



## Sheldon H. Klein

Senior Counsel

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**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 \(AIPLA\)](#) 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.

### Areas of Focus

#### Services

[Intellectual Property](#)

[Intellectual Property](#)

[Litigation](#)

[Litigation](#)

[Copyrights](#)

[Licensing & Commercial](#)

[Transactions](#)

[Trademarks](#)

#### Sectors

[Health Care](#)

[Wholesale & Retail](#)

[Distribution](#)

[Restaurant, Food & Beverage](#)

[Technology](#)

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### 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.
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## Credentials

### Education

- The George Washington University Law School, J.D., with honors
- University of Michigan, B.A., with high distinction

### Bar Admissions

- District of Columbia
- Maryland

## Court Admissions

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

## Recognition

- *Lexology Index*, Thought Leader – USA IP – Trademarks, 2025
- *Lexology Franchise Guide (formerly Who's Who Legal)*, 2007-2019, 2022-2023
- *World Trademark Review*, "Leading Trademark Lawyer," 2011-2013, 2015-2025
- Washington, D.C. *Super Lawyers*, 2014-2023

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## Presentations

- Program Co-Chair & Opening Remarks, "Advanced Trademark Law 2025: Current Issues," Practising Law Institute (PLI) Seminar, March 27, 2025
- 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](http://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
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## 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
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## Professional Activities

- 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