

David Kelly

Partner



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Bar and Court Admissions

- District of Columbia
- Louisiana
- Pennsylvania

Education

- Duquesne University School of Law, J.D., 1983
- University of Pittsburgh, M.S., Civil Engineering, 1980
- University of Pittsburgh, B.S., Civil Engineering, 1979

Professional Activities

- District of Columbia Bar
- American Bar Association
- International Trademark Association

David Kelly has represented clients in trademark, copyright, and unfair competition issues for more than 30 years, with a focus on litigation, disputes, and strategic counselling. Dave represents many famous brands, and has handled many notable matters, including recently obtaining a preliminary injunction followed by an award of \$19,200,000 in statutory damages for trademark counterfeiting against a large, high-profile, online, print-on-demand retailer, and the first fame findings for the marks H-D and HD (E.D. Wisconsin 2018), and successfully enforcing AstraZeneca's single-color "purple" trademark for its NEXIUM® heartburn medication against two generic pharma companies, obtaining TROs and preliminary injunctions on both infringement and dilution grounds along with the first fame finding for AstraZeneca's "purple" mark (D. Delaware 2015)

Dave is consistently recognized as one of the country's top trademark lawyers. In 2018, *Legal 500 US* named Dave as a Leading Lawyer, *Legal 500's* top category, for both trademark litigation and non-contentious matters for the 11th consecutive year. Only nine U.S. lawyers were named in each category, and during the past decade Dave was either the only U.S. lawyer or one of only two lawyers named in both categories. In 2017, Dave was named to the inaugural *Legal 500 Hall of Fame* where only 11 U.S. trademark lawyers were recognized, with Dave being the only lawyer named for both trademark categories. According to *Legal 500* feedback, clients describe Dave as "a leader in the field," "a superstar," "an outstanding trademark litigator," and "an exceptionally bright and thoughtful advocate." Clients also look to Dave for strategic advice based on his reputation as being "full of business savvy" and "a source of much practical advice... that understands our business in a way that most lawyers don't."

In 2019, *WTR 1000* named Dave one of the top 10 lawyers nationwide for both trademark enforcement and litigation and trademark prosecution and strategy. Dave was one of only three lawyers named to both categories in *WTR 1000's* top band of nationally recognized lawyers. According to *WTR 1000* feedback, Dave is "arguably the best trademark practitioner in the country"; "the man to call" for "make-or-break disputes"; "smart as a whip and always 10 steps ahead of his rivals. When complex questions arise, he thinks outside of the box to deliver ingenious solutions"; a lawyer who "maintains strong relationships with massive brands and has built a stunning firm around him"; "has a fantastically clear grasp of things and is an eminently practical and skilled negotiator" whose "substantial proficiency and estimable business acumen single him out in the field"; and "his real-world advice doesn't elevate law above business."

Dave has also been recognized as by *IP Stars* for many years. *IP Stars* feedback includes that Dave is a "leader in the field," a "superstar," and has "unparalleled knowledge and experience in trademark litigation and TTAB cases." Dave has been similarly recognized by *Managing Intellectual Property*, *WIPR*, *Expert Guides*, and others.

Before co-founding Kelly IP, Dave practiced for 26 years at Finnegan, Henderson, Farabow, Garrett & Dunner, chairing the trademark group for many years.

Highlights

- Obtained a preliminary injunction against an online apparel seller of counterfeit and infringing apparel bearing Harley-Davidson's trademarks (E.D. Wis.)
- Enforced AstraZeneca's single-color "purple" trademark against two generic pharma companies, obtaining TROs and preliminary injunctions on both infringement and dilution grounds along with a fame finding for AstraZeneca's mark (D. Del.)
- Represented Aston Martin in multiple litigations to enforce its iconic grille and side vent designs (C.D. Cal.)

Professional Recognition

- Recognized by *Legal 500 U.S.* as a Leading Lawyer, *Legal 500's* top category reserved for only 10 or so lawyers in the country, for both trademark litigation and non-contentious trademark law (2008-2018); the only lawyer named on both lists during 2009-2013 and one of only two lawyers names during 2014-2018.
- Inducted into *Legal 500's* inaugural Hall of Fame in 2017, which “highlights individuals who have received constant praise by their clients for continued excellence . . . and who are at the pinnacle of the profession,” which included only those U.S. lawyers recognized by *Legal 500* as a Leading Lawyer in a practice area for six consecutive years. Only 11 trademark lawyers across the country were recognized for trademark litigation and trademark non-contentious, Dave was the only lawyer named to *The Legal 500 Hall of Fame* in both trademark categories.
- Recognized by *World Trademark Review 1000 (WTR 1000)* as a “Gold” status lawyer nationally for trademark litigation (2016-2019), *WTR 1000's* highest ranking. As a “Gold” status lawyer nationally for non-contentious trademark work (2018-2019); *WTR 1000* recognizes only 8-10 lawyers across the country for “Gold” status in each category.
- Recognized by *WTR 1000* as a “Gold” status lawyer for the Washington, DC Metro area for trademark litigation (2011-2019) and for non-contentious trademark work (2015-2019); *WTR 1000* recognizes only 3 lawyers in the DC Metro area for “Gold” status in each category.
- Named as an IP Star for the Washington, DC area by *Managing Intellectual Property (MIP)* (2014-2018).
- Shortlisted for *MIP's* “Outstanding IP Litigator Award” in the Washington DC area in 2016, 2017, and 2018, one of only seven lawyers shortlisted for this award and the only or one of two trademark lawyers.
- Recognized by Chambers as a leading trademark lawyer in the Washington, DC area (2015-2018).
- Recognized as a “World IP Leader” by World Intellectual Property Review (WIPR), a guide to leading IP practitioners around the world (2016-2019).
- Recognized by *Super Lawyers* as one of the top IP Litigation lawyers in the Washington, D.C. area (2013-2019).
- Recognized among top U.S. trademark lawyers in the *Guide to the World's Leading Trademark Law Practitioners* (Top 10—2006, Top 25—2008, Top 15—2010).
- Recognized by Washingtonian Magazine as one of the top IP lawyers in the Washington, D.C. area (2009, 2011, 2014).
- Recognized among top 25 U.S. trademark experts in Legal Media Group's *Expert Guides* to the Leading U.S. Lawyers—Best of the Best USA (2007, 2009, 2011).
- Recognized by the *Legal Times* as one of the top 10 “Leading Lawyers” in trademark and copyright in the Washington, DC area (2008).
- Recognized by the *Washington Business Journal* as one of the top 3 IP lawyers (and the only trademark lawyer) in the Washington, D.C. area (2008).
- Selected by WIPO as one of the first Panelists for the Uniform Dispute Resolution Policy (UDRP) administered by WIPO's arbitration center (2000).

Select Publications

- Author or co-author of more than 75 articles on various trademark topics in numerous publications, including *The Trademark Reporter*, *Advertising Age*, *The National Law Journal*, *AIPLA Quarterly Journal*, *Landslide*, *Trademark World*, *IP Worldwide*, *Intellectual Property Today*, *Law 360*, *Corporate Counsel*, *The Merchandising Reporter*, *The Practical Lawyer*, *Association Law & Policy*, and *The European Intellectual Property Review*.
- Three-time recipient of the *Burton Award* for “Excellence in Legal Writing” on the topics of the intersection of the Lanham Act and the First Amendment (2010), genericness (2005), and linking (2002).