

Trademarks, Copyrights & Trade Secrets

Intangible business assets—including all manner of brand names, logos, and trade dress—are of inestimable value. An effective trademark promotes goodwill in the marketplace, distinguishes your business from its competitors, and confers value, exclusivity, and quality.

Our Trademarks, Copyrights & Trade Secrets Practice Group offers clients the services they need to clear, register, and enforce their trademark rights. Yet successful trademark management goes far beyond clearance searches and prosecution of applications; it is a vital part of a comprehensive, long-term branding strategy. Our trademark team combines a practical, strategic business perspective with extensive legal experience to help our clients develop and protect the integrity of their brands.

The firm manages the national and global trademark portfolios of hundreds of clients that span a diverse array of industries and range in size from emerging companies to multinational corporations. Experienced in international jurisdictions, our team regularly calls on a carefully selected network of foreign trademark counsel to facilitate our work on a global scale. Our full range of trademark services also includes corporate transactions and related agreements as well as dispute resolution.

Our successful track record has not gone unnoticed. We are consistently listed among the preeminent trademark practices in *World Trademark Review 1000 – The World's Leading Trademark Professionals*.

Trademark Clearance and Prosecution

We counsel clients with respect to name or logo availability, assess business risks associated with the adoption of marks, and work with clients to maximize the value of their trademarks. Our trademark team offers keen business insight into how a potential trademark aligns with clients' overall business goals.

During the clearance process, we conduct extensive availability searches for similar marks already in use or registered by other parties within the United States and other relevant jurisdictions. Sensitive to the pace of business, we clear marks quickly and efficiently. Once the marks are cleared, we prosecute clients' trademark applications through the examination process, serving as forceful and effective advocates before trademark registration agencies.

Beyond registration, we counsel clients on how best to leverage and protect their marks and create brand extension opportunities. We customize presentations and manuals to guide our clients on the effective use, protection, and extension of trademarks. Our docketing specialists manage our clients' global trademark portfolios while monitoring third-party trademark applications in order to alert clients to potential threats to their brands. We offer read-only access enabling clients with real-time view of their trademark portfolios.

Corporate Transactions

We have extensive experience negotiating and drafting agreements governing the use of trademarks and other types of intellectual property in a wide variety of industries. They include agreements for coexistence and concurrent use, assignments, consents, manufacturing, private labeling, distribution, collaboration, marketing ventures, and licensing.

We also represent buyers and sellers in complex corporate transactions that involve trademark assets. During the purchase or sale of a trademark, we conduct due diligence to ensure that the assets are valued appropriately, confirm registration details in the United States and in other jurisdictions, evaluate the chain of title, and appraise the significance of any liens, assignments, or restrictions that might be in place.

Team lawyers assist our clients in perfecting security interests with respect to intellectual property rights, and also help them draft disclosure statements relating to such properties. When conducting audits, our trademark attorneys also turn a critical eye on clients' portfolios to help maximize the value of key brands, ensure adequate and accurate coverage, as well as reduce maintenance costs associated with tertiary brands.

Enforcement

We have extensive experience enforcing and defending intellectual property in oppositions, cancellations, and appeals before the Trademark Trial and Appeal Board. Our trial-ready lawyers have a proven success record in litigating trademark infringement cases and related claims in federal and state courts.

Domain Names and Online

Clients benefit from our significant experience handling international domain name disputes before the World Intellectual Property Organization and similar dispute resolution organizations. Our trademark team works to ensure that our clients' trademarks are not abused by cybersquatters and other misuses on the internet. We also provide strategic counsel on other pertinent online branding issues, such as infringement of trademarks on social media and through the use of internet keywords in online advertising campaigns.

Trade Secrets

We take a proactive approach to preventing misappropriations of trade secrets, whether by outgoing executives, unscrupulous partners, or hackers. Our trade secrets team regularly helps clients establish information protection programs to safeguard sensitive business information. Clients value our experience in resolving issues resulting from the violation of non-compete and non-disclosure agreements and other trade secret breaches.

Copyright

Clients rely on us to provide strategic guidance in helping them protect, register, and manage original copyrightable content such as books, websites, logos, computer software, music,

photographs, and artwork. Our team includes experienced litigators who have an outstanding record of success in enforcing clients' rights and defending their work against infringement claims.

EXPERIENCE

- > We defended Distinctive Assets, a high-end, niche marketing company that offers celebrity and product placement opportunities within the entertainment industry, against suit filed from the Academy of Motion Picture Arts and Sciences (AMPAS), the owner of the OSCARS trademark used in connection with The Academy Awards. We swiftly negotiated a confidential settlement which permits our client's continued nominative, fair use of the AMPAS trademarks, avoiding expensive litigation and delays to Distinctive Assets' nominee gift bag event.
- > In an ongoing engagement, we continue to serve as Bayer's go-to counsel to support a wide variety of U.S. and international counselling, brand watching, label review and enforcement in connection with many of its marquee consumer brands, as well as its exclusive US counsel for trademark availability opinions across all Bayer entities.
- > We handled all aspects of expedited clearance of hundreds of candidate trademarks and logo designs in more than 60 countries across a dozen categories of goods and services for a global manufacturer of performance materials and specialty chemicals for the life sciences, advanced technologies and research industries in connection with client's acquisition of a leading supplier and distributor of laboratory supplies, equipment and chemicals. Additionally, we are handling all of the global clearance, prosecution, and enforcement for the new combined company, which will be a global player in manufacturing and supply chain solutions for the life sciences, advanced technologies, aerospace and research industries.
- > On the eve of a major tech client's initial public offering, we expeditiously managed the clearance and prosecution efforts to increase coverage of the client's house mark as well other sub-brands in connection with significant global expansion.
- > We represent one of the largest manufacturers of specialized hydrocarbon products in the world. This work includes addressing and negotiating key issues such as development, allocation of intellectual property ownership, licensing and control for the new product line, market allocation, implementation strategy, downstream liability and pricing structure.
- > We helped devise enforcement strategy for major footcare retailer to curtail knockoffs of branded products by private label.
- > We serve as plaintiff's counsel in an ongoing opposition seeking to bar registration of client's application to register a mark in the U.S. that comprises our client's long-term common law mark.

HONORS & AWARDS

- > **World Trademark Review (2012-2019)**
Recognized among leading global trademark practitioners
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Listed among the preeminent trademark practices in *World Trademark Review 1000 - The World's Leading Trademark Professionals*
- > **World Trademark Review (2019)**
Recognized among leading global trademark practitioners
- > **Leadership Council on Legal Diversity: Fellows Program (2018)**
Landmark program created to identify, train, and advance the next generation of leaders in the legal profession