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Areas of Practice

Intellectual Property | Trademark Law | Copyright Law | Intellectual Property Litigation | International Law | Customs and International Trade | Customs and Border Protection (CBP) Intellectual Property Remedies

Mr. McDonald specializes in trademark and copyright law, including trademark registration and clearance opinions, investigations and enforcement litigation. He defended the American Bar Association in the only suit for trademark infringement ever brought against the ABA, No. 07-1861 (D.D.C. 2008), prosecuted the only successful trademark opposition based on fraud at the USPTO in six-years, 112 USPQ2d 1361 (TTAB 2014), and entered appearances on behalf of a foreign government in two trademark infringement cases at the U.S. Court of Appeals for the Second Circuit, 726 F.3d 62 (2d Cir. 2013), and 809 F.3d 737 (2d Cir. 2016). In 2021 he led a litigation team that brought down 81 “copycat” websites spanning an array of top-level domains in multiple jurisdictions, No. 1:21-cv-00612-LMB-MSN (E.D.Va.). He is recognized on the World Trademark Review WTR 1000 List of the World’s Leading Trademark Professionals of 2022. He has also represented innovative drug developers in the negotiation of licensing agreements, and in 2018 produced a series of advocacy papers for a pharmaceutical association in connection with the compulsory licensing of pharmaceutical patents.

Prior to specializing in intellectual property, Mr. McDonald litigated in numerous federal courts, serving as a federal appellate litigator at the U.S. Department of Labor, and before that with a boutique litigation firm specializing in natural resources, energy regulation, and administrative law. In law school he interned in the Trial Unit of the Enforcement Division at the U.S. Securities and Exchange Commission and clerked at the U.S. Department of Energy.

Mr. McDonald 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).

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Experience

- *Bote LLC v. BOTEBOARD.COM and John Does 1-10 et al.*, No. 1:21-cv-00612-LMB-MSN (E.D.Va.), counsel for plaintiff in successful action against phishing attack by fictitious anonymous counterfeiters, resulting in unmasking of John Doe defendants and take-down of 81 “copycat” websites spanning an array of top level domains that were unamenable to action in a single jurisdiction.
- *United States v. The Brinson Co.*, Criminal No. 14-035 (E.D.La.), counsel for Daimler AG in federal prosecution against criminal defendants for counterfeiting of Mercedes-Benz automotive diagnostic and repair software involving victim impact statement and successful recovery following petition for remission of forfeited assets.
- *Nat’l Grange v. California State Grange*, 15-17179, 15-17274 (9th Cir.) and related actions in the U.S. District Court for the Eastern District of California, Nos. 2:14-cv-00676 and 2:16-cv-00201, counsel for national fraternal organization in trademark infringement and false advertising action against former state chapter.
- *Federal Treasury Enterprise v. Spirits International B.V.*, 726 F.3d 62 (2d Cir. 2013) and 809 F.3d 737 (2d Cir. 2016), represented foreign government as *amicus curiae* in Stolichnaya vodka trademark litigation.
- *AESP, Inc. v. Signamax, LLC*, 29 F. Supp. 3d (E.D.Va. 2014), and related TTAB proceedings, 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 opposer in first successful fraud action at TTAB case since *In re Bose Corp.*, 580 F.3d 1240 (Fed. Cir. 2009)).
- *Transamerica Corp. v. Moniker Online Services LLC*, 672 F. Supp. 2d 1353 (S.D.Fla. 2009), counsel for plaintiff in case of first impression sustaining action for direct service mark counterfeiting against domain name registrar and registration service providers.
- *Collen IP v. American Bar Association*, 07-1861 (ESH) (D.D.C. 2008), counsel for American Bar Association in successful defense of trademark infringement suit.
- *Bank Soyuz v. Office of Foreign Assets Control*, Case No. 1:05CV01073 (D.D.C.), counsel for foreign bank in successful action against U.S. Treasury Dept. and Office of Foreign Assets Control (OFAC) forcing release of frozen assets.

Publications

- *How Targeting Establishes Jurisdiction in Trademark Usage on the Internet*, International Trademark Association Newsletter, July 6, 2022, <https://www.inta.org/report-how-targeting-establishes-jurisdiction-in-trademark-usage-on-the-internet>

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- Continuing Legal Education Seminar, *Targeting of U.S. Trademarks and Copyrights by Foreign Defendants as Grounds for Personal Jurisdiction After Walden v. Fiore (U.S. 2014)*, American Bar Association Intellectual Property Law Section, May 10, 2022, https://sgrlaw.com/wp-content/uploads/2022/05/Updated-ABA-Webinar-Powerpoint_36918760v1.pdf
- *New USPTO Rules Introduce Significant Changes in US Trademark Practice*, 17(2) Journal of Intellectual Property Law & Practice, Oxford University Press (2022), <https://academic.oup.com/jiplp/advance-article/doi/10.1093/jiplp/jpab166/6523030?questAccessKey=e6c75c9a-31dc-4038-a5c6-957216ad665d>
- *Enforcement of Intellectual Property Rights*, 28 Calif. Int'l. L. J. 9 (2020), <https://www.sgrlaw.com/wp-content/uploads/2020/10/California-International-Law-Journal-Article1.pdf>
- *U.S. Supreme Court Holds Willfulness Unnecessary for Award of Profits in Trademark Infringement Case*, 15(7) Journal of Intellectual Property Law & Practice, Oxford University Press (2020), <https://academic.oup.com/jiplp/advance-article/doi/10.1093/jiplp/jpaa081/5849540?questAccessKey=4454df96-b9e2-4134-9b7d-de299afc9305>
- *Compulsory Licensing of Pharmaceutical Patents in the Russian Federation Threatens Foreign and Domestic Drug Developers* 46 AIPLA Quarterly Journal 1 (2018), https://www.sgrlaw.com/wp-content/uploads/2018/05/McDonald-Bruce_Compulsory-Licensing-in-the-Russian-Federation-461-AIPLA-QJ-V3-Winter-2018.pdf, parallel Russian text at https://www.sgrlaw.com/wp-content/uploads/2018/05/McDonald-Bruce_Compulsory-Licensing-Article-Russian-Text.pdf
- *Setbacks in Regulatory Data Protection Confront Innovative Drug Developers in the Russian Federation*, 51 Int'l Law. 171 (2018), www.americanbar.org/content/dam/aba/administrative/international_law/til_51-2_cpy.pdf; parallel Russian text at www.sgrlaw.com/wp-content/uploads/2018/05/McDonald-Bruce_Regulatory-Data-Protection-Article-Russian-Text.pdf
- Co-author, *International Intellectual Property Law*, 49 Year in Rev. (ABA) 195 (2015)
- *Remedies Against Fictitious and Anonymous Service Mark Counterfeiting*, 7(1) Landslide 47 (2014), https://www.americanbar.org/groups/intellectual_property_law/publications/landslide/2014-15/september-october/remedies-against-fictitious-anonymous-service-mark-counterfeiting
- Co-author, *International Intellectual Property Law*, 48 Year in Rev. (ABA) 213 (2014) *Intellectual Property Procedure in U.S. Courts and Administrative Tribunals Under the New U.S. Patent Act* (in Russian), Journal of the Intellectual Property Court of the Russian Federation (2013), https://ipcmagazine.ru/jurnal/JSIP_01_2013.pdf
- Co-Author, *International Intellectual Property Law: Year in Review*, 47 Int. Law. 213 (Spring 2013)
- Co-Author, *Privacy, Electronic Commerce and Data Security, 2012 Year in Rev.*, 47 Int. Law. 99 (2013)
- Co-Author, *International Intellectual Property Law: 2011 Year in Review*, 46 Int. Law. 215 (Spring 2012)

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- *Why Trademark Owners Must Lead the Fight for Accountability in E-Commerce*, World Trademark Review (Aug./Sept. 2011), https://www.bipc.com/assets/PDFs/Insights/Article-Intellectual_Property_Protect_Your_Marks_From_Adult_Websites-The_State_of_Internet_Governance-20110629.pdf
- Co-Author, *Intellectual Property Law: Year in Review*, 45 Int'l Law. 205 (2011)
- Co-Author, *Intellectual Property Law: Year in Review*, 44 Int'l Law. 245 (2010)
- Co-Author, *Intellectual Property Law: Year in Review*, 43 Int. Law. 549 (2009)
- Lead Author, *Substituted Service of Process by Electronic Mail: Achieving Notice on Fictitious Owners of Commercial Websites for Access to Judicial Remedies*, Report of International Trademark Association (INTA), November 11, 2009, <https://silo.tips/download/report-substituted-service-of-process-by-electronic-mail-the-whois-subcommittee>
- *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)
- *Sites in Shadow: Typosquatters on the Web Don't Deserve the Mask of Anonymity*, Legal Times (June 26, 2006),
- *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)
- *International Intellectual Property Rights, 2000 Year-in-Review*, 35 Int'l Law. 465 (2001)
- *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),
https://lawreview.law.ucdavis.edu/issues/22/2/articles/DavisVol22No2_McDonald.pdf
- "Unemployment Insurance," in *Manual for Practicing Attorneys* (D.C. Bar 1987)
- Click [here](#) for a full list of Mr. McDonald's publications and appearances.

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Admissions

District of Columbia

U.S. District Court for the District of Columbia

Memberships

American Bar Association Section of International Law:

- Chair, Vice-Chair, Co-Chair and Senior Advisor, International Intellectual Property Rights Committee (1999 – present)
- Vice-Chair and 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 (current)
- Outstanding Volunteer of the Year Award (2007-2008)
- Member, INTA Internet Committee, Whois Subcommittee (2009-2015)
- Leader, INTA Task Force on Translation and Transliteration of Whois Contact Data (2014-2015)
- Leader, INTA Task Force on ICANN Procedures for Conflicts Between WHOIS and National Privacy Laws (2014-2015)
- 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)
- Rotary Club of Arlington, Virginia (member, 1986 – 2009, president, 2005)
- Cosmos Club, Washington, D.C. (2009-present)

Recognitions

- World Trademark Review 1000 (WTR 1000) - List of World's Leading Trademark Professionals (District of Columbia)