

# Trademark

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Wiley's Trademark Practice provides clients with the benefits of a boutique firm backed by the full resources of one of Washington, DC's most respected law firms. Our experienced team of trademark attorneys—led by a former Trademark Examining Attorney with the U.S. Patent and Trademark Office (USPTO) and a former in-house Trademark Counsel to a global entertainment company—works closely with attorneys in the firm's Copyright, Corporate, Privacy, Franchise, Patent, and Telecom, Media & Technology practices to provide our clients with complete management throughout the life of a brand, including trademark selection, registration, enforcement, and licensing.

## **Global Brand Acquisition and Management**

A trademark portfolio is a living asset that must keep pace with growth and change in the business. Accordingly, we focus on the building and protection of brand equity around the world. With an in-depth understanding of our clients' businesses, our trademark attorneys conduct comprehensive assessments of their brands and determine how best to protect them based on their value as company assets. Ultimately, protection of a brand may be minimal or extensive, depending on an individual company's needs.

When filing outside the United States, we examine whether it is in the client's best interest to utilize international filing conventions such as the Madrid Protocol, or to retain local counsel in individual jurisdictions. We maintain long-standing relationships with local counsel around the world for this purpose. The firm supports state-of-the-art software to assist in the management of global portfolios.

## **Enforcement, Litigation, and Dispute Resolution**

The enforcement of a trademark is essential to its value. We specialize in administrative and court actions to protect our client's trademarks from infringement, dilution, and encroachment by third parties. Recognizing that litigation is not always the best option for settling a dispute, we routinely evaluate and promote the possibility of creative settlement options, including alternative dispute resolution (ADR).

Wiley Trademark attorneys routinely appear in *inter partes* proceedings before the USPTO's Trademark Trial and Appeal Board in contests regarding the registration of marks. We also regularly litigate trademark infringement and Lanham Act actions in federal courts around the United States, and are skilled in U.S. International Trade Commission (USITC) and U.S. Customs procedures to stop infringing goods before they cross the border. We also are experienced in the management of complex cross-border cases.

In the counterfeiting area, we handle cases in essentially every U.S. circuit involving a wide variety of products, including luxury handbags, cosmetic products, automotive parts, apparel, appliances, electronics, photocopying equipment, software, and toner products. For all these matters, we have been successful in obtaining *ex parte* seizure orders, typically resulting in a prompt and favorable settlement for clients. We work regularly with U.S. Customs and Border Protection (CBP) in connection with the seizure of counterfeit products bearing federally registered marks recorded with that agency, and we have made presentations on identifying counterfeit products to CBP officers in particular ports of entry where the proliferation of counterfeit goods is more common. We also have had success in obtaining “Lever-rule” adjudications from CBP barring the importation of gray-market products, and we regularly coordinate anti-counterfeiting actions in overseas markets.

We have had extensive experience in challenging diluting uses of our clients’ famous trademarks on the basis of both blurring and tarnishment. Such activity has included dilution claims both in the U.S. District Courts and before the Trademark Trial and Appeal Board.

In addition, our experience in the enforcement of trademarks in electronic commerce is extensive. We routinely use trademark claims to combat all manner of online scams including defending Internet domain names from misappropriation by “cybersquatters,” analyzing each situation individually and determining the best course of action—whether acquisition of a domain name, arbitration proceedings under the Internet Corporation for Assigned Names and Numbers (ICANN) Uniform Domain-Name Dispute-Resolution Policy (UDRP) and analogous country-code domain policies, actions under the Anticybersquatting Consumer Protection Act (ACPA), or *in rem* proceedings—to economically and efficiently achieve our client’s objectives.

### **Trademark Licensing**

Successfully leveraging a trademark through licensing benefits both licensor and licensee. It increases a licensor’s revenue and builds brand recognition, and, from the licensee’s perspective, increases market demand by associating a product with an established brand. Our Team routinely negotiates and drafts agreements for licensors and licensees in such diverse areas as clothing, media, toys, food products, and electronics. We also have assisted with the creation and management of quality control and brand assurance programs, including a multi-million-dollar licensing and merchandising program for well-known animation properties.

### **Transactions**

Wiley’s Trademark Practice works closely with the firm’s Corporate Practice in transactional projects to evaluate the scope and coverage of intellectual property in a variety of transactions, including: licensing, mergers and acquisitions, public offerings, private equity, and venture capital investments. We assist purchasers, investors, and sellers to evaluate any discrepancies between the information provided by or obtained from the seller and that obtained through the purchaser’s independent search. Our Team is skilled at working with corporate and tax counsel to determine “how” and “where” the intellectual property assets should be acquired, and compliance with the Securities and Exchange Act of 1934. Among our recent

experience in this area, we have assisted purchasers in the acquisition and venture capital investment in food companies and automotive parts companies, managed the sale of a sports and entertainment company, and assisted in the acquisition of an Internet services provider. We also have represented parties in sale transactions involving domain name and associated Web portal intellectual property assets in a number of transactions reported at the time to be the largest ever such transactions.

### **Trademark Watching Service**

Your company's trademark portfolio and company name are significant assets that build brand equity in your trading area and beyond. Businesses large and small must take steps necessary to protect and grow their brands. Implementing a trademark watching program is a cost-effective and powerful way to maintain brand strength and develop brand equity while monitoring the bottom line. Whether your company owns one trademark registration or application or hundreds, or merely relies on common law rights in a trademark or trade (corporate) name, subscribing to a trademark watching service can help to protect your brands against dilution and infringement.

Wiley offers trademark watching services that will assist in protecting and enforcing your valuable trademarks and company names in physical and virtual contexts.

### **Contact Us**

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