



## **DAMON J. WHITAKER**

**Counsel**

**Atlanta**

E: [damon.whitaker@bcplaw.com](mailto:damon.whitaker@bcplaw.com)

T: [+1 404 572 6913](tel:+14045726913)

### **BIOGRAPHY**

Damon Whitaker focuses his practice on intellectual property and commercial litigation. As an experienced litigator and trial attorney, he represents clients in both federal and state courts and alternative dispute resolution forums. Damon assists both individuals and companies across industries, including banking and financial services, technology, construction, health care and life sciences, sports and entertainment, consumer products, education, food and beverage, manufacturing, outdoor advertising, real estate, retail, and insurance, to protect their intellectual property and other commercial rights.

Damon maintains an active intellectual property litigation practice. He advises on false advertising cases involving consumer products, mechanical measuring devices, and medical devices, among others, often utilizing his science background to challenge or defend “tests prove” advertising claims. Damon litigates trademark disputes in a wide array of different industries and fields and

patent cases involving software, wireless communications, bio-chemical assays, children's products, and other technologies. He represents clients on trade secrets and restrictive covenants cases in connection with employment disputes and arising from the sale of businesses.

Damon also leads the Atlanta office's trademark and copyright registration practice, counseling clients on state and federal trademark clearance and registration, copyright registration, and enforcement practices and actions. He also prosecutes and defends Internet domain name disputes under the Uniform Domain Name Dispute Resolution Policy (UDRP).

Damon represents banks and other financial institutions in a variety of disputes, including foreclosures, liens, attorney fees, federal and state unfair and deceptive acts or practices statutes, and appellate matters.

Damon is also a member of the firm's Higher Education sector team where he advises clients on intellectual property matters and assists with investigative matters.

Damon is experienced in handling claims for attorney's fees and litigation costs, including trial victories under Georgia's fee statute addressing bad faith and stubborn litigiousness and under federal intellectual property statutes for willful violations. He also provides pro bono services to various charitable and non-profit organizations.

## CIVIC INVOLVEMENT & HONORS

- Recognized by Top Verdict as winner of one of the [Top 20 Verdicts](#) in Georgia in the year 2016 for *WIKI Instrument Corp. v. Ashcroft* (10th highest verdict)
- *Super Lawyers*, Georgia Rising Star (2010 - 2016)
- *Florida Law Review*
- *Journal of Law & Public Policy* – Managing Editor

## PROFESSIONAL AFFILIATIONS

- Atlanta Bar Association – Intellectual Property Law Section
- State Bar of Georgia – Intellectual Property Section

## ADMISSIONS

- Florida, 2004

- Georgia, 2003

## EDUCATION

University of Florida, J.D., high honors, Order of the Coif, 2003

University of North Florida, B.S. - Biology, *magna cum laude*, 1998

## RELATED CAPABILITIES

- Intellectual Property & Technology Disputes
- Consumer Finance Disputes
- Retail & Consumer Products
- Media & First Amendment
- Litigation & Dispute Resolution
- Regulation, Compliance & Advisory
- Enforcement
- Litigation
- Regulation
- Trademark Prosecution, Counseling & Protection Services
- Business Speech
- Telephone Consumer Protection Act (TCPA)
- Hotels & Hospitality
- Trademark Litigation
- Business & Commercial Disputes

## EXPERIENCE

- Successfully pursued false advertising and unfair competition claims for electronic vaporizer manufacturer against competitor for its anonymous social media page and posts and orchestrating a failed consumer class action. *Puff Corporation v. Kandypens, Inc.*, No. 1:20-cv-976-CFC (D. Del.). Case was resolved as part of a global settlement that included competitor publishing corrective advertising admitting its responsibility for the dismissed class action and social media page, that the claims in the class action were not true, and correcting its other false statements about the client and its product.
- Key trial and litigation counsel for pressure gauge manufacturer WIKA Instruments as Lanham Act plaintiff in successful false advertising and unfair competition lawsuit against industry competitor, *Wika Instrument I, LP, f/k/a Wika Instrument Corp. v. Ashcroft, Inc.*, No. 1:13-cv-43-

CAP (N.D.Ga.). Two week federal trial resulting in jury and Court awarding WIKA disgorgement of competitor's profits, injunctive relief, corrective advertising and attorneys' fee awards under federal and state law, and complete defense verdict for WIKA on competitor's counterclaims, 2016 WL 308 3087904 (April 22, 2016).

- Assisted in the independent investigation and prepared report to the Florida Board of Governors concerning the University of Central Florida's misuse of nearly \$100 million in restricted state funds for over a dozen capital projects at the university over a ten-year period.
- Represented a major health care products manufacturer in false advertising lawsuits against competitors' "tests prove" advertisements.
- Successfully defended children's products company against competitor's claims of patent infringement, obtaining summary judgment ruling of non-infringement for approximately 98% of the accused playards. *Graco Children's Products, Inc. v. Kids II, Inc.*, No. 1:13-cv-01183-JEC (N.D. Ga.). Summary judgment ruling entered March 26, 2018 (Dkt. No. 179); case dismissed May 29, 2018.
- Represented various companies with wireless communications technologies in defending against patent infringement lawsuits involving asserted wireless mesh network inventions.
- Enforced the trademarks of an electronic medical records software company against various infringers.
- Successfully defended bank against federal and state trademark infringement and unfair competition claims, resulting in summary judgment; see published order at *Atlantic National Bank v. Atlantic Southern Bank*, 2010 WL 5067416 (S.D. Ga. 2010).
- Defended medical device manufacturer against allegations of trademark and trade dress infringement and false advertising; see published order at *MSP Corp. v. Westech Instruments, Inc.*, 500 F.Supp.2d 1198 (D. Minn. 2007).
- Enforced copyrights of supplemental health insurer, obtaining an injunction prohibiting the sale of infringing insurance policies; see published order at *American Family Life Assurance Company of Columbus v. Assurant, Inc.*, 2006 WL 4017651 (N.D. Ga. 2006).
- Successfully defended individual employees and their new employers against claims for trade secret misappropriation and violation of non-competition agreements and other restrictive covenants brought by former employers.
- Enforced a non-competition agreement related to the sale of outdoor advertising assets, resulting in a \$5 million state court jury verdict for breach of contract, fraud and attorneys'

fees, and upheld the judgment on appeal; see *Corey v. Clear Channel Outdoor, Inc.*, 683 S.E.2d 27 (Ga. App. 2009).

- Obtained a jury verdict for breach of contract, tortious interference and attorneys' fees for a software company, *GT Software v. WebMethods*.

## RESOURCES

### PUBLICATIONS

- "Protecting Assets: Trademark Filing Practices in the Age of AI, Social Engineering and Inventive Schemes," *Law.com*, July 24, 2024
- "Trademark Initial Interest Confusion on the Internet," *TerraLex Intellectual Property Newsletter*, 13th Edition, 2006
- "The Patentability of Embryonic Stem Cell Research Results," 13 *U Fla. J.L. & Pub. Pol'y* 361, 2002

### SPEAKING ENGAGEMENTS

"*Emojis As Intellectual Property*," Dury Consulting CLE-Emoji Law 101, July 17, 2017

## RELATED INSIGHTS

News

Aug 05, 2024

### **Vigilance and Best Practices: Protecting Trademark Owners from Evolving USPTO Scams**

Insights

Feb 06, 2024

### **Fourth Circuit holds faxes received online not subject to TCPA**

A fax is a fax is a fax or is it? In a recent ruling in the long-running TCPA junk fax case *Career Counseling, Inc. v. AmeriFactors Financial Group*, the Fourth Circuit Court of Appeals held that the statute's prohibition against uninvited fax advertisements does not apply to faxes received through online fax services. In a very positive development for TCPA defendants, the Court affirmed the denial of class certification for a proposed class including both members who used a traditional fax machine and those who used an online fax service. The Court reasoned that identifying the traditional fax machine users would require individualized inquiries, which rendered the proposed class unascertainable. While consistent with the Federal Communication Commission's declaratory

ruling from In the Matter of AmeriFactors Financial Grp., LLC Petition for Expedited Declaratory Ruling (“FCC Ruling”),[1]the decision marks a d...

News

Apr 05, 2022

## **BCLP Team Advises Neenah, Inc., in \$3B Merger of Equals**