

## Bruce Alexander McDonald

Mr. McDonald is a partner in the trademark and intellectual property litigation groups at Smith, Gambrell & Russell, LLP, a 200-attorney law firm based in Atlanta and founded in 1980. He is a 1979 graduate of the American University, Washington College of Law (1979), and a member of the District of Columbia Bar with undergraduate degrees in Economics and Russian from the University of California, in addition to a national Russian language scholarship at Leningrad State University (1976).

**Federal Court Litigation.** Mr. McDonald's recent and representative court cases and administrative actions at the Trademark Trial and Appeal Board (TTAB) include:

- *National Grange v. California State Grange*, Nos. 15-17179, 15-17274 (9<sup>th</sup> Cir.) (pending) (counsel for national association in trademark infringement action)
- *International Olympic Committee v. Frayne*, 4:15-cv-03277 (S.D.Tex.) (pending) (counsel for international association in cybersquatting and trademark infringement action)
- *Federal Treasury Enterprise v. Spirits International B.V.*, Nos. 14-4721, 15-152 (2d Cir.) (pending) (counsel for *amicus curiae* Advisory Council to the Russian Court of Intellectual Property)
- *AESP, Inc. v. Signamax, LLC*, 29 F. Supp. 3d (E.D.Va. 2014) (counsel for Czech corporation in successful defense of trademark infringement action on jurisdictional grounds)
- *Nationstar Mortgage LLC v. Ahmad*, 112 USPQ2d 1361 (TTAB 2014) (counsel for successful opposer in first published TTAB case to sustain fraud action since *In re Bose Corp.*, 580 F.3d 1240 (Fed. Cir. 2009)
- *Federal Treasury Enterprise v. Spirits International B.V., et al.*, 726 F.3d 62 (2d. Cir. 2013) (counsel for *amicus curiae* Government of the Russian Federation)
- *Johnson & Johnson v. Obschestvo s Ogranichennoi Otvetstvennostiu WDS*, Opposition No. 91182207 (TTAB 2013) (counsel for Russian cosmetics manufacturer)
- *Transamerica Corp, v. Moniker Online Services LLC*, 672 F. Supp. 2d 1353 (S.D.Fla. 2009) (counsel for plaintiff in landmark ruling)
- *Collen IP v. American Bar Association*, 07-1861 (ESH) (D.D.C. 2008) (counsel for American Bar Association in first trademark infringement suit ever brought against the ABA)
- *Bank Soyuz v. Office of Foreign Assets Control*, Case No. 1:05CV01073 (D.D.C.) (successful action against U.S. Treasury Dept. Office of Foreign Assets Control (OFAC) forcing release of frozen assets)

**Russian Practice.** Mr. McDonald is fluent in Russian and has represented the government of the Russian Federation as *amicus curiae* in related appellate actions over the past three years, and successfully defended a Russian cosmetics manufacturer in a TTAB opposition. In 2013, he addressed the Russian Supreme Court, in Russian, on intellectual property procedure in U.S. courts and administrative agencies, and was subsequently the first and only American named to the Advisory Council of the Russian Court of Intellectual Property.

**Export Licensing.** Mr. McDonald has experience in export licensing dating back to responsibility for export control compliance on behalf of a U.S. technology company engaged during the Cold War in shipments of array processors and related technology to the Eastern Bloc and China. In 2006 he represented a Russian bank in one of the only known successful court actions against the U.S. Treasury Department and OFAC arising out of the wrongful imposition of economic sanctions. He has prepared export control compliance programs for information technology companies and software developers, and in November 2013 was engaged by an intellectual property law firm to provide specialized advice on export licensing and international trade.

**Labor and Employment Litigation.** Mr. McDonald spent four years in the Office of the Solicitor at the U.S. Department of Labor and appeared as lead counsel in several dozen oral arguments before the U.S. Courts of Appeals including *Back v. Director, Office of Workers' Compensation Programs*, 796 F.2d 169 (6th Cir. 1986); *Begley v. Consolidation Coal Co.*, 826 F.2d 1512 (6th Cir. 1987); *Farmer v. U.S. Dept. of Labor*, 839 F.2d 269 (6th Cir. 1988); *Heffinger v. U.S. Dept. of Labor*, 813 F.2d 401 (4th Cir. 1986); *Kiser v. Office of Workers' Compensation Programs*, 85-19944, 1986 U.S. App. LEXIS 186368 (4th Cir. June 12, 1986); *Phillips v. Director, Office of Workers' Compensation Programs*, 768 F.2d 982 (8th Cir. 1985); and *Williamson Shaft Contracting Co. v. Phillips*, 794 F.2d 865 (3d Cir. 1986).

**Energy and Natural Resource Litigation.** Mr. McDonald's litigation experience includes four years in an oil and gas federal litigation boutique where he appeared as counsel of record in cases including *Oasis Petroleum Corp. v. U.S. Dep't of Energy*, 718 F.2d 1558 (Temp. Em. Ct. App. 1983); *Kocher Coal Co. v. Marshall*, 497 F. Supp. 73 (E.D.Pa. 1980), and *Kocher Coal Co. v. Marshall*, 505 F. Supp. 156 (E.D. Pa. 1981).

### **Professional and Civic Associations**

#### **American Bar Association Section of International Law**

- Chair, Vice-Chair, Co-Chair and/or Senior Advisor, International Intellectual Property Rights Committee (1999 - present)
- Vice-Chair and/or Senior Advisor, Committee on Privacy, E-Commerce & Data Security (2007 - present)
- Editor in Chief, International Data Protection and Online Security Newsletter (2009-2010)
- Liaison to American Bar Association Section of Intellectual Property Law (2002-2005)
- Outstanding Volunteer of the Year Award (2007-2008)
- Creator and Editor in Chief, ABA Journal of Newly Independent States of the Former Soviet Union (1995-97)
- Translation of Russian Civil Code and other draft legislation into English for ABA Central and Eastern Europe Law Initiative (CEELI)(1991-1994)

#### **International Trademark Association**

- Member, INTA Internet Committee, Whois Subcommittee (current)

- Leader, INTA Task Force on Translation and Transliteration of Whois Contact Data (current)
- Leader, INTA Task Force on ICANN Procedures for Conflicts Between WHOIS and National Privacy Laws (current)
- Leader, Working Group on Substituted Service of Process by Electronic Mail (2008-2012)
- Author, Working Group Report on Electronic Service of Process on Fictitious Owners of Commercial Websites, presented to INTA Board of Directors and Executive Committee (Miami, FL, Nov. 11, 2009)

#### **U.S.-Russia Business Council**

- Member, 2004-present

#### **Civic Association**

- Cosmos Club, Washington, D.C. (2009-present)
- Rotary Club of Arlington, Virginia (1986-2009; President, 1995-96)

#### **Publications and Appearances**

- Guest Lecturer, Pericles Center for International Legal Education (Nov. 20, 2015)
- *Remedies Against Fictitious and Anonymous Service Mark Counterfeiting*, 7(1) *Landslide* 47 (Sept./Oct. 2014)
- *Contrasts and Comparisons Between the U.S. Court of Appeals for the Federal Circuit and the Court of Intellectual Property of the Russian Federation*, Panel Presentation, Sixth Annual Dispute Resolution Conference, American Bar Association, Moscow, Russia, (Sept. 19, 2014)
- *BRICS and IP*, Second Annual BRICS Conference, Panel Presentation, Eurasia Center, Washington, D.C. (May 13, 2014)
- *Limitations of Judicial Power Under Article III of the U.S. Constitution*, Panel Presentation (in Russian), Moscow State Kutafin University of Law, Moscow, Russia (February 14, 2014)
- White Paper, *Issues Raised by the Exercise of Judicial Power in the Development of Standards, Guidelines and Definitions Relating to Unfair Competition and Intellectual Property*, presented to the Court of Intellectual Property of the Russian Federation, Moscow, Russia (Dec. 27, 2013) (in Russian with English translation)
- *Intellectual Property Procedure in U.S. Courts and Administrative Tribunals Under the New U.S. Patent Act* (in Russian), *Journal of the Russian Court of Intellectual Property* (August 2013) (in Russian)
- Speaker and Program Chair, *International Trademark Registration Under the Madrid Protocol*, Spring Meeting, American Bar Association, Section of International Law, Washington, D.C. (April 24, 2013)

- Speaker (in Russian), Supreme Commercial Court of the Russian Federation, Moscow, Russia (April 22, 2013)
- *Legal & Regulatory Issues in the Beverage Industry: Trademark Registration*, Multimedia Presentation, Aug. 15, 2013, posted at [www.bevnetfbu.com/experts/bruce-a-mcdonald](http://www.bevnetfbu.com/experts/bruce-a-mcdonald)
- Speaker (in Russian), Moscow Academy of Economics and Law, *Recent Developments in U.S. and International Trademark Law* (September 24, 2012); and other Russian audiences (September 24, 2012)
- Co-Author, *International Intellectual Property Law: 2012 Year in Review*, 47 Int. Law. 213 (Spring 2013)
- Co-Author, *Privacy, Electronic Commerce and Data Security, 2012 Year in Review*, 47 Int. Law. 99 (2013)
- Co-Author, *International Intellectual Property Law: 2011 Year in Review*, 46 Int. Law. 215 (Spring 2012)
- *Why Trademark Owners Must Lead the Fight for Accountability in E-Commerce*, World Trademark Review (Aug./Sept. 2011)
- *Copyright, Patent and Trademark Developments in the Russian Federation: 2010 Year in Review*, Russia Business Watch (Spring 2011)
- Speaker, *Fictitious & Anonymous Websites*, 2011 Spring Meeting, ABA Section of International Law, Washington, D.C. (April 8, 2011)
- Co-Author, *Intellectual Property Law: 2010 Year in Review*, 45 Int'l Law. 205 (2011)
- Editor-in-Chief, *American Bar Association International Data Protection and Online Security Committee Newsletter* (2009-2010)
- Speaker, *Electronic Service of Process in Actions Arising Out of the Advertising and Sale of Goods and Services at Fictitious and Anonymous Websites*, American Bar Association, Annual Meeting, San Francisco, CA, August 6, 2010
- Co-Author, *Intellectual Property Law: 2009 Year in Review*, 44 Int'l Law. 245 (2010)
- *Domain Name Registrar May be Liable for Service Mark Counterfeiting as "De Facto" Registrant*, ABA International Data Protection & Online Security Newsletter, Vol. II, No. 1 (Spring 2010)
- Speaker, *Fictitious and Anonymous Websites and Domain Name Registration*, New York State Bar Association, Media Law Committee, New York City, December 15, 2009
- *Electronic Service of Process in Actions Arising From Advertising and Sale of Goods and Services at Fictitious and Anonymous Websites*, ABA International Data Protection & Online Security Newsletter, Vol. 1, No. 2 (Fall 2009)
- *Alarm Grows Over Counterfeit Website Ownership as Registrars, Feigning Privacy Concerns, Oppose Disclosure; ICANN Appears Powerless to Intervene*, ABA International Data Protection & Online Security Newsletter, Vol. I, No. 1 (Spring 2009)

- Co-Author, *Intellectual Property Law: 2008 Year in Review*, 43 Int. Law. 549 (Summer 2009)
- *Report of International Trademark Association (INTA), Substituted Service of Process by Electronic Mail: Achieving Notice on Fictitious Owners of Commercial Websites for Access to Judicial Remedies*, presented to INTA Board of Directors and Executive Council, Miami, FL (Nov. 11, 2009)
- *Russian IP Laws Meet Essential WTO Standards*, Russia Business Watch (Spring 2009)
- *The Great Domain Debate*, Statement of International Trademark Association (INTA), European CEO (June 2008)
- Co-Author, *Intellectual Property Law: 2007 Year in Review*, 42 Int'l Law. 463 (Summer 2008)
- Co-Author, *Intellectual Property Law: 2006 Year in Review*, 41 Int'l Law. 379 (Summer 2007)
- Speaker, Internet Seminar, "China IPR Webinar Series," U.S. Department of Commerce, Office of China Economic Area (Nov. 13, 2007)
- Panel Participant, "*The Future of Whols*," sponsored by New York Chapter of the Internet Society, New York, New York (November 8, 2006)
- *Sites in Shadow: Typosquatters on the Web Don't Deserve the Mask of Anonymity*, Legal Times (June 26, 2006)
- *Intellectual Property Developments in China: 2005*, China Intellectual Property (June 2006), pp. 22-33
- Roundtable Host, "Preventing the Sale of Counterfeit Goods and Other Trademark Infringements on Internet Auction Sites," Philadelphia, PA, sponsored by International Trademark Association (INTA), April 13, 2005
- *Service Mark Counterfeiting And Worse: U.S. Companies Resort to Self-Help in Canada When Cross-Border Law Enforcement Falls Short*, Metropolitan Corporate Counsel (Sept. 2004)
- "International Trademark Registration and the Madrid Protocol," in Masterson, ed., *International Practitioner's Deskbook Series: International Trademarks and Copyrights - Enforcement and Management* (American Bar Association 2004)
- Co-Author, "Recording Trademarks, Trade Names and Copyrights with U.S. Customs: Requirements, Procedure and Fees," in Masterson, ed., *International Practitioner's Deskbook Series: International Trademarks and Copyrights - Enforcement and Management* (American Bar Association 2004)
- *Russian Independents Struggle for Parity With Majors Under Tax Changes*, Oil and Gas Financial Journal (June 2004)
- *Cybersquatting and Trademark Infringement on the Internet: Recent Developments and Best Practices for Investigation and Enforcement*, presented at Spring Meeting, ABA Section of International Law and Practice (2002)

- Program Co-Chair, *Securing and Enforcing Intellectual Property Rights Abroad*, Annual Meeting, ABA Section of International Law and Practice, Washington, D.C. (Aug. 10, 2002)
- Program Chair, *Due Diligence Investigations in International IP Acquisitions & Transactions*, ABA Section of International Law and Practice (June 5, 2002)
- Program Co-Chair, International Intellectual Property Practitioners' Workshop, Spring Meeting, ABA Section of International Law and Practice (May 9, 2002)
- *International Intellectual Property Rights, 2000 Year-in-Review*, 35 Int'l Law. 465 (2001)
- Panelist, *Intellectual Property and International Trade*, American Bar Association and Federal Communications Bar Association, Washington, D.C. (May 24, 2001)
- Program Chair, Internet Domain Names, Trademarks and Disputes in Cyberspace, Spring Meeting, ABA Section of International Law and Practice, Washington, D.C. (April 27, 2001)
- *Trademarks, Internet Advertising and the Demise of Progressive Encroachment*, National Law Journal (Dec. 18, 2000)
- *Trademark Counterfeiting Raises Public Outcry in the Russian Federation*, Trademark World (Oct. 2000)
- *Recommended Corporate Policy for Trademark and Service Mark Use and Protection*, The Metropolitan Corporate Counsel, Vol. 8, Nos. 5 & 6 May 2000 (Part I); June 2000 (Part II)
- *Intellectual Property Rights and Electronic Commerce*, 1 Internet L. & Bus. 483 (May 2000)
- Program Chair, Intellectual Property Rights and Electronic Commerce, Spring Meeting, ABA Section of International Law and Practice, Washington, D.C. (April 13, 2000)
- *Issues Raised by State Claims of Copyright Infringement in Automated Mapping Data*, presented at Sixth World Congress, Intelligent Transport Society, Toronto, Ontario (Nov. 11, 1999)
- *Intellectual Property Protection in the Republic of Georgia*, Caspian Crossroads (1998)
- Program Chair, *Intellectual Property Protection in the Former Soviet Union*, Annual Meeting, American Bar Association, Toronto, Canada (July 31, 1998)
- Keynote speaker (in Russian), *U.S. and International Patent, Trademark and Copyright Law*, presented to Young Lawyers Association of the Republic of Georgia, Tbilisi, Georgia (Nov. 12, 1997)
- Speech (in Russian), *Recent Developments in U.S. and International Patent and Trademark Practice*, presented to Patent and Trademark Office of Republic of Georgia, Tbilisi, Georgia (November 15, 1997)
- *A Model Intellectual Property Enforcement Act for the Russian Federation*, ABA Journal of the Newly Independent States of the Former Soviet Union Law Committee (Fall 1997)

- Published Russian/English Translation, *Law of the Russian Federation on the Judicial System of the Russian Federation*, ABA Journal of the Newly Independent States of the Former Soviet Union Law Committee (Fall 1997)
- *Index of Russian Laws and Regulations*, ABA Journal of the Newly Independent States of the Former Soviet Union Law Committee (quarterly, 1995-1997)
- Editor in Chief, ABA Journal of the Newly Independent States of the Former Soviet Union Law Committee (1995-1997)
- Speech (in Russian), *Intellectual Property Rights and WTO Accession by the Republic of Georgia*, to Joint Session of Georgian Government, Tbilisi, Georgia (Oct. 16, 1996)
- Television Interview (in Russian), *Intellectual Property Issues and WTO Accession*, national broadcast, Tbilisi, Republic of Georgia (Oct. 16, 1996)
- *Before You Get Out the Branding Irons: Is the Appearance of Brand Names in Catalogs "Trademark Use" or Mere Advertising?* Catalog Age (May 1996)
- *Protection of Technology Transfers and International IP Agreements*, 6 Cent. Eur. Bus. Guides (May 1, 1996), 1996 WL 865105
- Published Translation, *Collection of Declassified CPSU Documents*, ABA Journal of the Newly Independent States of the Former Soviet Union Law Committee (Fall 1996)
- *Intellectual Property Developments in the Russian Federation*, ABA Journal of the Newly Independent States of the Former Soviet Union Law Committee (Winter 1996)
- *Intellectual Property Developments in the Russian Federation*, East/West Executive Guide (March 1996)
- *Rights Owners in Russia Suffer as Pirates Flourish*, Managing Intellectual Property (Feb. 1996)
- *The Toll Free Trademark*, Managing Intellectual Property (Feb. 1996)
- *Opportunity for Export of Intellectual Property Gets Big Boost From GATT Implementation*, Managing Intellectual Property (Jan. 1996)
- *Trademarks and the Internet: How to Protect Your Turf*, Catalog Age (Sept. 1995)
- *GATT Ratification Means Big Changes to US IP Law*, Managing Intellectual Property (March 1995)
- Keynote Speaker (in Russian), Rotary Club, St. Petersburg-Neva, Russia (Sept. 15, 1994)
- Keynote Speaker (in Russian), Rotary Club, St. Petersburg, Russia (Sept. 14, 1994)
- Keynote Speaker (in Russian), Rotary Club, Moscow, Russia (Sept. 6, 1994)
- *Bruce A. McDonald on Legal Issues: Protecting Your List From Wrongful Use*, Catalog Age (Aug. 1994)

- *Recent Legislative Developments in the U.S.*, Copyright World (March 1994)
- Author (in Russian), *Comparative Analysis of Russian and American Intellectual Property Law*, Zakon (Jan. 1994)
- *Eximbank Operating Procedures Under the Russian Oil and Gas Framework Agreement*, East/West Executive Guide (Oct. 1993)
- *Copyright Issues Raised by the Outsourcing of Information Services*, Copyright World (Sept. 1993)
- *Debate Intensifies Over Copyright Issues Raised by Digital Technology and Information Networks*, Copyright World (June 1993)
- Program Co-Chair (in Russian), *Principles of American Intellectual Property Law*, Fourth Annual International Computer Forum and Exhibition, Moscow, Russia (June 2-4, 1993)
- *Copyright Bill Passes First Round in Supreme Soviet*, East/West Executive Guide (April 1993)
- *Introduction of Basic Copyright Protection for Computer Programs and Electronic Databases in the Russian Federation*, Copyright World (March 1993)
- Report of ABA Subcommittee on Newly Independent States and Eastern Europe, American Bar Association (March 1993)
- Speech, *Investment Security for Business Activity in Russia and the Former Soviet States*, presented to Women in International Trade, Washington, D.C. (March 18, 1993)
- Russian/English Translation, *Draft Civil Code of the Russian Federation*, ABA Central and Eastern Europe Law Initiative (CEELI) (Feb. 1993)
- Russian/English Translation, *Draft Law of the Russian Federation on Joint Stock Corporations*, ABA Central and Eastern Europe Law Initiative (CEELI) (Feb. 1993)
- *Mexico's New Intellectual Property Laws and the North American Free Trade Agreement*, NAFTA Reporter (Dec. 1991)
- *Confidential Information and the Use of Protective Orders in Trademark Cases*, Intellectual Property Law (1990)
- *Preserving Trademark Rights: is Token Use Sufficient?* 1(2) Intellectual Property Law 147 (1990)
- *Ethical Problems for Physicians Raised by AIDS and HIV Infection: Conflicting Legal Obligations of Confidentiality and Disclosure*, 22 U.C. Davis L. Rev. 557 (1989)
- Co-author, with Frank E. Robbins, *Frivolous Appeals and Inequitable Conduct*, presented to the Intellectual Property Symposia (November 30, 1988)
- "Unemployment Insurance," *Manual for Practicing Attorneys* (D.C. Bar 1987)