



Kelly P. McCarthy

Partner

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Services

Brand Integrity and Innovation Group
Business
Intellectual Property

Biography

Kelly McCarthy represents clients in relation to brand protection issues, trademark enforcement and portfolio management. Her clients include public and private entities, from emerging regional companies to global industry leaders.

Ms. McCarthy advises clients on a variety of trademark and brand protection issues, including matters involving product and corporate name selection; trademark availability and clearance; worldwide branding strategies; trademark related agreements including licenses; management and prosecution of worldwide and US trademark portfolios; disputes before the U.S. Trademark Trial and Appeal Board; domain name disputes and cybersquatting concerns; foreign, domestic and online anti-counterfeiting and enforcement measures; advertising, claims and promotions, and social media and Internet marketing issues.

Ms. McCarthy specializes in the development and implementation of customized and comprehensive brand protection programs that focus on global trademark portfolio growth while combatting product counterfeiting concerns and other infringements.

Prior to joining Sideman & Bancroft LLP, Ms. McCarthy was Of Counsel at Tomlinson Zisko LLP.

Representative Matters

Intellectual Property Counseling

- Ongoing representation of Varian Medical Systems, Inc., a Fortune 1000 multinational developer and manufacturer of medical devices and software for cancer treatment, in trademark matters and other selected intellectual property issues
- Ongoing representation of Stella & Dot LLC, popular designer of apparel, accessories, cosmetics and

skincare, in all aspects of intellectual property development, anti-counterfeiting and enforcement matters

- Ongoing representation of Welly Health PBC, a popular emerging company in the personal care space, in all aspects of intellectual property development and enforcement matters
- Ongoing representation of ILIA Beauty, a popular maker of clean cosmetics and skin care, in all aspects of intellectual property development, anti-counterfeiting and enforcement matters
- Advised Kat Von D Beauty, Bite Beauty, Fenty Beauty by Rihanna, Marc Jacobs Beauty, Ole Henriksen of Denmark and parent company Kendo Brands in all aspects of intellectual property development and enforcement matters
- Ongoing representation of Magpul Industries Corp., a leading supplier of accessories for firearms for military and recreational applications, in all aspects of intellectual property development and anti-counterfeiting matters
- Ongoing representation of Method Products and its parent company Ecover, maker of environmentally conscious cleaning products, in all aspects of intellectual property development and enforcement matters
- Advised Method Products on successful multi-platform social media marketing strategy (www.votedaisy.com)
- Ongoing representation of OLLY PBC, a leading maker of vitamin, supplements and nutrition products, in all aspects of intellectual property development and enforcement matters, including the successful prosecution of the company's application for trade dress protection of its unique bottle shape
- Ongoing representation of San Diego Gas & Electric, Southern California Gas, US Gas & Power and parent company Sempra Energy, a Fortune 500 energy services company, in U.S. trademark clearance and prosecution matters
- Ongoing representation of Varex Imaging, the world's largest independent supplier of medical X-ray tubes and image processing solutions, in relation to the company's trademark matters and other selected intellectual property issues
- Trademark and IP counsel to Cedar Ridge Apple Ranch, LLC, producer and seller of the Indigeny Reserve line of alcoholic and nonalcoholic beverages
- Advisor to an up-and-coming cosmetics and skincare company in the launch of its website, including incorporation of all levels of social media promotions and guest blogging activities
- IP counsel to Limay Ventures, LLC, owner of the U.S. rights to the trademark La Bodeguita del Medio and the U.S. restaurant by that name, on, among other matters, issues arising from the ownership of the mark and its similarities to another trademark as affected by current U.S. embargoes
- Trademark and IP counsel to Stemple Creek Ranch, a California-based cattle ranch producing organic grass-fed beef and lamb
- Counsel to Passport Resorts, owner of a collection of high-end hotels and restaurants in IP matters arising in relation to its hotel and restaurant properties
- Management of domestic and international trademark prosecution matters, including counseling, USPTO filings, management of local counsel, watch service monitoring, and content and trademark licensing, for Incase Designs Corp., a developer of personal electronics accessories
- Counsel to venture-backed start-ups RockYou, Xignite, Inc., and Glassdoor, Inc., in all U.S. and international trademark prosecution matters

Intellectual Property Enforcement

- Development and implementation of comprehensive anti-counterfeiting program for Kat Von D Beauty including policing of online markets and customs enforcement
- Counsel to a well-known California winery in relation to claims against a former employee for trade dress infringement, trademark infringement and passing off, copyright infringement, theft of trade secrets, and breach of contract
- Counsel to major international personal electronics brand in relation to anti-counterfeiting efforts and enforcement of trademark rights in the United States
- Counsel for oversight and management of all online intellectual property enforcement efforts for a popular children's entertainment franchise and a well-known fashion and lifestyle brand
- Co-counsel/trademark subject matter specialists with regard to geographical descriptiveness claims on behalf of a well-known California winery in a Trademark Trial and Appeal Board (TTAB) cancellation action
- Representation of Testarossa Vineyards, LLC, a California producer of award-winning Chardonnays and Pinot Noirs, in an action for trademark infringement against an Italian winery and its U.S. importers
- Management of domestic and international trademark enforcement matters, including counseling, watch service monitoring, web monitoring, investigation, cease and desist demands, TTAB proceedings, litigation, and settlement negotiation, for Incase Designs Corp., a developer of personal electronics accessories

Mergers and Acquisitions

- Representation of the selling stockholders of Advanced Portfolio Technologies, Inc., a provider of software and data products supporting investment advisory services, in its sale to SunGard
- Special IP counsel to Incase Designs Corp., a designer and developer of carrying solutions for consumer electronics, in the leveraged buyout of Incase by Swander Pace
- Special IP counsel to Incase Designs Corp., in the acquisition of Incase by Incipio Technologies
- Special IP counsel to Varian Medical Systems, Inc. in spin-off of Varex Imaging

Professional Involvement

Ms. McCarthy belongs to the International Trademark Association (INTA), where she has served as the chair of the Academic Committee and now sits on the unREAL Campaign Committee. She is also a member of the San Francisco Intellectual Property Association and the Personal Care and Products Council. Ms. McCarthy is the author of a number of articles and journal publications and speaks and writes frequently on intellectual property issues.

Ms. McCarthy is a member of the West Coast board of directors for buildOn, a national charitable organization focused on breaking the cycle of poverty, illiteracy and low expectations through service and education in the United States and developing nations.

Listed in *World Trademark Review's List of The World's Leading Trademark Professionals 2017- 2020*. Ms. McCarthy is recognized as a Trademark Star in *Managing Intellectual Property's 2020* review of the world's leading IP practitioners and law firms.

Publications

- Commentary, "Counterfeiting in Cannabis: How to Protect Your Brand," Cannabis Business Times, 2019
- Kelly McCarthy advises consumers in "What's That on Your Face? Your Makeup May Not Really Be What You Think It Is" for Bob Cut Magazine
- Commentary, "Christie Brinkley Vows to Track Down, Halt Scammers," WWD, 2018
- Commentary, "Government Report Finds Amazon and Walmart Are Selling Counterfeit Products," NewBeauty, 2018
- Commentary, "How Yosemite Lost Its Historic Names - And May Win Them Back," San Francisco Chronicle, 2016
- Commentary, "Olympics Organizers Say Cybersquatter is Blocking Website for 2020 Games," Westlaw Journal Computer & Internet, 2015
- Commentary, "Who Owns Yosemite? Concessionaire Claims Trademark on Famed Sites," San Francisco Chronicle, 2015
- "Brand Protection in the Web Marketplace: A Task for Mere Mortals?" InsideCounsel, 2015
- Commentary, "With No Trademark, Sriracha Name is Showing Up Everywhere," Los Angeles Times, 2015
- "Trademark Saga for King's Candy Crush Game," San Francisco Daily Journal, 2014
- Co-author, "Co-branding: A sweet business strategy?" Westlaw Journal - Computer & Internet, 2014
- Commentary, "Big fish and Whacked Moles: How to Fight Anonymous Counterfeiters Who Are Tarnishing Your Brand," InsideCounsel, 2014
- "Online Wild West for Fakes Can Be Regulated," Intellectual Property Magazine, 2014
- "Don't Ya Just Love E-Commerce? Effective Web Monitoring Programs for Anti-counterfeiting," InsideCounsel, 2014
- "Strategic Budgeting for Anti-Counterfeiting Programs," InsideCounsel, 2014
- "Positioning Trademark Portfolios and Supply Chains to Combat Counterfeits," InsideCounsel, 2014
- Commentary, "David vs. Goliath, Trader Joe's Sues Independent Reseller 'Pirate Joe'," Forbes, 2013
- Commentary, "How to Avoid the Pinterest Bandit," Upstart Business Journal, 2012
- Commentary, "New York Federal Judge Denies Jurisdiction Over Alleged California Cybersquatter," The Westlaw Journal - Computer & Internet, 2012
- "Domain Names: Protecting Your Turf," The Street, 2012
- Co-author, "Protecting Your Budget While Protecting Your Brand," Executive Counsel, 2011
- Commentary, "Online Counterfeiting," BNA's Patent, Trademark & Copyright Law Daily™, 2011
- Commentary, "How to Spot a Counterfeit Product," Mainstreet.com, 2011
- Commentary, "What did Yosemite get for the \$12 million paid to its former concessionaire?" San Francisco Chronicle, 2019
- Commentary, "Why Continued Community Engagement Is Critical Alongside Pepsico's Removal Of Aunt Jemima Brand," the World Trademark Review, 2020

Speaking Engagements

- Kelly McCarthy and Erica Brand Portnoy present "Brand Protection and Counterfeiting: So Many Bad Guys, So Little Time" for the 2019 Legal & Regulatory Conference of the Personal Care Products Council
- Kelly McCarthy and Erica Portnoy discuss counterfeit and gray marketing issues in "Welcome to the Jungle" at the 2018 Legal & Regulatory Conference of the Personal Care Products Council

- Kelly McCarthy and Jill Feinberg discuss “You Wanna Call It What?? Effective Clearance Strategies for Product, Shade and Fragrance Names in the Personal Care Industry” at the Personal Care Products Council’s May Conference
- Polly Dinkel and Kelly McCarthy present “Can You Say That? Comparative Advertising and Trademark Usage in the Personal Care Industry” for The Personal Care Products Council
- Kelly McCarthy and Rick Nelson present “The Two Towers Of Evil: Fighting Gray Market And Counterfeiting In The Personal Care Industry” at The Personal Care Products Council’s 2016 Legal and Regulatory Conference
- Kelly McCarthy joins panel discussion for INTA webcast, “The XX Factor: Women and Trademark Law”
- Kelly McCarthy discusses “Developing an Effective Anti-Counterfeiting Program” in a webinar for the Commercial Law WebAdvisor
- Kelly McCarthy and Beatrice Martinet speak at the “IP Issues in the Food and Beverage Industries” conference in Napa
- Kelly McCarthy speaks on “Social Media and the Law” at the West Coast General Counsel Conference
- Kelly McCarthy speaks on “Social Media and the Law” at the Bar Association of San Francisco
- Polly Dinkel, Kelly McCarthy and Alisa Won speak at the ACC event “Essentials for Start-Ups: A Legal Toolkit for In-House Counsel”
- Kelly McCarthy speaks on “Online Counterfeiting” at the General Counsel Conference West Coast
- Kelly McCarthy speaks at the NAMWOLF Regional Meeting on “The Ethics of the Internet and Social Media for In-House and Outside Counsel”
- Kelly McCarthy presents a webinar on “Social Media in California” via the Employer Resource Institute
- Kelly McCarthy speaks on “Brand Portfolio Development, Enforcement Strategies and Related Acquisitions in the Digital Marketplace” at the San Francisco Intellectual Property Association
- Kelly McCarthy speaks at the INTA World Trademark Workshop in Brussels
- Kelly McCarthy presents “Social Media and the Law” at The Recorder’s Roundtable

Education

Loyola Marymount University
B.A. 1998, cum laude

University College Dublin, Ireland
1996 - 1997

University of California, Hastings College of the Law
J.D. 2001