Services

Trademarks

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Successful companies rely on the power of their trademarks and brands to communicate the quality and distinctiveness of their products and services. Trademarks are often some of the most valuable assets of a company.

Our trademark team diligently and creatively help our clients throughout the life of a mark – from selection, clearance, prosecution and maintenance to portfolio management, trademark audits, licensing, watch services, disputes and litigation. Our trademark team does not simply provide rote registration services. Instead, we work with our clients to articulate their business goals, ensuring that each trademark asset serves those goals.

Trademarks, Branding, Social Media and Advertising

Brand Development: Brand development is a crucial task for most businesses, from the biggest brand owners to athletes, influencers and other emerging brand owners. We help guide our clients in brand development to help them optimize their brand for more differentiation, alignment and impact. We then work with them to protect that brand offensively and defensively.

Trademark and Trade Dress Counseling and Prosecution: We offer cost-effective and forward-looking strategies for our clients' branding processes, whether the matter involves a multi-jurisdictional roll-out for a multi-national corporation or the protection of a new mark for a start-up enterprise. We have handled thousands of marks and branding situations worldwide and have nurtured a global network of foreign counsel to help our clients navigate the nuances of non-U.S. trademark and trade dress laws.

Domestic Trademarks: Before adopting a trademark, we advise clients on strategies to adopt strong marks that are protectable and registerable. Our counseling during the early phases of trademark development helps avoid costly conflicts or enforcement problems down the road. Once our client selects a mark, we conduct availability searches and render clear and practical opinions regarding registration. We carefully evaluate each search request to ascertain the goods and services to search, the type of search to conduct, and whether other

resources are needed. We investigate relevant marks and names to determine if they are in use and, if so, the nature and extent of any rights their owners may possess. Our extensive litigation experience allows us to provide realistic opinions on a mark's availability, as well as practical recommendations on using and registering the mark to avoid or minimize potential problems. During prosecution, if we are met with refusals from the trademark office, we provide practical advice for the best and most efficient way to respond.

International Trademarks: As with U.S. prosecution, we do not treat foreign trademark filings as routine administrative matters but as extensions of our clients' business goals. Thus, we look at the nature of the mark, the U.S. application, U.S. or foreign search results, and potential disputes, and discuss the use plans for the mark with the client to understand the progression of the mark's rollout. From this, we develop appropriate foreign filing strategies, often using a stage-gate or zone-of-interest sequential plan, for filing the mark in international jurisdictions. For over 30 years, we have nurtured a network of trademark lawyers and agents around the world to assist our clients with foreign trademark filings. We have extensive experience with international clearance projects and present search results in organized and streamlined formats that are easy to understand, contain concise summaries and include specific advice on recommended actions.

Social Media and Advertising Properties

Social Media and Sponsorships: We are well versed in the advertising and intellectual property (IP) issues as they relate to social media platforms including the user agreements of various platforms and emerging platforms. We are intimately familiar with viral marketing, including use of user-generated content and Federal Trade Commission (FTC) guidelines for endorsements, sponsored content, the use of influencers and testimonials; native advertising; and rules and regulations promulgated by the sports governing bodies regarding the use of athletes, venue "flash" advertising and related attempts at unauthorized association.

Promotions, Sweepstakes and Contests: We also advise clients with respect to the legal requirements of promotions, sweepstakes and contests. We prepare official rules and promotion details that comply with local, state and federal law and ensure compliance with social media platform rules. We also advise clients regarding compliance with state registration and bonding requirements. We review print, radio, television, direct mail and internet advertising to confirm which rule disclosures may be required. We regularly work with promotion/sweepstakes/contest vendors engaged to assist clients with the administration and management of a particular promotion.

Non-Fungible Tokens (NFTs) and the Metaverse

Our IP lawyers work with clients to help them obtain and protect their crypto properties like NFTs for brand control, increased revenue, brand awareness and enhancing trust and authenticity for use, *g.*, in the metaverse. We help clients obtain NFT trademarks that represent digital media, virtual goods, digital collectibles and other crypto-assets that can be bought, sold, exchanged and transacted using blockchain technology. For example, we help our clients review their existing trademarks and, if needed, apply for additional trademarks for digital assets, crypto-assets and virtual goods authenticated by NFTs. We also help our clients navigate the use and policing of their brands in the metaverse as it grows and matures to

provide increasingly immersive experiences for more and more people.

Trademark-Related Transactions

Due Diligence: We regularly assist clients with IP due diligence tasks when they are looking to invest in or acquire certain businesses to determine the relative value of the IP assets and to assess risk. Trademarks are often a focus of this analysis especially when there are agreements that affect a target's rights in the marks.

Agreements: Our comprehensive trademark services include agreement work related to trademarks such as licenses, co-branding agreements, sponsorship agreements, and naming rights agreements. Our attorneys have extensive commercial experience, which we draw upon to counsel clients in audits, acquisitions, sales and securitization transactions. Importantly, our IP lawyers understand tax, corporate, litigation, employment and franchise implications and are aware of the many "hidden" IP issues that may arise in modern business scenarios.

Franchises and Trademarks: When you franchise your business, you grant a specific license to your franchises, allowing them to use your trademarks. Licensing and providing for use of your trademark is a complex issue that our knowledge and experience in intellectual property, franchising, and licensing make our team uniquely suited to help you.

Trademark Trial and Appeal Board (TTAB) Proceedings and Litigation

TTAB Proceedings: TTAB rules and procedures in trademark opposition and cancellation proceedings are complex legal matters that require the attention of sophisticated attorneys. Vorys attorneys have years of practicing in the forum. We carefully consider the claims and defenses and the relevant evidence in view of our client's business goals and formulate our strategy to best achieve those goals, whether by settlement or trying the case.

Trademark and Domain Name Litigation: Vorys has had success at the federal and state level defending and enforcing our clients' trademark rights. Whether we are helping with a multi-million dollar dispute or assisting one of our entrepreneurial clients, we tailor our litigation strategy to maximize the outcome. Our litigation practice covers all types of trademark infringement and dilution cases involving trademarks, service marks, trade dress, product configuration, trade names and domain names disputes under ICANN's Uniform Dispute Resolution Policy (UDRP). Because of the pervasive nature and extent of cybersquatting and infringement activity on the internet, we have advised clients on developing domain name registration strategies to help avoid or minimize costly enforcement work. We also help clients manage and set priorities for enforcement efforts by developing specific guidelines and strategies. We have significant experience in obtaining the transfer of infringing domain names from cybersquatters through litigation under the Anti-Cybersquatting Consumer Protection Act (ACPA) and by informally tapping domain name industry channels. We tailor our ACPA approach to the facts, and we seek quick, inexpensive solutions for our clients. Our attorneys have also successfully defended against ACPA claims when parties claiming rights have over-reached

Gray-Market Goods and Counterfeits: We handle matters involving piracy and counterfeiting, trade dress, deceptive trade practices, customs registration and UDRP arbitrations. We regularly appear in courts across the U.S. and have successfully obtained emergency injunctive relief for our clients, including *ex parte* seizures, temporary restraining orders and preliminary injunctions. Our international network allows us to implement global brand protection programs quickly and effectively. We have a team that can assist with referring matters to government authorities in appropriate cases where violations of clients' brand, trade secrets and IP run afoul of criminal statutes.

Unfair Competition and False Advertising Litigation: Vorys represents plaintiffs and defendants in unfair competition and false advertising litigation. We help our clients navigate the complexities of such litigation and seek to maintain a business' reputation without unnecessary spend. We have experience handling numerous disputes before the National Advertising Division of the Better Business Bureau (NAD), the National Advertising Review Board (NARB) and other tribunals.

eCommerce and Distribution Control Management

Counterfeiting and gray market goods are growing at an alarming rate, due at least in part to the increasing predominance of on-line marketplaces. This results in industry losses of billions of dollars annually. Our IP team regularly works with Vorys eControl, a practice which is entirely dedicated to helping manufacturers and brand owners protect and grow their brand in the age of global and online marketplaces in an efficient, effective and legally compliant manner.

We regularly appear in courts across the U.S. and have successfully obtained emergency injunctive relief for our clients, including *ex parte* seizures, temporary restraining orders and preliminary injunctions.

We help our clients use forums and procedures developed by online market places, such as Amazon's Utility and Design Patent Neutral Evaluation Processes, to remove offending products listed by bad actors or infringers to protect our clients' brands and IP rights.

News

News, 8.16.2024
Venturino Named to 2024 *IAM Strategy 300* List

News, 8.15.2024
More Than 170 Vorys Attorneys Named to the 31st Edition of The Best Lawyers in America® Lists

News, 8.15.2024
16 Vorys Attorneys Included in the 31st Edition of *Best Lawyers* "Lawyer of the Year"

News, 6.6.2024
Thirty-Four Vorys Attorneys Ranked in 2024 *Chambers USA* Guide

News, 12.29.2023
More Than 30 Vorys Attorneys Included on Ohio Super Lawyers and Rising Stars List

News, 11.28.2023
Venturino Named to 2023 *IAM Strategy 300* List

News, 11.2.2023
Vorys Receives 72 Tier One Rankings on 2024 Best Lawyers "Best Law Firms" List

News, 10.6.2023
Shaw Selected for the 2024-2025 Right of Publicity INTA Committee

News, 10.6.2023
Kelly Selected for the 2024-2025 Emerging Issues INTA Committee

News, 10.6.2023
Clancy Selected for the 2024-2025 Public Information INTA Committee

8.31.2023
Vorys Adds Nationally Recognized Trademark and Copyright Lawyer

News, 8.17.2023
More Than 155 Vorys Attorneys Named to the 30th Edition of The Best Lawyers in America® Lists

News, 4.18.2023
Shaw Receives 2023 Cincinnati Bar Association Young Lawyers Section Leadership Award

News, 4.12.2023
New Episode of Vorys IP Podcast Discusses Private Equity

News, 2.15.2023
New Episode of Vorys IP Podcast Discusses Advanced Topics in NFTs

News, 2.1.2023
New Episode of Vorys IP Podcast Highlights NFTs

News, 11.3.2022
Vorys Receives 69 Tier One Rankings on 2023 *U.S. News – Best Lawyers* "Best Law Firms" List

4.13.2022
New Episode of Vorys IP Podcast Highlights Strategies for Creation, Management and Protection of Trademarks and Branding

3.31.2022
Female-Owned Businesses Get Ahead with the Vorys Initiative for Business Empowerment

News, 1.12.2022
Special Episode of the Vorys IP Podcast Focuses on Key IP Cases from 2021 & What to Look Out for in 2022

News, 11.3.2021
New Episode of the Vorys IP Podcast Focuses on Trademark Basics

News, 6.22.2020
Jordan Featured in *Texas Lawyer* Q&A on The Current State of IP During the Pandemic

News, 5.4.2020
Watkins Named to 2020 *IAM Strategy 300* List

News, 8.15.2018
More Than 100 Vorys Attorneys Named to 2019 Best Lawyers in America® List

News, 1.1.2018
Vorys Elevates Seven to Partner

News, 7.21.2014
Vorys Continues to Strengthen IP Team with Addition of Two Partners

Publications

Authored article, Spring 2024
The Precedent: Vol 002

Authored article, Summer 2023
The Precedent: Vol. 001

Client alert, 2.9.2023
Verdict Reached in MetaBirkin NFT Case

Client alert, 1.11.2023
2023 Intellectual Property Law Primer: Supreme Court Preview

Client alert, 1.9.2023
TMA: A Year in Review

Client alert, 3.30.2022
Did you Know the USPTO Offers Pro Bono Patent Services?

Client alert, 3.28.2022
USPTO to Offer Pro Bono Services to Qualifying Inventors

Client alert, 2.1.2022
Patent and Trademark Office Updates You Need to Know

Client alert, 12.1.2021
Patent and Trademark Office Updates You Need to Know

Client alert, 11.19.2021
Highlights of USPTO Performances and Initiatives FY 2021-FY 2022

Client alert, 11.10.2021
Patent and Trademark Office Updates You Need to Know

Client alert, 10.27.2021
Partnering in Patents Developments

Client alert, 9.7.2021
Patent and Trademark Office Updates You Need to Know

Client alert, 8.11.2021
Patent Office Updates You Need to Know (August 11, 2021)

Client alert, 7.6.2021
Patent Office Updates You Need to Know (July 6, 2021)

Client alert, 6.1.2021
Patent Office Updates You Need to Know (June 1, 2021)

Client alert, 5.27.2021
Prove It or Lose It: TMA Provides New Tools to Sweep Away Deadwood Marks, Settles Circuit Split over Injunctive Relief Burden of Proof

Client alert, 5.24.2021
Patent Office Updates You Need to Know (May 24, 2021)

Client alert, 5.4.2021
Patent Office Updates You Need to Know (May 4, 2021)

Client alert, 4.26.2021
Same but not Similar? Supreme Court Asked To Weigh In on Counterfeit Case

Client alert, 4.12.2021
Patent Office Updates You Need to Know (April 12, 2021)

Client alert, 3.2.2021
Patent Office Updates You Need to Know (March 2, 2021)

Client alert, 2.1.2021
Patent Office Updates You Need to Know (February 1, 2021)

Client alert, 1.25.2021
Patent Office Updates You Need to Know (January 25, 2021)

Client alert, 1.11.2021
Patent Office Updates You Need to Know (January 11, 2021)

Client alert, 1.6.2021
2021 Intellectual Property Primer: Cases to Watch this Year

Client alert, 1.5.2021
Patent Office Updates You Need to Know (January 5, 2021)

Client alert, 12.28.2020
Patent Office Updates You Need to Know (December 28, 2020)

Client alert, 12.21.2020
Patent Office Updates You Need to Know (December 21, 2020)

Client alert, 12.14.2020
Patent Office Updates You Need to Know (December 14, 2020)

Client alert, 12.8.2020
Patent Office Updates You Need to Know (December 8, 2020)

Client alert, 11.30.2020
Patent Office Updates You Need to Know

Client alert, 11.23.2020
Patent Office Updates You Need to Know (November 23, 2020)

Client alert, 11.16.2020
Patent Office Updates You Need to Know (November 16, 2020)

Client alert, 11.9.2020
Patent Office Updates You Need to Know (November 9, 2020)

Client alert, 11.2.2020
Patent Office Updates You Need to Know (November 2, 2020)

Client alert, 10.26.2020
Patent Office Updates You Need to Know (October 26, 2020)

Client alert, 10.12.2020
Patent Office Updates You Need to Know (October 12, 2020)

Client alert, 9.14.2020
Patent Office Updates You Need to Know (September 14, 2020)

Client alert, 9.8.2020
Patent Office Updates You Need to Know (September 8, 2020)

Client alert, 8.31.2020
Patent Office Updates You Need to Know (August 31, 2020)

Client alert, 8.24.2020
Patent Office Updates You Need to Know (August 24, 2020)

Client alert, 8.17.2020
Patent Office Updates You Need to Know (August 17, 2020)

Client alert, 8.11.2020
Patent Office Updates You Need to Know (August 11, 2020)

Client alert, 8.4.2020
Patent Office Updates You Need to Know (August 4, 2020)

Client alert, 7.21.2020
Patent Office Updates You Need to Know (July 21, 2020)

Client alert, 7.15.2020
Intellectual Property Alert: Notes from the USPTO and Patent Public Advisory Committee Quarterly Meeting Part 5 of 8: Artificial Intelligence

Client alert, 7.13.2020
Patent Office Updates You Need to Know (July 13, 2020)

Client alert, 7.7.2020
COVID-19 Patent & Trademark Office Updates

Client alert, 7.6.2020
Intellectual Property Alert: Notes from the USPTO and Patent Public Advisory Committee Quarterly Meeting Part 4 of 8: IT Update

Client alert, 7.1.2020
Intellectual Property Alert: Supreme Court Decision Sheds Light on Examination of .COM Trademark Applications

Client alert, 6.29.2020
COVID-19 Patent & Trademark Office Updates

Client alert, 6.22.2020
COVID-19 Patent & Trademark Office Updates

Client alert, 6.19.2020
Intellectual Property Alert: Notes from the USPTO and Patent Public Advisory Committee Quarterly Meeting – Part 2 of 8

Client alert, 6.16.2020
COVID-19 Patent & Trademark Office Updates

Client alert, 6.9.2020
COVID-19 Patent & Trademark Office Updates

Client alert, 6.2.2020
COVID-19 Patent & Trademark Office Updates

Client alert, 5.28.2020
USPTO to Grant Further Relief for Certain Patent-Related Fees and Deadlines

Client alert, 5.26.2020
COVID-19 Patent & Trademark Office Updates

Client alert, 5.18.2020
COVID-19 Patent & Trademark Office Updates

Client alert, 5.11.2020
COVID-19 Patent & Trademark Office Updates

Client alert, 5.5.2020
COVID-19 Patent & Trademark Office Updates

Client alert, 4.29.2020
COVID-19 Patent & Trademark Office Updates

Client alert, 4.27.2020
Intellectual Property Alert: Supreme Court Rules Willfulness Not Required to Obtain Profits in Trademark Suits; Increases Risk to Defendants, Potential Recovery to Plaintiffs in Trademark Litigation

Client alert, 4.20.2020
COVID-19 Patent Office Updates

Client alert, 4.8.2020
Update: Changes to IP Operations Worldwide

Client alert, 4.1.2020
Patent and Trademark Office Extends Filing and Payment Deadlines for COVID-Related Causes

Client alert, 3.30.2020
COVID-19 Patent and Trademark Filing Impacts

Authored article, 8.30.2018
Vanilla With Cherry Overtones: Pursuing A Nontraditional Trademark

Client alert, 7.31.2018
Client Alert: Are You Prepared To Be Audited By The Trademark Office?

Client alert, 3.2.2018
Client Alert: It's That Maddening Time of Year Again: March

Client alert, 2.3.2017
Client Alert: More Changes are Coming to Trademark Practice: Specimens and Declarations

Client alert, 1.5.2017
Client Alert: Changes are Coming to Trademark Practice: New Fees and Rules

Client alert, 8.22.2016
Client Alert: The Complexity of Trademarks in the Marijuana Business

Client alert, 7.6.2016
Client Alert: Don't Panic! Protecting your UK Trademark Coverage in the Wake of the 'Brexit'

Client alert, 10.13.2015
Client Alert: Beware of Trademark Scams - More than your Money is at Stake

Authored article, *PR Daily*, 9.2.2014
5 Things to Consider When Naming a Brand

Client alert, 8.18.2014
Client Alert: Five Considerations When Selecting a New Brand

Client alert, 10.28.2013
Are Your Licenses Really Franchises? How to Avoid Inadvertent Franchise Regulation

Client alert, 5.20.2013
Client Alert: "Use" of a Mark in the U.S.A.

Client alert, 8.14.2012
Client Alert: New Pilot Program By U.S. Trademark Office: Could Affect All Registrants

Client alert, 8.31.2011
Client Alert: Trademark Owners: Block Your Trademarks in the New .XXX Domain

Client alert, 8.1.2011
Intellectual Property Alert: What Trademark Owners Need to Know About ICANN's New gTLD Program

Speaking Engagements

Speaking Engagement, 7.17.2024
2024 National Association of Patent Practitioners' Annual Meeting & Conference

Event, 5.30.2024
2024 Black Sports Business Symposium

Event, 3.5.2024
Webinar: Legal Considerations for Navigating Endorsement and Promotional Activities

Event, 11.16.2023
2023 Vorys Legal Education (VLE) Seminar

Event, 10.19.2023
AIPLA 2023 Annual Meeting

Event, 10.4.2023
41st Conference of the Heads of the Trilateral Patent Offices

Event, 9.8.2023
MWBLSA 2023 Academic and Leadership Conference

Event, 6.13.2023
Sustainable Innovation Summit in Honolulu, Hawai'i

Event, 3.16.2023
IPOwners Spring Summit Panel

2.10.2021
2020 Year in Review - Intellectual Property Law Update

1.31.2018
Year in Review: Our Top IP Developments of 2017

2.26.2013
Brand-Standing – Practical Advice to Protect Your Trademarks and Brands in E-Commerce, Social Media, and Business Transactions

Presented by TechColumbus and Vorys, Sater, Seymour and Pease LLP

10.30.2012
POSTPONED: INTA Roundtable Workshop: Trademark Protection under the Madrid System and Community Trademarks

Due to Hurricane Sandy, this event has been postponed until a to-be-determined date and time.
Presented by the International Trademark Association and Vorys, Sater, Seymour and Pease LLP

9.13.2012
INTA Roundtable Workshop: Fifty Shades of M&A IP due Diligence in M&A Transactions

Presented by the International Trademark Association and Vorys, Sater, Seymour and Pease LLP

6.12.2012
INTA Roundtable Workshop: Trademark Law Practice Updates Around the World

Presented by the International Trademark Association and Vorys, Sater, Seymour and Pease LLP