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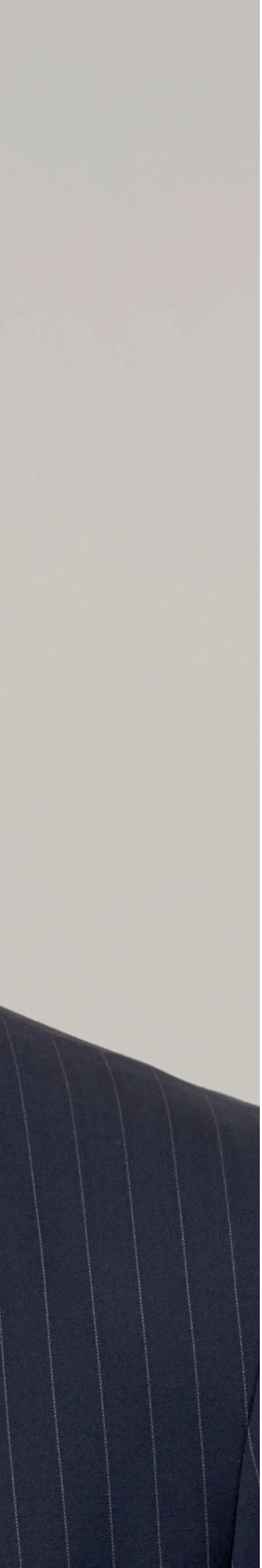
Biography

Douglas (Chip) Rettew focuses his practice on trademark, false advertising and unfair competition litigation, trials, appeals and disputes.

He has been recognised by the *WTR 1000* as "[o]ne of the best litigators in the country with an unbelievable success rate", "a go-to litigation lead for world-famous consumer brands" and "a bigwig in the IP arena" whose "shrewd litigation and trial skills are unmatched".



What does leadership in the IP law field look like to you?

Good leaders in our field must establish their devotion to the profession in various ways. First, they should speak, write and educate the younger generation of professionals coming up the ladder. Here, mentoring is critical. Leaders must provide thorough, constant feedback and give younger professionals hands-on experience with increased and greater opportunities as they develop.

Second, as our world shrinks, IP leaders should establish and nurture relationships with peers around the globe. Beyond the obvious business upsides, it is good to know how other jurisdictions approach trademark law and how your country fits into the bigger picture. Also, there is something nice about attending conferences and spending time with colleagues and friends from around the globe.

The firm has positioned itself as providing services across patents and trademarks for a variety of industries. How do you ensure that the team continues to be at the forefront of service provision and industry developments when spanning multiple focus areas?

This is no easy task. But Finnegan's trademark and copyright group is a well-oiled machine. To ensure that we remain at the forefront and top of our field, we employ a variety of measures. First, we have rigorous training for new lawyers. In addition to the hands-on experience that they get working with our world-class clients and their brands, we organise training sessions from leaders and experts in our group on topics including trademark clearance, prosecution, licensing, litigation, trials and appeals. We have similar training on copyright law, false advertising, rights of publicity, domain name disputes and similar issues. Second, we write a popular blog, *Incontestable*, where our attorneys summarise trademark cases of interest each month. A number of the cases discussed are ones that we have litigated and won. Third, we have monthly meetings for the trademark and copyright group, attended by professionals at all levels – from lawyers to legal assistants, investigators, secretaries and marketing representatives. These meetings provide an opportunity to share information on new clients, cases, projects, issues, tips and success stories. Fourth, because so much of our work involves persuasive and clear writing, Finnegan has a dedicated senior lawyer who works with junior lawyers, and consults with more experienced ones, on how to consistently and continuously improve writing. Fifth, beyond our blog posts, several Finnegan lawyers author treatises (including INTA's online treatise on trade dress and the American Intellectual Property Law Association's treatise on remedies) and articles in various publications. We also teach at law schools and speak at conferences around the world on a host of topics.

Your practice boasts a strong commercial focus. Do you feel that the way in which companies approach the monetisation and value of brands has changed in recent years, and why?

Absolutely. When I started in the field, I was (wrongly) advised that intellectual property was mainly the realm of patent lawyers and that it was not wise to specialise solely in the trademark and copyright area. Thankfully, I did not listen. Over the years, our field has grown exponentially as companies have come to realise that a brand can be (and often is) among their most valuable business assets – and this is not just for the likes of Coca-Cola. In addition to accounting more for brands at a financial level, companies are investing resources to develop their important marks into famous ones. With that comes more investment in enforcement, litigation and international registration.

What challenges are being raised by clients most frequently at the moment, and how can these be tackled?

With the proliferation of e-commerce (where physical brick-and-mortar stores are not needed to sell products), it has become more difficult to clear brands internationally. Thus, companies need counsel who can dig deep and properly assess the real risks in using a new mark, while also thinking creatively on how to clear the path for use and registration.

The ease of e-commerce has also created challenges in enforcing brands. As trademark owners must be diligent in stopping third-party infringements early on, they need to devote resources for finding, investigating and stopping unauthorised uses.

What are the top qualities that clients should look for when seeking world-class trademark advisers?

World-class trademark advisers should know the law in their jurisdiction inside and out. They should also understand each client's industry, issues, business

objectives and risk tolerances. This is what makes our job fun, challenging and never boring.

When choosing a litigator, clients are well suited with someone who has real trial experience, knows how to try a case and, more importantly, likes trying cases before judges and juries (and is eager to do so). Those are the types of lawyer who prepare cases properly and efficiently, by focusing on what really matters at the end of the day. Moreover, litigators with those qualities often settle the cases that can be resolved – and win the cases that cannot.

Do you think that it is getting easier or harder to litigate trademark disputes, and why?

Trademark litigation is becoming more complex, more challenging and more fun. This is in part because empirical surveys are becoming more accessible since they can be conducted online (at cheaper costs than the traditional in-person mall-intercept surveys). With this statistical social-science evidence comes a host of thorny issues that give experts plenty of fodder to debate and fight over. To that end, litigators must understand the nuances of survey research (there was a value to paying attention in maths class after all) and, importantly, know which experts are the best in court, before judges and juries. One lesson that I have learned from trying cases is that it is often better to have an expert who can communicate complex concepts cogently and clearly, than to have one who rests their laurels merely on degrees and academic accolades.

Which trademark-focused case has been your most memorable or satisfying, and why?

I have had the good fortune of trying trademark cases before judges and juries, which is somewhat rare in our field. I have loved every one, but the case that stands out was my first. I was an associate at Finnegan and a client, Gateway Computers, wanted me to try a case on my own. With the firm's blessing and support, I flew to South Dakota and tried the case before a jury and judge (the jury was advisory and the judge ultimately decided the case). I had been to only one trial before (where I was tasked with legal research and sorting binders and exhibits) and had never taken a witness, let alone delivered an opening statement and closing argument. Far from the sophisticated trial teams that now support many of our cases, I went to this case with one paralegal, a folder of supplies and a copy of *McCarthy on Trademarks and Unfair Competition*. Fortunately, my paralegal was outstanding and supported me through what was truly a trial by fire. We ended up winning, the court issued a published decision and I successfully defended the victory on appeal to the US Court of Appeals for the Eight Circuit. The case was no-nonsense, no-frills lawyering at its finest. It started what has become a very fortunate run. Since then, I have had the privilege and honour of trying cases for other major brands, including Under Armour, Bridgestone and Vagisil.

What qualities make for an elite-level attorney, and how can they be better developed?

An elite-level IP attorney must:

- know the law cold and be diligent in keeping up with substantive and procedural developments;
- be a quick study and able to absorb the nuances of each client's IP portfolio and business;
- have good instincts and not be afraid to make decisions;
- be creative and think of ways to achieve a client's business objectives through the law; and
- be a good communicator, both in writing and orally.

All of this comes from a high level of commitment (eg, reading new cases, reading and writing articles, and attending and giving speeches) and lots of practice.

As a law firm leader, what keeps you up at night?

Competition, keeping clients happy and winning over judges and juries. As our field grows, so does the competition. This keeps us on our feet and forces us to be effective, efficient and creative with billing arrangements. While perhaps not good for sleep, or my receding hairline, it ultimately makes for better lawyers.

If you could make one change to the trademark world, what would it be?

In the United States, we need more clarity on what constitutes irreparable harm in trademark cases, which is a requirement for obtaining an injunction. As much of our practice involves preliminary injunctions (and injunctive relief generally), this is very important. Following a Supreme Court patent case, the lower courts have held that it is not enough to show a likelihood of success on the merits of a trademark claim; more is needed for irreparable harm. What that is arguably remains unclear.

Also, it would be good to see a unified federal right-of-publicity statute. Currently, we must rely on a hodgepodge of different – and sometimes inconsistent – state laws that govern this important legal area.

AI has been a big talking point over the past year. What impact do you feel it will have on trademark practice?

I do not believe that AI can supplant the ultimate judgement calls that trademark professionals need to make in regard to clearance, prosecution and litigation. However, it can streamline things and make them more efficient. This will likely further manifest itself in clearance searching and litigation document review and production. The prospect of making litigation more efficient is a good and exciting thing. With that, more clients can have their day in court (without breaking the bank) and lawyers can focus their time and attention on the meaty substantive issues.

Finally, what advice would you give to those in the early stages of a career in IP law?

Insecurity is the best job security. This is one of the most exciting, fun and challenging careers out there. But to succeed, you need to keep up with the law, promote yourself, work tirelessly and give your all to clients, their issues and their cases. This means late nights, weekend work and interrupted holidays. Success in this field is not for the faint hearted. But it is worth it.