

HARVEY & COMPANY

INTELLECTUAL PROPERTY LAW

CURRICULUM VITAE



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Peter Harvey's practice emphasizes trademark, trade dress, copyright, trade secrets, and unfair competition litigation in U.S. federal courts. He also advises on IP rights clearance, registration and management. He has assisted clients in a wide variety of industries, including alcoholic beverages, athletic footwear, banking, computer hardware and software, food, wine, motorcycles, music and video, paper products, publishing, and communications, and including high-technology businesses headquartered on the West Coast.

Mr. Harvey's more significant cases include representing an Italian motor scooter manufacturer against a former Indian licensee selling infringing copies of the scooter ([Piaggio & C.S.p.A. v. Bajaj Auto, Ltd.](#)); securing a defense verdict following a jury trial against a Canadian creator of classical music products for children, and its U.S.-based distributor, in a trademark infringement action ([Mavrides v. Hammond](#)); defending a trademark infringement action brought by Jacques Cousteau and The Cousteau Society against Mr. Cousteau's son arising out of the latter's use of the Cousteau name in connection with a luxury eco-resort in the Fiji Islands ([The Cousteau Society v. Post Ranch](#)); and securing the Ninth Circuit's affirmance of a summary judgment involving tequila bottle trade dress ([E. & J. Gallo Winery v. Proximo Spirits, Inc.](#))

Mr. Harvey is listed in *Who's Who Legal* and World Trademark Review's WTR1000 as a recognized international expert in trademark law and has been honored among *Northern California Superlawyers* for a number of years. He is active in the International Trademark Association (INTA). He serves on INTA's Trademark Mediators Network, which offers alternative dispute resolution services in intellectual property related matters. He was an INTA board member in 1994-1996 and has chaired several INTA committees, including the International, Forums, Meetings and Alternative Dispute Resolution Committees. He served as INTA's Counsel in 2008-2009 and received the INTA President's Award in November, 2012. Mr. Harvey is also a member of the American Bar Association and has chaired its Intellectual Property Law Section subcommittees on the federal trademark dilution law and the right of publicity. Since 2001, Mr. Harvey has taught Entertainment & Media Law as an Adjunct Professor at the University of San Francisco School of Law. He was honored as the Adjunct Professor of the Year in May, 2013.

Mr. Harvey is a frequent speaker and widely-published author. He is currently co-authoring the Federal Judicial Center's *Trademark Case Management Judicial Guide* for Federal judges, to be published in May, 2017. He co-authored "Shoot First and Ask Questions Later? The Impact of *MedImmune v. Genentech* on Declaratory Judgment Actions in Trademark Disputes," in *The Trademark Reporter* (2010). He presented "Secondary Liability for Online Sale of Counterfeits: Interests, Policies, Proof and Best Practices," at the J. Thomas McCarthy Institute Symposium on The Brand as Property (2009); "Trademark Ethics: Prosecution, Policing, Pretexting and Foreign Practice," at the International

Congress of AIPPI (2008); and “Trademarks, Celebrities, and the Good Deed: Using Celebrity Branding for the Public Good” at the American Bar Association Annual Meeting (2007).

Mr. Harvey graduated *magna cum laude* in economics and with distinction in all subjects from Cornell University’s College of Arts and Sciences and received his law degree from Yale Law School. He has practiced law in San Francisco since 1973. Contact Peter Harvey at peter@harvey.law.

PRESENTATIONS & PAPERS

Panel discussion with Judges Pierre Laval and Alex Kozinski and David Bernstein on “Issues in Trademark Case Management,” for Intellectual Property in the New Technological Age – A Conference for Federal Judges Sponsored by the Federal Judicial Center and the Berkeley Center for Law & Technology, Berkeley, California, May, 2016.

Paper entitled “Geographical Indications: The United States Perspective” and panel presentation with Irene Calboli, Julia Holden and Latha Nair on “Trademarks and Geographical Indications,” at the International Trademark Association’s conference entitled “When Trademarks Overlap with Other IP Rights,” Munich, Germany, December, 2014.

Panel discussions with Annette Hurst, Kathryn Fritz and David Bernstein on “Issues in Trademark Case Management,” for Intellectual Property in the New Technological Age – A Conference for Federal Judges Sponsored by the Federal Judicial Center and the Berkeley Center for Law & Technology, Berkeley, California, May, 2011 through May, 2015.

Panel discussion with Kathryn Fritz on “Trademark Case Management: Legal Principles, Discovery and Settlement,” before the Federal Magistrate Judges of the Central District of California, Ojai, California, March, 2012.

Moderator and panelist with Mei-lan Stark, David Bernstein, and Michael Cassels, “Tips for Mastering the Art of Effective Oral Presentation,” at the 133rd Annual Meeting of the International Trademark Association, San Francisco, California, May, 2011.

Moderator and panelist with J. Thomas McCarthy and David J. Franklyn, “Walking the Walk: Effective Teaching Methods for Adjunct Trademark Law Professors,” at the 133rd Annual Meeting of the International Trademark Association, San Francisco, California, May, 2011.

Moderator and panelist with Ellen Shankman, Roger Schechter, Dan Dougherty, and James Swire, “Secondary Liability for Online Sale of Counterfeits: Interests, Policies, Proof and Best Practices,” at the J. Thomas McCarthy Institute Symposium on The Brand as Property, San Francisco, California, November, 2009.

Panel discussion with Laura Covington, Dan Dougherty, Julia Holden, and Bruce Longbottom on “Stopping Online Counterfeiters: Whose Job Is It?” at INTA’s Trademark Law and the Internet symposium, San Francisco, California, February, 2009.

Presentation and paper with William Raman on “Order in the Court: Best Practices in Trademark Litigation Procedure” at the Law Education Institute, Vail, Colorado, January 2009.

Panel presentation and paper with Michael Charles, Catherine Mennenga, and Elizabeth Ann Morgan on “Trademark Ethics: Prosecution, Policing, Pretexting and Foreign Practice,” at the International Congress of AIPPI, Boston, Massachusetts, September, 2008.

Panel discussion and paper with William Raman, Jaime Schwartz and Verena von Bomhard on “Undressing Trade Dress, 2008: Where Are We?” at the International Trademark Association’s Advanced Trademark Symposium, Grapevine, Texas, March 2008.

Presentation and paper on “Trademarks Rock: Ownership of Band Names After a Break-Up” at the Law Education Institute, Vail, Colorado, January 2008.

Panel presentation and paper with Catherine Mennenga and Elizabeth Morgan on “Prosecution, Policing, Pretexting and Foreign Practice” at the Intellectual Property Owners Association Annual Meeting, New York, New York, September 2007.

Presentation and paper on “Privilege and Ethical Limits on Using Investigators in IP Licensing Matters” at Law Seminars International, Seattle, Washington, August 2007.

Panel presentation and paper with Helen Hill Minsker, Daniel Levin, and Daniel F. Feldman on “Trademarks, Celebrities, and The Good Deed: Using Celebrity Branding for the Public Good” at the American Bar Association Annual Meeting, San Francisco, California, August 2007.

Presentation and paper on “The Declaratory Judgment Response to a Cease & Desist Letter: ‘First to File’ or ‘Procedural Fencing?’” at the Law Education Institute, Aspen, Colorado, January 2007.

Panelist, with Michael Cassels, Karen Feisthamel and Kwan-To Li, in presentation on “Taking the Ethical Path,” at the Leadership Meeting of the International Trademark Association, Phoenix, Arizona, November 2006.

Paper on “Privilege and Ethical Limits on Investigations in Trademark Cases,” presented at 128th Annual Meeting of the International Trademark Association, Toronto, Ontario, Canada, May 2006.

Presentation and paper on “Buildings, Bears and Megabytes: The Copyright Year in Review, 2005” at the Law Education Institute, Aspen, Colorado, January 2006.

Presentation and outline on “*MGM Studios v. Grokster*: What Good Is That iPod?” sponsored by the Bar Association of San Francisco’s Intellectual Property Section, San Francisco, California, September 2005.

Moderator and panelist, with Bruce Keller, Stefan Voelker and Tony Grana, in presentation on “Product Placement and Misplacement: The Good, the Bad and the Ugly,” 127th Annual Meeting of the International Trademark Association, San Diego, California, May 2005.

Presentation and paper on “Fair Use in Copyright, Publicity and Trademark Litigation,” at the Law Education Institute, Aspen, Colorado, January 2005.

Participant in three-day Advanced Trademark Litigation presentation on preliminary injunction practice at the 126th Annual Meeting of the International Trademark Association, Atlanta, Georgia, May 2004. Accompanying paper published as part of conference materials.

Presentation with Jeremy Feigelson on “Practical Ethics for the IP Practitioner,” at the Law Education Institute, Aspen, Colorado, January 2004.

Presentation entitled “Beyond Victoria’s Secret: Proving ‘Actual Dilution,’” at the Barristers Club of San Francisco Intellectual Property Section panel on “Trademark Dilution and Damages,” San Francisco, June 2003.

Presentation on panel with Bradley Hartman, Alex Kozinski and Robert Lattinville, entitled “Fair or Foul: Using the Intellectual Property, Identity, and Images of Others Without Consent or Liability,” at the 70th Annual Convention of the State Bar of Arizona, Scottsdale, Arizona, June 2003.

Presentation on “The Children’s Online Privacy Protection Act: A Trap for the Unwary Online Marketer,” at the Cosmetic, Toiletry, and Fragrance Association’s Legal & Regulatory Conference, Santa Fe, New Mexico, May 2003.

Presentation on “Two Ethics Issues in U.S. Trademark Practice: Ethical Concerns in Using Investigators and Avoiding Pitfalls in the Joint Defense Privilege” at the session on “Ethics and Privilege in Litigation” at the 125th Annual Meeting of the International Trademark Association, Amsterdam, The Netherlands, May 2003. Accompanying paper published as part of conference materials.

Presentation on “Music and Other Content Distribution on the Internet,” at the Law Education Institute, Aspen, Colorado, January 2003.

Presentation on “Digital Distribution of Music and Other Entertainment Content: The State of Play,” at the Center for International Legal Studies Conference on “Lawyering in the International Market,” Valle Nevado, Chile, August 2002. Accompanying paper published as part of conference materials.

Presentation on “Copyright Joint Works and Implied Licenses: Sorting Out Authorship and Use Rights,” Law Education Institute, National CLE Conference, Steamboat Springs, Colorado, January 2002. Presentation published as chapter in LEI conference proceedings.

Co-chair of Practising Law Institute (PLI) program on “Strategies for Litigating Copyright, Trademark & Unfair Competition Cases,” San Francisco, California, December 2001 and October 2002, and New York City, October 2002. Presentation of paper on “Seven Strategies for Highly Effective Trademark Injunction Motions” published as chapter in related PLI coursebook.

Co-chair of Practising Law Institute (PLI) program on “Litigating Copyright, Trademark & Unfair Competition Cases for the Experienced Practitioner,” San Francisco, California, December 2000. Presented paper on “Insurance for IP Cases: The Coverage Debate,” December 2000. Presentation published as chapter in PLI book, and also as part of papers delivered at the Law Education Institute, Vail, Colorado, January 2001.

Presentation on “Maintaining Intellectual Property Rights Through Registration, Proper Use and Contractual Provisions,” Protecting Your Intellectual Property Assets, Practising Law Institute (PLI), New York City, March 1997, July 1998, July 1999, July 2002 and San Francisco, December 2000, July 2001 and July 2002. Presentation published as chapters in related PLI course books.

Presentation on “Insurance for Intellectual Property Disputes” to the Alameda County Bar Association, Intellectual Property Committee, November 2000.

Presentation on “The Right of Publicity: Past, Present and Future” at the International Trademark Association’s Annual Meeting, Denver, Colorado, May 2000. Accompanying paper published as part of meeting materials.

Presentation on “Using ADR In False Advertising Disputes” at Forum on False Advertising sponsored by the National Advertising Division of the Better Business Bureaus and the International Trademark Association, New York City, April 2000.

Co-chair of Practising Law Institute (PLI) program on “Litigating Copyright, Trademark & Unfair Competition Cases for the Experienced Practitioner,” San Francisco, California, December 1999. Presented paper on “Scandals, Skits and Search Engines: The Trademark Year in Review, 1999.” Presentation published as chapter in PLI book, and also as part of papers delivered at the Law Education Institute, Vail, Colorado, January 2000.

Presentation on “Using the Internet to Police Your Mark” at International Trademark Association Trademark Administrator’s Forum, San Francisco, California, September 1999.

Presentation on “A Music Law and Business Primer for Trademark Lawyers,” at International Trademark Association’s Annual Meeting, Seattle, Washington, May 1999. Accompanying paper published as part of meeting materials.

Presentation on “Two Hot Topics in Intellectual Property Law: The Right of Publicity and the Doctrine of Inevitable Trade Secret Misappropriation” to the Alameda County Bar Association, Intellectual Property Committee, February 1999.

Co-chair of Practising Law Institute (PLI) program on “Litigating Copyright, Trademark & Unfair Competition Cases for the Experienced Practitioner,” San Francisco, California December 1998. Presented paper on the doctrine of “inevitable” trade secret misappropriation, also published as chapter in PLI book.

Presentation on “‘Inevitable’ Trade Secret Misappropriation After *Pepsico, Inc. v. Redmond*,” in Practising Law Institute’s Fourth Annual Institute on Intellectual Property Law, San Francisco, California, November 1998. Presentation published as chapter in PLI book.

Presentation on “Robots, Voices and Videotapes: Recent Developments in the Right of Publicity,” American Bar Association, Intellectual Property Section, Summer Conference, Williamsburg, Virginia, June 1998.

Co-chair of Practising Law Institute (PLI) program on “Litigating Copyright, Trademark & Unfair Competition Cases for the Experienced Practitioner,” San Francisco, December 1997. Presented paper on “1997 Trademark Litigation Update,” also published as chapter in PLI book.

Presentation on “Monetary Recovery in Trademark Cases,” 21st Annual Intellectual Property Institute, California State Bar Intellectual Property Law Section, San Jose, California, November 1996.

Presentation on “Trade Secret Audits: Risks of Loss and Strategies for Protection,” Conducting Intellectual Property Audits, Practising Law Institute (PLI), New York, February 1996. Presentation published as a chapter in PLI course book, co-authored by Jeffery Anne Tatum, General Counsel of Chips and Technologies, Inc.

Presentation on “Structuring Employment Relationships to Ensure Ownership and Control of Intellectual Property,” Conducting Intellectual Property Audits, Practising Law Institute, New York, February 1995. Presentation published as a chapter in PLI course book.

Presented paper on “Efforts Under GATT, WIPO, and Other Multinational Organizations Against Trademark Counterfeiting,” Waidring Conference on Trademark Law, Waidring, Austria, March 1993. Paper reprinted in *European Intellectual Property Review*, December 1993.

Co-chair of INTA Forum “Successful Strategies in Trademark Litigation,” Tokyo, Japan, October 1993. Presented paper on “United States Trademark Trial Practice: Principal Events in the Typical Trademark Infringement Lawsuit.”

Presentation on “Extraterritorial Jurisdiction Under the Lanham Trademark Act,” American Bar Association, International Law Section program on Extraterritorial Application of U.S. Law, 1985. Presentation published in *The Computer Lawyer*, November 1985.

ARTICLES

“Defining Trade Dress,” with Naomi Jane Gray, *The Recorder*, Vol. 136, No. 18, April 30, 2012.

“Shoot First and Ask Questions Later? The Impact of *MedImmune v. Genentech* on Declaratory Judgment Actions in Trademark Disputes,” with Seth I. Appel, *The Trademark Reporter*, Volume 100, No. 5, September-October, 2010.

“Privilege and Ethical Limits on Using Investigators in IP Licensing Matters,” *The Licensing Journal*, Volume 27, Number 10, November-December 2007

“The Declaratory Judgment Response to a Cease and Desist Letter: ‘First-to-File,’ or ‘Procedural Fencing?’” with Seth I. Appel, *The Trademark Reporter*, Vol. 96, No. 3, May-June, 2006.

“Ethics and Privilege in the Digital Age,” with David H. Bernstein, *The Trademark Reporter*, Vol. 93, No. 6, November-December, 2003.

“A Music Law and Business Primer for Trademark Lawyers,” University of San Francisco *Intellectual Property Law Bulletin*, Vol. 5, Spring 2000, Number 1.

“Ad Campaign,” *Intellectual Property*, February 12, 1998.

“Applying United States Intellectual Property Laws Abroad: Trademarks, Copyrights and Extraterritoriality,” *Entertainment and Sports Lawyer*, publication of American Bar Association Forum on the Entertainment and Sports Industries, Vol. 15, No. 3, Fall 1997.

“Holler Over Harley,” *California Law Business*, October 27, 1997.

“Publicity Right Remains a State-Law Phenomenon,” *The National Law Journal*, May 12, 1997.

“Mark of Distinction,” San Francisco and Los Angeles *Daily Journal*, April 24, 1997.

“Dilute Disputes: Federal Protection for Famous Names,” San Francisco and Los Angeles *Daily Journal*, March 7, 1997.

“Money Orders: Damage Awards in Trademark Cases,” San Francisco and Los Angeles *Daily Journal*, October 18, 1996.

“Identity Crisis: Personal Names as Trademarks,” San Francisco and Los Angeles *Daily Journal*, August 16, 1996.