



Scott M. Douglass

Shareholder

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Scott Douglass represents clients across the country in matters involving trademarks, trade dress, copyrights, software, design patents, and other intellectual property.

Mr. Douglass helps businesses and individuals protect their brands and add value by acquiring, enforcing, and protecting their intellectual property rights. He concentrates his practice in litigation, licensing, and intellectual property prosecution.

Mr. Douglass litigates trademark, trade dress, copyright, and design patent claims in federal courts across the country. He represents companies and individuals acting as both rightsholders asserting their rights and as defendants accused of infringing others' rights. He has defended clients against temporary restraining orders and preliminary injunctions, investigated and prepared lawsuits, and advised clients in all aspects of the litigation process, from complaint through discovery and summary judgement.

In addition to his litigation practice, Mr. Douglass has extensive experience advising companies in trademark, copyright, and patent licensing agreements; non-disclosure and confidentiality agreements; asset sales; software and end-user licenses; and other intellectual property transactions. He is better able to advise his clients by maintaining a diverse practice between litigating and licensing.

Mr. Douglass assists clients in a wide range of industries, including film and television, music, entertainment; beer and spirits; food and restaurants; professional services, financial services, manufacturing, retail services, and pharmaceutical products.

Beyond litigation, Mr. Douglass advises clients on the adoption and protection of brands and registration at the U.S. Patent and Trademark office (USPTO). With years of experience prosecuting trademarks at the USPTO and before the Trademark Trial and Appeal Board, he is able to help clients anticipate obstacles and plan for brand growth and product launches to maximize the value of their intellectual property. He also helps clients through online domain name enforcement and Digital Millennium Copyright Act (DMCA) takedown notices and by protecting clients' works and creative expressions in the form of copyright registration at the U.S. Copyright office.

During law school, Mr. Douglass clerked for the Honorable John Bryant in the U.S. District Court for the Middle District of Tennessee and the Honorable Charmiane Claxton in the U.S. District Court for the Western District of Tennessee. He also clerked for the general counsel of one of the largest tobacco companies in the world and worked for the U.S. Senate Committee on Small Business & Entrepreneurship.

Before attending law school, Mr. Douglass worked as a legislative aide to two United States Senators, studied Arabic in the Middle East, and traveled in Africa and the Middle East.

Representative Matters

Litigation

- Defeated a motion for a temporary restraining order and preliminary injunction against a music festival client.

- Achieved a favorable settlement after filing a motion for summary judgment on behalf of a client accused of federal trademark infringement by a Fortune 500 company.
- Defended a client against federal trade dress infringement claims, resulting in a voluntary non-suit by the plaintiff.
- Enforced trademark rights and copyright in a client's nationally recognized brand against multiple defendants who sought to unlawfully use the client's brand for commercial development.
- Achieved a favorable settlement in a federal trademark infringement suit against an accused infringer who adopted client's logo for advertising to client's competitors.
- Successfully pursued a motion for sanctions against a defendant in a federal trademark infringement case.
- Achieved a favorable settlement on behalf of a client accused of federal trademark counterfeiting and infringement by a Fortune 500 company.
- Prevailed on a motion to dismiss for a lack of personal jurisdiction on behalf of defendants improperly sued in federal district court.
- Achieved a favorable settlement in a federal trademark infringement suit against a competitor who violated a decade-old settlement agreement.
- Initiated the take-down of more than a dozen infringing domain names under the Uniform Domain-Name Dispute-Resolution Policy (UDRP).

Prosecution, Licensing, and Counseling

- Registered more than 100 trademarks with the U.S. Patent and Trademark Office.
- Overcame USPTO Trademark Office Actions for mere descriptiveness, likelihood of confusion, geographic descriptiveness, and other grounds.
- Protected the intellectual property rights and exposure to liability through licensing, non-disclosure, and settlement agreements of brands, products, and inventions for diverse clients.



Professional Honors & Activities

- Listed in *Best Lawyers: Ones to Watch® in America* for Intellectual Property Law and Litigation: Intellectual Property (2021 – 2023)
- Selected to Mid-South Super Lawyers "Rising Stars" in Intellectual Property (2018 – 2023)
- Participant – Nashville Bar Foundation Leadership Forum (2019 – 2020)
- Member – American Intellectual Property Law Association
- Member – Copyright Society of the South
- Member – International Trademark Association
- Member – Memphis Bar Association
 - Co-chair, Business Law Section (2021 – present)
- Member – Nashville Bar Association
 - Co-chair, Business Law Committee (2019 – 2020)
 - Former Member of Board of Directors, Young Lawyers Division
- Member – Tennessee Bar Association
- Member – Tennessee Intellectual Property Law Association
- Member – Licensing Executives Society
 - Former Chair – Webinar Committee
 - Former Chair – Emerging Enterprises Committee



Publications

- "The Fast-Moving Race Between Gen-AI and Copyright Law" (July 2024)
- "Re-Considering the Right of Publicity in the World of Generative AI," republished in *IP Watchdog* (July 2024)

- "Don't Forget About NFTs! USPTO and USCO Issue Joint Study on the Interplay Between NFTs and Intellectual Property," republished August 2024, in *The Licensing Journal* (June 2024)
- "The Supreme Court Draws the Line on the Foreign Reach of the Lanham Act" (July 2023)
- Co-author – "Licensing in Bankruptcy," Scott Douglass, Dominic Rota, and Michael Wennerlund, *American Bankruptcy Trustee Journal*, Vol. 38, Issue 2 (Spring 2022)
- Co-author – "Thinking of Rebranding Post-Pandemic? The 'Tacking' Doctrine May Say Otherwise," *Tennessee Bar Journal* (May/June 2021)
- Co-author – "Trademarks + The Significance of Source," *Barista Magazine* (October/November 2019)
- Co-author – "Right Before Remedy – Supreme Court Requires Businesses to Register Their Copyrights Before Enforcement," *Association of Corporate Counsel Tennessee Focus* (First Quarter 2019)
- Co-author – "Cybersecurity and Your Company: Don't Wait Until You've Been Hacked To Get Serious About Security," *Attorney At Law Magazine* (March 2017)



Speaking Engagements

- "Drafting Ethical Cease and Desist Letters for Trademark and Copyright Infringers," Association of Corporate Counsel Tennessee (2021)
- "'So You Want to Start A . . .' – Intellectual Property Considerations for the 'Non-Startup' New Business," Nashville Bar Association, Business Law Institute (2020)
- "Ethics & Professionalism in Intellectual Property Law," Tennessee Bar Association, Intellectual Property CLE Blast (2019)
- "Leveraging Tech for Legal," Roundtable Hosted by Evolve Law
- "IP Curriculum," Entrepreneur Center Accelerators (Project Music/1440)
- "Intellectual Property: Nuts and Bolts," National Business Institute, Manufacturing Law Event, Nashville



Webinars

- The FTC's Proposed Ban on Non-Competes: What We Know and What You Can Expect (February 2023)
- Recent Developments in IP Law (December 2022)



Education

- Wake Forest University School of Law, J.D., 2012
 - Managing Editor – *Wake Forest Journal of Law & Policy*
- Rhodes College, B.A., 2006, cum laude



Admissions

- Tennessee, 2012
- District of Columbia, 2023
- U.S. District Court for the Middle District of Tennessee
- U.S. District Court for the Western District of Tennessee
- U.S. District Court for the Eastern District of Tennessee
- U.S. District Court for the Western District of Texas
- U.S. Court of Appeals for the Sixth Circuit
- U.S. Court of Appeals for the Federal Circuit