



## JENNIFER A. VAN KIRK

Partner

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Phoenix

Jennifer Van Kirk counsels clients on a wide variety of intellectual property matters, including all aspects of trademark and brand protection: trademark clearance, prosecution, licensing, portfolio management, and litigation guidance. Her experience includes traditional marks as well as three-dimensional marks, motion marks, service trade dress, and packaging trade dress. She also assists clients with identifying, protecting, and licensing copyrights and rights of publicity for use in products and advertising and protecting and licensing clients' copyrights and rights of publicity.

### Trademark Prosecution and Brand Protection

With a network of trademark agents in nearly every country, Jennifer has particular experience helping clients secure and protect trademark rights around the world. She assists in securing worldwide portfolios for new brands and streamlining portfolios for long-established brands. Additionally, her international trademark experience includes advising clients on what global registrations to pursue, filing strategies to maximize coverage, what form the mark should take, cost-containment options, and which trademarks to secure.

### Copyrights and Rights of Publicity

Jennifer has extensive multimedia clearance experience, which includes tracing the chain of title (including probate analyses) to works of art, photographs, and rights of publicity and then securing licenses to use those third party rights on products and in advertising. She helps clients protect their copyrights through formal

### Practices

- Intellectual Property
- Copyright
- Trademark
- Intellectual Property Litigation
- Sweepstakes and Promotions
- Licensing and Transactions

### Industries

- Sports, Entertainment, and Recreation
- Indian Tribal Nations
- Manufacturing, Machinery, and Equipment
- Gaming
- Educational and Research Institutions
- Hotels and Resorts
- Mining and Manufacturing
- Outdoor Recreation
- Restaurants
- Restaurants, Retail, and Hospitality
- Sports

registrations, licensing agreements, and enforcement actions. She has negotiated licenses between her clients and major motion picture studios, merchandising firms, and rights organizations, including BMI, MPLC, and the CCC. When necessary, she represents clients whose copyrights have been infringed by third parties.

## Trademark Enforcement

On the trademark enforcement side, Jennifer has experience managing the policing programs of several prominent clients, including one of the world's top spas, a federal government agency, a multibillion-dollar tool manufacturer, the leading e-cigarette company, and an international bakery and restaurant franchise with over 200 stores globally.

Jennifer has also coordinated anti-counterfeiting programs in the Far East and has extensive experience litigating before the Trademark Trial and Appeal Board. When necessary, she defends her clients against infringement allegations made by other companies.

## Internet IP

Jennifer regularly counsels clients on Internet-related intellectual property issues. She has considerable experience with domain name disputes, having represented clients in dozens of successful arbitration proceedings under the Uniform Domain Dispute Resolution Policy (UDRP). She also counsels clients about recording with ICANN's Trademark Clearinghouse and other rights protection mechanisms.

## Industry Recognition

Jennifer is frequently recognized by top legal organizations and publications, including the International Bar Association's *Who's Who Legal – Trademarks*, "AV/Preeminent Attorney" rating from Martindale-Hubbell, *The Best Lawyers in America*® in the categories of copyright and trademark law, and "IP Stars" by *Managing IP* magazine, which described her as "a highly regarded trademark lawyer, focused on counseling clients in a host of matters related to brand protection and licensing."

Additionally, Jennifer and her colleagues are honored to be continually recognized by *World Trademark Review* "WTR 1000 - The World's Leading Trademark Professional Ranking":

Few have Van Kirk's exceptional facility for global brand protection; attentive to the needs of clients and in tune with market developments, she deploys deep industry insight to strengthen portfolios and enforce them robustly when necessary. "Jennifer provides an exemplary service and representation, being a responsive, thorough, and accurate lawyer. When there are time-sensitive matters to be dealt with, she can be counted on."

"Jennifer puts clients' commercial considerations first and is brilliant at managing overseas firms and giving global advice that is consistent."

“The practitioners at Lewis Roca are exceptional – with outstanding trademark knowledge. They really take ownership of matters and provide rock-solid support in a clear, organized way. It’s always very easy communicating with them.” Jennifer Van Kirk is one of these “top-notch” individuals. “She has the contacts and experience needed to effectively manage clients’ matters globally, giving them a single point of contact for everything. Extremely knowledgeable about all their businesses, she prioritises things appropriately and gets things off her desk efficiently.”

## Education

- J.D., magna cum laude, University of Illinois College of Law, 1996
- B.A., cum laude, University of Illinois, Phi Beta Kappa, 1993

## Bar Admissions

- Arizona, 1999

## Court Admissions

- U.S. Court of Appeals, Seventh Circuit
- U.S. District Court, District of Arizona
- U.S. District Court, Northern District of Illinois
- U.S. District Court, Central District of Illinois
- U.S. District Court, District of Colorado

## Community

- Arizona State Bar Committee for State Trademark Law Reform, Former Co-chair
- Childsplay Inc., Board of Trustees Member
- International Trademark Association, Former Subcommittee Chair for the Bulletin

## Representative Matters

- Represented the U.S. Postal Service in *United States Postal Service v. Lost Key Rewards, Inc.*, wherein the Trademark Trial and Appeal Board ruled in favor of the client’s opposition to the Lost Key mark on the grounds that there was a likelihood of confusion and a false association with an institution.
- Co-authored the motion for summary judgment in *Zipee v. United States Postal Service*, wherein the court ruled that “Postal Service” is a protectable trademark and the unauthorized registration of postal-service.com constituted infringement and cybersquatting.

- Secured international trademark portfolio for a leading e-cigarette company by filing trademark applications in 100+ countries.
- Created and implemented an international trademark enforcement and policing program for the spa ranked #1 in the world 11 times by *Conde Nast Traveler*.
- Coordinated anti-counterfeiting efforts for an electronics manufacturer.
- Drafted and assisted in the implementation of intellectual property policies for a software company.

## Honors & Recognitions

- Southwest Super Lawyers, Intellectual Property, 2023
- Top Lawyers, *Phoenix Magazine*, 2022
- The Best Lawyers in America, Woodward/White, Aiken, S.C., Copyright and Trademark Law, 2013-2023
- The Best Lawyers in America - Lawyer of the Year, Copyright Law, 2017, Trademark Law, 2022
- World Trademark Review, WTR 1000, The World's Leading Trademark Professionals, 2018-2023
- Managing Intellectual Property, IP Star (Arizona), Trademark, 2018-2022
- *AZ Business Magazine*, AZ Business Leaders, Intellectual Property, 2019
- *AZ Business Magazine*, Top 100 Lawyers in Arizona, 2018
- 2014 IP Handbook, IP Star, Managing Intellectual Property, 2014
- *AZ Business Magazine*, Top Lawyers, Intellectual Property Law and Information Technology Law, 2010

## News

- Lewis Roca Lawyers Recognized as 2023 Southwest Super Lawyers® and Southwest Rising Stars® Honors & Recognitions | 04/6/2023
- Lewis Roca Lawyers Recognized as Leading Trademark Professionals in 2023 *World Trademark Review (WTR) 1000* Directory Honors & Recognitions | 02/21/2023
- Lewis Roca Lawyers Recognized as *The Best Lawyers in America*© 2023 Honors & Recognitions | 08/18/2022
- Lewis Roca Partners Recognized as IP Stars 2022 Honors & Recognitions | 06/9/2022
- Lewis Roca Lawyers Named in 2022 World Trademark Review (WTR) 1000 Directory Honors & Recognitions | 03/3/2022
- Lewis Roca Lawyers Named to 2022 *Best Lawyers* List Honors & Recognitions | 08/19/2021

- Lewis Roca Lawyers Recognized as IP STARS 2021  
Honors & Recognitions | 06/17/2021
- Lewis Roca Lawyers Named in 2021 *WTR 1000* Directory  
Press Release | 02/17/2021
- Lewis Roca Lawyers Recognized as The Best Lawyers in America© 2021  
Press Release | 08/20/2020
- Two Lewis Roca Lawyers Named IP STARS 2020  
Honors & Recognitions | 06/18/2020
- Lewis Roca Rothgerber Christie Recognized in 2020 *WTR 1000* Directory  
Honors & Recognitions | 02/13/2020
- Lewis Roca Lawyers Recognized as The Best Lawyers in America© 2020  
Press Release | 08/15/2019
- Lewis Roca Rothgerber Christie Lawyers Named IP STARS 2019  
Honors & Recognitions | 05/20/2019
- Lewis Roca Elects New Members of Executive Committee  
Press Release | 04/2/2019
- Lewis Roca Rothgerber Christie Lawyers Recognized by 2019 *WTR 1000* Directory  
Honors & Recognitions | 01/15/2019
- Lewis Roca Lawyers Recognized as The Best Lawyers in America© 2019  
Press Release | 08/15/2018
- Lewis Roca Rothgerber Christie Attorneys Named IP STARS 2018  
Lewis Roca Rothgerber Christie LLP announced five attorneys have been named IP STARS 2018  
Honors & Recognitions | 05/21/2018
- Arizona Top 100 List Includes Charles, Freeman and Van Kirk  
Az Business magazine recognizes Lewis Roca Rothgerber Christie attorneys  
Honors & Recognitions | 03/27/2018
- Four Lewis Roca Rothgerber Christie Attorneys Named to 2018 World Trademark Review's "WTR 1000" Directory  
Directory focuses exclusively on trademark practices and practitioners, identifying the trademark industry's leading practitioners in 72 jurisdictions around the world  
Press Release | 02/23/2018
- Partners Honored as Lawyer of the Year by Best Lawyers  
85 Lewis Roca Rothgerber Christie attorneys in The Best Lawyers in America 2018  
Press Release | 08/15/2017
- Van Kirk Named Leading Trademark Professionals  
Intellectual Property attorneys included in 2017 edition of World Trademark Review 1000  
Honors & Recognitions | 02/1/2017

- Lewis Roca Rothgerber Christie Attorneys Named in ‘Best Lawyers’  
11 partners also honored as ‘Lawyer of the Year’ in The Best Lawyers in America® 2017  
Honors & Recognitions | 08/15/2016

## Publications

- AI for Trademark Lawyers Moving Beyond Search to Expanding Work  
Quoted, *Bloomberg Law - IP Law*, 02/14/2023
- Penn State Case Tests Sports Merchandising’s Legal Foundation  
Quoted, *Bloomberg Law - IP Law* (Reproduced with permission. Published July 20, 2022. Copyright 2022 by The Bureau of National Affairs, Inc. (800-372-1033) <http://www.bloombergingustry.com>), 07/20/2022
- Gibson’s ‘Pyrrhic’ Verdict Leaves Guitar-Shape IP Status Unclear  
Quoted, *Bloomberg Law*, 06/10/2022
- Your Business and the Law  
Quoted, *InBusiness Magazine*, 6/2022
- Hot Intellectual Property Topics and Trends: The IP of Everything Podcast  
Los Angeles Business Journal, 06/23/2021
- Social Media and the Right of Publicity: What Advertisers Need to Know  
Co-Author, *World Trademark Review*, Winter 2021
- New USPTO Rules for Foreign Applicants  
07/19/2019
- Foreign-Domiciled Trademark Applicants and Registrants Required to Retain Local Counsel for U.S. Trademark Matters  
07/19/2019
- Resources for Non-US Trademark Applicants

## Client Alerts

- USPTO Increases Trademark and TTAB Fees for 2021  
12/23/2020
- Trademarks for COVID-19 Products and Services Given Free Expedited Examination by the USPTO  
06/23/2020
- The USPTO Continues to Offer Relief for Businesses Impacted by COVID-19  
05/28/2020
- The USPTO Extends Patent and Trademark Deadlines Due to COVID-19  
04/30/2020

- USPTO Offers Deadline Extensions Due to COVID-19  
*04/1/2020*

## Blog Posts

- The IP of Everything Podcast - Episode 18 - The IP of AI  
*Lewis Roca Blog, 05/4/2023*
- The IP of Everything Podcast - Episode 17 - The IP of the USPTO  
*Lewis Roca Blog, 02/3/2023*
- The IP of Everything Podcast - Episode 16 - The IP of the Metaverse  
*Lewis Roca Blog, 12/19/2022*
- The IP of Everything Podcast - Episode 15 - The IP of Parody  
*Lewis Roca Blog, 09/2/2022*
- The Metaverse - Are You Prepared?  
*Lewis Roca Blog, 06/8/2022*
- The IP of Everything Podcast - Episode 14 - The IP of Geographic Indicators  
*Lewis Roca Blog, 05/19/2022*
- The IP of Everything Podcast - Episode 13 - The IP of BJ Novak  
*Lewis Roca Blog, 02/11/2022*
- The IP of Everything Podcast - Episode 12 - The IP of NCAA Athletes  
*Lewis Roca Blog, 12/10/2021*
- The IP of Everything Podcast - Episode 11 - The IP of Customized Fashion  
*Lewis Roca Blog, 10/15/2021*
- The IP of Everything Podcast - Episode 10 - The IP of NFTs  
*Lewis Roca Blog, 08/6/2021*
- The IP of Everything Podcast - Episode 9 - The IP of Take-Out  
*Lewis Roca Blog, 05/28/2021*
- The IP of Everything Podcast - Episode 8 - The IP of "Where Are They Now?"  
*Lewis Roca Blog, 04/23/2021*
- The IP of Everything Podcast - Episode 7 - The IP of Distance Learning  
*Lewis Roca Blog, 02/25/2021*
- The IP of Everything Podcast - Episode 6 - The IP of Memes  
*Lewis Roca Blog, 01/29/2021*
- USPTO Increases Trademark and TTAB Fees for 2021  
*Lewis Roca Blog, 12/23/2020*

- IP of Everything Podcast - Episode 5 - The IP of Political Campaigns  
*Lewis Roca Blog, 10/26/2020*
- IP of Everything Podcast - Episode 4 - The IP of #!&%!  
*Lewis Roca Blog, 10/2/2020*
- IP of Everything Podcast - Episode 3 - Band Names  
*Lewis Roca Blog, 08/31/2020*
- IP of Everything Podcast - Episode 2 - The IP of Tattoos  
*Lewis Roca Blog, 08/5/2020*
- Supreme Court Finds BOOKING.COM Non-Generic And Capable Of Federal Trademark Registration  
*Lewis Roca Blog, 06/30/2020*
- Trademarks for COVID-19 Products and Services Given Free Expedited Examination by the USPTO  
*Lewis Roca Blog, 06/23/2020*
- Do You Have Your Copyright House in Order?  
*Lewis Roca Blog, 06/22/2020*
- IP of Everything Podcast - Episode 1 - IP of Tiger King  
*Lewis Roca Blog, 06/18/2020*
- The USPTO Continues To Offer Relief For Businesses Impacted By COVID-19  
*Lewis Roca Blog, 05/28/2020*
- The USPTO Extends Patent and Trademark Deadlines Due to COVID-19  
*Lewis Roca Blog, 04/30/2020*
- USPTO Offers Deadline Extensions Due To COVID-19  
*Lewis Roca Blog, 04/1/2020*
- New USPTO Rule Requires Trademark Owner Email Address  
*Lewis Roca Blog, 02/12/2020*
- New USPTO Rules For Foreign Applicants Are In Effect. Are You Covered?  
*Lewis Roca Blog, 02/3/2020*
- Adult-Themed Domain Blocks - Discount Expires December 31, 2019  
*Lewis Roca Blog, 12/6/2019*

## Events

- Co-presenter, "Trademarks and Copyrights in the Time of COVID: How our 'New Normal' has Impacted Enforcement and Compliance Strategies - Sports Edition," Sports Lawyers Association, Webinar, October 1, 2020
- Phoenix: 2017 AIPLA Women in IP Happy Hour  
05/4/2017