



A NEWSLETTER FROM COLEMAN & HOROWITT, LLP, ATTORNEYS AT LAW

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COLEMAN & HOROWITT, LLP WELCOMES NEW LAWYERS AND PARTNERS

Coleman & Horowitz, LLP is pleased to announce that **Michael P. Dowling** and **Brady K. McGuinness** have joined the firm and that **Sherrie M. Flynn** and **Paul M. Parvanian** have been elevated to partner.



Michael P. Dowling, a native of Fresno, graduated from California State University, Fresno and received his law degree from Gonzaga University School of Law in 1994. Prior

to joining the firm, Michael was a sole practitioner with the Law Offices of Michael P. Dowling and was formerly a partner with the Fresno firm Dowling, Aaron & Keeler.

Michael is a partner in the transactions department of the firm's Fresno office where he will provide representation to clients in business transactions, estate planning, probate and trust administration matters. Michael is a member of the Fresno County Bar Association (Member, Sections on: Estate Planning, Trust and Probate; past Chairman); State Bar of California (Member, Sections on: Estate Planning, Trust and Probate Law); Fresno Estate Planning Council. mdowling@ch-law.com

Brady K. McGuinness, also a native of Fresno, graduated from California

State University, Fresno and received his law degree and master's of business administration from Santa Clara University. Prior to joining the firm, Brady was a partner in the Fresno firm Betts, Rubin & McGuinness.



Brady, who is also licensed as a real estate broker, will work as senior counsel in the transactions department in Fresno where he will represent clients in business formation, dissolution, and transactions and all facets of real estate including transactions, entitlements, eminent domain, and financing. Brady is a member of the Fresno County Bar Association. bmcguinness@ch-law.com



The firm is also pleased to announce that **Sherrie M. Flynn** and **Paul M. Parvanian** have been elevated to partner. **Sherrie M. Flynn**, a registered patent lawyer,

represents clients in intellectual property matters including patent prosecution and trademark, copyright, and trade dress

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registration and litigation involving intellectual property, trade secrets, unfair competition, and complex business and construction litigation. sflynn@ch-law.com



Paul M. Parvanian represents clients in various matters including business, real estate, construction, landlord-tenant and professional liability defense litigation. Paul also represents banks, finance companies, and auto dealers in the defense of consumer claims including those involving the

Consumer Legal Remedies Act, Automobile Sales Finance Act, Song Beverly Consumer Warranty Act, as well as other consumer protection statutes. pparvanian@ch-law.com

Please join us in welcoming Michael, Brady, and our new partners, Sherrie and Paul.

COLEMAN & HOROWITT, LLP CREATES DISPUTE RESOLUTION SERVICES

Since its inception, we at Coleman & Horowitz, LLP recognized the benefits of alternative dispute resolution. We knew that the effective use of negotiation and mediation would offer a more cost effective alternative to trial. We also knew that while arbitration is not right in every case, it was necessary to be trained in representing clients in arbitration. More importantly, we recognized that while the number of providers of ADR services has grown, there is still a need for trained neutrals in the Central Valley.

Based on the need, the firm has formed Coleman & Horowitz Dispute Resolution Services. The firm's new arbitration and mediation services feature attorneys trained to handle all forms of ADR including arbitration, judicial reference, discovery referee, special master, mediation, early neutral evaluation, med/arb, and mini trial. Our providers obtained training from the best sources including Pepperdine School of Law, Strauss Institute of Dispute Resolution, San Joaquin College of Law/Better Business Bureau dispute resolution training, American Arbitration Association, and FINRA Dispute Resolution.

Members of our dispute resolution services include

- **William H. Coleman** - contract, business, partnership, licensing, wills and trust disputes
- **Darryl J. Horowitz** - contract, construction, consumer finance, banking, collections, partnership, unfair competition, professional liability, intellectual property, labor and employment, real estate, personal injury, and securities disputes

- **David J. Weiland** - contract, construction, banking, collections, partnership, unfair competition, intellectual property, labor and employment, real estate, personal injury, and professional liability disputes
- **Laurence Y. Wong** - medical malpractice, personal injury, professional liability, contract, banking, consumer finance, partnership, unfair competition, and business disputes
- **Keith M. White** - construction, business, real estate, professional liability, labor and employment, partnership, and unfair competition disputes
- **Daniel L. Rudnick** - contract, construction, collections, partnership, unfair competition, intellectual property, real estate, and personal injury disputes
- **Gary S. Shuster** - contract, partnership, unfair competition, trade secret, and intellectual property disputes

The firm's ADR mediators are available throughout California.

COLEMAN & HOROWITT, LLP OPENS NEW BAKERSFIELD OFFICE

Coleman & Horowitz, LLP has, since it opened, recognized the need to serve our clients where the needs arise. For the past several years, we have seen an increase in work in the Southern San Joaquin Valley. In 2015, we opened an office in Visalia at 2330 West Main Street, managed by **Gregory J. Norys**.

To service clients in Kern County, we are pleased to announce the opening of our newest office in Bakersfield, California, located at 201 New Stine Road, Suite 300, Bakersfield, California 93309.

The new office will be managed by **Daniel L. Rudnick**, a life-long Bakersfield resident who has a long history of representing businesses and their owners in Bakersfield and previously served as general counsel for VPI. Mr. Rudnick, an entrepreneur and owner of several businesses, will serve as an entrepreneur in residence and represent clients in business, commercial, agricultural, real estate, oil and gas, unfair competition and intellectual property litigation, landlord-tenant disputes, and real estate and agricultural transactions.

With the office in Bakersfield, the firm has offices in Fresno, Los Angeles, Visalia and Bakersfield and provide representation throughout the state. Further, with our membership in Primerus, we can provide service to our clients worldwide.

COLEMAN & HOROWITT, LLP NAMED A "TOP LAW FIRM"

Each year the Martindale-Hubbell lawyer directory announces a list of the Top Law Firms in the country. They are determined based on the number of partners who have received the top AV® (Preeminent) rating available from Martindale-Hubbell following an anonymous peer review.

Coleman & Horowitz, LLP is pleased to announce that it has been named a Top Law Firm. Recently, **Laurence Y. Wong** and **C. Fredrick Meine III**, partners in the firm's Los Angeles and Fresno offices, respectively, received an AV®-Preeminent rating. This pushed the number of AV-rated partners to six, the others being **William H. Coleman**, **Darryl J. Horowitz**, **Eliot S. Nahigian**, and **David J. Weiland**.

The firm is pleased to have received such recognition. Our clients already believe we provide a high level of service. We are happy to see that our peers agree.

RECENT DEVELOPMENTS

WE ARE PLEASED TO REPORT THE FOLLOWING
RESULTS FOR OUR CLIENTS:

- **Darryl J. Horowitz** favorably resolved a pre-litigation claim against a real estate brokerage and one of their agents. In the matter, the agent sold her residence and acted as the seller and listing agent. After the sale, the buyers contended that the seller failed to disclose the location of the property boundaries and, as a result, the buyers did not receive the property they thought they were purchasing. In an earlier mediation, the parties entered into a conditional settlement agreement to create a non-exclusive easement for use by the buyer. After the parties were unable to agree on an acceptable easement, the buyers sought a second mediation and claimed damages of over \$200,000, but we were able to negotiate a settlement for less than defense costs.
- **C. Fredrick Meine III** favorably resolved a complicated commercial landlord-tenant dispute. In the action, our client's tenant was delinquent in its rent. The lease included an option, but it also included a clause that prevented the tenant from exercising an option to extend the terms of the lease if the tenant was in default for payment of rent. The tenant was then served with a notice to pay rent or quit and a judgment was quickly entered against the tenant. Unbeknownst to the landlord, however, there was a subtenant owned by a principal of the main tenant. The subtenant contended that it was entitled to separate notice and the court agreed. Thereafter, however, the subtenant realized

that it would be unable to stay in the property and negotiated a settlement, which included an additional payment of rent by the subtenant directly to the landlord and a drop-dead date for all parties to move out of the property while preserving our client's right to recover unpaid rent from the main tenant as well as the subtenant.

- **William H. Coleman** and **Darryl J. Horowitz** favorably resolved a partnership dissolution. In the action, our client was a partner of a local business in Fresno and Madera Counties. When one of the original partners passed away, the other partner thought it best to dissolve the business in a way that that partner could continue to run the business division he previously operated while the other partner's widow would run the other business division. Because there were multiple other holdings, this meant that the parties could either litigate in court over who was entitled to what or they could work cooperatively in arriving at an equal distribution of assets. In working with counsel for the other partner, we were able to work out an equitable distribution of partnership assets that allowed each of the operating divisions to remain intact so they could continue to be operative well into the future. Had the parties engaged in litigation, it would have surely damaged both the ongoing business operation and could have damaged the goodwill of both operating divisions. The parties would have also incurred significant additional expense in litigation that was avoided by working towards a common sense, practical solution.

If you have any questions regarding any of the developments referenced above or have a similar matter you may wish to discuss with us, please contact Maria O'Neill at (559) 248-4820 / (800) 891-8362 or by e-mail at moneill@ch-law.com.

THANK YOU

After 20 years in business, and our growth over the past two years, we realize that we have succeeded where others may have failed because of referrals from you, our friends and clients. We thank you for those referrals.

We recognize that no business can grow without referrals. We value the confidence you have placed in us with your business and referrals. We hope you will continue to show us your confidence with future referrals.

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MANAGING YOUR TRADEMARK PORTFOLIO

BY *SHERRIE M. FLYNN*

Whether you own one, five or twenty trademarks, properly managing your trademark portfolio will maximize your investment and help insure that you get the best possible return on your investment. Key to preserving or increasing the value of your trademarks and the associated goodwill of your business is managing your trademark portfolio by developing strategies for maintenance and enforcement of your marks.

Register Your Trademarks

First, to maximize the value of any mark, you should register it. Although you do not have to register your trademark to establish rights in the mark, there are several important advantages to trademark registration. Federal trademark registration provides (i) constructive notice to the public of your claim of ownership of the mark, (ii) a legal presumption that you own and have the exclusive right to use the mark on or in connection with your registered goods and/or services, (iii) the ability to bring an action concerning your mark in federal court, (iv) the ability to file the registration with U.S. Customs to prevent importation of infringing foreign goods, and (v) the ability to use the U.S. registration as a basis to obtain registration in foreign countries.

While common law rights in a trademark are developed based on use of the mark, proving such use, particularly as of a certain date, may be difficult, and common law rights extend only to those geographical areas in which the trademark was actually used. On the other hand, federal registration provides a presumption of the exclusive right to use the mark throughout the U.S.

If you are building a trademark portfolio, choosing a mark

is important for establishing your brand and laying the foundation for your company's portfolio. Variations of the original mark may be used to develop a family of marks representing sub-brands of your products or services. It is best to consult a trademark attorney when registering your mark because, among other reasons, the identification of goods and/or services in the application is typically critical to properly protecting your rights in the mark.

Record Ownership

In some cases, a company may acquire a portfolio of trademarks as part of a purchase of a business or a merger with an existing business. Should this occur, it is important to promptly record assignment of the marks, as securing the necessary documentation and signatures may be difficult at a later time. Assignments of the transferred trademarks should be recorded with the U.S. Trademark Office or the appropriate foreign jurisdiction. Each jurisdiction may have its own requirements for filing and recording of assignments, and it may be necessary to engage foreign counsel to properly record assignments in foreign countries.

Portfolio Maintenance and Review

Trademarks must be renewed on a periodic basis to continue to derive the benefits of trademark registration. In the U.S., trademarks must be renewed between the fifth and sixth years after registration, between the ninth and tenth years, and then between every ninth and tenth years thereafter. Additionally, filing a declaration of incontestability at an appropriate time when certain criteria are met increases the benefits of a federal registration. An incontestable registration is immune to challenge on certain grounds, including that the registered mark is merely descriptive and lacks secondary meaning. In addition, an incontestable registration serves as conclusive evidence of the validity of the registered mark, the

registrant's ownership of the mark, and the registrant's right to use the registered mark in commerce.

These significant additional benefits further immunize a trademark from challenge by others. In addition to maintenance of your trademarks, it is important to periodically review your trademark portfolio to determine whether new marks should be registered, marks no longer used should be abandoned, or any marks should be registered internationally. If you are choosing and registering new marks, timing of applications and associated deadlines may be critical to establishing rights in the mark. For example, certain foreign countries require that applications for registration claiming priority to a U.S. trademark be filed within six months of the U.S. application. Likewise, the U.S. requires that registrations claiming priority to a trademark applied for or registered in a foreign country be filed within six months of filing of the foreign application. Engaging a knowledgeable U.S. trademark attorney and/or foreign counsel familiar with the requirements of the particular jurisdiction is critical for proper establishment of your trademark rights.

On the other hand, if you are not using one or more of your trademarks or are not using a mark on all of the goods or services for which it is registered, modification of the identification of goods or services, or abandonment of the mark in its entirety may be appropriate or necessary to avoid costly cancellation proceedings by others. Abandoning trademarks that have little or no value preserves resources that may be used for other, more valuable marks.

Enforcement of Trademarks

Immediately after federal registration, you should begin using the ® symbol to put others on notice of your registration and ownership of the mark. Before applying for registration of a trademark, during the registration process, or if only registering the trademark in a particular state, use the symbol "TM" to notify others that you are claiming ownership of the mark.

In addition to using the appropriate symbol, you should develop strategies for enforcement of your marks, and periodically review and modify your strategies as appropriate. This may include monitoring company websites, social media sites, etc., for third party usage of marks that are the same or similar to your trademark. In lieu of or in addition to monitoring such third-party usage, there are several companies that offer trademark watch services that provide notices of identical or similar marks that have been recently published in the U.S. and on foreign trademark registers. Use of these services can significantly increase your ability to identify competing trademarks in the marketplace.

Once you have located a potential infringer, you should consider sending, or having an attorney send, a "cease and desist" letter to demand that the potential infringer cease use of a mark that you consider to infringe your mark. You should also consider filing an opposition or cancellation proceeding with the U.S. Trademark Trial and Appeal Board, or the appropriate tribunal in another jurisdiction, to oppose registration or cancel an existing competing registration. There are a number of deadlines and requirements for opposing or cancelling a mark, and it is important to know such deadlines and requirements, or engage the services of an experienced trademark attorney. For federally registered trademarks, and in lieu of or in addition to such proceedings, an infringement action may be brought in federal court in the U.S.

Whatever the strategy, affirmative steps should be taken to protect your trademarks and to prevent infringement or dilution by others. An experienced trademark attorney can significantly aid in development and enforcement of your trademark portfolio, and by doing so, maximize the return on investment in your trademarks and in your business.



The author, Sherrie M. Flynn, is a partner in the Fresno office of Coleman & Horowitz, LLP, where she works in the firm's litigation department. Sherrie, who is registered as a patent attorney with the USPTO, represents clients in intellectual property matters including the prosecution, licensing, assignment and enforcement of patents, trademarks, copyrights, trade dress and trade secrets. She also represents clients in complex commercial, business, real property, unfair competition and construction litigation and alternative dispute resolution. Sherrie received an engineering degree from Carnegie Mellon University and her J.D. from San Joaquin College of Law, where she served as the managing editor of the Agricultural Law Review. Sherrie is a member of the Fresno County Bar, ABA (Intellectual Law Section), LAIPLA (Los Angeles Intellectual Property Law Association), and ABTL. She can be reached at (559) 248-4820/(800) 891-8362 or sflynn@ch-law.com.



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