

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: 2017-2016, 2012, 2010

SuperLawyers – New York Women's Edition 2017

SuperLawyers – New York Metro, Intellectual Property: 2008-2018

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

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)

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)

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 2003PLI 2003

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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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