

Icon Of IP: Kilpatrick Townsend's Theodore Davis

By Kevin Penton

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In the complex world of trademark law, where practitioners are often renowned for their attention to detail and specificity, Kilpatrick Townsend & Stockton LLP's Theodore H. Davis Jr. has a reputation for being particularly at ease when wandering into its weeds.

A "virtual walking encyclopedia" of trademark law, Davis combines an uncanny ability to compartmentalize his knowledge of legal precedent, an incredible memory and a strong work ethic in his efforts to help others grasp the legal practice's nuances, said Miles J. Alexander, an intellectual property partner with Kilpatrick.



Theodore H. Davis Jr.

"It would be almost negligent not to go to him with a question," Alexander said. "His grasp of the law is so good, he will put something out in one draft that will take someone else much more of an effort."

For the past 18 years, Davis has worked every year on summarizing and detailing the importance of about 250 to 300 reported trademark opinions coming out of the nation's courts, not just the Trademark Trial and Appeal Board.

The resulting 400-page manuscript, which tends to include about 2,000 footnotes, is known as the U.S. Annual Review for the Trademark Reporter, a publication of the International Trademark Association.

"I get into the weeds of some of these cases in a way that I don't think anybody else does," said Davis, who currently serves as chair of the intellectual property section of the American Bar Association.

Davis' synthesis of the cases assists attorneys throughout the country as they weigh which jurisdiction would be best to bring a suit in or what case law to cite in their suits, he said.

As part of the effort, Davis conducts a review of the cases during a presentation at the International Trademark Association's annual convention that is often the gathering's most attended session, said Joseph Ferretti, president-elect of the association and vice president and chief counsel of global trademarks for PepsiCo Inc.

“From a practitioner’s standpoint, his breadth of knowledge of the law is highly appreciated,” Ferretti said.

Working on the annual review is a year-round effort, with a strong push during the final two months, said Davis, who published the latest version on Feb. 29. The annual project gives Kilpatrick Townsend an edge, as clients feel reassured that someone with his expertise is on their side and other attorneys in the firm can lean on his knowledge, he said.

“I would not be able to do it without the support of my firm,” Davis said.

Although some attorneys recall knowingly sharpening their litigation skills as far back as their kindergarten playgrounds, Davis says the thought of becoming a lawyer first crossed his mind when he was an undergraduate at North Carolina’s Davidson College, as he worked in the Ohio Senate during the summer after his freshman year.

Ferretting out the details that go into the legislative process appealed so much to Davis’ inquisitive nature that the Atlanta native cast aside his dreams of medical school, refocusing them instead on law school.

Walking down a hallway at the University of Virginia School of Law before he enrolled, Davis noticed a bulletin board that included student notes that had been published by the resident law journals. He pulled down several, including one on trademark law, and was captivated by what he read.

“By the time I started classes, I had a pretty good idea of what I wanted to do,” Davis said.

Eight years after graduating from law school, Davis testified in 1998 before the House Judiciary Committee’s subcommittee on courts and intellectual property, arguing that the legal approach lawmakers were proposing for resolving a circuit split on the question of which party bore the burden of proof on the issue of functionality in a trade dress case was wrong.

In infringement suits concerning trade dress, a legal term that refers to a product’s packaging or design, Davis argued that it would be wrong for a defendant to have the burden of proof on the question of functionality, or whether the trade dress was inherently needed for the product to work. Generally, trade dress deemed to be functional does not qualify for a trademark.

Rather, Davis argued that the party that asserts trade dress protection for an unregistered trade dress in an infringement case should be the one that has to prove that the matter is not functional. The subcommittee ultimately sided with Davis, who helped to craft the language for what became Section 43(a)(3) of the Lanham Act, he said.

“It’s an obscure issue, but it’s the kind of thing that gets me excited,” Davis said with a laugh. “In the long run, it has been the right way to do it.”

Mei-lan Stark, senior vice president for intellectual property at Fox Entertainment Group, said she considers herself extremely fortunate to have worked with Davis early in her career, when she could just pop into his office and ask him questions.

She recalls being amazed at how Davis managed to carry so much knowledge in his head, rattling off

case law relevant to her queries that was always on point. But rather than just give people the answer they are looking for, Davis puzzles out quandaries with his colleagues, helping them develop their own analytical skills, she said.

"He'll give you morsels of fish, but he really wants to teach you how to fish," Stark said. "He knows a million times more than you, but he never makes you feel embarrassed to ask questions."

Davis said he has been the lead or primary co-author on several amicus briefs submitted to the U.S. Supreme Court on behalf of the International Trademark Association, including for 1992's *Two Pesos v. Taco Cabana* — in which the high court held that proof of secondary meaning is not needed to win a case in which the trade dress is considered inherently distinctive under the Lanham Act — and 2000's *Wal-Mart Stores v. Samara Brothers* — a related case in which the justices ruled that in an infringement action involving an unregistered trade dress, a product's design is protected as distinctive upon a demonstration of secondary meaning.

Davis' writing is typically published a couple of times a year in legal journals. He has been published for a long enough time that he is considering publishing an article that would contest an argument made by a younger version of himself in 1992.

The 1992 article — in which he argued that the federal government's ban on "disparaging" trademark registrations violates the First Amendment's free speech clause — was cited in December's Federal Circuit case *In re: Simon Shiao Tam*, in which the appellate court held that members of a band called The Slants were wrongly refused a registration on their name on the grounds that it was offensive to Asian-Americans.

Davis said he is now weighing the constitutionality of the statute in light of the First Amendment's right to petition clause, he said.

"I haven't disavowed it yet," he said of his earlier writing. "I've come up with an alternative theory, a parallel theory."

Davis says he hopes to continue working on the annual review until he completes 25 of them. He said he considers himself an advocate who hopes to continue to work to steer trademark law throughout his career.

"I enjoy seeing courts get things right and I enjoy seeing Congress get things right, when it comes to trademark issues," Davis said. "My goal is to make sure that happens."

--Additional reporting by Bill Donahue. Editing by Jeremy Barker and Patricia K. Cole.
