

Partner

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Practice Areas

- IP Litigation
- IP Transactions
- Emerging Technologies

Education

- DePaul University, College of Law (J.D., 1976), *cum laude*
- DePaul University, (B.A., Economics, 1973), *magna cum laude*

News

- Jane Shay Wald Named to List of Top Women Litigators
- David Nimmer Named Century City Bar Association's 2010 IP Lawyer of the Year



Jane Shay Wald

Jane Shay Wald is a partner of the firm and chair of the firm's trademark practice group. Ms. Wald's intellectual property practice focuses on trademark, unfair competition, false advertising and copyright. She counsels clients on acquiring and maintaining U.S. and foreign rights and on potential and

pending infringement problems. She counsels regarding titles, names, logos, and configurations, and prosecutes trademark applications in the U.S. Patent and Trademark Office. She litigates before the Trademark Trial and Appeal Board and the federal courts. She counsels regarding IP issues, especially trademarks and trademark licenses, in distressed assets contexts.

Ms. Wald currently serves as president-elect of the Century City Bar Association. The *Los Angeles and San Francisco Daily Journal* recently named her to its 2010 list of the "Top 100 Women Litigators" in California, recognizing her for being a "leader in trademark infringement suits in federal court and before the U.S. Patent and Trademark Office." Ms. Wald has been selected a "Best Lawyers in America" for 2007-2011, and has been named to *Los Angeles* magazine's list of Southern California "Super Lawyers" for her work in intellectual property for 2005-2010. *Super Lawyers* also named her one of the "Top 100 Lawyers" in Southern California in 2010, and one of the "Top 50 Women Lawyers" in Southern California in 2010, 2009, 2006 and 2005. Ms. Wald received the California State Bar Intellectual Property Law Section's Vanguard Award for private practice in 2009. In 2009, she was also included in California's *Who's Who Legal*, the strategic legal partner of the ABA section of International Law. In addition, the *Los Angeles and San Francisco Daily Journal* named Ms. Wald one of California's "Top 10 Trademark Lawyers" in 2008 and one of California's "Top 30 Intellectual Property Lawyers" in 2005. She was also named Century City Bar Association's "Intellectual Property Lawyer of the Year" in 2003.

Jane Shay Wald (continued)

Professional Activities

- Century City Bar Association, President-Elect, 2010; Vice-President, 2009; Secretary, 2008; Treasurer, 2007; Board of Directors, 2006 - present.
- University of California, Los Angeles Law School, Adjunct Professor, Trademark Law, Fall Semester, 2007, 2006.
- University of Southern California Law School, Adjunct Professor, Trademark Law, Spring Semester, 2005; Spring Semester, 2004; Spring Semester, 2003.
- LA Copyright Society, Board of Trustees, Immediate Past President, 2005-2006; President, 2004-2005; President-Elect, 2003-2004; Vice- President, 2002-2003; Secretary, 2001-2002; Treasurer, 2000-2001.
- American Intellectual Property Law Association (AIPLA), Vice-Chair, Trademark Litigation 2002-2004; AIPLA Chair, International Trademarks and Treaties, 1999-2001, and AIPLA Delegate to WIPO, Geneva, Switzerland, "Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications," 1999, 2001.
- Copyright Society of the USA, Board of Trustees, 1997-1999.

Publications and Presentations

Ms. Wald has written and spoken extensively on topics relating to her various fields of expertise. Among these include:

- USC Institute on Entertainment Law and Business, October 2010, Los Angeles, CA.
- *A Legal Strategist's Guide to Trademark Trial and Appeal Practice*, published by the ABA Section of Intellectual Property Law, August 2010. Co-author of Chapter Nine, "Settlement and Alternative Dispute Resolution."
- Practising Law Institute (PLI), June 2010, Chicago, IL. Presentation, "Understanding Trademark Law," and course materials.
- American Bankruptcy Institute, March 2010, Los Angeles, CA. Panelist, "Clash of the Titans: Intellectual Property Law Meets Bankruptcy."
- Practising Law Institute (PLI), June 2009, Chicago, IL. Presentation, "Trademark Infringement," and course materials.
- American Intellectual Property Law Association (AIPLA) Mid-Year Meeting, May 2009, San Diego, CA. Moderator of Panel: "Trademark-Related Fraud on the USPTO; TTAB's New Rules of Practice; Moving from TTAB Proceedings to District Court; Ethics and Trademark Practice Before the USPTO."

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- "Trademark Licenses in Bankruptcy- Cert Denied: This Time," article *Century City Lawyer*, Volume 15, No. 13, Winter 2009.
- "Ninth Circuit to Plaintiff: Game Over! Virtual 'Pig Pen' Protected by First Amendment," article, *The Intellectual Property Strategist*, Volume 15, Number 6, March 2009.
- American Bar Association (ALI-ABA), August 6, 2008. Faculty Panelist, Telephone Seminar/Audio Webcast, "*Tiffany v. eBay*: Roadmap for Avoiding Liability or Short Detour for Trademark Owners."
- "He Who Steals My Trash Pays Cash?," article, *The Intellectual Property Strategist*, Volume 14, Number 9, June 2008.
- Litigation Standing Committee of the Intellectual Property Law Section of the State Bar of California in conjunction with the Trademark Standing Committee, April 24, 2008. Teleconference Presentation, "Some Pre-Filing Considerations in U.S. Trademark Litigation: Pre-Filing Investigation and Preparation for U.S. Trademark Litigation."
- USC Gould School of Law Intellectual Property Law Institute, March 2008, Beverly Hills, CA. Trademark Law. Moderator, "Focus on Sports Entertainment."
- "Earmarks and Trademarks Collide: Fourth Circuit Reverses District Court in *The Last Best Beef, LLC v. Jonathan W. Dudas et al.*," article, *The Intellectual Property Strategist*, Volume 14, Number 4, January 2008.
- "A Forward Look at the Three Other Confusions: Reverse, Initial Interest, and Post-Sale," article, *California Business Law Practitioner*, Volume 22, Number 2, Spring 2007.
- "Ninth Circuit Follows TTAB Policy: Questions Remain As to What Kinds of Unlawful Acts Bar Trademark Rights," article, *The Intellectual Property Strategist*, Volume 13, Number 8, May 2007.
- "Overpleaded Opposition Supports DJ Motion," article, *The Intellectual Property Strategist*, Volume 13, Number 7, April 2007.
- Symposium on International Intellectual Property: Recent Trends and Future Developments, April 2007, Chapman University School of Law, Orange, CA. Presentation, "Geographical Indications," and materials.
- The 16th All Ohio Annual Institute on Intellectual Property, September 14-15, 2006, Cleveland, OH and Cincinnati, OH. Presentation, "Confusion about 'Confusion' – Reverse, Initial Interest, and Post-Sale Types."
- "Finding Fraud," article, *Los Angeles and San Francisco Daily Journal Supplement*, September 7, 2006.
- Los Angeles County Bar Association, Intellectual Property and Entertainment Law Section, May 24, 2006, Los Angeles, CA. Presentation, "Reverse, Initial Interest, and Post-Sale: A Forward Look at Reverse and 'Other' Likelihoods of Confusion."

Jane Shay Wald (continued)

- Century City Bar Association, Patents, Copyrights and Trademarks Section, March 2006, Los Angeles, CA. Presentation, "2005 Year in Review; Trademark Developments," and course materials.
- American Intellectual Property Law Association (AIPLA) Annual Meeting, October 2005, Washington DC. Paper, "Alternatives to Use: Recent Developments by U.S. Courts in Territoriality and Extraterritoriality – The Answer? Yes, No and Maybe."
- Practising Law Institute (PLI), July 2005, San Francisco, CA. Presentation, "Enforcing Copyrights," and course materials.
- American Bar Association, Section of Dispute Resolution, April 14, 2005, Los Angeles, CA. Presentation, panelist on "Mediation of Copyright and Trademark Disputes: Cutting the Gordian Knot."
- Century City Bar Association, Patents, Copyrights and Trademarks Section, February 2005, Los Angeles, CA. Presentation, "2004 Year in Review: Trademark Developments," and course materials.
- Practising Law Institute (PLI), July 2004, San Francisco, CA. Presentation, "Enforcing Copyrights," and course materials.
- "The Federal Courts' View of the State of Dilution in the States," article, *Intellectual Property Law Strategist*, Law Journal Newsletter, July 2004.
- Judges of the Central District of California Seminar, May 2004, Lake Arrowhead, CA. Presentation, "Barbies, Bulldozers and Brands in Expressive Works."
- Practising Law Institute (PLI), March 2004, Los Angeles, CA. Co-Chair (LA Chair), "Handling Intellectual Property Issues in Business Transactions."
- American Law Institute – American Bar Association (ALI-ABA), February 2004, Washington, D.C. Presentation, "State of Dilution in the States After Victoria's Secret," and course materials.
- Century City Bar Association, Patents, Copyrights and Trademarks Section, February 2004, Los Angeles, CA. Presentation, "2003 Year in Review: Trademark Developments," and course materials.
- State Bar of California, IP Law Section, April 2003, Santa Monica, CA. Presentation, "Strategies for Creating and Maintaining an International Trademark Portfolio; European Community Update."
- International Trademark Association (INTA), February 2003, Beverly Hills, CA. Basics of U.S. Trademark Law Forum. Presentation, "Trademark Licensing."
- Century City Bar Association, Patents, Copyrights and Trademarks Section, January 2003, Los Angeles, CA. Presentation, "2002 Year in Review: Trademark Developments," and course materials.
- American Intellectual Property Law Association (AIPLA) Annual Meeting, October 2002, Washington, D.C. Presentation, "The Functionality Defense to Trade Dress Claims."
- Century City Bar Association, Patents, Copyrights and Trademarks Section, February 2002, Los Angeles, CA. Presentation, "2001 Year in Review: Trademark Developments," and course materials.

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- Practising Law Institute (PLI), September 2001, Palo Alto, CA. Presentation, "Trademark Searches and Investigations," and course materials.
- American Intellectual Property Law Association (AIPLA), Trademark Law Roadshow, June 2001, Los Angeles, CA. Presentation, "Design Protection Under the Lanham Act in View of Samara and Traffix."
- International Trademark Law Association (INTA), May 2001, San Francisco, CA. Presentation, "Inside Tips and Latest News from the U.S.P.T.O. and T.T.A.B."
- American Intellectual Property Law Association (AIPLA), March 2001, Delegate to World Intellectual Property Organization (WIPO), Geneva, Switzerland.
- Judges of the Central District of California Seminar, February 2001, Ojai, CA. Presentation, "Trademark Developments."
- Century City Bar Association, Patents, Copyrights and Trade Dress Section, February 2001, Los Angeles, CA. Presentation, "2000 Year in Review: Trademark Developments," and course materials.
- All Ohio Annual Institute on Intellectual Property, September 2000, Cleveland and Cincinnati, OH. Trademark Presentation, "False Advertising Under Section 43(a) of the Lanham Act."
- Association of Corporate Patent Counsel (ACPC), February 2000, Palm Springs, CA. Presentation, "Trademarks for a New Millennium."
- Century City Bar Association, Patents, Copyrights and Trademarks Section, February 2000, Los Angeles, CA. Presentation, "1999 Year in Review: Trademark Developments," and course materials.
- American Intellectual Property Law Association (AIPLA), November 1999, Delegate to World Intellectual Property Organization (WIPO), Geneva, Switzerland.
- American Law Institute - American Bar Association (ALI-ABA), November 1999, Washington, D.C. Presentation, "Litigating Trademark, Trade Dress, and Unfair Competition Cases: Ethical Issues," and course materials.
- American Law Institute - American Bar Association (ALI-ABA), April 1999, Philadelphia, PA. Presentation, "Ethical Issues in Trademark Practice," and course materials.
- Century City Bar Association, Patents, Copyrights and Trademarks Section, February 1999, Los Angeles, CA. Presentation, "1998 Year in Review: Trademark Developments," and course materials.
- Los Angeles Intellectual Property Law Association, June 1998, Carlsbad, CA. Presentation, "Setting Up and Managing a Trademark Licensing Program," and course materials.
- American Law Institute - American Bar Association (ALI-ABA), April 1998, Washington, D.C. Presentation, "Ethical Issues in Practice," and course materials.
- Century City Bar Association, Patents, Copyrights and Trademarks Section, February 1998, Los Angeles, CA. Presentation, "1997 Year in Review: Trademark Developments," and course materials.

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- U.S. Patent and Trademark Office, December 10, 1997, Washington, D.C. Testimony before Office of Legislation and International Affairs concerning proposed rule making to amend certain rules governing practice before the Trademark Trial and Appeal Board, pursuant to 62 F.R. 30802.
- American Law Institute - American Bar Association (ALI-ABA), April 1997, Washington, D.C. Presentation, "Ethical Issues in Practice," and course materials.
- American Bar Association, April 1997, Arlington, VA. Section of Intellectual Property Law, Patent, Trademark and Copyright Law. Moderator, "The Trademark as an Asset Base."
- Century City Bar Association, Patents, Copyrights and Trademarks Section, February 1997, Los Angeles, CA. Presentation, "1996 Year in Review: Trademark Developments," and course materials.
- Minnesota State Bar Association, CLE, December 1996, Minneapolis, MN. Presentation, "Setting Up and Managing a Licensing Program," and course materials.
- Los Angeles Intellectual Property Law Association, May 1996, Palm Desert, CA. Presentation, "The European Community Trademark," and course materials.
- American Law Institute - American Bar Association (ALI-ABA), April 1996, Chicago, IL. Presentation, "Ethical Issues and Current Developments in Practice," and course materials.
- Century City Bar Association, Patents, Copyrights and Trademarks Section, February 1996, Los Angeles, CA. Presentation, "1995 Year in Review: Trademark Developments," and course materials.
- American Intellectual Property Law Association (AIPLA), 1995 Annual Meeting, October 1995, Washington, D.C. Presentation, "The Effect of the Qualitex Decision on Trademark Registration and Infringement."

Bar & Court Admissions

- Illinois
- New York
- California
- U.S. Court of Appeals, Federal Circuit
- U.S. District Court - Southern District of New York
- U.S. District Court - Eastern District of New York
- U.S. District Court - Central District of California
- U.S. District Court - Northern District of California
- U.S. Supreme Court
- U.S. Court of Appeals, Ninth Circuit