

RIEBLING



Peter J. Riebling

Partner

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Peter J. Riebling devotes his practice to trademark, copyright, unfair competition and advertising issues, with a focus on global strategy, counseling, disputes, litigation and licensing. For more than 20 years, he has managed and directed teams for some of the world's most respected brands, and is consistently recognized as one of Washington, DC's top trademark lawyers.

Peter works closely with clients as a collaborative team focused on achieving a common goal. He manages and directs trademark and copyright enforcements, online and social media take-down actions, foreign anti-counterfeiting actions, domain name arbitration proceedings, large global trademark portfolios, licensing, and due diligence. He has obtained injunctive relief against client competitors in trademark infringement litigation, and obtained injunctive relief in trade secret and breach of contract litigation.

Peter routinely negotiates copyright, software, technology and trademark licensing agreements, and advises companies on advertising regulatory compliance and rights of publicity. He represents numerous pro bono clients, and is a frequent lecturer on intellectual property at the American University Kogod School of Business.

Peter personally negotiated the sale of a now-famous trademark to Apple in face-to-face negotiations with Steve Jobs, and co-authored a US Supreme Court *amicus* brief filed by Dr Pepper/Seven Up, Inc. in *Qualitex Corp. v. Jacobson Products Co.* on the successful issue of whether color may be subject to trademark protection. In addition, Peter provided written testimony to the Chairman of the House Subcommittee on Courts and Intellectual Property prior to passage of the Federal Trademark Dilution Act and has been a featured speaker for the District of Columbia Bar on trade secret litigation strategies.

Peter is an acknowledged leader in the intellectual property community, with consecutive peer recognition rankings in the *World Trademark Review's WTR 1000* (2011–present).

Prior to founding Riebling IP, Peter was a partner for 13+ years at Katten Muchin Rosenman LLP, and prior to that he was an equity partner at Arter & Hadden LLP, where he was the partner in charge of associates in Washington, DC. Before practicing law, Peter worked at the White House Office of National Service and served as campaign manager for a US Senate election.

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Education

JD, Southwestern Law School

BA, University of California, Los Angeles

Bar Admissions

District of Columbia

Virginia

California

Court Admissions

US Supreme Court

US District Court, District of Columbia

US Court of Appeals, Federal Circuit

US Court of Appeals, Fourth Circuit

US District Court, Eastern District of Virginia

US Court of Appeals, Ninth Circuit

US Court of Appeals, District of Columbia Circuit

Memberships

[International Trademark Association](#) (Member, 1994 - present)

[Trademark Insiders](#) (Founder, 2014)

Publications

["Trademark Transfers: Be a Hero Not a Bystander", World Trademark Review](#)

[Landmark Trade Secrets Law Creates New Federal Civil Cause of Action and Compliance Obligations for All Employers, Westlaw Journal, Intellectual Property edition, Volume 23, Issue 3](#)

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Recent Speaking Engagements and Presentations

[Association of Corporate Counsel \(ACC\) Technology and IP Forum: Best Practices for Protecting Your Company's Trade Secrets in Light of the Defend Trade Secrets Act](#)

Selected Legal Career Achievements and Engagements

- Negotiated sale of now-famous trademark to Apple in face-to-face negotiations with Steve Jobs.
- Co-authored U.S. Supreme Court Amicus Brief for Dr Pepper/Seven-Up Corp. in *Qualitex Co. v. Jacobson Products Co.*, 115 S. Ct. 130 (color subject to trademark protection).
- Provided written testimony to the Chairman of the House Subcommittee on Courts and Intellectual Property prior to passage of the Federal Trademark Dilution Act.
- Managed software company's global trademarks, copyrights, commercial contracts, and licensing - for past 22 years.
- Negotiated technology agreements for software company against universities and health care associations.
- Lead counsel in successful two-year contract litigation in Virginia state court against content provider.
- Represented world famous Fortune 400 toy manufacturer in trademark cease and desist, enforcement and federal court matters, especially for world-famous doll brand - for past 16 years.
- Successfully obtained transfer of rights for toy manufacturer in numerous cases after federal court litigation, settlements and take-down notices to Internet Service Providers.
- Managed world famous hotel's global trademark portfolio (more than 330 matters), and all prosecution, maintenance, enforcement and litigation worldwide - for past 16 years.
- Obtained EU-wide injunction against hotel competitor.
- Managed financial trading software company's global trademark and copyright portfolio - for past 16 years.
- Represented financial trading company in federal court litigations involving trade secrets theft, copyright infringement and breach of contract.
- Managed computer hardware manufacturing company's global trademark portfolio - for past 16 years.
- Managed battery manufacturer's global trademark portfolio (more than 1,500 matters), together with global enforcement, licensing and litigation, including in China - for past 13 years.

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- Strategic counseling for battery manufacturer in trade dress and product configuration litigation seeking declaratory relief.
- Managed publicly traded telecommunications company's global trademark portfolio (more than 200 matters) - for past 13 years. (This company maintained the database for all telephone numbers used by all telecommunications providers in North America under contract with the US government).
- Handled complex trade secret litigation filed in Virginia court against telecommunications company's direct competitors and former company employees. Obtained a preliminary injunction in the case which involved unauthorized remote entry to the company's computer systems and customer databases.
- Handled federal court cases for domain name registry over *in rem* disposition of domain names in the company's possession as the registry operator.
- Handled federal district court and appellate litigation and court appearances for telecommunications company over issue of First Amendment rights to domain name registrant privacy protections.
- Managed educational technology company's global trademark portfolio (more than 280 matters) and all trademark prosecution, maintenance, enforcement and litigation, as well as copyright enforcement - for 12 years.
- Managed US bank's trademark portfolio and prosecution, maintenance, enforcement, federal court litigation and licensing - for 10 years.
- Managed UK skincare, toiletry and cosmetic products company's US trademark prosecution, enforcement and litigation - for nine years.
- Managed Super Bowl Champion NFL team's trademark portfolio, including all prosecution, enforcement and maintenance - for seven years.
- Represented national Olympic sports organization in trademark enforcement and Trademark Trial & Appeal Board litigation - for four years.
- Managed financial investment company's trademark prosecution and brand management for hotel and other real-estate related ventures - for past six years.
- Managed market research company's global trademark portfolio (more than 400 matters) - for five years; prosecuted and maintained all foreign registrations and applications worldwide, assisted with all USPTO Office Actions, and handled all trademark enforcement and licensing efforts worldwide in addition to all copyright prosecution matters; handled copyright and software license agreements and negotiations.
- Represented U.S. sports "major league" in domestic and foreign trademark enforcement - for five years.

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- Managed cellular telecommunication service provider's global trademark portfolio (more than 130 matters), including all prosecution, enforcement, maintenance and litigation in federal court - for four years.
- Obtained for cellular telecommunication service provider the first precedential UDRP ruling that no use of a domain name can constitute use of a domain name in "bad faith," which has since been cited more than 2,000 times in WIPO Panel Decisions.
- Represented world-class California vineyard in foreign trademark litigation - for four years.
- Represented global food manufacturer in foreign trademark litigation - for four years.
- Represented national fast-food chain in foreign trademark litigation, for four years.
- Managed Fortune 160 department store's foreign trademark portfolio (more than 170 matters), including prosecution, maintenance, enforcement and litigation, including in China - for three years.
- Managed Fortune 150 consumer packaged goods company's trademark "help-desk" to answer immediate questions from company's in-house trademark lawyers and paralegals - for past three years; provided in-house legal training and handled responses to trademark cease and desist letters.
- Assisted with management of international paint and coatings company's global trademark portfolio (more than 2,400 matters), and enforcement, counseling and due diligence - for past three years.
- Management of largest domain name registry's trademark portfolio and enforcement strategy (450 matters) - for past year. Manage cease and desist and enforcement program.
- Managed endurance sport company's global trademark and copyright portfolio and cross-border litigation enforcement - for past year; created trademark strategy plans; protected trademark rights to prime time NBC series about company; managed pan-European Union injunction proceeding against European television show infringer.
- Trademark, copyright and book publishing advice counseling to authors.
- *Pro bono* representation of multiple national disease awareness associations in trademark counseling and in Trademark Trial & Appeal Board litigation against infringers.
- *Pro bono* representation of national suicide awareness association in contract negotiations with vendors and universities.
- *Pro bono* representation of National Park "friends group" in contract negotiations with the National Park Service.
- Represented national fast-food restaurant chain in trademark litigation filed by competing national restaurant chain.

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- Represented workplace safety products manufacturer in trade dress and false advertising litigation.
- Represented national airline in trademark prosecution and strategy.
- Represented global personal care products company before the U.S. Trademark Trial & Appeal Board.
- Represented chemical company in U.S. trademark issues and disputes.
- Represented natural gas company in worldwide re-branding and trademark protection (900+ filings).
- Represented financial trading exchange in worldwide trademark protection.
- Represented real estate developer in defending trademark demands involving \$1.5 Billion, 30-acre development project in downtown Miami.
- Lead and solo counsel in two-day trial in Virginia court for rock band manager against band for breach of contract.
- Represented nutritional supplement company in trademark infringement defense and counterclaims, and before the Trademark Trial and Appeal Board.
- Management and supervision of numerous IP due diligence projects and audits for corporate acquisitions.

Additional Interests

- Cultural anthropology
- Spartan OCR (x 2)
- U.S. Marine Corps Marathon (x 2)
- Los Angeles Marathon (x1)
- Bull Run Battlefield 50 Mile (x2)
- JFK 50 Mile (x1)
- The North Face 50 Mile (x3)