

Karen Lim

Partner

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Overview

“My experience living in Asia, Europe, and the U.S. has sensitized me to cultural differences which helps me to help my clients. Whether I am assisting a U.S. client to obtain and enforce trademarks globally or advising foreign clients on U.S. trademark protection, understanding cultural nuances heightens my awareness of clients’ unspoken assumptions and enables me to answer not just the questions that were asked, but also the ones that should have been asked.”

Karen Lim brings a truly international perspective as she advises clients on the selection, clearance, prosecution, maintenance, and enforcement of trademarks in the U.S. and around the world, leveraging applicable international treaty provisions to her clients’ benefit. She brings this perspective not only to managing global trademark portfolios, but also to counseling clients on copyright, unfair competition, and domain name issues, as well as negotiating and drafting intellectual property agreements.

Karen takes a forward-looking approach when advising clients on their intellectual property strategies at all stages of a trademark portfolio’s development. From crafting and implementing a startup’s worldwide filing program to streamlining a mature portfolio to meet digital challenges and changing business objectives, Karen weighs upfront costs against long-term value. She also bears in mind the interplay among different types of intellectual property protection, drawing on trademarks, copyrights, and design patents to achieve multi-faceted and robust protection. Karen’s clients span a wide range of industries, including fashion, cosmetics, jewelry, watches, pharmaceuticals, management consulting, education, entertainment, and hospitality.

Before becoming a lawyer, Karen designed costumes for theatre and opera productions across the United States.

Representative Experience

- Conducted time-sensitive, global search projects for pharmaceutical, life sciences, and

entertainment clients, each involving tens of marks at a time

- Devised multi-mark global filing strategy for emerging social club/co-working space client
- Achieved well-known mark recognition in China for major U.S.-based global management consulting firm
- Obtained three-dimensional trademark registrations in the U.S. for major luxury goods clients
- Combated trademark piracy in China on behalf of fashion and consumer goods clients
- Successfully argued against numerous likelihood-of-confusion, descriptiveness, and surname objections before the United States Patent and Trademark Office
- Advised U.S. and foreign clients on creative, legitimate ways to meet U.S. use requirements
- Co-ordinated global, multi-mark assignment program for sports licensing client

Education

Fordham University School of Law (JD, *magna cum laude*, 2004)

Fordham Law Review, Notes and Articles Editor;
Order of the Coif;

University of Michigan (MFA, 1996)

Theatre Design

Cambridge University (MA, 1986)

English

Admissions

Bar Admissions

New York

Court Admissions

U.S. District Court, Eastern, New York

U.S. District Court, Southern, New York

Focus

- Personal Care & Cosmetics
- Hospitality & Hotels
- Entertainment Properties
- Jewelry & Watches
- Professional Services
- Celebrities, Bands & Athletes
- Startup & Emerging Growth
- Toys
- Fashion
- Pharmaceuticals

Services

- International
- Trademark

Associations

Asian American Bar Association of New York
(Director, 2012 - 2016; Co-chair, Intellectual Property Committee, 2011-2014)

New York City Bar Association (Chair,
Subcommittee for Women of Color, Women in the Profession Committee, 2009-2012)

Recognition

World Trademark Review's WTR 1000 2021

Who's Who Legal Trademarks Global Leader 2020

Super Lawyers® New York Metro Rising Stars
2013-15

Speaking Engagements

- *Structuring Trademark Clearance Opinions*, Strafford, March 2019 and July 2020
- *Choosing Local Counsel*, International Trademark Association 140th Annual Meeting, Seattle, May 2018
- *Learning to Share in the Social Media Playground: Illustrative U.S. Cases*, Asian Patent Attorneys Association, 66th Council Meeting, Bali, Indonesia, October 2016
- 13th Annual Women in Intellectual Property Law Program, New York State Bar Association, June 2015
- *Trademark Co-existence Agreements*, Seventh Annual AIPLA Trademark Boot Camp, June 2015
- *What Did You Just Call Me?! – Disparagement Under the Lanham Act* (moderator), National Asian Pacific American Bar Association, November 2014
- *Branded Products and Celebrity Likenesses in Expressive Works*, American Bar Association, June 2014
- *Enforcing Trademarks in China & Recent Developments on Chinese Trademark Law*, Trademark Talk Institute, New York City Bar, May 2014

- *Intellectual Property 101 for Journalists*, Asian American Journalists Association of New York & Asian American Bar Association of New York, July 2012
- *U.S.-Asia Trademark Issues*, Asian American Bar Association of New York, September 2011

Clerkship

Law Clerk to Hon. Harold Baer, Jr., U.S. District Judge, Southern District of New York, 2005-06

Publications

- Use It or Lose It: Truer Than Ever in the U.S.A., *The International Comparative Legal Guide to Trade Marks 2019* (with Jason Jones)
- From Disparagement to Fame and Other Key Developments in U.S. Trademark Law, *The International Comparative Legal Guide to Trade Marks 2016* (with Jason Jones)
- U.S. Chapter to *The International Comparative Legal Guide to Trademarks 2015* (with Jason Jones)