





Kristen McCallion

Principal

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Overview

About Kristen

Kristen McCallion is a principal in the New York office of Fish & Richardson P.C. and chair of the firm's copyright group. Ms. McCallion represents businesses in the consumer products, internet, media, and interactive entertainment industries in copyright, trademark, false advertising, trade dress, and unfair competition litigation in U.S. district and appellate courts and in state courts.

She advises clients on proper trademark adoption and use to increase brand awareness and maximize the value of trademark portfolios. With her clients, she develops both domestic and foreign trademark filing programs, thereby securing registration protection on a global scale, fortifying brand strength and reducing costs associated with foreign trademark disputes. Ms. McCallion also represents trademark owners in trademark opposition and cancellation proceedings in the U.S. Trademark Trial and Appeal Board.

Ms. McCallion also regularly counsels clients on a broad spectrum of copyright matters, including infringement, registration, and fair use issues. Working in collaboration with her clients, she implements filing strategies to develop comprehensive copyright registration portfolios. Ms. McCallion applies her highly specialized knowledge of copyright registration practices and procedures to formulate defensive strategies in copyright disputes and litigation. She also actively enforces her clients' copyrights against infringers.

She has been named an "IP Star" and one of the "Top 250 Women in Law" by *Managing Intellectual Property* and ranked in the top tier of trademark attorneys at the state and national level by *World Trademark Review's WTR 1000*. In the 2018 edition of *WTR 1000*, Ms. McCallion is described as an attorney who "wields superb judgement and is extremely strategic," and who is "intelligent, formidable and a pleasure to deal with; there's no time wasting with her, so you're able to get to a resolution

more quickly.” Ms. McCallion has also been selected by *Super Lawyers* New York, recommended by *The Legal 500* for Trademark and Copyright work, named to *Profiles in Diversity Journal’s* “Women Worth Watching,” featured in *The New York Times Magazine*, and named “Empire State Counsel” by the New York State Bar Association.

Prior to law school, Ms. McCallion served as a media, public relations, and corporate communications executive in the entertainment industry.

Focus Areas

Services

- Copyright
- Trademark
- Trademark Counseling and Prosecution
- TTAB Oppositions and Cancellations
- Digital Millennium Copyright Act
- Transactions and Agreements
- ITC Litigation
- Trademark, Copyright, and Media Litigation

Industries

- Consumer Products
- Digital Media and E-Commerce
- Internet

Education

J.D. *cum laude*, University of Miami School of Law (2005) Staff Editor, *Inter-American Law Review*

B.A., English, Art History, Tulane University (1996)

Experience

Full Circle United, LLC v. Skee-Ball, Inc. – Represented Full Circle United, LLC in a trademark dispute involving the term “skee-ball.” The suit involves allegations of trademark infringement against Full Circle by Skee-Ball, Inc. (“SBI”), a manufacturer of skee-ball machines, and the owner of the federal trademark registration of “skee-ball,” which has subsisted since 1929. FCU sought cancellation of the “skee-ball” trademark registration on grounds of and also filed a petition to cancel SBI’s trademark registration in the Trademark Trial and Appeal Board. The case was settled favorably.

Read Fish’s press release [here](#). This case has earned national media coverage, including the [New York Post](#), [Corporate Counsel](#) and [New York Law Journal](#). Ms. McCallion was also interviewed by NPR, which can be heard [here](#).

Kenny Kramer et al. v. Skyhorse Publishing, Inc. et al. – Represented Skyhorse Publishing in a defamation suit filed by Kenny Kramer—the real life inspiration for “Cosmo Kramer” on the *Seinfeld* television show, and owner of Kramer’s Reality Tours, Inc., which operates a bus tour in New York City. Kramer sued Skyhorse Publishing, claiming his reputation was damaged after Skyhorse published a memoir written by a former *Seinfeld* writer, in which the author recounted his experiences on the Kramer’s Reality Tour bus tour. Fish & Richardson moved to dismiss the case on the ground that defamation had not been pled. In July 2014, the Supreme Court of the State of New York granted Fish’s motion, and dismissed the lawsuit in its entirety.

Luv N’ Care Ltd., et al. v. Regent Baby Products Corp. – Fish represents the defendant, Regent Baby Products, in this trade dress litigation pending in New York in which plaintiffs claimed infringement of more than a dozen different baby feeding products. Fish was successful in dismissing plaintiff’s federal and trademark dilution claims on a 12(b)(6) motion, staying a design patent claim, and negotiating a dismissal with prejudice of all claims against the client concerning nine of the original products at issue. Then, in December 2013, Regent Baby prevailed on its motion for partial summary judgment when the court found that two of the remaining products at issue are generic, “common shapes frequently used in the sippy cup industry” that do not warrant trade dress protection under the Lanham Act. The Court also dismissed Luv N’ Care’s tortious interference claim. Read Fish’s press release [here](#).

Society of the Holy Transfiguration Monastery Inc. v. Archbishop Gregory of Denver, Colorado – Represented The Holy Transfiguration Monastery (“HTM”) located in Brookline, MA, in a copyright infringement suit alleging infringement of HTM’s copyrighted translations of ancient religious Greek texts. Presented oral argument in the U.S. Court of Appeals for the First Circuit before a three-judge panel that include retired U.S. Supreme Court Justice Souter, sitting by designation. The First Circuit affirmed HTM’s prior victories, concluding that the defendant was liable for copyright infringement and

reaffirming, in a significant opinion, that translations are copyrightable works and that the art of translation is a creative process that involves artistic choices. This decision earned national media coverage, including the National Law Journal.

McLaren v. Chico's FAS, Inc. – Successfully defended Chico's in a copyright infringement litigation in the Southern District of New York brought by artist McLaren, who alleged infringement of drawings of mannequins by three-dimensional mannequins displayed by Chico's retail outlets. Fish successfully dismissed this case with prejudice at the pleading stage, avoiding costly discovery, on the invalidity of plaintiff's copyright registration—an issue of first impression in New York.

Therapy Products Inc. d/b/a Erchonia Medical v. Bissoon, et al. (Southern District of New York) – Successfully defended four defendants in a trademark infringement, false advertising, and unfair competition litigation involving both federal and New York state law claims in the federal district court of the Southern District of New York, which granted Fish's motion for summary judgment to all defendants on all claims. In a subsequent decision, the Court ordered plaintiff to pay all defendants their attorney's fees and costs.

Therapy Products Inc. d/b/a Erchonia Medical v. Bissoon, et al. (Second Circuit Court of Appeals) – Successfully defended all defendants in the Second Circuit Court of Appeals. The appeals court granted Fish's motion to dismiss plaintiff's appeal of the district court's award of attorney's fees for lack of jurisdiction. Later, the appeals court affirmed the award of summary judgment to the defendants on all claims and ordered plaintiff to pay additional costs to defendants.

Chico's FAS, Inc. et al. v. Cache, Inc. et al. – Represented Chico's in a trade secret litigation commenced in New York state court that alleged theft of trade secrets related to clothing designs and other business information. Fish was successful in defeating Cache's attempt to remove the case to federal court where, Cache argued, the trade secret claims as they related to clothing designs were preempted by copyright law. The case was settled favorably for the client.

Inference Data LLC v. Catalyst Repository Systems Inc., et al. – Instituted an Article 75 Petition to Stay an Arbitration in the Supreme Court of the State of New York on behalf of client, Inference Data, LLC. Negotiated favorable settlement for the client of federal and state law claims involving copyright infringement, trademark infringement and unfair competition.

Aedes De Venustas, Inc. v. Venustas International, Inc. – Represented defendant in a trademark infringement and unfair competition litigation involving both federal and New York state law claims in the federal district court of the Southern District of New York. Negotiated a favorable settlement for client.

Publications and Presentations

Ms. McCallion is a contributing author to Fish's IP Law Essentials.

"Trademark, Copyright Legislation Passed as Part of COVID-19 Relief Bill," co-author, *Fish Trademark & Copyright Thoughts Blog* (January 19, 2020).

"Trademark & Copyright: 2020 Year in Review," co-speaker, *Fish Trademark & Copyright Webinar* (January 7, 2021).

"Defeating Trademark Counterfeiting in the COVID-19 Era," co-speaker, *Fish Trademark & Copyright Webinar* (December 10, 2020).

"Visual Artists Rights Act Protects Even Transient Art in the Absence of an Explicit Waiver," co-authored with John Goetz, *Fish IP Law Essentials Blog* (June 17, 2020).

"Can I Copyright My Logo?," co-authored with John Goetz, Ryan Petty, *Fish IP Law Essentials Blog* (May 1, 2020).

"Futureproofing Your Online Brand Protection Strategy," World Trademark Review's Brand Protection Online (March 5, 2019).

"2018 Trademark & Copyright Year in Review Webinar," Fish webinar (January 23, 2019).

"USPTO Announces Expedited Cancellation Pilot Program," *Trademark & Copyright Thoughts Blog* (January 28, 2019)

Quoted in, "USPTO Goes After Fakers; Experts Praise Initiative to Combat Improper Specimens, Calls for Further Action," *World Trademark Review* (March 7, 2018).

"USPTO Publishes Amendments to Trademark Rules of Practice," *Trademark & Copyright Thoughts Blog* (October 17, 2016).

"Dancing Baby May Be Headed To Supreme Court," *Trademark & Copyright Thoughts Blog* (August 19, 2016).

International Contributor, chapter 25 "The Impact of Freedom of Expression on Dilution Enforcement in the United States" of "International Trademark Dilution" (2016).

Quoted in, "Is HBO Censoring the 'Game of Thrones' Spoiler?" *Corporate Counsel* (May 10, 2016).

“Ninth Circuit Issues Amended Opinion in ‘Dancing Baby’ DMCA Notice-and-Takedown Case,” *Trademark & Copyright Thoughts Blog* (March 31, 2016).

“Thwart Counterfeiters to Save Brands: Vigilance is the best defense against copycats online and on the ground” Fish News Article (March 8, 2016).

“Feeling the Burn,” *Intellectual Property Magazine* (December 8, 2015).

“Copyright Infringement and Fair Use: Latest Developments,” Fish webinar (March 31, 2015).

Interviewed, “Women Worth Watching,” *Profiles in Diversity Journal* (September 2014).

“IP by Design: Protecting Unique Products Using Trade Dress, Patent, and Copyright Law,” Fish webinar (June 4, 2014).

“Supreme Court to decide if trademark “tacking” is properly determined by judge or jury,” *Fish Litigation Blog*, (June 24, 2014).

“Hard Issues in Soft IP – A Year in Review,” NYIPLA 2014 Annual Meeting, CLE Workshop (May 20, 2014).

“Exclusive Rights and Infringement,” 18th Annual BCLT/BTLJ Symposium: The Next Great Copyright Act (April 3, 2014).

“Protect a Distinctive Website With Trade Dress Law,” *Law360*, March 31, 2014.

Quoted in, “A Setback for Redskin Potatoes Won’t Hurt the Washington Redskins,” *TIME.com* (March 21, 2014).

“Supreme Court Decide Whether FDA Food Beverage Labeling Rules Preempt False Advertising Claims,” *Fish Litigation Blog* (January 2014).

“Federal District Court of New York Holds Google Books Project Is Fair Use,” *Fish Litigation Blog* (November 2013).

“Social Media and Intellectual Property. Should you be Doing More?” ALM 6th Annual IP Trademark, Copyright & Licensing Counsel Forum (October 22, 2013).

“Supreme Court grants *Certiorari* in copyright case *Petrella v. Metro-Goldwyn-Mayer, Inc.*,” *Fish Litigation Blog* (October 2013).

“Numerical Valuations: Copyrightable Expression Versus Discovered Fact,” *New York Law Journal* (June 2013).

Interviewed and quoted in, “Court rules resale of digital files violates copyright law,” *e-commerce law & policy* (April 2013).

“Yoga, exercise or dance?” *Intellectual Property Magazine* (March 2013).

“Fear the crowd – pitfalls of crowdsourcing for innovators,” *Intellectual Property Magazine* (November 2012).

“‘Technological gimmickry’ or a novel non-infringing use?“, *Intellectual Property Magazine* (June 2012).

“Inspiration or Infringement?“, *Intellectual Property Magazine* (November 2011).

“What Your Business Needs to Know About Copyright: Navigating the DMCA Safe Harbor and Notice and Takedown Provisions,” Fish & Richardson Webinar (June 15, 2011).

“What Your Business Needs to Know About Copyright: Registration – Why You Need to Get It Right,” Fish & Richardson Webinar (April 6, 2011).

“Are there property rights in US time-sensitive information?” with John B. Pegram, *E-commerce Law & Policy* (June 2010).

“Copyrights Are Your Business: What Your Company Needs to Know,” Fish & Richardson Web Seminar, September 10, 2008.

“This Season’s Must Have IP Rights,” with Peter Fields, *Managing Intellectual Property* (December 2007/January 2008).

“War for Sale! Battlefield Contractors in Latin America & the ‘Corporatization’ of America’s War on Drugs,” 36 *U. Miami Inter-Am. L. Rev.* 317 (2005).

Recognition

Listed in *World Trademark Review WTR 1000*, New York (2017 – 2021).

Client Choice Award – Copyright – New York by *Lexology* (2019).

Selected as an “IP Star” by Top 250 Women in IP (2013) and “IP Star” by *Managing Intellectual Property* (2013-2020).

Selected by *Super Lawyers* New York (2013-2019).

Recommended by *The Legal 500* for Trademark and Copyright work and advising “various clients on the protection of copyright works and infringement matters.”(2015).

Named to *Profiles in Diversity Journal's* “Women Worth Watching” list (2015).

Featured in *The New York Times Magazine*, Top Women Attorneys in Metro New York (2014).

Named “Empire State Counsel” by the New York State Bar Association for providing over 50 *pro bono* hours (2013).

Recommended for “Intellectual Property – Copyright” in *Legal 500* United States (2011-2013).

Selected by *Super Lawyers* New York as a Rising Star (2011, 2012).

Memberships & Affiliations

Member, Copyright Society of U.S.A., New York Chapter

Member, New York Intellectual Property Law Association

Member, IPO Copyright Law & Practice Committee (2010-present)

Member, American Intellectual Property Law Association (AIPLA), Copyright Law Committee (2012-present)

Member, International Association for the Protection of Intellectual Property (AIPPI)

Member, International Trademark Association (INTA), Saul Lefkowitz Committee (2013-present)