

Karen Artz Ash

Partner and Co-Chair,
Trademark/Copyright/Advertising/Privacy Group

New York Office

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Practices

FOCUS: Intellectual Property

Advertising, Marketing and Promotions

Corporate

Intellectual Property Litigation

International

Trademark Licensing and Strategy

Trademarks and Trademark Litigation

Industries

Fashion

Private Client Services

Education

JD, New York Law School, *magna cum laude*

AB, Georgetown University

Bar Admissions

New York

Community Involvements

American Bar Association, Sections on Patent, Trademark and Copyright Law and Trial Law

American Bar Foundation, Fellow

Anti-Defamation League, New York Regional Board, the Lawyer's Committee, National Commission

International Trademark Association, Mediation/ADR Subcommittee

Licensing Journal, Editorial Board

National Association of Mediators

New York County Lawyers' Association

New York State Bar Association, Sections on Trial Law and Intellectual Property

From Paris runways to retail outlets across the US, Karen Artz Ash protects the intellectual property of major names in fashion. She provides comprehensive IP counsel to designers and clothing manufacturers as well as clients in other industries in which IP assets figure prominently. The institutional memory that she and her team have established with long-time clients and within the fashion industry as a whole allow her to provide practical and deeply informed advice across a wide range of issues.

Strategic IP counsel

Karen has a talent for helping clients make strategic decisions about IP assets that support their overall business goals. That includes, but goes beyond, basic issues like selecting, defending and enforcing IP rights. Karen often assists with corporate structuring issues, often rooted in tax analysis, for entities with IP assets that represent a large portion of their overall value. She also strategizes on re-brandings, negotiates commercial agreements involving IP rights and helps clients to incorporate protections for their IP into their business operations.

With the many international relationships in the fashion industry, Karen has developed significant experience in cross-border issues. Her team is known for its creative approach to those matters. Karen brings a background in economics and finance to her practice, and gained experience as a clerk in New York bankruptcy court that continues to benefit clients that have either gone through reorganizations or acquired assets from third parties in bankruptcy.

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New York Women's Bar Association

Southern District Court of New York,
Mediator Advisory Committee

Mediation Program, US District Court,
Southern District of New York, Panel

United States International Trademark
Association

Volunteers of Legal Service, President,
Board of Directors

Second Circuit Court of Appeals, CAMP
Mediation Program

New York Law School Advisory Council

Recognitions

Recognized or listed in the following:

- *ACQ Magazine*
 - Best Trademark Lawyer of the Year, 2013
- AV Preeminent Peer Review Rating by LexisNexis Martindale-Hubbell
- *Best Lawyers in America*
 - Trademark Law, 2015–2022
- BTI Client Service All-Star
 - 2019
- *Corporate INTL-US Legal Review*
 - 2010
- *Crain's New York Business*
 - Leading Women Lawyers in New York City, 2018
 - Notable Women in Law, 2020
- Elected Fellow of the American Bar Foundation
- Empire State Counsel®
 - Pro Bono Honoree, 2014, 2016–2018
- *Euromoney*
 - *Women in Business Law Expert Guide*
- *Forbes*
 - Best Lawyers in America, 2005
- Global IP Star
 - 2018
- *Lawyer Monthly*
 - Women in Law Award, 2014

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- *Managing Intellectual Property*
 - IP Star – Trademark, 2014–2021
 - Global Lifetime Achievement Award, 2019
 - Top 250 Women in IP, 2013–2014, 2018–2021
 - Top 10, 2013
- *National Law Journal*
 - Intellectual Property Trailblazer, 2016
 - Top Rated Lawyer, 2012–2015
- New York Law School Gala
 - 2018 Honoree
- *New York Magazine*
 - New York's Leading Lawyers, 2012–2018
 - Women Leaders in the Law, 2012–2019
- *Practical Law Company, Cross-Border IP in Business Transactions Handbook*
 - 2010–2011
- Super Lawyers
 - New York, 2010–2021
 - Top Women Lawyers – Intellectual Property, 2013–2018
- The Legal 500 United States
 - Recommended Attorney, 2013, 2015–2021
- *World Trademark Review 1000*
 - New York, 2010, 2012–2021
- *WTR Global Leaders*
 - United States: New York, 2020

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News

- Katten Attorneys Named 2021 New York Super Lawyers and Rising Stars Honorees (September 30, 2021)
- Katten Attorneys Listed in *The Best Lawyers in America*® (August 19, 2021)
- Katten Appoints New Practice Heads, Building on Stellar Leadership (July 15, 2021)
- Katten Ranked Best in Intellectual Property by Managing IP Stars 2021 (July 7, 2021)
- Katten Receives High Marks in Derivatives, M&A and Securitization in The Legal 500 United States 2021 Guide (June 10, 2021)
- Katten IP Practice Honored by *World Trademark Review 1000* (February 24, 2021)
- Katten Attorneys Chosen for New York Super Lawyers and Rising Stars Lists (October 28, 2020)
- Karen Artz Ash Talks to *Managing IP* About Impact of Ruth Bader Ginsburg's Legacy (September 24, 2020)
- Intellectual Property Co-Chairs Karen Artz Ash and Floyd Mandell Featured on List of Elite Trademark Attorneys Worldwide (September 17, 2020)
- Katten Attorneys Distinguished as Top Legal Talent in the 2021 *Best Lawyers in America* and *Best Lawyers: Ones to Watch* Lists (August 20, 2020)
- Katten Named Top-Tier Firm in Structured Finance and Securitization by The Legal 500 United States 2020 Guide (June 16, 2020)
- Katten Ranked Best in Intellectual Property by Managing IP Stars 2020 (May 1, 2020)

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- *World Trademark Review* Spotlights "Exceptional" Katten IP Partners (March 5, 2020)
- Three Katten Attorneys Named to Leading Women Lawyers List by *Crain's New York Business* (December 17, 2019)
- Katten Attorneys Nominated to 2019 New York Super Lawyers, Rising Stars Lists (September 12, 2019)
- Katten featured as recommended legal counsel for fashion companies in *Women's Wear Daily* (September 10, 2019)
- Katten Praised in The Legal 500 United States 2019 Guide (June 11, 2019)
- Katten Attorneys Recognized as 2019 Managing IP Stars (May 30, 2019)
- Karen Artz Ash Comments on Cases Fashion Attorneys are Watching (May 1, 2019)
- Katten's IP Practice Leader Honored with Lifetime Achievement Award (April 5, 2019)
- Katten Attorneys Recognized as Client Service All-Stars by BTI Consulting (April 4, 2019)
- Katten Praised by *World Trademark Review* (March 27, 2019)
- Katten Wins Dismissal of Opposition to Mansur Gavriel Trademark Registration Following TTAB Trial (October 1, 2018)
- Katten Attorneys Named to 2018 New York *Super Lawyers*, Rising Stars Lists (September 13, 2018)
- Katten Distinguished by *The Legal 500 United States* (June 14, 2018)
- Karen Artz Ash Named to *Managing Intellectual Property's* Top 250 Women in IP (April 26, 2018)
- Katten Prized as Top IP Firm by *World Trademark Review* (February 8, 2018)
- Karen Artz Ash and Allison Yacker Named to Leading Women Lawyers List by *Crain's New York Business* (December 18, 2017)

Karen Artz Ash

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- Katten Attorneys Acknowledged in 2017 New York Super Lawyers, Rising Stars Lists (September 20, 2017)
- Katten Distinguished by *The Legal 500 United States 2017* (May 31, 2017)
- Katten Recognized as Top IP Firm by *World Trademark Review* (January 20, 2017)
- Eighteen Katten Attorneys Distinguished in 2016 New York Metro *Super Lawyers* List (September 21, 2016)
- 79 Katten Attorneys Selected for *Best Lawyers in America*® 2017 (August 15, 2016)
- Karen Artz Ash Comments on Recent US International Trade Commission Ruling (June 27, 2016)
- Eighteen Katten Practices and 70 Attorneys Recognized by *The Legal 500 United States 2016* (June 17, 2016)
- Karen Artz Ash Named Intellectual Property Trailblazer by *The National Law Journal* (May 2016)
- Katten Recognized by *World Trademark Review 1000* for Exceptional Work in Trade Identity Protection (January 27, 2016)
- Twenty Katten Attorneys Recognized in 2015 New York Metro *Super Lawyers* List (September 16, 2015)
- Karen Artz Ash Quoted in Law360 Article on Sixth Circuit Decision Regarding Copyright Protection for Cheerleading Uniforms (August 21, 2015)
- 91 Katten Attorneys Recognized in *Best Lawyers in America*® 2016 (August 17, 2015)
- Nine Katten Practices and 42 Attorneys Distinguished by *The Legal 500 United States 2015* (June 3, 2015)
- Katten Attorneys Receive High Marks From *World Trademark Review 1000* (January 28, 2015)
- Eighteen Katten Attorneys Named to 2014 New York Metro *Super Lawyers* List (September 23, 2014)

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- Katten Attorneys Meredith Martin Addy, Karen Artz Ash and Kristin Achterhof Named to *Managing Intellectual Property's* "IP Stars - Top 250 Women in IP" (September 1, 2014)
- 85 Katten Attorneys Named to *Best Lawyers in America*® 2015 (August 18, 2014)
- Katten Obtains Permanent Injunction for Aéropostale in Settlement of Trademark Infringement Lawsuit (July 25, 2014)
- Partners Karen Artz Ash and Jan Tamulewicz Comment on Licensing Agreements in Law360 (June 3, 2014)
- 2014 *Managing Intellectual Property* IP Handbook Recognizes Intellectual Property Attorneys and Practice (May 13, 2014)
- Katten Attorneys Karen Artz Ash and Kristin Achterhof Named to *Managing Intellectual Property's* "IP Stars - Top 250 Women in IP" (October 13, 2013)
- Seventeen Katten Attorneys Named to 2013 New York Metro *Super Lawyers* List (September 18, 2013)
- Partner Karen Artz Ash Named to Inaugural Mediator Advisory Committee for the US District Court for the Southern District of New York (July 10, 2013)
- Katten Releases Memo on Child Model Legislation (June 27, 2013)
- Six Katten Practices and Twenty-Four Attorneys Distinguished by *The Legal 500 United States* 2013 (June 4, 2013)
- Katten's Intellectual Property Practice and Attorneys Recognized in *Managing Intellectual Property's* 2013 IP Handbook (May 15, 2013)
- Partner Karen Artz Ash Profiled in Law360 Q&A (May 3, 2013)
- Partner Karen Artz Ash Featured in *New York Magazine* 2013 Women in the Law (March 2013)
- Katten Attorneys Praised by *World Trademark Review 1000* (February 7, 2013)
- Partner Karen Artz Ash Profiled in *New York Law Journal* Q&A (November 16, 2012)

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- Katten Named Trademarks Law Firm of the Year (September 14, 2012)
- Katten Named Among World's Top Trademark Firms in *WTR 1000* (April 26, 2011)
- Partner Karen Artz Ash Recognized in 2010 Corporate INTL US Legal Review (August 2010)
- Katten Wins Victory for Clothing Retailer in Copyright Dispute (June 2010)
- Katten Pro Bono Client Wins Neighborhood Achievement Award (June 2010)
- Katten Wins Dismissal of Antitrust Suit on Behalf of Speedo (May 2010)
- Katten Receives Award for Commitment to *Pro Bono* Service (September 24, 2009)

Publications

- *The Katten Kattwalk* (Triannual) | *Author*
- Q&A With Karen Artz Ash (October 4, 2021)
- TTAB Affirms USPTO's Refusal of 'Deceptively Misdescriptive' Applications for the Word 'Clear' (May 13, 2021)
- Implementation of New Standard Contractual Clauses (February 10, 2021)
- Data Protection Representatives and NIS Representatives (January 28, 2021)
- Key Areas of Change to Data Protection Laws Post-Brexit (January 14, 2021)
- Post-Brexit UK Intellectual Property Protection (December 7, 2020)
- Top Five Tips for Brand Protection (November 18, 2020)
- Karen Artz Ash Talks to *Managing IP* About Being Mindful in Brand License Agreements (September 10, 2020)

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- TTAB Prohibits Trademark Registration With US Flag Design (August 17, 2020)
- Petition to Cancel on the Ground of Abandonment Fails despite Lack of Traditional Use (May 22, 2020)
- TTAB Enters Judgment Based on Finding of Willful Evasion (November 22, 2019)
- TTAB Expands Generic Inquiry to Product Packaging (October 28, 2019)
- New York District Court Issues Transformative Fair Use Decision (September 18, 2019)
- TTAB Affirms Trademark Refusal on Grounds of Failure to Designate Source (July 10, 2019)
- Supreme Court Holds Trademark License Not Terminated Upon Rejection in Bankruptcy (May 23, 2019)
- When is Attorney-Client Privilege Waived? (May 21, 2019)
- TTAB Continues to Rule on Genericness (April 19, 2019)
- TTAB Provides Guidelines on Acquiescence (April 4, 2019)
- Supreme Court Confirms Registration is Prerequisite to Claim for Infringement (March 7, 2019)
- TTAB Rules Sales to Single Customer Sufficient To Avoid Abandonment (February 22, 2019)
- TTAB Clarifies Requirements for Consent Agreements (January 23, 2019)
- Hashtags Do Not Prevent Likelihood of Confusion (December 17, 2018)
- TTAB Rules No Likelihood of Confusion Between Designer Surnames (November 2018)
- Generic Use Abroad Does Not Mean Generic Use in US (October 19, 2018)
- Court Allows Laches Defense in Cancellation Case (September 2018)
- The TTAB Addresses Issue Preclusion and *Ex Parte* Appeals (May 2018)
- Trade Mark Infringement Test for TV Show Titles (February 2018)

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- Disputes Between Departing Member and Remnant Group (October 2017)
- Debunking the Fashion Industry's "Three Change" Rule (August 28, 2017)
- Fee Shifting Applied in Trademark Dispute (May 2017)
- Hip, Hip, Hooray for Copyrightable Decorative Elements (March 23, 2017)
- Opposition Fails Due to Improper Trademark Assignment (April 2017)
- Use of Social Media in Likelihood of Confusion Analysis (March 2017)
- Extraterritorial Application of the Lanham Act (November 2016)
- Company Fights Back Against the USOC (October 2016)
- Proper Geographic Scope for Injunctive Relief (September 2016)
- TTAB Clarifies Allegation Time Period for Dilution Claims (June 2016)
- Cautions on Related Party Uses of Marks (May 2016)
- Launch of New Generic Top Level Domains *.store* and *.shopping* (April 26, 2016)
- TTAB Refuses Co-Existence Agreement (April 2016)
- Supreme Court to Review Fee Shifting in Copyright Cases (March 2016)
- Issue Preclusion Applied to Priority Dispute (February 2016)
- Registration Cancelled for *De Minimis* Use (December 2015)
- Design Marks: Comparing and Tacking (November 2015)
- The Licensing Law Update (2014–2016 Editions)
- TTAB Allows Only One Bite at the Apple (October 2015)
- Once Generic, Always Generic (September 2015)
- Appealing Refusals to Register Marks (July 2015)
- Laches Defense in a Cancellation Proceeding (June 2015)
- Apple-Samsung Trade Dress Case Demonstrates Potential Value of Design Patents (May 20, 2015)
- Undue Prejudice in an Acquiescence Defense (May 2015)

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- Is Offering of a Service Use of a Mark? (April 2015)
- Supreme Court Gives TTAB Decisions Preclusive Effect Over Federal Court Infringement Actions in Limited Circumstances (March 25, 2015)
- Court Expands Something More Standard (March 2015)
- Opportunistic Bad Faith in the UDRP (February 2015)
- False Origin Claims Applied to Services (December 2014 / January 2015)
- US Trademarks: Google Defeats Genericness Claim (November 2014)
- Third Circuit Rules on Awarding Attorneys' Fees (October 2014)
- Federal Circuit Rules on Trade Mark Pronunciation (September 2014)
- Seventh Circuit Rules on Trade Mark Abandonment (July / August 2014)
- Misrepresentation of Source Claims (June 2014)
- Narrowing Colour Claims (May 2014)
- Don't Delay Filing Intent-to-Use Applications (April 2014)
- TTAB Expands Protection for Famous Marks (March 2014)
- No Presumption of Irreparable Harm (February 2014)
- Fashion Law – A Guide for Designers, Fashion Executives and Attorneys (2014)
- PRL Challenges Intent-to-Use Application (December 2013 / January 2014)
- House Mark Distinguishes Secondary Mark (November 2013)
- Assigning Intent-to-Use-Based Applications (October 2013)
- New Rules on Use of Child Models (September 2013)
- Impact of TTAB Rulings on Court Decisions (July / August 2013)
- Costco Claims Tiffany Is Generic (June 2013)
- Questions Left Unanswered by *Louboutin* Case (May 2013)
- Anonymous Comments Allowed as Evidence of Confusion (April 2013)
- Protect Your Trademark Online: Global Trademark Clearinghouse to Begin Accepting Submissions (March 11, 2013)

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- Supreme Court Rules on Covenant Not to Sue (March 2013)
- The Territorial Extent of Trade Marks (December 2012 / January 2013)
- Becoming a Fashion Designer (2013)
- Issues Relating to Potential Licensor Liability for Defective or Dangerous Products (November / December 2012)
- Court Cases Highlight Product Liability for Licensors (November 2012)
- Court Ensures Trade Mark Protection for Fashion Colours (October 2012)
- New Treatment of Trade Mark Licenses in Bankruptcy (September 2012)
- The Use of Licensing Agents (September 2012)
- Bankruptcy in Fashion Licensing (August 2012)
- Trademark Licensee's Rights Survive Rejection of License in Bankruptcy in *Sunbeam* Decision (July 17, 2012)
- How to Petition for Special Treatment (July / August 2012)
- New Generic Top-Level Domain Names: What Brand Owners Need to Know (June 15, 2012)
- Deceptive Geographic Marks Clarified (June 2012)
- Risks of Guerilla Marketing at the Olympics (May 2012)
- Lessons for Managing a Brand License Agreement (May 2012)
- Trade Marking Linsanity (April 2012)
- Louboutin Claims Colour Exclusivity (March 2012)
- Beware Similar Marks on Related Goods (February 2012)
- Tips on Acceleration of Royalties Provisions (December 2011 / January 2012)
- Renewing Domain Names and the ACPA (November 2011)
- Dividing Trade Marks (July / August 2011)
- Reverse Confusion (May 2011)
- Rules on Gift Cards (April 2011)
- Domain Name Enforcement Broadened (March 2011)

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- How to Avoid Naked Licensing (February 2011)
- The Misconceptions About Incontestability (December 2010 / January 2011)
- UDRP Evidence Standards (November 2010)
- Extraterritorial Application of the Lanham Act (October 2010)
- Insurance Coverage for Infringement Claims (September 2010)
- Common Law Rights Can Outlast Registration (July / August 2010)
- Changes in Declaratory Judgment Standards (June 2010)
- Licence Agreements in Cross-Border Agreements (May 2010)
- Cautions on Consent to Registration Agreements (April 2010)
- Likelihood of Confusion for Alcoholic Beverage Marks (March 2010)
- Obtaining Registrations for Personal Names (February 2010)
- 2009 Year-End Intellectual Property Issues Advisory (December 2009)
- Co-Existence Agreements (December 2009 / January 2010)
- Effect of Corporate Name Registrations (November 2009)
- Changes to Fraud Analysis (October 2009)
- Registration on the Supplemental Register (September 2009)
- Settlement of Opposition Proceedings (July / August 2009)
- Intent-to-Use Requirements (June 2009)
- Licensing in the Credit Crunch (May 2009)
- Trade Mark Disclaimers (April 2009)
- Trade Mark Monitoring (March 2009)
- Excusable Neglect (February 2009)
- Deceptively Misdescriptive Geographic Marks (December 2008 / January 2009)
- Avoid Domain Name Scams (November 2008)
- Licence Agreement Representations (October 2008)

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- Protecting Certification Marks (September 2008)
- Avoiding Willful Infringement (July / August 2008)
- Using a Third Party's Trade Mark (June 2008)
- Claiming Trade Mark Rights in Particular Colours (May 2008)
- Environmentally Friendly Marketing Claims (April 2008)
- Enforcement Options for Foreign Marks (March 2008)
- Alternatives to Federal TM Filings (February 2008)
- Limitations on Governing Law Provisions (December 2007 / January 2008)
- Excusable Non-Use of a Trade Mark (November 2007)
- Use of Personal Names (October 2007)
- Infringement Risks and Related Goods (September 2007)
- Enforceability of Priority Filings (July / August 2007)
- Fraud Warnings (June 2007)
- Risks Arising from Phonetic Similarity (May 2007)
- Mediation of Trademark Disputes Has Advantages (April 23, 2007)
- The Importance of Trade Mark Clearance (April 2007)
- Cautions About Foreign Word Marks (March 2007)
- Keyword Advertising and Trade Mark Infringement (February 2007)
- What to Know About Geographic References (December 2006 / January 2007)
- Addressing Grey Market Sales into the US (November 2006)
- Gripe Sites and Fair Use (October 2006)
- Tips on Using Priority Foreign Filings (September 2006)
- Disputes in the Financial Service Industry (July / August 2006)
- Trade Mark Enforcement for Domain Names (June 2006)
- Expanding Well-Known Brands to the US (May 2006)

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- Domain Name Issues in License Agreements (April 2006)
- New Developments Concerning Trademark Licenses in Bankruptcy (March 2006)
- Defensive Ownership of Domain Names (February 2006)
- The Effect of "New Uses" on Copyright License Agreements (October 4, 2004)
- Anticipate New Technologies When Drafting Copyright Licenses (August 3, 2004)
- Reducing the Effects of Licensing Bankruptcy (July / August 2004)
- Madrid Protocol's Effect on Trademark Search Strategies (March 2004)
- Analysis and Perspective: Just Another Option Foreign Trademark Protection Following U.S. Membership in the Madrid Protocol (November 2003)
- Beware! Tricky Penalties for Illegal Software Copying (August 2001)
- Trademark License Agreement Lessons (July 2001)
- Pitfalls of Software Use (March / April 2001)
- The Commercial Valuation of Trademarks (March 1995)
- Trademark Ownership: Distributors Versus Manufacturers (June 2017)
- Fashion Law: A Guide for Designers, Fashion Executives, and Attorneys (March 2014)

Presentations and Events

- Success in Style (April 12, 2018) | *Moderator*
- Brands and Fashion Conference (March 22–23, 2017) | *Panelist* | *Advertising and Promotion in the 21st Century Global Marketplace*
- Fashion Licensing and Brand Protection (February 11, 2015) | *Panelist*

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- Book Signing and Launch Party for *Becoming a Fashion Designer* by Lisa Springsteel (May 7, 2013) | *Panelist*
- 34th Annual American Image Awards (May 7, 2012) | *Sponsor*
- 2012 Men's Wear Industry CEO Summit (March 29, 2012)
- WWD Apparel & Retail CEO Summit (November 14–15, 2011) | *Sponsor and Participant*
- 2011 Men's Wear Industry CEO Summit (March 29, 2011) | *Speaker*
- WWD Apparel/Retail CEO Summit (November 1–2, 2010) | *Sponsor*
- Effective Media Strategies for 2011 (October 14, 2010) | *Sponsor*
- Mastering Mobile Marketing (June 17, 2010) | *Sponsor*
- Advanced Licensing Agreements 2010 (March 25–26, 2010) | *Speaker* | *Treatment of IP Licenses in Bankruptcy*
- Fashionably Law: Fashion & the Law Firm (March 4, 2010) | *Speaker*
- WWD Apparel CEO Summit (November 9–10, 2009) | *Sponsor*
- WWD Branding Forum – Luxury Redefined (September 17, 2009) | *Sponsor*
- Gray Goods (November 16, 2006) | *Speaker*