

# Daily Journal

APRIL 17, 2013

## Intellectual Property 2013

One of the striking things about picking the list of top intellectual property attorneys, aside from the difficulty of choosing among hundreds of highly qualified nominees, is the diversity of their achievements. The litigators chosen travel the country to do battle for their clients.

While these attorneys' work has stretched worldwide, some of the biggest cases of the past year took place in California. To qualify for the list, an attorney must be based in California even if much of his or her work is done elsewhere, such as the U.S. International Trade Commission in Washington, D.C., the U.S. Patent and Trademark Office in Virginia, and district courts in Texas, Delaware, Illinois and elsewhere. And their focus must be on intellectual property, as opposed to general litigators who sometimes handle such work.

— The Editors

### Top 25 Portfolio Managers/ Patent Prosecutors

#### J. Alison Grabell

Ezra Brutzkus Gubner LLP | Woodland Hills

Trademark, copyright



**G**litz, glamour and geography. Those were the elements of an appeal made by Grabell to the U.S. Patent and Trademark Office.

Her client at the time, Topson Downs of California Inc., had filed an application to register the trademark "Tinseltown" at the patent office for a variety of clothing items.

But the office refused registration on the grounds that the mark was primarily geographically descriptive of the goods and therefore not "registrable," Grabell said. *In re Topson Downs of California Inc.*, Trademark Trial and Appeal Board, U.S. Patent and Trademark Office, 85067696.

"We sat here with our mouths hanging open," Grabell said. "Why is this primarily geographically descriptive? There is no geographical place called Tinseltown. It suggests the movie industry, glamour and glitz. We thought that it was a great mark for that purpose."

When she made no progress at the examiner level, Grabell worked her way up to the Trademark Trial and Appeal Board and scored for her client in January.

"I had to be careful not to offend anybody," she said. "That's where my diplomacy comes in. I pulled together my legal resources and common sense. It was an interesting challenge to pull this all together."

Since deference usually is given to the examiners, Grabell

added, "Winning on appeal was pretty good."

In another matter, her client, Jerry Leigh of California Inc., filed an application to register a trademark — "Hoodiebuddie" — for clothing items under a worldwide licensing program.

But the trademark office refused registration on the grounds of likelihood of confusion with a prior registered mark "Hoodies."

After investigating the use of that mark, Grabell filed a petition for cancellation of the registration on the grounds of non-use, later adding the grounds of genericness and fraud on the trademark office. *Jerry Leigh of California Inc. v. Ernest Walters III*, Cancellation No. 92051949 (Trademark Trial and Appeal Board, U.S. Patent and Trademark Office).

After three years of litigation, the appeals board entered default judgment and ordered the registration canceled in January. Accordingly, the examiner withdrew the refusal to register her client's mark.

"I get very wrapped up in the whole process," Grabell said. "It is not only a game of skill, but a game of art. I have a good linguistic and liberal arts background. Some people look at the numbers to get the whole story. I look at the words. It's a different side of the brain."

— Pat Broderick