

THEODORE K. CHENG

New York ♦ New Jersey ♦ Pennsylvania ♦ Connecticut



Theodore K. Cheng is an arbitrator and mediator, focusing on commercial, intellectual property (IP), entertainment, technology, and 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, Large, Complex Case, and Employment arbitration and mediation rosters of the American Arbitration Association (AAA), the Panel of Distinguished Neutrals of the CPR Institute, the American Intellectual Property Law Association (AIPLA) List of Arbitrators and Mediators, and the Silicon Valley Arbitration & Mediation Center's List of the World's Leading Technology Neutrals. Mr. Cheng serves on the AAA's Council, and he is also the President of the Justice Marie L. Garibaldi American Inn of Court for ADR, the Chair of the

New York State Bar Association (NYSBA) Dispute Resolution Section, and the Secretary of the Copyright Society of the U.S.A. He has also been inducted into the National Academy of Distinguished Neutrals. The *National Law Journal* named him a 2017 ADR Champion. More information is available at www.theocheng.com.

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

Representative COMMERCIAL/INTELLECTUAL PROPERTY matters:

- \$16 million dispute over alleged unauthorized use by multi-media company of over 30,000 photographs after termination of copyright license (chair)
- Breach of digital marketing services agreement (chair)
- \$10 million dispute over alleged unpaid licensing fees brought by software trading platform vendor against broker-dealer (sole)
- \$3.8 million breach of contract and fraud claims for unauthorized credit card transactions in violation of governing merchant agreement (sole)
- \$1.7 million breach of finder's fee agreement claim relating to sale of company assets in natural gas facility construction and maintenance business (sole)
- \$1.5 million dispute brought by named beneficiaries over carrier's denial of life insurance policy proceeds (sole)
- \$700,000 breach of contract claim between artist and manager in music industry (sole)
- \$650,000 dispute alleging violations of Carmack Amendment and other state law claims (sole)
- \$475,000 breach of settlement agreement and trademark infringement and dilution claims pertaining to collaborative venture to produce and promote film in health care industry (sole)
- \$400,000 breach of e-commerce services agreement claim (sole)
- Multi-million dollar patent license dispute pertaining to manufacture and sale of in-vehicle entertainment systems (wing)
- \$14 million alleging breach of consulting agreement relating to licensing arrangement in jewelry industry (wing)
- \$8.5 million alleging breach of distributorship agreement in snack cakes/baked good industry (wing)

- \$8 million alleging breach of trademark licensing agreement in fashion/retail industry (wing)
- \$25 million copyright infringement claim brought by recording industry against owner/operator of mixtape music app (mediator)
- \$10 million copyright infringement claim over alleged unauthorized use of photographs by numerous television stations (mediator)
- Patent infringement claims arising from manufacture and sale of competing furniture product (mediator)
- Breach of a patent license agreement for failure to pay royalties (mediator)
- Breach of intellectual property license and supply agreement involving a patented taggant ink system used in a household consumer appliance (mediator)
- Trademark infringement and unfair business practices claims arising from breach of settlement agreement between pharmaceutical companies over competing skin cream products (mediator)
- Trademark infringement claims involving different products in allegedly related household consumer appliances marketplace (mediator)
- Breach of a distributorship agreement for hair care products, along with trademark infringement claims (mediator)
- Pre-litigation dispute between members of limited liability company regarding continued funding for entity developing new trading strategy and ownership of patent over that technology (mediator)
- Pre-litigation dispute between members of limited liability company regarding allegations of breach of fiduciary duty and other malfeasance (mediator)

Representative EMPLOYMENT matters:

- \$1.4 million dispute brought by a record company executive for breach of his employment and royalty agreements, racial discrimination, and other related claims, including counterclaims for breach of the employment agreement and tortious interference with contract (sole arbitrator)
- \$1.0 million dispute brought by former employee-trader for unpaid and overdue compensation pursuant to bonus agreements (sole arbitrator)
- Fair Labor Standards Act (FLSA) claims for failure to pay minimum wages and for compensable time brought by individual truck drivers (sole arbitrator)
- Claims for unlawful suspension based upon gender discrimination and breach of contract for failure to pay severance package (sole arbitrator)
- Claims to recover unpaid wages and withheld gratuities under the New York Labor Law (sole arbitrator)
- Wrongful discharge claims in the food & hospitality and beverage industries (mediator)
- Claim for unlawful termination based upon disability discrimination and retaliation brought by an executive in a financial services organization (mediator)
- Race and gender discrimination claims brought by a former employee in the retail industry (mediator)
- Claim for failure to reimburse advanced sales commissions pursuant to an employment contract (mediator)
- FLSA claims for failure to pay minimum wage and overtime in the food & hospitality, catering, and grocery industries (mediator)

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. In 2007, he was named one of the Best Lawyers Under 40 by the National Asian Pacific American Bar Association.

Representative COMMERCIAL/INTELLECTUAL PROPERTY matters:

- Tried fraud and breach of contract claims on behalf of exploited investor, resulting in \$2.4 million compensatory and punitive damages jury verdict
- Tried patent damages claim on behalf of pharmaceutical company over infringing animal vaccine, resulting in favorable jury verdict
- Defended a patent infringement litigation over patents relating to technology for the cryosurgical removal of warts and other benign skin lesions, which settled on eve of trial
- Litigated copyright infringement actions brought by classes of songwriters and music publishers against unlicensed Internet file-sharing companies Grokster and Napster
- Briefed and argued appeal before Guam Supreme Court on commercial lease dispute involving worldwide restaurant franchisee, overturning \$9 million jury verdict
- Successfully resolved accusations against on-line retailer of selling counterfeit goods
- Successfully defended software company against allegations of trademark infringement, dilution, and unfair competition brought by purported senior mark owner
- Represented a patentee in industry-wide infringement lawsuits relating to pioneering methods for locating available real estate properties on a computer
- Conducted litigation campaign to enforce telecommunications company's patent relating to data compression algorithms
- Defended health care company in suit alleging claims for patent infringement, trademark infringement, copyright infringement, and theft of trade secrets over design, development, and sale of mass-marketed medical device
- Conducted trademark portfolio due diligence in connection with the acquisition of a pharmaceutical company
- Advice regarding transfer of patent and trademark assets in connection with negotiation of sales and distribution agreement regarding textile and garment products
- Provided Digital Millennium Copyright Act (DMCA) advice and consultation to multimedia company in connection with potential acquisitions
- Conducted pre-publication review of a book for potential violations of nondisclosure agreements
- Drafted and negotiated non-exclusive licensing agreement of patent rights owned by U.S. technology university (pertaining to ligands for metals and metal-catalyzed processes) to Japanese commercial manufacturer to develop and sell licensed products and processes
- Drafted and negotiated joint research and development agreement between German and U.S. manufacturers of scientific instruments
- Drafted and negotiated research and testing agreement between U.S. technology university and Japanese manufacturer and distributor of specialty chemicals products

Representative EMPLOYMENT matters:

- Tried unpaid wages claim on behalf of domestic worker, resulting in sizeable compensatory and punitive damages jury verdict
- Dismissed lawsuit alleging employment discrimination, anti-trust infractions, and a RICO violation against a major investment bank
- Represented companies and former employees in “raiding,” non-compete, and breach of employment agreement suits
- Drafted employment agreements containing intellectual property and trade secret protections, confidentiality provisions, restrictive covenants, and non-compete and non-solicitation clauses
- Negotiated separation and severance agreements for hedge fund company employees

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.theocheng.com.

Selected Publications

- “Considering Arbitration or Mediation for Licensing Disputes,” *Federal Lawyer* (May/June 2019)
- “Preparation is the Key to a Successful and Rewarding Mediation,” *NY Litigator* (Spring 2019)
- “Providing for Neutrals with Industry, Legal, and Business Expertise,” *EASL Journal* (Fall/Winter 2018)
- “When Experts Come From Different Planets: Finding the Difference Driving Seemingly Irreconcilable Expert Evidence in Arbitration,” *NY Litigator* (Fall 2018)
- “Maintaining Confidentiality in Arbitration,” *The Resolver* (Spring 2018)
- “Sometimes Less is More (and Vice Versa): A Primer on Pleading Practice in Arbitration,” *NY Litigator* (Spring 2018)
- “Developing Skills to Address Culture in Arbitration and Mediation,” *Dispute Resolution Journal* (Winter 2017)
- “Merits-Based Review of Arbitration Awards: A Potentially Appealing Option,” *NY Litigator* (Fall 2017)
- “Resolving Fair Use Disputes Through Mediation and Early Neutral Evaluation,” *The Resolver* (Fall 2017)
- “Making an Appearance: Being Present and Engaged at the Mediation Session,” *The Resolver* (Winter 2017)
- “Appellate Mediation: A Dispute Resolution Process Worth Considering,” *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,” *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,” *EASL Journal* (Spring 2015)
- “Discerning the Boundaries of an Arbitrator’s Power to Fashion Appropriate Remedies,” *The Resolver* (Spring 2015)
- “*Already* and *Kirtsaeng*: Lessons for Prospective Intellectual Property Enforcement,” *Inside* (Winter 2013)
- “*Golan* and *Mayo*: Practical Tips for Intellectual Property Owners and Users,” *EASL Journal* (Fall/Winter 2012)

Selected Speaking Engagements

- Panelist, “Yes, We Are Talking About Arbitration Again!,” *PLI Wage & Hour Litigation and Compliance 2020* (Jan 28, 2020)
- Faculty, *ABA 17th Annual Advanced Mediation and Advocacy Skills Institute* (Nov 15-16, 2019)

- Panelist, “Pleadings in State Court, Federal Court, and Arbitration,” NYSBA Commercial Litigation Academy 2019 (Nov 14, 2019)
- Panelist, “Ethics in ADR: The Ultimate Guide for New Jersey Attorneys,” NJICLE (Nov 7, 2019)
- Panelist, “Arbitration: Best Practices, Hot Topics and Insights From The Panel,” ABA Roundtable (Oct 8, 2019)
- Panelist, “The Arbitrator’s Perspective: Where Legal Counsel Has Gone Right and Wrong in Arbitration Proceedings,” ACI National Forum on Wage & Hour Claims and Class Actions (Jun 25, 2019)
- Panelist, “Mediation in 2019,” Cornell ILR/SDNY/2d Cir. (May 7, 2019)
- Panelist, “When Experts Come From Different Planets: Strategies and Techniques for Reconciling Seemingly Irreconcilable Expert Evidence in Arbitration, ABA 2019 DRS Spring Conference (Apr 12, 2019)
- Panelist, “PLI Advanced Copyright Law: Current Issues” (Mar 14, 2019)
- Panelist, “Ethics and Fitness: Protecting the Integrity and Quality of the ADR Processes,” 2019 AAA/ICDR/AAA Mediation.org Panel Conference (Mar 8, 2019)
- Panelist, “What the *Epic* Decision Means for FLSA Litigation,” ABA Federal Labor Standards Legislation Committee Midwinter Meeting (Feb 21, 2019)
- Panelist, “An Evening of Interactive Peer-Exchange to Advance Your Mediation Practice to a New Level!,” Garibaldi Inn (Feb 14, 2019)
- Panelist, “Smarter, Faster and Cheaper Litigation and Arbitration for Technology Disputes,” AAA/ICDR/ACC/SVAMC/iTechLaw Conference (Nov 14, 2018)
- Faculty, ABA 16th Advanced Mediation and Advocacy Skills Training Institute (Oct 25-26, 2018)
- Moderator, “Pursuing FLSA and Employment Discrimination Claims in the Wake of *Epic Systems*,” ABA Labor & Employment Law Section Webinar (Aug 1, 2018)
- Panelist, “Best Practices in Mediation: Lessons From the Masters,” Camden County Bar Association (May 14, 2018)
- Panelist, “Drafting Arbitration Clauses to Ease Preparing for the Hearing,” ABA DRS Webinar (Dec 13, 2017)
- Panelist, “Pleadings in State Court, Federal Court, and Arbitration,” NYSBA Commercial Litigation Academy 2017 (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, 2016-2022; 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. (Secretary, 2018-2020; 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 (President, 2018-2021; Secretary/Treasurer, 2017-2019; Board Member, 2016-2017)
- National Asian Pacific American Bar Association
- 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 State Bar Association (Dispute Resolution Section, Chair, 2019-2020; Chair-Elect, 2018-2019; Vice Chair, 2017-2018; Co-Chair, Mediation Committee, 2016-2018)
- 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.