Trademarks, Copyrights & Licensing

Barclay Damon's team of trademark, copyright, and licensing lawyers have decades of collective experience representing clients in matters before the United States Patent and Trademark Office (USPTO) and the United States Copyright Office and in registering and enforcing the intellectual property assets of our clients. We manage well over 1,000 active trademarks per year.

Trademarks, copyrights, and other forms of intellectual property (IP) are some of the most valuable assets a client can license, own, and protect. Unfortunately, many businesses fail to appreciate the value of their brand and forego registration of a trademark—sometimes until after it is too late. We ensure our clients register their trademarks as early, and we have found that conducting an initial consultation and discussing often helps avoid or overcome potential hurdles in the application process. Our attorneys provide guidance every step of the way.

Our attorneys have assisted a wide-ranging and varied client base with practical and cost-effective legal advice in, among other things, establishing, protecting, commercializing, and enforcing their trademarks, copyrights, and other forms of IP, both domestically and internationally. Our clients range from owners of some of the world's most famous brands to the emerging brands of start-ups, individuals, and entrepreneurs. We represent manufacturers, service providers, and others from myriad industries, including food service, higher education, cannabis, and archery and outdoor. We also provide counsel on a variety of IP matters to solo practitioners and small non-IP law firms as well as advise foreign IP counsel on US IP matters.

In addition to core trademark and copyright registration services, we provide guidance and legal advice in drafting and negotiating various types of contracts related to the development, licensing, and commercialization of IP and with due diligence in M&A transactions.

Our attorneys are proponents of alternative dispute resolution where and when appropriate given the cost and delays associated with litigation. In the event that litigation is the necessary route, our clients are reassured by our deep experience with handling federal court litigation throughout the United States.

Trademarks

Our attorneys and professional staff handle our clients' trademark needs from cradle to grave. The process begins with searching, assessing, and counseling our clients on the registrability of potential marks. The next steps are efficiently filing and prosecuting applications, both in the United States and internationally, and filing renewals, statements of use, and other periodic mandates dictated by the USPTO.

In addition to procuring trademarks and managing global intellectual property portfolios, our attorneys counsel clients on domain name issues and in developing and implementing strategies for protecting their intellectual property rights on the internet, including taking action against cybersquatters, handling take-down notices, and reviewing and developing related website policies.

We provide clients with practical and cost-effective advice regarding these assets, including how, when, and where to protect those rights; using ownership and licensing strategies; and protection and enforcement programs, including ways to prevent the importation and exportation of counterfeit products through registration with US Customs and Border Protection, sometimes with the aid of the firm's Canada-US Cross-Border Team.

When it comes to enforcement, our attorneys enforce and defend our clients' intellectual property in courts throughout the United States and abroad and regularly represent our clients' interests in quasi-judicial adversarial proceedings, such as in cancellation and opposition proceedings before the USPTO.

In addition to managing trademark portfolios for our domestic clients, our attorneys have developed relationships with foreign law firms throughout the world, maintaining those relationships through regular attendance at International Trademark Association (INTA) programs and events; the New York State Bar

Association (NYSBA) Intellectual Property Section; and through regularly speaking, writing, and presenting on IP-related issues and updates.

Copyrights

Barclay Damon's lawyers have been guiding our clients through the sometimes nuanced and misunderstood form of intellectual property. Many people are familiar with copyrights because they have seen the notice inside the front cover of a book or at the beginning of a movie. However, copyrights are far more encompassing than just those circumstances. In the event someone disregards a copyright, it can have unintended consequences, such as receiving a cease and desist letter or a federal court lawsuit.

We work with clients to strategize, prepare, file, and prosecute applications, including requests for reconsideration, for various types of works, such as photographs, sculptures and other artwork, music, books, and software. For the latter, we advise clients on the nuances of registration, protecting trade secrets within software source code, and guiding our clients in the submission of deposit material as permitted by the US Copyright Office.

We also analyze the chain of title from the author to the owner and, when appropriate, prepare “work made for hire” and other copyright transfer assignments and agreements to fully vest title in the owner. Understanding copyrights, their scope, and the remedies available can offer significant advantages both as deterrence and in damages through enforcement, such as when a copyrightable work is timely registered in accordance with the US Copyright Act. For example, a valid certificate of copyright can entitle the “prevailing party” in litigation to an award of costs, including attorneys' fees.

In addition to traditional enforcement through litigation or the defense of federal court lawsuits throughout the United States, our attorneys often rely on alternative dispute resolution strategies like mediation for instances such as the receipt of cease and desist letters or for those charged with infringement, and including the development of cost-effective litigation strategies that often lead to efficient and amicable settlements. Because the Copyright Act contains a “prevailing party” attorney's fees provision, prompt attention to these lawsuits is paramount as is consideration of a Rule 68 Offer of Judgment to foreclose or mitigate damages, including the potential award of attorney's fees, an available remedy when the copyright is previously registered.

A growing segment of copyright law involves the Digital Millennium Copyright Act (DMCA), which contains additional remedies for the removal of or tampering with copyright management information, such as when an unknowing company employee downloads a protected image and removes the copyright notice. There are also provisions regarding take-down notices, the registration of an agent for receipt of those notices, and other nuanced requirements. Our attorneys have assisted clients with these matters as well. Finally, the Copyright Office now offers a form of small claim administrative copyright enforcement that is still evolving but will likely grow in use.

IP Transactions and Licensing

Our attorneys handle a wide range of contracts and transactions involving IP. Together with the firm's Data Security & Technology Practice Area lawyers, we have assisted our clients in meeting the demands of the ever-changing fields of data accumulation, technology, and the ever-growing aspect of artificial intelligence (AI).

We regularly provide strategic counseling, drafting, IP due diligence, and negotiation involving a wide range of deal types and technologies, such as joint development, manufacturing, resale, distribution, licensing of intellectual property, asset purchase, and M&A transactions. For routine transactions, we use our toolbox of contract templates, such as nondisclosure agreements (NDAs), security interest agreements, and instruments recordable with the USPTO.

Furthermore, in support of our clients, we prepare and record IP assignments, security interests, and releases with the USPTO; perform IP searching, analysis, and reporting, including chain of title reports; analyze breach of contract issues and handle breach notice and breach cure letters; and analyze IP infringement allegations, handling demand letters, settlement negotiations, and settlement agreements.

Representative Experience

- Successfully argued against a refusal of registration citing registration covering an identical mark by distinguishing the applicant's goods and channels of trade from those covered by the cited registration.
- Serves as outside trademark counsel to an international presenter of artistic programming and arts education and manages its international trademark portfolio.
- Successfully enforced a client's federal trademark registration through a cease and desist letter and encouraged the infringer to immediately adopt a less-similar mark.
- Serves as lead litigation trial counsel for a global cigar company.
- Managed the domestic enforcement of trademark rights for an apparel and headwear company.
- Collaborated in the clearing, filing, and prosecution of trademark applications for the global rebranding of a pharmaceutical company.
- Managed the worldwide trademark portfolio for a national alcohol beverages manufacturer.
- Defended a footwear manufacturer and retailer in a trademark-infringement action that was resolved favorably prior to trial.
- Represented a health care provider in a trademark-infringement action that was resolved favorably prior to trial.
- Represented a medical device manufacturer in a successful uniform domain name dispute resolution policy (UDRP) proceeding that resulted in the transfer of an infringing domain name.
- Served as trial counsel in a trade-dress infringement action that resulted in a favorable jury verdict of noninfringement for a specialty paper products manufacturer.
- Serves as outside trademark counsel for a global telecommunications manufacturer, including counseling on the selection and adoption of new brands, clearing and filing new marks, and maintaining its global trademark portfolio.
- Represented a client in asserting its trademark rights against a tour management company relating to the title of its nationwide hip-hop concert tour, which featured several top Billboard artists, resulting in the company’s rebranding of the tour, settlement payment, abandonment of its pending trademark applications, and agreement to cease use of our client’s trademark.
- Represented a publicly traded pharmaceutical manufacturer in the drafting and negotiation of international product development agreements as well as patent and know-how license agreements.
- Representing a hospital system in developing and implementing a product champion program for its physician-inventors, including filing patent applications, providing counseling for the procurement of prototype development services and business development consulting services, performing a legal review of marketing platforms, and drafting and negotiating commercialization agreements.
- Represented a Fortune 500 energy company, handling the revision and negotiation of contracts related to the development, supply, and licensing of energy systems and related technologies.
- Successfully defended a medical device manufacturer against an infringement claim brought by a licensor of enterprise resource planning software, securing an amended software license agreement that clarifies the scope of the permitted use.