

Allison Strickland Ricketts

Partner

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Overview

“There is no other set of lawyers with the depth of knowledge that we have to ensure that clients have strong, protectable trademark rights, informed by our extensive experience on the offensive and defensive side of matters.”

Allison Strickland Ricketts has deep experience in evaluating the availability of proposed new trademarks, developing strategies to remove obstacles to adoption and registration of trademarks, and creating strong trademark rights that her clients can use and register with confidence. She has reviewed and evaluated thousands of trademark clearance searches, and has filed and prosecuted more than 2,000 U.S. trademark applications. Allison also maintains protection for older registrations in compliance with strict U.S. standards that require the owner to demonstrate it is making valid use of a trademark in commerce.

The 2020 *World Trademark Review's* WTR 1000 noted Allison's “exceptional knowledge of USPTO

rules” and when the *World Trademark Review* was preparing its article on the “Top Takeaways from 2019,” they sought Allison's opinion and quoted her in the article. For the third time in a row, she was named to *MANAGING INTELLECTUAL PROPERTY's* list of the *TOP 250 WOMEN IN IP* worldwide, which “recognizes female practitioners in private practice who have performed exceptionally for their clients and firms in the past year.”

Allison is skilled at negotiating resolutions to disputes, preparing effective and advantageous settlement and coexistence agreements, and negotiating and drafting license agreements. Allison's thoughtful and creative advice helps individuals, entrepreneurs, and businesses of all sizes make smart and cost-effective decisions about their valuable intellectual property.

A frequent speaker on the topic of trademark law and practice, Allison is especially in demand for insights on the Madrid Protocol system, overcoming difficult Trademark Office refusals to register marks, and structuring coexistence agreements.

Allison regularly attends USPTO events near her office in Alexandria, Virginia, frequently speaking with officials from the U.S. and other countries about policy issues and changes. She is active in many industry organizations, including the American Intellectual Property Law Association, having served on its Board of Directors and chaired or vice-chaired several of its committees over the years. Allison's clients are drawn from the worlds of fashion, entertainment, consumer products, pharmaceuticals, non-profit organizations, innovative new technology, and many other industries.

Representative Experience

- Guided major apparel brand through extensive clearance and registration process to launch new men's line
- Conducted pharmaceutical naming analysis for drugs submitted for FDA approval
- Assisted with due diligence for trademark portfolio acquisitions by a winery

Education

Columbia Law School (JD, 1993)

Harlan Fiske Stone Scholar; Recipient, Samuel I. Rosenman Prize, 1993; *Columbia Journal of Law and Social Problems*, Member 1991-1992

University of Alabama (BA, *cum laude*, 1983)

Admissions

Bar Admissions

New York

Virginia

Court Admissions

U.S. Supreme Court

U.S. District Court, Eastern, New York

U.S. District Court, Southern, New York

Focus

- Consumer Products
- Professional Services
- Startup & Emerging Growth
- Pharmaceuticals

Services

- Trademark

Associations

Compumark Client Advisory Panel, 2016-2018

American Intellectual Property Law Association (AIPPLA) (Board of Directors, 2005-2008; Amicus Committee, 2009-2012; Special Legislation Committee, 2011-2014; FDA Clearance of Trade Names/Brands Subcommittee, 2008-2009; Trademark Law Committee, Chair 2004-2005, Vice-Chair 2003-2004; Trademark Treaties and International Law Committee, Chair 2001-2003, Vice-Chair 2000-2001; TTAB Sub-Committee, Chair 1999-2001)

Intellectual Property Owners' Association

U.S. Trademark Office Practice Committee (Vice-Chair 2015-2017, Member 2009- 2014)

American Inns of Court, Pauline Newman Inn, 2013-2014

Recognition

Managing Intellectual Property's "Top 250 Women in IP" by IP Stars 2016-2020

Managing IP's IP Stars 2015-20

World Trademark Review Global Leader 2020-20

World Trademark Review's WTR 1000 2014-2021, "Ricketts is one of the foremost minds in the country on USPTO practice and the Madrid Protocol."

The Best Lawyers in America® in the field of Trademark Law 2015-2021

Who's Who Legal: Trademarks Global Leader 2020

Who's Who Legal: Trademarks 2011-2019

Lexology Client Choice Award, Trademarks 2013, 2015

American Intellectual Property Law Association (AIPLA) Mentor of the Year 2009

Speaking Engagements

Refusal of Trademark Registration, Strafford Webinar, February 9, 2021

Responding to Trademark Office Actions: Assessing Response Alternatives and Persuading the Examiner, Strafford Webinar, January 9, 2020

Responding to Trademark Office Actions: Assessing Response Alternatives and Persuading the Examiner, Strafford Webinar, September 26, 2018

Responding to Trademark Office Actions: Assessing Response Alternatives and Persuading

the Examiner, Strafford Webinar, September 12, 2017

Counseling the Non-Profit Startup, American Intellectual Property Law Association (AIPLA) Annual Meeting, October 2015

Co-Existence Agreements: Enforceability and Counseling Issues, AIPLA Trademark Bootcamp, 2014, 2016

Tricks of the Trade for the Madrid Protocol, sponsored by the International Intellectual Property Society, 2009

Tough Issues in Trademark Prosecution, part of the INTA's Next Level program, INTA's New Total Immersion Program for Up-and-Coming Trademark Lawyers. The "Next Level" program provided interactive workshops and Master Classes taught by leaders of the trademark profession to train and develop the next generation of trademark lawyers, March, 2009

Advanced Trademark Prosecution Issues (specimen-drawing agreement, mutilation, deceptive versus deceptively misdescriptive marks, geographically deceptively misdescriptive marks, coexistence agreements, foreign website evidence) The Practising Law Institute's Advanced Seminar on Trademark Law 2007

Navigating Trademark Practice Before the PTO 2006: Trademark Searching and Clearance (Reasons to search; practical tips for searching, clearance and opinions; searching in light of the Madrid Protocol), Practising Law Institute, February 23, 2006

Navigating Trademark Practice Before the PTO 2005: U.S. Implementation of the Madrid Protocol:

A Status Report, Practising Law Institute, February 24, 2005

Trademarks: Year in Review, AIPLA Annual Meeting, October 16, 2004

International Developments Affecting U.S. Trademark Law and Practice, AIPPI U.S. Conference, October 13, 2004

Madrid Protocol - One Year Later, International Trademark Association, Trademark Administrators Conference, October 3, 2004

Electronic Filings in the USPTO, INTA Trademark Administrators Workshop, April 8, 2004

Copyright and Trademark Law for the Nonspecialist: Understanding the Basics: Overview of Basic Principles of Trademark Law and Unfair Competition Law (types of marks, searching, selection, acquisition and scope of rights, domain names, dilution, update on Madrid Protocol), Practising Law Institute, March 25, 2004

Copyright & Trademark Law for the Nonspecialist: Understanding the Basics: Copyright and Trademark Licensing (fictional characters, key provisions, quality controls, and enforcement; considerations in the Internet age), Practising Law Institute, March 21, 2002

Bridge the Gap: Practice Pointers for the Newly Admitted Attorney: Copyright and Trademark Law: An Overview, Practising Law Institute, December 20, 2001

Copyright & Trademark Law for the Nonspecialist: Understanding the Basics: Copyright and Trademark Licensing (fictional characters, key provisions, quality controls, and enforcement), Practising Law Institute, March 22, 2001

Bridge the Gap: Practice Pointers for the Newly Admitted Attorney: Copyright and Trademark Law: An Overview, Practising Law Institute, February 20, 2001

Copyright & Trademark Law for the Nonspecialist: Understanding the Basics: Copyright and Trademark Licensing (fictional characters, key provisions, quality controls, and enforcement), Practising Law Institute, April 6, 2000

Publications

Attorneys Optimistic Pandemic Won't Disrupt USPTO Filings, quoted in *Law360* article, March 17, 2020

USPTO Revises Email Address Requirement for Trademark Owners, Lexology, February 14, 2020

New USPTO Rule Requires U.S.-licensed Lawyers for Foreign-domiciled Applicants, Registrants, and Parties to TTAB Proceedings, Lexology, July 3, 2019

Post-registration Audit Program, Lexology, March 14, 2017