
WIPO LIST OF NEUTRALS

BIOGRAPHICAL DATA

Colin T. O'BRIEN
Latimer Levay Fyock LLP
Chicago, IL
United States of America



Nationality: American/Irish

EDUCATIONAL AND PROFESSIONAL QUALIFICATIONS

J.D., Loyola University, College of Law, Chicago 2004;
B.A., University of Maryland, Maryland, 1995.

Bar admissions:
Illinois, 2004;
United States District Court for the Northern District of Illinois, 2010.

LANGUAGES

English

PRESENT POSITION

Partner, Co-Chair, Intellectual Property Group, Latimer Levay Fyock, LLP.

PROFESSIONAL EXPERIENCE BEFORE PRESENT POSITION

Partner, Partridge Partners P.C., Chicago;
Attorney, Pattishall, McAuliffe, Newbury, Hilliard Geraldson, Chicago.

MEMBERSHIP IN PROFESSIONAL BODIES

International Trademark Association;
Member of the Internet Committee, past co-chair of the GAC outreach sub-committee;
American Intellectual Property Law Association;

Intellectual Property Constituency of ICANN;

January 29, 2020

Intellectual Property Law Association of Chicago.

AREAS OF SPECIALIZATION

Trademark;
 Copyright;
 U.S. Federal Litigation;
 U.S. Trademark Trial and Appeal Board Litigation;
 Domain Name enforcement (URS, ACPA, UDRP);
 gTLD Applications.

EXPERIENCE IN INTELLECTUAL PROPERTY

Practicing intellectual property law (both contentious and non-contentious) for 15 years.

Significant litigation experience in pursuing and defending Lanham Act, Copyright, Anti-cybersquatting Consumer Protection Act, Design Patent Infringement and Computer Fraud and Abuse Act actions on behalf clients throughout the United States. Obtained numerous victories for clients through UDRP and URS actions. Also work with attorneys throughout the world in order to ensure clients rights are protected overseas.

Also handles traditional transactional matters involving trademarks and copyrights including trademark clearance reviews and investigations, drafting international and domestic clearance opinion letters; reviewing FDA regulations to ensure client compliance; prosecution and maintenance of domestic and foreign trademarks; and the drafting office action responses.

EXPERIENCE WITH RESPECT TO DOMAIN NAMES

Has extensive experience in litigating UDRP actions have assisted in the drafting of over 80 UDRP complaints which resulted in decisions.

Assisted in the preparation of the new gTLDs: .lanxess, .pru, .prudential and .pramerica;
 Assisted with the legal right objection against .hospital on behalf of American Hospital Organization;
 Drafted URS complaints on behalf of clients Lanxess, at World Properties, and Servicemaster;
 Participated in U.S. Lawsuits related to Anti-cybersquatting Protection Act claims.

Has also spoken extensively on Domain Name related matters.

Recent Speaking Events:

“Practical Trademark Prosecution Tips Given Recent Developments”, American Intellectual Property Law Association Annual Meeting, May 16, 2018;
 “The Everchanging Internet: What Companies Need to Know About Brand Protection, Data, Security and Regulatory Compliance”, Speaker Illinois Paralegal Association, October 27, 2017;
 “Data Privacy & Cybersecurity Roundtable”, Partridge Partners Symposium, September 29, 2017;
 “Guest Lecture on Internet Enforcement and New gTLDs”, Loyola Law School, November 15, 2016;
 “Professionalism in the Legal Workplace: Focusing on the Law Student Extern Legal Volunteer, and Clinician”, Panelist – Loyola University Law School Ethics Symposium, 2015, 2016, 2017, and 2019;
 “The Demise of .COM New Generic Top Level Domain Names: What Brand Owners Need to Know” Illinois State Bar Association CLE Presentation, April 7, 2014;
 “New Generic Top Level Domain Names (gTLDs)”, DePaul Law School, October 11, 2013;
 “New gTLDs: Steps to Protect Your Trademark”, Speaker Chicago Bar Association, September 3, 2013;
 Taught Advanced Trademark Law at the John Marshall Law School for LLM students 2014, 2015, and 2016.

EXPERIENCE IN COURT LITIGATION

Acted as counsel in over 40 litigation matters in the U.S. Federal Courts and Trademark Trial and Appeal board. Subject matter concerned trademark infringement, copyright infringement, patent infringement, design patent infringement, Computer Fraud and Abuse Act, Anti-Cybersquatting Protection Act;

Acted as general counsel for U.S. clients regarding disputes in Canada, Mexico, Argentina, Peru, Colombia, Brazil, Australia, Japan, New Zealand, Poland, Sweden, Norway, Finland, Germany, France, Spain, Italy, Republic of Korea, Switzerland, Austria, United Kingdom, Ireland, the European Union, and the Netherlands;

Assisted Indian counsel in securing a “.in” domain name in one of the first litigations involving domain names in India.
