



WILLIAM R. SAMUELS

PARTNER

CHAIR, COPYRIGHT AND TRADEMARK LAW GROUP

INTELLECTUAL PROPERTY | COPYRIGHT | TRADEMARK | PATENT

LITIGATION | PATENT PORTFOLIO MANAGEMENT | IP ENFORCEMENT

3 Park Avenue

15th Floor

New York, NY 10016

Phone: 212-784-6939

Fax: 212-784-6935

wsamuels@sh-law.com

BIOGRAPHY

William R. Samuels is a seasoned intellectual property attorney who devotes his practice primarily to copyright and trademark law, tailoring strategies and protection plans to achieve each respective client's goals and business objectives. Before joining Scarinci Hollenbeck, Bill was the founding member of his eponymous law firm, W.R. Samuels Law PLLC, founded in 2011. The firm handled all aspects of domestic and international IP matters, including trademarks, copyrights, patents, IP enforcement and defense, IP licenses and agreements, domain names, software services, counterfeit protection, unfair competition, and IP counseling and audit services.

Bill began his legal career in San Francisco, CA, as outside general counsel to various startup companies, advising them on intellectual property, business strategies, and general corporate matters. He then spent three years at a California IP boutique advising clients on trademarks, copyright, design and trade dress protection, anti-counterfeiting and customs enforcement, trade secrets and unfair competition, as well as global licensing regimes.

ARTICLES & PUBLICATIONS

- Articles Editor, California Bar Association IP Section Law Journal, December 2010 - Present
- Author, Celebrating 20 Years of The Intellectual Property Law Section: Trademark Law, Bright Ideas, Winter, Volume 21, Number 3, 2012
- Author, Rosetta Stone Ltd. v. Google, Inc.: Deciphering Trademark Issues in Keyword Advertising (Part Two), GPSolo eReport: American Bar Association, Vol. 3, No. 3, October, 2013
- Author, Rosetta Stone Ltd. v. Google, Inc.: Deciphering Trademark Issues in Keyword Advertising (Part One), GPSolo eReport. American Bar Association, Vol. 3, No. 1, August, 2013
- Co-Author, Teller v. Dogge: When Two Magicians Duel Over the Secret to an Iconic Illusion. They Conjure a Copyright Infringement Lawsuit, Volume 38, Number 1, April 1, 2013

PRESENTATIONS

- Moderator, Perspectives on Trademark Licensing from In-House and Outside Counsel, New York State Bar Association: IP Section Annual Meeting, 2016
- Moderator, Trademarks, Domain Names & Cybersquatting, NY State Bar Association, IP Section Trademark Committee, 2016
- Moderator, Venturing Forward: Issues Facing Start-Up Companies, NY State Bar Association, IP Section Fall Meeting 2016, 2016
- Host, INTA Roundtable: The Madrid Protocol - Staying Afloat when Navigating the waters of the Madrid Protocol, International Trademark Association, 2016
- Speaker, Trademarks: From Clearance Search To Litigation, New York State Bar Association, 2015
- Speaker: Trademark Law, A Primer on Intellectual Property, New York State Bar Association, 2014
- Moderator, How to Enforce Against Counterfeiters: Strategies and Realities in The Connected Global Marketplace, New York State Bar Association: Fall Meeting, 2014
- Moderator, IP Licenses In Bankruptcy, New York State Bar Association, Intellectual Property Law Section Trademark Committee
- Moderator, Preliminary And Permanent Injunctions In Trademark Cases, New York State Bar Association, Intellectual Property Law Section Litigation And Trademark Committees
- Speaker, Basics of Intellectual Property Law, New York State Bar Association, Trademarks
- Program Chair, New York State Bar Association IP Section Annual Meeting, 2017
- CLE Organizer & Host, Policing Your Brand On The Internet: How To Protect & Defend What Is Yours, New York State Bar Association, Intellectual Property Law Section Trademark Committee
- CLE Speaker, Basics of IP Law: Trademarks, New York State Bar Association

- Speaker, Legal Considerations For Freelancers, New York University, Health & Environmental Reporting Program (SHERP), NYU Science
- Speaker, To Copy Or Not To Copy: Considerations In Copyright Law, Brooklyn Bar Association, Intellectual Property Law Section

CLASSES/SEMINARS

- Host, INTA Roundtable: The Madrid Protocol - Staying Afloat when Navigating the waters of the Madrid Protocol, International Trademark Association, 2016
- Speakers focused on IP issues specific to start-ups, including whether, when, and why to seek IP protection, and the value-add to outside investors. The panel included inside and outside counsel, and early/late stage investors., Moderator, Venturing Forward: Issues Facing Start-Up Companies, NY State Bar Association, IP Section Fall Meeting 2016, 2016
- The panel discussed and evaluated current practical considerations in asserting and defending cybersquatting claims, trademark considerations in light of Uniform Domain Name Dispute Resolution Policy (“UDRP”) decisions, litigation concerns under the Anti-Cybersquatting Consumer Protection Act (“ACPA”) 1999 amendment to the Lanham Act, and related enforcement and defense approaches, as well as counseling strategies for assisting clients that are operating and staking claims online., Moderator, Trademarks, Domain Names & Cybersquatting , NY State Bar Association , IP Section Trademark Committee, 2016
- An overview of trademark licensing basics with additional discussion of more advanced issues., Moderator, Perspectives on Trademark Licensing from In-House and Outside Counsel, New York State Bar Association: IP Section Annual Meeting, 2016
- Program covered trademark law from initiating a clearance search to litigating a trademark dispute. Attendees learned what trademark law is intended to protect, the registration process, enforcement issues in trademark litigation, and other important knowledge that you need to know if you are practicing trademark law., Speaker, Trademarks: From Clearance Search To Litigation, New York State Bar Association, 2015
- This panel of in-house counsel, outside counsel, and law enforcement discussed steps taken by global brands and the state and federal government to protect rights holders and to prevent counterfeit goods from entering the US and enforcing criminal liability for the sale of counterfeit goods. An overview about brand enforcement, social media, and new gTLDs in the enforcement context was provided, accenting relevant information about enforcing against counterfeit products. , Moderator, How to Enforce Against Counterfeiters: Strategies and Realities in The Connected Global Marketplace, New

York State Bar Association: Fall Meeting, 2014

- Provided breakdown, information, and understanding of trademark law and domestic and international trademark practice to enable solo and small firms to address such issues for their clients. , Speaker: Trademark Law, A Primer on Intellectual Property, New York State Bar Association, 2014
- Spoke on copyright, contract, and practical legal issues that affect freelance writers., Speaker, LEGAL CONSIDERATIONS FOR FREELANCERS , New York University, Health & Environmental Reporting Program (SHERP), NYU Science
- Lecture and discussion of copyright considerations regarding the Internet, digital technology, and file sharing—including a focus on fair use issues., Speaker, TO COPY OR NOT TO COPY: CONSIDERATIONS IN COPYRIGHT LAW, Brooklyn Bar Association, Intellectual Property Law Section
- Panelists discussed issues of particular concern, including: Bankruptcy treatment of “executory contracts” and criteria for determining whether a licensing agreement is an “executory contract” Special provisions of the Bankruptcy Code governing intellectual property Differences between the bankruptcy treatment of trademarks and other types of IP Strategies for dealing with a licensor’s or licensee’s bankruptcy filing Due diligence of licensing agreements to identify potential bankruptcy issues Emerging and unresolved issues in the bankruptcy treatment of IP, Moderator, IP LICENSES IN BANKRUPTCY , New York State Bar Association, Intellectual Property Law Section Trademark Committee

BAR ADMISSIONS

- NEW YORK
- CALIFORNIA

EDUCATION

- EMORY UNIVERSITY SCHOOL OF LAW, J.D.
- UNIVERSITY OF PENNSYLVANIA, M.A.
- GEORGETOWN UNIVERSITY, B.A.

LANGUAGES

- ENGLISH
- SPANISH

PRO BONO ACTIVITIES

- VOLUNTEER ATTORNEY, CALIFORNIA LAWYERS FOR THE ARTS

HONORS & AWARDS

- LAYWERS OF DISTINCTION
- SUPERLAWYERS METRO RISING STARS
- FORBES LEGAL BLACK BOOK