

# Nadine H. Jacobson

Partner

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## Overview

**“For more than 30 years, I’ve advised on global trademark registration and protection strategies, with a focus on litigating and resolving trademark disputes around the world. I’ve seen it all and so I can tell a client which risks are worth taking and which risks they should avoid. I can with great confidence say: ‘Here’s the likelihood you’ll be challenged in a given country and, if challenged, here’s the likelihood you’ll win.’ I strive to give clients business-appropriate solutions to their legal problems, and provide advice which reflects their tolerance for risk, their need for responsiveness and the constraints of their budget.”**

Few U.S.-based lawyers know more about global trademark strategies and managing global trademark conflicts than Nadine Jacobson, who has searched, cleared for use, and prosecuted for registration thousands of trademarks of all types globally. Nadine has also litigated and defended hundreds of international Opposition and

Cancellation proceedings as well as infringement actions around the world. She registers and defends design patents and industrial designs in various countries, including those protected by the Hague Treaty, as well as those filed nationally. Nadine has also advised on dozens of acquisitions and divestitures in which the trademark and copyright assets were either the primary or crucial aspect of the overall transaction.

When the U.S. joined the Madrid Protocol in 2003, Nadine not only chaired the PLI seminar on this important development, but also spoke at numerous seminars arranged by legal trade associations such as the AIPLA and INTA, explaining to U.S. practitioners how the Madrid Protocol works. Most recently, she has been advising Canadian practitioners in advance of their impending accession to the Madrid System. She chaired the INTA Subcommittee on the Madrid Protocol and continues to work closely with both practitioners and WIPO personnel to enhance the Madrid Protocol and encourage its wider use.

Nadine's knowledge of the Paris Convention, the TRIPS Agreement, and the Berne Convention is equally comprehensive, and she is frequently asked to speak and advise on various aspects of these IP treaties. Indeed, early in her career, WIPO invited Nadine to speak at its 1997 Asian regional conference to advise government officials in developing countries as to how they must amend their national laws to comply with the TRIPS Agreement, including enhanced protection for Well-Known Marks and for Geographic Indications. Most recently, Nadine has been hired by a U.S. multinational law firm to serve as an expert witness on various aspects of trademark law in an international arbitration.

Nadine's in-depth understanding of IP treaties, national trademark laws, and the related enforcement procedures of dozens of foreign jurisdictions informs her strategic advice to trademark owners from both the U.S. and other countries, including the EU, Japan, China and many others. In addition to her clearance, prosecution, and enforcement work, Nadine conducts IP portfolio audits, investigations, and due diligence. She also provides additional transactional support by negotiating and drafting IP-related agreements, including licenses, assignments and global consent and coexistence agreements as well as the IP-related provisions of Asset and Stock Purchase agreements.

Nadine represents both startups and established companies across a broad range of industries including pharmaceuticals, apparel, jewelry, cosmetics, watches, consumer health products, medical devices, food and beverage, industrial systems, and home security products as well as

restaurant, hotel, retail, entertainment and financial services.

## Representative Experience

- Negotiated client's acquisition of French company's trademarks in the EU; 30-year French business changed its name as part of the transaction enabling client to expand its well-known mark to Europe
- Negotiated multinational coexistence agreement enabling client to enter Asian market for its core services
- Served as an independent expert witness in an international arbitration brought against a Central American country challenging decision of its Supreme Court in a trademark conflict
- Advised a multinational pharmaceutical company as it divested various business units to competitors and entered joint venture with another competitor; advised in sorting out and assigning trademark assets to various corporate entities as part of overall transaction
- Multicountry global trademark conflicts
- Developed extensive evidence of bad faith without the ability to conduct discovery in order to cancel trademark pirates' registrations of clients' well-known mark on grounds of bad faith in the EUIPO Tribunals and Chile Supreme Court

## Education

Harvard Law School (JD, *cum laude*, 1990)

Harvard University (AB, *magna cum laude*, 1985)

## Admissions

### Bar Admissions

District of Columbia

Massachusetts

New York

### Court Admissions

U.S. Supreme Court

## Focus

- Fashion
- Startup & Emerging Growth
- Personal Care & Cosmetics
- Consumer Products
- Food & Beverage
- Jewelry & Watches
- Pharmaceuticals

## Services

- International
- Trademark
- Transactions
- Design
- Copyright
- Litigation

## Associations

International Trademark Association (INTA)  
(Member, Data Protection Committee, 2024-2025;  
Member, Emerging Issues Committee, 2016-2019;  
EU/OHIM Office Practices Committee, 2014-2015;

Classification Committee 2011-2013; Chair, Madrid  
Systems Subcommittee, 2008-2010; Madrid  
Systems Subcommittee, 2006-2007; Chair,  
INTA/OHIM Conference on EU Law, 2007; EU  
CTM Practices Subcommittee, 2001-2005;  
Meetings Committee, 1999-2001)

Association of the Bar of the City of New York  
(Member, Trademarks and Unfair Competition  
Committee, 1997-2000, 2001-2004, 2006-2009,  
2014-2017)

International Association for the Protection of  
Intellectual Property (AIPPI)

American Bar Association

## Recognition

*Chambers USA* Ranked Lawyers 2021-23  
*World Trademark Review's* WTR 1000 2013-24  
"Nadine Jacobson has an encyclopaedic  
knowledge of global trademark law and is routinely  
called upon to serve up her expertise at venues  
around the world."

*Who's Who Legal* IP – Trademarks, 2011; Thought  
Leaders – Global Elite (Top 5%), 2012-23; Thought  
Leaders – USA, IP – Trademarks 2024, "With over  
25 years of experience and expertise, Nadine  
Jacobson is highly recommended for her excellent  
international trademark work."

*Managing IP's* IP STARS 2014-23  
*World Trademark Review* Global Leaders 2020-23

*The Best Lawyers in America*®, Trademark Law  
2023-24

*New York Metro Top Women Lawyers* 2021

*Super Lawyers*® Intellectual Property, New York  
Metro 2007, 2010-23 "Top Women Attorneys in  
New York," 2021-23

*Who's Who Legal 100* 2014

*Expert Guides, World's Leading Trade Mark Lawyers* 2018

*Euromoney's Women in Business Law Expert Guide, Trademarks* 2014-22

*Euromoney's Guide to World's Leading Lawyers,* 2014

*The Legal 500*

## Languages

Hebrew

Spanish

## Speaking Engagements

*How Leaders Can Attract and Maintain Law Firm Talent through Innovative Compensation Models,* panelist, International Trademark Association (INTA), September 2023

*Brexit: The Implications for Trademarks in the United Kingdom and the European Union,* panelist, International Trademark Association (INTA) Annual Meeting, May 2019

*Challenging Bad Faith Trademarks: Pitfalls and Possibilities,* Fross Zelnick CLE, June 2018

*Pharmaceutical Brand Names: Navigating the PTO/FDA Rapids,* New York State Bar Association CLE, May 2018

*Managing Intellectual Property's Global Trademark Roadshow,* Palo Alto, CA, June 2017

*Madrid Protocol: How it Works and Tricks of the Trade,* American Intellectual Property Law Association (AIPLA), May 2015

*The Madrid Protocol and Singapore Treaty: What Canadian Practitioners Need to Know,* Intellectual Property Institute of Canada, May 2012

*Recent and Proposed Changes to The Madrid*

*Protocol: Repeal of the Safeguard Clause and the Issue of Replacement,* New York Intellectual Property Law Association (NYIPLA), June 2009

*Madrid Protocol Workshop Update: Questions and Answers,* INTA, May 2009

*Tricks of the Trade for the Madrid Protocol Seminar,* International Intellectual Property Society (IIPS), April 2009

*Trademark Registrations Strategies Forum: Pervasive Prosecution Problems: The Madrid Protocol,* INTA, March 2006

*Madrid Protocol Seminar,* Chair and Speaker, Practising Law Institute (PLI), June 2003

*Madrid Protocol Seminar on Filing Strategies,* AIPLA, April 2003

## Publications

*Madrid Protocol – Recent Developments and Practice Tips,* World Trademark Review, July 2021