JEFFREY M. SAMUELS

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EMPLOYMENT

David L. Brennan Professor of Law and Director, Center for Intellectual Property Law and Technology, University of Akron School of Law, Akron, Ohio, August 1998 to present.

- Develop, implement and staff curriculum, including Master of Laws in Intellectual Property (IP).
- Program recently ranked nationally #5 for IP curriculum offerings and #24 overall.
- Initiated, coordinate and organize annual intellectual property law symposium, continuing legal education and guest lectures.
- Initiated and oversee new student-run IP journal.
- Initiated establishment of IP summer study abroad program in Geneva, Switzerland.
- Serve as primary contact between law school and intellectual property law bar and community; work with IP Advisory Council on program development.
- Courses taught: Trademark and Unfair Competition Law, Introduction to Intellectual Property Law, Intellectual Property Policy and Politics, International Intellectual Property Law, Current Issues in Intellectual Property Law, Seminar on Piracy and Counterfeiting, Patent Law.
- Committee service: Curriculum; Appointments; Admissions; Library; Student and Alumni Affairs; Dean Search; Provost's Ad Hoc Academic Alignment

Visiting Professor, Center for Studies in International Industrial Property (CEIPI), Robert Schuman University, Strasbourg, France, 2003, 2005, 2006, 2007. Serve as guest lecturer on U.S. and international trademark law. Initiated discussions regarding faculty and student exchange programs.

Chair, Trademark Public Advisory Committee of the United States Patent and Trademark Office (USPTO), three-year term commencing July 2003; reappointed August 2006. Chair committee and advise the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office on matters relating to the policies, goals, performance, budget, and user fees of the trademark operation.

Expert witnessing and consulting June 1996 – present. Provide expert witness and consulting services to law firms involved in litigation and other matters involving trademark and related unfair competition law.

Alternative Dispute Resolution 1999 – present. Panelist, ICANN's Uniform Domain Name Resolution Policy; Panelist, International Trademark Association and the Center for Public Resources' ADR Program; Member, ADR Neutrals for the U.S. District Court for the Northern District of Ohio; Member, National Arbitration Forum's Intellectual Property Arbitration Panel.

Government Relations Manager for the International Trademark Association, November 1994-July 1997 (directed the introduction, consideration and enactment of "The Federal Trademark Dilution Act of 1995").

Professorial Lecturer in Law, 1993 – 1998. The George Washington University Law School. 1998. George Mason University School of Law. Taught trademark law and provided support for the program. Guest lecturer in courses on international intellectual property law and intellectual property law legislation. Lecturer intellectual property law program for Taiwanese attorneys and government officials.

Partner, Spencer & Frank, March 1993 - June 1996. Practiced trademark and related unfair competition law and copyright law, including prosecution, expert witnessing, consulting and litigation.

Assistant Commissioner of Patents and Trademarks, November 1987 - January 1993. Head of the trademark division of the U.S. Patent and Trademark Office. Established and implemented policy, procedures and strategy on all facets of trademark operations, including legal and legislative issues, international cooperation, external relations, rulemaking, budget, personnel, automation, labor/management issues; statutory Member, Trademark Trial and Appeal Board (TTAB). May 1992 - January 1993. Assigned additional responsibilities to oversee activities of the Offices of the Assistant Commissioner for Information Systems and the Assistant Commissioner for Public Services and Administration and to serve as principal liaison to the Department of Commerce's Office of Inspector General.

Acting Assistant Secretary of Commerce and Commissioner of Patents and Trademarks, November 1989 - March 1990 and as needed 1987 - 1993. Responsible for overall management of the U.S. Patent and Trademark Office, including congressional and other external relations.

SIGNIFICANT ACCOMPLISHMENTS IN GOVERNMENT SERVICE

- Implemented "Trademark Law Revision Act of 1988."
- Headed U.S. delegation to the World Intellectual Property Organization's Working Group meetings on implementation of the Madrid Protocol on the International Registration of Marks and on Harmonization of the Laws Relating to Trademarks.
- Implemented quality improvement initiatives, including creation of Office of Trademark Quality Review and total quality management program.
- Author of major TTAB policy decisions relating to amendments to identifications of goods and services and examiner reconsideration.

CONGRESSIONAL TESTIMONY

House Judiciary Subcommittee on Courts and Intellectual Property:

"Abrogation of States Eleventh Amendment Immunity from Patent Infringement," February 1990. Cited by the Supreme Court of the United States in Florida Prepaid v. College Savings Bank, 527 U.S. 627, n.6 at 641 (1999).
"Computers and Intellectual Property," March 1990.
"Copyright Protection for Architectural Works," March 1990.
"Madrid Protocol Implementation Act of 1993," May 1993.
"Federal Trademark Dilution Act of 1995," July 1995 (prepared testimony only).
"H.R. 3163, The 'Trade Dress Protection Act'," February 1998.
"Hearing on Dilution and Anti-counterfeiting Bills," May 1998.

House Appropriations Subcommittee on Commerce, State, Justice, the Judiciary and Related Agencies:

"1991 Budget Request of U.S. Patent and Trademark Office," February 1990.

Managing Editor, May 1982 - October 1987; **Legal Editor**, August 1976 - April 1982. BNA's Patent, Trademark & Copyright Journal; **Founder**, World Intellectual Property Report; **Chair**, Professional Conferences; The Bureau of National Affairs, Inc.

EDUCATION, BAR MEMBERSHIPS AND ORGANIZATIONS

Albany Law School, Doctor of Jurisprudence, May 1975.

Colgate University, Bachelor of Arts with Honors, May 1972.

Ohio State Bar (1999); District of Columbia Bar (1978); Virginia State Bar (1977); New York State Bar (1976); U.S. Court of Appeals for the Federal Circuit (1996); U.S. District Court for the Eastern District of Virginia (1997).

American Intellectual Property Law Association, Chair, Committee on Trademark Legislation 1999-2000; Vice-Chair, Committee on Trademark and Trade Identity Unfair Competition Law 1994-1995; Chair, Trademark Office Subcommittee 1997-2000; Staff Editor, AIPLA Quarterly Journal 1996-2000, authored congressional testimony on legislation to amend federal dilution statute 2002.

The International Trademark Association, Government Relations Manager 1995-1997; Member, Brief Amicus Committee 1997-1999, Member, Meetings Committee 2000-2002.

American Bar Association Section of Intellectual Property Law, Chair, State Trademark Legislation Committee, 2007-2008; Co-chair, Trademark Legislation Committee, 2006-2007; Chair, Trademark Dilution Task Force, 2005-2006; Co-chair, International Trademark Laws and Treaties, 2005-2006; Chair, Federal Trademark Legislation Committee 1994-1995; Chair, Sovereign Immunity Subcommittee, 2002-2004; Chair, Intent-to-Use Subcommittee 1997-98; Chair, Trade Dress Subcommittee 1998-99.

Cleveland Intellectual Property Law Association, President, 2004-2005; President-Elect 2003-2004; Program Chair 1999-2002; Board Member, 2001-2002.

Advisory Board Member, BNA's Patent, Trademark & Copyright Journal, 1993-present.

Advisory Board Member, World Intellectual Property Report, 1993-present.

PUBLICATIONS (Excluding Proceedings and Course Books)

"Patent Trademark and Copyright Laws" (BNA: 1983, 1984, 1985, 1987, 1989, 1991, 1992 Supp., 1993, 1994, 1995, 1996, 1997, 1998, 1999, 2000, 2001, 2002, 2003, 2004, 2005, June 2005, 2006, June 2006, 2007, June 2007).

Samuels, Jeffrey M. and Samuels, Linda B., "Court Opinions Affecting PTO Trademark Practice: The Year in Review," Journal of the Patent and Trademark Office Society, Vol. 89 No. 3, March 2007, pp. 177-203.

Samuels, Jeffrey M. and Samuels, Linda B., "Trademark Jurisprudence of Judge Rich," American University Law Review, Vol. 46 No. 4, April 2007, pp. 761-791.

Samuels, Jeffrey M. and Samuels, Linda B., “Recent Developments in U.S. Trademark Law: A Confusing State of Affairs,” Journal of the Patent and Trademark Office Society, Vol. 88 No. 4, April 2006, pp. 361-377.

Samuels, Jeffrey M. and Samuels, Linda B., “Precedential Court Decisions Affecting PTO Trademark Practice: The Year in Review,” Journal of the Patent and Trademark Office Society, Vol. 88 No. 3, March 2006, pp. 203-216.

Samuels, Jeffrey M. and Samuels, Linda B., “Major Trademark Decisions Relating to PTO Practice: The Year in Review,” Journal of the Patent and Trademark Office Society, Vol. 87 No. 5, April 2005, pp. 298- 310.

Samuels, Jeffrey M. and Samuels, Linda B., “International Trademark Protection Streamlined: The Madrid Protocol Comes into Force in the United States,” The University of Georgia School of Law Journal of Intellectual Property Law, Vol. 12 Fall 2004, No. 1., pp. 151-161.

Samuels, Jeffrey M. and Samuels, Linda B., “Key Trademark Decisions Relating to PTO Practice,” Journal of the Patent and Trademark Office Society, , Vol. 86, No. 4, April 2004, pp. 247-279. Selected for translation into Japanese and reprinted in Journal of the Japanese Group A.I.P.P.I, Vol. 49, No. 10, (Fall 2005) pp. 12-27.

Samuels, Jeffrey M. and Samuels, Linda B., "Internet Domain Names: The Uniform Dispute Resolution Process," American Business Law Journal, Vol. 40, No. 4, Summer 2003, pp. 885-904.

Samuels, Jeffrey M. and Samuels, Linda B., “Notable Court Decisions Affecting PTO Trademark Practice, ” Journal of the Patent and Trademark Office Society, Vol. 85, No. 3, Mar. 2003, pp. 191-218.

Samuels, Jeffrey M. and Samuels, Linda B., "Trademark Decisions Affecting PTO Practice in 2001," Journal of the Patent and Trademark Office Society, Vol. 84, No. 4, April 2002, pp. 310-330, reprinted in Japanese version of AIPPI Journal, 2002; translated into Japanese and reprinted Journal of the Japanese Group A.I.P.P.I, Vol. 47, No. 9, pp. 18-30.

Samuels, Jeffrey M. and Samuels, Linda B., “Recent Court Opinions Affecting USPTO Practice: The Year in Review,” Journal of the Patent and Trademark Office Society, Vol. 83, No. 9, Sept. 2001, pp. 619-639.

Samuels, Jeffrey M. and Samuels, Linda B., “Trade Dress Undressed: Wal-Mart v. Samara, ” AIPLA Quarterly Journal, Vol. 29, No. 1, Winter 2001, pp. 43-63, Selected for reprinting in Intellectual Property Law Review 2002 (West Publishing Co.).

Samuels, Jeffrey M. and Samuels, Linda B., “Supreme Court Makes Protection of Product Design Trade Dress More Difficult,” Journal of the Academy of Marketing Science, Vol. 29 No. 1, Winter 2001, pp. 108-109.

Samuels, Jeffrey M., “Trade Dress Protection: The Issue of Distinctiveness and Potential Conflicts,” Northern Kentucky Law Review, Symposium Issue – Intellectual Property Law: Issues in the New Millennium, Vol. 27 No. 5, Fall 2000, pp. 1041-54.

Samuels, Jeffrey M. and Samuels, Linda B., "Highlights of Opinions Affecting PTO Practice," Journal of the Patent and Trademark Office Society, Vol. 82, No. 5, May 2000, pp. 311-335.

Trademark Registration Practice by James E. Hawes (West). Primary contributor to 1999 and 2000 updates.

Samuels, Jeffrey M. and Samuels, Linda B., "Principal Opinions Affecting PTO Trademark Practice," Journal of the Patent and Trademark Office Society, Vol. 82 No. 4, April 1999, pp. 281-302.

Samuels, Jeffrey M. and Samuels, Linda B., "Significant Trademark Decisions," Journal of the Patent and Trademark Office Society, Vol. 80 No. 7, July 1998, pp. 453-468.

Samuels, Jeffrey M. and Samuels, Linda B., "Noteworthy PTO Trademark Decisions," Journal of the Patent and Trademark Office Society, Vol. 80 No. 4, April 1998, pp. 231-240.

Trademark Protection and Practice by Jerome Gilson (Matthew Bender & Co.). Associate Editor of treatise, 1993–1998.

Trade Marks, Trade Names and Unfair Competition, World Law and Practice by John Olsen and Spyros Manlatis (FT Law and Tax, London). Contributor of section of treatise relating to U.S. trademark law and practice, 1994-present.

Samuels, Jeffrey M., "Formulating an Effective Association Intellectual Property Program," ASAE Association Law and Policy and ASAE Law Compendium, 1997.

Samuels, Jeffrey M. and Samuels, Linda B., "Recent Developments in Trademark Law and Practice," Journal of the Patent and Trademark Office Society, Vol. 79, March 1997, pp. 181-190.

Samuels, Jeffrey M. and Samuels, Linda B., "The Trademark Office as a Government Corporation," Fordham Intellectual Property, Media & Entertainment Law Journal, Vol. 7, Autumn 1996, pp. 137-145. Cited in Senate Report 105-42 on the "Omnibus Patent Act of 1997," 105th Congress, First Session, July 1, 1997, p. 45.

Samuels, Jeffrey M. and Samuels, Linda B., "Recordal of Fastener Insignia Under the Fastener Quality Act," American Fastener Journal, Vol. 13, No. 6, Nov./Dec. 1996, pp. 4, 10, reprinted World Intellectual Property Report, Vol. 11, pp. 24-25, January 1997, co-author.

Samuels, Jeffrey M. and Samuels, Linda B., "Color Trademarks: Protection Under U.S. Law," Journal of Public Policy and Marketing, Vol. 15, No. 2, Fall 1996, pp. 305-307.

Samuels, Jeffrey M. and Samuels, Linda B., "Famous Marks Now Federally Protected Against Dilution," Journal of Public Policy and Marketing, Vol. 15, No. 2, Fall 1996, pp. 306-310.

Samuels, Jeffrey M. and Samuels, Linda B.,"Protection For Color Under U.S. Trademark Law," AIPLA Quarterly Journal, Vol. 23, No. 1, Winter 1995, pp. 129-152.

Samuels, Jeffrey M. and Samuels, Linda B., "The Community Trademark," World Intellectual Property Report, April 1996, pp. 114-116.

Samuels, Jeffrey M. and Samuels, Linda B., "The Madrid Protocol to Enter into Force April 1," World Intellectual Property Report, March 1996, pp. 86-87.

Samuels, Jeffrey M. and Samuels, Linda B., "The Changing Landscape of International Trademark Law," George Washington Journal of International Law and Economics, Vol. 27, Nos. 2 & 3, 1994, pp. 433-455. Excerpted in Goldstein, Copyright, Patent and Related State Doctrines: Cases and Materials on Intellectual Property Law (Foundation Press, 1999), pp. 1045-1048; excerpted in Dinwoodie, et al. International Intellectual Property Law and Policy (Lexis, 2001); excepted in Dinwoodie, et al. International and Comparative Trademark and Unfair Competition Law (Lexis, 2002). Selected as finalist for the Ladas Award sponsored by the Brand Names Education Foundation.

Samuels, Jeffrey M., "The Madrid Protocol From the U.S. Perspective," Journal of Japan Trademark Association," Vol. 21, 1994, pp. 23-30 (in Japanese), Proceeding, pp. 99-113 (in English).

Samuels, Jeffrey M., "The Madrid Protocol and Harmonization of Trademark Laws," Canadian Intellectual Property Review, Vol. 10, No. 3, May 1994, pp. 667-668.

Samuels, Jeffrey M., “European Community Trademark: What Every U.S. Owner and Practitioner Should Know,” Trademarks America, June 1994, pp. 9-11.

Samuels, Jeffrey M., "Patent and Trademark Office Practice," The Journal of Proprietary Rights, (Part I) Vol. 5, No. 9, September 1993; (Part II) Vol. 5, No. 10, October 1993; (Part III) Vol. 5, No. 11, November 1993; (Part IV) Vol. 5, No. 12, December 1993.

Samuels, Jeffrey M., “House Panel Holds Hearing on Madrid Protocol,” Dinwoodey Center Journal, The George Washington University National Law Center, September 1993, pp. 3-4.

Samuels, Jeffrey M. and Samuels, Linda B., "U.S. Perspective on the Madrid Protocol," European Intellectual Property Review, Vol. 15, November 1993, pp. 418-25.

Samuels, Jeffrey M. and Samuels, Linda B., "Reflections on Management of the PTO," Journal of the Patent and Trademark Office Society, April 1993, pp. 247-256.

Samuels, Jeffrey M. and Samuels, Linda B., "Color Trademarks: Shades of Confusion," The Trademark Reporter, Vol. 83, August 1993, pp. 554-570.

Samuels, Jeffrey M., "Letter To The Editor" [regarding "The Madrid Protocol - Some Reflections"], The Trademark Reporter, Vol. 82, September - October 1992, pp. 810-813.

Samuels, Jeffrey M. and Samuels, Linda B., “Questions and Answers on Intent to Use,” Patent and Trademark Office Society, Vol. 71, No. 8, August 1989, pp. 585-599.

Samuels, Jeffrey M. "Analysis of Trademark Law Revision Act of 1988," World Intellectual Property Report, February 1989, pp. 34-35.

Samuels, Jeffrey M. and Samuels, Linda B., "New Developments in Copyright Protection of Computer Software," International Journal of Legal Information, October - December 1987, pp. 195-200.

Samuels, Jeffrey M. and Samuels, Linda B., "Semiconductor Chip Protection Act of 1984: An Analytical Commentary," American Business Law Journal, Winter 1986, pp. 601-616.

Samuels, Jeffrey M. and Samuels, Linda B., "The Patentability of Computer-Related Inventions," Corporation Law Review, Spring 1983, pp. 144-155.

Samuels, Jeffrey M. and Samuels, Linda B., "Contributory Infringement: Relief For the Patent Owner," Corporation Law Review, Fall 1981, pp. 332-345.

SELECTED PRESENTATIONS

Akron Kiwanis Club, January 2002.
Agency for International Development, July 1998.
ALI-ABA Video on the Trademark Law Revision Act, December 1989.
All Ohio Intellectual Property Law Conference, September 1995, September 2000; September 2003.
American Bar Association Section on Intellectual Property Law, March 1988, April 1994, June 1999, April 2002; March 2003, June 2003.
American Intellectual Property Law Association Trademark and Unfair Competition Law Committee, October 1988; January and October 1989; October 1990; January 1993, May 1996, January 1998, April 1999.
American Intellectual Property Law Association, May 1997, October 1999, October 2000. October 2006.
American Law Institute - American Bar Association Continuing Legal Education Spring Program, April 1992; April 1993.
American Society of Association Executives, October 1997.
Annual Meeting of The United States Trademark Association May 1988; May 1991; May 1992.
Arter & Hatten, September 1997.
Asian Pacific Legal Institute, July 1996; July 1997.
Association of the Bar of the City of New York Section on Unfair Competition, March 1990.
Bar Association of District of Columbia Patent, Trademark & Copyright Section, December 1988; February 1993.
Bar Association of Metropolitan St. Louis, April 2002.
BNA's 12th Annual Patent Law Conference, November 1988.
Brooklyn Law School Symposium for Business Lawyers, February 1989.
Carolina Patent, Trademark and Copyright Law Association, April 1989; November 1989.
Center for American and International Law, November 2005.
Chicago Bar Association, June 1988; May 1989; June 1990; May 1991; May 1992.
Civic Forum of the Air, July 2003.
Cleveland Intellectual Property Law Association, February 1993, November 1998, November 1999, November 2001, January 2003, February 2005.
Columbus, Ohio Intellectual Property Law Association, February 2005.
European Community Trademark Conference, March 1995.
Executive Management Institute, January 1990.
Federal Circuit Bar Association May 1996.
Federal Judicial Center Russian Judges Conference, November 1995.

Florida State Bar Intellectual Property Law Section, November 1999, November 2002.
Forum on the Trademark Law Revision Act of 1988, The United States Trademark Association, February; March; June 1989.
George Mason University School of Law Intellectual Property Law Program, March 1998, March 1999, March 2000.
George Washington University Intellectual Property Law Program, February 1993, November 1994; March 1995, October 1995, March 1996, October 1997, March 1998, October 1998, March 1999, October 2000, October 2001.
Government Patent Lawyers Association, March 1989.
IDRC Korean International Seminar, May 2007.
Indiana Patent Law Association, July 1989.
Insight Intellectual Property Program, November 1997, April 1999, November 1999.
Intellectual Property Owners/PTO Day Program, December 1989; December 1990; December 1991; December 1992, December 1996, December 1997, December 1998, December 1999, December 2000, December 2002, December 2003, December 2004, December 2005, December 2006.
Intellectual Property Owners Annual Meeting, November 1999, September 2007.
Intellectual Property Section of the State Bar of California, October 1988; November 1990; September 1992, April 1994, October 1994.
International Intellectual Property Alliance, March 2003.
International Trademark Association Annual Meeting, May 2002; Trademark Basics Program, December 2002.
International Trademark Association Forum, March 1995.
Iowa Intellectual Property Law Association, October 1990; September 2003, October 2006.
Japan Intellectual Property Association, October 1995.
Japanese Trademark Association, February 1994, June 1995, September 1996.
Kent State University Business Students, November 2001.
Lawcast Audiotape on Federal Trademark Dilution Act of 1995, January 1996.
Lexis/Nexis Program on Trademark Law, April 2003.
Los Angeles Intellectual Property Law Association, September 1992, June 1994.
Minnesota Patent Law Association, September 1989.
National Council of Intellectual Property Law Associations, October 1988; October 1989; April 1992; September 1998, September 2000.
New Jersey Intellectual Property Law Association, October 1995.
New York Patent, Trademark and Copyright Law Association, November 1989; February 1990; November 1990, March 1996.
Northern Virginia Chapter of Federal Bar Association, September 1988.
International Intellectual Property Society, March 2003.
Oliff & Berridge CLE Seminar, April 1995, May 1998.
Orange County (California) Patent Law Association, October 1988.
Patent and Trademark Office Trademark Examiners, January 1999, February 2000.
Patent and Trademark Office Program on Patent Law Reform, January 1999.
Patent and Trademark Law Institute of Canada, October 1993.
Patent and Trademark Office Society, February 1993.
Patent Club of Washington and Maryland Patent Law Association, April 1989.
Patent Depository Library Conference, May 1990.
Patent, Trademark and Copyright Law Section of State Bar of Georgia, June 1989.
Patent, Trademark and Copyright Section of District of Columbia Bar Association, April 1989.
Patent, Trademark and Copyright Section of Washington State Bar Association, April 1988.
Philadelphia Public Library Bicentennial Anniversary of First Patent and Copyright Laws, July 1990.

Philadelphia Public Television, July 1990.
Pittsburgh Intellectual Property Law Association, October 1994.
Practising Law Institute, June 1991; June 1992; July 1992; June 1993; July 1993, April 1994, July 1994, July 1995.
San Francisco Intellectual Property Law Association, May 1990, September 1994.
State Bar of Ohio, Law and the Media, April 2007.
State Bar of Wisconsin, January 1990.
Taiwan Economic and Cultural Office, August 1997.
Trade-Mark Agents Institute, London, March 1990; March 1993.
Trademark and Copyright Committee of Pharmaceutical Manufacturers Association, March 1989.
Trademark Law for Trade Associations, October 1989.
UCLA Law School, September 1992.
The United States Trademark Association Forum on Trademark Basics, September 1991.
The United States Trademark Association Pacific Rim Workshop, September 1992.
The United States Trademark Association Paralegal Forum, September 1988.
University of Akron Annual Intellectual Property Conference, March 1999, March 2000, March 2002.
University of Akron School of Engineering, November 1998.
Virginia State Bar Intellectual Property Law Section, February 1993, June 1994.
Voice of America, June 1989.
Washington State and Oregon Patent Law Associations, March 1992, April 1998.
Worldnet TV, June 1988.
Youngstown, Ohio Inventors Group, October 1999.

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