

Kathleen E. McCarthy (Katie)

Partner

*Trial and Global Disputes / Intellectual
Property*



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Katie McCarthy focuses on trademark, copyright, design, advertising and internet law. As a partner in our Intellectual Property, Patent, Trademark and Copyright Litigation practice, Katie represents clients in a wide array of industries including consumer products, pharmaceuticals, retail, internet services, sports and entertainment, cosmetics, and food and beverages. Katie appears on behalf of clients in federal court and before the U.S. Patent and Trademark Office's Trademark Trial and Appeal Board. Katie also develops domestic and international protection and enforcement programs.

During her more than 30 years of experience, Katie has first-chaired numerous trials and preliminary injunction hearings. Katie actively polices online infringement and scams for several clients. In addition to litigation and contested matters, Katie directs international and domestic trademark clearance and prosecution programs, manages domain name disputes and acquisitions, and develops social media and other intellectual property-related policies.

Katie also counsels clients on a broad range of IP-related matters, helping to find creative and practical solutions to legal challenges, and developing legal strategies and policies that advance their business goals.

Katie has served on the Board of the New York Intellectual Property Law Association for years, recently finishing a term as President during which she organized and moderated a forum of key discussion leaders debating online platform liability. Katie served as Editor-in-Chief of the International Trademark Association peer-reviewed scholarly journal, *The Trademark Reporter*, having served on the committee soliciting and editing articles for the journal for more than 20 years. Katie's article, "Free Ride or Free Speech: Predicting Results and Providing Advice for Trademark Disputes Involving Parody" won INTA's 2020 Ladas Memorial Award for best paper in the professional category. Katie has presented at and co-chaired PLI's IP Enforcement Update program annually since 2011 and frequently writes and speaks for PLI, INTA, NYIPLA and other organizations on trademark, copyright and false advertising topics. Katie is the author of PLI's one volume treatise, "Kane on Trademark Law: A Practitioner's Guide."

Katie has been recognized in the 2012–2016 editions of *Legal 500* for her trademark work.

Matters

A Better Choice Lock & Key LLC v. **Google Inc.** et al (DC Cir., filed 2016) (Lead counsel for defendant in Lanham Act, antitrust class action case with CDA Section 230 defense motion to dismiss granted and affirmed on appeal in precedential decision).

Baldino's Lock & Key Inc. v. **Google Inc.** et al (EDVA and 4th Cir., filed 2014) (Lead counsel for defendant securing CDA Section 230 defense on motion to dismiss in case involving Lanham Act and RICO claims).

Valerus Field Solutions LP v. Valerus Specialty Chemicals (SDTX, filed 2015) (Lead counsel for plaintiff in trademark infringement action, securing settlement prior to preliminary injunction motion).

On Site Energy Co. v. **MTU Onsite Energy** (EDNY, filed 2010; jury trial August 2012) (Lead counsel in trademark infringement action challenging the use of the term ON SITE ENERGY in connection with power generators, securing jury verdict for the defense).

Spanx, Inc. v. Times Three Clothiers d/b/a Yummie Tummie (NDGA, SDNY, filed 2013) (Lead counsel in design patent infringement declaratory judgment action and related design patent and utility patent infringement action, securing decision invalidating two patents with case resolved and dismissed thereafter).

Fritz Hansen A/S v. Restoration Hardware (SDNY, filed 2013) (Lead counsel in trademark and trade dress infringement action involving copies of chair designs, securing resolution).

Rolex Watch U.S.A., Inc. v. PRL Holdings (SDNY 2012) (Lead counsel in appeal of TTAB decision involving marks RLX RALPH LAUREN and RALPH LAUREN RLX, securing resolution prior to trial). Prior cases include: **Rolex Watch U.S.A., Inc.** v. Capetown Diamond Corp. et al (N.D. Georgia 2003-2007) (Lead counsel in the latest of a series of cases establishing that genuine Rolex watches altered with non-genuine integral parts such as diamond bezels and bracelets are counterfeit);

Rolex Watch U.S.A., Inc. v. Town & Country Jewelers (2005);

Rolex Watch U.S.A., Inc. v. JBJ Distributors, Inc. (5th Cir. July 29, 2003) (per curiam);

Rolex Watch U.S.A., Inc. v. Zeotec Diamonds, Inc., 2003 U.S. Dist. LEXIS 5595 (C.D. Cal., Mar. 7, 2003) (Lead counsel);

Rolex Watch U.S.A., Inc. v. Michel Co., 179 F.3d 704 (9th Cir. 1999);

Rolex Watch U.S.A., Inc. v. Meece, 158 F.3d 816 (5th Cir. 1998).

Credentials

EDUCATION

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

ADMISSIONS

U.S. Court of Appeals for the Federal Circuit
Supreme Court of the United States
U.S. Court of Appeals for the Second Circuit

U.S. Court of Appeals for the Fourth Circuit
U.S. Court of Appeals for the Eleventh Circuit
U.S. Court of Appeals for the D.C. Circuit
U.S. District Court for the Eastern District of New York
U.S. District Court for the Northern District of New York
U.S. District Court for the Southern District of New York
New York

ASSOCIATIONS

New York

Recognition

Named to Managing Intellectual Property's Global Top 250 Women in IP

MANAGING INTELLECTUAL PROPERTY 2018

Trademark

LEGAL 500, 2012–2016

Insights

ARTICLE

August 29, 2019 • Source: The Trademark Reporter

Free Ride or Free Speech? Predicting Results and Providing Advice for Trademark Disputes Involving Parody

August 29, 2019 • Source: The Trademark Reporter

Free Ride or Free Speech? Predicting Results and Providing Advice for Trademark Disputes Involving Parody

NEWSLETTER

August 27, 2020

International Food Law Gazette – August 2020

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Events

WEBINAR

September 22, 2021

Key Food and Beverage Issues – Social and Environmental Responsibility in Manufacture, Supply and Advertising

April 21, 2021

Key Food and Beverage Issues: Recent Developments in Trademark Infringement and Parody Disputes

March 18, 2021

Let's Talk Tech: What We Are Watching in 2021

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News

CASES & DEALS

August 10, 2021

Equifax to Acquire Appriss Insights for \$1.825 billion

IN THE NEWS

October 20, 2021 • Source: Law360 and Bloomberg Law

Katie McCarthy and Allison Altersohn represent Hotaling, importer of Luxardo Maraschino cherries, before a New Jersey federal court in an unfair competition dispute against Berry Solutions and EMC Group

August 25, 2021 • Source: The Fashion Law

Katie McCarthy quoted in a profile that examined the trademark dispute between Off-White and Afters Ice Cream

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