

TRADEMARK PROSECUTION, COUNSELING AND PROTECTION SERVICES

OVERVIEW

When protecting your brand and reputation, a company should define itself through establishing, managing, and developing trademarks. With a 150-year history, BCLP is no stranger to being the source in leading and protecting companies for their entire portfolio, whether in the US or across the globe. Our team continues to manage over 10,000 marks in over 150 jurisdictions, advising companies as a single point of contact to make sure they have the adequate protections to establish, register, renew, license, and deliver strategic brands the level of support they deserve.

BCLP provides the full range of trademark prosecution services in brand management and protection. We guide clients to clear, protect, maintain, and enforce trademark rights throughout the world. Our clients often benefit from intelligent solutions around their assets as they seek strategic advice to launch and protect brands, develop global branding strategies, implement licenses and distribution agreements, and navigate trademark oppositions favorably.

Our innovative team drives protection strategies based on commercial needs and the value propositions that enable a high degree of profitability in the marketplace, whether through new brands or ventures, distribution networks, or the digital frontier. BCLP's trademark team adapts and evolves our practice as the world continues to change, allowing clients to benefit from the latest developments in law and business.

TRADEMARK IDENTIFICATION AND SELECTION

At the start of any asset protection journey is selecting and clearing appropriate trademark rights which can include words, designs, logos, slogans, product or packaging shapes, colors, sounds, motions, and scents, identifying which products, services, or identities should be subject to those trademark rights. This is a continuing process as a business grows and consumers come to view its marks as indicating a single source. BCLP provides comprehensive guidance to clients to identify and protect rights at every stage.

TRADEMARK CLEARANCE

We provide trademark searching and clearance regarding branding strategies, registration, use, and enforcement of proposed and adopted marks. Our lawyers provide a range of alternative searching options for selecting and clearing marks for adoption and use, as well as for anticipating potential obstacles to registration and minimizing litigation risks.

TRADEMARK PROTECTION AND PROSECUTION

BCLP works with companies of all sizes, from *Fortune* 500s to startups, to handle every facet of trademark registration and protection before the USPTO, EUIPO, WIPO, and abroad. With early and close engagement, we prepare and file applications where it may best suit stakeholders. We start with conducting searches and clearances, followed by managing the application review on your behalf including complying with examiner requirements, and responding to refusals and office actions. If a client's application is opposed at the TTAB or otherwise, we apply our deep experience in defending and resolving oppositions and cancellations. Once the examiners have approved the mark, we can help with the specimen and statement of use after publication, and soon after have a registered trademark. BCLP is supportive of your needs in this entire process, providing an approach that works closely with you to support the entire lifecycle of your trademark, including ongoing proof of use and renewals.

BCLP also provides a full range of trademark services in all matters before the European Union Intellectual Property Office (EUIPO), the German Patent and Trademark Office (DPMA) and the French Patent and Trademark Office (INPI), including opposition and cancellation proceedings. We also handle international trademark filings through the Madrid System covering more than 130 countries worldwide.

GLOBAL TRADEMARK PORTFOLIO MANAGEMENT

Companies trust BCLP to establish their entire portfolio or move their entire portfolio to provide full-service support because of our ability to handle trademark assets with a genuine level of care that doesn't leave you feeling managed. We regularly guide companies to carefully launch and develop brands domestically and abroad. Our firm works with companies on the cross-border expansion of their trademark rights as well as in filing and managing applications and registrations in single or multiple jurisdictions. We are credited by many clients for providing tailored, business-oriented, cost-effective global brand management and strategy advice to help clients meet their business goals.

TRADEMARK LICENSING

We handle a full range of trademark licensing, acquisition, and transfer services, including in the context of content and brand licensing, co-branding and cross-promotions, consent-to-use, multi-level distributorships, internet matters, and e-commerce platforms. Our trademark team assists

clients with intellectual property due diligence in corporate transactions, intellectual property audits, transfers of ownership, and granting of security interests in connection with mergers, acquisitions, and investments.

Our experience includes handling:

- For a major manufacturer of toy action figures: licenses with motion picture studios, publishers, and major professional sports leagues and their players' associations
- For a major motorcycle aftermarket manufacturer: license in for use of a well-known mark on its products
- For a school in a state university system: licenses out of the use internationally of its mascot in connection with an educational outreach project
- For an international footwear company: co-branding agreements, joint promotion agreements, product placements, and other collaborative efforts, with major brand owners and motion picture studios
- For a major US home furnishings retailer: licenses with US and international manufacturers, and joint venture and co-branding agreements
- For a manufacturer of stylized footwear: licenses out to video game developers/manufacturers to include depictions of footwear in games
- For a global retailer of toys and baby products: licenses with third parties to allow the client to expand its trademark portfolio with a relatively small expense
- For a world-renowned dance company: licenses out of their source-indicating choreography for live performances by third parties and for use in advertisements and on consumer products
- For a major charity whose goal is to bring clean and safe drinking water to people in developing nations: licenses out of its trademarks on a variety of products, a portion of the sales revenue of which goes to the charity to further its work
- For a major manufacturer of HVAC equipment: licensing in connection with the acquisition of a company and its portfolio of internationally well-known brands
- For an international appliance manufacturer: licenses out of its world-famous brands
- For a major international food producer: brand licenses
- For consumer products manufacturers: licenses and other agreements with major league sports teams and stadium owners concerning sports stadium naming rights

- For an international hair products company: licenses with distributors in over three dozen countries
- For major apparel manufacturers: US and foreign licenses in and out
- For sporting goods manufacturers: US and foreign licenses in and out
- For US beverage companies: licenses out

CORPORATE TRANSACTIONS

Our trademark team assists clients with intellectual property audits, intellectual property due diligence, transfers of ownership, and granting of security interests in connection with mergers, acquisitions, and investments.

MEET THE TEAM



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November 4, 2021

U.S. News - Best Lawyers® 'Best Law Firms' 2022