

John Paul Oleksiuk

Partner



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New York

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Intellectual Property

Trademark, Copyright and Advertising

Copyright

Pharmaceutical and Medtech Branding

Fashion, Apparel and Beauty

Artificial Intelligence

John Paul litigates trademark and copyright disputes in federal courts throughout the US. He manages international trademark portfolios for clients in a variety of industries – including clearance, prosecution, counseling, and handling matters pending before the Trademark Trial and Appeal Board (TTAB) at the US Patent and Trademark Office (USPTO). JP advises on trademark- and copyright-related aspects of corporate transactions. JP also advises clients on cutting edge AI issues and he is an active member of Cooley's AI task force.

In addition to his practice, JP is an active member of the International Trademark Association (INTA), where he has had leadership roles and served on the parallel imports and the unfair competition committees. JP currently serves on INTA's internet committee.

JP has been named annually as a top trademark attorney in the World Trademark Review 1000 since 2019. During law school, he served on the executive board of the Notre Dame Journal of Law, Ethics & Public Policy, and he was a research assistant to trademark law professor Mark P. McKenna.

JP's representative matters include:

- Represented a publicly traded edtech company in copyright litigation
- Represented a publicly traded life sciences company in a TTAB trial and related civil action in federal court
- Represented R80 LLC in trademark infringement litigation in *R80 LLC v. Societe des Produits Nestlé S.A. et al.* (D. Md.)
- Represented Charlotte's Web in *Charlotte's Web, Inc. v. AAXLL Supply Co LLC dba Balance CBD* (N.D. Cal.), and obtained stipulated judgment on trademark and false advertising claims
- Represented Allbirds in litigation involving trademark, trade dress and false advertising claims in *Allbirds, Inc. v. Giesswein Walkwaren AG* (N.D. Cal.), and obtained settlement
- Represented 23andMe in connection with trademark and false advertising claims in *23andMe, Inc. v. Ancestry.com DNA, LLC, et al.* (N.D. Cal.), and obtained settlement
- Advised Kylie Jenner's cosmetics company on a \$600 million long-term strategic partnership, and advised Kim Kardashian's cosmetics company on a \$200 million strategic transaction
- Established the fame of the TiVo trademark and prevailed on a claim for trademark dilution after oral arguments at the USPTO with a precedential decision in *TiVo Brands LLC v. Tivoli, LLC* (TTAB)
- Represented online home community Houzz in a trademark and unfair competition lawsuit in *Houzz Inc. v.*

ODL, Incorporated et al. (N.D. Cal.), and obtained settlement

- Defeated a motion for preliminary injunction and won the copyright case on summary judgment in defense of a Chinese company sued for copyright infringement in *DaVinci Editrice S.r.l. v. Ziko Games, LLC et al.* (S.D. Tex.)
- Defeated a motion for preliminary injunction and obtained settlement in a trademark case, *Nordstrom, Inc. v. 7525419 Canada Inc. dba Beyond the Rack, et al.* (W.D. Wash.)
- Obtained a permanent injunction, an order for transfer of 54 domain names, and an award of \$2.23 million in damages, along with costs and reasonable attorney fees, on behalf of BitTorrent in a trademark and cyberpiracy case, *Bittorrent, Inc. v. Bittorrent Marketing GmbH* (N.D. Cal.)
- Obtained a summary judgment in a USPTO cancellation action for non-use in *MeUndies, Inc. v. Drew Massey dba myUndies Inc.* (TTAB)
- Represented a mix of underwriters and issuers in a combined total of 25+ initial public offerings
- Managed global trademark portfolios for hundreds of innovative companies

JP's publications, presentations and speaking engagements include:

- Faculty Presenter, "AI and Trademark Infringement," Intellectual Property Law Institute 2024, PLI Practising Law Institute, October 2024
- Panelist, "Corporate Authorship," 2024 Copyright Symposium, co-hosted by UCLA Institute for Technology, Law & Policy and McCarthy Institute at Sandra Day O'Connor College of Law at Arizona State University, March 2024
- Panelist, "Emerging Issues in Generative AI," Columbia Law School Career Symposium, March 2024
- Presenter, "Copyright and Trademark Update: New Case Law, Generative AI Developments and 2024 Outlook," Cooley CLE Speaker Series webinar, December 2023
- Author, "Supreme Court Ruling Confirms Limits on Parody Defenses to Trademark Claims," Cooley Alert, June 2023
- Panelist, "Generative AI Summit," presented by A.Team, Cooley, and OpenAI, May 2023
- Presenter, "Legal Implications of Generative AI," April 2023
- Guest Lecturer, IP Issues and Entrepreneurship, University of Pennsylvania Wharton MBA Program and New York University Law School
- Presenter, "Recent Developments and Current Trends in Trademark Law: 2022 Update and 2023 Outlook," Cooley CLE Speaker Series webinar, December 2022
- Presenter, "Preparing for the Trademark Modernization Act and CASE Act," Lexology webinar, December 2021
- Presenter, "Recent Developments and Current Trends in Trademark Law: Update From 2021 and Outlook for 2022," Cooley CLE Speaker Series webinar, December 2021
- Presenter, "Cooley U – Intellectual Property Basics," Cooley U webinar series, December 2020
- Presenter, "Recent Developments and Current Trends in Trademark Law," Cooley CLE Speaker Series webinar, December 2020
- Presenter, "Key Developments in Trademark and Advertising Law in 2019," Cooley MCLE – San Diego 2019/2020 and Cooley MCLE – Santa Monica/Los Angeles 2019/2020
- Panelist, "Global IP Security," The Future of Intellectual Property: Examining IP in a Changing World summit, sponsored by the Michelson 20MM Foundation and the Michelson Institute for Intellectual Property in partnership with the University of Southern California, November 2019

- Speaker, “Shades of Gray: Current Issues in Parallel Importation Law – A Global Perspective,” INTA Annual Meeting, May 2019
- Presenter, “Hot-Button Issues in Trademark and Copyright Enforcement and Litigation,” Cooley CLE Program, April 2019
- Author, “Trademark Considerations and Naming Venture Capital Funds,” TheFundLawyer blog, April 2018
- Moderator, “The Trademark Specialist’s Role in Corporate Finance and M&A Transactions,” INTA Annual Meeting, May 2017
- Panelist, “Protecting Intellectual Property,” Corporate Structure in an Emerging Market: Rethinking the Lawyer’s Role in Local Business Trends symposium, sponsored by Pepperdine Law’s Journal of Business, Entrepreneurship & the Law, March 2016
- Moderator, “Private Trademark Decisions: Online Service Providers Acting as Arbiters,” INTA Annual Meeting, May 2015
- Speaker, “Making Your Name on the Global Stage: How to Build and Protect Strong Trademarks Worldwide,” Cooley China High-Growth Companies Workshop, May 2014
- Panelist, “Legal for Startups: Building Value While Mitigating Risk,” Silicon Beach Fest, June 2013
- Co-author, “2010 Trademark Law Decisions of the Federal Circuit,” American University Law Review, April 2011

Education

University of Notre Dame Law School
JD, 2008

University of Pittsburgh
BS, 2005

University of Pittsburgh
BA, 2005

Admissions & Credentials

New York

California

Pennsylvania

US Patent and Trademark Office

Court Admissions

US District Court for the Central District of California

US District Court for the Northern District of California

US District Court for the Southern District of California

US District Court for the Southern District of New York

US District Court for the Eastern District of New York

US District Court for the Eastern District of Pennsylvania

Rankings & Accolades

Legal 500: Key Lawyer – Intellectual Property – Trademark Litigation

World Trademark Review 1000: Top Trademark Lawyer

Memberships & Affiliations

International Trademark Association