

## TRADEMARK

Companies devote considerable time, effort and expense to crafting the words, logos, designs and other creative elements—even the business name itself—that solidify their identity in the public’s minds and distinguish their brands and products from competitors.

To protect that investment, some of the most well-known companies turn to Armstrong Teasdale’s Trademark practice area for the global management and protection of trademarks, trade dress and internet-related assets.

Our Intellectual Property (IP) lawyers and professionals have a broad range of experience, including former in-house counsel for some of the most widely recognized global brands. They are experienced in the preparation and prosecution of trademark and service mark applications domestically and around the world, as well as opposition and cancellation efforts before the Trademark Trial and Appeal Board (TTAB) of the U.S. Patent and Trademark Office and around the world.

The Trademark team works closely with lawyers in the copyright, patent, international, corporate and litigation practice areas to protect and enforce clients’ rights worldwide. This close collaboration offers each client the full benefit of our lawyers’ knowledge in every situation.

The services we provide to our clients include:

- Advising on whether brands are registrable as trademarks
- Conducting trademark searches and providing risk analysis associated with the adoption and use of new trademarks, service marks, trade dress, logos and slogans
- Filing and prosecuting trademark applications and maintaining registrations around the world
- Negotiating and advising clients regarding inbound and outbound trademark assignments, licenses and consent, coexistence and other related agreements
- Advertising, marketing and social media content review and counseling, including the creation and implementation of marketing promotions, sweepstakes and contests
- Product and packaging review and counseling
- Monitoring and enforcing trademark rights around the world, including watch notice services, online marketplace research, oppositions, cancellations, and trademark and trade dress litigation
- Managing investigations and enforcement actions against counterfeiters in the U.S., U.K., Europe, China and across the globe
- Defending against trademark enforcement actions
- Intellectual property due diligence and related aspects of complex business transactions, specifically brand acquisitions and divestitures

## EXPERIENCE

### **\$65 Million Sale of Specialty Home Furnishings Business**

Represented the seller, a manufacturer of specialty home furnishings, in its acquisition by a leading brand aggregator in numerous different consumer products spaces. The sale, for \$65 million in cash and equity, represented the buyer’s first



acquisition in the home furnishings space. We also provided counsel on employment, employee benefits, tax, patent, and intellectual property aspects of the transaction.

**Expedited Trademark Clearance for Pharmaceutical Company**

Conducted an extensive number of domestic and foreign trademark clearance searches for a large pharmaceutical company on an expedited basis.

**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.

**Counsel on 135 Contested Matters in 43 Jurisdictions Worldwide**

Provided counsel on 135 separate contested matters (trademark litigation, cancellation actions, oppositions or defense against non-use cancellation actions) in 43 jurisdictions worldwide against one trademark owner. Earned a favorable decision in London, which led to settlement of all other matters.

**Oversight of Significant Global Patent Portfolio**

Oversaw a worldwide intellectual property portfolio consisting of approximately 11,000 trademark filings, over 70 patent filings and over 8,000 domain names.

**Led Due Diligence, Transition and Acquisition of IP Portfolios**

Led the intellectual property due diligence, transition and acquisition of IP portfolios of all sizes from small companies with only common law rights to large companies with worldwide portfolios of up to 2,000 trademark filings and 3,000 domain names.

**Summary Judgment Affirmed on Appeal in Trademark Case**

Secured summary judgment for a manufacturer in dispute over use of the client's mark. The plaintiff in the case sought a permanent injunction in Wisconsin and Michigan and disgorgement of profits. The U.S. District Court for the District of Wisconsin granted summary judgment precluding an award of profits and denied a permanent injunction after trial. Both rulings were affirmed on appeal to the U.S. Court of Appeals for the Seventh Circuit.

**Filed Trademarks for Retirement Plan Provider in Naming of Major Sports Stadium**

Served as IP counsel to a retirement plan provider related to their involvement in purchasing naming rights to a major U.S. sports stadium. Provided counsel on and filed for trademark protection of names and logos following multi-year deal.

**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.

**Successful Outcomes for Hotel and Real Estate Franchisors in Trademark Infringement Matters**

Successfully pursued trademark infringement actions on behalf of international hotel and real estate franchisors.

**Successful Enforcement of Global Intellectual Property Rights**

Enforced and defended trademarks, copyrights and patent rights for a jewelry designer and retailer against third-party infringers.



#### **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.

#### **Summary Judgment in Trademark Dispute Affirmed on Appeal**

Successfully defended a manufacturer of pet supplies in a lawsuit in which a competitor alleged trademark infringement. The decision by the U.S. District Court for the Eastern District of Missouri was affirmed on appeal to the Eighth Circuit. In addition, the circuit court reversed and remanded the lower court's finding of validity regarding the competitor's trademark, which the client had challenged.

#### **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.

#### **Representation of Camping, Music Festival Promoter in Infringement, Cybersquatting Case**

Represented camping and outdoor music festival promoter in a trademark infringement and anti-cybersquatting case in federal court. After filing a complaint and motion for temporary restraining order (TRO), the defendant capitulated to such an extent that there was no need to go forward with the TRO hearing.

#### **Trademark Protection for U.S. Home Goods Manufacturer**

Represented a U.S. home goods manufacturer helping it protect the trademark related to its iconic product by asserting trademark infringement, unfair competition and dilution claims under the Lanham Act.

#### **Successfully Defended Franchisor's Trademarks and Trade Names**

Served as lead counsel in various holdover franchisee disputes, successfully restraining former franchisees from using franchisor's trademarks and trade names.

#### **Successfully Defended Manufacturers in Trademark Infringement, Breach of Contract Actions**

Successfully defended two different manufacturers of creams and lotions in two separate actions in the Southern District of Florida and the Federal District of Utah for trademark infringement and breach of contract.