



Thomas E. Zutic

Partner

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Tom Zutic is Chair of DLA Piper's Washington, DC Trademark, Copyright, and Media Group. Tom regularly counsels clients on a variety of intellectual property issues affecting their day-to-day business operations and transactions. Tom works with clients on a wide variety of intellectual property matters, with a particular focus on trademark counselling and enforcement, complex intellectual property licensing, as well as copyright enforcement and litigation, domain name, and other Internet issues. He partners with clients to identify valuable intellectual property assets, as well as develop effective strategies to enhance the value of their intellectual property and take action against unauthorized uses of the same. Tom works closely with clients in all sectors including the video game and media, retail, real-estate, and professional services sectors.

Tom has in-depth experience in intellectual property licensing and he works with clients to acquire, develop, and exploit intellectual property assets. He also frequently advises clients on brand development and protection, as well as the intellectual property aspects of mergers and acquisitions, including due diligence and agreement drafting.

Tom also handles trademark and copyright litigation matters in the federal courts, as well as inter partes trademark matters before the United States Patent and Trademark Office Trademark Trial and Appeal Board. Tom has successfully handled numerous ICANN domain name disputes and assists clients with all aspects of domain name portfolio management.

Tom is Chair of the US Chapter of Iris, DLA Piper's LGBTQ Resource Group, and he is a member of DLA Piper's North American Pro Bono Committee. He also serves on the Boards of the Washington Area Lawyers for the Arts and Olney Theatre Center.

- Trademark and Copyright
- Litigation, Arbitration and Investigations

- Media, Sport and Entertainment

Admissions

- District of Columbia

- Maryland
- New York

Recognitions

- Thomas is commended in the *WTR 1000: The World's Leading Trademark Professionals 2017*.
- In 2015 and 2016, Thomas was named by *World Trademark Review 1000* as a top trademark practitioner and they state "IP renaissance man Thomas Zutic counsels, prosecutes and litigates with aplomb."
- *The Legal 500 United States*, a well-regarded legal directory, has recommended Thomas for his trademarks work.

Education

- J.D., American University, Washington College of Law
cum laude
The American University Law Review
- B.A., George Washington University
Political Science

Memberships

- American Bar Association, Intellectual Property Section
- Maryland Bar Association
- International Trademark Association
- District of Columbia Bar Association
- American Intellectual Property Law Association
- Washington Area Lawyers for the Arts

INSIGHTS

Thomas regularly makes presentations and conducts workshops for his clients on the basic principles involved in the use and protection of trademarks, copyrights, trade secrets and domain names.

Publications

Subscribed, sealed, delivered: The rise of the subscription box retail model

16 December 2019

By paying a regular fee, subscribers receive a recurring delivery of products, often picked at random for the customer by the supplier. The convenience of these boxes appearing on the doorstep, coupled with the "reward uncertainty" for what might be in the box, can be a powerful strategy for keeping consumers engaged with brands.

Surviving a trademark opposition challenge: do you have a true "intent-to-use"? 5 key tips

10 SEP 2014

Two precedential decisions from the TTAB

- Co-author, "5 Tips For Surviving A Trademark Opposition Challenge," *Law 360*, December 23, 2014

Events

- Presenter "Getting Your Franchise Rocket Ready to Launch," FranConnection 2012, National Harbor, Maryland (May 2012)

NEWS

36 DLA Piper lawyers in 11 countries ranked among *The World's Leading Trademark Professionals*

24 February 2021

World Trademark Review 1000: The World's Leading Trademark Professionals has named 36 DLA Piper lawyers from 11 countries to its 2021 list of top trademark professionals.

PRO BONO

In 2008, Thomas was appointed to the board of directors of Washington Area Lawyers for the Arts, whose legal services program supports artistic expression and creative innovation in the arts and cultural communities of Washington, DC, Maryland and Virginia. In 2009, WALA recognized him with its Stewardship Excellence Award for his work re-establishing and running its monthly legal advice clinics.