






# Catherine H. Stockell

## Of Counsel

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Catherine’s clients look to her for innovative approaches to their marketing, remarking that she is “indispensable” and “consistently proves to be a creative, quick and responsive resource.” Furthermore, in the 2018 edition of *World Trademark Review WTR 1000*, Catherine was applauded for her “organizational talents” and “forward-thinking, outward-looking mindset.”

## Overview

### About Catherine

Catherine Stockell has over thirty years specializing in the practice of trademark and copyright law. For the first half of her career, prior to joining Fish, Catherine was a partner at an IP firm where her practice focused primarily on trademark litigation, representing clients and their brands in a variety of industries including food and beverage, tobacco, sporting goods, nutritional products, healthcare, financial services, personal care products, office supplies, home and construction. Catherine now counsels clients on the adoption of new marks and brand strategy; clearance, adoption, registration and protection of trademarks and copyrights in the United States and abroad; trademark opposition and cancellation proceedings before the Trademark Trial and Appeal Board in the U.S. Patent and Trademark Office; enforcement activities, including trademark and copyright protests, takedowns, and UDRP proceedings; defense of her clients’ brands and marketing activities; negotiating successful settlement agreements; and licensing, mergers, acquisitions, divestitures and secured financings.

She has considerable experience in innovative trademark strategies in both the U.S. and abroad, including the development, protection and registration of so-called non-traditional trademarks. Catherine's extensive background allows her to provide clients with strategic advice respecting brand development, management and protection, licensing, and where required, litigation, appeals, and settlement.

## Focus Areas

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### Services

- Copyright
- Trademark
- Trademark Counseling and Prosecution
- TTAB Oppositions and Cancellations
- Digital Millennium Copyright Act
- Transactions and Agreements

### Education

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J.D., Widener University School of Law (1985) Internal Managing Editor, *Delaware Journal of Corporate Law*

B.A., English, University of the South (1980)

### Experience

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*The Scotch Whisky Association and The Black Watch Regiment v. Majestic Distilling Company, Inc.* – successful defense of trademark infringement action against use of the BLACK WATCH mark for line of distilled spirits; obtained award of attorney fees; U.S. Supreme Court denied appellants' petition for certiorari on issue of attorney fees.

*Swingline Inc. v. Staple Center, Inc.* – successful prosecution of trademark infringement action against defendant’s use of the SWINGLINE mark for replacement staples; overcame fair use defense.

*Institut National Des Appellations D’Origine v. Vintners International Company* – successful defense of appeal before the U.S. Court of Appeals for the Federal Circuit; upheld prior dismissal of opposition against application to register CHABLIS WITH A TWIST for wines.

*Breckenridge Brewing Company v. Jim Beam Brands Co.* – defense of trademark infringement action involving the mark AVALANCHE BLUE for flavored liqueur; obtained advantageous settlement.

*Mirage Productions Inc. v. Polaroid Corporation* – successful defense of trademark infringement action involving the mark MIRAGE for holographic marketing materials.

## Insights

### Publications

Quoted, “Recipe For Success: How A Food Becomes A Trademark” *Law360* (January 10, 2019).

Quoted, “Kiss Frontman Unlikely To Get ‘Horns’ Gesture Trademark,” *Law360* (June 14, 2017).

Quoted, “What’s That Smell? Play-Doh Leads Charge For Scent TMs,” *Law360* (February 23, 2017).

“Think Globally, Act Globally: Legal Considerations for Developing and Managing a Global Brand,” *World Trademark Review Yearbook 2014-2014*, with Joel Leviton (May 2014).

“Are Colors for You? A Primer on Protecting Colors as Marks in the United States,” *INTA Bulletin*, with Erin Hickey (November 15, 2009).

### Speaking Engagements

“Thinking Outside the Box: Sensible Strategies for Non-Traditional Trademarks,” *Fish & Richardson Trademark & Copyright Webinar*, with Irina Lyapis (June 28, 2017).

“Non-Traditional Marks: Marketing to the Senses with Shape, Sound, Color, and More,” *Fish & Richardson Trademark & Copyright Webinar*, with Lisa Martens and Erin Hickey (November 2011).

# Recognition

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Listed in World Trademark Review *WTR 1000*, New York, Trademark Prosecution and Strategy (2016 – 2019, 2022).

Listed in New York Super Lawyers – *MetroList* (2012-2017).

## Memberships & Affiliations

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Member, International Trademark Association (INTA)

American Bar Association

New York Bar Association