



# K&L Gates Trademark Practice



## Brand Development, Management, and Protection

As the world shrinks and windows of opportunity open in new markets and technologies, brand owners recognize that increasing brand value depends on both choosing strong marks and protecting them.

## Why K&L Gates?

With 36 offices on three continents, K&L Gates' Trademark practice is the complete package for brand owners and branding companies that not only need clearance, prosecution, policing, and licensing experience, but a real world connection in every important technology and geography. Trademark owners, big and small, come to us for advice and direction. Please ask how we can help you, too.

## Our Services

### Branding and Prosecution

K&L Gates lawyers and para professionals have assisted numerous clients, including naming companies and multinational corporations, in the selection and clearance of their trademarks. We regularly counsel clients on how to choose marks that achieve their marketing goals, while maximizing the likelihood that the marks can be used without challenge and policed in an increasingly crowded marketplace.

Annually ranked among the top trademark filers in the United States, K&L Gates boasts a rich and varied trademark prosecution practice. We regularly prosecute applications

for marks used on everything from food and beverages to medical devices, and from media, publishing and the arts to all manner of internet and e-commerce applications. In addition, our ranks include former U.S. Trademark Examiners, whose experience in managing the process with the Patent and Trademark Office can be an invaluable benefit. Our lawyers also include a number of former in-house counsel, who add valuable insight to our trademark client service teams.

With offices in Europe and Asia, and a strong network of carefully screened foreign associates, we also help our clients develop and implement cost-effective strategies for registering and enforcing their rights in over 150 countries.

### Transactions and Audits

K&L Gates helps clients maximize the value of their trademark assets by assisting in the process of licensing, transferring, or acquiring assets. We realize that each situation is unique and can assess the interplay between the client's objectives and the nature of the intellectual property assets in question. By understanding the assets and the surrounding issues, we help our clients maximize the value of the transaction.

Our transactional experience includes traditional trademark licensing and asset acquisition, as well as the licensing of celebrity names, personae, images, and all aspects of merchandise licensing.

Our lawyers perform intellectual property due diligence for a range of corporate transactions, including mergers and acquisitions. We also regularly perform audits to assist clients in identifying their trademark assets, including those that may be under or overprotected. These audits can be valuable tools in placing an economic value on those assets in connection with transactions, litigation, and taxation matters.

### The Internet and Domain Names

We help intellectual property owners thrive in the Internet environment. We stay on the cutting edge of the legal issues raised by on-line and e-commerce activities, and are well positioned to advise clients about emerging concerns, whether the issue relates to domain names, keyword advertising, phishing, scraping, online scams, domaineering, or cybersquatting.

Need local counsel in California? We're there.

Responding to a claim in Chicago or thinking about an action before the International Trade

Commission in Washington, D.C.? We're

there, too. Need to understand how local

consumers in China or the Carolinas, London, Berlin, Boston, Dallas, Pittsburgh, or Seattle are going to perceive a proposed brand?

We've got you covered.



## Enforcement

We protect our clients' brands on a global level. Our trademark lawyers appear in courts and agencies around the world to assert and defend claims of infringement, dilution, and unfair competition. We aggressively pursue counterfeiters and others who attempt to trade on the goodwill of our clients' trademarks, including by obtaining injunctive relief and involving customs and other governmental authorities to seize goods when warranted.

We are accomplished at handling disputes involving atypical trademarks, such as product designs and three-dimensional products. And, we are experienced in anti-counterfeiting activities and customs seizures.

As part of our worldwide enforcement efforts, we can monitor applications and registrations that might impact our clients' trademarks. In the United States, we oppose or move to cancel those applications and registrations before the Trademark Trial and Appeal Board. In other countries, we regularly oversee challenges to such applications and registrations.

We also have extensive experience in asserting false advertising, unfair competition, and misappropriation claims, as well as in counseling clients to defend and preferably avoid such claims.

## Education and Publishing

K&L Gates lawyers frequently speak and write on leading edge trademark development, management and protection issues before large and small audiences around the world. Our lawyers also regularly provide training on such topics as branding considerations, portfolio management and cost control to other trademark professionals and to teams of in-house lawyers and marketing groups.

## Our International Reach

Trademark law can vary enormously from country to country. Through the broad reach and experience of our lawyers, and our international network of associates, we have a deep understanding of global trademark issues. K&L Gates lawyers work with our clients to establish cost-effective strategies for registering and enforcing their marks worldwide.

## China Trademark Capabilities

K&L Gates works with clients to provide counsel in connection with China, Hong Kong, and Taiwan trademark filings, appeals, oppositions, and enforcement with lawyers who are comfortable working to the standards of top U.S. and European law firms. When working with the K&L Gates Asia Trademark group, clients can expect the same level of client service and responsiveness as one would receive from their U.S. legal counsel. Further, we coordinate with U.S. trademark counsel in our own firm, as one firm, with one face. We have found this practice avoids the communication and billing issues that sometimes arise when legal work crosses firm boundaries. Our broad geographic reach allows us to provide coordinated service with trademark strategy and trademark disputes that cross international boundaries. We view our China Trademark capabilities as a value-added service to loyal clients of the firm and offer this work at competitive, and sometimes even more cost-effective, pricing arrangements when compared to Western facing Chinese trademark firms.



K&L Gates ranked No. 3  
in Intellectual Property Today's list of the  
Top Trademark Firms of 2010.\*

\*firms are ranked according to the number of trademarks issued in 2009

## Representative Matters

- Successfully advised *Puma* against Payless in an athletic shoe trade dress case.
- Successful defense of *Abercrombie & Fitch* in a leading case involving clothing trademarks.
- Successful representation of *Brett Bros. Sports Intl.* in a sports equipment trademark case.
- Assisted *Frank J. Zamboni & Co., Inc.* in restoring its trademark rights in China
- Assisted a U.S.-based manufacturer to develop in-house trademark strategy for China imports to avoid violations of Chinese trademark laws.
- Represented General Motors Corporation and Burger King Corporation in trademark matters in Taiwan.
- Represented many U.S., European and Japanese clients in filing numerous trademark applications with the Chinese Trademark Office (CTMO).
- Coordinated the trademark filings for U.S. clients (including an internet company) in Greater China areas including Mainland China, Taiwan, Hong Kong, and Singapore.

## Representative Clients

- Abercrombie & Fitch
- American & Efird, Inc.
- AOL, LLC
- AVermedia Technologies, Inc.
- Burlington Coat Factory Warehouse Corporation
- Citrix Systems, Inc.
- Earth Day Network
- Expedia, Inc.
- Frank J. Zamboni & Co., Inc.
- Hendrick Motorsports, Inc.
- Hotels.com L.P.
- Hotwire, Inc.
- Hughes Network Systems, LLC.
- Instrumentation Laboratories, Inc.
- Joe Gibbs Racing, Inc.
- Kestrel Vintners
- Nicholas Cole Cellars
- Polartec, LLC
- Providence Health & Services
- PUMA AG
- Red Lion Hotels Corporation
- Sahale Snacks, Inc.
- ServiceMax Cleaning Systems
- Signature Genomic Laboratories, LLC
- Solar Power Partners, Inc.
- SPARC International, Inc.
- The Inspirational Network, Inc.
- Time Warner, Inc.
- TripAdvisor LLC
- Valve Corporation
- World Wrestling Entertainment, Inc.



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K&L Gates LLP



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