

JOHN M. SCAGNELLI Partner

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BIOGRAPHY

John Scagnelli's intellectual property law work has involved managing, defining and protecting the intellectual property assets of entities in a wide variety of industries. He assists clients in virtually all intellectual property matters, ranging from the selection and registration of trademarks and service marks to the copyright protection of materials such as printed and electronic literature, computer software, and product designs.

Mr. Scagnelli has negotiated and prepared licensing agreements and contracts, including trademark licensing agreements and publishing contracts, and he has represented clients in the purchase or sale of many types of intellectual property. Mr. Scagnelli has also litigated intellectual property lawsuits which have involved various forms of intellectual property and unfair competition. He counsels clients on intellectual property matters in connection with technology transfer, infringement, and validity opinions, as well as the intellectual property of mergers and acquisitions.

INTELLECTUAL PROPERTY BACKGROUND

As an attorney with the New York City firm of Townley & Updike (1975-1977), Mr. Scagnelli represented N.F.L. Properties, Inc., and the North American Soccer League Properties, Inc., the licensing arms of the National Football League and North American Soccer League, the New York Racing Association (NYRA), the New York Daily News, and the Good Humor Corporation. His work included trademark, copyright, patent licensing, and litigation. His litigation cases included the National Football League v. State of Delaware (Delaware Football Lottery case), and Trademark Trial and Appeal Board Proceedings.

As an attorney with the New York City firm of Milgrim, Thomajan, Jacobs & Lee (1979-1982), Mr. Scagnelli handled trade secrets, trademark, copyright and other intellectual property work. He represented corporations on intellectual property matters, including Clairol, Bristol-Myers, and the Long John Silvers chain. Mr. Scagnelli was a Member of the Editorial Board and Domestic Articles Editor of The Trademark Reporter, the Official Journal of the U.S. Trademark Association from 1979-1987.

Mr. Scagnelli served as Corporate Regulatory and Trademark Counsel for Chesebrough – Pond's Inc. (1977-1979), a diversified multi-national consumer products company, whose branded products include Ragu food products, Health-tex clothing, Bass shoes, Vaseline Intensive Care Lotions, and Prince Matchabelli and Rave perfumes and hair products. Mr. Scagnelli handled intellectual property matters, including trademark and copyright filings, Trademark Trial and Appeal Board, and court litigation proceedings, foreign intellectual property filings and intellectual property protection.

As an attorney with the Newark, New Jersey firm of Clapp & Eisenberg (1986-1990), Mr. Scagnelli handled intellectual property matters and Trademark Trial and Appeal Board and court proceedings for corporations, including Health-tex, Inc.

As an attorney with the New York litigation firm of Whitman Breed Abbott & Morgan (1990-2000), Mr. Scagnelli handled intellectual property counseling work and litigation for industrial clients, including Pharmaceutical Formulations, Inc. in Edison, New Jersey, then the second largest private label pharmaceutical company in the United States.





EDUCATION

- Yale Law School (JD, 1975)
- Yale University (BA, summa cum laude, 1972)

BAR ADMISSIONS

- New York
- United States District Court, Southern and Eastern Districts of New York
- United States Court of Customs and Patent Appeals
- United States Court of Appeals, Federal Circuit
- United States Court of Appeals, Second Circuit
- New Jersey and U.S. District Court, District of New Jersey
- United States Court of Appeals, Third Circuit
- United States Court of Appeals, Eighth Circuit
- United States Court of Appeals, District of Columbia Court

AFFILIATIONS

- Association of the Bar of the City of New York
- New Jersey State Bar Association
- American Bar Association
- New York County Lawyers Association





