Trademarks

Lathrop GPM's Trademark team works closely with clients to provide strategic advice on how to protect and enhance the value of their brands and ideas. The team's attorneys have global experience in obtaining registrations for traditional and nontraditional trademarks. Clients of all sizes regularly count on the team for a variety of services, including in the following areas.

Trademark Prosecution and Portfolio Management

Lathrop GPM secures hundreds of new marks each year and monitors a number of large trademark portfolios. The team currently manages over 17,000 active trademark applications and registrations, both domestic and international, on behalf of a broad spectrum of clients. This includes:

- Developing domestic and international trademark and brand management strategies
- Trademark selection and clearance
- Trademark registration
- Trademark portfolio diligence and audits

Recent Experience

- Serve as IP counsel for a *Fortune* 50 global financial services company; the work includes trademark prosecution, trademark licensing, IP clearance and trade secret evaluation and protection.
- Provide ongoing trademark advice for a national bridal retailer. The scope of work includes filing and obtaining trademarks; asserting trademark claims on behalf of our client; and presenting policies and training programs to protect IP rights and avoid infringement.
- Handle international and domestic trademark portfolio for major international jewelry brand, including counseling client on enforcement, protection, policing and when/where to file applications.

- Serve as IP counsel for a $2.3B national retailer providing portfolio advice and management, much of which at fixed rates.

International Network

Through an established global network of foreign associates representing over 200 countries, Lathrop GPM trademark attorneys have access to local expertise in virtually every corner of the globe, as well as the ability to register, enforce, and defend clients' intellectual property worldwide.

Licensing and Transactions

We help clients generate additional revenue from their trademark assets by structuring sound licensing programs. We work with clients throughout this process, from the preparation and negotiation of license agreements (both domestic and foreign) to the creation of internal compliance programs and the handling of alleged violations. We seek to balance the profitable exploitation of trademarks with the clear preservation of ownership rights.

When business transactions involve trademarks, we work with clients to obtain proper valuation and protect business objectives. Lathrop GPM advises clients on the trademark issues involved in mergers and acquisitions, strategic alliances, joint ventures, bankruptcies, and more. Our work includes transaction opinions, trademark portfolio evaluation, due diligence, and the preparation of agreements and licenses. We are able to call upon our colleagues across the firm - from corporate to tax to bankruptcy practices - to provide comprehensive deal counsel.

Recent Experience

- Managed the IP facets of the $650 million sale of Silpada Designs to Avon Products, Inc., and the subsequent buyback from the original owners.
- Served as counsel for a high-net-worth individual regarding angel investments for a do-it-yourself medical test and a new method for copper manufacture. Performed due diligence, including an audit and evaluation of IP protection and procedures; negotiated the terms of the investments.

- Counsel a manufacturer of probiotic dietary additives with regard to licensing and related corporate issues.
- Represent an internationally known artist and illustrator regarding the licensing of artwork for a variety of products.

Trademark Litigation and Enforcement

We protect our clients nationwide - in courtrooms across the country, through mediation and arbitration, and before the Trademark Trial and Appeal Board. We handle all aspects of trademark and trade dress litigation, including infringement and dilution, and have extensive experience in domain name disputes.

The team offers strategies to ensure early detection of potential trademark infringement, including:

- Monitoring for potential infringement, including emerging issues relating to the Internet, including domain names, social media, keyword search terms and cybersquatting
- Evaluating infringement issues
- Developing and implementing an enforcement plan

Recent Experience

- Defended a well-known shoe manufacturer and retailer in multiple trademark and trade dress suits, many of which had potential liability of eight or nine figures.
- Defended an international jeweler — a company that has products available in more than 55 countries across six continents — in a trademark dispute brought by one of its former authorized retailers. The store sued, claiming ownership of our client's brand. We prevailed in defeating the store's preliminary injunction motion, which would have prevented further sales of our client's product in the state. The case settled favorably prior to a scheduled jury trial.
- Successfully argued for a preliminary injunction against a cybersquatter who used the principal mark of a well-known children's clothing retailer.
- Brought a trademark action on behalf of a regional dairy company against a convenience store chain that was using a confusingly similar stylized trademark on some of its products. We achieved a favorable settlement and convinced the convenience store chain to

voluntarily discontinue all use of the infringing stylized mark.

- Defended a biotechnology client in a dispute over trademark rights with a large Japanese company. The successful resolution included substantial payment by the plaintiff, which financed our client's new marketing initiative.