

Ilaria Maggioni

Counsel

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Clients rely on Ilaria for US and International registration, protection and enforcement of trademarks, copyrights, patents, and the procurement and management of multi-country legal teams in Intellectual Property disputes as well as guidance for due diligence, drafting and negotiation of contracts, licenses, supply and distribution agreements, and other agreements with IP components.

OVERVIEW

Ilaria Maggioni concentrates her practice on the registration, protection and enforcement of intellectual property rights in the U.S. and abroad. She litigates both domestic and international patent, copyright and trademark infringement as well as commercial disparagement and trade libel. Ilaria guides companies through the clearance and registration process of trademarks, logos and other IP rights, including the due diligence review and assessment of acquisitions and transfers of IP portfolios and assets in corporate deals. She represents them through take-downs of infringing and defamatory content and in WIPO (UDRP) proceedings.

Clients rely on Ilaria for the drafting and negotiation of contracts, licenses, supply and distribution agreements, influencer, talent sponsorship and web endorsement agreements and other agreements with IP components.

Ilaria's experience includes the management of multi-country legal teams in patent enforcement and litigation. She began her legal career in Rome, Italy and she has been a practicing New York attorney since 2002. She is experienced in cross-border transactions and brings a global perspective to her intellectual property practice, which spans across industries, including chemical, pharmaceuticals, fashion, manufacturing, food and beverage, software and electronics, mass-consumer products, entertainment and education.

Ilaria is bilingual in Italian and English. She is fluent in Spanish and has working knowledge of French and Portuguese.

PRACTICES

Intellectual Property

BAR AND COURT ADMISSIONS

New York

Italy

U.S. Court of Appeals for the Federal Circuit

U.S. Court of Appeals for the Second Circuit

U.S. District Court for the Eastern District of New York

U.S. District Court for the Southern District of New York

EDUCATION

University of Pennsylvania School of Law, LLM, 1997

University of Pisa, JD, *summa cum laude*, 1996

London School of Economics, Introduction to English Law, 1992

LANGUAGES

Italian

Spanish

MEMBERSHIPS

American Bar Association

International Trademark Association, *The Trademark Reporter* Committee

New York City Bar Association



RECOGNITION AND INVOLVEMENT

Ilaria is a member of the International Trademark Association (INTA), where she has been reconfirmed as a member of the Committee for *The Trademark Reporter* (2023), the organization's law journal. She previously served on *The Trademark Reporter's* Editorial Board and the Features Subcommittee for Policy and Practice of the INTA Bulletin Committee.

Outside of the office, Ilaria is a certified yoga teacher (RYT200). She is also an avid skier and served on the Board of Skilex International, a multinational entity that organizes ski competitions, events and educational programs on the law of mountaineering sports and liability for legal professionals. She loves music, and supports the Jazz community in New York City and abroad.

REPRESENTATIVE MATTERS

Structured and negotiated licensing, co-existence agreements, supply and manufacturing contracts, asset purchase agreements, cross-branding and merchandising deals for clothing and consumer goods, sporting goods and sports operators, industrial design, pharma, computer hardware and software, music production and entertainment companies

Built comprehensive contractual packages for software products' development and launch including: non-disclosures, developer contracts (independent contractor and employee-based); demo-testing and experimental-use agreements; multiuser licenses; skin-wrap licenses; end-user, reseller and distribution contracts; work performed in several different fields including for fantasy sport websites, remote monitoring telemetry systems for chemical water-treatment, instructional music software, monitoring and inventory database software

Represented leading medical practice in the field of hair transplantation in patent litigation involving medical device patent, in US litigation and coordination of related patent litigation in Germany and Canada

Represented major multinational Optical Character Recognition (OCR) software company in patent litigation involving nine software patents in the fields of OCR, Network Architecture and Electronic Archiving; reached settlement just days before *Markman* hearing

Advised major capital investor about re-possessing and pledging of IP and related IP chain-of-title recordation in complex secured transactions

Procured and maintained substantial domestic and International trademark portfolios, arranged and supervised comprehensive multi-country and WIPO Madrid Protocol trademark filing programs, in many industries including for a leading U.S. dermatology pharmaceutical company, a New York-based pharmaceutical company in the oncology sector, and wine and spirits makers and importers with worldwide branded distribution reach

Handled *inter partes* oppositions and cancellations before the U.S. Trademark Trial and Appeal Board and equivalent authorities worldwide; assessed strategy for intervention at critical stages of prosecution or developing disputes, securing positioning for settlement

Performed patent and trademark clearance and IP portfolio assessment, due diligence and strategy for start-ups and mature companies, cooperating closely with internal technical and marketing departments and in-house counsel

Arranged for validation, representation and enforcement of European patents in the telecommunication sector

Advised client on domain name procurement, maintenance and resolution of disputes via UDRP and litigation, including obtaining transfer of domain names from cybersquatters to legitimate trademark owners

Handled trademark, copyright and patent transfers, assignments and secured IP transactions

Counseled client on IP portfolio prosecution

Represented OCR software company in patent action involving five patents on information processing. Negotiated favorable settlement at the pleading stage

Represented, as part of large defense team, online pharmacies against pharmaceutical manufacturer in the leading case on keyword advertising before the U.S. District Court for the Southern District of New York; obtained dismissal of plaintiff's related claims in favor of the online pharmacies

Obtained judgment of invalidity and non-infringement in the U.S. District Court for the Southern District of New York in favor of a Belgian manufacturer of equipment for computer chip inspection. Member of appeal team before the U.S. Court of Appeals for the Federal Circuit, which upheld the judgment of patent invalidity and non-infringement in favor of client

Represented a German pharmaceutical company as local counsel in seven Abbreviated New Drug Application (ANDA) litigations

Represented promotional goods manufacturer in infringement action to enforce design patent against commissioning purchaser and Chinese manufacturer; secured favorable settlement after discovery

Represented patent owner enforcing design patent for fashion accessories against national fashion retailers in the U.S. District Court for the Southern District of New York; obtained settlement at the early pleading stage

Defeated summary judgment motion in favor of client rejecting a trademark "fair use" and First Amendment defenses to trademark infringement on clothing; reached successful settlement just prior to trial

Represented wine store owner in trade dress litigation concerning store layout in the U.S. District Court for the Southern District of New York

Represented clothing manufacturer in copyright infringement actions concerning fabric patterns in the U.S. District Court for the Southern District of New York

Represented eyewear manufacturer in infringement action involving design elements applied to fashion eyeglasses frames. Secured settlement after successfully reopening default judgment

Obtained \$10 million judgment in online trade libel and defamation action in the Caribbean Federation of St. Kitts and Nevis under English Common Law; settled shortly after preliminary court decision concerning prospects of U.S. enforcement of the foreign money judgment in the U.S. District Court for the District of New Jersey

IN THE NEWS

White and Williams Lawyers Help YUV Obtain First Patent for Custom Hair Color Dispenser
9.22.23

PUBLICATIONS

Generative Artificial Intelligence: Calling for a New Legal Front
Client Alert, 1.16.24

Winter COVID-19 Relief Bill: Overview of Key IP and Entertainment Provisions
Intellectual Property Alert, 1.4.21