Sheldon H. Klein

Senior Counsel | sheldon.klein@lathropgpm.com

WASHINGTON, D.C.
600 New Hampshire Avenue, NW
The Watergate - Suite 700
Washington, DC 20037

T: 202.295.2215
F: 202.295.2265

Assistant
Angelina Mejia
202.295.2211
Email

PRACTICE AREAS

Copyrights

Intellectual Property

Trademarks

Intellectual Property Litigation

Licensing, Technology Transfer & Commercialization

Litigation

Intellectual Property & Technology

INDUSTRIES

Technology

Restaurant, Food & Beverage

Wholesale & Retail Distribution

Health Care

COURT MEMBERSHIPS

- District of Columbia

Sheldon Klein represents clients in the areas of trademark, copyright, unfair competition, advertising and social media, handling matters involving intellectual property (IP) availability and infringement opinions, portfolio management, litigation, licensing and transactions.

Sheldon handles a wide range of IP issues. He conducts IP audits and due diligence investigations and drafts IP licenses and other agreements. He also enforces IP rights via negotiation, litigation, and opposition and cancellation proceedings before the U.S. Patent and Trademark Office's Trademark Trial and Appeal Board and foreign trademark offices.

Clients highly value the depth and breadth of Sheldon's intellectual property experience and knowledge. He has taught IP law at George Washington University, and chairs an annual seminar/webinar on advanced trademark law for the Practising Law Institute. He regularly writes about current issues and presents on IP law topics nationally and internationally.

Sheldon served as President of the American Intellectual Property Law Association (AIPLA), www.aipla.org, and of the U.S. section of the International Association for the Protection of Intellectual Property (AIPPI-US) for the 2018-19 term, and continues to serve on the AIPLA Executive Committee. Sheldon is a longtime, active member of AIPLA and has held a number of leadership roles of this premier intellectual property law association that serves members throughout the nation and the world.

- Maryland
- U.S. District Court for the District of Columbia
- U.S. District Court for the District of Maryland
- U.S. Court of Appeals Federal Circuit
- U.S. Court of Appeals District of Columbia
- U.S. Court of Appeals District of Columbia Fourth Circuit
- U.S. Court of Appeals District of Columbia Sixth Circuit
- U.S. Court of Appeals District of Columbia Ninth Circuit
- U.S. Supreme Court

EDUCATION

George Washington University, J.D., with honors

University of Michigan, B.A., with high distinction

Representative Experience

- Obtained preliminary injunction against infringer of a well-known service mark in the political consulting and polling field.
- Successfully defended Canadian exporter accused of trademark infringement; magistrate judge recommended dismissal for lack of jurisdiction; complaint dismissed with prejudice by plaintiff.
- Obtained declaratory judgment of trademark non-infringement on behalf of a major Washington-based trade association after a threat by a key competitor just prior to launch of a major rebranding effort.
- Obtained relief for a major U.S. furniture manufacturer from rampant imports of counterfeit goods via litigation, U.S. Customs seizure/destruction of goods at their port of entry and at retail locations in multiple states, and seizure/destruction of goods at their point of manufacture in Taiwan.
- Obtained summary judgment, upheld on appeal (Ninth Circuit), against terminated franchisee who continued to use part of a famous international franchisor's trademark.
- Obtained relief from multiple copyright infringements for the creator of a famous graphic work via litigation, and for the owner of a famous sculptural work via negotiation.
- Obtained relief for operator of popular social network/e-commerce website from multiple clone sites via cease and desist letters and DMCA takedown notices.
- Advised offshore operator of auction websites on trademark, copyright, and content issues.
- Handled multiple deceptive advertising cases on behalf of a major U.S. telecommunications company and a multinational medical device manufacturer in arbitration before the National Advertising Division of the Council of Better Business Bureaus.
- Conducted copyright audit for a famous U.S. author.
- Served as expert trademark witness in arbitration involving competing successor nonprofit organizations.
- Resolved a longstanding trademark dispute among two major nonprofit organizations via a creative licensing agreement.
- Manages international trademark portfolios for clients in a variety of industries.

Events

- Advanced Trademark Law 2024: Current Issues | Practising Law Institute
  March 6, 2024
- The Supreme Court Trademark-Bankruptcy Ruling's Impact on Franchisors
  July 11, 2019

Presentations

- Seminar Chairperson and Opening Remarks, "Advanced Trademark Law: 2024 - Current Issues," Practising Law Institute (PLI) Seminar, March 6, 2024
- Co-Presenter, "New Clarity at the Intersection of Trademark and Bankruptcy Law," Practising Law Institute (PLI) Seminar, March 11, 2020
- Onstage Interview with Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (USPTO), Andrei Iancu, and overall MC, at the Annual Meeting of the American Intellectual Property Law Association, October 25-27, 2019
- Testimony on Proposed Changes to Trademark Fees before the Quarterly Meeting of the Trademark Public Advisory Committee of the United States Patent and Trademark Office, September 23, 2019
- "Trademarks in a Rush," 20th Annual Congress of ASIPI, the Inter-American Intellectual Property Association, Rio de Janeiro, Brazil, November 26, 2018
- "Recent Developments in U.S. IP Law," The 3rd International AIPPI Convention on The Economy of Innovation, Tel-Aviv, Israel, May 1, 2018
- "AIPLA Webinar: Debriefing the Supreme Court's Tam Decision," August 2, 2017
- "Advanced Trademark Law," Practising Law Institute Seminar, Co-Chair, 2007-2018
- "Protecting Trademarks in the New gTLDs," MultiLaw Joint Practice Groups Meeting, Hong Kong, May 11, 2014
- "Trademark Boot Camp," AIPLA, 2009, 2010, 2012, 2013
- "Hot IP Topics for High Tech Companies and their Investors," AIPLA Mid-Winter Institute, January 2013

- "Proposed Changes in Section 8 Timing," 23rd Annual Intellectual Property Owners Conference on USPTO Law and Practice, December 2012
- "Rosetta Stone, Inc. v. Google, Inc.: Unlocking the Fourth Circuit's Keyword Advertising Decision and Previewing Its Consequences," ABA Webinar, June 14, 2012
- "Is the N.A.D. the Right Forum for You?" AIPLA Webinar, 2010
- "Legal Considerations in Selecting, Protecting, & Using Brand Names," BrightTALK Live and On Demand Webinar, www.brighttalk.com, 2010
- "Trademark Declaratory Judgment Actions—Using the Bazooka While Avoiding the Landmines," Practising Law Institute, 2010
- "Understanding Trademark Law," Practising Law Institute, 1995-2009
- "Arguing Advertising Disputes Before the N.A.D.," AIPLA Spring Meeting, 2009
- "Hot ICANN/Domain Name/Trademark Topics," Intellectual Property Law Association of Florida, 2008
- "Viacom Intl., Inc. v. YouTube, Inc.," C-SPAN interview on The Communicators, 2007
- "Keyword Triggered Advertising/Sponsored Links," INTA Annual Meeting, 2007
- "Hot Internet Trademark Topics," INTA Annual Meeting, 2006
- "Potential Trademark Conflicts Arising from Aggressive Internet Marketing," AIPLA Mid-Winter Institute, 2005
- "Trademarks and Keywords, and Other Hot Internet/Trademark Topics," AIPPI Israel Chapter, 2004
- "Opposition and Cancellation Actions/TTAB Practice," INTA Trademark Administrator's Conference, 2003
- "U.S. Discovery Tools," INTA Annual Meeting, 2002
- "Trademarks and the Internet: Recent Developments," Michigan State Bar IP Law Section Annual Meeting, 2001
- "Music on the Internet," Practising Law Institute, 2001
- "The Digital Millennium Copyright Act," Intellectual Property Institute of Canada Annual Meeting, 2000
- "Advanced Practice Before the Trademark Trial and Appeal Board," INTA, 1995, 1997, 1999

- "Trade Dress Protection," AIPLA Spring Meeting, 1995

Publications

- "BLACK LIVES MATTER: Name Confusion and the Importance of Trademark Law," co-author, CEO World, July 1, 2020
- "U.S. Department of Commerce Announces Intent to Transition Key Internet Domain Name Functions," co-author, INTABulletin, May 2014
- "Case Study: Rosetta Stone v. Google," Law360, May 22, 2012
- "A Key Victory for Keyword Advertising Programs: The Ninth Circuit's Decision in Network Automation, Inc. v. Advanced Systems Concepts, Inc." co-author, IPLaw360, March 17, 2011
- "U.S. Courts Continue to Differ on the Issue of 'Use' in the Context of Search Engine Keyword-Triggered Advertising," co-author, Trademark World, December 2007
- "Use of Trademarks in Keyword-Triggered Search Engine Advertising: A Hot Topic in Internet Law," co-author, Metropolitan Corporate Counsel, May 1, 2005
- "The Role of Trade Mark Use in U.S. Infringement, Unfair Competition, and Dilution Proceedings," chapter co-author, Trade Mark Use, Oxford University Press, January 2005
- "Practice Pointers Protecting Company and Trademark Nicknames," co-author, The Intellectual Property Strategist, June 2002

Client Alerts And Blog Posts

- Trademark Modernization Act of 2020
  December 23, 2020
- Supreme Court: Booking.com and Other Domain Names Combining a Generic Term with ".com" Can Be Registered and Protected as Trademarks
  June 30, 2020
- IP Alert: USPTO Implements Masking of Email Addresses of Trademark Owners Who Are Represented by Outside Counsel
  April 28, 2020
- IP Alert: New USPTO Requirements Mandate a Valid Direct Owner Email Address; Privacy Concerns Raised
  February 12, 2020
- IP Alert: Supreme Court Copyright Decisions Confirm That Early Registration Is Crucial
  March 5, 2019

- IP Update: The Latest on Famous and Scandalous Trademarks
  January 17, 2019
- IP Alert: ICANN WHOIS Privacy Updates Change the Process for Locating Infringing Domain Owners
  July 9, 2018
- FTC Ruling Problematic for Brand Owners
  November 2, 2017
- IP Alert: New Procedure for Electronic Registration of DMCA “Safe Harbor” Agents Goes Live December 1; Companies Have 13 Months to Comply
  December 1, 2016
- Analysis: The Supreme Court’s B&B Hardware Decision Could Have a Significant Impact on Trademark Infringement Disputes
  April 16, 2015
- IP Alert: Brand Owners Must Consider Whether to Pay Hefty Fees to Preempt Gripers and Extortionists from Registering YOURBRAND.SUCKS
  March 20, 2015
- Advertising and Food Alert: The Food, Drug, and Cosmetic Act Does Not Shelter a Beverage Company from Claims of Deceptive and Misleading Food and Beverage Labeling and Advertising
  June 19, 2014
- IP Alert: Patent Litigation Reform - The Innovation Act
  December 10, 2013
- Client Alert: Trademark Clearinghouse Registrations
  April 11, 2013
- IP Alert: What Trademark Owners Need to Know About the New Internet Generic Top-Level Domains (gTLDs)
  June 27, 2012
- IP Alert - Protect Your Brand From Potential Harm In The ".XXX" Domain Name Space
  September 26, 2011

In The News

- Law360 Article Quotes Sheldon Klein on Rising Trademark Fees
  November 17, 2020
- CEO World Features Article Co-Authored by Sheldon Klein on the Importance of Trademarking High-Profile Names
  July 1, 2020

- "Will Tom Brady Win the 'Tom Terrific' Trademark? Here's What Legal Experts Think," The Boston Globe
  June 5, 2019
- Featured as Partner and AIPLA President on Executive Leaders Radio Program with American Radio at 43:40
  March 10, 2019
- "Firms Wonder Whether to Bite Bullet and Buy .sucks," MPR News
  April 3, 2015

News Releases

- Lathrop GPM and Six Intellectual Property Attorneys Earn World Leading Trademark Honors
  February 22, 2024
- Lathrop GPM's Sheldon Klein to Moderate AIPLA Panel
  October 18, 2023
- Washington, D.C. Super Lawyers Recognizes 4 Lathrop GPM Attorneys
  May 2023
- Lathrop GPM and Nine Intellectual Property Attorneys Earn World Leading Trademark Honors
  February 14, 2023
- Win For Lathrop GPM Client Bach to Rock Is Like Music To Their Ears
  August 17, 2022
- Five Attorneys Named 2022 Washington, D.C. Super Lawyers and Rising Stars
  May 3, 2022
- Lathrop GPM and Six Intellectual Property Attorneys Earn World Leading Trademark Honors
  March 16, 2022
- Five Attorneys Named 2021 Washington, D.C. Super Lawyers and Rising Stars
  April 27, 2021
- Lathrop GPM and Six Intellectual Property Attorneys Earn World Leading Trademark Honors
  February 18, 2021
- Eight Attorneys Named 2020 Washington, D.C. Super Lawyers and Rising Stars
  June 10, 2020

- Firm and Five Attorneys Earn World Leading Trademark Honors
  February 17, 2020
- 11 Gray Plant Mooty Attorneys Named 2019 Washington, D.C. Super Lawyers and Rising Stars
  April 19, 2019
- Firm and Five Attorneys Named World Leading Trademark Professionals
  February 6, 2019
- Sheldon Klein Becomes President of AIPLA
  October 29, 2018
- 11 Gray Plant Mooty Attorneys Named 2018 Washington, D.C. Super Lawyers and Rising Stars
  April 23, 2018
- Five Gray Plant Mooty Attorneys Named World Leading Trademark Professionals
  February 7, 2018
- 11 Gray Plant Mooty Lawyers Named 2017 Washington, D.C. Super Lawyers and Rising Stars
  April 24, 2017
- Four Gray Plant Mooty Attorneys Ranked as Top Trademark Professionals in 2017 Edition of WTR 1000
  January 23, 2017
- Sheldon Klein Named to AIPLA Board of Directors
  November 2, 2015
- Gray Plant Mooty Ranked Among Top 25 Twin Cities IP Law Firms
  July 24, 2015
- Gray Plant Mooty's Jennifer Debrow, Dean Eyler, and Sheldon Klein Ranked as Top Trademark Professionals in WTR 1000
  February 16, 2015
- Nine Gray Plant Mooty Attorneys Named 2014 DC Super Lawyers and Rising Stars
  April 25, 2014
- Gray Plant Mooty Attorneys Assist in the Publishing of The Franchise Law Review
  February 21, 2014
- Gray Plant Mooty Trademark Practice and Attorneys Debrow, Hein, and Klein Recognized in WTR 1000
  March 23, 2012
- Gray Plant Mooty's Sheldon Klein Recognized as Leading IP Attorney by Washingtonian Magazine and Who's Who Legal

December 27, 2011

- Intellectual Property and Advertising Law Expert Sheldon Klein Joins Gray Plant Mooty
  June 29, 2011

Professional Affiliations

- American Intellectual Property Law Association, Immediate Past President
- International Trademark Association, U.S. Legislation Committee, Member
- Intellectual Property Constituency of the Internet Corporation for Assigned Names and Numbers (ICANN), Member
- U.S. Patent and Trademark Office, Trademark Public Advisory Committee, Past Member
- Bar Assn. of D.C., Patent, Trademark & Copyright Section, Past Chair

Community Involvement

- Jewish Federation of Greater Washington, Board of Directors
- Maryland-Israel Development Center, Montgomery County Steering Committee

Honors

- *Who's Who Legal*: IP - Trademarks, 2007-2019, 2022-2023
- *World Trademark Review*, "Leading Trademark Lawyer," 2011-2013, 2015-2024
- Washington, D.C. *Super Lawyers*, 2014-2023