

## WIPO LIST OF NEUTRALS

### BIOGRAPHICAL DATA

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Date of Birth: May 8, 1950  
Nationality: American

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### EDUCATIONAL AND PROFESSIONAL QUALIFICATIONS

B.A., Colgate University, New York, 1972;  
J.D., Albany Law School, Union University, 1975.

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### LANGUAGES

English.

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### PRESENT POSITION

David L. Brennon, Professor of Law and Director of the Center of Intellectual Property Law and Technology, University of Akron School of Law;  
Contributor, *Trademark Registration Practice*, published by West Group;  
Jeffrey M. Samuels, Esq. – Represents clients in trademark matters before U.S. Patent and Trademark Office;  
Consultant and expert witness in trademark and related unfair competition cases.

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April 25, 2012

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### EXPERIENCE BEFORE PRESENT POSITION

Law Office of Jeffrey M. Samuels, specializing in the practice of intellectual property law, including trademark and copyright prosecution and litigation, licensing and counseling.

Served as an expert witness in trademark litigation, with clients from both domestic and foreign companies, 1996-98;

Partner, Spencer, Frank and Schneider, Washington DC, specializing in practice of trademark law 1993-96;

Assistant Commissioner of Patents and Trademarks, U.S. Patent and Trademark Office – responsible for management of USPTO's trademark operations.

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### MEMBERSHIP IN PROFESSIONAL BODIES

Chair, Trademark Public Advisory Committee of the United States Patent and Trademark Office – July 2003-July 2006;

American Bar Association (ABA):

Section of Intellectual Property Law;

Chair, Committee on Federal Trademark Legislation;

American Intellectual Property Law Association (AIPLA):

Vice-Chair, Trademark and Unfair Competition Law Committee;

Alternative Dispute Resolution Panel;

Chair, Trademark Registration Committee;

International Trademark Association:

Member, Meetings Committee;

Federal Bar Association:

Co-Chair, Legislation Committee;

American Arbitration Association (AAA).

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### AREAS OF SPECIALIZATION

Trademark and related unfair competition law.

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### EXPERIENCE IN INTELLECTUAL PROPERTY

U.S. Patent and Trademark Office (USPTO), Assistant Commissioner of Patents and Trademarks 1987-93:

Bureau of National Affairs Inc:

- *BNA's Patent, Trademark & Copyright Journal*, 1976-87,
- Managing Editor, 1982-87;

- Trademark operations, including implementation of the Trademark Law Revision Act of 1988;
  - Head of the U.S. delegation to numerous Committees of Experts convened by WIPO relating to the drafting of regulations implementing the Madrid Agreement and Protocol, and to the drafting of the Trademark Law Treaty;
  - Represented the U.S. Administration at a number of congressional hearings;
  - Partner, Spencer, Frank & Schneider, 1993-96:
  - Prosecution of trademark applications with the USPTO and litigation before Federal Courts and the USPTO's Trademark Trial and Appeal Board.
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### MAJOR PUBLICATIONS

Editor, *Patent, Trademark and Copyright Laws*, Bureau of National Affairs, Inc., 1983- 2000;  
Author, chapter entitled "Foreign Trademark Protection" and substantially revised the chapter on  
"Trademark Prosecution" in the multi-volume treatise *Trademark Protection and Practice*, by  
Jerome Gilsons, Mathew Bender;  
"Color Trademarks: Shades of Confusion," *The Trademark Reporter*, vol. 83, page 554 (co-author);  
"The U.S. Perspective on the Madrid Protocol," *European Intellectual Property Review*, vol. 15,  
Issue II, November 1993 (co-author);  
"The Changing Landscape of International Trademark Law", *George Washington Journal of  
International Law and Economics*, Vol. 27, Nos. 2 & 3, 1994, pp. 433-455 (co-author).

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### EXPERIENCE IN COURT LITIGATION

Since entering private practice in 1993, has worked on several cases in the U.S.A.:

- copyright infringement relating to architectural blueprints;
- an action for trade dress and trademark infringement;
- *inter partes* proceedings before the USPTO's Trademark Trial and Appeal Board, primarily opposition and cancellation proceedings.

Has been retained as an expert/consultant on a number of trademark-related claims involving trademarks and service marks owned by The Limited, Inc., Visa International, Cross Pen, W.R. Grace & Co, the National Basketball Association, Tandy Corp., and numerous other companies.

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### PROFESSIONAL TRAINING IN MEDIATION

AIPLA's Institute on Alternative Dispute Resolution, Florida, January 1993;  
AIPLA's Mediation Course, November 1996. Attended training sessions offered by U.S. District Court for the Northern District of Ohio.

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### PROFESSIONAL TRAINING IN ARBITRATION

During law school, was enrolled in a course on labor arbitration;  
AIPLA's Institute on Alternative Dispute Resolution, Florida, January 1993.

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### EXPERIENCE IN MEDIATION

As an Assistant Commissioner at the USPTO from 1987 to 1993, was called upon to "mediate" a number of labor disputes between various public employee unions and Patent and Trademark Office management. Mediated several trademark-related disputes under programs sponsored by International Trademark Association and U.S. District Court for the Northern District of Ohio.

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### EXPERIENCE IN ARBITRATION

As part of a law school course on labor arbitration, has attended several actual arbitration hearings and drafted proposed arbitration awards for review by the professor/arbitrator;  
At the USPTO served as the deciding official in a number of personnel-related matters, which included rendering written decisions. One matter involved a complicated and politically sensitive sexual harassment charge in which his decision was upheld by the Merit Systems Protection Board and by

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the U.S. Court of Appeals for the Federal Circuit.

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