



## Lisel M. Ferguson, Partner

Practice Areas	Sports and Active Lifestyle Intellectual Property Litigation, Intellectual Property Trademarks and Copyrights Licensing and Technology Transactions Patent Prosecution and Counseling Privacy and Cybersecurity Environment and Natural Resources Life Sciences Litigation, Corporate and Commercial Food and Beverage
Admissions	California United States Patent and Trademark Office
Languages	German
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### Professional Summary

Lisel M. Ferguson counsels clients on patent, trademark and copyright prosecution worldwide, and intellectual property litigation throughout the United States. She is the Leader of Procopio's [Intellectual Property Litigation Team](#) and co-leader of Procopio's [Sports and Active Lifestyle Practice Group](#), and has been named the Top Attorney in San Diego County in the Sports and Active Lifestyle industry by *San Diego Magazine*.

Lisel's practice focuses on computer hardware and software, sporting goods, apparel, Internet, entertainment, medical devices, agricultural products and services, and consumer goods. She has experience working with Federal Litigation, Trademark Trial and Appeal Board (TTAB) actions, Uniform



Domain-Name Dispute Resolution Policy (UDRP) actions, domain name disputes and Internet law. She is experienced in handling all aspects of intellectual property; in addition to protection and enforcement she has experience with customs, negotiating and drafting licenses and royalty agreements worldwide, with clients from Asia, Mexico, Chile, Australia, Canada, the Netherlands and the United Kingdom.

Lisel is admitted to practice before all the Federal and State Courts in California, the U.S. Court of Appeals, the United States District Court of Colorado, the U.S. District Court of Arizona and the U.S. District Court of Utah, as well as Federal Circuit Court.

Prior to practicing law, Lisel spent over five years working full time in the professional fields of science and biology, managing eco-tourism research projects and marine mammal diving physiology research. She also managed a cognitive science study on children with focal lesions for UCSD, Salk and Children's Hospital. She worked for Scripps Institute of Oceanography, UCSD and for an International Turtle Conservation Group where she assisted with numerous professorial level and Ph.D. research projects in addition to co-authoring scientific journal articles.

## **Representative Matters**

### **Intellectual Property Litigation**

- Resolved a patent infringement action involving nutritional supplements for animal feed.
- Defended a guitar manufacturer in trademark/trade dress case.
- Defended a patent infringement case brought against an ice making and distributing machine maker.
- Prosecuted a trademark infringement case involving a domain name dispute in Federal Court.
- Defended a claim of trade secret misappropriation relating to a web store selling online first aid and survival supplies.
- Represented a Korean manufacturer of die board bending machines in multiple trademark, patent and misappropriation of trade secrets cases.
- Represented a surfboard inventor in a breach of contract case.
- Obtained a judgment against an overseas company through service via the Hague Convention.
- Prosecuted a trademark and copyright infringement case for a beer manufacturer and obtained a very favorable result.



## Intellectual Property Prosecution

- Obtained patents for such products as storm drain filtration systems, horticultural products, surfboards, skateboards, ski equipment, medical and veterinary devices, research equipment and various sporting goods.
- Obtained foreign patents and trademarks in Australia, New Zealand, the European Union, South America, Canada, Korea, China, Africa, Japan, and Hong Kong.
- Represents clients in filing for patents, trademarks, copyrights and negotiating licensing and royalty agreements.
- Represents numerous businesses, including apparel companies, beverage companies, pet product companies, clean tech companies and sporting companies with their intellectual property portfolios.
- Obtains customs records and conducts customs training sessions to protect clients' products worldwide.

## Recognitions

- 2021 Woman Leader in the Law, *American Lawyer Magazine*
- *San Diego Business Journal* Business Women of the Year, 2020 finalist
- 2019 West Coast Top Rated Lawyers, ALM
- San Diego Magazine Top Lawyer, 2019 (Sports & Active Lifestyle)
- *Martindale-Hubbell*® AV Preeminent® Peer Review Rated Lawyer, 2019
- *Martindale-Hubbell*® AV Preeminent Rating
- AmLaw Top Rated Lawyer in Intellectual Property Law, 2018
- "Top Lawyers," *San Diego Magazine*, 2014-present
- *San Diego Super Lawyers*®, 2014-2018 (Intellectual Property)
- "Super Lawyers/Southern California 2014: The Top Women," *Los Angeles Magazine*, September 2014
- "Southern California Super Lawyers," *Super Lawyers Magazine*, Southern California, 2014



## Community

- Greater San Diego Hunter Jumper Association - Member
- Burn Institute - Board Member
- German-American Societies of San Diego - Board member "Assistant Vice President"
- American Bar Association
- California Dressage Society
- San Diego County Bar Association
- The San Diego Intellectual Property Law Association
- United States Dressage Federation
- United States Equestrian Foundation

## Education

- JD, University of San Diego School of Law
- BS (Biology, minors Psychology and Photography), University of California, San Diego

## News Coverage

- "San Diego Business Woman of the Year 2020 Awards Finalists," *San Diego Business Journal*, November 16, 2020.
- Evans, Jeremy. "Time Out: How we Represent and Play in the Big Leagues," *San Diego Lawyer*, July 1, 2013.

## Seminars

- Co-Presenter: "How To Work With Outside Counsel To Keep IP Litigation Budgets In Check," Webinar, November 23, 2020. [Video recording](#) and [PowerPoint](#).
- Panelist. "Protecting your Online Business and Assets in our New Environment of COVID-19," San Diego & Imperial Small Business Development Center (SBDC) Network, May 6, 2020.
- Panelist: "Webinar: Protecting Your Online Business and Assets," April 15, 2020.

- “Trademark Pre-litigation Practice and Strategies,” USD School of Law Guest Lecture, San Diego, CA, January 15, 2019.
- Moderator: “Executive Women in Life Sciences: Managing Corporate Change & Building Winning Teams,” Women in Bio - Southern California, San Diego, CA, October 16, 2018.
- Panelist. “Intellectual Property: Protecting Yours and Using Others,” San Diego Press Club Event, San Diego, CA, September 12, 2018.
- Co-presenter. “Why, When and How to Develop an IP Strategy Appropriate for Your Startup,” SDSI Springboard Mentor Forum, San Diego, CA, April 18, 2018.
- Professor. “Art 135” Business Practices, San Diego City College.
- Co-presenter. “Fortify Your Brand: Protecting Your Online Presence and Social Media Identity,” SIA Snow Show, Denver, CO, January 26, 2017.
- Co-presenter. “Developing an International Intellectual Property Portfolio”, Procopio International Business Summit, San Diego, CA, March 17, 2016.
- Co-presenter. “Avoid a BIFF; Protect Your IP! The Basics You’ll Need from A to Z,” SIA Snow Show, Denver, CO, January 27, 2016.
- Co-presenter. “Why, When and How to Develop an IP Strategy Appropriate for Your Business,” SIA Snow Show, Denver, CO, January 31, 2015.
- “Protecting Your Intellectual Property in the US and Overseas,” UCSD Rady School of Management Global Business Strategy, San Diego, CA, August 2013-2015.
- “Licensing and Bankruptcy,” LES San Diego, La Jolla, CA, May 21, 2014.
- “The Benefits of Mistakes,” SDSI Chalk Talk, Carlsbad, CA, April 22, 2014.
- “Licensing Executives Society: Increase the Value of your IP through Licensing,” LES San Diego, La Jolla, CA, March 11, 2014.
- “Protect Your Profits: What You Need to Know to Protect Against IP Piracy,” CONNECT and SDSI Public Policy Forum, Carlsbad, CA, June 26, 2013.
- “IP & Employment Matters - Common, Costly Mistakes for Start-up Entrepreneurs to Avoid,” Procopio and SV Forum, Palo Alto, CA, May 22, 2012.



## Publications

- Co-author. "Steps To Take With Outside Counsel to Keep IP Litigation Budgets in Check," *LA Daily Journal*, February 3, 2021.
- "[Ensure Your Trademarks and Brands are Adequately Protected in the UK](#)," January 14, 2021.
- "[Pirates Live On in the Form of Sovereign States](#)," San Diego Lawyer Magazine, June 22, 2020.
- Co-author. "[Trademark Owners Secure Key Victory In U.S. Supreme Court](#)," May 7, 2020.
- Co-author. "[USPTO Targets Fraud Through Trademark Rule Changes](#)," April 27, 2020.
- "[Protecting Your Online Business and Assets in the Age of COVID-19](#)," April 6, 2020.
- "[U.K. Promises to Protect All Existing European Union Trademarks Post-Brexit](#)," July 30, 2018.