

**James J. Kozuch, Esq., P.E., MBA**



**Primary Areas of Expertise**

Intellectual Property  
Commercial Litigation  
Energy  
Pharmaceuticals  
Medical Devices  
Licensing & Joint Development

With over 20 years of experience as an arbitrator and more than 35 years as an advocate for clients in many mediations and arbitrations, Mr. Kozuch brings great depth to our firm's Alternative Dispute Resolution (ADR) practice.

As an arbitrator he has presided over and decided more than thirty cases ranging from relatively minor disputes to complex commercial cases (involving alleged breaches of contracts, non-competes, fiduciary duties, etc.) and intellectual property cases (involving inventorship, ownership of patents and products, allegations of trade secret misappropriation, copyright infringement, trademark infringement, false advertising, unfair competition, and breaches of license agreements). The cases have involved medical devices, oil & gas equipment, computerized business systems, process control equipment, cannabis transdermal patches, chemicals suppliers, metal alloys manufacturers, oil & gas leases, and franchises for stores and a restaurant.

As an advocate Mr. Kozuch has represented clients in many mediations and over thirty arbitration hearings involving breach of contracts, breach of warranties, fraud, patent and trademark infringement, false designation of origin, products liability, negligence, premises liability, and professional liability (engineers, architects) involving a wide range of industries and products. Most recently he served as co-counsel in an arbitration involving disputes over a collaboration agreement for medical devices.

Additional details and information are provided below regarding Mr. Kozuch's ADR experience, legal and industry experience, education, professional licenses, work history, publications and presentations, award & honors, and professional associations.

**Professional Summary**

Experienced litigator, trial lawyer, patent attorney, and counselor to inventors, startups, and intellectual property (IP) owners. Has been lead counsel in trials involving patents, trademarks, trade secrets, false advertising, unfair competition, non-compete agreements, and breach of contracts. Prepares and prosecutes U.S. and international patent applications, provides opinions, and

prepares license agreements, joint development agreements, and other types of agreements. Has extensive experience with medical devices and pharmaceutical litigation. Prior to practicing law, worked in engineering and strategic planning for several large corporations, including major energy and chemical companies. Is a Registered Patent Attorney and a Licensed Professional Engineer.

**Alternative  
Dispute  
Resolution  
Experience**

Appointed to the American Arbitration Association (AAA) National Roster of Neutrals in 2003 and serve on the Commercial Roster of Neutrals and five specialty panels - Domestic Life Sciences Panel, National Patent Arbitration Panel, Pharma Panel, HiTec Panel, and Intellectual Property Panel. In 2012 became a member of the International Panel of Arbitrators for the International Centre for Dispute Resolution (ICDR).

*Representative matters include:*

Served as a sole ICDR arbitrator in a case in the process control field with claims for alleged breaches of a Shareholders Agreement, including alleged breaches of a non-compete clause and third-party claims for alleged breaches of contract and fiduciary duties. Prepared and submitted a reasoned award.

Served as an ICDR neutral on a three-member Panel in a case involving inventorship, ownership of patents and downhole production tools for the oil & gas industry, and alleged trade secret misappropriation, breach of contract, unfair competition, and tortious interference. The Panel submitted a reasoned award.

Served as an AAA neutral on a three-member Panel in a medical device case involving a claim for breach of a Royalty Agreement and a counterclaim for patent misuse/antitrust violation plus defenses of forgery and conspiracy. The Panel submitted a reasoned award.

Served as an AAA neutral on a three-member Panel in an energy-related case involving claims for breach of covenant not to compete, misappropriation of trade secrets, breach of contract, and trademark infringement. The parties were engineering and equipment companies in the petroleum field that entered into an Asset Purchase Agreement and a License & Supply Agreement.

Served as an AAA neutral on a three-member Panel in a case alleging breach of contract for failing to complete a computerized business system on time. Counterclaim was for breach of contract for improper, premature termination. The Panel submitted a reasoned award.

Served as a sole AAA arbitrator in a dispute over alleged breaches of a License Agreement for proprietary rights relating to cannabis transdermal patches to develop and commercialize processes, methods, and products. Additional

claims were for trade secret misappropriation, trademark infringement, false advertising, unfair competition, and fraud. Counterclaims were for fraud, breach of contract, and tortious interference.

Served as a sole ICDR arbitrator in a chemicals supply case for breach of a Supply Agreement and payment of royalties pursuant to a Royalty Agreement, plus a counterclaim for damages and a patent infringement defense.

Served as a sole AAA arbitrator in a dispute over alleged breaches of related agreements between a manufacturer of metal alloys and an exclusive sales agent for the metal alloys.

Served as a sole ICDR arbitrator in a consolidated case with claims and counterclaims for alleged breaches of a License Agreement, copyright infringement, and misrepresentations.

Served as a sole AAA arbitrator in a royalty dispute case involving an oil & gas lease in the Marcellus Shale gas play.

Served as a sole ICDR arbitrator in another royalty dispute case involving another oil & gas lease in the Marcellus Shale gas play.

Served as a sole AAA arbitrator in a dispute over an alleged breach of a Franchise Agreement for a restaurant. Claimant sought a declaratory award ordering Respondent to discontinue use of trade names, trademarks, and service marks.

Served as a sole AAA arbitrator in a dispute over Franchise Agreements for five stores. Claimant sought a declaratory award regarding their rights, attorneys' fees, expenses, and costs. Respondents' crossclaims sought rescission of the agreements.

Also served as a sole AAA arbitrator in a case involving an alleged breach of contract for website design services provided by an independent contractor.

Served as an arbitrator in various cases in federal and state courts.

*As an advocate* represented clients in many mediations and 30+ arbitration hearings involving breach of contracts, breach of warranties, fraud, patent and trademark infringement, false designation of origin, products liability, negligence, premises liability, and professional liability (engineers, architects).

**Technology Proficiency**

Have served as a sole arbitrator and as a neutral on three-arbitrator panels in cases where the hearings were conducted by Zoom, as were status conferences with counsel and the parties. In addition to Zoom, am available for conferences via Teams Meeting. Have considerable experience with Electronically Stored

Information (ESI) both as an advocate and as an arbitrator. Have negotiated and prepared ESI Orders as an advocate and have entered ESI Orders as an arbitrator.

**Professional Licenses**

Admitted to the Bar: Pennsylvania (1985); Pennsylvania Supreme Court; U.S. District Court: Eastern, Western, and Middle Districts of Pennsylvania, Western District of Michigan; U.S. Court of Appeals: Third Circuit, Federal Circuit; U.S. Supreme Court; U.S. Patent and Trademark Office; Licensed Professional Engineer, Pennsylvania since 1977.

**Education**

Temple University School of Law (JD - 1985); Lehigh University (MBA - 1976); Cornell University (BS, Mechanical Engineering - 1972).

**Legal Experience**

Practiced law since 1985 primarily as a litigator. Has been a Registered Patent Attorney since 1995.

Handled jury trials and bench trials in a variety of matters, including breach of contracts, breach of warranties, unjust enrichment, products liability, trade secret misappropriation, breach of non-competes, false advertising, patent infringement, trademark infringement, and unfair competition. Tried 30+ arbitrations and 16 trials to verdict, seven of which were jury trials.

Examined and cross-examined expert witnesses at trials in three Hatch-Waxman cases, two other patent infringement cases, a false advertising case, a breach of contract case, and several personal injury cases.

Counseled clients on all aspects of intellectual property (IP) law and IP litigation, prosecuted U.S. and international patent applications, provided opinions on patentability, infringement, and validity, and litigated many IP cases. Served as a Special Master for a federal court in a complex trade secrets case. Also prepared patent license agreements, litigated agreements, reviewed agreements in due diligence projects, and advised clients on licensing and related issues.

Supervised the prosecution of over 130 patent applications in eighteen countries. Coordinated with a French law firm with regard to litigation in Paris involving a U.S. based client for patent infringement and unfair competition.

In the Life Sciences area, prepared agreements for various types of transactions, including agreements for licensing, joint development, and sponsored research. Also have experience with dispute resolution in life sciences, especially pharmaceuticals and medical devices. Have been a litigator and trial attorney in twelve pharmaceutical cases and one medical device case, all of which were for patent infringement. In about eight of those cases, which were Hatch-Waxman cases (Paragraph IV or ANDA cases), was responsible for handling the issue of "Commercial Success." That included working with experts

(economists and accountants) on financial evaluations and analyses involving pricing, marketing, and sales of pharmaceutical products. Served as co-counsel in an arbitration involving disputes over a collaboration agreement for medical devices.

Also have extensive experience with IP rights for medical devices and in the life sciences area, primarily pharmaceuticals, which included providing opinions and prosecuting patent applications in the U.S. and other countries. Participated in a due diligence evaluation of IP in an acquisition by a pharmaceutical company. And performed a valuation of the IP portfolio of a medical device startup company.

**Industry Experience**

Before becoming an attorney, worked in engineering, strategic planning, and financial analysis for several Fortune 500 companies, including major energy and chemicals companies. Performed economic and engineering feasibility studies, energy forecasting, financial analysis, project evaluation, market research and analysis, and coordination of planning efforts. Also assisted in preparing sales contracts, annual budgets, and long-range plans. Have been a Licensed Professional Engineer, Pennsylvania since 1977.

**Work History**

Of Counsel (Partner 2001-2019; Associate 1998-2000), Caesar Rivise PC, 1998-Present; Associate, Seidel Gonda Lavorgna & Monaco, 1995-1998; Partner/Associate, Rawle & Henderson, 1987-1995; Associate/Intern, Butz Hudders & Tallman, 1982-1987; Strategic Planner, Air Products & Chemicals, 1980-1982; Strategic Planner, Gulf Oil, 1979-1980; Engineer/Strategic Planner, Mobil Oil, 1974-1979; Engineer, Pennsylvania Power & Light, 1972-1974.

**Awards and Honors**

Martindale Hubbell AV Preeminent rated since 2004; Listed in The Best Lawyers in America for "Patent Law" and "Litigation - Patent" in 2013-2024; Named Pennsylvania SuperLawyer for Intellectual Property Litigation in 2004-2023; Selected "2013 Top Rated Lawyer in Commercial Litigation" and "Philadelphia Top Rated Lawyer" by American Lawyer Media and Martindale-Hubbell; Trial Advocacy Award for Achievement in the Field of Trial Advocacy, The Barristers Society, Temple University School of Law, 1985.

**Professional Associations**

Intellectual Property Owners Association (Past Vice Chair, IP Licensing Committee); Pennsylvania Bar Association (Past Co-Vice Chair of Alternative Dispute Resolution Committee; Past Delegate in House of Delegates); Bar Association of Lehigh County (Past Board Member and Past President); Philadelphia Intellectual Property Law Association; Lehigh Lawyers Association (Founder and Past Board Member); Cornell Engineering Alumni Association (Past Board Member); American Society of Mechanical Engineers (Thomas Edison Patent Award Committee, Past Chair).

**Recent  
Publications  
& Speaking  
Engagements**

PUBLICATIONS: Twelve articles on blog of Caesar Rivise, PC website, 2014-2022; Book review of Clean Tech Intellectual Property: Eco-Marks, Green Patents, and Green Innovation -- book review was published in the European Journal of Risk Regulation (EJRR), Vol. 3/2011, pp. 457-459; "'Commercial Success' in Pharmaceutical Patent Litigation and Cross-Examination of the Patent Owner's Economist," INTELLECTUAL PROPERTY TODAY magazine, April 2009.

SPEAKING ENGAGEMENTS: "Arbitration Basics," guest presentation to M.Eng. in Technical Entrepreneurship graduate students at Lehigh University, 2020 and 2019; "An Introduction to Intellectual Property for Artists and Art Organizations," Tamaqua Community Art Center, supporter of the Arts in Northeastern Pennsylvania, 2016; Panelist, "Protecting Intellectual Capital - Trade Secrets, Non-Competes, Non-Disclosures and Employment Agreements," Mid-Year Meeting of the International Association of Defense Counsel, 2012; Panelist, "Trade Secrets Basics, Protection, and Litigation," In-House Counsel CLE Seminar of American Lawyer, 2012; "Intellectual Property Basics: Protection of Competitive Assets," Entrepreneurial Studies Program, Muhlenberg College, 2011; "Intellectual Property Rights in a Global Marketplace," ASME conference on "Engineering in the Global Market: Keys for Success," 2009; Panelist and author, "Mock Expert Examination in Patent Infringement Case," 3rd Annual Intellectual Property Law Institute, Pennsylvania Bar Institute, 2009; "Proving the Elements of Inequitable Conduct - Materiality and an Intent to Deceive," Paragraph IV on Trial Conference, 2008; Panelist and co-author, "Strategies for Addressing Key Issues in Patent Claim Construction," Law Seminars International, 2007.