






Lisa Greenwald-Swire

Principal

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World Trademark Review 1000 notes that Lisa has a “**diverse practice**” and “**a 100% success rate at the Trademark Trial and Appeal Board (TTAB)**.” Of her work, one happy client comments: “Timeliness and professionalism are her distinguishing characteristics, and **I feel lucky to have her as a partner** – she does a wonderful job.”

Overview

About Lisa

Lisa Greenwald-Swire helps companies of all sizes to develop, protect, and maintain their trademark portfolios, both within the U.S. and around the world. Her practice focuses on prosecution and counseling, including brand strategy, strategic portfolio development, and licensing. Throughout her career, she has overseen the diligence on billion-dollar acquisitions, represented trademark holders in hundreds of TTAB matters, managed thousands of global trademarks, and helped innovative start-ups develop their portfolio strategies. A leader within the firm, Lisa serves as the head of the Silicon Valley office trademark and copyright practice group and an elected member of the firm's management committee.

Lisa has extensive experience handling global enforcement programs and opposition and cancellation proceedings before the Trademark Trial and Appeal Board (TTAB). She has managed numerous trademark and copyright infringement matters in U.S. district courts, including against large, well-known opponents such as Nintendo of America, Turner Entertainment, and Monster Energy. Lisa has also worked on over 300 TTAB cases with an impressive record of success, and she has successfully resolved numerous domain name disputes under the Uniform Domain-Name Dispute-Resolution Policy (UDRP). In addition, Ms. Greenwald-Swire advises clients on issues related to advertising claim substantiation, false advertising, social media strategy, rebranding, and licensing agreements.

Lisa has served as an experienced counselor in numerous major transactions, including her oversight of the diligence behind the 2021 acquisition of a \$10 billion semiconductor company. She also manages thousands of trademarks globally for companies ranging from start-up ventures to multi-billion-dollar multinationals.

Lisa was named one of the Top 250 Women in IP and an IP Star by *Managing Intellectual Property* and a Top 20 Under 40 Attorney by the *Daily Journal* (2013). She has also been recognized in the World Trademark Review 1000 for California Trademark Prosecution and Strategy since its inaugural issue in 2011.

Previously, she clerked for the Honorable David O. Carter of the U.S. District Court for the Central District of California (1999-2000). She also clerked for Judge John E. Munter of the city and county of San Francisco superior court (1997), was a legal assistant at the office of the corporation counsel in the civil division (1993, 1995-1996), and was a reader and assistant to Judge David Tatel of the U.S. District Court of Appeals for the D.C. Circuit (1995).

Lisa writes extensively on current trademark issues. She also teaches a course on trademark strategy and trends at the University of California, Santa Barbara.

Focus Areas

Services

- Copyright
- IP Licensing, Transactions, and Agreements
- Trademark
- Advertising and Marketing
- Domain Names and Internet
- Trademark Counseling and Prosecution

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

Industries

- Consumer Products
- Digital Health
- Digital Media and E-Commerce
- Electrical and Computer Technology
- Energy and Petrochemical
- Financial and Business Services
- Life Sciences
- Transportation

Education

J.D. *cum laude*, Georgetown University Law Center (1999) Editor-in-Chief, *The Georgetown Journal of Legal Ethics*

B.A. *with honors*, *Phi Beta Kappa*, *Phi Kappa Phi*, *Sigma Iota Rho*, *Pi Sigma Alpha*, Political Science, English, University of Michigan

Experience

Manages over 1,000 trademark filings for digital entertainment company Playtika, and defends the company in numerous trademark oppositions, including in disputes with Nintendo of America, Monster Energy, and Turner Entertainment.

Served as counsel for Marvell Semiconductor Inc. in support of two high-profile, billion-dollar acquisitions of innovative companies in the semiconductor industry. Fish performed the trademark and copyright diligence behind Marvell's \$10 billion acquisition of Inphi Corporation as well as the \$1.1 billion acquisition of Innovium, Inc., both of which were completed in 2021. Fish continues to

manage over 2,000 trademarks globally on behalf of Marvell.

Playtika v. Playtronica Oue – Successful negotiation of agreement and limitation of other side's PLAYTRONICA application

Marvell v. MixMarvel – USPTO acceptance of our letter of protest and successful negotiation of a co-existence agreement and limitation of the opposing side's filings.

On behalf of semiconductor manufacturer Marvell, conducted a successful negotiation of a co-existence agreement and limitation of the opposing side's filings.

Marvell, Inc. v. LEYFA Measurement SAS – Successful negotiation and limitation of other side's filing and letter of undertaking.

U.S. District Court Cases

Pro Shore LLC v. Dayton Superior Corp. – Represented Dayton Superior Corp. in a trademark infringement suit filed in the Northern District of California. Obtained Dismissal with Prejudice for the client.

Sheex Inc. v. BedGear LLC – 1:14-cv-01380-LPS – Represented Sheex, Inc. a company that specializes in bedding and nightwear made from “performance” fabrics. She assisted Sheex in the counterclaim complaint by its competitor Bedgear for infringement of their trademarks. In Bedgear's answer, Defendant Bedgear denied infringement of Sheex Patents and brought Counterclaims against Sheex for trademark infringement of Bedgear's PERFORMANCE-formative marks, among others. Through patience and a lot of hard-fought negotiation, a settlement was reached.

Car-Freshner Corporation et al. v. TD Auto Finance LLC – Represented TD Auto Finance, LLC in trademark infringement case brought by Car-Freshner Corporation regarding distributed advertisements in the shape of trees. Obtained favorable settlement for the client.

K2 Intelligence, L.L.C. et al. v. K2 Advisors, L.L.C. et al. – Represented K2 Advisors in a declaratory judgment action related to K2 Intelligence's use of K2 INTELLIGENCE for its business services. Obtained favorable settlement for the client.

Josh Agle Inc. v. American Greetings Corporation – Represented defendant American Greetings in a copyright infringement suit filed in the Central District of California. Obtained a favorable settlement for the client.

Aliphcom v. Bose Corporation – Represented defendant Bose in a declaratory judgment suit filed in the Northern District of California, involving trademark infringement relating to use of Bose’s WAVE® mark. Obtained a favorable settlement for the client.

San Francisco Technology, Inc. v. Solgar, Inc. – Represented defendants NBTY, Inc. and Solgar, Inc. in this false marking patent case filed in the Northern District of California. Obtained a favorable settlement for the client.

Reason Foundation v. The Reason Project – Represented The Reason Foundation, a well-known non-profit organization promoting libertarian principles, in a trademark infringement and unfair competition action relating to the use of the REASON mark by The Reason Project, a non-profit organization promoting secular values. Obtained a favorable settlement for the client.

TTAB Cases

Playtika v. Lotum One GmbH – Successful opposition against WORDBLITZ application

Blisslights, LLC v. Shenzhen Nanxin Technology – TTAB order granting judgment by default in BlissLights’ favor against Shenzhen Nanxin Technology Limited. Accordingly, Nanxin’s application for registration of the STAR PROJECTOR mark was refused.

Gilead Sciences, Inc. vs. Intarcia Therapeutics, Inc. – Enforced trademark rights regarding Gilead’s TRUVADA mark adverse to Intarcia’s ZAVADA mark. Resulting in a favorable settlement agreement for Gilead, and abandonment of the ZAVADA trademark application.

US TTAB Opposition v. Armada USA – Enforced trademark rights for Marvell Technology Group, Inc. and settled a US TTAB Opposition v. Armada USA, regarding Marvell’s registered ARMADA mark adverse to Armada’s A ARMADA & Design trademark application. Resulting in a favorable settlement agreement for Marvell, and abandonment of the Armada USA’s mark for A ARMADA & Design.

Franklin Resources, Inc. v. AF Holdings, L.P. – Represent Franklin Resources, Inc. in opposition to application to register FRANKLIN SQUARE CAPITAL PARTNERS – case pending

eHarmony, Inc. v. InqHire Corporation – Represented eHarmony, Inc. in opposition to application to register JOBHARMONY. Case resolved on summary judgment for eHarmony, Inc., opposition was sustained, and JOBHARMONY application was rejected.

Computer Geeks, Inc. v. COMPGEEKS.COM – Represent COMPGEEKS.COM in opposition to application to register COMPUTER GEEKS – case pending

UDRP Cases

Successful UDRP on behalf of semiconductor manufacturer Marvell in regards to the MARVELL.INFO domain name.

eHarmony Inc v. Brett Donovan – Represented eHarmony, Inc. in domain name dispute involving the domain name. Obtained favorable panel decision transferring domain to eHarmony, Inc.

eHarmony Inc. v. Errol Scarlett – Represented eHarmony, Inc. in domain name dispute involving the domain. Obtained favorable panel decision transferring domain to client.

Insights

Publications

- “Drug Ads and Social Media: A Toxic or Lifesaving Combination?” *Pharmaceutical Compliance Monitor* (October 2013)
- “Protecting your brand in the social media environment,” *World Trademark Review Roundtable Issue 39* (October/November 2012)
- “Cost-Effective Enforcement Strategies for a Challenging Economy,” *The Computer and Internet Lawyer*, 27, 6 (June 2010)
- “Moral Ethics,” *The Georgetown Journal of Legal Ethics*, 12, 3 (Spring 1999)

Speaking Engagements

- “Protecting brands on Social Media,” *Fish Trademark and Copyright Webinar* (June 2019)
- “Getting A Win On E-Commerce Platforms: Successes, Failures & Lessons Learned,” *Consero’s Brand Protection & Anti-Counterfeiting Executive Roundtable* (March 2019)
- “Brand Infringement On Social Media: Navigating Enforcement Options & Best Practices,” *Consero: Brand Protection & Anti-Counterfeiting Executive Roundtable* (March 2018)
- “Empowering Men and Women to Build an Infrastructure that Helps Women Thrive” (December 2017)
- “TTAB Year in Review,” *All Hands Meeting* (October 2015)
- “Into the Breach: Identifying and Prioritizing Online Threats,” *Consero Brand Protection & Anti-Counterfeiting Executive Roundtable* (July 2015)
- “Investigation and Enforcement Strategies to Counter Evolving Threats to Your Brand and Product,” *Consero Brand Protection & Anti-Counterfeiting Executive Roundtable* (July 2014)
- “IP by Design: Protecting Unique Products Using Trade Dress, Patent, and Copyright Law,” *Fish webinar* (June 2014)

- “Successfully Positioning Medical Devices for Protection and Approval,” *BIOMEDevice Wireless Medical Devices WEST* (December 2013)
- “Trademarks Introduction,” University of Santa Barbara (February 2013)
- “What Your Business Needs to Know About Copyright – Navigating the DMCA Safe Harbor and Notice and Takedown Provisions,” *Fish & Richardson Web Seminar* (June 2011)
- “What Israeli Companies Really Need to Know About IP in the US,” Israel (January 2011)
- “IP, the New Commodity: Monetizing Your Copyrights and Trademarks,” *Corporate Counsel’s IP Trademark, Copyright & Licensing Forum* (September 2010)
- “Product Life Cycle Management,” *Bay Area Pharma and Life Sciences IP Summit* (February 2010)
- “Cost-Effective Brand Enforcement Strategies for a Challenging Economy,” *PLI’s 15th Annual Institute on Intellectual Property Law* (October 2009)
- “Hot Topics in New Media,” Fish & Richardson and Field Fisher Waterhouse (2008)

Recognition

- Recognized as a notable practitioner in Intellectual Property, Copyright & Trade Secrets: Transactions, *Chambers USA* (2022)
- Listed in *World Trademark Review 1000* in California and nationally for trademark prosecution and strategy (2011-2022), and for enforcement and litigation in 2018. *WTR 1000* notes that Lisa has a “diverse practice” and “a 100% success rate at the Trademark Trial and Appeal Board (TTAB).” Of her work, one happy client comments: “Timeliness and professionalism are her distinguishing characteristics, and I feel lucky to have her as a partner – she does a wonderful job.”
- “IP Star,” *Managing Intellectual Property* (2013-2014, 2016-2022)
- Northern California *Super Lawyers* (2013-2019, 2021)
- “Women Worth Watching,” *Profiles in Diversity Journal* (2018, 2020)
- “Guide to the World’s Leading Trade Mark Law Practitioners,” *The Legal Media Group* (2018)
- “IP Star,” *Managing Intellectual Property’s Top 250 Women in IP* (2013, 2015)
- California *Super Lawyer, Top Woman of Law* (2013-2015)
- “Top 20 Under 40” Attorney by the *Daily Journal* (2013)
- Named one of California’s Top Intellectual Property Lawyers by the *Daily Journal* (2012)

Clerkships

U.S. District Court for the Central District of California, The Honorable David O. Carter, 1999 - 2000

Memberships & Affiliations

Intellectual Property Advisory Panel, American Law Institute CLE

Member, International Trademark Association (INTA); Emerging Issues Committee (2022-2023); Internet Committee, Online Trademark Use Subcommittee (2014-present); Famous & Well-Known Marks Committee, North

America Subcommittee (2010-2013); Internet Committee (Fall 2006-2009); Alternative Dispute Resolution Committee (Spring 2002-Fall 2006)

Member of the Board of Directors and Civil Rights Committee, Anti-Defamation League (Spring 2002-current)

American Bar Association

Association of Trial Lawyers of America

National Association of Women Business Owners (NAWBO)