



## Scott M. Oslick

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Scott is an intellectual property lawyer with a focus on trademarks and copyrights. He advises clients on protecting their intellectual property rights and devises strategies for developing clients' intellectual property portfolios. Scott has experience in all areas of trademark prosecution, including trademark clearance and availability opinions, preparing and prosecuting trademark applications and handling appeals before the Trademark Trial and Appeal Board. Scott represents clients in ex-parte appeals, infringement matters, cancellation proceedings and third-party oppositions before the Trademark Trial and Appeal Board. He also has experience in representing clients in Federal Court.

Scott has handled trademark, copyright and domain name matters for clients in a wide variety of industries, including consumer electronics, e-commerce, information technology, food and beverages, clothing, sports and general business. He handles matters for Fortune 500 companies, small businesses and individual entrepreneurs, as well as international clients located in the Canada, the United Kingdom, Europe, Australia, Brazil and Israel.

Prior to joining Merchant & Gould in 2006, Scott served as an Examining Attorney for the United States Patent & Trademark Office for seven years. During that time, Scott examined over 9000 trademark applications, including applications filed electronically and under the Madrid Protocol. Scott represented the Trademark Office in numerous ex parte appeals and oral arguments before the Trademark Trial and Appeal Board. As a result of his experience at the Trademark Office, Scott is incredibly familiar with the trademark prosecution process. Scott consistently utilizes this knowledge to the benefit of his clients.

Atlanta

Denver

Knoxville

Madison

Minneapolis

New York

Seattle

Washington DC

# Scott M. Oslick (Continued)

## Education

University of Maryland, College Park, 1994  
American University, Washington College of Law, 1997

## Bar Admissions

Maryland, 1997

## Professional Affiliations

American Bar Association  
ABA Forum on the Entertainment and Sports Industries  
International Trademark Association (INTA)  
Minnesota Intellectual Property Association

## Speaking Engagements

GETTING INTO THE GAZETTE: Tips For Responding To Refusals, Requests and Requirements, The 2009 Intellectual Property Institute, Faculty, September 24, 2009.

Inside the USPTO'S Closet, September 22, 2009.

It's In the Way That You Use It (Specimen Basics and Avoiding Functionality Refusals), January 26, 2009.

Specimens of Use and Trademark Application Filing Bases: An Overview, May 9, 2008

Atlanta

An Overview of Trademark Prosecution from Filing to Registration, January 8, 2008

Behind the Scenes at the USPTO - The Examiner's Perspective Webinar, September 26 - 27, 2007

Denver

The Basics of Trademark Prosecution, July 18, 2007

## Articles

Knoxville

What's Needed to Own a Business Method?, by Tony Zeuli, Scott Oslick and Josh Graham, Bench & Bar November, 2009.

Madison

The Bose Wave Mark: Honest Mistakes No Longer Considered Fraud in U.S., by Christopher J. Schulte and Scott M. Oslick, 369 ITMA Review 29, October 2009.

## Recent Decisions and Notable Cases

Minneapolis

Fireman's Fund Insurance Company v. Forsyte Corporation, Claim No. FA0708001055246 (NAF, September 17, 2007) - Successfully argued for the transfer of the domain name firemansfundinsurance.com to Fireman's Fund Insurance Company.

New York

The Debt Doctors, LLC v. Mountain Marketing Group, LLC, Cancellation No. 92047140 (T.T.A.B. August 1, 2007) - Successfully prosecuted trademark cancellation action on behalf of Petitioner, The Debt Doctors, LLC, involving the mark 1-800-DEBT DOC.

Seattle

In re Gags and Games, Inc. (TTAB 2005) - Successfully defended the US Patent and Trademark Office in an appeal involving a likelihood of confusion refusal between the marks HALLOWEEN USA and HALLOWEEN U.S.A. and Design. The Board agreed that marks registered on the Supplemental Register are entitled to protection under Section 2(d) of the Lanham Act.

Washington DC

## Scott M. Oslick (Continued)

In re King Chapman & Broussard Consulting Group, Inc. (TTAB 2004) - Successfully defended the US Patent and Trademark Office in an appeal involving a descriptiveness refusal of the mark CO-MANAGEMENT intended for use in connection with management consulting to provide organization change consulting and team facilitation and education consulting to provide breakthrough education.

In re Pucci Corporation (TTAB 2004) - Successfully defended the US Patent and Trademark Office in an appeal involving a likelihood of confusion refusal between the marks PUCCI, intended for use in connection with custom tailored apparel and accessories therefore, and EMILIO PUCCI, for children's clothing and ladies' tailored apparel.

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