Kathleen E. McCarthy (Katie)

PARTNER

CONTACT

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PRACTICES

Copyright
Energy Intellectual Property
Healthcare Industry
Intellectual Property
Licensing
Trademarks/False Advertising

MEMBERSHIPS

New York IP Law Association
International Trademark Association

EDUCATION

J.D., Harlan Fiske Stone Scholar, Columbia University School of Law
B.A., Dean's List, College of the Holy Cross

ADMISSIONS

New York

PROFILE

Katie McCarthy, a partner in the Intellectual Property Practice Group in King & Spalding's New York office, has 24 years of experience in litigation and related counseling in domestic and international trademark, copyright, false advertising, right of publicity, unfair competition and Internet matters. She works with clients to find creative and practical solutions to their legal challenges, and helps them develop legal strategies to advance their business goals.

Ms. McCarthy has first-chaired numerous trials and preliminary injunction hearings and has practiced in the federal courts, the U.S. Patent and Trademark Office Trademark Trial and Appeal Board, the International Trade Commission and ICANN domain name arbitrations.

In addition to litigation and contested matters, Ms. McCarthy directs international and domestic trademark clearance and prosecution programs. She is co-chair of the New York Intellectual Property Law Association's Trademark Law and Practice Committee and sits on the editorial board of INTA's scholarly journal, *The Trademark Reporter*.

Ms. McCarthy also frequently writes and speaks on trademark and false advertising matters. Examples of speaking engagements and articles include:

- "Everything You Know is Wrong: Formerly Settled Copyright Issues," Presentation, PLI Understanding Copyright Law in the Data Era 2012 (July 2012)
- "International Protection in an Internet World," Presentation, PLI Intellectual Property Law Institute (September 2011)
- "Practical Advice on Stopping Blatant Infringements," Presentation and Program Co-Chair, PLI IP Enforcement and Litigation 2011: Civil and Criminal Update (March 2011)
- "Brand Protection: Trademark Issues in Cyberspace," Presentation, PLI Information Technology Law Institute (April 2010)
- "Hot Trademark Topics before the TTAB and Federal Courts," Presentation, PLI Intellectual Property Law Institute (September 2010)
- "Update on Fraud at the Trademark Office: the TTAB's *Medinol* Approach Hits the Federal Circuit", NYIPLA "Hot Issues in Trademark and Copyright Law Seminar (June 3, 2009).
- "Enforcement of IP Rights in the U.S. and Globally", Department of State's International Visitor Leadership Program, International Trademark Association Headquarters (May 28, 2009)
- "Protecting Trademarks in a Web 2.0 World: User Generated Content Affecting Trademarks, including Virtual Worlds," Presentation, PLI Information Technology Law Institute, New York and San Francisco (Spring 2009)
- "Practical Skills - Basics of Intellectual Property Law - Trademarks," Presentation, New York State Bar Association Seminar (May 8, 2008)
- "An Introduction to the New Trademark Trial and Appeal Board Rules", Article, co-author with James R. Robinson, appearing in *The Trademark Reporter*® (November-December 2007)
- "Ethical Considerations in Trademark Practice", presentation, NYIPLA "Hot Issues in Trademark Law" Seminar (June 2007)
- "Fraud on the Trademark Office" Chair/host of NYIPLA Trademark Committee Luncheon Lecture (January 2007)

- “What Every Litigator Must Know About Intellectual Property: Trademark Litigation”, PLI Seminar (July 2003; July 2004)
- Article, “The Current State Of Dilution: Attempting To Identify Factors That Influence Who Wins and Who Loses Dilution Cases”, Mealey’s Litigation Report: Volume II, Issue #8 (Jan. 20 2003)
- “The Standards for Proving Dilution in Trademark Cases”, PLI Eighth Annual Institute for Intellectual Property Law (September 2002)
- “Trademark Infringement Litigation in the U.S.” and “Opposition and Cancellation Actions in the U.S.: Presenting an Effective Case”: INTA Trademark Administrators Conference (Chicago, October 2001)
- “The Effect of the Internet on Global Intellectual Property Practice”, PLI Global Trademark and Copyright Program (New York , October 1999; New York and San Francisco, October 2000)
- “False Comparative Advertising”, ABA Intellectual Property Law Section Seminar (Washington, D.C., March 1998)

MATTERS

Litigation examples include:

- Lead counsel for defendant in jury trial securing successful defense verdict and winning on counterclaims for fraud and genericness in trademark infringement case involving power generation equipment conducted in New York federal court;
- Lead counsel for plaintiff in bench trial in trademark infringement case involving snack foods conducted in California federal court;
- Lead counsel for plaintiff in preliminary injunction hearing in trademark infringement case involving building materials conducted in North Carolina federal court;
- Lead counsel for plaintiff in bench trial in trademark infringement case involving wines conducted in New York federal court;
- Lead counsel for defendant in preliminary injunction hearing in copyright infringement case involving automotive parts catalogs conducted in New York federal court;
- Lead counsel for defendant in preliminary injunction hearing in copyright infringement case involving photographs conducted in Hawaii federal court;
- Lead counsel for plaintiff in temporary restraining order and preliminary injunction hearing in false advertising case involving staple gun products conducted in New York federal court;
- Lead counsel for plaintiff in a preliminary injunction hearing in trademark infringement case involving restaurant and bakery names conducted in New York federal court;
- Counsel for defendant in bench trial in trademark infringement case involving tool model numbers for staple guns conducted in Connecticut federal court;
- Counsel for defendant in preliminary injunction hearing and related appeal in trademark infringement case involving beverages and candy conducted in Illinois federal courts;
- Lead counsel for either applicant/registrant or opposer/petitioner in numerous Trademark Trial and Appeal Board ex parte and contested proceedings; and
- Counsel for plaintiff in numerous domain name infringement cases before ICANN arbitrators and in federal court.

NEWS & INSIGHTS

NEWS

22 May 2013	**King & Spalding’s Intellectual Property Practice, Ten IP Partners Recognized in 2013 Managing IP Handbook**
28 Jan 2013	**Katie McCarthy and Bruce Baber to Present at PLI’s IP Enforcement and Litigation 2013 Seminar**
07 Jan 2013	**IP Group Of The Year: King & Spalding**
05 Sep 2012	**Katie McCarthy to Present at PLI’s 2012 Intellectual Property Law Institute**
30 May 2012	**Legal 500 Recognizes 21 King & Spalding Practices And 68 Firm Lawyers in Latest U.S. Guide**

06 Feb 2012	**McCarthy, Horwitz Play Key Roles at PLI's 2012 IP Enforcement and Litigation Program**
02 Aug 2010	**Katie McCarthy Updates Trademark Law at PLI Intellectual Property Institute**
09 Jun 2010	**King & Spalding's McCarthy Presents e-Learn on Brand Protection in Cyberspace**
06 Apr 2010	**Katie McCarthy to Discuss IP Cyberspace Issues at PLI Seminar**
17 Feb 2009	**Katie McCarthy A Featured Speaker At Information Technology Law Institute**
25 Apr 2007	**Trademark Litigator Kathleen McCarthy Joins King & Spalding**

PUBLICATIONS

26 Sep 2011	**Intellectual Property Newsletter - September 2011**
03 Sep 2009	**Federal Circuit Weighs In On—and Rejects—TTAB Medinol Fraud Standard**