# PAUL A. COLETTI

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# INTELLECTUAL PROPERTY ATTORNEY

# Trusted Third-Party Neutral Providing Expert Mediation and Arbitration for Complex Disputes

Accomplished intellectual property attorney now arbitrating and mediating intellectual property cases, bringing deep expertise in patent, litigation, licensing, prosecution, trademark, and copyright disputes. Proven track record of negotiating settlements, managing high-stakes IP disputes, and advising stakeholders on alternative dispute resolution (ADR) strategies. Adept at facilitating fair and efficient resolutions that minimize litigation risks and costs. Influential, approachable communicator and valued collaborator with extensive experience building credibility and trust, gaining executive buy-in on ideas and strategies. Proven expertise in handling high-stakes litigations, M&A due diligence, and freedom-to-operate analyses across medical devices, pharmaceuticals, and consumer products. Adept at leading global IP teams and aligning IP strategy with business objectives.

#### **SPECIALTIES**

All Manners of Intellectual Property Law Including: Patent Litigation, Licensing, Prosecution, Trade Secrets, Trademarks, Medical Devices, Pharmaceutical Licensing, Business Development

#### **SKILLS**

Intellectual | Strategy Alignment | Mediation | Mergers & Acquisitions (M&A) | Astute | US Patents & Patent Applications Intellectual Property | Registered Patent Attorney | Patent Related Licensing | Arbitration & Mediation Techniques Alternative Dispute Resolution (ADR) | IP Litigation Strategy & Settlement Negotiations | Neutral Case Evaluation

### **EXPERIENCE**

MEDIATOR/ARBITRATOR 2005-

Accomplished intellectual property attorney transitioned into arbitration and mediation, bringing deep expertise in patent, litigation, licensing, prosecution, trademark, and copyright disputes.

JOHNSON & JOHNSON, New Brunswick, NJ

1987 - 2024

### Vice President, MedTech IP Strategy and Associate Patent Counsel

2023 - 2024

Managed J&J MedTech patent team, with an emphasis on strategy, including high leverage litigations, strategic licensing, important patent prosecution and management of the MedTech IP team in India.

- Directed the strategic assessment and management of IP implications for a major medical device acquisitions, mitigating legal risks, securing a significant number of key patents, and ensuring seamless integration of critical technologies.
- Led the team responsible for in-house patent search due diligence, uncovering critical insights that facilitated a smooth acquisition of protection by key intellectual property assets.
- Urged reforms of patent law through organizations in Washington, DC, strengthening intellectual property protections and fostering innovation.

Associate Patent Counsel 2002 – 2023

Directed patenting activities of Johnson & Johnson subsidiaries, including patent prosecution, freedom to operate opinions, litigation and counsel. Protected the company's intellectual property (IP) assets while supporting innovation across various business sectors, including pharmaceuticals, medical devices, and consumer health products. Litigations included all forms of adversarial patent proceedings, including both medical device and pharmaceutical patent infringement matters, oppositions, inter partes review, and reexaminations and interferences. Managed staff of 100+ for J&J MedTech IP group, including 55+ attorneys. Continued to practice in front of the USPTO.

#### **JOHNSON & JOHNSON – Continued**

- Led high-stakes patent litigations in the field of coronary stents, achieving favorable outcomes that safeguarded market share and protected over \$1BB in annual revenue.
- Supervised multiple IP due diligences of medical device company acquisitions, identifying key assets and risks, which
  contributed to successful transactions and long-term portfolio growth.
- Evaluated IP-related aspects of J&J IPO investments across diverse technologies, mitigating potential legal challenges and optimizing investment returns.
- Supervised and personally conducted numerous freedom-to-operate studies, providing strategic guidance that enabled J&J companies to enter new markets with confidence while minimizing infringement risks.

## ADDITIONAL RELEVANT EXPERIENCE

JOHNSON & JOHNSON, New Brunswick, NJ, Senior Patent Attorney, Patent Attorney

1987 - 2002

WILLIAN BRINKS OLDS GILSON & LIONE LTD., Chicago, IL, Associate Attorney

#### **EDUCATION**

- Juris Doctorate (JD), Law, University of Notre Dame Law School, Notre Dame, IN
- Master of Science (MS), Mechanical Engineering, Purdue University, West Lafayette, IN
- Bachelor of Science (BS), Mechanical Engineering, Tandon School of Engineering, New York University, Brooklyn, NY

### **LICENSES & CERTIFICATIONS**

- World Intellectual Property Office (WIPO) List of Approved Neutrals (mediation and arbitration)
- Northwestern University, Certificate in Mediation Skills comprehensive 40-hour evaluation and training
- Chartered Institute of Arbitrators (CIArb.) Completed course for path to Fellowship
- Standing Advisory Committee for the European Patent Office (SACEPO) European Patent Office
- ITAC 14 for Intellectual Property US Department of State US Trade Representative, 2014 Expires: 2026
- Licensed Attorney Supreme Court of New Jersey, 011801988
- Licensed Attorney Attorney Registration and Disciplinary Commission of the Supreme Court of Illinois, 6170931
- Registered Patent Attorney USPTO, 32019

# **HONORS & AWARDS**

- Awarded Corporate IP Stars Managing Intellectual Property, 2015 2024
- Juror, Leaders League Alliance Summit, 2023 2024
  - Served on International Jury Evaluating Best Law Firms Worldwide
- Top Intellectual Property Counsel First Chair, 2017
- Intellectual Property Individual of the Year Association of Corporate Counsel
- Inventor, Balloon Catheter with Radioactive Means US 5863285
- Inventor, Endoscopic Stapler and Hernia Repair Mechanism US 5174487
- Author of Multiple Intellectual Property Articles and Publications