

# Floyd A. Mandell

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

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## Practices

FOCUS: Intellectual Property Litigation  
Advertising, Marketing and Promotions  
Appeals and Critical Motions  
Electronic Discovery and Information Governance  
Intellectual Property  
International  
Litigation  
Trademark Licensing and Strategy  
Trademarks and Trademark Litigation

## Industries

Entertainment and Media  
Entertainment and Media Litigation  
Family Offices  
Fashion  
Health Care  
Hospitality  
Sports and Sports Facilities  
Technology

## Education

JD, University of Illinois College of Law  
BA, Northern Illinois University

## Bar Admissions

Illinois

Floyd Mandell is the founder of the firm's Intellectual Property department. He has represented some of the world's most recognizable companies in intellectual property litigation. Few other lawyers have handled as many high-profile cases over the past 20 years involving copyrights, trademarks, trade secrets, trade dress, false advertising and defamation. He has been lead counsel in more than 40 published decisions, many involving novel or cutting-edge issues. On more than one occasion, Floyd has litigated cases with more than \$1 billion at stake for his clients.

## Widely respected for bet-the-company IP litigation

Floyd has served as lead trial counsel for globally recognized brands in technology (Microsoft Corporation, Yahoo!, Intel, Panasonic, Sanyo, Stripe), food and beverage (PepsiCo/Gatorade, Boar's Head, Cracker Barrel, Planet Hollywood), retail and fashion (Forever 21, Arcadia Group Limited and its Topshop brand, Tommy Hilfiger, ASICS, Fruit of the Loom), media (Cumulus Media; Westwood One; Times Mirror, Inc.), entertainment (Universal Studios; Universal Music Group; Home Box Office, Inc.; E! Entertainment Television, LLC; Scripps Network), pharma and health care (Bausch & Lomb) and beyond.

Floyd's client relationships frequently span many years, and leading companies turn to him again and again for his business-focused guidance. They trust him with their most significant legal problems. Usually, these are disputes that threaten a famous brand, like the trademark action against PepsiCo over Gatorade's use of a slogan referring to it as "The Sports Fuel Company." Floyd earned a summary judgment victory for PepsiCo, which had been found liable for millions of dollars in a previous similar case. Similarly, Floyd secured a summary judgment victory for Microsoft, affirmed on appeal, involving a claimed infringement arising out of its X-Box product.

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## Community Involvements

American Bar Association, Intellectual Property and Litigation Sections  
Intellectual Property Law Association of Chicago  
International Trademark Association  
Patent Law Association of Chicago  
Panel of Neutrals for the US District Court for the Northern District of Illinois  
Panel of Trademark Mediators, Selection Committee

Floyd is consistently ranked among the top intellectual property litigators in the United States by Chambers USA, Legal 500, *Law360*, the *National Law Journal*, and other outlets. Recognized as a skilled mediator and arbitrator, he is a member of the Panel of Neutrals for the Alternative Dispute Resolution Program sponsored by the International Trademark Association. He is on the list of mediators/arbitrators recommended by the US District Court for the Northern District of Illinois for Lanham Act cases.

## Representative Experience

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**"Floyd is very reasonable, business-minded and has a reputation as a sophisticated IP litigator which precedes him when issues arise." "He's so great as a litigator, he wins all the time so you know your case is handled by one of the best."**

- *Chambers USA 2022 (Illinois, Intellectual Property: Trademark, Copyright & Trade Secrets) survey response*

- *SportFuel Inc. v. PepsiCo Inc., et al.*, No. 18-3010 (7th Cir. Aug. 2, 2019).
- *Adidas America, Inc., et al. v. Forever 21, Inc.*, 3:17-cv-00377 (C.D. Oregon, pending).
- *Toni Basil v. Disney, Kohl's, Forever 21*, 126 U.S.P.Q.2d 1046 (C.D. Cal. 2018).
- *Dermfx, Inc. v. Obagi Medical Products, Inc.*, 2017 WL 2684548 (C.D. Cal. 2017).
- *ABS Entertainment, Inc. v. Cumulus Media Inc., et al.*, 1:15-cv-06806 (S.D.N.Y. 2018).
- *Peter Ludlow v. Sun-Times Media LLC, et al.*, 14 L 1529 (Ill. App. Ct. 1st Dist. 2015).
- *E.G. Ground Management v. YCharts and Morningstar*, CV15-00055 (C.D. Cal. 2015), motion to dismiss granted.
- *Berkley Networks Corporation v. Inmarket Media, LLC, et al.*, 2014 WL 8332290 (S.D.N.Y. 2015).
- *Stuart J. Kaufman, M.D. & Associates, P.A. v. Bausch & Lomb Inc.*, WL 6154166 (M.D. Fla. 2013).
- *Braddock v. Angelina Jolie*, WL 2282219 (N.D. Ill. 2012).

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- *Kinbook, LLC v. Microsoft Corp.*, 866 F. Supp. 2d 453 & WL 246291 (E.D. Pa. 2012). *Kinbook, LLC v. Microsoft Corp.*, 490 F. App'x. 491 (C.A.3 (Pa.) 2013). AFFIRMED.
- *Arcadia Group Brands Ltd. v. Studio Moderna SA*, WL 3584469 (N.D. Ill. 2011).
- *E! Entertainment Television, Inc. v. Entertainment One GP Ltd.*, 363 F. App'x. 510 (C.A.9 (Cal.) 2010).
- *Roxbury Entertainment v. Penthouse Media Group, Inc.*, 669 F. Supp. 2d 1170 (C.D. Cal. 2009).
- *Karl Storz GMBH & Co. KG v. Bausch & Lomb Inc.*, 345 F. App'x. 579 (C.A.Fed. 2009).
- *GTFM, LLC v. Universal Studios, Inc.*, WL 1377048 (S.D.N.Y. 2006).
- *In re Aimster Copyright Litigation*, 334 F.3d 643 (C.A.7 (Ill.) 2003).
- *Agave Loco LLC v. Sazerac North America, Inc., et al.*, 107 U.S.P.Q.2d 1270 (N.D. Ill. 2013).
- *Microsoft Corporation v. Community Health Systems, Inc.*, 3:18-cv-00291 (D. Tenn. 2018).
- *Planet Hollywood v. Hollywood Casino*, 80 F. Supp. 2d 815 (N.D. Ill. 1999).

## Recognitions

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*Recognized or listed in the following:*

- AV Preeminent Peer Review Rating by LexisNexis Martindale-Hubbell
- *Best Lawyers in America*
  - Litigation - Intellectual Property | Trademark Law, 2010–2023
  - Lawyer of the Year
    - Trademark Law, Chicago, 2021

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- Best of the Best USA Expert Guide
  - Top 30 Trade Mark Practitioners in the USA, 2019
- *Chambers USA*
  - Intellectual Property, 2005–2020
  - Intellectual Property: Trademark, Copyright & Trade Secrets, 2021–2022
- *Intellectual Asset Management*
  - IAM Strategy 250, 2009–2011
  - IAM Strategy 300, 2012–2014
- International Law Office
  - Client Choice Award
    - Intellectual Property Law, 2011
    - Intellectual Property: Trademarks - Illinois, 2016
- Katten Muchin Rosenman LLP Pro Bono Service Award
  - 2014
- *Law360*
  - MVP - Intellectual Property, 2012, 2019
  - 10 Most Admired Intellectual Property Attorneys, 2010
- *Lawdragon*
  - Lawdragon 500, 2010-2013
- *Leading Lawyers Network*
- Legal Media Group
  - Guide to the World's Leading Trademark Practitioners
- *Managing Intellectual Property*
  - IP Star – Trademark, 2013–2022
  - Litigator of the Year, Illinois – Finalist, 2022

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- *National Law Journal*
  - Top 50 Intellectual Property Trailblazers & Pioneers, 2014
- *Super Lawyers*
  - Illinois, 2005–2022
- *The Legal 500 United States*
  - Recommended Attorney, 2012–2022
- Thomson Reuters
  - Stand-out Lawyer, 2022
- *Who's Who Legal*
  - Trademarks, 2013–2017
- *World Intellectual Property Review*
  - WIPR Leaders, 2017–2018
- *World Trademark Review 1000*
  - National, 2011–2022
  - Illinois, 2011–2022
- *WTR Global Leaders*
  - United States: Illinois, 2020
- *Global IP Star*
  - 2018

## News

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- Katten Attorneys Recognized by *Best Lawyers*® (August 18, 2022)
- Katten Awarded Top Ranking in Structured Finance: Securitization in *The Legal 500 United States 2022* (June 8, 2022)
- Katten Ranked Leading Law Firm by *Chambers USA 2022* (June 1, 2022)

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- *Managing Intellectual Property* Recognizes Seven Katten Attorneys as 2022 IP Stars (May 27, 2022)
- Katten IP Partners Receive Accolades in *World Trademark Review 1000* (May 23, 2022)
- Katten Attorneys Named to 2022 Illinois Super Lawyers, Rising Stars Lists (January 28, 2022)
- 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 Boosts Rankings in *Chambers USA 2021* (May 20, 2021)
- Katten IP Practice Honored by *World Trademark Review 1000* (February 24, 2021)
- Katten Attorneys Chosen for 2021 Illinois Super Lawyers, Rising Stars Lists (January 29, 2021)
- 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)
- Katten Rated Top Law Firm by *Chambers USA 2020* (April 23, 2020)

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- *World Trademark Review* Spotlights "Exceptional" Katten IP Partners (March 5, 2020)
- Katten Attorneys Selected to 2020 Illinois Super Lawyers, Rising Stars Lists (January 29, 2020)
- Significant trademark win by Floyd Mandell and Julia Mazur ranked among Top 10 Trademark Rulings of 2019 (December 31, 2019)
- Floyd Mandell Named *Law360* 2019 Intellectual Property MVP (November 14, 2019)
- Seventh Circuit Affirms Trademark Win for Katten's Client Pepsi, Gatorade (September 13, 2019)
- Katten Praised in The Legal 500 United States 2019 Guide (June 11, 2019)
- Katten Lauded Top Ranked Law Firm by *Chambers USA* 2019 (April 25, 2019)
- Katten Praised by *World Trademark Review* (March 27, 2019)
- Super Lawyers Lists Honor More Than 50 Katten Attorneys in Illinois (January 24, 2019)
- Katten Distinguished by *The Legal 500 United States* (June 14, 2018)
- Katten Successfully Represents Pepsi, Gatorade in Trademark Row (June 14, 2018)
- Katten Rated as Leading Law Firm by *Chambers USA* 2018 (May 3, 2018)
- Katten IP Team Wins "Mickey" Trademark Infringement Case (February 15, 2018)
- Katten Prized as Top IP Firm by World Trademark Review (February 8, 2018)
- Katten Attorneys Recognized in 2018 Illinois Super Lawyers, Rising Stars Lists (January 25, 2018)
- Chicago Team Achieves Favorable Settlements in Two Federal Civil Rights Cases (December 8, 2017)

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- Katten Selected as the "Go-To" Firm for Sports Law in Chicago (July 27, 2017)
- Katten Distinguished by *The Legal 500 United States 2017* (May 31, 2017)
- Katten Recognized as Leading Law Firm by *Chambers USA 2017* (May 30, 2017)
- Katten Recognized as Top IP Firm by *World Trademark Review* (January 20, 2017)
- Katten Attorneys Recognized in 2017 Illinois *Super Lawyers*, Rising Stars Lists (January 13, 2017)
- 79 Katten Attorneys Selected for *Best Lawyers in America*® 2017 (August 15, 2016)
- Eighteen Katten Practices and 70 Attorneys Recognized by *The Legal 500 United States 2016* (June 17, 2016)
- *Chambers USA 2016* Distinguishes 22 Katten Practices and 50 Attorneys (May 27, 2016)
- Katten Attorneys Ronni Davidowitz, Guy Dempsey, Christina Hassan and Floyd Mandell Receive 2016 Client Choice Awards (February 17, 2016)
- Katten Recognized by *World Trademark Review 1000* for Exceptional Work in Trade Identity Protection (January 27, 2016)
- Forty-Seven Katten Attorneys Recognized in 2016 Illinois *Super Lawyers* List (January 8, 2016)
- Katten Represents Cumulus Media in Win Over Class Claims Regarding Pre-1972 Royalties (December 2, 2015)
- Floyd Mandell Discusses "Orphan Works" and Copyright Law for Law360 (October 1, 2015)
- Floyd Mandell Provides Tips on Avoiding Intellectual Property Litigation Landmines (September 14, 2015)
- 91 Katten Attorneys Recognized in *Best Lawyers in America*® 2016 (August 17, 2015)



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- Floyd Mandell Comments on Comparison of Recent Trademark Decision to License Plates (July 20, 2015)
- IP Law360 Voices of the Bar Panelist Floyd Mandell Discusses Supreme Court's Decision Not to Review *Google v. Oracle* (July 2, 2015)
- Floyd Mandell Quoted in *World Intellectual Property Review* Article on New Spike Lee Trademark Claim (June 9, 2015)
- Nine Katten Practices and 42 Attorneys Distinguished by *The Legal 500 United States* 2015 (June 3, 2015)
- Katten Attains 22 Practice and 58 Attorney Rankings by *Chambers USA* 2015 (May 20, 2015)
- Katten Secures Motion to Dismiss for YCharts in California District Court Case (May 19, 2015)
- Katten Successfully Represents Cumulus Media in Illinois Appellate Court Defamation Case (April 21, 2015)
- Katten Attorneys Receive High Marks From *World Trademark Review 1000* (January 28, 2015)
- Fifty-Three Katten Attorneys Recognized in 2015 Illinois *Super Lawyers* List (January 12, 2015)
- Katten Represents InMarket Media in Successfully Blocking Injunction Bid (January 5, 2015)
- Partner Floyd Mandell Quoted in Law 360 Article About Tech Cases to Watch in 2015 (January 2, 2015)
- Katten Represents HBO Films in Intellectual Property Settlement (December 31, 2014)
- Partner Floyd Mandell Named One of the Top "50 Intellectual Property Trailblazers & Pioneers" by *The National Law Journal* (October 29, 2014)
- 85 Katten Attorneys Named to *Best Lawyers in America*® 2015 (August 18, 2014)
- Katten Recognizes Twelve Attorneys With Pro Bono Service Awards (July 25, 2014)

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- Katten Obtains Permanent Injunction for Aéropostale in Settlement of Trademark Infringement Lawsuit (July 25, 2014)
- Katten Obtains Dismissal for Cumulus Broadcasting in Defamation Suit (July 21, 2014)
- Eight Katten Practices and Forty-Two Attorneys Recognized by *The Legal 500 United States* 2014 (July 3, 2014)
- *Chambers USA* 2014 Distinguishes 24 Katten Practices and 54 Attorneys (May 23, 2014)
- Floyd Mandell, Co-Head of the Trademarks and Trademark Litigation Practice, Offers Tips for Trademark Injunctions in Law360 (May 13, 2014)
- 2014 *Managing Intellectual Property* IP Handbook Recognizes Intellectual Property Attorneys and Practice (May 13, 2014)
- Fifty-Four Katten Attorneys Recognized in 2014 Illinois *Super Lawyers* List (January 13, 2014)
- Floyd Mandell, National Co-Head of the Intellectual Property Practice, Discusses Upcoming Technology Cases with Law360 (January 2, 2014)
- Katten's Representation of Agave Loco Highlighted in Law360 Article (October 2, 2013)
- Katten's Representation of Scripps in *Food Fanatics* Suit Noted in Law360 (September 11, 2013)
- Katten's Representation of Bausch & Lomb in District Court Noted in Law360 (September 5, 2013)
- 83 Katten Attorneys Lauded in *Best Lawyers in America*® 2014 (August 15, 2013)
- Katten Obtains Favorable Decision for Bausch & Lomb in Trademark Infringement Suit (July 29, 2013)
- Six Katten Practices and Twenty-Four Attorneys Distinguished by *The Legal 500 United States* 2013 (June 4, 2013)
- *Chambers USA* 2013 Recognizes 24 Katten Practices and 49 Attorneys (May 24, 2013)

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- Katten's Intellectual Property Practice and Attorneys Recognized in *Managing Intellectual Property's* 2013 IP Handbook (May 15, 2013)
- Katten Representation of Bausch & Lomb in Trademark Infringement Suit Noted in Law360 (April 9, 2013)
- Katten Nominated for Two *Managing IP* North America Awards (March 20, 2013)
- Katten Attorneys Praised by *World Trademark Review 1000* (February 7, 2013)
- Partner Floyd Mandell Named to 2012 Lawdragon 500 (January 31, 2013)
- Third Circuit Affirms Katten's District Court Victory for Microsoft in Kinect Trademark Suit (January 14, 2013)
- Sixty-Nine Katten Attorneys Included on 2013 Illinois *Super Lawyers* List (January 4, 2013)
- Katten Attorneys Quoted in *Chicago Daily Law Bulletin* Article on RumChata Trademark Suit (January 2, 2013)
- Katten Attorney Floyd Mandell Named Law360 MVP for Intellectual Property (December 4, 2012)
- Katten Named Trademarks Law Firm of the Year (September 14, 2012)
- 80 Katten Attorneys Named to *Best Lawyers in America*® 2013 Guide (August 24, 2012)
- Katten Attorneys Mentioned in *Crain's* Story on Angelina Jolie Copyright Dispute (June 28, 2012)
- *Chambers USA* 2012 Distinguishes 19 Katten Practices and 45 Attorneys (June 7, 2012)
- Partner Floyd Mandell Quoted in *Managing IP* on the Upsides of Mediation in Trademark Disputes (April 2, 2012)
- Eighty-Six Katten Attorneys Named 2012 Illinois Super Lawyers (February 28, 2012)

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- Katten Case Win Featured in Bloomberg BNA's *Patent, Trademark & Copyright Journal* (February 10, 2012)
- Katten Earns Summary Judgment for Microsoft in Kinect Trademark Litigation (January 26, 2012)
- 75 Katten Attorneys Named to *Best Lawyers in America*® 2012 Guide (September 12, 2011)
- Katten Named 2011 Midwest Copyright Firm of the Year by *Managing Intellectual Property* (July 8, 2011)
- Partner Floyd Mandell Named Top Intellectual Property Strategist for Third Consecutive Year (June 2011)
- Katten Earns Recognition for 17 Practices and 44 Attorneys in 2011 *Chambers USA* Guide (June 10, 2011)
- Katten Named Among World's Top Trademark Firms in *WTR 1000* (April 26, 2011)
- Partner Floyd Mandell Receives 2011 ILO Client Choice Award for Intellectual Property (March 2011)
- Partner Floyd Mandell Co-Authors Book Chapter on Trademarks (October 2010)
- Floyd Mandell Named Among Most Admired Intellectual Property Attorneys (September 1, 2010)
- 70 Katten Attorneys Named to *Best Lawyers in America*® 2011 (August 9, 2010)
- Katten Named "Firm of the Year" for Copyright Law by *Managing Intellectual Property* (July 14, 2010)
- Katten Lands 16 Practices and 39 Attorneys in *Chambers USA* Guide (June 24, 2010)
- Katten's Floyd Mandell Named among World's Leading Intellectual Property Strategists by IAM for Second Consecutive Year (June 21, 2010)
- 12 Katten Partners Named Among Nation's Leading Lawyers by Lawdragon (May 19, 2010)

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- Partner Floyd Mandell Co-Authors Book Chapter on Trademarks (2010)
- 66 Katten Attorneys Named to 2010 List of *Best Lawyers in America*® (August 5, 2009)
- Katten Lands 14 Practices and 37 Attorneys in *Chambers USA* Guide (June 12, 2009)
- Katten's Floyd Mandell Named Among World's Leading Intellectual Property Strategists by IAM (April 1, 2009)
- Partner Floyd Mandell Talks With *Chicago Lawyer* (November 3, 2008)
- Partner Floyd Mandell Quoted in Law360 on IP Strength (October 31, 2008)
- Katten's Floyd Mandell Named Among Top 500 Lawyers in America by Lawdragon (October 22, 2008)
- Katten Lands 14 Practices and 32 Attorneys in *Chambers USA* Guide (June 13, 2008)
- Katten Lands 15 Practices and 28 Attorneys in *Chambers USA* Guide (June 15, 2007)
- Partner Floyd Mandell Quoted in the *Chicago Tribune* about Online User Reviews of Businesses (February 23, 2007)
- Partner Floyd Mandell Quoted in *Chicago Tribune* on Online User Reviews (February 21, 2007)
- Katten Attorneys Get Class Action Lawsuit Against Zango Dismissed, With Prejudice (September 7, 2006)
- Katten Lands 12 Practices and 24 Attorneys in *Chambers USA* Guide (June 7, 2006)
- Universal Wins Movie Parody Trademark Case (May 22, 2006)
- Partner Floyd Mandell Interviewed Regarding Katten's Role in Defense of Universal Studios and Universal Music (May 22, 2006)
- Intellectual Property Practice Co-Chair Floyd Mandell Quoted in Law360's Practice Profile (March 31, 2006)

# Floyd A. Mandell

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## Publications

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- *The Katten Kattwalk* (Triannual) | Contributor
- Supreme Court Confirms Registration is Prerequisite to Claim for Infringement (March 7, 2019)
- Hip, Hip, Hooray for Copyrightable Decorative Elements (March 23, 2017)
- Apple-Samsung Trade Dress Case Demonstrates Potential Value of Design Patents (May 20, 2015)
- Supreme Court Gives TTAB Decisions Preclusive Effect Over Federal Court Infringement Actions in Limited Circumstances (March 25, 2015)
- Trends in David-Vs.-Goliath Trademark Cases in 2013 (December 12, 2013)
- The Use of Early Mediation Strategies in Lanham Act Disputes (December 2013)
- Successful Partnering Between Inside and Outside Counsel: Trademark Protection Program (October 2013)
- New Generic Top-Level Domain Names: What Brand Owners Need to Know (June 15, 2012)
- 2009 Year-End Intellectual Property Issues Advisory (December 2009)
- Mediation of Trademark Disputes Has Advantages (April 23, 2007)

## Presentations and Events

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- International Trademark Association Annual Meeting (May 2–6, 2015) | Moderator | *Secrets for Success in Mediating Lanham Act Cases*
- 2014 ABA Business Law Section Annual Meeting (September 12, 2014) | Panelist | *Cutting Edge Issues in Intellectual Property Litigation*

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- International Trademark Association 136th Annual Meeting (May 10–14, 2014) | *Panelist | The Shape of Things to Come: Clearing and Protecting High-Tech Product Configurations*
- Taking Control of Your Career (March 31, 2010) | *Presenter*
- Successful Partnering Between Inside and Outside Counsel: 10 Commandments to Successful Partnering Relationship (April 12, 2007) | *Presenter*
- Gray Goods (November 16, 2006) | *Speaker*