

## Intellectual Property

### ATTORNEYS

- Dora M. Peñagaricano  
(Practice Leader)
- Roberto C. Quiñones-Rivera  
(Practice Leader)
- Leslie Y. Flores-Rodríguez
- Lizzie M. Portela-Fernández
- Antonio Escudero-Viera
- María Teresa Szendrey-Ramos
- Isabel Torres-Sastre
- Sonia M. López del Valle

The McConnell Valdés Intellectual Property team is among the most highly respected and accomplished in Puerto Rico. Top-ranked by Chambers and Partners Latin America for “extremely responsive and 100% knowledgeable” counsel, the team is deeply experienced across the IP ambit.

We are often called upon to help draft IP laws, regulations and amendments by government officials. McConnell Valdés was invited to help draft the new Trademarks Act of Puerto Rico and the Consumer Defense Code. When the Department of Consumer Affairs (DACO) Regulation on Misleading Practices and Advertisements was amended, it incorporated a number of firm proposals and amendments. One of our attorneys helped draft the Right of Publicity bill, the Trade Secrets bill, and the Moral Rights bill, signed into law between 2011 and 2012.

Recognizing intellectual property as an invaluable corporate asset, we are dedicated to helping clients select and obtain the best protection for their trademarks, service marks, patents, and copyrights under both United States and Puerto Rico law. In addition, we regularly coordinate the protection and enforcement of our clients’ intellectual property in international jurisdictions, by working closely with qualified attorneys in other countries.

Comprised of lawyers from both the corporate and litigation practices, team members have achieved significant victories for clients facing the full scope of IP challenges, from trade dress and cross-border copyright infringement cases to cases involving the sale of counterfeit items and false advertising claims. Our seasoned litigators have achieved wins for our clients in federal, state and local courts, as well as before the Puerto Rico trademarks, commercial names, and moral rights registration agencies.

We successfully prosecute and vigorously defend our clients’ copyrights and innovations before the Copyright Office and the United States Patent and Trademark Office (USPTO). Our team’s representation also extends to defending clients against claims presented by the Business Software Alliance (BSA), helping clients on an array of related issues by:

- Formulating responses to BSA claims.
- Advising clients on software audits.

- Establishing and crafting corporate software use policies and internal controls to prevent unauthorized software copies.
- Preparing memoranda to employees regarding the unlicensed duplication or use of software.
- Preparing corporate–employee agreements.

A number of our “excellent,” “extremely helpful” and “focused” team members, ranked among Puerto Rico’s Leading Lawyers by *Chambers and Partners Latin America* and selected by their peers for inclusion in *The Best Lawyers in Puerto Rico 2016 and 2017*, are active members of the International Trademark Association (INTA) and participate in many of INTA's regional committees.

### **What We Do**

The McConnell Valdés Intellectual Property Litigation team:

- Assists clients in obtaining trademark, copyright, patent, and service mark protection.
- Assists clients in managing their IP portfolios.
- Drafts sponsorship agreements.
- Drafts trademark license agreements.
- Obtains injunctions against the importation of counterfeit, infringing and gray market products into Puerto Rico.
- Obtains injunctions in false advertising claims.
- Obtains injunctions in right-of-publicity cases.
- Represents clients before federal, state, and local courts and before the USPTO and Copyright Office, as well as Puerto Rico agencies.
- Represents clients in connection with claims presented by the BSA.

### **REPRESENTATIVE CLIENTS & MATTERS**

■

Successful representation of clients such as Tous, Cartier, and Romero Britto, obtaining temporary restraining orders, preliminary and permanent injunctions, and monetary damages for trademark infringement, trademark counterfeit, trade dress infringement, false designation of origin, copyright infringement, and unfair competition.

- Successful representation of record companies, such as Universal and Warner, and artists in copyright infringement actions.
- Representation of a major insurance company in a false and misleading advertisement, false association, unfair competition, and trademark infringement action filed by a competitor.
- Successfully defended client in the first false advertising case decided in the First Circuit.
  - Filed the first case before the federal court of Puerto Rico under the Anti-cybersquatting Consumer Protection Act.
  - Obtained an injunction ordering the withdrawal from the Puerto Rico market of the yellow artificial sweetener product SAME, since its trade dress was a copy of the trade dress of the SPLENDA artificial sweetener product.
  - Successful dismissal of patent infringement suits for lack of personal jurisdiction
  - Successfully defended J. Walter Thompson Company in a breach of license and copyright infringement case filed by Cartagena relating to music use in an advertising campaign
  - Litigation of the first “right-of-publicity” case brought in state court in Puerto Rico in which the Supreme Court of Puerto Rico established the rights of the parties.
  - Representing one of world's leading music companies in a case granting summary judgment as to time-barred copyright claims; rejecting plaintiff's arguments under equitable estoppel doctrine.
  - Representation of renowned artist Romero Britto and his exclusive international licensee in the largest trademark, copyright and civil counterfeiting case filed in the U.S. District Court for Puerto Rico