



## Susan M. Kayser

### Partner

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## OVERVIEW

Susan Kayser is a nationally recognized IP litigator and counselor, having been named an “All Star” by *Managing Intellectual Property*; an “IP Trailblazer” by the *National Law Journal*; and consistently recognized by *The Legal 500 US* and the *World Trademark Review* as a leading trademark practitioner (both litigation and non-contentious). She services clients in the fashion, luxury, consumer products, food, and technology industries on trademark, advertising, and copyright matters.

## CLIENT RECOGNITION:

- “Always in demand, Susan Kayser takes on a ton of work, but is never overwhelmed. She treats her clients to a tip-top counselling and litigation service and puts shoulder to the wheel to help them grow globally. She is an anchor of K&L Gates' worldwide trademark group.” *World Trademark Review* 1000 (2021).
- “Since moving from Jones Day to K&L Gates in the spring of 2018, Susan Kayser has settled in well. The nationally reputed litigator and counsellor has a lot going on but never drops the ball. Recently, she successfully represented Procter & Gamble in defending the exclusivity of billion-dollar brand GILLETTE. She also continues to serve as primary US trademark and copyright counsel for Abercrombie & Fitch.” *World Trademark Review* 1000 (2020).
- “She wields a thorough command of the law and relevant procedural rules. Her calm and rational approach has resulted in favourable settlements with difficult parties without the need for the nasty hysterics so often favoured by other counsel.” *World Trademark Review* 1000 (2018).
- “...ample experience in the courtroom...” securing permanent injunctive relief and millions in damages. *WTR* 1000 (2017).
- “fantastic disputes specialist...whose work on a variety of high-profile contentious briefs has left a string of clients 'thrilled'” *WTR* 1000 (2015).
- “shrewd interlocutory tactics” and “tactical trial lawyering skills.” *The Legal 500 US* (2010).
- “...’amazing support’ in relation to portfolio management” *The Legal 500 US* (2007).
- “a solid litigator with broad-based knowledge of trademark law” *WTR* 1000 (2011).

- “responsive and thorough” WTR 1000 (2013).
- “outstanding” and “a true delight to work with” WTR 1000 (2014).

## TRADEMARKS

Susan has significant experience in obtaining (and defeating) TROs and preliminary injunctions, including those involving contributory infringement and counterfeiting, and *ex parte* seizures. She handles all aspects of USPTO practice, has won numerous oppositions before the TTAB, and obtained fame decisions, including from the National Arbitration Forum.

Susan also provides clients with results-oriented counseling, manages multibillion dollar worldwide trademark portfolios and worldwide clearance projects, serves as lead negotiator for multi-jurisdictional disputes, and leads IP due diligence teams for brand acquisitions.

## ADVERTISING

Susan litigates and defends competitor false advertising claims under the Lanham Act. She clears advertising and marketing campaigns, including advising on related trademark, copyright, and right of publicity issues. She conducts training for companies on compliance with US advertising laws. She also counsels clients on compliance with Section 5 of the Federal Trade Commission Act, including testimonials, endorsements, and online advertising, marketing, and social media issues; efficacy claims for sport and health products; the FTC's Green Guides; and “Made in the USA” claims.

## COPYRIGHTS

Susan represents clients in copyright litigation and counsels on protection and enforcement of original works, including fabric designs, labels, art (paintings and sculptures), photographs, and architectural designs. She also represents clients on moral rights under the Visual Artists Rights Act (VARA).

## PROFESSIONAL BACKGROUND

Prior to joining the firm, Susan served as a trademark litigator for an international law firm, where she represented famous brands. In addition, she also defended against the Lanham Act false advertising claims by competitors. She regularly counseled clients on advertising issues and compliance with Section 5 FTC regulations, including testimonials, endorsements, and online advertising issues, efficacy claims for sport and health products, and “Made in the USA” claims.

## ACHIEVEMENTS

- Listed in the World's Leading Trademark Professionals by *World Trademark Review 1000*, 2011-2024
- *Managing Intellectual Property* “All Star,” 2014, 2016-2021
- *National Law Journal* “IP Trailblazer,” 2014

- Lead lawyer for “Standout” trademark litigation *Chloé SAS v. SISCOM*, *The Financial Times*, most innovative US litigations, 2013
- Consistently ranked as a leading trademark litigator by *The Legal 500 US* survey

## PROFESSIONAL / CIVIC ACTIVITIES

Susan served on the editorial board of *Trademarks & Brands Online*. She was also a member of the International Trademark Association North American Global Advisory Council and former chair of the Subcommittee on Trademark Policy and Advocacy for the Enforcement Committee. She is coauthor of the chapter “Copyright Damages” for the treatise *Calculating and Proving Damages* (Law Journal Press). She has also been on the forefront of online contributory infringement and counterfeiting, and is frequently quoted and cited on the subject. Susan is a former adjunct professor of Trademarks and Unfair Competition at The Catholic University of America Columbus School of Law, Washington, D.C.

## SPEAKING ENGAGEMENTS

- Panelist, Enforcing Contributory Online Trademark Infringement: Willful Blindness, Knowledge Standard, Stafford 5 December 2023
- How Trademarks & Copyrights Impact our Retail Space, Columbus OH, 11 October 2023
- Panelist, American University Washington College of Law Intellectual Property Brief The Art of Intellectual Property Law (Trademarks) 24 March 2023
- Moderator of K&L Gates LLP's panel: "Fashion's Role in Politics, Diplomacy & Social Change: Leading Change or Mere Reflection," 2022 Luxury Law Summit Americas, 2 November 2022
- Panelist, Intellectual Property at the Supreme Court, Lucky Brand Dungarees, Inc. v. Marcel Fashion, Inc., American University Washington College of Law, 13 January 2020
- Anti-Counterfeiting: Brand Strategies and Government Resources, guest lecturer, American University Washington College of Law, Washington, D.C., 10 June 2019
- STOPfakes.gov - Identify, Invest, Investigate = Impact, keynote speaker, Intellectual Property, U.S. Dept. of Commerce, International Trade Administration, Chicago, IL, 30 April 2019
- Luxury & Fashion Webinar: Trademark, Design and Copyright Update for Fashion Brands, 21 March 2019
- Blockchain and Trademarks, Strafford CLE, 4 December 2018
- Madison Avenue Meets Hollywood: Navigating Product Placement Deals in Movies and Television, INTA 2018 Annual Meeting, Seattle, 21 May 2018
- Food Labeling post-POM Wonderful LLC v. Coca-Cola Co., panelist, D.C. Bar Washington, D.C., 29 July 2014

- The Presumption of Irreparable Harm: Don't Stop Believing, INTA 2014 Annual Conference Hong Kong, 12 May 2014
- Executive Roundtable Series: Protecting Your Business Against Online Counterfeiting and Patent Trolls, Washington, D.C., 26 February 2014
- E-Discovery: Obtaining Electronic Documents Without Glitches, INTA Leadership, Miami Beach, Florida, November 2013
- Executive Roundtable Series: Hot Topics in Trademark, False Advertising, and Copyright Law, Washington, D.C., 27 April 2012
- Winning (And Managing Costs In) False Advertising and Other Lanham Act Litigation Webinar, 19 April 2012
- Madrid Protocol - Is It Working For U.S. Brand Owners? panelist, INTA Annual Conference Seattle, Washington, May 2009
- INTA - Trademark Administrators Conference, Madrid Protocol, panelist, Arlington, Virginia, October 2008
- What's New in Patent, Trademark and Insurance Coverage Law, panelist, Washington Metropolitan Association of Corporate Counsel (WMAACC), Falls Church, Virginia, April 2008
- Intellectual Property: Assessing Current and Proposed Reforms in Patent, Trademark, and Copyright, panelist, ABA Section of Administrative Law and Regulatory Practice, The ABA Section of Intellectual Property Law Washington, D.C., 25 October 2007
- Federal Trademark Dilution Revision Act, moderator, INTA Roundtable, Washington, D.C., April 2007

## EDUCATION

- J.D., American University Washington College of Law, 1993 (*magna cum laude*)
- B.A., American University, 1989 (*Communications*)

## ADMISSIONS

- Bar of District of Columbia
- Bar of New York
- United States Court of Appeals for the Federal Circuit
- United States Court of Appeals for the Fourth Circuit
- United States Court of Appeals for the Ninth Circuit
- United States Court of Appeals for the Seventh Circuit
- United States District Court for the District of Columbia

- United States District Court for the District of Maryland
- United States District Court for the Eastern District of Virginia
- United States District Court for the Northern District of Illinois
- United States District Court for the Southern District of New York

## THOUGHT LEADERSHIP *POWERED BY HUB*

- 12 April 2024, Chanel Seeks Permanent Injunction Against WGACA
- 2 April 2024, Litigation Minute: Class-Action Challenges to Natural and Clean Beauty Product Claims
- 9 February 2024, Victory for Chanel in Luxury Reseller Trial
- 11 July 2023, Global Consumer Products Anti-Counterfeiting Webinar
- 21 June 2023, US Supreme Court Rules Against Andy Warhol–Foundation in Copyright Fair Use Dispute Over Prince Portrait
- August 2022, Fashion Law Update – August 2022
- 24 May 2022, FTC Imposes Multi-Million Dollar Penalties for Deceptive Consumer Reviews; Best Practices Reminders on Endorsements and Testimonials
- 30 March 2022, Copyright Dispute Over Andy Warhol's Portraits of Prince Heading to U.S. Supreme Court
- 23 November 2021, Fashion Law Update - November 2021
- 29 June 2021, White House Provides Guidance on "Made in America" Executive Order
- 22 June 2021, Unicolors v. H&M: Copyright Registration Validity
- 16 October 2020, Fashion Law Update - October 2020 Edition
- 4 September 2020, Can't "Shake It Off" Yet: Court Denies Taylor Swift's Motion to Dismiss Copyright Infringement Lawsuit
- 18 August 2020, Are Valentino's Rockstud® Shoes as Distinctive as the Red Soles?
- 14 July 2020, COVID-19: Advertising During and Beyond Pandemics - Reopening and Returning to Work: Messaging and Challenges
- 15 April 2020, Photographer Unsuccessful in Copyright Case Over Use of Embedded Instagram Photo
- 8 April 2020, Who Owns an Athlete's Tattoos? The Player? The Tattoo Artist? A Licensor?
- 23 March 2020, COVID-19: Three Ways to Reshape Advertising Readiness and Re-Tune Messaging in a Pandemic
- 1 February 2020, Fashion Law – February 2020 Edition

- 13 January 2020, Trademark infringement case update: Lucky Brands Dungarees v Marcel Fashion Group
- 27 June 2019, U.S. Supreme Court Strikes Down Ban on "Immoral" or "Scandalous" Trademark Registrations
- 12 April 2019, Webpage specimens not automatically use in commerce
- 8 April 2019, Fashion & Food Industry Update: More Companies Adopting Blockchain Solutions
- 8 April 2019, More Companies Adopting Blockchain Solutions
- 21 March 2019, Trademark, Design and Copyright Update For Fashion Brands
- 6 March 2019, U.S. Supreme Court Decides Two Copyright Cases and Impacts Registration Strategy for Copyright Owners
- 28 September 2018, Blockchain Can Change Everything: Even Trademark Transactions

## OTHER PUBLICATIONS

- "Analysis and Takeaways as Defence Preclusion is Considered in U.S. Supreme Court Hearing," *World Trademark Review*, 15 January 2020
- "Sweet as Hard Candy," *Ragtrader*, October 2019
- "Blockchain Can Change Everything: Even Trademark Transactions," *American Bar Association*, September/October 2018
- World Intellectual Property Review (WIPR), 'Physical, conceptual, distinctive'-why the Batmobile is copyrightable (26 November 2015)
- E-Commerce Law Reports - volume 15 issue 06, *Multi Time Mach. Inc. v. Amazon.com Inc.* (November 2015)
- Operation Choke Point: a tool against online counterfeiting, *E-Commerce Law & Policy* - PDF Only QI (May 2014)
- Combating Contributory Infringement on the Internet, *INTA Bulletin* - PDF Only (1 May 2014)
- The duties of online service providers, *TBO Newsletter* (March 2014)
- Counterfeiting: *Chloé SAS et al v. Sawabeh Information Services Co., et al.*, *E Commerce Law Reports*, Vol. 13, Issue 06 (December 2013)
- Second Circuit Clarifies Copyright Fair Use Standard (May 2013)
- FTC Updates Guidance on Online Advertising Disclosures (March 2013)
- Calculating and Proving Damages, Chapter 8, coauthor, *Copyright Damages*, Law Journal Press (2011)
- Recent Copyright Case Developments (5 August 2011)
- Sui Generis Right for Databases. Revamped or Redundant? coauthor, *IP Intelligence* (Fall 2009)



- 2007 Trademark Law Decisions of the Federal Circuit, coauthor, *57 Am. U.L. Rev.* 1039 (2008)
- Resolving Trademark Disputes Through ADR, Inside the Minds: Intellectual Property Dispute Resolution, *Aspatore* (2008)
- Prospective Franchisee Not Covered by Connecticut Act, *The Franchise Lawyer*, Vol. 3, No.4. (Spring 2000)
- Summarized opinions of the United States Court of Appeals for the District of Columbia Circuit and the District of Columbia Court of Appeals, *Case Digests, Legal Times* (November 1997–September 1999)
- Advertising Fund Disclosures: Lessons Learned From the Meineke Case, coauthor, *Franchise Update*, 2nd Quarter 1997, at 34, 36 (1997)
- Back Away From the Benefits, review of the Supreme Court's 1996–97 term, *Legal Times*, S48 (14 July 1997)

## NEWS & EVENTS

- 14 February 2024, *World Trademark Review 1000* Recognizes K&L Gates, Lawyers as IP and Trademark Leaders in 2024 Edition
- 7 February 2024, INTA Annual Case Law Review (New York, NY), Hosted by INTA
- 23 October 2023, K&L Gates' Intellectual Property Practice, Lawyers Recognized in 2023 *Managing IP* Magazine's "IP Stars"
- 9 February 2023, K&L Gates, Lawyers Named as IP and Trademark Leaders in 2023 *World Trademark Review 1000* Rankings
- 6 October 2022, K&L Gates Recognized in 2022 *Managing IP* Magazine's 'IP Stars'
- 15 March 2022, K&L Gates, Lawyers Named as IP and Trademark Leaders in 2022 *World Trademark Review 1000* Rankings
- 3 June 2021, K&L Gates Lawyers Ranked as 2021 'IP Stars' by Managing IP Magazine
- 17 February 2021, K&L Gates, Lawyers Named as IP and Trademark Leaders in 2021 *World Trademark Review 1000* Rankings
- 23 July 2020, K&L Gates Intellectual Property Practice Ranked by The Legal 500 United States 2020 Guide with Six Lawyers Recommended
- 29 June 2020, K&L Gates, Lawyers Ranked as Trademark and Patent 'IP Stars' by *Managing IP Magazine*
- 18 February 2020, K&L Gates, Lawyers Named as IP and Trademark Leaders in 2020 *World Trademark Review 1000* Rankings
- 12 February 2019, K&L Gates, Lawyers Recognized as IP and Trademark Leaders in 2019 *World Trademark Review 1000* Rankings
- 14 May 2018, K&L Gates Boosts IP Litigation Practice with Washington, D.C., Partner Addition

## AREAS OF FOCUS

- IP Litigation
- IP Procurement and Portfolio Management

## INDUSTRIES

- Advertising and Marketing
- Artificial Intelligence
- Consumer Products
- Food and Beverage
- Luxury Products and Fashion
- Technology

## EMERGING ISSUES

- Social Media Law

## REPRESENTATIVE EXPERIENCE

- Represented a leading, global specialty retailer in bringing trademark infringement lawsuit against two global clothing brands relating to their use of a Moose design on clothing. Able to leverage global enforcement actions in the U.S., Canada, UK, and EU, resulting in favorable resolution for our client.
- Represented a sugar-free breakfast and snack foods manufacturer in trademark infringement and unfair competition litigation against a competing food manufacturer, resulting in favorable settlement prior to defendant's answer deadline.
- Represented a children's organic snack manufacturer in successfully obtaining a very favorable decision before the National Advertising Division.
- Defended Onia, WeWoreWhat, Danielle Bernstein, Saks 5th Avenue, BOP, and Carbon 38, against trademark and copyright infringement allegations brought by a fashion brand relating to alleged copying of designs used on clothing and other items. After well over a year of contentious litigation, all claims were dismissed with prejudice.
- Defended Victoria's Secret against fitness company's claims of trademark infringement, unfair competition/passing off, and related state law claims relating to Victoria's Secret's use of the words "SWEAT" and "SWEAT ON POINT" in marketing. All claims were dismissed with prejudice.



- Represented National Space Society in defending against photographer's claims of copyright infringement relating to use of a photograph on social media. All claims were dismissed with prejudice.
- Represented grocery chain Mexico Foods, LLC d/b/a El Rancho in its declaratory judgment lawsuit for non-infringement of competitor's design trademark and trade dress. After El Rancho filed a Motion for Judgment on the Pleadings requesting the court to enter judgment in El Rancho's favor based on the facts in the Complaint and that a mere "eyeball" tests shows the trademarks are not confusingly similar. The case was successfully resolved in mediation and all claims were dismissed with prejudice.
- Represented Abercrombie & Fitch Co. in defending a lawsuit brought by pro se plaintiff that named over 25 retail manufacturing defendants, in which plaintiff alleged trademark rights in the terms LOWER EAST SIDE and LES NYC. The case against Abercrombie & Fitch resolved successfully in its favor.
- IP counsel to international corporation on its acquisitions of clothing and accessories brands, including acquisition of all trademarks, copyrights, and domain names, and related license arrangements.
- As lead trademark counsel for six luxury brand plaintiffs, Chloe, Cartier, Montblanc, Alfred Dunhill, Lange & Sohne, and Panerai, secured summary judgment on contributory trademark infringement and counterfeiting claims against large B2B website, and obtained multiple favorable pre-trial rulings, including highly contested jurisdictional claims over website owner and operator located outside the U.S., and dismissal of all of defendants' counterclaims including wrongful seizure and violation of the Stored Communications Act and the Computer Fraud and Abuse Act.
- Advised a major Japanese trading company, and its affiliate, in the establishment of a groundbreaking, cross-border e-commerce platform with one of China's largest state-owned enterprises and its affiliate.
- On behalf of the Kipling, Timberland, and Nautica brands, obtained a \$31 million damages award, permanent injunction, and transfer of multiple domain names in an action to combat the unauthorized and counterfeit uses of the three plaintiffs' famous trademarks in multiple domain names and copycat websites.
- On behalf of multi-national consumer goods corporation, the Procter & Gamble Co., secured a consent judgment and permanent injunction against a private-label manufacturer infringing the trade dress packaging and trademarks of a successful teeth whitening line of products.
- On behalf of the Kipling brand, secured TRO and preliminary injunction against multiple manufacturers and sellers infringing the trade dress of Kipling handbags and travel bags.