



## **Scott D. Woldow**

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### **Areas of Practice**

Intellectual Property | Trademark Law | Intellectual Property Litigation | International Law

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Scott Woldow is a Partner in the Intellectual Property Practice, leads the Trademark Practice Group, and is Managing Partner of the Washington, D.C. office of Smith, Gambrell & Russell, LLP.

Mr. Woldow specializes in counseling clients with regard to intellectual property matters, prosecuting applications to register trademarks and service marks worldwide, maintenance of existing trademark and service mark registrations worldwide, trademark clearance opinions, advice concerning infringement, opposition, and cancellation issues, representation of clients before the Trademark Trial and Appeal Board, consent agreements, settlement agreements, and intellectual property litigation. Before adverse and costly litigation actions, Mr. Woldow takes a proactive role in settlement negotiations.

As part of the Firm's top-ranked trademark team, Mr. Woldow helps clients develop branding strategies and acquire and enforce U.S. and international rights in trademarks. Mr. Woldow has prosecuted over 2,000 trademark applications before the United States Patent and Trademark Office and over 500 trademark oppositions matters before the U.S. Trademark Trial and Appeal Board (TTAB).

Mr. Woldow is a sought-after speaker on trademark issues worldwide. He presented Key Legislative Developments at the INTA Leadership Meeting (May 2021); Presented cannabis and CBD issues before the USPTO Examining Attorney workforce (June 2021); and presented key aspects of the U.S. Trademark Modernization Act to senior leadership of the USPTO and leading Academics (March 2021).

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## Experience

- Developed, implemented, and managed global trademark prosecution, maintenance, and enforcement program for several Fortune 1000 companies, including major chemical, healthcare, pharmaceutical, and software companies.
- Representation of numerous Fortune 1000 companies in brand protection disputes, including proceedings before the Trademark Trial and Appeal Board.
- Developed, implemented, and managed an online enforcement program for a leading government contract provider.
- Representation of client in negotiating a worldwide purchase of a blocking portfolio of registrations from a pharmaceutical competitor.
- Representation of client in negotiating the purchase of a cosmetic trademark blocking a Swiss company from entering into the United States under its trade name.
- Representation of client in its successful opposition of the United States portion of a worldwide drilling industry conflict and the negotiation of a global settlement of a pharmaceutical trade name conflict.

### *Ex Parte Appeals:*

- Representation of Neuvo Laredo Cantina in a successful appeal of a Geographic Descriptiveness Refusal.
- Representation of Overhead Door Corporation in a successful appeal of a Descriptiveness Refusal.
- Representation of Abkit, Inc. in a successful appeal of a Likelihood of Confusion Refusal.

Prior to joining the Firm, Mr. Woldow was a Trademark Examining Attorney for the United States Patent and Trademark Office, with concentrations in the chemical, pharmaceutical, and medical device fields. Mr. Woldow is a member of the District of Columbia Bar.

Mr. Woldow earned his B.A. degree, with honors in Philosophy in 1993 from Hofstra University, where he also earned Minors in Psychology and History. He earned his J.D. degree in 1997 from The American University, Washington College of Law. During law school, Mr. Woldow was a member of Phi Alpha Delta, and he was a trial practice participant. Mr. Woldow also earned a Master's in Business Administration from The American University in 1999.

## Admissions

District of Columbia

Maryland (inactive)

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## Memberships

International Trademark Association – Chair of the Government Officials Education and Training Committee (2018 – 2019)  
Chair of the Trademark Office Practice Committee – United States Patent and Trademark Office Subcommittee (2020 – Present)

## Recognitions

World Trademark Review 1000 (WTR 1000) - List of World's Leading Trademark Professionals (District of Columbia), (2021-2023)  
Chambers USA – Intellectual Property: Trademark, Copyright & Trade Secrets (District of Columbia) (2016 – 2017, 2021-2023)  
WTR 1000 – Ranked in the United States: D.C. Metro Area (2022)  
Super Lawyers (2016-2019)

## Publications

[INTA Insights | Small & Medium-Sized Enterprises "Engaging SMEs on the Importance of Registering Their Trademarks and Protecting Their Brands,"](#) *INTATV1*, April 6, 2023.

[INTA Insights | Jenny Simmons and Scott Woldow on USPTO Rule Changes,](#) *INTATV1*, October 27, 2022.

United States Trademark Law Developments, USPTO Virtual Seminar, [U.S.-China 2022 Developments in Trademark Law and Practice Perspectives](#), September 8, 2022.

[USPTO Implements Trademark Modernization Act,](#) *INTA News*, January 2022.

SGR Technology Blog: [Metaverse: The Next Commercial Frontier](#), November 12, 2021.

[United States: Attorney Recognition Rule Changes,](#) *INTA Bulletin*, Vol. 76 Issue 36, September 15, 2021.

SGR Client Alert: [Trademark and Copyright Implications of the Consolidated Appropriations Act, 2021](#), March 8, 2021.

[UNITED STATES: USPTO Continues to Tackle Increased Fraudulent Filings,](#) *INTA News*, November 10, 2021.

[Training Explores Cannabis Industry and Trademarks,](#) *INTA News*, June 16, 2021.

Key Legislative Developments: A Year in Review, INTA Presentation, 2021 Leadership Meeting, May 7, 2021.

[INTA Webcast Offers Insight into New U.S. Trademark Act, Changes in USPTO Practice,](#) *INTA Bulletin*, March 17, 2021.

[The U.S. Trademark Modernization Act of 2020: What Every Trademark Practitioner Needs to Know,](#) *INTA Presentation*, March 3, 2021.

## Continued

[INTA Meets with USPTO Officials on New Email Rule](#), *INTA Bulletin*, May 1, 2020.

[INTA Collaborates with the USPTO on Industry Training Focused on Cheese Industry](#), *INTA Bulletin*, July 14, 2019.

[Trademark Scams Protect Your Brand and Your Wallet](#), November 6, 2018.

Trademark Filing Strategies for Foreign Applicants filing in the United States, INTA Presentation, INTA Annual Meeting, Seattle, Washington, May 22, 2018.

[INTA Collaborates with the USPTO on an Industry Training Focused on Coffee Industry](#), *INTA Bulletin*, December 15, 2017.

INTA Hosts USPTO Dialogue ["View from the Outside"](#) *INTA Bulletin*, November 1, 2017.

SGR Intellectual Property Blog: [Industry Training with USPTO Highlights Trademark Challenges for Fashion](#), September 14, 2017.

[Two-Hundred View INTA-USPTO Industry Training on Trademarks in the Wine Industry](#), INTA Presentation, January 15, 2017.

[United States Trademark Application Identification of Goods and Services Navigating the Issues and Providing Solutions to Maintain a Broad Description](#), INTA Presentation, May 24, 2016.

[The Importance of Trademark Protection primarily for Startup Companies and New Businesses](#), Podcast, March 29, 2016.

Hot Topics in Trademark Prosecution – "Post Registration Issues," on behalf of the International Trademark Association before Government Officials of the USPTO, November 4, 2015.

Trademark presentation to the Amazon "Zonsquad – Amazon Private Seller Organization," "Make Your Mark: Brand Recognition, Goodwill and Your Company's Future," Gaylord National Hotel and Convention Center, National Harbour, October 3, 2015.

SGR Client Alert: [Trademark Tips for the New Year](#), January 8, 2015.

SGR IP Webinar: [Avoiding the Pitfalls: Defending Against Trademark Infringement](#), April 24, 2014.

INTA Responds to USPTO Request for Comments on Goods/Services ID Amendments Due to Technology Evolution, *INTA Bulletin*, December 15, 2013.

SGR Client Alert: [Intellectual Property Invoice Scams](#), July 15, 2013.

[Trademark Owners: Take Caution](#), *Trust the Leaders, Issue 34, Summer 2013*, July 9, 2013.

SGR Client Alert: [ICANN Trademark Clearinghouse Open for Business](#), April 3, 2013.

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USPTO Changes Requirements for Specimens and Post-Registration Filings, *INTA Bulletin*, June 15, 2012.

World Intellectual Property Organization in cooperation with the United States Patent and Trademark Office, Summer School on Intellectual Property, "Geographical Indications," Alexandria, Virginia, August 2, 2011.

United States Patent and Trademark Office Electronic Filing Focus Group and Panel Discussion, Alexandria, Virginia, June 23, 2011.

USPTO Data Visualization Center Dashboard, *INTA Bulletin*, June 15, 2011.

Introduction to Intellectual Property Patents, Trademarks, Copyrights and Litigation, Frankfurt, Germany, March 14, 2009.

The Importance of Trademark and Patent Protection in the United States, Intellectual Property Panel Discussion, Wiesbaden, Germany, March 12, 2008.

United States Patent and Trademark Office E-Commerce and Electronic Filing Panel Discussion, Atlanta, Georgia, October, 2001.