

Marc A. Lieberstein

Partner

The Grace Building
1114 Avenue of the Americas , New York , NY USA 10036
t 212.775.8781 | f 212.937.3842
mlieberstein@kilpatricktownsend.com



Services

Brand Licensing & Related
Transactions
Clearance & Portfolio Management
Contracts & Commercial
Agreements
Copyright Litigation & Counseling
Franchising
Intellectual Property
Trademark, Copyright &
Advertising

Industries

Media & Entertainment
Retail & Consumer Goods

Marc is the co-chair of the Franchise Group and Retail & Consumer Goods industry team. His practice focuses on intellectual property licensing and franchising in the retail/consumer goods and services areas, fashion/apparel and accessories, food and beverage, and commercial/industrial design, including the drafting, negotiation, and enforcement of license and franchise documents and agreements, as well as implementation of branding and commercialization objectives for clients via licensing and franchising. In conjunction with the services above, Marc counsels clients on creating effective strategies for procuring, protecting, and enforcing their global intellectual property assets. Marc has also participated in and used alternative dispute resolution forums such as arbitration and mediation to enforce intellectual property rights and resolve license and franchise contractual disputes. Marc frequently lectures and writes on intellectual property and franchise issues for a variety of intellectual property and franchise organizations and publications, including International Trademark Association (INTA), New York State Bar Association Intellectual Property Section, and the American Bar Association Forum on Franchising, *The Franchise Lawyer*, *Franchise Law Journal*, *National Law Journal*, *IP Strategist*, and *The New York Law Journal*, *Practical Law*, *The Licensing Journal*.

Marc is listed in the 2020 and the nine years immediately preceding editions of *World Trademark Review 1000 – The World's Leading Trademark Professionals*. He was recognized as a New York “Super Lawyer” in Intellectual Property by *Super Lawyers* magazine in 2019 and the nine years immediately preceding, and, in 2018 and the six years immediately preceding, he was named a Top 100 New York Metro “Super Lawyer” in Intellectual Property. Marc was recognized in 2020 by *The Best Lawyers in America*[®] for Franchise Law. He has been recognized as

an "IP Star" in 2019 and the six years immediately preceding by *Managing Intellectual Property* magazine. In 2017, 2018, and 2019 Marc was recognized by *Who's Who Legal* as a Global Leader for Franchising and Trademarks. He was named a franchise "Legal Eagle" in 2018 and 2019 by *Franchise Times*. Marc was also recommended by *Legal 500 US* in 2015, 2016, 2017 and 2018 for Copyright and in 2019 for Non-Contentious Trademark Law. In 2013, he received the Lexology *Client Choice Guide - International 2013* Award and is the sole winner in the Intellectual Property: Copyright category for New York. Marc was also listed in the 2012 and the four years immediately preceding editions of *Chambers USA: America's Leading Lawyers for Business* for Intellectual Property: Trademark & Copyright. *Chambers* noted that Marc has "tremendous business savvy and is tenacious in his work ethic," according to his clients (2012).

INTA honored Marc with the Volunteer Service Award (VSA) in the Advancement of Committee or Subcommittee Objectives category. The VSA recognized Marc in 2015 for providing exemplary volunteer service to INTA. As a member of INTA's Alternative Dispute Resolution Committees Neutral Standards & Measurement Subcommittee, Marc made a tremendous impact by volunteering both his time and expertise to support the Association's goals and objectives. Marc also received the 2015 Commitment to Justice Award presented by Her Justice recognizing his pro bono work in representing a client who sought help in terminating her arranged marriage. Through skillful negotiation, without any court intervention, Marc secured for the client a divorce on terms very favorable to her and to her children. He is a recipient of the Kilpatrick Townsend 2014 Pro Bono Justice Award. Marc is also a recipient of the 2015 Cardozo Law School Alumni of the Year Award recognizing Marc's leadership and dedication to Cardozo Alums and students.

Representative Clients: MOMOFUKU, FUKU, S'WELL BOTTLE, STETSON, HANESBRANDS, FLOWERS FOODS, COMPASS GROUP, EXPRESS SERVICES, RIVER STREET SWEETS-SAVANNAH'S CANDY KITCHEN, EPIC KITCHEN, BILLY REID, and ENERGIZER.

Experience

Provide franchise advice and counsel, including preparation of Franchise Disclosure Document, Franchise Agreement, as well as related developer and other agreements, along with franchise registration, renewal and update services to numerous clients in the food beverage and consumer services areas. Representative clients include: FLOWERS FOODS; EXPRESS SERVICES; EPIC KITCHEN; THE JUICY CRAB; ZIPPY'S RESTAURANTS; FUKU; RIVER STREET SWEETS – SAVANNAH'S CANDY KITCHEN; MAXIMIZED LIVING, PUTT-PUTT.

Provide advice and counsel concerning licensing and related brand transactions, such as manufacturing, supply and distribution agreements, as well as provide global trademark, copyright and patent portfolio and enforcement services to S'well Bottle Company.

Provide global trademark, copyright and patent portfolio and enforcement services to Nuance Communication.



Provide global trademark and copyright portfolio and enforcement services to Helen Keller Services.

Provide advice and counsel concerning licensing and related brand transactions, such as manufacturing, supply and distribution agreements, as well as provide global trademark, copyright and patent portfolio and enforcement services to Hudson's Bay Companies.

Provide advice and counsel concerning licensing and related brand transactions, such as manufacturing, supply and distribution agreements, as well as provide global trademark, copyright and patent portfolio and enforcement services to John B. Stetson Company.

Provide advice and counsel concerning licensing and related brand transactions, such as manufacturing, supply and distribution agreements, as well as provide global trademark, copyright and patent portfolio and enforcement services to Momofuku Group.

Provide advice and counsel to a North American clothing manufacturer, designer, and retailer, including draft, revise and audit for international Retail and eCommerce Agreement templates, as well as provide counsel concerning disputes with licensees around the world, and draft and negotiate product supply and services agreements, social media influencer agreements, and trademark merchandise and co-branding license agreements.

Served as co-lead counsel in an international arbitration proceeding for plaintiff licensor JA Apparel Corp. against a Chinese licensee. After conducting a full trial on liability, we successfully obtained an arbitral award confirming the termination of the licensee, finding that the licensee materially breached the license agreement, enjoining the licensee's activities in China and dismissing the China licensee's counterclaim. We also obtained a damages award in the amount of \$1.2 million, a permanent injunction including an order to return or destroy all remaining inventory, and an award of attorneys' fees and costs. The arbitration award was later formally recognized by the Shanghai Number One Intermediate People's Court.

Provide advice and counsel in areas of trademark and copyright to global manufacturer, designer and supplier of wallcovering products, including trademark and copyright licensing, registration and clearance.

Advice and counsel in areas of patent, trademark and copyright to Economic Development Resource Guide, a provider of state-of-the-art consulting services and software products, for measuring economic development performance, impact and opportunity for transportation and infrastructure projects, energy programs and projects, and commercial and industrial development.

Brand licensing and counsel to Osram Sylvania, one of the largest lighting and materials companies in the world with a long-standing reputation of providing solutions in homes, businesses, institutions, and automobiles, to



provide advice on brand licensing programs, audit and update license agreement terms, as well as brand licensing and protection strategy.

Brand licensing and counsel to one of the world's leading manufacturers and marketers of tissue, packaging, paper, pulp, building products and related chemicals, to provide advice on brand and technology licensing program, audit and update license agreement terms, as well as licensing and brand protection strategy.

Provide advice and counsel to Patty Madden Inc., leading designer of wallcovering patterns, including trademark and copyright counsel, licensing and clearance.

Provide patent, trademark and copyright advice and counsel to Mavenir Systems Inc. (formerly Comverse Technology Inc.), a leading mobile telecommunications software provider, including matters related to Open Source software.

Represented PayFlex Systems USA, Inc. in trademark infringement litigation against Sensei Inc., a health care technology company. PayFlex had previously hired Sensei as a software development consultant for PayFlex's new product, "HealthHub," a healthcare benefits planning and management mobile tool. A year later, PayFlex discovered that Sensei had launched its own nearly identical benefits management product, coincidentally named "Health Hub." Once we filed a complaint Sensei immediately agreed to stop use of the Health Hub mark and signed a consent judgment, including a permanent injunction. Case settled. PayFlex Systems USA, Inc. v. Sensei, Inc. et al., No. 8:11-cv-00265 (D. Neb. filed Aug. 2, 2011).

Retained to defend independent software developer on a pro bono basis against former law firm employer that alleged copyright infringement, fraud, breach of fiduciary duty and trade secret theft. Negotiated a favorable settlement for the software developer that resulted in a dismissal of all claims, as well as permitting the software developer to sell the accused software product. Esbin & Alter, LLP v. Zappier et al., No. 1:08-cv-00313 (S.D.N.Y. filed Jan. 14, 2008).

Successfully represented copyright owner and designer of wallcovering patterns against infringer manufacturer. After discovery, the matter was resolved with a monetary settlement agreement and a permanent injunction. RJF Int'l Corp., et al. v. U.S. Vinyl Mfg Corp., et al., No. 1:06-cv-04021 (S.D.N.Y. filed May 25, 2006).

Successfully represented Design Tex Group, Inc., copyright owner and designer of wallcovering patterns, against infringer manufacturer. The matter was quickly resolved with a settlement agreement that procured a monetary settlement and a permanent injunction. Design Tex Grp., Inc. et al. v. Fidelity Indus. et al., No. 1:05-cv-00008 (S.D.N.Y. filed Jan. 3, 2005).

Successfully represented Colour & Design, Inc., copyright owner and designer of wallcovering patterns, against



infringer manufacturer. After extensive discovery, the matter was resolved with a monetary settlement agreement, a permanent injunction on several designs, and a business arrangement for other designs. *Colour & Design, Inc. v. U.S. Vinyl Mfg Corp et al.*, No. 04-8332 (S.D.N.Y. filed Oct. 21, 2004).

Successfully represented Design Tex Inc. and designer Patty Madden in a copyright infringement action. The District Court granted summary judgment finding not only copyright infringement, but also finding the corporation and its president jointly and severally liable. Damages included not only the maximum \$150,000 statutory award allowed, but also attorney fees under the Copyright Act. *Design Tex Group, Inc. v. U.S. Vinyl Manufacturing Corp.*, 76 U.S.P.Q.2d 1946, 1949 (S.D.N.Y. 2005). *Laminating Serv. Inc. v. U.S. Vinyl Mfg. Corp. et al.*, No. 1:04-cv-07728 (S.D.N.Y. filed Sept. 29, 2004).

Successfully represented defendant, Andin International Inc., owned by Aya Azrialant, a jewelry designer accused of copyright infringement of a mother child pendant design copyrighted by the plaintiff. After a full trial on the merits, the court found no substantial similarity and ruled in favor of the defendant. *Sandberg and Sikorski Corp. v. Andin International, Inc.*, 51 U.S.P.Q.2d 1574 (S.D.N.Y. 1999).

Represented Chromalloy Gas Turbine Corp. in connection with an appeal of a district court ruling that the employee owned the invention. On appeal, the Federal Circuit reversed and found in favor of the employer because the employee was "employed to invent." *Chromalloy Gas Turbine Corp.*, the largest business unit of Sequa, provides the airline industry with a broad range of aftermarket services and ranks as the leading independent supplier of advanced repairs for jet engine parts. *Teets v. Chromalloy Gas Turbine Corp.*, 83 F.3d 403 (Fed. Cir. 1996).

Education

Benjamin N. Cardozo School of Law, J.D. (1992)

State University of New York, University at Albany, B.A., History, Minor in Business (1989) *cum laude*

Admissions

Connecticut (1992)

New York (1993)

Court Admissions

U.S. Court of Appeals for the Federal Circuit (1995)

U.S. Court of Appeals for the Second Circuit (2000)

U.S. District Court for the Eastern District of New York (1992)

U.S. District Court for the Southern District of New York (1992)



U.S. Supreme Court (2005)

Professional & Community Activities

Benjamin N. Cardozo School of Law, Alumni Association Pro Bono Committee, Former Chair (2010-2014); Alumni Association, Former Chairperson (2006-2010); Career Development Committee, Former Chair

International Trademark Association (INTA), Commercialization of Brands Committee, Sub-Committee Chair for Licensing (2020-); Brands & Innovation Committee (2018); ADR Committee (2013-2017); Neutrals Standards and Measurements Sub-Committee, Chair (2014); Amicus Committee, Member (2012-2013); Law Firm Committee, Chair (2010-2011); Programs Committee, Member (2005-2010); Programs and Standards Subcommittee, Chair (2007-2010); E-Learning Committee, Member (2004); INTA Annual Meeting Project Team, Member (2003 and 2005)

New York State Bar Association, Intellectual Property Law Section, Honorary Member and Former Section Chair (2002-2004); Litigation Committee, Co-Chair (2006-present); Trademark Law Committee, Former Co-Chairperson (1998-2002); Business Law Section, Franchise, Distribution and Licensing Law Committee, Member (2014-present)

American Bar Association, Intellectual Property Section, ABA Forum on Franchising, Member (2013-present)

Association of the Bar of the City of New York, Fashion Law Committee, Member (2012-present), Chair (2014-2017); Intellectual Property Council Representative (2013)

Hebrew Academy of Nassau County (HANC), Board of Directors (2010-2012)

Young Israel of Plainview, Board of Trustees (2010-2012); Former Vice President of Fundraising (2007-2008); Little League Director (2004-present)

Unchained At Last, Board of Directors (2018)

Foundation for Art & Healing, Board of Directors (2018)

Insights

Events

Fundamentals of Franchising

March 10, 2020

In The News

Kilpatrick Townsends Trademark Team Earns Top Ranking From World Trademark Review

February 20, 2020

Perspectives

6 Key Takeaways from Mission Product vs. Tempnology for Brand Licensing and Franchising

February 7, 2020



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Kilpatrick Townsend's Marc Lieberstein Named Co-Chair of INTA Licensing Sub-Committee

January 27, 2020

[Perspectives](#)

Retail and Consumer Goods Team Alert | 2020 VISION

January 16, 2020

[In The News](#)

Podcast | Why Taxes and Unions are Behind the Assault on the Franchise Industry

January 14, 2020

[In The News](#)

Podcast | Are Attacks on the Franchise Industry Employee Structure Ending?

January 14, 2020

[In The News](#)

Podcast | The Franchise Industry Is Under Assault On Employment Structure

January 14, 2020

[Publications](#)

Fair Workweek Laws: Coming Soon to a Neighborhood Near You

November 19, 2019

[News Releases](#)

Record Number of Kilpatrick Townsend Attorneys Named 2019 New York Metro Super Lawyers

November 1, 2019

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Thirty-nine Kilpatrick Townsend Attorneys Named to 2018-2019 *International Who's Who of Business Lawyers*

October 22, 2019

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Kilpatrick Townsend's New York Office is Pro Bono

September 17, 2019



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Is the Franchise Model Under Attack?

September 6, 2019

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Trademark Law and the Cannabis Industry: Six Things That Will Separate Brand Winners from Brand Losers

August 22, 2019

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Record-Breaking Recognition for Kilpatrick Townsend in *The Best Lawyers in America*® 2020

August 15, 2019

[Publications](#)

Franchising 101: Key Takeaways for IP Lawyers

August 2, 2019

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Kilpatrick Townsend Receives Top Rankings from 2019 Legal 500 US

July 10, 2019

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Kilpatrick Townsend Attorneys Named 2019 Managing Intellectual Property IP Stars

June 17, 2019

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Rupert Barkoff Remembered as 'True Pioneer' in Franchise Law

June 12, 2019

[Perspectives](#)

5 Key Takeaways | Brand Meaning and Valuation in the Age of Millennial and Gen Z Consumerism

May 30, 2019

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Kilpatrick Townsend at the 2019 INTA Annual Meeting

May 14, 2019



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Four Kilpatrick Townsend Attorneys Named 2019 Franchise Times Legal Eagles

April 30, 2019

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Video | Doing Well by "Doing Good"

April 17, 2019

[Perspectives](#)

6 Key Takeaways | Franchise 101 for IP Lawyers

April 5, 2019

[Perspectives](#)

7 Key Takeaways | Doing Well by "Doing Good" - A Look at Brands and Corporate and Social Responsibility

March 22, 2019

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Doing Well By "Doing Good" - A Look At Brands and Corporate and Social Responsibility

March 20, 2019

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Kilpatrick Townsends Trademark Practice Receives Gold Level Recognition

February 5, 2019

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3 Key Takeaways: Franchising and Licensing in the United States and Brazil

November 5, 2018

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Franchise Relationships

October 25, 2018

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5 Key Takeaways: Perspectives on Non-Traditional Franchise Ownership Structures

October 23, 2018



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Perspectives on Non-traditional Franchise Ownership Structures

October 12, 2018

In The News

Kilpatrick Townsend Ranked Among Top-Three in the World for Trademark by 2018 Who's Who Legal

October 8, 2018

News Releases

Twenty Kilpatrick Townsend Attorneys Named 2018 New York Super Lawyers

September 28, 2018

Perspectives

5 Key Takeaways: Franchising in the United States and Germany

June 25, 2018

News Releases

Kilpatrick Townsend Attorneys Named 2018 Managing Intellectual Property IP Stars

June 19, 2018

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Franchising in the United States and Germany: A Comparative on Recent Legal Developments

June 13, 2018

News Releases

Kilpatrick Townsend Receives Top Rankings from 2018 Legal 500 US

June 11, 2018

Publications

Brands, CSR, and Compliance: Working Together to Create Value and Improve Society

May 1, 2018

News Releases

Kilpatrick Townsend Attorneys Named 2018 Franchise Times Legal Eagles

April 12, 2018



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Forty-Four Kilpatrick Townsend Attorneys Named to 2017 - 2018 International Who's Who of Business Lawyers
March 19, 2018

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Kilpatrick Townsends Marc Lieberstein Named to Two Distinguished Boards
February 6, 2018

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Kilpatrick Townsends Trademark Practice Receives Gold Level Recognition in the 2018 World Trademark Review 1000
January 25, 2018

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State Franchise Exemptions
January 16, 2018

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Kilpatrick Townsend Attorneys Named to 2017 International Who's Who of Franchise Lawyers
December 7, 2017

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5 Key Takeaways What You Need to Know in the US and Latin America About Franchising and IP
November 20, 2017

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3 Key Takeaways: Doing Business in Mexico – NAFTA Renegotiations
November 1, 2017

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Franchising: An Updated Look at the Basics
October 9, 2017

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Kilpatrick Townsend Recognized by Prestigious 2017 Legal 500 US
October 2, 2017



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Kilpatrick Townsend Attorneys Named 2017 New York Super Lawyers
September 27, 2017

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Kilpatrick Townsend Attorneys Named 2017 New York Super Lawyers
September 27, 2017

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Kilpatrick Townsend Attorneys Named 2017 Managing Intellectual Property IP Stars
June 27, 2017

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3 Top Takeaways: Brands and Their Corporate and Social Responsibility
May 2, 2017

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Brands and Their Corporate and Social Responsibility
April 26, 2017

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Kilpatrick Townsends Trademark Practice Receives Gold Level Recognition in the 2017 World Trademark Review 1000
February 9, 2017

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Top Takeaways: 2016 American Bar Association Forum on Franchising
November 14, 2016

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Mine is Better Than Yours! – The Risks and Rewards in Conducting Comparative Advertising
November 2, 2016

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Key Takeaways from the Advanced Trademark Law Seminar
October 21, 2016



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Top Takeaways from the 2016 Advanced Trademark Law Seminar
October 10, 2016

[In The News](#)

Kilpatrick Townsend's Media Report September 30 - October 6, 2016
October 7, 2016

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Kilpatrick Townsend Attorneys Named 2016 New York Super Lawyers
October 5, 2016

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

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Putting the Diligence in Intellectual Property Due Diligence: Cautionary Tales of Those Who Didn't
September 26, 2016

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Transatlantic Transactions: Minimizing Risk, Maximizing Value
September 15, 2016

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Client Success: Thinking Outside the "Bag" Leads to Victory in China.
August 31, 2016

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Kilpatrick Townsend's Media Report June 17-23, 2016
June 24, 2016

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Kilpatrick Townsend Recognized by Prestigious 2016 Legal 500 US
June 20, 2016



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Chorley Enterprises, Inc. v. Dickey's Barbecue Restaurants, Inc.: Arbitration Provisions in Maryland Franchise Agreements

June 2, 2016

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Brand Licensing Strategies to Maintain Value and Goodwill

June 1, 2016

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Thirty-Two Kilpatrick Townsend Attorneys Named 2016 Managing Intellectual Property IP Stars

May 26, 2016

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Internet of Things: Protecting and Profiting from Your Company's Knowledge Assets

February 25, 2016

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Kilpatrick Townsend Receives Top Recognition in 2016 World Trademark Review 1000

January 21, 2016

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Asset Review

November 10, 2015

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How Do I Know What My Company's IP is Worth?

October 22, 2015

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Kilpatrick Townsends Marc Lieberstein Wins Trademark Industry Award

October 19, 2015

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Wearables and the Internet of Things: Strategies for Protecting and Monetizing Your Data and Intellectual Property



October 8, 2015

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Kilpatrick Townsend Attorneys Named 2015 New York Super Lawyers

September 30, 2015

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Licensing Your Brand in China: Guidelines for Brand Owners

September 15, 2015

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Kilpatrick Townsend's Media Report September 4-10, 2015

September 11, 2015

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Court Watch: Potential Claims Under an FDD

September 8, 2015

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NLRB Issues Joint Employer Decision Potentially Affecting Franchisors

August 28, 2015

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Should U.S. Franchisors Be Worried about Implied Liability after The Dunkin' Donuts Decision in Québec?

August 1, 2015

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Licensing Your Brand in China: Guidelines for Brand Owners

June 29, 2015

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Twenty-Nine Kilpatrick Townsend Attorneys Named 2015 Managing Intellectual Property IP Stars

May 6, 2015

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The Wear of the Future: Where Fashion, Law, and Technology Collide
April 2, 2015

[Events](#)

Preparing for the Runway
March 19, 2015

[Events](#)

The Business of Fashion
March 5, 2015

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Kilpatrick Townsend Attorneys Honored by Her Justice 2015 Commitment to Justice Awards
February 9, 2015

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Kilpatrick Townsend Once Again Receives Top Recognition in 2015 World Trademark Review 1000
February 5, 2015

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Kilpatrick Townsends Marc Lieberstein Named 2015 Alumni of the Year By Cardozo Law School
January 20, 2015