

## Trademark and Advertising

### Practices and Industries

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#### PRIMARY CONTACTS

**David A. Bell**

+1 214.651.5248

**Tiffany Ferris**

+1 214.651.5152

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Haynes Boone's Trademark and Advertising Practice Group protects and enforces its clients' marks, which include some of the world's most famous brands. We are particularly distinguished by our experience in high-impact matters such as international clearance and enforcement of marks, global trademark prosecution and protection programs, oppositions and cancellations, advertising review, trademark and unfair competition litigation, domain name disputes, and social media counseling.

Our trademark and advertising attorneys represent sophisticated brand owners in managing and optimizing their trademark portfolio and enforcement programs, including: AT&T, DIRECTV, Galderma Laboratories, Halliburton, Krispy Kreme, Mattress Firm, Michaels Stores, The National Football League, Outback Steakhouse, Reddy Ice, Tuesday Morning, and Wild Oats. We would welcome the opportunity to add your name to that group of brand owners.

With decades of experience, our team is dedicated to protecting our client's brands and advertising initiatives. Our group has been recognized by the *World Trademark Review* (WTR) in its *WTR 1000 directory* for 14 consecutive years and ranks the firm as one of the nation's "Gold-Tiered" trademark firms. WTR describes the group as "one of the best-known names in the American trademark practice" and "an uncommonly strong Southwest regional, national and international brands practice [that] is always at or near the top of the list for marquee companies selecting trademark counsel." *Managing IP* has recognized Haynes Boone as one of the nation's Top 11 Trademark Prosecution firms in its 2022 *IP STARS* directory. Our team is also consistently recognized by *Chambers USA*, *Chambers and Partners*, and *The Legal 500*, Legalease Ltd.

#### Clearance and Prosecution

For clients looking to establish new brands abroad, we plan, manage and conduct worldwide trademark clearance and availability searches, along with analyzing proposed marks' eligibility for registration and advising of relevant foreign trademark practices.

Our lawyers have handled thousands of trademark registrations and prosecutions with the U.S. Patent and Trademark Office (USPTO), as well as registrations in every state and nearly every foreign jurisdiction across the globe.

We leverage our extensive experience and longtime knowledge to anticipate and minimize potential problems our clients may face in developing and selecting new marks, as well as to shape our filing strategies for new trademark applications. Our clients benefit from fewer challenges and rejections of filings, as well as the corresponding lower cost of establishing and protecting their new brands.

## **Trademark Protection Programs**

Our team manages many large, global portfolios and performs gap analyses and provides suggestions for reducing portfolio size where appropriate. We help clients profit from their brands by structuring, negotiating, and recording trademark license, merchandising, and co-branding, and other agreements, both in the U.S. and abroad. We also conduct domestic and international trademark due diligence in connection with mergers and acquisitions, and we work with our litigators to handle investigations, discovery, and strategy in pending or threatened IP litigation.

## **Oppositions and Cancellations**

Oppositions and cancellation proceedings before the Trademark Trial and Appeal Board at the USPTO can be incredibly useful tools, such as when a conflicting trademark is filed or when an earlier application or registration blocks a brand owner's own application. Our lawyers have guided clients through hundreds of successful cancellations and oppositions.

## **Trademark Litigation**

Few firms can boast the depth of trademark litigation experience at Haynes and Boone. Whether our clients seek preliminary injunctive relief, to protect their marks or trade dress from infringers, or are facing claims from a competitor trying to unfairly gain market advantage, we have the team, skill and track record to successfully resolve their dispute.

Our dedicated team of trademark litigators has successfully tried dozens of trademark and unfair competition cases in courts around the country, including recovering an \$8.5 million jury award against a global retail chain. We regularly handle unfair competition disputes of all types, including trademark, trade dress and service mark infringement, dilution, false advertising, misrepresentation and misappropriation claims, as well as other matters involving Internet commerce, advertising, mobile applications and social media.

Our litigators, all members of our nationally recognized brand management team, work closely with our trademark prosecution attorneys to deliver the best results possible for clients, every step of the way. We handle trademark disputes in a variety of venues, including at the USPTO, in federal and state trial and appeals courts, and before arbitration panels.

## **Advertising Counseling and Disputes**

Our advertising group provides clients with practical guidance to help manage legal risks related to consumer and competitor claims, as well as regulatory enforcement actions. Our team's breadth of experience on both the offensive and defensive side of advertising challenges lends itself to strong and practical counseling regarding claims and campaigns in any medium. We regularly represent clients in state and federal court and before the National Advertising Division (NAD) to assert challenges and defend against false advertising claims. Advertisers and challengers rely on our team to successfully challenge unfair, deceptive, or misleading advertising as well as to defend adequately substantiated claims.

## Domain Name Disputes

Even before the Internet became an indispensable part of business, our lawyers have been successfully resolving domain name disputes both nationally and internationally, as well as acquiring for our clients domain names from squatters and competitors. We routinely litigate domain name disputes in state and federal court, including under the Anti-Cybersquatting Consumer Protection Act (ACPA). We also have a perfect track record of obtaining resolution of domain disputes under the Uniform Domain-Name Dispute Resolution Policy (UDRP).

When our clients either lack legal options for forcing a transfer or simply prefer a voluntary transfer, we often acquire currently owned domain names, through negotiation with or acquisition of a domain name owner. Additionally, we have handled numerous ancillary matters relating to domain names, including claims for breach of contract, fraud and pretexting.