



→ Michelle LaVoie Wisniewski

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Michelle LaVoie Wisniewski is an associate in the Intellectual Property Practice Group in Sheppard Mullin's Orange County office.

Areas of Practice

Michelle helps clients build, enforce, and protect brands. She provides strategic counseling, prosecutes trademarks in the United States, and coordinates worldwide brand expansion.

Michelle has experience before a variety of courts in connection with intellectual property matters including California's state and federal courts, the Ninth Circuit Court of Appeals, and the Trademark Trial & Appeal Board. Most recently, Michelle obtained a unanimous victory before the United States Supreme Court in a trademark infringement matter.

Michelle's experience extends to transactional matters, including the negotiation and preparation of intellectual property agreements, intellectual property diligence, licensing and ownership issues.

Honors

Southern California Rising Star, *Super Lawyers*, 2009-2016

Experience

Representative Matters

Successfully represented Respondent Hana Bank before the United States Supreme Court in a trademark infringement matter, with an emphasis on written advocacy. *Hana Financial v. Hana Bank*, 574 U.S. 418 (2015). In a unanimous decision, the Supreme Court resolved a Circuit split involving the doctrine of trademark tacking to uphold the Ninth Circuit Court of Appeal's decision favoring Respondent.

Represented Hana Bank in the same matter before the Ninth Circuit Court of Appeals, 735 F.3d 1158 (9th Cir. 2013), wherein the court upheld a unanimous jury verdict and final defense judgment favoring Hana Bank. *Hana Financial, Inc. v. Hana Bank* (C.D. Cal. Case No. CV07-1534-PA).

Represented a well-known electronics company in a proceeding before the Trademark Trials and Appeal Board, obtaining a favorable trial decision preventing petitioner from cancelling the client's trademark in light of its transitioned use from one product to a related product over time. *Sony Mobile Comm'n Inc. v. VIZIO, Inc.* (T.T.A.B. Proceeding No. 92/070,572).

Represented an entrepreneurial beverage company to obtain injunctive relief before the Ninth Circuit Court of Appeals and the Central District of California in *Innovative Beverage Concepts, Inc. v. Ames International, Inc.* (C.D. Cal. Case No. CV-04-00562-CJC; 9th Cir. Case No. 05-55459).

Secured district court summary judgment ruling of non-infringement in favor of the defendant to a trademark infringement matter in *Hana Financial, Inc. v. Hana Bank* (C.D. Cal. Case No. CV07-1534-PA).

Assisted in obtaining Ninth Circuit Court of Appeals approval of summary judgment award in favor of a high-tech defendant in a trade secret misappropriation matter in *Wyatt Technology v. Smithson, et al* (9th Cir. Case No. 06-56470).

Obtained favorable summary judgment ruling that trademark counterfeiting liability was non-dischargeable through bankruptcy in *Taylor Made Golf Company Inc. v. Han* (2:06-ap-01193-BR).

Helped procure transfer of domain name on behalf of a medical device company who had fallen victim to a phishing fraud through the registration and use of a domain name incorporating its trademark in *Beckman Coulter, Inc. v. Wilson* (WIPO Case No. D2010-1163).

Other representations include negotiating a favorable settlement of trademark litigation for a large retail defendant after highlighting the weaknesses in plaintiff's damages claim upon summary judgment, successfully defending an online auction site against liability for third party user conduct, and obtaining dismissal of a copyright litigation matter against a prominent online service provider based on the activities of its users.

Articles

Intellectual Property Law Blog Posts

- "Second Circuit Decision Expands Famous Trademark Owners' Rights," March 1, 2007
- "The Open Source Initiative: A 30-Second Primer," May 3, 2006

Media Mentions

Supreme Court Update - *Hana Financial v. Hana Bank*
The National Law Review, 02.2015

Supreme Court Resolves Circuit Split on Trademark Tacking
The Recorder, 01.23.2015

Sheppard Mullin Team Argues U.S. Supreme Court Trademark Case for Hana Bank
12.03.2014

Memberships

Member, American Bar Association (ABA)

Member, Intellectual Property Law Section, State Bar of California

Member, Orange County Bar Association (OCBA)

Member, International Trademark Association (INTA)

Member, American Intellectual Property Law Association (AIPLA)

Member, Association of Business Trial Lawyers (ABTL)

Practices

Litigation

Intellectual Property

False Advertising, Lanham Act and Unfair Competition

Patent Litigation

Trade Secrets

Trademarks and Trade Dress

Copyrights

Education

J.D., University of California, Berkeley, 2004

B.S., Northwestern University, 1998, *cum laude*