



Clark W. Lackert

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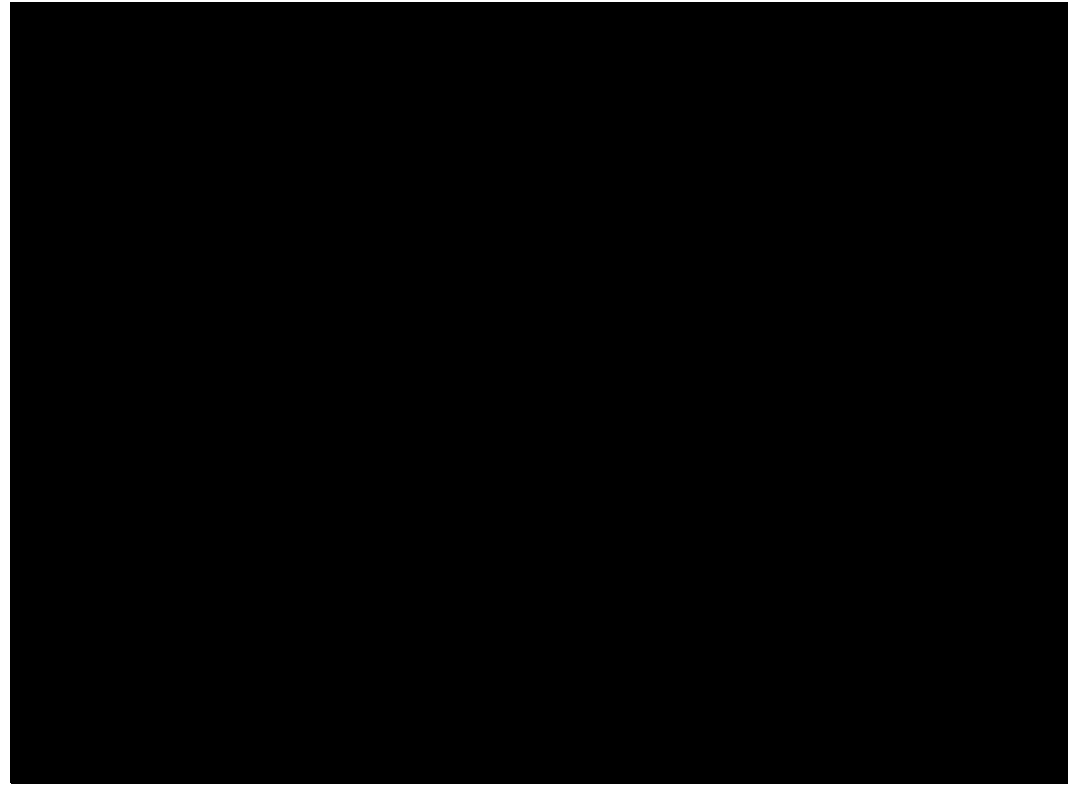
Overview

Clark focuses his practice on trademark, copyright, domain name, licensing, and anti-counterfeiting matters, both in the United States and internationally. He has more than two decades of experience in all aspects of international trademark and copyright laws, including conflict and litigation cases, acquisitions and divestitures involving due diligence for intellectual property assets, licensing and franchising, enforcement actions, and global portfolio management. As part of his sophisticated international practice, he has worked with local counsel in more than 200 countries and coordinated litigation in the United States and abroad. His clients include multinational corporations, startup companies, *Fortune* 200 companies, and household names.

Clark is known for his thought leadership and knowledge of the field, which enables him to provide a cost-effective and strategic approach to his clients' challenges. He is a frequent author on issues involving online liability for trademark infringers and counterfeiters, geographical indications, and famous trademarks, among other topics, and has lectured on these topics to various professional groups throughout the United States and on six continents, including to the China Trademark Association, the Brazilian Intellectual Property Association, the Institute of Patent and Trade Mark Attorneys of Australia, the AIPPI South Africa, the U.K. Institute of Trade Mark Attorneys (of which he is a long-standing member), the Japan Patent Attorneys Association, the Coalition of Intellectual Property Rights, the International Association of Intellectual Property, and many others.

He is also active in various professional associations. He is the past president of the U.S. group of the International Association for the Protection of Intellectual Property (AIPPI) and a former member of the executive committee of the board of directors for the International Trademark Association (INTA), and has chaired numerous ABA and INTA trademark and copyright committees. As an internet domain name arbitrator for the World Intellectual Property Organization (WIPO), Clark has rendered 57 published decisions and is an active member of the Intellectual Property Constituency (IPC) of the Internet Corporation for Assigned Names and Numbers (ICANN). He previously served as a consultant to the U.S. government on implementation of the World Trade Organization TRIPS Agreement concerning trademark, patent, and copyright issues.

Clark is consistently considered one of the world's top trademark lawyers by various rankings.



All Insights

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- 11.03.2020 Life on Mars?
Intellectual Property Magazine
-
- 03.02.2020 Trademarks Off-World: A New Frontier or Lost in Space?
World Trademark Review
-
- 12.31.2019 EU Court Rules Cannabis Trademark Unregistrable as Contrary to Public Policy
-
- 10.03.2019 Co-Branding: Cooperation or Competition?
World Trademark Review
-
- 07.22.2019 Global Protection For Cannabis Trademarks: Real Or Smoke And Mirrors?
Innovate Magazine
-
- 07.08.2019 New U.S. Patent and Trademark Office Rule Concerning Legal Representation for Foreign Trademark Applicants, Registrants, and Parties in TTAB Proceedings Effective August 3, 2019
-
- 06.01.2018 Country Names as Trademarks
INTA Bulletin
-

02.01.2018	Disparagement in U.S. Trademark Law <i>AIPPI Journal Japan</i>
01.01.2018	Anti-Social Media: New Horizons in Brand-Based Fraud <i>World Trademark Review Yearbook</i>
07.21.2015	ICANN 53 Global Meeting <i>Technology Law Dispatch</i>
05.01.2015	Cybersecurity's Weapon of Choice <i>Corporate Counsel</i>
01.01.2014	Counterfeits and Infringements Online - A Global Overview of Liability <i>World Trademark Review</i>
09.01.2013	Inside the Minds: Defending Intellectual Property Rights in China <i>Thomas Reuters</i>
11.01.2009	Pharmaceutical Trademarks - U.S. <i>World Trademark Review, Issue 21</i>
09.01.2009	Non-Traditional Trademarks - U.S. <i>World Trademark Review, Issue 20</i>
07.01.2009	Trademark Enforcement - U.S. <i>World Trademark Review, Issue 19</i>
06.01.2009	Best Practices for Trademark Enforcement <i>Corporate Lawyer</i>
04.01.2009	Advanced Trademark Prosecution Issues <i>World Trademark Review, Issue 19</i>
03.01.2009	Internet Issues for Trademarks - U.S. <i>World Trademark Review, Issue 17</i>
12.01.2008	Protection for Unregistered Trademarks - U.S. <i>World Trademark Review, Issue 16</i>
06.01.2008	Protecting Well-Known and Famous Mark, a Global Perspective <i>IP Value</i>
04.01.2007	Chinese Domain Names in the 21st Century <i>Asia Law</i>
06.01.2006	Key Issues in Managing a Global Brand

IP Value

- 06.01.2005 Global Trademark Practice in the 21st Century
IP Value
-
- 04.01.2004 IP Rights May be Used to Combat Internet Fraud
The National Law Review
-
- 08.01.2003 The Madrid Protocol: Mechanics, Strategies, and Beyond
National Legal Center for Public Interest
-
- 06.01.2003 INTA and the International Courts
Trademark Reporter (INTA)
-
- 05.01.2002 Famous Marks Dilution - Does the U.S. Meet TRIPS Standards?
NYLJ
-
- 12.01.1998 Worldwide Trademark Transfers
International Trademark Association (INTA)
-
- 06.01.1998 Geographical Indications: What Does the WTO TRIPs Agreement Require?
Trademark World
-
- 04.01.1998 Famous Marks
International Quarterly, Volume 10
-
- 06.01.1996 Intellectual Property Rights Reform in the Middle East
Middle East Commercial Law Review
-
- 06.01.1988 International Efforts Against Trademark Counterfeiting
Columbia Business Law Review

All News

- 02.15.2021 Carlton Fields Attorneys Named 2021 “World’s Leading Trademark Professionals”
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- 02.04.2021 Carlton Fields’ Clark Lackert Featured in AsiaIP on IP Laws for Outer Space
-
- 11.03.2020 Clark Lackert Authors Intellectual Property Magazine Article About Trademarks in Space
-
- 02.18.2020 Carlton Fields Attorneys Named 2020 “World’s Leading Trademark Professionals”
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12.25.2019	Trademarks in Space: How to Future-Proof Off-World Brands
10.03.2019	Co-Branding: Cooperation or Competition?
09.12.2019	New York Metro Super Lawyers Honors Carlton Fields Attorneys on 2019 Lists
07.22.2019	Global Protection for Cannabis Trademarks: Real or Smoke and Mirrors?
05.14.2019	Distinguished Intellectual Property Attorney Clark W. Lackert Joins Carlton Fields

Recognition

- *The Best Lawyers in America*, Litigation – Intellectual Property, Trademark Law (2007–2021)
- *WTR1000*
- *New York Super Lawyers* (2007–2012, 2014–2019)
- *Who's Who Legal*

Professional & Community Involvement

- International Association for the Protection of Intellectual Property (U.S. Group)
 - President (2006–2008)
 - Secretary (2001–2006)
- International Trademark Association
 - Executive Committee of the Board of Directors
 - Chair, Amicus Brief Committee
 - Chair, Issues and Policy Committee
 - Chair, External Affairs Committee
 - Chair, Geographical Indications Committee
 - Chair, Related Rights Committee
 - Chair, Bulletin Committee
- American Bar Association
 - Chair, Internet Trademark Use Subcommittee, Trademarks and the Internet Committee, Section of Intellectual Property Law (2020–2021)
 - Chair, Copyright and Trademark Division
 - Chair, International Trademark Committee
 - Chair, Trade Secrets Committee
 - Chair, Franchising Committee

- American Intellectual Property Law Association
 - Editorial Board, *AIPLA Quarterly Journal* (2019–2022)
- The Coalition for Intellectual Property Rights
- Pharmaceutical Trade Marks Group
- Pharmaceutical Research and Manufacturers of America
- New York Intellectual Property Law Association
- New York State Bar Association

Speaking Engagements

- "Comprehensive Intellectual Property Legal Protection in Space Will Enhance ISS Commercialization and Nongovernment Utilization," International Space Station Research & Development Conference (September 22, 2020)
- "IP in Space: The Time to Act is Now," Florida Space Day, Tallahassee, FL (January 22, 2020)
- "International Trademark Law and Practice," INTA Annual Meeting, Boston, MA (2019)
- "Global Protection for Famous Trademarks," INTA Annual Meetings (2012–2019)
- "U.S. Trademark Law Update," IPTA conference, Perth, Australia (2017)
- "U.S. Trademark Law Update," JPAA, Tokyo, Japan (2017)
- "U.S. Trademark Law Update," Chofn, Shenzhen and Hangzhou, China (2017)
- "International Searching and Filing Strategies," PLI Understanding Trademark Law in the Global Marketplace 2012, New York, NY (July 17, 2012)
- "Global Protection for Famous Trademarks," INTA International Academy, Washington, D.C. (May 5, 2013)
- "Special Issues in Copyright and Trademark Law," PLI IP Issues in Business Transactions 2013, New York, NY (January 3, 2013)
- "The Right Mechanics: Trademark Searching and Clearance in a Global Environment," INTA Trademark Administrators Conference, Charlotte, NC (October 14–16, 2012)
- "International Searching and Filing Strategies," PLI Understanding Trademark Law in the Global Marketplace 2012, New York, NY (July 17, 2012)
- "Global Protection for Famous Trademarks," INTA International Academy, Washington, D.C. (May 6, 2012)
- "IP Practitioner in Residence," Indiana University Maurer School of Law, Bloomington, IN (February 15, 2012)
- "U.S. Trademark, Domain Name, and Internet Update," U.S. IP Law Forum, London, UK (November 16, 2011)
- "U.S. Trademark, Domain Name, and Internet Update," U.S. IP Law Forum, Milan, Italy (November 15, 2011)
- "U.S. Trademark, Domain Name, and Internet Update," U.S. IP Law Forum, Milan, Italy (November 14, 2011)
- "Online Trademark Infringements: U.S. and International Developments and Best Practices," New Jersey Trademark Counsel Luncheon Club, Basking

Ridge, NJ (November 3, 2011)

- "International Searching and Filing Strategies," PLI Understanding Trademark Law, New York, NY (July 19, 2011)
- "Fighting Counterfeiting and Trademark Infringement in China," NYIPLA Half-Day Trademark CLE Program, New York, NY (June 14, 2011)
- "Global Protection for Famous Trademarks," INTA International Academy, San Francisco, CA (May 14, 2011)
- "AdWords: A Comparative Analysis," Fordham Annual IP Conference, New York, NY (April 29, 2011)
- "EU & U.S. Trademark Dilution," Fordham Annual IP Conference, New York, NY (April 28, 2011)
- "Handling Complex Prosecution Issues," INTA Roundtable, Irvine, CA (April 15, 2011)
- "IP Practitioner in Residence," Indiana University Maurer School of Law, Bloomington, IN (March 29–30, 2011)
- "The Intersection of Trademark and Copyright and the Right of Publicity," USC Gould School of Law 2011 IP Institute, Beverly Hills, CA (March 22, 2011)
- "Global Brand Protection Against Online Infringements," Bird & Bird LLP, Milan, Italy (February 16, 2011)
- "Global Brand Protection Against Online Infringements," ITMA London Evening Meeting, London, UK (February 15, 2011)
- "Legal Remedies Available for Brand Owners in the United States," INTA USPTO Study Tour on IP and Enforcement for Latin American Judges, New York, NY (November 3, 2010)
- "Global Brand Protection Against Online Infringements," ACC-NY CLE Program, New York, NY (November 2, 2010)
- "Trademarks," Korea Electric Association (KEA) IP Seminar, Seoul, South Korea (September 28, 2010)
- "Trademark Law (US) Committee: Use and Abuse of Trademarks on the Internet," IPO Annual Meeting, Atlanta, GA (September 13, 2010)
- "Global and U.S. Trademark Enforcement and Anti-Counterfeiting Issues," USPTO Global Intellectual Property Academy and the Thai Central IP and International Trade Court Seminar on Enforcement of Intellectual Property Rights, Alexandria, VA (August 16, 2010)
- "International Searching and Filing Strategies," PLI Understanding Trademark Law 2010, New York, NY (July 20, 2010)
- "Famous Marks Doctrine from a Global Perspective," INTA Famous and Well-Known Marks Committee, New York, NY (July 20, 2010)
- "Challenges in Protecting Foreign GIs in the U.S. as well as AOPs in Foreign Jurisdictions," ORIGIN Conference – American Origin Products (AOP): Economic and Legal Perspectives, Washington, D.C. (June 3, 2010)

Credentials

EDUCATION

- New York University School of Law
(LL.M., Trade Regulation)

- University at Buffalo School of Law (J.D.)
- Cornell University (A.B., cum laude)

BAR ADMISSIONS

- New York

Background

- Partner and Counsel, Reed Smith LLP, New York, NY (2013–2019)
- Partner, Dickstein Shapiro LLP, New York, NY (2010–2013)
- Partner and Deputy Practice Group Leader (IP), King & Spalding LLP, New York, NY (2001–2010)
- UDRP Domain Name Panelist – Arbitrator, WIPO, Geneva, Switzerland (2000–present)
- Named Partner, Nims, Howes, Collison, Hansen & Lackert, New York, NY (1981–2001)

Areas of Focus

PRACTICES

- Alternative Dispute Resolution Services
- Cannabis Law
- Intellectual Property
- Intellectual Property Protection
- Technology