

**Sean P. McConnell**

Partner

Berwyn

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Sean advises clients across a diverse range of industry sectors as they develop and protect their brands. His creative and business-minded strategies help clients with all aspects of their trademarks, brand protection, and advertising.

**OVERVIEW**

Sean provides comprehensive intellectual property guidance to clients in connection with their intellectual property assets, particularly in the areas of trademarks, brand development and protection, marketing, and advertising. Drawing from extensive experience handling key transactions, resolving disputes, and managing global IP portfolios, he collaborates with clients to help them achieve their unique goals.

Sean regularly works with companies and organizations ranging in size from startups to multinational conglomerates. In addition to representing artists, celebrities, and athletes, he is experienced across a wide spectrum of industries, such as agriculture and food manufacturing, alcoholic beverages, cosmetics, electronics, entertainment and media, energy, fashion and apparel, financial and insurance services, higher education, industrial and building products, pharmaceuticals, restaurants, retail, technology/software products and services, tobacco, and a variety of nonprofit organizations.

As a former professional marketer, Sean uniquely understands the potential business disruption and costs involved with rebranding. He designs a holistic plan for each client to develop, build, protect, and monetize their intellectual property portfolios. In addition to licensing, sales, and acquisitions, Sean helps clients protect and defend against infringement through litigation in the federal courts and before the Trademark Trial and Appeal Board (TTAB). He is also experienced with false advertising matters across a broad range of products and services, from cosmetics labeling and solar panels to retail automotive sales.

Sean is an army veteran who served as a captain in the U.S. Army Judge Advocate General's Corps. He deployed to Iraq in 2005 with the Third Infantry Division, serving as one of the primary strategic planners supporting Iraq's first constitutional referendum and permanent government national elections.

**REPRESENTATIVE MATTERS****Litigation Matters**

- Successfully defeated on summary judgment a multimillion-dollar trade secret misappropriation claim related to

roofing products, including the successful defense of the appeal to the Court of Appeals for the Fourth Circuit on behalf of an international interior/exterior building supply manufacturer.

- Successfully defeated on summary judgment a multimillion-dollar trade secret misappropriation claim involving solar panel tiles, and obtained a \$1 million breach of contract counterclaim.
- Successfully defeated a multimillion-dollar trademark infringement claim, on behalf of a financial services software company.
- Successfully opposed registration of multiple infringing trademarks in contested U.S. trademark opposition and cancellation proceedings, on behalf of a variety of clients.
- Successfully opposed registration of a competitor's claimed trade dress for a suppression trigger device, on behalf of an international manufacturer of fire suppression products.
- Negotiated a global settlement agreement that brought an end to multijurisdictional trademark litigation, on behalf of a motorcycle parts manufacturer.
- Successfully defended a motion for TRO and preliminary injunction brought by an international restaurant chain for alleged trademark infringement, on behalf of a regional convenience store chain.
- Successfully negotiated a settlement in a copyright infringement matter that developed an ongoing licensing agreement, on behalf of U.S. based performing rights organization.

## **Transactional Matters**

- Jointly led IP due diligence on \$80 million acquisition of medical device company's international IP portfolio.
- Served as interim in-house global IP licensing counsel for a *Fortune* 250 clothing manufacturer.
- Led sale of a portfolio of copyright and trademark assets for institute of higher education.
- Led IP due diligence on acquisition of a nationwide restaurant group.
- Provided ongoing review of joint development agreements and software licenses for a global technology and software services firm.
- Provided ongoing due diligence and helped negotiate and draft a multiparty, global settlement agreement involving a series of assignments and ongoing licenses for a portfolio of IP assets.
- Guided multiple companies through joint development agreements and product sale and software license agreements.
- Manages global trademark portfolios for a variety of clients.

## **TOP AREAS OF FOCUS**

- Trademark + Copyright

## **ALL AREAS OF FOCUS**

- Cannabis
- Emerging Companies + Venture Capital
- Health Care + Life Sciences
- Intellectual Property
- Marketing + Advertising
- Trademark + Copyright

## **PROFESSIONAL/COMMUNITY INVOLVEMENT**

- Board member, Mid-Atlantic Diamond Ventures
- Board member and secretary, Arm 2 Artisans
- Member, International Trademark Association (INTA), Commercialization of Brands Committee
- Past Board president, The Energy Cooperative of Pennsylvania, a local clean energy supplier
- Past secretary, Entrepreneurs Forum of Greater Philadelphia
- Past Advisory Board member, National Multiple Sclerosis Society – Greater Delaware Valley Chapter

## EDUCATION AND CERTIFICATIONS

### EDUCATION

- University of Pittsburgh School of Law, J.D., 2002
- Duquesne University, B.S., 1998

### BAR ADMISSIONS

- Pennsylvania

### COURT ADMISSIONS

- U.S. District Court, Eastern District of Pennsylvania
- U.S. Court of Appeals, Third Circuit

## SPEAKING ENGAGEMENTS

- Speaker, 2023 Winter Mid-Atlantic Diamond Ventures Forum, December 1, 2023.
- Speaker, “Navigating the IP Landscape: Intellectual Property Issues, Strategies, and Management for In-House Counsel,” Troutman Pepper Webinar, October 25, 2023.

## PUBLICATIONS

- Co-author, “How Far Can You Reach? The Territorial Limits of Lanham Act Infringement and False Designation of Origin Claims,” *Law Journal Newsletter*, September 2023.
- Co-author, “What Is a “Patent Waiver” Anyway? Zooming Out on the TRIPS COVID IP Waiver Debate,” *IPWatchDog.com*, August 9, 2021.
- Co-author, “USPTO Extends Certain Trademark Filing Deadlines Under the CARES Act,” *Troutman Pepper*, April 3, 2020.