

# Robert E. Chudakoff

Partner



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## Practices/Industries

- IP Litigation
- Trademark/Copyright Litigation
- Patent Litigation
- eDiscovery

## Education

Miami University  
(B.A., 1984)  
Case Western Reserve  
University School of Law  
(J.D., 1987)

## Overview

Rob has extensive experience in the defense and prosecution of intellectual property claims. He practices in trademark, trade dress and copyright infringement, false designation of origin, unfair competition and deceptive trade practices, and false advertising matters. Rob also has comprehensive experience in software and technology matters, including both prosecution and defense of software development contract disputes. Rob combines a deep background in technology and business litigation including computer, software, internet and e-commerce matters. Rob serves as chair of the firm's Security Committee, which guides policy and protection for client data within the firm. He has achieved the highest ranking, AV Preeminent<sup>®</sup>, from Martindale-Hubbell<sup>®</sup> and has been named to the Ohio Super Lawyers list.

Rob serves on the Blockland Cleveland Legal Node. The Blockland initiative exists to educate and promote real-world blockchain applications, while establishing and leading a blockchain ecosystem with support from private, public, and philanthropic individuals and organizations.

Rob is also a member of the firm's eDiscovery Practice Group. He has significant and substantive experience in all phases of the eDiscovery process, including assessing client systems, assisting clients with identification, preservation, collection, processing and review of electronically stored information, selecting the right eDiscovery vendor, negotiating reasonable and efficient eDiscovery protocols with opposing counsel and litigating eDiscovery disputes when they arise. Rob is the Chair of the firm's Litigation Support Users Group, which provides an effective interface between the firm's attorneys and its IT and Litigation Support professionals."

Rob also has over 30 years of experience handling complex insurance coverage and bad faith litigation in both federal and state court. He is a former Vice-Chair of the ABA's Property Insurance Law Committee and Past President of the National Society of Professional Insurance Investigators. Rob has successfully defended insurance carriers in a variety of bad faith cases including allegations of failure to settle liability claims and wrongful coverage denial. He also brings a wealth of jury trial experience in this field.

## Experience

- Extensive jury trial experience in both state and federal courts.
- Extensive experience since 1987 in the defense and prosecution of intellectual property claims, including statutory and common law trademark and trade dress infringement, copyright infringement, false designation of origin, unfair competition and deceptive trade practices, and false advertising.
- Comprehensive experience handling and litigating various software and technology disputes, including defense of system integrators in litigation concerning implementation of ERP software solutions.
- Ohio counsel for Microsoft Corporation in anti-piracy litigation (copyright/trademark infringement and trademark counterfeiting).

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## Experience (Cont)

- Ohio counsel for Broadcast Music, Inc. (BMI) in copyright infringement litigation regarding unauthorized performance of musical compositions in the BMI repertoire.
- Counsel for Jo-Ann Stores, LLC, a leading national specialty retailer of crafting, decorating, and sewing products, handling traditional intellectual property litigation matters involving patent, trademark and copyright infringement, as well as domain name and other Internet and e-Commerce issues and disputes.
- Successfully defeated a motion for temporary restraining order in a patent case, allowing a client manufacturing company to participate in a critical industry tradeshow.
- Successfully appealed a trade dress protection case for a market newcomer accused of copying a large competitor's unpatented grease pump. The Sixth Circuit reversed the decision and saved the client \$2 million in damages.
- Represented hundreds of automobile dealerships in Lanham Act false advertising litigation in federal district court.
- Seasoned trial experience in business litigation, with extensive knowledge of computers, software, Internet and e-Commerce law.

## Reported Cases

- *Broadcast Music, Inc. v. J & S Entertainment, Inc.*, 2015 WL 1728235 (N.D. Ohio 2015) (representing BMI, obtained judgment and statutory damages award for copyright infringement arising from unauthorized public performance of musical compositions).
- *Broadcast Music, Inc. v. Reisner*, 2014 WL 1761582 (N.D. Ohio 2014) (representing BMI, obtained judgment and statutory damages award for copyright infringement arising from unauthorized public performance of musical compositions).
- *Broadcast Music, Inc. v. Pub Acquisition, LLC*, 2014 WL 2993661 (N.D. Ohio 2014) (representing BMI, obtained judgment and statutory damages award for copyright infringement arising from unauthorized public performance of musical compositions).
- *Broadcast Music, Inc. v. Meadowlake, Ltd.*, 754 F.3d 353 (6th Cir. 2014) (representing BMI, successfully defended summary judgment and statutory damages award in copyright infringement action on appeal helping develop Sixth Circuit law on personal liability of corporate officers and owners for copyright infringement).
- *Altronic, LLC v. Green*, 2013 WL 6145133 (N.D. Ohio 2013) (successfully defeated motion for summary judgment against invalidity defense in a patent infringement case).
- *Carson Optical, Inc. v. Prym Consumer USA, Inc. and Jo-Ann Stores, Inc.*, 2013 WL 1209041 (E.D.N.Y. 2013) (representing Jo-Ann Stores in design patent and trade dress case; obtained dismissal of trade dress, unfair competition and other tort related claims).
- *Broadcast Music, Inc. (BMI) v. Meadowlake, Ltd.*, 2013 WL 3927793 (N.D. Ohio 2013) (representing BMI, obtained summary judgment and statutory damages award in copyright infringement action for unauthorized performance of musical compositions).
- *Altronic, LLC v. Green*, 2012 WL 6113677 (N.D. Ohio 2012) (successfully defeated motion for temporary restraining order in a patent infringement case).
- *Microsoft Corp. v. McGee*, 490 F. Supp. 2d 874 (S.D. Ohio 2007) (represented Microsoft in software piracy case and obtained judgment for statutory damages in excess of \$713,500 for copyright and trademark infringement and trademark counterfeiting).

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## Reported Cases (Cont)

- *Microsoft Corp. v. 9038-3746 Quebec, Inc.*, 2007 U.S. Dist. LEXIS 83669 (N.D. Ohio 2007) (represented Microsoft in software piracy case for copyright and trademark infringement and related claims; obtained temporary restraining order freezing certain business assets of Defendants).
- *Pietrangelo v. Lorain Cty. Pr. & Pub. Co.*, 2017-Ohio-8783, 100 N.E.3d 1028 (Ohio Ct. App., 2017), *app not allowed sub nom. Pietrangelo v. Lorain Cty. Printing & Publg. Co.*, 153 Ohio St. 3d 1468; 106 N.E.3d 65 (2018) (obtained dismissal of defamation action against newspaper and successfully defended same on appeal).

## Presentations

- "Practicing Law in Ohio During a Pandemic," Thomson Reuters Webinar (September 2021)
- "Guilt By Association: What Is Good Faith Reliance On Your Expert?" National Society of Professional Insurance Investigators 2007 Annual Advanced Insurance Fraud Seminar, Indianapolis, Indiana (November 2007)

## Publications

- "E-Commerce in Ohio: Legal and Business Issues," Co-author, *National Business Institute, Inc.* (December 2000)
- "Recent Developments in Property Insurance Law," Lead author, *Tort & Insurance Law Journal* (Vol. 35, No. 2 Winter 2000)
- "Property Insurance Annotations: Fire and Extended Coverages," Contributing author, TTIPS Property Insurance Law Committee (3d ed. 1998)
- "Special Investigations," Law of Claims Fraud Investigation and Defense, *American Educational Institute, Inc.* (1992)

## Involvement

### Professional Affiliations

- Federal Bar Association – Northern District of Ohio Chapter (*Board of Directors*)
- American Bar Association (*Section of Intellectual Property, Section on Tort, Trial and Insurance Practice "TTIPS", Former Vice-Chair, Property Insurance Law Committee*)
- Cleveland Metropolitan Bar Association
- American Intellectual Property Law Association
- Intellectual Property Owners (IPO) Association
- Cleveland Intellectual Property Law Association
- Blockland Cleveland Legal Node
- National Society of Professional Insurance Investigators (*Past President, National and Ohio Chapter*)

### Firm Involvement

- Security Advisory Board, Chair

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## Honors & Distinctions

- Named to the Ohio Super Lawyers list (2013-2022)
- AV Preeminent Peer Review Rated – Martindale-Hubbell
- Certified Professional Insurance Investigator

## Admissions

- State of Ohio
- U.S. Court of Appeals, Sixth Circuit
- U.S. District Court, Northern District of Ohio
- U.S. District Court, Southern District of Ohio
- U.S. District Court, Central District of Illinois