

WIPO LIST OF NEUTRALS

BIOGRAPHICAL DATA

Clark W. LACKERT
Carlton Fields, P.A.
New York, NY
United States of America



Nationality: American

EDUCATIONAL AND PROFESSIONAL QUALIFICATIONS

LL.M., New York University, 1983;
J.D., State University of New York, Buffalo, 1976;
A.B., (cum laude), Cornell University, 1973.

LANGUAGES

English
Russian (6 years study), French (3 years study).

PRESENT POSITION

Shareholder, Carlton Fields, May 2019.

PROFESSIONAL EXPERIENCE BEFORE PRESENT POSITION

Partner, Reed Smith LLP, May 2013-May 2019;
Partner, Dickstein Shapiro LLP, May 2010-2013;
Partner, King & Spalding April 2001-2010;
Senior Partner, Nims, Howes, Collison, Hansen & Lackert, New York, 1981-2001;
Trademark Attorney, Offner & Kuhn, New York, 1979-81;
Trademark Attorney, Haseltine, Lake & Waters, New York, 1978-79;
Trademark Research Adviser, Trademark Research Corporation, New York, 1977-78.

January 28, 2020

MEMBERSHIP IN PROFESSIONAL BODIES

Chair, External Affairs Committee, International Trademark Association (INTA), since 1998;
Chair, Issues and Policy Committee, INTA, 1996-98;
Chair, International Editorial Board, INTA, 1991-93;
Member, Board of Directors Executive Committee, INTA, 1993-94;
Chair, Amicus Brief Committee, INTA;
Chair, Geographical Indications Committee, INTA;
Chair, Related Rights Committee, INTA;
Chair, Franchising Committee, American Bar Association (ABA), 1989-91;
Chair, Trade Secret Committee, ABA, 1987-89;
Chair, International Trademarks Committee, ABA, 1985-87;
Chair, Copyright and Trademark Division, ABA;
Member, Executive Committee, International Association for the Protection of Industrial Property (AIPPI), since 1998;
Overseas Member, Institute of Trade Mark Agents, United Kingdom, since 1988;
Member, Trademark Committee, New York State Bar Association, since 1994;
The Coalition for Intellectual Property Rights;
Pharmaceutical Trade Marks Group;
The Pharmaceutical Research and Manufacturers of America; American Intellectual Property Law Association;
New York Intellectual Property Law Association.

AREAS OF SPECIALIZATION

International trademark, licensing and anti-counterfeiting;
International trademark searching, filing, maintenance, litigation and protection programs; Acquisitions and divestitures involving trademarks.

EXPERIENCE IN INTELLECTUAL PROPERTY

Over 20 years of varied intellectual property experience, including representing multinational corporations as well as start-up companies to protect their intellectual property, both in the United States and globally. Such experience includes searching and filing trademark applications, opinions concerning trademark and copyright availability, licensing, anti-counterfeiting work, *inter partes* patent office work and court litigation, and global litigation practice working with local counsel in over 200 countries.

EXPERIENCE WITH RESPECT TO DOMAIN NAMES

Professional article in *Internet Law Journal* on "Famous Trademarks and the Internet". Advising on trademark domain name issues.

MAJOR PUBLICATIONS

Professional articles have appeared in:

Columbia Business Law Review;
International Quarterly;
Internet Law Journal;
Middle East Commercial Law Review;
National Law Journal; *Russian Patent Office Gazette*;
Trademark World.

Selected Professional Lectures:

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- "Global Protection for Famous Trademarks," INTA Annual Meetings (2012-2019);
 - "U.S. Trademark Law Update," IPTA conference, Perth, Australia (2017);
 - "U.S. Trademark Law Update," JPAA, Tokyo, Japan (2017);
 - "U.S. Trademark Law Update," Chofn, Shenzhen and Hangzhou, China (2017);
 - "International Searching and Filing Strategies," PLI's Understanding Trademark Law in the Global Marketplace 2012, New York (July 17, 2012);
 - "Global Protection for Famous Trademarks," INTA International Academy, Washington (May 5, 2013);
 - "Special Issues in Copyright and Trademark Law," PLI IP Issues in Business Transactions 2013, New York (January 3, 2013);
 - "The Right Mechanics: Trademark Searching and Clearance in a Global Environment," INTA Trademark Administrators Conference, Charlotte, NC (October 14-16, 2012);
 - "International Searching and Filing Strategies," PLI's Understanding Trademark Law in the Global Marketplace 2012, New York (July 17, 2012);
 - "Global Protection for Famous Trademarks," INTA International Academy, Washington (May 6, 2012);
 - "IP Practitioner in Residence," Indiana University Maurer School of Law, Bloomington, IN (February 15, 2012);
 - "U.S. Trademark, Domain Name, and Internet Update," U.S. IP Law Forum, London, UK (November 16, 2011);
 - "U.S. Trademark, Domain Name, and Internet Update," U.S. IP Law Forum, Milan, Italy (November 15, 2011);
 - "U.S. Trademark, Domain Name, and Internet Update," U.S. IP Law Forum, Milan, Italy (November 14, 2011);
 - "Online Trademark Infringements: U.S. and International Developments and Best Practices," New Jersey Trademark Counsel Luncheon Club, Basking Ridge, NJ (November 3, 2011);
 - "International Searching and Filing Strategies," PLI Understanding Trademark Law, New York (July 19, 2011);
 - "Fighting Counterfeiting and Trademark Infringement in China," NYIPLA Half-Day Trademark CLE Program, New York (June 14, 2011);
 - "Global Protection for Famous Trademarks," INTA International Academy, San Francisco (May 14, 2011);
 - "AdWords: A Comparative Analysis," Fordham Annual IP Conference, New York (April 29, 2011);
 - "EU & US Trademark Dilution," Fordham Annual IP Conference, New York (April 28, 2011);
 - "Handling Complex Prosecution Issues," INTA Roundtable, Irvine, CA (April 15, 2011);
 - "IP Practitioner in Residence," Indiana University Maurer School of Law, Bloomington, IN (March 29-30, 2011);
 - "The Intersection of Trademark and Copyright and the Right of Publicity," USC Gould School of Law 2011 IP Institute, Beverly Hills, CA (March 22, 2011);
 - "Global Brand Protection Against Online Infringements," Bird & Bird LLP, Milan, Italy (February 16, 2011);
 - "Global Brand Protection Against Online Infringements," ITMA London Evening Meeting, London, UK (February 15, 2011);
 - "Legal Remedies Available for Brand Owners in the United States," INTA U.S.P.T.O. Study Tour on I.P. and Enforcement for Latin American Judges, New York (November 3, 2010);
 - "Global Brand Protection Against Online Infringements," ACC-NY CLE Program, New York (November 2, 2010);
 - "Trademarks," Korea Electric Association (KEA) IP Seminar, Seoul, South Korea (September 28, 2010);
 - "Trademark Law (US) Committee: Use and Abuse of Trademarks on the Internet," IPO Annual Meeting, Atlanta (September 13, 2010);
 - "Global and U.S. Trademark Enforcement and AntiCounterfeiting Issues," USPTO Global Intellectual Property Academy and the Thai Central IP and International Trade Court Seminar on Enforcement of Intellectual Property Rights, Alexandria, VA (August 16, 2010);
 - "International Searching and Filing Strategies," PLI's Understanding Trademark Law 2010, New York (July 20, 2010);
 - "Famous Marks Doctrine from a Global Perspective," INTA Famous and Well Known Marks Committee, New York (July 20, 2010);

- "Challenges in Protecting Foreign GIs in the U.S. as well as AOPs in Foreign Jurisdictions," ORIGIN Conference - American Origin Products (AOP) Economic and Legal Perspectives, Washington (June 3, 2010).
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TRAINING IN MEDIATION

WIPO Workshop for Mediators in Intellectual Property Disputes, San Francisco, May 2000.
