

Scott E. Rogers

Partner



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Practices/Industries

- Trademark/Copyright Prosecution & Portfolio Management
- Trademark/Copyright Litigation
- Intellectual Property

Education

University of Illinois at Urbana-Champaign
(B.A., 1984)

University of Texas at Austin
(M.A., 1987)

Florida State University
College of Law
(J.D., with *highest honors*, 1990); Order of the Coif

Associate Editor, *Florida State University Law Review*

Overview

Scott is an accomplished intellectual property attorney with substantial experience representing clients in both domestic and international trademark and copyright matters. He is skilled in the prosecution of trademark and copyright applications as well as in the enforcement of intellectual property rights. Scott's extensive knowledge of intellectual property law also covers the protection of trade dress, trade secrets, non-competition agreements, unfair competition, deceptive trade practices, and the licensing of intellectual property. He oversees international intellectual property matters for clients and works with attorneys in numerous countries throughout the world.

Scott is the former Vice President and General Counsel of Ty Inc., best-known as the creator of Beanie Babies® plush toys. In that capacity, he was responsible for establishing and protecting a multibillion-dollar trademark and copyright portfolio in the face of many challenges presented by counterfeiters, infringers, copycats, and others seeking to exploit the company's intellectual property.

Scott also provides legal advice with respect to employment and labor law, compliance with Consumer Product Safety Commission regulations, and sweepstakes laws. He has achieved the highest ranking, AV Preeminent®, from Martindale-Hubbell®.

Experience

- Oversees the licensing program for a major toy manufacturer.
- Successfully defended a global manufacturer in a multimillion dollar trade dress and copyright infringement lawsuit that would have halted sales of its top-selling product line.
- Successfully defended a company in a trademark infringement suit seeking over \$1 million in damages, involving a defense verdict in which the jury deliberated for less than 20 minutes.
- Obtained a jury verdict and permanent injunction for a client in a trademark infringement trial to enforce the client's core mark.
- Obtained summary judgment and a permanent injunction for a client in a trademark infringement action.
- Successfully persuaded numerous infringers of a client's trademarks, trade dress, and copyrights to cease and desist infringing activity.
- Successfully prosecuted hundreds of trademark and copyright applications, and overcame numerous objections to registration of certain trademarks.
- Successfully defended two opposition proceedings before the Trademark Trial & Appeal Board (TTAB), which permitted both clients to register their respective trade names.

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Experience (Cont)

- Registered a unique “costume” service mark for a client after registration was initially denied by the examining attorney, thereby paving the way for a variety of other unique service mark registrations for the same client.
- Successfully sued for recovery of highly sensitive confidential materials taken by an ex-employee for a client whose business involves classified work for the U.S. military.
- Overcame numerous Office Actions for a variety of clients.
- Successfully defended over 10 claims brought by former employees of a client, both in federal court and state agencies in Illinois, Georgia, New York, and California.
- Successfully defended three hotel properties in ADA lawsuits (two in New York, one in California).
- Represented a client in a purported class action lawsuit brought in California, but successfully moved to compel arbitration in Illinois and defeated class certification.

Presentations

- “E-Commerce: Brand Enhancement and Enforcement Issues,” Nationwide CLE Series (November 2015)
- “Trademark/False Advertising/Report from the Trenches,” American Bar Association IP Section Spring CLE (March 2015)
- “Fraud on the PTO: Trademark Owners/Practitioners at Risk,” VIP GlobalNet Seminar (May 2010)
- Trade Dress and Copyright Law, International Trademark Association’s 121st Annual Meeting (May 1999)

Publications

- “Seventh Circuit Seeks to Reign in the Fair Use Defense,” *Intellectual Property Today* (December 2014).
- “No Fairy Tale: Banishing Patent Trolls From Your Business,” ACC Docket, Volume 31, Issue 10 co-author (December 2013).
- “Beware of Scanner Patent Troll,” co-author (June 2013).
- “How to Avoid (Even ‘Accidentally’) Committing Fraud on the PTO: Trademark Owners and Practitioners at Risk,” co-author, BNA’s *Patent, Trademark & Copyright Journal* (October 2010).
- “The Consumer Product Safety Improvement Act of 2008 (October 2008).
- “Public Accommodations and the Americans with Disabilities Act,” co-author (June 2008).

Involvement

Professional Affiliations

- International Trademark Association
- American Bar Association
- Illinois State Bar Association
- Intellectual Property Owners Association

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Honors & Distinctions

- Recognized in the World Trademark Review 's *WTR 1000 – The World's Leading Trademark Professionals* (2020-2022)
- AV Preeminent Peer Review Rated – Martindale-Hubbell
- Named a “Leading Lawyer” in a survey of lawyers by the Law Bulletin Publishing Company (2018-2020)

Admissions

- State of Illinois
- Supreme Court of the United States
- U.S. Court of Appeals, Seventh Circuit
- U.S. District Court, Northern District of Illinois
- U.S. District Court, Eastern District of Michigan