

David Goldberg Associate



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David Goldberg focuses on domestic and international trademark law. He helps clients protect their brands domestically by researching trademark availability, filing applications for trademark registration and maintaining those registrations. He also works in close collaboration with a network of experienced counsel who provide the same services in other countries around the globe.

Mr. Goldberg helps clients police and enforce their trademarks. For example, he has opposed before the U.S. Trademark Trial and Appeals Board the registration of trademarks that are confusingly similar to those of ARE's clients, including a major Japanese automobile maker and a premier U.S. department store. He also works with clients to amicably resolve trademark disputes by drafting appropriate licenses and agreements. He recently crafted a Global Coexistence Agreement allowing a client, an international food, beverages and confectionary producer, to use, register and protect its trademark in countries where a third-party hair-care product manufacturer already had registered that trademark for use on its products.

He also advises on trademark portfolio management. One recent project involved a U.S. company expanding the reach of its retail e-commerce platform internationally. Mr. Goldberg was part of the ARE team that audited hundreds of the company's brands to ascertain and/or secure IP rights in dozens of countries, advised on whether to relinquish or establish new marks and whether to undertake or defend enforcement actions, and adjusted the program as a result of negotiations, litigation and licensing agreements.

Mr. Goldberg has assisted in patent litigations in the consumer healthcare products and financial services fields, and helped draft amicus briefs for the New York Intellectual Property Law Association in *Association for Molecular Pathology v. Myriad Generics, Inc.*, involving the patent-eligibility of human genes, and *CLS Bank v. Alice Corp. Pty. Ltd.*, involving computerized trading platforms.

Before attending law school, Mr. Goldberg worked as a litigation paralegal at Willkie, Farr & Gallagher LLP and as an in-house regulatory paralegal at Oppenheimer & Co., Inc. He has an M.A. in History from the University of Michigan and taught at The City University of New York's Bronx Community College.

EDUCATION

- Fordham University School of Law, New York, NY, J.D., 2012
Honors: Magna Cum Laude, Order of the Coif, Mary Daly Scholar, 2012 Thomas F. Reddy Jr. Prize (for excellence in Intellectual Property), 2008 Fordham Law School Prize, 2008-2012 Dean's List, Fordham Law Review, Alpha Sigma Nu
- University of Michigan, Ann Arbor, MI, M.A. (History), 1992
- University of California, Berkeley, CA, B.A. (History), 1987

PROFESSIONAL ASSOCIATIONS & MEMBERSHIPS

- Association of the Bar of the City of New York
- New York Intellectual Property Law Association, Amicus Briefs Committee (2012-present), Trademark Law & Practice Committee (2014-present)
- International Trademark Association

BAR ADMISSIONS

- New York, 2013
- U.S. District Court for the Southern District of New York, 2013
- U.S. District Court for the Eastern District of New York, 2013

ADDITIONAL LANGUAGES

- German
- Swedish

AMICUS BRIEFS

- **Brief Of Amici Curiae, *Cuozzo Speed Technologies, LLC, v. Michelle K. Lee, Under Secretary Of Commerce For Intellectual Property And Director, Patent And Trademark Office* (U.S. February 24, 2016)**

AMICUS BRIEFS CONT.

- **Brief Of Amici Curiae, *Milo Shammas, Petitioner, v. Drew Hirshfeld, Commissioner for Patents, Respondent*. (U.S. December 1, 2015)**
- **Brief Of Amici Curiae, *Cuozzo Speed Technologies, LLC, v. Michelle K. Lee, Under Secretary of Commerce for Intellectual Property and Director, Patent and Trademark Office* (U.S. November 9, 2015)**
- **Brief of Amici Curiae, in *B & B Hardware, Inc. v. Hargis Industries, Inc.*, (U.S. October. 31, 2014)**
October 31, 2014
- **Brief of New York Intellectual Property Law Association as Amicus Curiae in Support of Neither Party, *Alice Corporation PTY. LTD., v. CLS Bank International, et al.*, (U.S. Jan. 29, 2014)**
January 29, 2014
- **Brief for *Amicus Curiae* New York Intellectual Property Law Association in Association for *Alice Corporation PTY. LTD. v. CLS Bank International, et al.*, (U.S. Oct. 07, 2013)**
October 7, 2013

PUBLISHED WORKS

- **Only 'Expenses' Not 'Attorney Fees' Should Be Awarded Under Section 21(b) of the Lanham Act** - *IPwatchdog.com, December 13, 2015*
- **Lanham Act constitutionality affirmed as six federal REDSKINS-based trade marks are cancelled** - *Journal of Intellectual Property Law & Practice (2015) doi: 10.1093/jiplp/jpv199* First published online: *November 27, 2015*

PUBLISHED WORKS CONT.

- **Supreme Court 2014-2015 IP Case Review**
- *New York Intellectual Property Law Association Bulletin, August/September 2015*
- **The US Supreme Court continues to follow stare decisis on the outdated Brulotte rule, but notes work-arounds on same**
- *Journal of Intellectual Property Law & Practice (2015) 10 (11): 807-808. doi: 10.1093/jiplp/jpv154*
- **Supreme Court 2013-2014 IP Case Review**
- *New York Intellectual Property Law Association Bulletin, August/September 2014*
- **ARE Trademark Law Alert: US Court of Appeals Finds Lanham Act Prohibition of Registration of Disparaging Trademarks to Be Unconstitutional**
- **ARE Patent Law Alert: US Court of Appeals for the Ninth Circuit Affirms District Court's Decision Setting Reasonable and Non-Discriminatory ("RAND") Royalty Rate**
- **ARE Patent Litigation Alert: SCOTUS Rejects Good Faith Belief Of Invalidity Of A Patent As A Defense To Induced Infringement**
- **ARE Trademark Law Alert: Normalization of US Relations With Cuba Opens New Possibilities and Dangers to US Brand Owners**
- **ARE Trademark Law Alert: Canada Introduces Sweeping Changes in its Trademark Law**
- **ARE Patent Law Alert: Supreme Court Relaxes Standards for Awarding Attorney Fees Under 35 U.S.C. § 285 in Patent Cases**
April 29, 2014

PUBLISHED WORKS CONT.

- **US Supreme Court addresses patent eligibility of isolated DNA and cDNA in *Myriad V***
- *Journal of Intellectual Property Law & Practice* (2013) doi: 10.1093/jiplp/jpt156
- **ARE Patent Law Alert: Unanimous U.S. Supreme Court Decision on Patent Exhaustion Upholds Patentee's Rights in Case Regarding Patented Self-Replicating Technologies**
May 15, 2013
- **CLS Bank Ruling Provides No Guidance On Patent Eligibility**
Law360, New York (May 13, 2013, 11:50 AM ET)
- **ARE Patent Law Alert: Federal Circuit Splits on Section 101 Analysis and Finds Computer Implemented Claims to be Patent-Ineligible**
May 11, 2013
- **Largely Uncontested Portion of Plurality Opinion in U.S. Court of Appeals for Federal Circuit in *CLS Bank International v. Alice Corp. Pty. Ltd. En Banc Decision* Regarding Section 101 Follows Reasoning in NYIPLA Amicus Brief**
- *New York Intellectual Property Law Association Bulletin, April/May 2013*
- **Isolated human genes and related therapeutic treatment methods held patent-eligible**
- January 24, 2013, *Journal of Intellectual Property Law & Practice*, 2013, Vol. 8, No. 2
- **ARE Patent Law Alert: U.S. Supreme Court Again Grants *Certiorari* in *Myriad* to Address the Patent-Eligibility of Human Genes**
November 30, 2012
- **ARE Patent Law Alert: Federal Circuit Clarifies That USPTO Can Only Consider Prior Art Found to Raise a Substantial New Question of Patentability in *Inter Partes* Reexamination Proceedings**
October 17, 2012
- **Decision by U.S. Court of Appeals for the Federal Circuit in *Myriad* Remand Mirrors Reasoning in NYIPLA Amicus Brief**
- *New York Intellectual Property Law Association Bulletin, August/September 2012*
- **ARE Copyright Law Alert: Second Circuit Clarifies Digital Millennium Copyright Act's Safe Harbor Provisions In *Viacom International, Inc. v. Youtube, Inc.* Decision**
April 18, 2012
- **ARE Patent Litigation Alert: Federal Circuit Finds Another Computer Implemented Method To Be Patent-Eligible Under Section 101**
October 3, 2011