

## Jean-Paul Ciardullo

### Partner

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Jean-Paul Ciardullo is a partner and intellectual property lawyer at Foley & Lardner LLP, where his primary practice area is intellectual property litigation. Jean-Paul litigates in all areas of intellectual property – including utility patents, design patents, trademarks, trade dress, copyright, and trade secrets – and also counsels on business torts, contract disputes, and licensing matters related to intellectual property. Jean-Paul has litigated extensively in the area of consumer product design rights, and has secured numerous summary judgment and trial victories that have helped shape the law of trade dress. Jean-Paul also has a winning track record in trade secret litigation under the Defend Trade Secrets Act and state trade secret laws, where he has won summary judgment and favorable settlements for his clients. Jean-Paul has assisted clients in a wide range of industries that include industrial manufacturing, E-commerce, medical devices, sporting equipment, semiconductor fabrication, automotive products, satellite radio, and hospitality. He is a member of the firm's IP Litigation Practice and Manufacturing Sector Team. Jean-Paul also serves as the Training Chair for the firm's Intellectual Property Department, where he has implemented many new and practical course offerings for The Foley Academy, the firm's apprenticeship training program.

Jean-Paul is also committed to pro bono service, and has helped numerous immigrant refugees obtain asylum in the United States.

Jean-Paul is originally a New Yorker, and prior to joining Foley in Los Angeles, was an intellectual property litigation attorney with Kramer Levin Naftalis & Frankel LLP in New York City.

### Representative Experience

- Secured \$6.7 million final judgment for furniture maker Herman Miller, Inc. following jury trial against a company accused of infringing and diluting trade dress rights in famous chair designs
- Secured summary judgment of no trade secret misappropriation for fitness-equipment maker iFIT in a Defend Trade Secrets Act lawsuit brought by rival Peloton

- Won \$1.6 million contempt award for client Toyo Tires, disgorging all of accused infringer's profits following violation of an earlier consent judgment concerning tire design right
- Secured \$0 settlement in defense of software patent litigation by discovering a logical impossibility imbedded within all the plaintiff's patent claims that rendered them invalid, while the other large corporate defendants failed to identify the defect and continued litigating at significant expense
- Won almost \$300,000 in attorneys' fees and an adverse inference jury instruction based upon investigating and revealing significant discovery misconduct by litigation opponent
- Persuaded a Central District of California district court that a cause of action for attempted extortion seeking punitive damages could be maintained by client SmileDirectClub against an accused cybersquatter
- Precipitated highly favorable settlement in defense of software patent litigation by tracking down one of the opposing party's former employees who was able to confirm the invalidity of the asserted patents
- Secured immediate dismissal of declaratory judgment suit where the plaintiff refused to confirm if their heat exchange products contained the patented technology
- Assisted in defeating \$100 million trademark claim against United Online following jury trial and subsequent appeal
- Persuaded a Southern District of California district court to apply favorable Ohio trade secret law, allowing the client's trade secret claim to proceed when it otherwise would have been barred
- Defeated multiple summary judgment motions attacking the validity of the trade dress rights of tire manufacturer Toyo Tires, and furniture maker Herman Miller
- Won dismissal of patent suit for lack of standing by uncovering that the plaintiff LLC had failed to secure approval for the lawsuit from the majority of its members in violation of Delaware LLC law
- Secured over \$100,000 in attorneys' fees for United Online in a multi-district patent litigation stemming from uncovering that the plaintiff had impermissibly divided ownership of the patent family in violation of terminal disclaimers filed with the Patent Office
- Served as prime witness for a trade secret theft litigation in China following personal inspection of a factory that was using the trade secret technology to manufacture wire drawing instruments
- Persuaded Eastern District of Virginia district court to adopt for the first time a requirement that patent invalidity counterclaims be pleaded with factual particularity
- Identified invalidating patent prior art against sports equipment patents by discovering and investigating declassified U.S. military records

## Awards and Recognition

Jean-Paul was selected for inclusion in the 2018 *Southern California Super Lawyers*® and the 2014 – 2016 *Southern California Super Lawyers – Rising Stars*® lists.

## Presentations and Publications

- Author, "Intellectual Property Protection for Consumer Product Designs in the United States," *MORE Brands and Fashion* (August 1, 2019)

- Co-author, "Supreme Court May Give Brand Owners an Easier Path to Trademark Damages," *Foley Insights* (July 2, 2019)
- Author, "New Possibilities for Copyrighting Consumer Products," *IP Litigation Current* (February 28, 2018)
- Author, "Can You Identify Your Trade Dress?," *IP Litigation Current* (July 18, 2016)
- Author, "Can Foreign Sales Infringe U.S. Patents?," *IP Litigation Current* (April 21, 2016)
- Author, "Apple v. Samsung: Design Patents Reap Profits," *IP Litigation Current* (May 29, 2015)
- Author, "Federal Circuit Limits Patent Exhaustion Doctrine for Complementary Technology," *IP Litigation Current* (March 11, 2015)
- Author, "Pre-Trial Consolidation May Run Afoul of the America Invents Act," *IP Litigation Current* (January 12, 2015)
- Author, "After the Supreme Court's Limelight Decision, Attention May Shift to Contract Analysis in Patent Cases," *IP Litigation Current* (July 2, 2014)
- Author, "New Scheduling Order May Preview Future Delaware 'Local Patent Rules,'" *IP Litigation Current* (March 26, 2014)
- Author, "District Judge Payne Holds That Form 18's 'Talismanic' Pleading is Superseded by Iqbal/Twombly," *IP Litigation Current* (March 17, 2014)
- Author, "Declaratory Judgment Claimants: Which Products Are You Saying Don't Infringe?" *IP Litigation Current* (January 27, 2014)
- Author, "Triaging Trade Secret Theft," *IP Litigation Current* (November 13, 2013)
- Author, "Federal Circuit Decision Highlights Seldom-Used Doctrine of Equivalents Analysis," *IP Litigation Current* (September 3, 2013)
- Author, "Judge Plager Suggests Construing Ambiguous Claims Against the Patent Holder," *IP Litigation Current* (August 14, 2013)
- Co-author, "Under the Gavel: A Defense of Patent Auctions," *The Daily Deal* (2006)
- Co-author, "Thermal expansion kinetics: Method to Measure Permeability of Cementitious Materials: IV, Effect of Thermal Gradients," *Journal of the American Ceramics Society* (2005)

## Languages

Jean-Paul speaks conversational Spanish.

## Sectors

- [Consumer Product Safety](#)
- [Manufacturing](#)

## Practice Areas

- [Commercial Litigation](#)
- [IP Litigation](#)
- [Intellectual Property](#)

## Education

- Fordham University School of Law (J.D., 2006)
- Princeton University (B.S.E., 2003)
  - Civil Engineering
  - Finance and Materials Science (Minor)

## Admissions

- California
- New York
- Circuit Court of Appeals
  - Ninth, Fifth, and Federal
- United States District Courts
  - Central, Northern, and Southern Districts of California
  - Southern District of New York
  - Eastern District of New York
  - Eastern District of Texas
  - Western District of Michigan