

OUR PRACTICE

Trademark and Branding

Baker Donelson's Trademark and Branding attorneys understand that global brand protection, achieved in partnership with your company's strategists, begins with strategic counseling to audit and identify core brands that further your company's core purpose; establish short- and long-term business goals; and construct a strategy that leverages and protects core brands as proprietary trademarks across social media, web-based business platforms and traditional business settings. We also provide clients with access to a free portal providing real-time access to trademark portfolio details as well as generating trademark deadline and trademark status reports.

We advance, maintain and protect this strategy by:

- Filing for registration, maintenance and renewal of trademarks in the United States and abroad, including negotiating Trademark Office actions on applications, and appealing to the Trademark Trial and Appeal Board or courts as necessary
- Registering trademarks with Customs in the United States and worldwide to prevent importation of infringing goods
- Working with our network of foreign associates around the world to register, maintain, renew and enforce trademark rights globally
- Licensing and franchising
- Performing trademark clearance searches and opinions for new marketing, and investigating the trademark rights of others
- Performing due diligence for mergers and acquisitions of trademarks
- Docketing trademarks for maintenance and deadline compliance
- Providing trademark watch services and 2(d) citation watch services that identify threats in competitors' activities



Representative Matters

- Successfully represented the designer and manufacturer of cheerleading apparel in a copyright infringement suit, including successful appeal to the Sixth Circuit Court of Appeals, which was affirmed by a 6-2 decision of the United States Supreme Court, where the Supreme Court established a new standard and resolved a circuit-split regarding the proper test for conceptual separability and copyrightability applicable for two-dimensional artwork applied to useful articles.
- Manage and enforce large international trademark portfolios for clients in the artificial intelligence (AI) software and AI services; consumer and cosmetics; building materials; food products and restaurant services; automotive; clothing and apparel; health and medical services; and senior and assisted living facilities, including providing brand advice and strategy for growth.
- Advised recording artists and songwriters regarding entertainment/music industry agreements and protection of intellectual property, including negotiation of publishing agreements, 360 deals, drafting and negotiating synchronization licenses for use of songs in films, drafting recording agreements for Grammy® Award winning artists, and counseling artists on obtaining commercial success.
- Successfully prosecuted dozens of copyright and trademark applications.
- Advised the client in the negotiation and purchase of a large trademark portfolio from a competitor.
- Outside trademark counsel for multiple clients in the restaurant services industry and food preparation industry.

- Global Intellectual Property counsel for Avis Budget Group, Inc. and Zipcar Inc., global leaders in fleet management technology, rentals and ride sharing.
- Advises recording artist on distribution agreements and copyright protection of songs and performances.
- Advised U.S. companies on the protection and monetization of copyright assets.
- Designed and implemented strategies for establishing protectable trademark and trade dress rights in marks requiring secondary meaning.
- Represented the client and performed extensive due diligence in the acquisition of large patent and trademark portfolios.
- Obtained favorable copyright rulings in the Sixth Circuit Court of Appeals on two issues of first impression which are of extreme importance to the fashion and clothing industries - the test for conceptual separability of graphic designs from clothing and the deference that courts should pay to registration decisions of the Copyright Office.
- Guided U.S. and overseas clients in medical devices, construction materials, franchising and cosmetics through the registration process for protection of trademarks at the state, federal and international levels.
- Prosecutes multi-country trademark applications through the World Intellectual Property Organization and the Madrid System.
- Advised multi-national company on trademark and copyright issues regarding online presence and warranty agreements for new product.
- Trademark and copyright counsel for multiple start-ups and app developers.