



DONNA FRAZIER SCHMITT

PARTNER

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As a member of the Intellectual Property practice group and leader of the Trademark Services practice area, Donna Schmitt strategically manages global trademark portfolios and advises clients on copyright, trade dress and trade secret matters.

Businesses in a variety of industries look to Donna to handle domestic and foreign trademark prosecution and for guidance on trademark selection, use, registration, policing, protection, infringement and enforcement. She also advises on commercialization of intellectual property through licensing. Donna counsels on domain name registration and use of trademarks and copyrights in social media.

As part of her practice, Donna works to identify trends and new tools to enforce intellectual property rights, including efforts to curb the sale and distribution of counterfeit and knockoff products from electronics to personal care items. She manages oppositions and cancellations at the United States Trademark Trial and Appeal Board, as well as in dozens of foreign countries. She develops and implements customs enforcement programs for her clients and, due to her in-house experience, incorporates business solutions along with legal options.

Donna's experience and current practice includes entities that provide goods and services in an array of industries. Donna is a member of Armstrong Teasdale's Health Care and Life Sciences industry team representing numerous entities, including local, regional and global health care systems and technology and investment companies focusing on this industry. She is also a member of the firm's Fashion and Design practice area representing large international luxury brands and local and international fashion entrepreneurs.

Active in the community, Donna has volunteered for academic and charitable institutions including Washington University School of Law, and is a board member for Whole Kids Outreach and a trustee for the City of St. Louis Mental Health Board, where she serves on the Finance Committee.

EDUCATION

- Washington University School of Law (J.D., 1991)
 - Order of Barristers
- University of Arkansas (B.A., *magna cum laude*, 1988)
 - English
 - Phi Beta Kappa

SERVICES AND INDUSTRIES

Agribusiness and Food
Consumer Products and Services
Copyright
Emerging Companies
Financial Services and Banking
Health Care and Life Sciences
Intellectual Property
Intellectual Property Litigation
International
Litigation
Manufacturing and Innovation
Mergers and Acquisitions
Outside General Counsel
Noncompete and Trade Secrets
Technology
Trademark

ADMISSIONS

Missouri
Illinois
Arkansas

PROFESSIONAL ACTIVITIES

- International Anti-Counterfeiting Coalition (Board of Directors 2006-2016; Executive Committee 2010-2014; Board Chairman, 2010-2012)
- International Trademark Association Committees - Meetings, Legislative, Anti-Counterfeiting (former Chair of North America Subcommittee) and Enforcement Committee
- National Association of Women Lawyers (Fashion Law Affinity Group)
- The Missouri Bar
- Bar Association of Metropolitan St. Louis
- American Bar Association
- Armstrong Teasdale Women's Inclusion Network (Committee Member)

CHARITABLE AND CIVIC INVOLVEMENT

- City of St. Louis Mental Health Board (Trustee; Finance Committee; Secretary/Treasurer; Executive Committee)
- Whole Kids Outreach (Board Member)
- Washington University Schools of Law and Engineering (Adjunct Professor)
- Washington University School of Law (Intellectual Property Advisory Board, 2006-2015)
- The College School of St. Louis (Personnel Committee, 2009-2015)
- Grace Place Retreat (Board of Directors, 2008-2012)
- St. Louis Volunteer Lawyers and Accountants for the Arts (Volunteer)

ACCOLADES

- World Trademark Review (WTR) 1000, Recommended Individual (2021)
- *The Best Lawyers in America*®, Trademark Law (2019-present)
- *Martindale-Hubbell*® Bar Register of Preeminent Women Lawyers (2011-2014)
- AV® Preeminent Rated, *Martindale-Hubbell*
- "40 Under 40," *St. Louis Business Journal*(2005) and Most Popular (2015)

BACKGROUND

Prior to joining the firm, Donna served as in-house counsel for Energizer Holdings and Edgewell Personal Care. She led the trademark and copyright department managing global trademark clearance and prosecution for a 10,000-plus trademark portfolio. As in-house counsel, Donna directly managed trademark infringement cases with litigation counsel and developed and implemented a brand protection practice to address counterfeit products globally. As Energizer and Edgewell entered into more aggressive trademark licensing to expand their brands, Donna was a member of the business teams that developed the company program and was the legal counsel lead for all licensing

issues. Now, Donna advises clients from manufacturers to developers and service providers on strategic business matters related to intellectual property.

EXPERIENCE

Judgment in Counterfeit Enforcement Action

Represented prominent luxury fashion brand in action in the U.S. District Court for Eastern District of New York against counterfeiter. Action terminated with cessation of all infringing conduct, highly favorable settlement, and consent judgment against infringer.

Outside IP Counsel, Trademark Prosecution for Global Consumer Products Company

Served as outside intellectual property counsel to a global consumer products company, advising on the clearance of proposed trademarks, prosecuting a high volume of applications across a wide range of consumer products, and managing the client's portfolios worldwide.

Summary Judgment for Health Care Client in Federal Trademark Infringement Suit

Secured summary judgment on behalf of the defendant, one of the largest non-profit hospital systems in the country, in a trademark infringement suit in federal court. The successful defense ensured the continued use of a naming convention impacting more than 25 health care delivery locations across the Midwest.

Copyright Infringement Lawsuit for Gaming Client

Armstrong Teasdale is representing an international gaming client in a copyright infringement lawsuit against a competitor in the U.S. District Court for the District of New Jersey. The complaint alleges the competitor stole and duplicated the client's copyrighted gambling handbook from a New Jersey racetrack. In some instances, the competitor even forgot to remove the client's name when duplicating the infringing handbook.

Successfully Opposed Competitor's Trademarks

Successfully petitioned the Trademark Trial and Appeal Board at the U.S. Patent and Trademark Office on behalf of a client to cancel a competitor's trademark and sustained its opposition to three other trademark filings filed by the same competitor. Our client alleged that the competitor's four marks related to feminine hygiene products were merely descriptive, lacked acquired distinctiveness and were generic.

Trademark Dispute for Health Care Client over Domain Name

Resolved a dispute for a health care client involving website domain names that were infringing the client's trademarks through successful Uniform Domain Name Dispute Resolution Policy (UDRP) complaints established by the Internet Corporation for Assigned Names and Numbers (ICANN) with the World Intellectual Property Organization (WIPO) Arbitration and Mediation Center. The panel appointed by WIPO ordered that the infringing domain name be transferred to the client.

Trademark Enforcement for Multinational Consumer Products Company

Successfully opposed a trademark application for a Fortune 500 multinational consumer products company involving a competitor's mark used to market toilet paper, which bore confusing similarities to the client's mark. The Trademark Trial and Appeal Board found that the identical nature of the goods in question and the similarities between the

two marks would likely result in confusion, and refused the competitor's application.

THOUGHT LEADERSHIP

December 18, 2020

Act Now: USPTO Announces Filing Fee Increases and Other Key Considerations

July 2, 2020

SCOTUS Rejects USPTO Rule on Generic Marks

March 18, 2020

Addressing False Claims, Fake Websites in Light of COVID-19

December 9, 2019

Policing Counterfeit Goods In 2019 Was Redefined By Tech Law360

February 6, 2018

Mum's the Word on Olympics Content to Avoid Infringement

Spring 2017

Knock it Off: Counterfeit Goods and the Building Blocks of an Effective Brand Protection Program

St. Louis Bar Journal

Spring 2017

Knock it Off: Counterfeit Goods and the Building Blocks of an Effective Brand Protection Program

St. Louis Bar Journal

January 27, 2017

USPTO Amendment Requires Additional Proof of Use for Trademarks

December 9, 2016

Michael Jordan's Trademark Victory in China: A Lesson Learned for International Companies

August 9, 2016

Warning: Don't Use Trademarked Olympic Hashtags, Images

July 11, 2016

"The Rewards of Letting Your Law Firm In": Partner Chris LaRose Writes Article for ACC St. Louis Newsletter

ACC St. Louis Newsletter