

Joseph E. Petersen

Partner

1080 Marsh Road , Menlo Park , CA USA 94025

t 650.614.6427 | f 650.644.0570

The Grace Building

1114 Avenue of the Americas , New York , NY USA 10036

t 212.775.8715 | f 212.775.8815

jpetersen@kilpatricktownsend.com



Services

Anti-Counterfeiting & Gray Markets

Copyright Litigation & Counseling

Intellectual Property

Online & Digital Enforcement

Trademark Litigation

Trademark, Copyright &

Advertising

Industries

Consumer Goods

Media & Entertainment

Retail & Consumer Goods

Technology

Joe Petersen focuses his practice on litigating copyright and trademark cases involving new technologies and business models. In addition to his broad copyright litigation and counseling experience, Mr. Petersen possesses substantial experience in managing large scale trademark enforcement programs and routinely protects his clients' interests in proceedings before the Trademark Trial and Appeal Board. He frequently speaks on copyright and trademark issues before national organizations and routinely advises legal publications on cutting edge copyright issues.

Mr. Petersen represented the library defendants in the suit brought by The Authors Guild and other plaintiffs against the HathiTrust Digital Library, a collaboration of more than 60 colleges, universities, and other nonprofit institutions that have pooled their collections of digitized books for the limited purposes of search, preservation and access for the print-disabled. Mr. Petersen also represents a leading wireless telecommunications company and recently helped secure a victory from the Ninth Circuit which held, among other things, that the carrier defendants had no duty to implement a Digital Rights Management system to filter allegedly infringing content exchanged over their networks. See *Luvdarts, LLC et al. v. AT&T Mobility, LLC*, 710 F.3d 1068 (9th Cir. 2013). Previously, Mr. Petersen defended independent music label Naxos of America from unfair competition claims and common law copyright claims asserted by Capital Records. That matter was ultimately certified by the Second Circuit to the New York Court of Appeals regarding questions of the reach and scope of common law copyright under New York state law.



Mr. Petersen is listed in the 2017 and the four immediately preceding editions of *Chambers USA: America's Leading Lawyers for Business* for Intellectual Property: Trademark & Copyright. *Chambers* noted that Joe Petersen "is rapidly gaining an enviable reputation as a "terrific copyright lawyer" and "has a strong practice in the protection and enforcement of trademarks" (2013). Mr. Petersen served as co-chair of the New York Chapter of the Copyright Society and regularly publishes on copyright related issues. Mr. Petersen was recommended for his copyright expertise in the prestigious 2011, 2012, 2013, 2014, 2015, 2016, 2017 and 2018 *Legal 500 US* and in 2011, Mr. Petersen was praised as "well regarded" for his knowledge of "cutting edge" copyright issues. Mr. Petersen was similarly praised in the 2008 *Chambers USA: America's Leading Lawyers for Business* for IP Trademark Copyright as being "well versed in copyright and trademark infringement claims, trade secret litigation and domain disputes." Mr. Petersen was recognized as an "IP Star" in 2019 and the six years immediately preceding by *Managing Intellectual Property* magazine. Mr. Petersen was recognized in 2017 and each of the four years immediately preceding as a New York "Super Lawyer" in the area of Intellectual Property by *Super Lawyers* magazine. He is listed in the 2018 edition of *World Trademark Review 1000 – The World's Leading Trademark Professionals*. Mr. Petersen is AV[®] rated by Martindale-Hubbell.*

In order to best serve his clients, Mr. Petersen divides his time between Kilpatrick's Menlo Park and New York offices. Mr. Petersen can be reached in Kilpatrick's Menlo Park office (650.614.6427) or in our New York office (212.775.8715).

*CV, BV, and AV are registered certification marks of Reed Elsevier Properties Inc., used in accordance with the Martindale-Hubbell certification procedure's standards and policies.

Experience

Defended a global mobility company in copyright infringement litigation alleging that mobile network carriers were liable for unauthorized sharing of plaintiffs' greeting card style MMS messages over their networks. The Ninth Circuit held, among other things, that the carrier defendants had no duty to implement a Digital Rights Management system to filter infringing content exchanged over their networks. Undeterred, the plaintiffs reformulated their case as an antitrust class action against defendants. The antitrust team with support from the copyright team again successfully defended client against the reformulated claims. See *Luvdarts, LLC v. AT&T Mobility LLC*, 710 F.3d 1068 (9th Cir. 2013).

Represents a *Fortune* 100 financial services company in trademark license negotiations and copyright issues.

Represented a leading jewelry design firm in connection with copyright litigations filed against numerous infringers of client's valuable copyrights.

Represented leading independent music label with litigation and mediation in connection with claims brought by



music label relating to pre-1972 music recordings.

The firm served as co-lead counsel for AT&T Mobility in connection with a rate court proceeding commenced by the American Society of Composers, Authors and Publishers in connection with performance of music on wireless devices and the Internet. Case was resolved by settlement.

Represented Hachette Filipacchi Media US Inc., a leading publisher of fashion magazines, in connection with lawsuit arising from termination of license agreement in New York.

Represents leading manufacturer of waterproof, breathable fabric in connection with the enforcement of the company's trademarks.

Represents a California-based *Fortune* 500 multinational corporation that designs and manufactures consumer electronics and computer software products in trademark enforcement work, including lead counsel representation of client in multiple proceedings before the Trademark Trial and Appeal Board.

Education

Vanderbilt University, J.D. (1996)

State University of New York, University at Albany, B.S. (1991) *summa cum laude*

Admissions

California

New York

Court Admissions

U.S. Court of Appeals for the First Circuit

U.S. Court of Appeals for the Second Circuit

U.S. District Court for the Eastern District of New York

U.S. District Court for the Southern District of New York

U.S. District Court for the Northern District of California

U.S. District Court for the Central District of California

U.S. District Court for the Southern District of California

Professional & Community Activities

Copyright Society of the USA, Trustee



Copyright Society of the USA, Northern California Chapter, Co-Chair

New York University School of Law, Engelberg Center Advisory Board, Member

Insights

News Releases

Kilpatrick Townsend Attorneys Named 2019 Managing Intellectual Property IP Stars

June 17, 2019

Perspectives

KT Client Success | Kilpatrick Townsend Achieves Copyright Success for adidas

June 6, 2019

In The News

The Copyright Considerations of Artificial Intelligence

July 18, 2018

News Releases

Kilpatrick Townsend Attorneys Named 2018 Managing Intellectual Property IP Stars

June 19, 2018

News Releases

Kilpatrick Townsend Receives Top Rankings from 2018 Legal 500 US

June 11, 2018

Publications

Inline Linking Put to the Test: District Court Questions Server Test and Creates Potential Circuit Split in Goldman v. Breitbart News Network, LLC

May 1, 2018

Alerts

Google's Use of Oracle's APIs Not Fair Use Under U.S. Copyright Law

April 30, 2018

Alerts

Southern District of New York's Controversial Decision Creates East Coast/West Coast Rift in Approach to Embedded Photographs



February 22, 2018

[News Releases](#)

Kilpatrick Townsends Trademark Practice Receives Gold Level Recognition in the 2018 World Trademark Review 1000

January 25, 2018

[News Releases](#)

Kilpatrick Townsend Recognized by Prestigious 2017 Legal 500 US

October 2, 2017

[News Releases](#)

Kilpatrick Townsend Attorneys Named 2017 New York Super Lawyers

September 27, 2017

[News Releases](#)

Kilpatrick Townsend Attorneys Named 2017 New York Super Lawyers

September 27, 2017

[News Releases](#)

Kilpatrick Townsend Attorneys Named 2017 Managing Intellectual Property IP Stars

June 27, 2017

[News Releases](#)

Kilpatrick Townsend Achieves Recognition From Chambers USA 2017

May 30, 2017

[News Releases](#)

Kilpatrick Townsend Launches KT Class Action Blog

January 19, 2017

[Alerts](#)

Circuit Split Remains: SCOTUS Passes on Defining Nominative Fair Use

January 19, 2017



[Alerts](#)

Key Takeaways from 2016 ACC Annual Meeting

October 27, 2016

[Alerts](#)

Key Takeaways from the Advanced Trademark Law Seminar

October 21, 2016

[Events](#)

IP Assets on the Offensive: Arming Your IP for Corporate Strategic Battles

October 17, 2016

[Publications](#)

Top Takeaways from the 2016 Advanced Trademark Law Seminar

October 10, 2016

[News Releases](#)

Kilpatrick Townsend Attorneys Named 2016 New York Super Lawyers

October 5, 2016

[Events](#)

I Walk the (Fair Use) Line: Advising the Business When the Company Wants to Use Third Party Trademarks and Names and Likenesses

September 22, 2016

[News Releases](#)

Kilpatrick Townsend Recognized by Prestigious 2016 Legal 500 US

June 20, 2016

[News Releases](#)

Kilpatrick Townsend Once Again Achieves Recognition From Chambers USA 2016

May 31, 2016

[News Releases](#)

Thirty-Two Kilpatrick Townsend Attorneys Named 2016 Managing Intellectual Property IP Stars

May 26, 2016



Events

Copyrights and Wrongs: Reforming Copyright Overreach

May 19, 2016

Events

Consumer-Related Trolls: Copyright, Trademark, and Patent

April 28, 2016

News Releases

Kilpatrick Townsend Attorneys Named 2015 New York Super Lawyers

September 30, 2015

In The News

Kilpatrick Townsend's Media Report September 11-24, 2015

September 25, 2015

Publications

Minimizing Copyright Risks When Using Open Source Software

September 1, 2015

News Releases

Kilpatrick Townsend Recognized by Prestigious 2015 Legal 500 US

July 15, 2015

In The News

Kilpatrick Townsend's Media Report May 29 - June 4, 2015

June 5, 2015

In The News

Kilpatrick Townsend Named to National Law Journal's "2015 Intellectual Property Hot List"

June 4, 2015

News Releases

Kilpatrick Townsend Once Again Achieves Recognition From Chambers USA 2015

May 22, 2015



[News Releases](#)

Kilpatrick Townsends Joe Petersen Featured Panelist at Digital Media Conference

May 11, 2015

[News Releases](#)

Twenty-Nine Kilpatrick Townsend Attorneys Named 2015 Managing Intellectual Property IP Stars

May 6, 2015

[Alerts](#)

Understanding B & B Hardware and Strategic Responses to the Opinion

March 31, 2015

[In The News](#)

Kilpatrick Townsend's Media Report December 19, 2014 - January 8, 2015

January 9, 2015

[Publications](#)

Traveling in the Fast Lane — Accelerated Case Resolution for Trademark Disputes

December 1, 2013