

Kathleen E. McCarthy (Katie)

Partner

*Trial and Global Disputes / Intellectual
Property, Patent, Trademark and
Copyright Litigation*

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Katie McCarthy focuses in trademark, copyright, design and advertising 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, 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. In addition to litigation and contested matters, Ms. McCarthy 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 that advance their business goals.

A Board member of the New York Intellectual Property Law Association, Katie also serves as Editor-in-Chief of the International Trademark Association scholarly journal, *The Trademark Reporter*. Katie has presented at and co-chaired PLI's IP Enforcement Update program annually since 2011 and frequently writes and speaks for PLI, INTA and other organizations on trademark, copyright and false advertising topics.

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

Matters

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

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. 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

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

October 22, 2018

REIT Advisor – October 2018

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Events

SPEAKING ENGAGEMENT

October 21, 2019

Katie McCarthy to Speak at PLI's Intellectual Property Law Institute 2019

December 6, 2018

Katie McCarthy to Speak at NYIPLA's Women's Mentoring Event

WEBINAR

June 18, 2019

Key Food & Beverage Issues: False Advertising

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News

IN THE NEWS

June 7, 2019 • Source: Bloomberg Law, Legaltech News, Law360 and Courthouse News Service

Katie McCarthy and Taylor Lankford represented Google, Yahoo! and Microsoft before the D.C. Court of Appeals which affirmed an earlier dismissal

RECOGNITION

May 31, 2019

Katie McCarthy Elected President of the New York Intellectual Property Law Association (NYIPLA)

May 20, 2019

Managing IP Names Lori Gordon and Kathleen McCarthy to Top 250 Women in IP List; Recommends Multiple King & Spalding IP Practices, Individuals in its Annual Guide

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