

Margaret C. McHugh

Partner

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Services

Clearance & Portfolio Management
Intellectual Property
Online & Digital Enforcement
Trademark Litigation
Trademark, Copyright & Advertising

Industries

Apparel, Accessories & Luxury Goods
Automotive
Chemicals
Consumer Goods
Electronics & Computer Technology
Financial Institutions
Food, Restaurant & Beverage
Health & Life Sciences
Media & Entertainment
Medical & Surgical Devices
Retail & Consumer Goods
Technology



Margaret McHugh has been practicing law for over 25 years and is an experienced trademark and copyright practitioner. Ms. McHugh's practice is focused on strategic counseling, trademark clearance, the prosecution of trademark and copyright applications in the U.S. and internationally, global trademark portfolio management, protecting and defending clients' intellectual property rights, licensing, and other business transactions and contracts pertaining to intellectual property.

Working with a range of clients, from entrepreneurs to *Fortune* 500 companies, in a broad range of industries, including computer hardware and software, medical devices and biotechnology, and well as other fields such as apparel, household consumer products, e-commerce, food products, life sciences, pharmaceuticals, transportation and wine, Ms. McHugh offers expert counseling and assistance in selecting the best trade names and trademarks and in putting in place practices that will help her clients establish the strongest brands to compete in the marketplace. Her broad skills include trademark searching and clearance opinions, trademark



and copyright prosecution, protecting and defending intellectual property rights, and the drafting and negotiation of assignments, licenses and other commercial agreements.

Ms. McHugh manages small and large trademark portfolios, both in the U.S. and internationally, helping both start-ups choose their first product name and carefully prioritize their foreign market filings, as well as established companies with hundreds of trademarks expand their global footprint. She takes advantage of her firm's well-established and reliable infrastructure, as well as a dependable network of foreign expert associates, to best position her clients to successfully secure trademark rights and to ensure these rights are maintained in the relevant countries. Excellent client service, accessibility and responsiveness are of utmost importance to Ms. McHugh, who dedicates herself to helping her clients obtain their business objectives in an efficient and cost effective manner.

Ms. McHugh is experienced in civil litigation in state and federal courts involving trademarks, copyrights, trade secrets and antitrust, as well as related disputes involving commercial transactions. She has been successful in resolving numerous disputes prior to litigation, or at an early stage of litigation, through mediation, arbitration and other less costly alternatives. Mr. McHugh has also handled hundreds of inter partes disputes before the Trademark Trial and Appeal Board.

Ms. McHugh has significant appellate experience and has represented clients in a number of successful appeals, including cases involving antitrust, contract and fraud claims. She was formerly a judicial clerk for the New York Supreme Court, Appellate Division (Third Judicial Department).

Experience Highlights

Trademark Counseling, Prosecution and Portfolio Management

Global trademark portfolio management and trademark enforcement for leading technology company with worldwide operations in diversified industries:

Portfolio consists of nearly one thousand files. Clear new product names, successfully register marks in dozens of countries, protect and enforce trademark rights in the US and abroad.

Trademark enforcement for major consumer electronics company.

Ongoing representation of a California-based *Fortune* 100 company, including handling of dozens of Trademark Trial and Appeal Board proceedings and other trademark disputes.

Trademark counsel for prominent developer of audio and imaging technologies.

Provide trademark counseling, global trademark portfolio management and trademark enforcement for San Francisco-based company focused on audio, imaging and voice technologies for cinema, home theaters, computers, mobile phones, and games.

Registrations in 100 countries.



Trademark clearance project for expanding pharmaceutical company.

Helped client evaluate trademark availability and assess risks associated with more than a dozen proposed alternative names for new products, managing team of attorneys to provide full legal opinions to the client in only a week.

Trademark clearance project for leading San Francisco-based apparel company.

Managed the clearance of more than 150 proposed marks, providing the client with a risk assessment in a matter of days.

Successful prosecution of Uniform Domain Resolution Proceedings (UDRP) complaints:

Filed complaints with WIPO on behalf of various clients whose marks were the subject of cybersquatting and infringement. Managed the prosecution of the complaints to a successful final decision requiring transfer of infringing domain names to our clients.

Representative Litigation matters

Successful prosecution of a federal copyright infringement case:

Represented the law firm of Brayton Purcell LLP in a copyright infringement case brought to protect our client's proprietary website material. Successfully obtained a preliminary injunction and overcame defendant's motion to dismiss. *Brayton Purcell LLP v. Recordon & Recordon* (N.D. Ca. 2004), decision upheld on appeal, 575 F.3d 981 (9th Cir. 2009).

Obtained a preliminary injunction in a trademark infringement case:

Represented Oracle Corporation in a case brought to enforce our client's rights in the ORACLE trademark. *Oracle Corp., et al. v. Light Reading, Inc.*, No. 02-2519 (N.D. Cal. filed May 23, 2002).

Defended manufacturer of consumer products accused of infringing trade dress of alleged well-known brand:

Dispute successfully settled with dismissal of complaint and without payment of any damages.

Experience

Represented Turner Broadcasting System against a variety of breach of contract and related claims. The Ninth Circuit upheld the dismissal of claims against our client.

Wylter Summit Partnership v. Turner Broadcasting System (9th Cir. 1997).

Represented Brayton Purcell LLP in a copyright infringement case brought to protect our client's proprietary website material, successfully obtained a preliminary injunction and overcame defendant's motion to dismiss. *Brayton Purcell LLP v. Recordon & Recordon* (N.D. Ca. 2004), decision upheld on appeal, 575 F.3d 981 (9th Cir. 2009).

Successfully and efficiently settled a trademark dispute between two pharmaceutical companies on a worldwide basis, shortly after adversarial proceedings were commenced, allowing our client to register and use

its mark without interference.

Successfully litigated to settlement a trademark and copyright infringement case for our client, an Internet retail business.

Obtained a preliminary injunction for our client in a trademark infringement case. *Oracle Corp., et al. v. Light Reading, Inc.*, No. 02-2519 (N.D. Cal. filed May 23, 2002).

Defended Connell Rice and Sugar Co., the largest rice exporter in the United States, in a nine-week jury trial of antitrust claims brought against Connell and Joseph L. Alioto (the former Mayor of San Francisco) in connection with the sale of over \$100 million worth of California rice to the Government of Korea during the 1980s. Plaintiffs were 70 Northern California rice growers. The jury returned a verdict for defendants and, following appeal, was settled for mutual releases and the payment of defendants' costs.

Represented plaintiffs who were inventors of a patented energy saving electronic ballast technology which defendant licensed from plaintiffs, then shelved it for the purpose of eliminating competition from the market. Following a six month jury trial, the firm obtained a \$96-million verdict for plaintiffs which was affirmed "without reservation" on appeal.

Successfully defended to settlement a copyright infringement case involving our client, an Internet service provider.

Education

American University, J.D. (1986) *cum laude*
The American University Law Review, Member

University of Virginia, B.A. (1981) *with honors*

Admissions

California (1988)

New York (1986)

Court Admissions

U.S. Court of Appeals for the Ninth Circuit

U.S. Court of Appeals for the Federal Circuit

Professional & Community Activities

International Trademark Association, Trade Name Enforcement Subcommittee, Member



National Association of Women Lawyers (NAWL), Member
American Bar Association, Section of Intellectual Property Law, Member
San Francisco Bar Association
Women's Intellectual Property Association (WIPLA), Member

Insights

[Alerts](#)

Key Takeaways: Doing Business in Mexico
October 20, 2016

[Webinars](#)

Doing Business in Mexico: Exploring Cross-Border Issues
October 20, 2016

[Events](#)

Doing Business in Mexico: Exploring Cross-Border Issues
September 29, 2016