



## Barry F. Soalt, Partner

Practice Areas      Emerging Growth and Venture Capital  
Health Care  
Intellectual Property  
Licensing and Technology Transactions  
Sports and Active Lifestyle  
Trade Secrets  
Trademarks and Copyrights

Admissions            California

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### Professional Summary

Barry F. Soalt counsels clients on matters pertaining to intellectual property law and counseling, particularly handling domestic and international representation in trademark, copyright and domain name issues. Barry's practice focuses on managing the intellectual property portfolios for numerous companies in the areas of selection, clearance and registration of trademark applications, enforcement of trademark, trade name, trade dress, copyright, trade secret and unfair competition litigation in federal court. He has extensive experience in handling opposition and cancellation proceedings, domain name disputes, effective dispute resolution and has knowledge of the legal and business issues inherent in licensing transactions. Barry is admitted before the Supreme Court of California, all California Courts, and the Southern and Central U.S. District Courts.

### Representative Matters

#### Intellectual Property Counseling

- Establishes intellectual property audits and programs for managing trademark portfolios of many companies in diverse product areas, from clothing to software and from telecommunications to entertainment and digital media arts.

- Manages strategic trademark portfolios for clients, including worldwide trademark monitoring to identify conflicting applications and potential infringement, requiring enforcement action through active network of foreign counsel to provide quick cost-effective action.
- Licenses and subsequent sales of a trademark to a major beverage company.
- Counsels franchisors in obtaining and maintaining portfolios of intellectual property worldwide; drafted and obtained state approvals for Uniform Franchise Offering Circulars (UFOC).
- Performs due diligence and transfer documentation in intellectual property sales and acquisitions, including drafting of assignments and licensing.
- Preparation of numerous agreements for website development, terms of use, access, privacy policies, services, licensing and electronic commerce.
- Negotiates and drafts numerous license agreements regarding the intellectual property rights of both public and private companies. Broad experience in drafting commercial agreements including: Non-Disclosure and Non-Competition Agreements, Independent Contractor and Consultant Agreements, Employee Agreements, Sales Representative Agreements, Distribution Agreements, Dealer Agreements and Exclusive Dealing Agreements.

#### Intellectual Property Litigation

- Represents clients in infringement analysis, trademark litigation in the Federal Courts, and in Oppositions and Cancellations before the Trademark Trial and Appeal Board.
- Represents public company plaintiff in service mark infringement, cyber-piracy and unfair competition action against unlawful use of marks including use of marks as domain names.
- Defends trade dress, trademark and design patent infringement actions against manufacturers in Federal Court.
- Represents clients as plaintiff in software copyright infringement actions in Federal Court.
- Represents clients in seizure action against manufacturers, distributors and retailers selling infringing video games, filed concurrently in multiple districts of multiple states.
- Uses traditional trademark actions, the Federal Anticybersquatting Consumer Protection Act and ICANN proceedings under the Uniform Domain Name Dispute Resolution Policy to enjoin use of and compel the transfer of domain names infringing registered trademarks.



## Community

- American Intellectual Property Law Association
- International Trademark Association
- San Diego County Bar Association
- The San Diego Intellectual Property Law Association
- San Diego Regional Chamber of Commerce

## Education

- JD, Western State College of Law
- BA (Biology and Physical Geography), University at Buffalo, *cum laude*

## Seminars

Most recent speaking engagement:

- "Minimizing Risks of IP Infringement Liability for Creative, Marketing and Advertising Professionals," SDX-San Diego Ad Club, January 2016.

## Publications

Most recent article:

- "[Did You Just Inadvertently Violate Trademark Law?](#)" November 28, 2017.
- Co-author, "[How Businesses Can Recover Serious Damages from Website Copyright Infringers,](#)" September 27, 2016.