



# ALEX BUTTERMAN

## PARTNER

Alex Butterman's practice covers all facets of trademark prosecution and practice before the U.S. Patent and Trademark Office (USPTO) and virtually every trademark office around the world with the help of an extensive network of foreign associates. Alex has also been counseling a diverse group of foreign and domestic businesses in a variety of industries and commercial sectors since 1995 at all stages of development - assessing and searching the availability of marks; establishing, enforcing, and maintaining trademark and service mark rights; resolving intellectual property disputes; handling internet domain name IP issues, anti-counterfeiting matters, copyright prosecution, IP licensing and transactional matters, and intellectual property research and due diligence investigations.

## CONTACT

Call  
571-577-8369

Email  
abutterm@dbllawyers.com

## PRACTICE AREAS

Corporate Transactions & Finance  
Intellectual Property  
Litigation & Disputes

## INDUSTRIES

Alcohol Beverage Law  
Automotive  
Banking  
Cannabis  
Government Contracting  
Health Care  
Insurance  
Manufacturing  
Media & Entertainment  
Non-Profits  
Retail and Consumer Products  
Software  
Technology

## OFFICE

Leesburg, VA

## EDUCATION

- Juris Doctor, St. John's University School of Law
- B.A., Psychology, Lehigh University

## ADMISSIONS

- Virginia
- Washington, D.C.
- New York
- New Jersey
- United States District Court, District of New Jersey

## EXPERIENCE

- In re Speccomm International, Inc., Applic. Ser. No. 75300898 (TTAB Feb. 28, 2001): successfully defended a descriptiveness refusal appealed by the applicant, as an Examining Attorney at the U.S. Patent and Trademark Office ("USPTO").
- In re J.R Simplot Company, U.S. Registration No. 2787936 for BIG EE: successfully persuaded the examining attorney to withdraw her final refusal to register the mark BIG EE for "french fried potatoes" (subsequently amended) over three BIGGIE formative registrations owned by Wendy's International Inc.
- Epoch Company, Ltd. v. Epoch Design, L.L.C., Canc. No. 92045688 (TTAB March 9, 2009): Represented Epoch Company Ltd. in its petition to cancel a registration for EPOCH DESIGN in class 28 for various toy goods and settled cancellation action by persuading Epoch Design to delete the toy goods from its registration.
- In re Print Industries Market Information and Research Organization, Reg. No. 3581860 (Jan. 31, 2009): Successfully overcame a final refusal of the examining attorney to register the class 16 printed publication goods because the identification of goods was allegedly beyond the scope of the original application; the examining attorney approved the application after reviewing the applicant's persuasive appeal brief.



**DUNLAP  
BENNETT &  
LUDWIG**

- OpenSpace Inc. v. OpenSpace, LLC, Opp. No. 91196063 (TTAB Dec. 10, 2010): Successfully negotiated a coexistence agreement for concurrent use of the identical OPENSOURCE mark between client's commercial real estate listing and advertising service and a junior user's leasing and renting of temporary workstations and work areas.
- mami Limited v. Himani Gupta, Opp. No. 91200679 (TTAB Nov. 27, 2013): successfully defended client's application to register HIMANI MAKEUP – SKINCARE and Design for cosmetics in class 3 from an opposition by the owner of the registered HIMANI (standard character) mark for class 5 medicated preparations and topical solutions by negotiating a coexistence and settlement agreement between the parties.
- Alion Science and Technology Corporation v. Washington Consulting Corporation, Canc. No. 92058434 (TTAB Aug. 3, 2014): successfully negotiated a coexistence agreement for concurrent use of virtually identical WASHINGTON CONSULTING marks after petitioning to cancel a junior user's registration.
- Baoding Baigou Outlander Backpack Limited Liability Company v. Sam Direct Global Trade Co., Limited, Opp. Nos. 91217400 + 91217784 (consolidated) (TTAB May 29, 2015): successfully opposed two bad faith applications filed by client's competing Amazon.com seller.
- Yupoong, Inc. v. Hasmukh Dholakiya, Opp. No. 91220512 (TTAB Jan. 29, 2016): Opposed and successfully settled an opposition to an application for a very similar mark and related goods.
- Yupoong, Inc. v. HBI Branded Apparel Limited, Inc., Opp. Nos. 91223056 + 91224198 (TTAB Dec. 22, 2015): Consolidated oppositions to prevent the registration of two COMFORT FLEX FIT marks (with and without design) over Yupoong's well-known FLEXFIT mark for headwear, including related oppositions in various other jurisdictions (Brazil, Europe, China, etc.); settled with a global coexistence agreement.
- Yupoong, Inc. v. Neo Sports Lab, Opp. No. 91234268 (TTAB Mar. 27, 2019): Successful final decision granting opposition to the registration of the FLEXUFIT mark for sports braces and joint supports in view of Yupoong's well-known FLEXFIT mark for headwear and sportswear and formerly for sports braces.
- Yupoong, Inc. v. Rhone Apparel, Inc., Opp. No. 91239475 (TTAB July 9, 2019): Opposed the registration of the FLEXKNIT mark for clothing on behalf of Yupoong's FLEXFIT registered marks and negotiated a coexistence agreement between the Parties.
- Pacific Isles International Trading Inc. v. Rosie S. Barrett, Canc. No. 92062031 (TTAB Dec. 10, 2020): Successfully prosecuted a cancellation action based upon a trademark ownership dispute between two sisters who had a falling out in the co-operation of a Filipino food import business. The cancellation action was decided by Registrant's failure to file the Section 8 Declaration of Continuing Use.
- Lonely Cow Wines (NZ) Limited v. Lonely Dog GP Limited, Opp. No. 91234583 (TTAB March 1, 2019): Defended a consolidated opposition against client's two applications with respect to the wine goods in each and successfully negotiated a settlement.
- Mobile Gaming Technologies, Inc. v. Bitcoin Ltd., Canc. No. 92067342 (TTAB June 12, 2019): Successfully defended a petition to cancel the client's registration based upon alleged non-use by presenting evidence of use in client's Answer and petitioner instantly ceased prosecuting the cancellation action.
- Bawarchi Biryani, LLC v. Rajesh Routhu, Canc. No. 92070265 (TTAB July 18, 2019): Responded to a petition to cancel client's registration with a counterclaim to cancel petitioner's two asserted registrations and petitioner became motivated to promptly negotiate a coexistence agreement with the client.
- Logistics Management Institute v. SAP National Security Services, Inc., Opp. No. 91250585 (TTAB Jan. 9, 2020): Opposed an application for a slogan virtually identical to the client LMI's slogan and negotiated a settlement that required SAP to institute use restrictions in its adoption of the slogan mark.
- Directus Consulting LLC v. RANGER Studio, LLC, Opp. No. 91253534 (April 15, 2020): Procured registrations for Directus Consulting over two earlier-filed, virtually identical registered or applied-for marks by negotiating a registration consent with the owner of the earlier DIRECTUS registration and opposing the Ranger Studio owner of a prior pending DIRECTUS application which resulted in Ranger's abandonment of its opposed application.
- Manage a portfolio of 150+ U.S. trademarks for a New Zealand based multi-national toy and consumer goods company, including having filed more than 50 new applications for them in 2022.



- Manage and enforce an international portfolio of trademarks for a Korean headwear manufacturer and owner of the second leading brand of headwear in the U.S. (FLEXFIT) for 15+ years, including registering marks and filing trademark oppositions around the world, negotiating trademark licensing and distribution agreements, and counseling on same.
- Managing and monitoring the trademark portfolio for PODS Moving and Storage and counseling and assisting on enforcement efforts for a well-known brand.
- Portfolio management for a nationally known culinary arts institute based in NY State.
- Managed the U.S. trademark portfolio for a multi-national Japanese software and information technology conglomerate.
- Examined, searched and counseled, filed, prosecuted, maintained and enforced several thousand trademarks and service marks since 1995, including being attorney of record in 85+ Trademark Trial and Appeal Board (TTAB) cases at the USPTO, mostly all of which were contested matters. Successfully prevailed in or settled over three quarters of these TTAB cases.
- Examined more than 1,500 trademark applications as an Examining Attorney at the U.S. Patent and Trademark Office.

## PUBLICATIONS

- Webinar Panel: TIMEOUT! Understanding NIL & NCAA Bounds (Oct. 26, 2021)
- Webinar Panel: Preparation And Prosecution Of Trademark Applications: A Comprehensive Guide (Feb. 20, 2019)
- Webinar Panel: Best Practices in Protecting Your Brand and The Fundamentals of Trademark Law: A 2017 Perspective (June 21, 2017)
- Webinar Panel: Tips for Effectively Searching the USPTO Database Using TESS – Part 2: Design Searching, State Bar of California, Intellectual Property Law Section (Dec 10, 2013)
- "‘Trademark Bullying’ – Time To Get Some Clear Definitions," World Trademark Review / The IP Media Group · Jul 2, 2013 (collaboration), WTR Issue 44 LR (August/September 2013)
- "‘Has Bose ‘Blown Away’ The Trademark Fraud Cancellation Crusade at the USPTO?" Intellectual Property Today (June 1, 2010)
- "THE LEGAL VIEW : An Ounce of Prevention is Worth a Pound of Cure"
- IGAL Newsletter (Jan. 1, 2007) (collaboration)
- "Baseball's Antitrust Exemption and an Owner-Imposed Salary Cap: Can They Coexist?" ABA's Entertainment and Sports Lawyer, Vol. 12, No. 3 (1994-1995) (Sep 1, 1994)

## PROFESSIONAL ASSOCIATIONS AND MEMBERSHIPS

- International Trademark Association (INTA) serving on its committees since 2006, including the Emerging Issues Committee; Enforcement Committee (task force leader); Law Firm Membership Committee; and Online Reference Materials Committee.
- American Intellectual Property Law Association Trademark Committee for the past 10+ years.

## HONORS & AWARDS

- 2022 Recognized as a Global Intellectual Property Leader in the 2022 edition of World Intellectual Property Review ("WIPR")
- 2020 Awarded Senior Counsel of the Year at DBL.
- 2013 Top Contributor by Avvo (earned 1,500 contributor points for answering legal questions from visitors to the www.avvo.com website).



## FULL BIO

Alex Butterman's practice covers all facets of trademark prosecution and practice before the U.S. Patent and Trademark Office (USPTO) and virtually every trademark office around the world with the help of an extensive network of foreign associates. Alex has also been counseling a diverse group of foreign and domestic businesses in a variety of industries and commercial sectors since 1995 at all stages of development - assessing and searching the availability of marks; establishing, enforcing, and maintaining trademark and service mark rights; resolving intellectual property disputes; handling internet domain name IP issues, anti-counterfeiting matters, copyright prosecution, IP licensing and transactional matters, and intellectual property research and due diligence investigations.

As an Attorney Advisor in Law Office 106 of the USPTO trademark examining operations for three years, Alex examined thousands of trademark applications in the fields of cosmetics, toiletries and cleaning preparations, publications and office supplies, toys and sporting goods, and service mark applications for all types of services, and defended registration refusals before the Trademark Trial and Appeal Board.

Professionally, Alex has been an active member of the International Trademark Association, participating in four of its committees for the past six consecutive committee terms (twelve years) as well as on the trademark committee of the American Intellectual Property Law Association.

Additionally, Alex enjoys spending time with his wife and kids, is an avid baseball fan, and takes pleasure in watching football, traveling, skiing, and playing golf, tennis, and other recreational sports.

