



Andrea Anderson

Partner

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Andrea provides strategic counsel to some of the world's largest brand owners.

PRACTICES

Intellectual Property
IP Litigation
Global Trademark Portfolio Management

EDUCATION

George Washington University School of Law, J.D., 1997

With Highest Honors

Ranked 1 of 450 in class

The George Washington Law Review

University of Washington, M.A., 1994

Middle East Studies

Schwartz Endowment Fellow, 1993-1994

University of Virginia, B.A., 1988

Foreign Affairs

BAR ADMISSIONS

Colorado
District of Columbia

The teams she leads assist clients with all aspects of brand creation and protection, including initial clearance, prosecution and registration, and where necessary, enforcement actions and litigation. Many of her clients build their portfolios through acquisitions, and she and her teams possess special expertise in the strategic evaluation of acquisition candidate portfolios and the development of enforcement and protection strategies for acquired trademarks. She also helps clients leverage their brands through negotiating and drafting high-profile licensing and co-branding arrangements.

While Andrea's objective is to help her clients avoid trademark disputes, when the occasional dispute arises, clients praise her ability to achieve favorable, quick, and cost-effective resolutions. Her strategic approach to dispute resolution is informed by the 10+ years she spent litigating trademark cases in federal court. Andrea continues to litigate before the U.S. Trademark Trial and Appeal Board and several cases she has handled have resulted in precedential opinions or decisions on issues of first impression.

Before joining Holland & Hart, Andrea worked for a large IP law firm in Washington, D.C., and served as a law clerk to The Honorable Raymond C. Clevenger, III of the U.S. Court of Appeals for the Federal Circuit.

EXPERIENCE

- Strategic Trademark Portfolio Management
- Trademark Enforcement Strategies
- Due Diligence and Acquisition Counseling

CLIENT RESULTS

Federal Court Actions

After a three-week jury trial, obtained verdict of infringement against one of the largest banks in the world. When the district court judge failed to enjoin the infringement, successfully appealed to the U.S. Court of Appeals for the Third Circuit, obtaining reversal of the trial court's decision for abuse of discretion.

Successfully defended client in jury trial involving allegation that client's product infringed plaintiff's registered color trademark. The case settled

extremely favorably on the third day of trial during cross examination of the plaintiff's principal.

On the Tuesday prior to Black Friday, prepared Complaint, Motion for Preliminary Injunction, and demand letter and obtained settlement under which a major U.S. retailer pulled an infringing product from its stores nationwide within 24 hours, positively impacting client's sales over the holiday weekend.

On behalf of a world-wide human resources consulting firm, defeated plaintiff's Motion for Preliminary Injunction (brought after the client announced its initial public offering), after which the case favorably settled, and client continued to use its mark.

On behalf of a leading tennis racquet manufacturer, initiated several gray goods cases, resulting in either injunctions or settlements under which unauthorized imports of client's product ceased.

On behalf of cable music provider, prepared and filed Motion for Preliminary Injunction, leading to favorable settlement under which major internet service provider ceased using an infringing mark.

Obtained summary judgment of no infringement in client's favor in copyright infringement suit seeking millions of dollars in damages.

Obtained summary judgment that client's barbed-wired themed jewelry did not infringe plaintiff's jewelry design, and obtained affirmation of ruling on appeal.

On behalf of major real estate company, successfully litigate and resolve numerous cases involving its distinctive signage design.

Prior to enactment of the TDRA, obtained ruling in a case of first impression rejecting, on summary judgment, the doctrine of "niche fame."

TTAB Actions

Successfully opposed application to register WINEBUD for wine, resulting in a precedential opinion related to consumer survey methodology.

Defeated opposition to client's application to register a single product color and obtained decision from the U.S. Trademark Trial and Appeal Board that client's mark was protectable. Case is cited in McCarthy on Trademark and Unfair Competition Law.

In a case of first impression, obtained judgment in client's favor due to opposer's failure to serve initial disclosures and pretrial disclosures, and avoided the expense associated with entering testimony on the client's behalf. The Board designated the decision precedential.

Obtained judgment in client's favor in cancellation action alleging that client's mark was geographically misdescriptive.

PUBLICATIONS

"Confusing CBD: Post-Legalization Trademark Strategies for Food and Beverage Marks," *World Trademark Review*, Co-Author, 05/07/2020

"Supreme Court's New Profits Awards Standard Unlikely to Affect Trademark Litigation Strategy," *Thomson Reuters Westlaw Journal Intellectual Property*, 05/06/2020

"'Unbinding' Precedent: TM Protection for Packaging Color Schemes Now More Attainable," *World Intellectual Property Review*, 05/05/2020

"User-friendly? Strategies for navigating the USPTO's use audits for global brand owners," *Managing Intellectual Property*, 01/02/2019

"3 Easy Ways to Deter Counterfeiters," 2/25/2011

"Avoid Branding and Marketing Mishaps - An Overview," *Executive Counsel*, 4/1/2010

"What New FTC Rules for Word of Mouth Marketing Mean for Your Business," *SNEWS*, 11/23/2009

"The FTC Cracks Down on Word-of-Mouth Marketing," *ColoradoBiz*, 10/20/2009

"Take action against unauthorized resellers," *Managing Intellectual Property*, 10/14/2009

"Trash or Treasure: Controlling your brand in the age of upcycling," *Trademark World*, 7/1/2009

"Federal Circuit to Hear Two Trademark Fraud Cases in May," *77 Patent, Trademark & Copyright Journal 648 (BNA April 10, 2009)*, 4/10/2009

"Trademark Counterfeiting on the Rise," *Colorado Biz*, December 2006

"Absolutely Fair? U.S. Supreme Court Agrees to Hear Fair Use Case," *Trademark World*, April 2004

"Limitations on the Automatic Stay Provision," *George Washington Law Review*, 1996

SPEAKING ENGAGEMENTS

"Trade Dress Protection Strategies," *Associação Brasileira da Propriedade Intelectual (ABPI)*, Rio de Janeiro, Brazil, 2019

"Becoming A Partner...And Then What? Business Development for Aspiring and New Partners," *American Bar Association Webinar*, 2019

"Brands in the Spotlight," *International Trademark Association - Business of Brands New York Conference*, 2019

"Protecting Your Corporate Identity Online," *ACC Annual Meeting*, 2011

"When Not to Send a Cease and Desist Letter," *Rocky Mountain IP*

Institute Half-Day, Half-Year, IP Fall Update 2010, Fall 2010

"Inside the Chatterbox - Engaging with Consumers and Protecting Your Brand in the World of New Media," *Co-Presenter with Paul Kirwin (Channel Signal), Outdoor Industry Association, October 2009*

"Recent Developments in U.S. Trademark Law," *Association of Brazilian Trademark Administrators, Rio de Janeiro, July 2009*

"Selling Green While Avoiding Red Flags: Legal Guidelines for Green Marketing Claims," *Outdoor Industry Association, October 2008*

"Intellectual Property Protection in the U.S.," *Scandinavian Outdoor Group, Gothenburg, September 2008*

"Basics of Trademark Enforcement," *Colorado Bar Association, Fundamentals of IP Law Seminar, June 2008*

"Keeping it Real - Protecting Your Brand from Trademark Counterfeiting," *Outdoor Industry Association Annual Rendezvous Conference, Vancouver, WA, October 4, 2007*

"Combating Counterfeiting," *World Trade Center of Denver, June 2006*

"Parallel Imports in the U.S.," *Facilitator at the International Trademark Association Annual Meeting, April 2006*

"Fraud on the PTO," *Facilitator at the International Trademark Association Roundtable, March 2006*

"The Treatment of Non-Traditional Trademarks Under U.S. Law," *Intellectual Property Law Association of Brazil, 2003*

RECOGNITION

"Andrea is just a genius – she gives pragmatic advice but infuses it with fantastically creative and unique ideas regarding brand creation and protection." [WTR 1000 – 2020]

"Andrea Anderson is 'absolutely first class' on the prosecution and strategic management side; 'I have a great deal of respect for what she does,' remarks one commentator." [WTR 1000 – 2016]

"Hands down the most responsive, creative IP lawyer I have ever worked with" remarked one client about Andrea. According to another: "[t]he characteristic that sets Andrea apart from her peers is her ability to place herself in the position of an in-house counsel." "[She] really listens to what clients need and adapts her communications to fit the audience." [Lexology Client Choice Award Survey Respondent – 2014]

"Andrea is a skilled negotiator. I have yet to find another outside lawyer that can always resolve a deal favorably." [Lexology Client Choice Award Survey Respondent – 2014]

- *World Trademark Review (WTR) 1000 - The World's Leading Trademark Professionals, Colorado, Gold Band 2014, 2016-2022*
- *World Trademark Review (WTR) Global Leaders, 2019-2020*
- *Chambers USA, Intellectual Property, 2014, 2019-2022*
- *Managing Intellectual Property, IP Star, 2013-2014, 2016-2022, Top 250 Women in IP, 2013, 2018-2022*
- Shortlisted for *Managing IP Americas Awards, US National*

Practitioner of the Year (Trademark Prosecution), 2021

- *The Best Lawyers in America*® Lawyer of the Year, Trademark Law – Denver, 2013; Trademark Law – Boulder, 2016, 2018, 2020
- *Who's Who Legal: Trademarks*, 2014-2016, 2018
- *The Best Lawyers in America*®, Trademark Law, 2013-2022
- *WIPR Leaders*, Trademark, 2017-2022
- Colorado Super Lawyers®, Intellectual Property, 2016-2022
- *5280 Magazine* Top Lawyers, Intellectual Property: Trademark, 2017-2022
- *Lexology* and *International Law Office*, Client Choice Award, Intellectual Property – Trademarks in Colorado, 2014
- *Euromoney Expert Guides: Trademark*, 2014
- *Lexology* and *International Law Office*, Client Choice award nominee, 2013

PROFESSIONAL AND CIVIC AFFILIATIONS

- Member, Mile High United Way Tocqueville Society, 2018-present
- Member, International Trademark Association (INTA) U.S. Legislation Committee, 2002-2005; 2017-2019; 2022-Present
Anti-Counterfeiting Committee, 2006-2009
Bulletin Committee, 2010-2014
Enforcement Committee, 2014-2016
- Member, Family Learning Center, A Boulder-based non-profit serving the educational needs of low-income and minority youth
Board of Directors, 2004-2008
Advisory Group, 2010-present