, clothing, fibers/films/non-woven structures), copyrights (e.g., for architectural plans, computer files, advertising copy, website design, recordings, photographs, compliance materials, movies), trademarks (for consumer goods, photographic goods, household furnishings, foodstuffs, beverages, jewelry, clothing, membership in environmental organization, charitable fundraising events), trade secrets (e.g., for customer lists, engineering information, and pricing information), loan guarantee (for real estate purchase/development), indemnification (e.g., by a licensee/sublicensor of its sublicensees), pharmaceutical marketing rights, professional services partnerships, subsidies for clinical provision of drugs, diagnostic apparatus intellectual property, digital books, aerospace technology, employment/headhunter services, party goods, over-the-counter (OTC) preparations and related intellectual property, website control/maintenance, nuclear medicine, online real estate auctions. Amounts in dispute ranged up to about US\$50 million. Parties were US and non-US small, medium, and large business entities and individuals.

MEDIATION PANELS: American Arbitration Association Commercial Master Mediator Panel and ICDR Panel of International Mediators; International Institute for Conflict Prevention & Resolution mediation panel; Silicon Valley Arbitration & Mediation Center mediation panel; World Intellectual Property Organization List of Mediators and Arbitrators; U. S. District Court for the Southern District of New York mediation panel; New York City Bar Association Mediation Panel for Attorney Disputes. Also listed as a mediator with the Chartered Institute of Arbitrators, London Court of International Arbitration, and United States Council for International Business (USCIB) of the International Chamber of Commerce.

Representative Issues Handled as a Mediator

Issues concerned ownership of patents, patent infringement, ownership of copyrights, copyright infringement, counterfeiting, trademark infringement, false advertising, trade defamation, cyber-piracy (concerning, e.g., domain name registration), ownership of websites, misappropriation of trade secrets, theft of artwork, fraud in the inducement, breach of fiduciary obligations, LLC operating agreements, violation of financial terms of loan, breach of mediation settlement agreement, insurance contributions, obligations of loan guarantor, bankruptcy, indemnification, scope of contractual rights, breach of non-competition clauses, quantum meruit, unjust enrichment.

Mediator Style & Process Preferences

To Listen - the most important ability of a neutral.

An Open Mind - the most important part of a neutral.

A neutral must lead but not dictate, be firm but not overbearing, act decisively but not capriciously, and be respectful, flexible, articulate, and fair.

A neutral must earn respect and engender trust.

A neutral must understand the process and keep in mind it is the parties' process, but not let any party hijack it.

A mediator should have training and experience in different modes (e.g., facilitative, understanding-based) and not have a rigid, one-size-fits-all approach. Different approaches will be appropriate at different times depending on: the nature and status of the dispute; the emotional, legal, financial, and other views each of those involved has of the dispute and its possible resolution; and the nature, knowledge, and ways of processing information and making decisions each of them has. Regardless of the approach used, everyone needs to be heard and to feel he or she is being heard, both by the mediator and by the others involved. The mediator must: actively listen and understand; use careful

non-judgmental questioning to identify and help the parties identify what their interests and concerns are, what they really want, and what solutions might be possible; be mindful of the stress the parties and counsel are under; keep confidences; create a safe environment so those involved feel they can speak freely (in both caucus and joint sessions); and become evaluative when appropriate and to the extent necessary.

No neutral is right for every dispute.

Education

Columbia University School of Engineering & Applied Science (BSChE-1968; MSChE-1971) (master's degree thesis proposed and evaluated a method for predicting thermodynamic activity coefficients); Fordham University School of Law (JD-1975).

Professional Licenses

Admitted to the Bar: New York (1976) and District of Columbia (1990); U.S. District Court: Southern (1977) and Eastern (1981) Districts of New York; U.S. Court of Appeals: Seventh (1980) and Federal (1982) Circuits; U.S. Patent and Trademark Office (1976-Patent Attorney Registration No. 27,893); U.S. Supreme Court (1980).

Professional Associations

Fellow, College of Commercial Arbitrators (CCA)

Fellow, Chartered Institute of Arbitrators (CIArb)

Fellow, American College of e-Neutrals (ACESIN)

Member, National Academy of Distinguished Neutrals (NADN)

Member/Panelist, Silicon Valley Arbitration & Mediation Center (SVAMC)

Member, New York International Arbitration Center (NYIAC)

Member, London Court of International Arbitration-North American Users' Council (LCIA)

Member, International Institute for Conflict Prevention & Resolution (CPR)

Member, Association for Conflict Resolution-Greater New York Chapter (ACR-GNY)

Member, American Bar Association (ABA)

Member, New York State Bar Association (NYSBA)

Member, Association of the Bar of the City of New York (NYCBA)

Member, New York Intellectual Property Law Association (NYIPLA).

Recent Publications & Speaking Engagements

Co-Presenter, "Not Business as Usual: Techniques for Resolving Life Science Disputes," Silicon Valley Arbitration & Mediation Center (2020).

Author, "Strategic Planning for Contract-Based Disputes," NYS Bar Assn. (Corp. Counsel Section), INSIDE, vol. 38, no. 1, pp. 36-40 (Spring 2020).

Author, "Third-Party Arbitration Summonses: Some Helpful Practice Pointers," ABA, Section of Litigation, ADR (May 23, 2019).

Co-Presenter, "Smarter, Faster, And Cheaper—Can You Get It All In Tech Arbitration?" Silicon Valley Arbitration & Mediation Center, Annual Meeting (April 2019).

Author, "Dealing With Experts And Expert Evidence In Commercial Arbitration," NYS Bar Assn., NEW YORK DISPUTE RESOLUTION LAWYER, vol. 12, no. 1, pp. 10-13 (Spring 2019).

Author, "Dealing With Damages In Commercial Arbitration," DISPUTE RESOLUTION JOURNAL, vol. 73, no. 3, pp. 67-107, AAA (2018).

Moderator/Co-Presenter, "Damages In Commercial Arbitration," College of Commercial Arbitrators

Annual Meeting (2018).

Co-Author, "Mediation Best Practices Guide For The In-House Counsel: Make Mediation Work For You," CPR (2018).

Author, "The Arbitrator's Proposal," NY State Bar Assn., NEW YORK DISPUTE RESOLUTION LAWYER, vol. 10, no. 2, pp. 24-30 (Fall 2017).

Co-Author, "Arbitrating Technology Cases: Considerations for Businesspeople and Advocates," chapter in ADR ADVOCACY, STRATEGIES, AND PRACTICE FOR INTELLECTUAL PROPERTY AND TECHNOLOGY CASES, ABA (2017).

Author, "Arbitrating Disputes In The Life Sciences/Biotech/Pharmaceutical/Medical Device Field," College of Commercial Arbitrators website (2017).

Author, "Removing Anger in a Mediation Allowed Parties to Settle," The Blog of The CPR Institute (April 12, 2017).

Presenter, "Mediation: Principles, Process, And Strategies For The Mediator," NY State Bar Assn., Dispute Resolution Section, Mediation Committee (June 2016).

Co-Presenter, "Dispute Resolution for IP Claims: Lessons and Strategies," Law Seminars International, Tenth Annual Conference on "Advanced Concepts in Licensing IP and Technology" (August 2015).

Co-Presenter, "Awarding Attorneys' Fees: The Art And The Science," ABA, Dispute Resolution Section, 17th Annual Spring Meeting (April 2015).

Co-Presenter, "Ethics in Mediation: Lessons for Neutrals and Advocates," LAWLINE "Bridging the Gap" CLE Presentation (December 2014).

Co-Presenter, "Principles on which to Anchor Awards of Attorneys' Fees and Costs in Arbitration: The Art and the Science," College of Commercial Arbitrators Annual Meeting (November 2014).

Co-Author, "Guidance Note: Arbitration And Social Media," posted at CCA website (August 15, 2014).

Author, "Prevailing Parties And Attorneys' Fees," DISPUTE RESOLUTION JOURNAL, vol. 68, no. 2, AAA (November 2013).

Co-Author and Co-Presenter, "Getting The Arbitration Process Parties Want And Need—Drafting Arbitration Clauses," CLE course presented at law firms under auspices of The College of Commercial Arbitrators (2013-2014).

Principal Reviser, New York City Bar Assn., "The Amended Rules for Association-Sponsored Mediation And Arbitration Among Lawyers" (2012).

Co-Presenter, "Effective Use Of Experts In Mediation And Arbitration," Association For Conflict Resolution – Greater New York Chapter Annual Meeting (June 2011).

Co-Presenter, "IP Alternative Dispute Resolution – Is It Ready For Prime Time?," NY State Bar Assn. Annual Meeting, IP Session (January 2011).

Co-Author, NY State Bar Association White Paper, "The Benefits Of Mediation And Arbitration For Dispute Resolution In Intellectual Property Law" (January 2011), reprinted in NYS Bar Assn., NEW YORK DISPUTE RESOLUTION LAWYER, vol. 4, no. 2, pp. 61-65 (Summer 2011).

Author, "Arbitrating To Avoid The Markman Do-Over," DISPUTE RESOLUTION JOURNAL, American Arbitration Association (August/October 2006).

Please see my website for additional information.

Mediation Rate	\$490 Per Hour
Languages	English
Citizenship	United States of America
Locale	Larchmont, NY

The AAA's Rules provide the AAA with the authority to administer a mediation including, mediator appointment, general oversight and billing. Accordingly, mediations that proceed without AAA administration are not considered AAA mediations, even when the parties select an mediator who is on the AAA's Roster.

The information contained in this resume has been supplied solely by the individual mediator and may, or may not, be a complete recitation of their experience. The AAA assumes no responsibility for the content, completeness, accuracy, or reliability of the information contained in a mediator's resume. If you have any questions about a mediator's experience or background, you are encouraged to contact your case manager.

Mediators on the AAA Roster are not employees or agents of the AAA.