

Trademarks & Copyrights

Protecting your IP



Whether you seek to

- clear new marks
- develop, maintain, or expand trademark portfolios
- enforce or defend trademark or copyright rights
- license, assign, or acquire IP rights
- register your trademarks or copyrights (in the U.S. or foreign jurisdictions)

we bring to you a team of attorneys and paralegals with experience helping clients develop, enhance, safeguard, and enforce their intellectual property assets.

Multi-National corporations have entrusted us to manage and maintain worldwide trademark portfolios

- We manage trademark filings and registrations in countries throughout the world
- Our docketing system is carefully managed to reflect changes in the laws of the respective jurisdictions and to facilitate tracking deadlines for both domestic and non-U.S. registrations
- We have a worldwide network of trusted foreign associates who may be called upon to assist in a particular country on an as-needed basis
- We learn our clients' businesses and markets so we can offer strategic and global advice about where filings should be maintained or extended
- We monitor and manage trademark oppositions and enforcement actions in foreign countries in cooperation with foreign counsel
- Our services also include advising clients on international issues, such as on procurement of English and non-English marks and protection and enforcement of brands in China

Team with practical business approach and marketplace insights

Related Practice Areas

Bankruptcy, Creditors' Rights & Restructuring

Corporate & Securities

Cybersecurity & Data Breach Response

Cybersecurity & Data Privacy

E-Discovery - Encompass

E-Discovery & Information Governance

Insurance

Intellectual Property

Intellectual Property Litigation

Life Sciences - IP

Patent Counseling & Prosecution

Privacy & Data Management

Technology

Related Industries

Banking & Financial Services

Construction

Consumer Products & Retail

Education

Energy & Utilities

Health Insurance

Healthcare

Hospitality & Tourism

Insurance

Manufacturing

Nelson Mullins' trademark and copyright team members bring to clients a practical, business-focused approach, and broad marketplace insights on emerging IP-related legal requirements. Our team includes attorneys experienced in the following

- Navigating the trademark clearance process (in the United States and internationally)
- Working with lawyers from around the world to protect and enforce our clients' trademark rights in foreign jurisdictions
- Registering trademarks internationally utilizing the Madrid System
- Litigating at the USPTO, in federal and state courts, and managing litigation internationally

Attorney team members also play leading roles in professional associations, including the International Trademark Association (INTA) and the Intellectual Property Constituency of ICANN, and serve as trusted advisors to clients on portfolio strategies, licensing, coexistence, and deal due diligence.

Our Clients

Clients for whom we have provided trademark or copyright services include

- Companies and institutions headquartered within the United States, as well as companies headquartered in other locations around the world
- Educational institutions
- Large companies in industries that include: automotive, biotechnology, chemicals, consumer products, IT services, manufacturing, retail, software, and textiles
- Small companies with one or two registrations and start-ups

In the litigation context, we've represented clients in trademark, copyright, and trade secret litigation in jurisdictions across the United States, including CA, FL, GA, IN, NC, NY, SC, TN, and TX, and have selected and supervised counsel for matters in jurisdictions outside the United States, including before the Tribunal de Grande in Paris.

Flexible fee structures and service models

Equipped with an understanding of our clients' businesses and portfolios, we implement fee structures aligned with your needs to help enhance budget predictability.

Nelson Mullins' trademark and copyright practice is built around a core group of attorneys with deep experience who can help you:

- Clear and register trademarks (in the United States and internationally)
- Respond to trademark and copyright office actions

Pharmaceuticals &
Medical Devices

Real Estate

Sports

Technology

Transportation

- Negotiate and draft copyright and trademark licenses, assignments, and trademark coexistence agreements
- Copyright ownership clearance and advice
- Identify risks and protect interests in the deal context, through conducting due diligence on the acquisition of trademarks and copyrights
- Protect and defend copyright and trademark rights through advocacy and intellectual property litigation at the USPTO and in federal and state courts, as well as, manage litigation internationally
- Develop enterprise trademark registration programs
- Monitor and challenge trademark applications
- Create online intellectual property policing campaigns and brand protection measures on the internet and within social media networks

Why Nelson Mullins?

- Experience in trademark and copyright matters on an international basis
- Strategic and global IP advice based on an understanding of our clients' businesses
- Flexible fee structures, including alternative fee arrangements
- Commitment to providing solid advice and services in an efficient manner

Experience

Following is a selected sampling of matters and is provided for informational purposes only. Past success does not indicate the likelihood of success in any future matter.

Registration, Counseling, Portfolio Management

- Management of the trademark portfolios of multiple Fortune 500 companies.
- Represented a national retail chain in its portfolio management, trademark clearance, trademark prosecution, licensing, and enforcement as well as its private labeling program across hundreds of diverse product lines including food, clothing, beauty/cosmetics, and health, among others. Our trademark attorneys worked concurrently with in-house legal counsel and a private label/marketing team on issues particular to retail branding such as seasonal product roll-outs, product phase-outs, consumer focus group studies, and advertising and media issues.
- Manage the global trademark portfolio of a large manufacturing company. We conduct quarterly conferences with this client to review upcoming deadlines and review the portfolio. Also, we have negotiated extensive trademark licensing agreements both from the perspective of licensor and licensee. We are involved in the trademark clearance process through registration, maintenance, and enforcement.
- Our attorneys successfully obtained the registration of an important trademark for a multimillion dollar brand after prior counsel had recommended abandonment of application due to rejections by the Trademark Office. We subsequently litigated trademark infringement proceedings for the client as plaintiff in the United States, Europe, and Taiwan.

Trademark, Copyright, and Trade Secret Litigation

- **Obtained a TRO and Summary Judgment in matter for a motor sport client** (S.D. Fla.) - Represented a client as plaintiff in this trademark infringement case related to personal watercraft and jet boats. On behalf of the client, we obtained temporary restraining order and preliminary injunction against defendants for trademark infringement during the world's largest watercraft show and later obtained summary judgment with damages and costs awarded to our client.
- **Trademark defense litigation relating to disaster recovery services** (S.D.N.Y.) - Represented our defendant client in this case involving trademark infringement allegations related to disaster recovery services. On behalf of our client, we obtained dismissal of NY litigation.
- **Trademark infringement litigation matter** (D.S.C.) - Represented defendant client in this trademark infringement allegation matter related to tax preparation services. The case was resolved by settlement.
- **Trademark infringement litigation defense for Fortune 200 technology client** (M.D.N.C.) - Represented technology company against trademark infringement claims alleging that the company's advertising tagline was causing "reverse confusion" of the public. The case was resolved by settlement.
- **Trademark litigation defense resulting in summary judgment affirmed on appeal** - Represented defense lottery corporation c and its ticket printer against Georgia state trademark infringement claims challenging marks used on lottery tickets. The court granted summary judgment, and the Georgia Court of Appeals and Georgia Supreme Court affirmed.
- **Represented software industry company in case involving multiple IP and tort claims** (N.D. Ga.) - Represented a software company in a lawsuit against its competitor involving competing claims of unfair competition, including trademark infringement (involving keyword advertising and website metatags), false advertising, misappropriation of trade secrets, defamation, and tortious interference.
- **Trademark litigation defense for Hong Kong trading company client resolved after mediation** (S.D. Ind.) - Represented defendant Hong Kong trading company against trademark infringement claims relating to swimming pool products sold in U.S. The claim settled after mediation.
- **Trademark license dispute** (Chancery Court of Sumner County, Tennessee; Tenn. Ct. of Appeals) - Represented restaurant industry company in a dispute over a trademark license agreement, involving issues including waiver of contractual rights, and equitable estoppel. We successfully defended a motion for preliminary injunction and prevailed on a summary judgment motion. This was reversed on appeal, then settled.
- **Matter involving claims of trademark infringement and Anti-Cybersquatting Consumer Protection Act** (S.D. Fla) - Represented client in defense of a case involving claims of trademark infringement and violation of the Anti-Cybersquatting Consumer Protection Act (ACPA), in which we obtained dismissal of ACPA claims, which allowed for a favorable settlement on the remaining trademark claims.
- **Plaintiff representation in grey-market trademark infringement case** - Represented plaintiffs in the motorized products manufacturing industry in a grey market trademark infringement case.
- **Case involving plaintiff representation and resulting in consent order enjoining reproduction or distribution** (M.D.N.C.) - Represented plaintiff in this copyright infringement case involving allegations that defendant was selling integrated circuits loaded with unauthorized copies of plaintiff's copyrighted firmware. The case resolved with the entry of a consent order enjoining reproduction or distribution of the subject firmware by the defendant.
- **Case resulting in entry of consent preliminary and temporary injunction** (E.D. Tex.) - Represented plaintiff in the gaming industry in this case involving infringement of copyright software and designs. The case was resolved with the entry of a consent preliminary and temporary injunction against the defendant.
- **IP litigation defense** (South Carolina Court of Common Pleas, Greenville County) - Represented defendant IP owner in this case involving ownership of intellectual property related to pedal scooters. The case was resolved by settlement.

- **Copyright litigation defense involving stained glass designs** (N.D. Cal.) - Represented defendant in matter involving plaintiff who contended that several copyrighted stained glass designs were being used without authorization in certain products. The case was resolved by settlement.
- **Copyright litigation matter in Paris, France** (Tribunal de Grande Instance, Paris) - Selected and supervised European counsel in a copyright infringement case involving copyrights in light fixtures. The case was resolved by settlement.