
WIPO LIST OF NEUTRALS

BIOGRAPHICAL DATA

A. Justin OURSO III
Ourso Counsels
Bâton-Rouge, LA
United States of America



Nationality: American

EDUCATIONAL AND PROFESSIONAL QUALIFICATIONS

J.D., University of Virginia School of Law, Dillard Legal Fellow, 1977;
B.A., English Literature, Louisiana State University, 1974.

Admitted to practice: United States Supreme Court, Fifth and Eleventh United States Circuit Courts of Appeal;
all Louisiana Federal and State Courts;
Federal District Court for Connecticut.

Distinctions:

Listed in *The Best Lawyers in America* 2018 in the areas of Litigation – Intellectual Property and Trademark Law (listed annually since 2012);
Recognized by *The Best Lawyers in America* as the 2017 Trademark Law “Lawyer of the Year” in Baton Rouge.

LANGUAGES

English

PRESENT POSITION

Principal, Ourso Counsels.

PROFESSIONAL EXPERIENCE BEFORE PRESENT POSITION

Counsel, Lamothe & Hamilton, 1992-94;
Founder and Managing Director, Naquin & Ourso, A Professional Law Corporation, 1990-92;

October 6, 2022

Director, Barham & Churchill law firm, 1981-89;
Associate, Monroe & Lemann, law firm, 1977-81.

MEMBERSHIP IN PROFESSIONAL BODIES

Member designee, International Trademark Association since 1994;
American Bar Association, since 1977;
Louisiana State Bar Association, since 1977;
Baton Rouge Bar Association.

AREAS OF EXPERIENCE

Counseling, licensing and related transactional matters, and litigation in trademark, copyright, and web site matters.

Counseling and litigation in business matters, including trade secret, unfair trade practices, unfair competition, entertainment, media (publishing and broadcasting), contract, statutory, Louisiana Civil Code, constitutional, and selected state agency matters.

EXPERIENCE IN INTELLECTUAL PROPERTY

Over thirty-five years of experience as a lawyer in private practice in counseling, brand selection and risk avoidance, trademark and copyright prosecution, trademark and copyright licensing and related transactions and agreements, and trademark and copyright protection and enforcement, including litigation in state and federal courts and litigating proceedings in the U. S. Trademark Office;
Experience in counseling on domain names, web sites, and web site compliance with the federal COPPA and DMCA statutes, and counseling on, and negotiating and drafting, transactional documents on intellectual property related matters, including management, distribution, and noncompetition agreements, and web site user and privacy agreements;
Extensive training through educational programs of the International Trademark Association (“INTA”) and the American Bar Association (“ABA”) Section of Intellectual Property Law and Section of Litigation for over twenty years in trademarks, copyrights, domain names, web sites, the Internet, ICANN, and the UDRP;
Moderated programs, presented as a speaker or panelist, and led small group workshops at a number of programs on various intellectual property topics, including programs of the International Trademark Association and the American Bar Association Intellectual Property Law Section.

EXPERIENCE WITH RESPECT TO DOMAIN NAMES

Domain Name Dispute Resolution training: “WIPO Advanced Workshop on Domain Name Dispute Resolution: Update on Precedent and Practice,” October 24 and 25, 2017, and WIPO Panelist Meeting, October 23, 2017;
Educational programs on domain names, the Internet, ICANN, and the UDRP at INTA and ABA meetings and conferences;
Counseling clients on the avoidance of domain name conflicts and disputes and the acquisition of domain names.

MAJOR PUBLICATIONS

“Intellectual Property Licensing Agreements Under the Bankruptcy Code: A Proposal for a New Legislative Solution to the Problem of the Disparate Treatment of Trademarks,” paper presented at the American Bar Association, Intellectual Property Law Section, 30th Annual Intellectual Property Law Conference, March 25, 2015, Bethesda, Maryland;

“The Federal Trademark Dilution Act: A Brief Introduction and Some Preliminary Thoughts,” paper presented at the Louisiana State Bar Association Intellectual Property Institute, March 19, 1998;
 “Noncompetition Covenants: A Preliminary Analysis of Louisiana Law on Restrictions in Agreements for the Sale of a Business,” paper presented at the New Orleans Bar Association Intellectual Property Law Seminar, September 25, 1992, and at the Tulane Law School Intellectual Property Conference, December 29, 1992.

EXPERIENCE IN COURT LITIGATION

Represented parties in court litigation as lead trial counsel for over thirty-five years in the United States Supreme Court, the Fifth United States Circuit Court of Appeal, all federal district courts in Louisiana, federal district court in Connecticut, and in Louisiana state courts in trademark, copyright, trade secret, unfair trade practices, unfair competition, entertainment, media (publishing and broadcasting), contract, statutory, Louisiana Civil Code, and constitutional matters, and in other business matters.

Representative cases include:

Nola Spice Designs, L.L.C. v. Haydel Enterprises, Inc., 783 F.3d 527 (5th Cir. 2015) (representation on appeal in the Fifth Circuit of trademark and copyright infringement claimant);
Hakim v. O'Donnell, 144 So.3d 1179 (2d Cir. 2014) (representation of reporter and broadcaster in defamation action);
Rosetta Stone Ltd. v. Google, Inc. 676 F.3d 144 (4th Cir. 2012) (co-author of amicus brief on behalf of the International Trademark Association in keyword advertising case);
Stewart v. Rhodia, Inc., 96 So.3d 482 (1st Cir. 2012) (representation of turbine manufacturer in toxic tort class action);
NovelAire Technologies, L.L.C. v. Harrison, 50 So.3d 913 (4th Cir. 2010) (representation of manufacturer in unfair trade practices claim against former employee and employee's partner);
Sinclair v. Studio Canal, S.A., 709 F. Supp. 2d 496, (E.D. La. 2010) (representation of movie rights owner in trademark declaratory judgment action);
Sedona Corp. v. Open Solutions, Inc., 646 F. Supp. 2d 262 (D. Conn. 2009) (representation of software developer in contract action);
Dameware Development, L.L.C., v. Northern Software, S.A., 2003 U.S. Dist. LEXIS 3982, 2003 WL 1341209 (E.D. La. 2003) (representation of claimant in action under Anticybersquatting Consumer Protection Act);
Peaches Entertainment Corp. v. Entertainment Repertoire Assocs., Inc., 62 F.3d 690 (5th Cir. 1995) (representation of music recordings retailer against another retailer for trademark infringement).

PROFESSIONAL TRAINING IN ARBITRATION

“WIPO Advanced Workshop on Domain Name Dispute Resolution: Update on Precedent and Practice,” October 24 and 25, 2017, and WIPO Panelist Meeting, October 23, 2017.

EXPERIENCE IN MEDIATION

Representation of parties as an advocate in private mediations and in federal and state court settlement conferences conducted as mediations for over thirty-five years.

MEDIATION EXPERIENCE
SUMMARY TABLE

Type	Administering Institution		Role			
	Name	Number of Mediations	Mediator		Counsel	
International Mediations						
	Ad Hoc					
	Others					
Number of Cases :						
Sub-Total						
Domestic Mediations	AAA					
	Court Annexed	~34			~34	
	Ad Hoc	2			2	
Number of Cases		~36				
Sub-total						
TOTAL		~36				