



CONTACT

Call

571-577-8369

Email

abutterman@dbllawyers.com

PRACTICE AREAS

Corporate Transactions & Finance
Intellectual Property
Litigation & Disputes

INDUSTRIES

Alcohol Beverage Law
Automotive
Banking
Cannabis
Government Contracting
Health Care
Insurance
Manufacturing
Media & Entertainment
Non-Profits
Retail and Consumer Products
Software
Technology

OFFICE

Leesburg, VA



ALEX BUTTERMAN

PARTNER

Alex Buttermann is a partner in the intellectual property practice at Dunlap Bennett & Ludwig focusing on all facets of trademark prosecution and counseling, representing clients before the U.S. Patent and Trademark Office (USPTO) and virtually every trademark office around the world with the help of an extensive network of foreign associates. Alex has acquired extensive experience and expertise as a trademark lawyer since 1995 counseling a wide variety of foreign and domestic businesses of all sizes and sectors at all stages of development in various industries establishing, maintaining, enforcing and assessing their brand portfolios. Alex helps clients select their trademarks and service marks, searches the availability and registrability of marks; registers and secures the company's rights in their marks; resolves intellectual property disputes; renders legal opinions and addresses any other legal issues related to management of the trademark portfolio for a business. Alex's practice also covers internet domain name issues, anti-counterfeiting matters, copyright prosecution, IP licensing and transactions, and intellectual property audits and due diligence investigations.

EDUCATION

- Juris Doctor, St. John's University School of Law
- B.A., Psychology, Lehigh University

ADMISSIONS

- Virginia
- Washington, D.C.
- New York
- New Jersey
- United States District Court, District of New Jersey

EXPERIENCE

- *Allright Mind Enterprises Ltd. v. Creative Arts By Calloway, LLC*, Opp. No. 91273573 (Aug. 1, 2024): Successfully defended client's application in an opposition by challenging the opposer's bona fide intent in their asserted earlier-filed intent to use and foreign registration-based applications for cannabis goods and services; the Board concluded that opposer's prior rights were invalid due to lack of bona fide intent in maintaining their applications for eleven years without alleging use of the mark.
- *TAJMA Enterprises v. Shaun M Rubrecht*, Canc. No. 92067668 (Aug. 29, 2024): Successfully petitioned to cancel the bad faith registration of the client's trademark by her former brand manager after a dispute and termination of the brand manager's contract; the Board concluded that the application to register the client's mark filed in the name of only the brand manager as a U.S. individual was not an application filed by the legal owner of the mark and therefore was void from the beginning.

- In re Speccomm International, Inc., Applic. Ser. No. 75300898 (TTAB Feb. 28, 2001): successfully defended a descriptiveness refusal appealed by the applicant, as an Examining Attorney at the U.S. Patent and Trademark Office ("USPTO").
- In re J.R. Simplot Company, U.S. Registration No. 2787936 for BIG EE: successfully persuaded the examining attorney to withdraw her final refusal to register the mark BIG EE for "french fried potatoes" (subsequently amended) over three BIGGIE formative registrations owned by Wendy's International Inc.
- Epoch Company, Ltd. v. Epoch Design, L.L.C., Canc. No. 92045688 (TTAB March 9, 2009): Represented Epoch Company Ltd. in its petition to cancel a registration for EPOCH DESIGN in class 28 for various toy goods and settled cancellation action by persuading Epoch Design to delete the toy goods from its registration.
- In re Print Industries Market Information and Research Organization, Reg. No. 3581860 (Jan. 31, 2009): Successfully overcame a final refusal of the examining attorney to register the class 16 printed publication goods because the identification of goods was allegedly beyond the scope of the original application; the examining attorney approved the application after reviewing the applicant's persuasive appeal brief.
- OpenSpace Inc. v. OpenSpace, LLC, Opp. No. 91196063 (TTAB Dec. 10, 2010): Successfully negotiated a coexistence agreement for concurrent use of the identical OPENSOURCE mark between client's commercial real estate listing and advertising service and a junior user's leasing and renting of temporary workstations and work areas.
- Emami Limited v. Himani Gupta, Opp. No. 91200679 (TTAB Nov. 27, 2013): successfully defended client's application to register HIMANI MAKEUP – SKINCARE and Design for cosmetics in class 3 from an opposition by the owner of the registered HIMANI (standard character) mark for class 5 medicated preparations and topical solutions by negotiating a coexistence and settlement agreement between the parties.
- Alion Science and Technology Corporation v. Washington Consulting Corporation, Canc. No. 92058434 (TTAB Aug. 3, 2014): successfully negotiated a coexistence agreement for concurrent use of virtually identical WASHINGTON CONSULTING marks after petitioning to cancel a junior user's registration.
- Baoding Baigou Outlander Backpack Limited Liability Company v. Sam Direct Global Trade Co., Limited, Opp. Nos. 91217400 + 91217784 (consolidated) (TTAB May 29, 2015): successfully opposed two bad faith applications filed by client's competing Amazon.com seller.
- Yupoong, Inc. v. Hasmukh Dholakiya, Opp. No. 91220512 (TTAB Jan. 29, 2016): Opposed and successfully settled an opposition to an application for a very similar mark and related goods.
- Yupoong, Inc. v. HBI Branded Apparel Limited, Inc., Opp. Nos. 91223056 + 91224198 (TTAB Dec. 22, 2015): Consolidated oppositions to prevent the registration of two COMFORT FLEX FIT marks (with and without design) for undergarments over Yupoong's well-known FLEXFIT mark for headwear, including related oppositions in various other jurisdictions (Brazil, Europe, China, etc.); settled with a global coexistence agreement.
- Yupoong, Inc. v. Neo Sports Lab, Opp. No. 91234268 (TTAB Mar. 27, 2019): Successful final decision granting opposition to the registration of the FLEXUFIT mark for sports braces and joint supports in view of Yupoong's several registrations of its well-known FLEXFIT mark for headwear and sportswear and formerly for sports braces.
- Yupoong, Inc. v. Rhone Apparel, Inc., Opp. No. 91239475 (TTAB July 9, 2019): Opposed the registration of the FLEXKNIT mark for clothing because of Yupoong's FLEXFIT registered marks and negotiated a coexistence agreement between the Parties.
- Pacific Isles International Trading Inc. v. Rosie S. Barrett, Canc. No. 92062031 (TTAB Dec. 10, 2020): Successfully prosecuted a cancellation action based upon a trademark ownership dispute between two sisters who had a falling out in the co-operation of a Filipino food import business. The cancellation action was decided by Registrant's failure to file the Section 8 Declaration of Continuing Use.
- Lonely Cow Wines (NZ) Limited v. Lonely Dog GP Limited, Opp. No. 91234583 (TTAB March 1, 2019): Defended a consolidated opposition against client's two applications with respect to the wine goods in each and successfully negotiated a settlement and coexistence.
- Mobile Gaming Technologies, Inc. v. Bitcoin Ltd., Canc. No. 92067342 (TTAB June 12, 2019): Successfully defended a petition to cancel the client's registration based upon alleged non-use by presenting evidence of use in client's Answer.



- *Bawarchi Biryani, LLC v. Rajesh Routhu*, Canc. No. 92070265 (TTAB July 18, 2019): Responded to a petition to cancel client's registration with a counterclaim to cancel petitioner's two asserted registrations, thereby motivating petitioner to promptly negotiate a coexistence agreement with the client.
- *Logistics Management Institute v. SAP National Security Services, Inc.*, Opp. No. 91250585 (TTAB Jan. 9, 2020): Opposed an application for a slogan virtually identical to the client LMI's slogan and negotiated a settlement that required SAP to institute use restrictions in its adoption of the slogan mark.
- *Directus Consulting LLC v. RANGER Studio, LLC*, Opp. No. 91253534 (April 15, 2020): Procured registrations for Directus Consulting over two earlier-filed, virtually identical registered or applied-for marks by negotiating a registration consent with the owner of the earlier DIRECTUS registration and opposing the Ranger Studio owner of a prior pending DIRECTUS application leading to Ranger's abandonment of its opposed application.
- Managing a portfolio of 400+ U.S. trademarks for a New Zealand based multi-national toy and consumer goods company, including filing approximately 50 new applications for them each year.
- Managing and enforcing an international portfolio of trademarks for a Korean headwear manufacturer and owner of the second leading brand of headwear in the U.S. for 15+ years, including registering marks and filing trademark oppositions around the world, negotiating trademark licensing and distribution agreements, and counseling on same.
- Managed the U.S. trademark portfolio and prosecuted and cleared new U.S. marks for a multi-national Japanese software and information technology conglomerate.
- Examined, searched and counseled, filed, prosecuted, maintained and enforced several thousand trademarks and service marks since 1995, including being attorney of record in 100+ Trademark Trial and Appeal Board (TTAB) cases at the USPTO, mostly all of which were contested matters. Successfully prevailed in or settled over three quarters of these TTAB cases.
- Examined more than 1,500 trademark applications as an Examining Attorney at the U.S. Patent and Trademark Office.

PUBLICATIONS

- Webinar Panel: TIMEOUT! Understanding NIL & NCAA Bounds (Oct. 26, 2021)
- Webinar Panel: Preparation And Prosecution Of Trademark Applications: A Comprehensive Guide (Feb. 20, 2019)
- Webinar Panel: Best Practices in Protecting Your Brand and The Fundamentals of Trademark Law: A 2017 Perspective (June 21, 2017)
- Webinar Panel: Tips for Effectively Searching the USPTO Database Using TESS – Part 2: Design Searching, State Bar of California, Intellectual Property Law Section (Dec 10, 2013)
- "'Trademark Bullying' – Time To Get Some Clear Definitions," *World Trademark Review* / The IP Media Group · Jul 2, 2013 (collaboration), *WTR Issue 44 LR* (August/September 2013)
- "'Has Bose 'Blown Away' The Trademark Fraud Cancellation Crusade at the USPTO?" *Intellectual Property Today* (June 1, 2010)
- "THE LEGAL VIEW : An Ounce of Prevention is Worth a Pound of Cure"
- • *IGAL Newsletter* (Jan. 1, 2007) (collaboration)
- "Baseball's Antitrust Exemption and an Owner-Imposed Salary Cap: Can They Coexist?" *ABA's Entertainment and Sports Lawyer*, Vol. 12, No. 3 (1994-1995) (Sep 1, 1994)

PROFESSIONAL ASSOCIATIONS AND MEMBERSHIPS

- International Trademark Association (INTA) serving on its committees since 2006, namely the Anti-Counterfeiting Committee, the Emerging Issues Committee; Enforcement Committee (task force leader); Law Firm Membership Committee; and Online Reference Materials Committee.
- American Intellectual Property Law Association Trademark Committee for the past 10+ years.



HONORS & AWARDS

- 2024-2025 Recognized in the World Trademark Review 1000.
- 2023 winner of the NIOSH Bullard-Sherwood Research to Practice Award for Intervention! for work with the Centers for Disease Control's National Institute for Occupational Safety and Health helping to register their face mask certification marks around the world.
- 2022 Recognized as a Global Intellectual Property Leader in the 2022 edition of World Intellectual Property Review ("WIPR")
- 2020 Awarded Senior Counsel of the Year at DBL.
- 2013 Top Contributor by Avvo (earned 1,500 contributor points for answering legal questions from visitors to the www.avvo.com website).

FULL BIO

As an Attorney Advisor in Law Office 106 of the USPTO trademark examining operations for three years, Alex examined thousands of trademark applications in the fields of cosmetics, toiletries and cleaning preparations, publications and office supplies, toys and sporting goods, and all types of service mark applications. Alex also defended registration refusals before the Trademark Trial and Appeal Board.

Professionally, Alex has been an active member of the International Trademark Association, continuously participating in its committees since 2006, most recently on the Anti-Counterfeiting Committee, as well as being a voting member of the American Intellectual Property Law Association trademark committee.

When not working for clients, Alex enjoys spending time with his wife and family, playing and watching real and fantasy baseball, watching football, playing golf, tennis and other recreational sports, and traveling and skiing.

