

# **Alexis Crawford Douglas**

# Partner

Chicago +1.312.807.4346

alexis.douglas@klgates.com

# **OVERVIEW**

Alexis Crawford Douglas concentrates her practice in the area of intellectual property, and handles a range of counseling, transactional, and litigation matters related to trademarks, domain names, social media, and copyrights.

Alexis provides strategic management of global trademark portfolios for clients ranging from multi-national to start-up companies in a variety of industries, including pharmaceuticals, diagnostics and medical devices, consumer products, marketing and advertising, energy, apparel, food and beverage, finance, and technology. Alexis assists clients with clearance, prosecution, protection, and enforcement of trademarks.

Alexis advises clients in trademark and copyright disputes, including representing clients in litigation matters in various federal courts and before the Trademark Trial and Appeal Board. She counsels clients in dealing with cybersquatting and online infringement matters, including domain name disputes pursuant to the Uniform Domain-Name Dispute-Resolution Policy (UDRP) and the Anticybersquatting Consumer Protection Act (ACPA), and website and social media takedowns involving the Digital Millennium Copyright Act (DMCA).

Alexis also counsels clients on intellectual property issues in complex commercial transactions, and provides strategic advice on licensing, assignment, and consent agreements related to intellectual property.

### PROFESSIONAL BACKGROUND

Alexis previously worked as an intellectual property intern for an American entertainment company, focused in filmed entertainment. She also served as a judicial extern for the Honorable Morton Denlow of the United States District Court for the Northern District of Illinois.

Prior to her legal career, Alexis worked at a business intelligence solutions company, where she managed a network of educational websites, and wrote and edited daily news briefs on niche industries for corporate clients. Alexis also owned and managed her own writing, editing, and consulting company.

### **ACHIEVEMENTS**

Listed in the World's Leading Trademark Professionals by World Trademark Review 1000, 2022-2024

- Selected to Super Lawyers, 2024
- Named to "40 Under Forty" list, Chicago Daily Law Bulletin, 2022
- Selected for Notable Women in the Law, Crain's Chicago Business, 2020
- Emerging Lawyer, *Leading Lawyers*™, 2021, 2022
- Listed in Best Lawyers: Ones to Watch® in America, 2020-2022
- Selected to Illinois Rising Stars in Intellectual Property, 2020-2023

# PROFESSIONAL / CIVIC ACTIVITIES

- Board of Managers for The Chicago Bar Association
- The Richard Linn American Inn of Court
- International Trademark Association, Internet Committee
- NIJC Pro Bono Asylum Attorney Program
- Board of Directors for the Skokie Valley Symphony Orchestra (2014-2015)
- Adjunct Professor and co-founder of The John Marshall Law School's Trademark Clinic (2014-2015)

## SPEAKING ENGAGEMENTS

- Mentor, "The Garage," a program empowering student entrepreneurs, Northwestern University, 17 November 2021
- Host Redefining Work-Life Integration in a Post-COVID World as Co-Chair of The Chicago Bar Association's Women's History Month programming, 15 March 2021
- Panelist for the American Bar Association's Fashion Law Round Table, 28 January 2021
- Panelist on Associate Tips and Tricks Panel for The Chicago Bar Association's Young Lawyers Section, 23 July 2020
- Interview on How to Make Partner for The Chicago Bar Association's Young Lawyers Section, 5 May 2020
- Panelist for Navigating Motherhood and Your Legal Career, The Chicago Bar Association's 2nd Annual Working Women's Legal Summit, 6 March 2020. Chair of The Chicago Bar Association's Women's History Month programming, including the Summit
- Hosted a panel and assisted with organization of The Chicago Bar Association's first Working Women's Legal Summit. 8 March 2019
- Moderated Trademark and Copyright Enforcement at the ITC and Customs presentation for The Richard Linn Inn American Inn of Court, 15 November 2018

- Moderated ABA Annual Meeting panel on If the Shoe Fits: What Footwear Cases Teach Us About IP Protection & Enforcement, 3 August 2018
- Panelist at Chicago Bar Association's Seminar for November 2016 New Admittees to the Illinois Bar on Career Development, 28 February 2018
- Presented on handling unlawful content on social media at General Counsel University: Like This: How to Assess & Manage Your Social Media Risk, October 2017
- Moderated Developing Business by Working in the Community for the Chicago Bar Association's Young Lawyers Section L.E.A.D. for Large Law Firms Committee, 7 November 2016
- Panelist and assisted with presentation preparation for Willfulness: The Ship Has Sailed on Seagate with pupilage group for The Richard Linn Inn of Court, 13 October 2016
- Emceed final round of Launch Competition at Techweek Chicago 2016
- Moderated Developing a Coveted Expertise for the Chicago Bar Association's Young Lawyers Section L.E.A.D. for Large Law Firms Committee, 7 April 2016
- Participated in Intellectual Property Law Society's IP practice panel at Northwestern University School of Law, 2 March 2016
- Panelist at Chicago-Kent Gastro IP Symposium discussing intellectual property issues for craft brewers, 10 November 2015
- Presented Tips For Tweets and Engaging Online: Navigating the Legal Issues on Social Media Platforms at Chicago Bar Association's Creative Arts committee meeting, 15 September 2015
- Presented Think Before You Tweet with K&L Gates partner Ben Weed at Techweek Chicago 2015
- Routinely provides presentations on trademark, copyright, social media and advertising guidelines to large and small companies in an accessible way to guide employees' behavior and emphasize importance of IP protection
- Annually teaches foreign trademark prosecution program to new associates at K&L Gates

# **EDUCATION**

- J.D., Chicago-Kent College of Law, Illinois Institute of Technology, 2011 (cum laude; Moot Court Honor Society, President; Journal of Intellectual Property, Associate Editor, Executive Articles Editor; Dolores K. Hanna Trademark Prize)
- B.S.J., Northwestern University, 2006 (Journalism and Political Science)

#### **ADMISSIONS**

Bar of Illinois

United States District Court for the Northern District of Illinois

### THOUGHT LEADERSHIP POWERED BY HUB

- 22 March 2024, HACKED! Regain Control of Your Social Media Identity
- 10 February 2023, False Advertising Large Jury Verdicts in 2022 and the Likely Uptick in False Advertising Suits in 2023 - Part 1
- 13 January 2023, If You Want it, You Should Have Done a Search on it: Why Trademark Searches Are Essential Before Settling Down With a New Brand
- 4 July 2022, Latvian Citizen Fined US\$4.5 Million and Sentenced to More Than Four Years of Imprisonment for Fraudulent Trade Mark Renewal Scheme
- February 2022, February 2022 Accolades
- August 2021, August 2021 Accolades
- 11 November 2020, Congratulations to Our Diverse and Women Lawyers
- 4 May 2020, Show Me the Money: Supreme Court Rules that Trademark Infringers may Disgorge Profits even if the Law was not Willfully Violated
- 22 August 2017, U.S. Court finds Adidas' Stan Smith shoe trade dress protectable
- 5 April 2017, Stop Spreading the News: A Five-Step Guide to Handling Unlawful Content Posted on Social Media & Other Public Platforms, This article originally appeared on Legaltech News
- 30 September 2015, Consider Fair Use Before Submitting Takedown Request

#### **NEWS & EVENTS**

- 14 February 2024, World Trademark Review 1000 Recognizes K&L Gates, Lawyers as IP and Trademark Leaders in 2024 Edition
- 9 February 2023, K&L Gates, Lawyers Named as IP and Trademark Leaders in 2023 World Trademark Review 1000 Rankings
- 10 January 2022, K&L Gates Advises Blue Point Capital Partners on Platform Investment in National OnDemand
- 19 August 2021, Nearly 300 K&L Gates Lawyers Named Among 2022 Best Lawyers in America, Ones to
- 28 January 2021, Dressing Up Rights: Building a Protectable Fashion Brand
- 2 November 2020, Numerous K&L Gates Diverse and Women Lawyers Recognized for Leadership and Legal Accomplishments

- 9 September 2020, Four Chicago Partners Listed Among 2020 Notable Women in Law by Crain's Chicago **Business**
- 25 June 2020, K&L Gates Intellectual Property Partner Elected to Board of Managers of The Chicago Bar Association
- 24 February 2020, K&L Gates Names 41 New Partners Across Global Platform

## **AREAS OF FOCUS**

- IP Procurement and Portfolio Management
- **IP** Litigation

#### **EMERGING ISSUES**

Social Media Law

### REPRESENTATIVE EXPERIENCE

- Successfully negotiated an amendment to a Japan energy company in Trademark Consent and Coexistence Agreement with software developer. The company uses its company name in various marks in connection with the provision of a wide range of energy-related services.
- Negotiated global trademark coexistence agreement between an established transfusion medicine trademark and new genetic mapping trademarks, resolving numerous contentious proceedings related to the marks around the world and charting a path for mutual cooperation and fields of use in the future, creating business certainty and clear spaces for the marks.
- Manage numerous trademark applications and Office Action responses to the U.S. Patent and Trademark Office involving a range of products and services
- Global trademark counsel to brands in a range of industries, particularly focused on diagnostics and pharmaceuticals; counsel clients on clearance searches and risk assessments for new trademarks, brands, logos and company names
- Handles intellectual property due diligence and agreement review in corporate transactions
- Represented plaintiff in trademark infringement, unfair competition and cybersquatting case in the Northern District of Illinois and obtained favorable judgment, novel damages award, and injunction
- Obtained successful transfer of domain names for car care client from cybersquatter offering competitive services
- Obtained successful transfer of .com domain name for online health insurance marketplace

- Represented plaintiff in trademark infringement and unfair competition action in the Southern District of New York, drafted pleadings, briefed and appeared in preliminary injunction hearings, engaged in motion practice, conducted depositions and advised on discovery strategy
- Obtained successful transfer of .com domain name based on extensive common law rights
- Routinely assist clients with removing infringing content from third-party websites
- Successful transfer of domain name for financial services firm from cybersquatter
- Obtained successful transfer of domain name for financial services firm from cybersquatter
- Represented defendant as trademark counsel in Northern District of Illinois case involving trade dress infringement allegations for unique bottle design
- Prevented transfer of rightfully registered domain names for medical device company