



Partner

David Kelly



Dave Kelly has represented clients in trademark, copyright, unfair competition issues for more than 35 years, with a focus on litigation, disputes, domain names and internet issues, and strategic counselling. Dave represents many famous brands and has handled numerous high-profile matters, including obtaining a preliminary injunction followed by an award of \$19,200,000 in statutory damages for trademark counterfeiting against a large, high-profile online print-on-demand retailer and the first fame findings for Harley-Davidson's marks H-D and HD (E.D. Wisconsin 2018), and successfully enforcing AstraZeneca's single-color "purple" trademark for its NEXIUM® heartburn medication against two generic pharma companies, obtaining temporary restraining orders and preliminary injunctions on both infringement and dilution grounds along with the first fame finding for AstraZeneca's "purple" color mark (D. Delaware 2015).

Dave is consistently recognized as one of the country's elite trademark lawyers. In 2022, *Legal 500 US* named Dave as a Leading Lawyer, *Legal 500's* top category, for both trademark litigation and non-contentious matters for the 15th consecutive year. Only ten or so U.S. lawyers were named in each category, and during the past decade Dave was either the only U.S. lawyer or one of a few lawyers named in both categories. In 2017, Dave was named to the inaugural *Legal 500 Hall of Fame*—only 11 U.S. trademark lawyers were recognized, with Dave the only lawyer named for both trademark categories. According to *Legal 500* feedback, clients describe Dave as "a leader in the field," "a superstar," "an outstanding trademark litigator," "among the market leaders in trademark disputes" and "an exceptionally bright and thoughtful advocate." Clients also look to Dave for strategic advice based on his reputation as being "full of business savvy" and "a source of much practical advice... that understands our business in a way that most lawyers don't."

In 2022, *WTR 1000* named Dave one of the top 10 lawyers nationwide for both trademark enforcement and litigation (7th consecutive year) and trademark prosecution and strategy (5th consecutive year). Dave was one of only a few lawyers named to both categories in *WTR 1000's* top band of nationally recognized lawyers. According to client and peer feedback, Dave "has an impeccable reputation and is unanimously hailed as one of the foremost trademark minds in the United States"; is "arguably the best trademark practitioner in the country"; "the man to call" for "make-or-break disputes"; "a redoubtable litigator"; "smart as a whip and always 10 steps ahead of his rivals"; "when complex questions arise, he thinks outside of the box to deliver ingenious solutions"; "he has an uncanny ability to immediately reach the right conclusion on something – he doesn't need time to process things"; "one of the best there is at coming up with creative solutions that precisely fit a brand's needs"; "strategic, thoughtful and responsive, and continues to raise the bar for what it means to be an excellent external partner"; a lawyer who "maintains strong relationships with massive brands and has built a stunning firm around him"; "has a fantastically clear grasp of things and is an eminently practical and skilled negotiator" whose "substantial proficiency and estimable business acumen single him out in the field"; and "his real-world advice doesn't elevate law above business."

Dave has also been recognized as an *IP Star* by *Managing Intellectual Property* for 12 consecutive years. *IP Stars* feedback includes that Dave is a "leader in the field," a "superstar," and has "unparalleled

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→ Education

- Duquesne University School of Law, J.D., 1983
- University of Pittsburgh, M.S., Civil Engineering, 1980
- University of Pittsburgh, B.S., Civil Engineering, 1979

→ Bar and Court Admissions

- District of Columbia
- Louisiana
- Pennsylvania

→ Professional Activities

- District of Columbia Bar
- American Bar Association
- International Trademark Association

knowledge and experience in trademark litigation and TTAB cases.” Dave has been similarly recognized by *WIPIR*, *Expert Guides*, and others.

Before co-founding Kelly IP, Dave practiced 26 years at Finnegan, Henderson, Farabow, Garrett & Dunner.

01. Highlights

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→ *H-D U.S.A. (Harley-Davidson) v. Square Wear LLC (E.D. Mich.)*

Obtained an Ex Parte Temporary Restraining Order against apparel counterfeiter in a trademark and copyright infringement action followed by a permanent injunction and a consent judgment that included an award of statutory damages of \$5.4 million for trademark counterfeiting.

→ *The Travelers Indemnity Company v. Vilches (TTAB)*

In an opposition against a former Travelers employee seeking to register an altered version of Travelers’ Umbrella Logo for “auto body repair services”, obtained a favorable decision from the TTAB finding that the Travelers Umbrella Logo is famous and that there was a likelihood of confusion and sustaining the Opposition in Travelers’ favor.

→ *LucasFilm Entertainment Co. Ltd. LLC v. Ilan Moskowitz aka Captain Contingency (TTAB)*

Successfully opposed an application for the mark MILLENNIAL FALCON for entertainment services and live musical performances on likelihood of confusion grounds based on Lucasfilm’s iconic MILLENNIUM FALCON mark used for more than 40 years with its Star Wars franchise, including a key finding that the MILLENNIUM FALCON mark was a “merchandising mark” used for various goods and services.

→ *BMW v. Issa. (D. Utah)*

Obtained an ex parte TRO and freeze of defendants’ assets and payment accounts in a trademark and copyright infringement, counterfeiting, dilution, and cybersquatting action involving BMW’s diagnostic and programming software and hardware for automobiles and motorcycles and unauthorized use of the trademarks BMW, RHEINGOLD, and ROLLS-ROYCE, among others, followed by a consent judgment and permanent injunction that included an award of statutory damages of \$10 million for trademark counterfeiting.

→ *NJOY, LLC v. Wang Xi Zhi (TTAB)*

Successfully opposed an application for the mark IJOY for electronic cigarettes on likelihood of confusion grounds based on NJOY’s prior registered mark NJOY for the same goods, including a key finding that the “NJOY marks are commercially strong” and fall on the stronger side of the spectrum” and entitled to a broader scope of protection.

→ *H-D U.S.A. (Harley-Davidson) v. SunFrog (E.D. Wis.)*

Obtained a preliminary injunction against an online apparel seller of counterfeit and infringing apparel bearing Harley-Davidson’s trademarks, followed by a favorable ruling on the merits of all claims on summary judgment along with a permanent injunction and an award of \$19,200,000 in statutory damages for trademark counterfeiting and the first fame finding for the mark HD.

- *AstraZeneca v. Dr. Reddy's Laboratories and AstraZeneca v. Camber Pharmaceuticals (D. Del.)*
Successfully enforced AstraZeneca's single-color "purple" trademark against two generic pharma companies in two different cases, obtaining temporary restraining orders and preliminary injunctions on both infringement and dilution grounds along with the first fame finding for AstraZeneca's "purple" color mark.
- *Fidelity National Information Services, Inc. v. Direct Horizon (M.D. Fla.)*
Represented FIS in trademark infringement and cybersquatting action relating to FIS' CHEXSYSTEMS trademark, and obtained a broad consent judgment enjoining Defendants from infringing FIS' trademark and from engaging in false and misleading advertising.
- *H-D U.S.A. (Harley-Davidson) v. Mayo (E.D. Wis.)*
Obtained summary judgment for Harley-Davidson on its trademark infringement and counterfeiting claims, a permanent injunction prohibiting defendants from selling their infringing jewelry, and an award of \$6 million in statutory damages for trademark counterfeiting.
- *Aston Martin Lagonda Limited v. Fisker (C.D. Cal.)*
Represented Aston Martin in multiple litigations to enforce its iconic automobile grille and side vent designs.
- *Harley-Davidson v. Wright (E.D. Wis.)*
Obtained consent judgment and permanent injunction against defendant taking genuine licensed Harley-Davidson bedding and window coverings and cutting and transforming them into lamp shades bearing Harley-Davidson trademarks.
- *Harley-Davidson v. Urban Outfitters (E.D. Wis.)*
In another "reconstruction" case, obtained swift settlement resulting in Urban Outfitters removing altered and reconstructed versions of genuine Harley-Davidson apparel products from the marketplace.
- *Travelers Indemnity Co. v. Travellers.com (4th Cir. and E.D. Va.)*
Obtained summary judgment from the District Court on cybersquatting claim resulting in transfer of the domain name TRAVELLERS.COM to Travelers (E.D. Va.), affirmed by Appeals Court.
- *Yahoo! Inc. v. BelgiumDomains, LLC (S.D. Fla.)*
Represented Yahoo! in a cybersquatting action involving the registration and use of more than 600 domain names comprised of Yahoo!'s trademarks or variations thereof and obtained a consent judgment and permanent injunction pursuant to a confidential settlement agreement.
- *Monster, Inc. v. Monster Memory and More, Inc. (TTAB)*
Obtained cancellation of registration for MONSTER MEMORY AND MORE for "memory cards" based on likelihood of confusion with Monster Cable's MONSTER mark while earning first fame ruling for MONSTER mark (TTAB 2013).
- *Harley-Davidson v. Hellenic Duty Free Shops (E.D. Wis. & 7th Cir.)*
Obtained TRO and preliminary injunctions from District Court against a Greek trademark licensee's unauthorized use of the licensed Harley-Davidson trademarks in Europe and decision that U.S. courts had personal jurisdiction over foreign defendant based on language of trademark license agreement, and decisions on the merits affirmed by Seventh Circuit Court of Appeals.

- *Lansinoh Laboratories, Inc. v. Philips Children's Medical Ventures, Inc. (E.D. Va.)*
Defeated preliminary injunction motion filed by the owner of the mark SOOTHIES for breast feeding pads to enjoin the maker of SOOTHIE pacifiers from expanding use of SOOTHIE mark to baby bottles and nipples.
- *H.D. Vest, Inc. v. Herbert Vest (N.D. Tex.)*
Defeated preliminary injunction motion filed by Wells Fargo subsidiary H.D. Vest, Inc. to enjoin defendant from using his personal name H.D. Vest in business names.
- *ProQuest Information and Learning Co. v. Island (TTAB)*
Successfully opposed an application for the mark INQUEST for database and research software based on likelihood of confusion with the registered mark PROQUEST for information retrieval products and services.
- *In Re National Council for Therapeutic Recreation Certification, Inc. (TTAB)*
Obtained a reversal of a refusal to register the certification mark CERTIFIED THERAPEUTIC RECREATION SPECIALIST for recreational therapy services on the grounds that the mark was generic or descriptive without secondary meaning.
- *Yahoo! Inc. v. 21Yahoo.com (E.D. Va.)*
Obtained a TRO for Yahoo! enjoining the defendants from using the domain name 21yahoo.com for a website at which it was offering free stock in 21Yahoo.com, Inc.
- *Small Luxury Hotels of the World v. Leading Hotels (S.D. N.Y.)*
Obtained a TRO against the mark SMALL LEADING HOTELS OF THE WORLD for hotel-marketing services based on the mark SMALL LUXURY HOTELS OF THE WORLD for the same services.
- *Disney Enterprises Co. v. The Short Sport(s) Co. (TTAB)*
Successfully opposed application for the mark THE MAGIC SWINGDOM for "sports training videos featuring animated and live characters for instructional purposes" based on Disney's MAGIC KINGDOM mark.
- *The Alta Vista Corp., Ltd. V. Digital Equipment Corporation (D. Mass.)*
Defeated a motion for preliminary injunction against the mark ALTAVISTA for Internet search-engine services based on the mark ALTAVISTA for publishing services.

02. Professional Recognition

- Legal 500 named Dave Kelly as one of 9 Leading Lawyers in the U.S., Legal 500's top ranking, for both trademark litigation and non-contentious matters (2022), the 15th consecutive year he was named to both lists; Dave has been either the only lawyer or one of a few lawyers named on both lists from 2009-2022.
- Legal 500 inducted Dave Kelly into its inaugural *Legal 500 U.S. Hall of Fame* 🏆 in 2017 recognizing "individuals who have received constant praise by their clients for continued excellence . . . and who are at the pinnacle of the profession." Only 11 trademark lawyers were inducted, and Dave was the only one named in both trademark litigation and prosecution categories.

- Dave Kelly recognized by *WTR 1000* as one of a few “Gold” status lawyers nationally for both contentious work (2016-2022) and for non-contentious work (2018-2022), and a “Gold” status lawyer in the Washington, DC area for contentious work (2011-2022) and non-contentious work (2015-2022).
- Named as an IP Star for the Washington, DC area by *Managing Intellectual Property (MIP)* (2014-2022).
- Shortlisted for *MIP*’s “Outstanding IP Litigator Award” in the Washington DC area in 2016, 2017, and 2018, one of only seven lawyers shortlisted for this award and the only or one of two trademark lawyers.
- Recognized by Chambers as a leading trademark lawyer in the Washington, DC area (2015-2022).
- Recognized as a “World IP Leader” by *World Intellectual Property Review (WIPR)*, a guide to leading IP practitioners around the world (2016-2020).
- Recognized by *Super Lawyers* as one of the top IP Litigation lawyers in the Washington, D.C. area (2013-2022).
- Recognized by *Washingtonian Magazine* as one of the top 100 lawyers in all practice areas in the Washington, DC area (2020).
- Recognized among top 25 U.S. trademark experts in *Legal Media Group’s Expert Guides to the Leading U.S. Lawyers—Best of the Best USA* (2007-2020)
- Recognized by the *Legal Times* as one of the top 10 “Leading Lawyers” in trademark and copyright in the Washington, DC area (2008).
- Recognized by the *Washington Business Journal* as one of the top 3 IP lawyers (and the only trademark lawyer) in the Washington, D.C. area (2008).
- Three-time recipient of the *Burton Award* for “Excellence in Legal Writing” on the topics of the intersection of the Lanham Act and the First Amendment (2010), genericness (2005), and linking (2002).
- Selected by WIPO as one of the first Panelists for the Uniform Dispute Resolution Policy (UDRP) administered by WIPO’s arbitration center (2000).

03. Select Publications

- Author or co-author of more than 75 articles on various trademark topics in numerous publications, including *The Trademark Reporter*, *Advertising Age*, *The National Law Journal*, *AIPLA Quarterly Journal*, *Landslide*, *Trademark World*, *IP Worldwide*, *Intellectual Property Today*, *Law 360*, *Corporate Counsel*, *The Merchandising Reporter*, *The Practical Lawyer*, *Association Law & Policy*, and *The European Intellectual Property Review*.