



Nadine H. Jacobson

Practice Description

Advises clients on international trademark, design patent, copyright, unfair competition and appellation of origin/geographic indication issues, including the EU Community Trademark, International Registrations under the Madrid Union (Trademarks) and the Hague Treaty (Industrial Designs), TRIPs, the Paris Convention and the Berne Convention. Develops strategies for acquiring, enforcing, maintaining and assigning intellectual property rights with an emphasis on foreign laws and international treaties, and litigates international and multi-country conflicts. Advises clients on related IP transactional issues in the context of IP portfolio audits, due diligence for acquisitions or divestitures, and agreements for related corporate IP transactions, including IP holding companies. Conducts global trademark clearance projects including analysis and evaluation of search data and related risk analysis, investigations and negotiations vis-a-vis prior third party rights, and implementing global filing strategies. Focuses on the retail apparel and accessories, cosmetics, watch, personal and household care products, housewares, pharmaceutical, retail store, restaurant and hotel, entertainment and financial services industries.

Education

Harvard University (A.B., magna cum laude, 1985); Harvard Law School (J.D., cum laude, 1990); Member, Harvard Legal Aid Bureau, 1989-1990. Adjunct Professor, International Trademark Protection, Benjamin N. Cardozo School of Law, Spring 1999 and Spring 2000.

Professional Activities

Member: International Trademark Association: Emerging Issues Committee, 2016 – present; EU/OHIM Office Practices Committee, 2014 – 2015; Classification Committee 2011 – 2013; Chair, Madrid Systems Subcommittee, 2008 – 2010; Madrid Systems Subcommittee, 2006 – 2007; Program 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, 2014 – present, 2006 – 2009, 2001 – 2004, 1997 – 2000).

International Association for the Protection of Intellectual Property (AIPPI); American Bar Association.

Honors

Recognized in *Who's Who Legal 2017 – Compendium Edition* and 2016 edition of *Who's Who Legal: Trademarks*;
 Named to 201-2016 *Super Lawyers®* New York Metro and Women's Edition lists;
 Selected to appear in IP STARS 2016, the fourth edition of IP Stars from *Managing IP (MIP)* magazine;
 Women in Business Law, 2017-2016;
 Recognized in the 2016, 2015, 2014 and earlier editions of the World Trademark Review (WTR) 1000 *Guide to the World's Leading Trade Mark Law Professionals*;
 Recognized in the 2014 and earlier editions of *Guide to World's Leading Lawyers*, published by Euromoney Legal Media Group;
 Recognized in *New York Super Lawyers®, Intellectual Property*, 2007, 2010-2018;
 Recognized in the 2014 and earlier editions of *Women in Business Law*, published by Euromoney Legal Media Group;
 Recognized in *Managing Intellectual Property's IP Stars*, 2014;
 Recognized in *Who's Who Legal 100 2014* and earlier editions;
 Recognized for international trademark work in *The Legal 500*.

Admissions

New York, 1993; Massachusetts, 1990; District of Columbia, 1991; U.S. Supreme Court

Selected Speaking Engagements

May 2015: American Intellectual Property Law Association (AIPLA), Madrid Protocol: How it Works and Tricks of the Trade;
 May 2012: Intellectual Property Institute of Canada, The Madrid Protocol and Singapore Treaty: What Canadian Practitioners Need to Know;
 June 2009: New York Intellectual Property Law Association (NYIPLA) Recent and Proposed Changes to The Madrid Protocol: Repeal of the Safeguard Clause and the Issue of Replacement;
 May 2009: INTA Madrid Protocol Workshop Update, Questions and Answers;
 April 2009: International Intellectual Property Society (IIPS) Tricks of the Trade for the Madrid Protocol Seminar;
 March 2006: INTA Trademark Registrations Strategies Forum: Pervasive Prosecution Problems: The Madrid Protocol;
 June 2003: Practising Law Institute (PLI) Chair and Speaker, The Madrid Protocol Seminar;
 April 2003: AIPLA 2003 Madrid Protocol Seminar on Filing Strategies.

Published Works

Essentials of Madrid Protocol Practice June 2003

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The Madrid Protocol: Filing Strategies for U.S. Trademark Owners April 2003

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