

## Susan Upton Douglass



### Practice Description

Trademark counseling, searching, filing, and general strategies; trademark practice before the U.S. Patent and Trademark Office and the Trademark Trial and Appeal Board; conflict resolution; negotiating and drafting license agreements, web site development agreements, contract manufacturing agreements, merchandising agreements, and the like; copyright counseling; filing copyright applications.

### Education

University of Chicago (B.A., with honors, 1977); New York University School of Law (J.D., 1980).

### Professional Activities

Member: U.S. Department of Commerce-Public Advisory Committee for Trademarks, 1997-1998; International Trademark Association (Member, U.S. Patent and Trademark Office Committee, 1985-1988, 1989-1991, 1993-1999, 2002-2005; USPTO Subcommittee, 2016; Chair, Subcommittee on U.S. Patent and Trademark Office 1986-1988, 1989-1991, 1995-1999; U.S. Legislative Analysis Subcommittee 1999-2001; Fraudulent Trademark Filings 2006-2007); Copyright Society of the U.S.A.

Adjunct Professor: New York City Technical College, 1991, 1993 (Trademark and Copyright Law).

### Honors

*Who's Who Legal – Thought Leaders 2018*

*Who's Who Legal – Thought Leaders 2017. One of only four attorneys selected from the U.S.*

*Women in Business Law: 2016, 2012, 2010*

*SuperLawyers – Best Women Lawyers 2015*

*Chambers Global Leading Lawyers (Featured Attorney, 2015)*

*Lawyer Monthly Magazine Women in Law Awards: 2015*

*Chambers USA Leading Lawyers: 2010-2015 (Featured Attorney, 2015)*

*SuperLawyers – New York Metro: 2008-2016*

*Who's Who Legal – Trademarks: 2002-2017. Singled out in 2014 as one of only six "Most Highly Regarded Individuals" in North America.*

*ExpertGuides – Trademarks (Legal Media Group/Euromoney): 2014*

*World Trademark Review – WTR 1000 The World's Leading Trademark Lawyers: 2012-2014 (Special Mention, 2014)*

*Guide to the World's Leading Women in Business Law: 2010-2014*

*Managing Intellectual Property – Top Trademark and Copyright Firms (Featured Attorney, 2005-2014)*

*Chambers USA Women in Law Awards IP Lawyer of the Year nominee: 2013*

*World Trademark Review WTR Leading Trademark Professionals: 2012-2013*

*Managing Intellectual Property – Top Trademark and Copyright Firms (Featured Attorney, 2005-2013)*

*SuperLawyers – New York Metro: 2008-2012*

*Lawdragon 500 Leading Lawyers in America: 2006-2012*

Named "World's Leading Trademark Law Practitioners" published by Legal Media Group, the legal publishing arm of Euromoney Institutional Investor: 2008

Named the "Expert's Expert" in the July/August 2007 issue of World Trademark Review

Awarded the "Most Prolific Electronic Filer" Award by the U.S. Patent and Trademark Office for Law Firms: April 2007

### Admissions

New York State

United States Court of Appeals for the Federal Circuit

United States District Courts for the Southern and Eastern Districts of New York

### Speaking Engagements

American Bar Association Forum on Franchising, International Franchising 201 - Intensive Program, "Intellectual Property Protection" (October 2015).

New York City Bar Association, Trademark Talk: Hot Topics and Recent Developments in Trademark Law, "Trademark Prosecution & the PTO: Practice Tips" (May 2014).

Strafford Publishing, "Trademark Application Pre-Filing Strategies: Overcoming the Obstacles" (April 2014).

Strafford Publishing, "Trademark Clearance Opinions: Analyzing Search Reports, Overcoming Clearance Challenges, and Crafting Opinions" (October 2011, December 2011, October 2012, September 2013).

NYSBA, "Trademark Bullying – A Proactive Approach" presented at the Intellectual Property Law Section Fall Meeting (September 2012).

ABA/NYSBA, Fundamentals of Franchising – IP Basics (June 2010).

International Trademark Association, "U.S. PTO Practice – Strategies for Non-U.S. Attorneys" presented at the Annual Meeting (May 2010).

The New York Intellectual Property Law Association, Hot Topics in Trademark Law, Clearance Conundrums: Strategies for Dealing with Blocking Marks (June 2008).

The American Bar Association 22nd Annual Intellectual Property Law Conference: Recent Developments in Trademark Law and Practice - Filings Under the Madrid Protocol (April 2007).

New York State Bar Association, Intellectual Property in Action: A look at the Practical Side of, and Current Controversies in, Intellectual Property Law: Intellectual Property Protection Strategies (October 2006).

American Bar Association Forum on Franchising, Bridging the Divide: Copyright Basics (October 2005).

Practising Law Institute, Navigating Trademark Trial & Appeal Board Practice 2003: Settlement, Arbitration, and Other Pre-Trial Dispositions of Contested Proceedings (February 2003).  
International Trademark Association, Trademark Basics Forum: Trademark Office Practice, a two-hour presentation, along with a 55-page book chapter on this topic (February 2001, February 2002).

#### **Published Works**

**Filings Under the Madrid Protocol** Presented at the 22nd Annual American Bar Association Intellectual Property Law Conference

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**Hey They're Playing My Song! - Litigating Music Copyrights**

Co-author: [Craig S. Mende](#)

**U.S. Application Practice Pointers**

**A Dozen Questions on Copyright Law**

**Twenty Questions Copyright Tips and Traps...Don't Trust Your Intuition**

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**Navigating Trademark Trial & Appeal Board Practice 2003**PLI 2003

[Download](#)

**Trademark Prosecution**

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**Ch. 5 - Trademark Prosecution**

**Deconstructing Music Sampling**

Co-author: [Craig S. Mende](#)

**Trademark and Copyright Licensing for the Non-Specialist 2000**

Co-author: [Allison Strickland Ricketts](#)

**Music Sampling: More Than Digital Theft?**

Co-author: [Craig S. Mende](#)

**Color Me Happy: The Supreme Court Rules on the Trademark Registrability of Color**

**Trademark Searching is a Risky Business**

**Trademark Protection: Maximizing Benefits Under the Trademark Law**

**Overview of Basic Principles of Trademark Law. How to Handle Basic Copyright and Trademark Problems**

Co-author: [Barbara A. Solomon](#)

**Ch. 4 - Copyrights**

**Fourth Circuit Court of Appeals: Foreign Owner Without Use or Registration in United States May Bring Unfair Competition, False Advertising, and Cancellation Actions** Mondaq, June 10, 2016.

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