



Edward T. Colbert

Partner

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Edward has over 30 years of experience handling litigation, licensing and other adversarial proceedings concerning all aspects of intellectual property, including patents, trademarks and copyrights, false advertising, unfair competition and trade secrets.

Edward's comfort and skill in the courtroom have enabled him to successfully represent banks and financial services companies, electronic/Internet commerce providers and entertainment companies, as well as manufacturers of medical devices and products, basic chemicals, petroleum products, and general consumer merchandise supply companies, including those in the apparel, food and beverage businesses.

Edward is recognized as a leading lawyer in *World Trademark Review 1000*, which says that "he can be trusted to do an 'outstanding job' in matters 'where strategy and results matter,'" and has received recognition from the *Legal 500 United States (2016-2018)*. In addition, he has been selected as a *Washington DC Super Lawyer (2016-2018)* for intellectual property law and was named a Washington, DC "IP Star" by *Managing Intellectual Property*.

Managing Intellectual Property also recognizes him as a veteran trademark lawyer, whom clients describe as a “top quality litigator.” Edward was named by *SmartCEO* magazine as a 2013 Washington “Power Player” in Intellectual Property law.

Edward has significant experience in domestic and international intellectual property licensing and acquisitions, and manages the trademark portfolios of leading retailers, companies and organizations worldwide. For example:

- He helped create and shape the United States Olympic Committee licensing program and was involved in the licensing and enforcement of Olympic marketing rights in the United States and certain related worldwide rights for the five Olympic Games and United States Olympic Teams.
- He served as chief trademark advisor in the launch of the Home Shopping Network and Martha Stewart Online and retail catalog operations.
- He has represented clients in due diligence reviews, negotiations and acquisition of numerous diverse properties, from search engine Ask.com to Stolichnaya vodka and Modelo beer.
- He provides pro bono representation to the Special Olympics in connection with maintenance and management of its worldwide trademark and licensing rights portfolio.

Edward is regularly hired as trademark counsel in actions involving famous brands and marks, and has significant copyright infringement experience. For example:

- When the Russian government brought suit in the United States seeking to obtain ownership of the STOLICHNAYA trademark, he secured a dismissal of the claim on behalf of its owner, Allied Domecq, in *Federal Treasury Enterprise Sojuzpolodoimport, et al. v. Spirits International, et al.*, 425 F. Supp. 2d 458 (S.D.N.Y. 2006).
- Edward also represented the United States Olympic Committee in developing and enforcing its exclusivity in commercial uses of Olympic terminology, culminating in representation of the Olympic Committee in *USOC v. San Francisco Arts & Athletics*, which was argued to the Supreme Court and confirmed the control of the USOC over Olympic marketing in the United States. (483 U.S. 522, 1987).

- In one of the first of the “portal wars,” Edward represented AT&T Corp. in *America Online, Inc. v. AT&T Corp.*, 64 F. Supp. 2d 549 (E.D. Va. 1999), in which he helped AT&T successfully defend against trademark infringement claims by winning a ruling on summary judgment that “you have mail” is generic.
- He won a major victory for start-up client Pintrips, protecting the company against a trademark infringement suit filed by social-media giant Pinterest Inc. In the judgment and decision issued after a 7 day trial, U.S. District Judge Haywood Gilliam Jr. ruled that Pinterest did not own or control the use of the word “pin” in the Internet space despite the registrations for “PIN” owned by Pinterest. Pintrips use of “pin” was held to be a fair use under the Lanham Act based on the term’s origin and broad use in electronic communication. The Court also held that trademark PINTRIPS did not infringe on the trademark PINTEREST. Pinterest did not appeal.
- He represented Maker’s Mark Distillery Inc. in a high-stakes battle for protection of its red wax neck coating trademark. The U.S. Sixth Circuit Court of Appeals held that a three dimensional physical attribute of packaging (the irregular red wax coating on the neck of the Maker’s Mark bottle) was capable of being a trademark, and did in fact function as a trademark, even though not a traditional work of two dimensional design. (3:09-cv-718 and 3:03-cv-00093, W.D.Ky.)
- He cleared the way for Constellation Brands and its subsidiary, Spirits Marque One, to proceed with a multi-million dollar advertising campaign for its brand SVEDKA vodka, by defending against the copyright claims brought by a well-known Hollywood photographer, concerning the use of a photograph. (CV 10-07175 ODW, C.D. CA).
- He defended against a claim by a computer program designer that the plaintiff, rather than his employer, owned the hedge fund program used to trade over a hundred million dollars a day. The issue of the validity of the IP ownership provision of the contract was a cutting edge decision that required a stay at the Third Circuit, while the question was reviewed by the Pennsylvania Supreme Court. (3rd Cir. PA, 05-1119).

Edward is active in bar association work, particularly the International Trademark Association where he serves as a mediator on the CPR Panel of Distinguished Neutrals. He is also a member of AIPLA, and the American Bar Association Sections on Intellectual Property and on Antitrust, and has also served as Chairman of the Sports and Entertainment Industries Committee.

He has also been active in the Maryland State Bar Association and participated on the steering committee to create an intellectual property committee for the Business Law Section. He currently serves as an arbitrator on the International Court of Arbitration for Sport in Lausanne, Switzerland and for the American Arbitration Association.

Edward regularly presents articles, programs and speeches about a wide variety of topics, including trademark dilution, cybersquatting, extension of copyrights in collective works, copyright parodies, the use of surveys in consumer cases, trademark registration rights under foreign conventions, concerted refusals to deal, and market definitions in a variety of markets including general retail and entertainment industries.

Edward began his career as a law clerk to the Honorable Herbert S. Boreman in the United States Court of Appeals for the Fourth Circuit.

Representative Experience

- *Melva Leona Vallery v. American Girl, LLC*, 2:13cv05066 (E.D. LA 2015), *aff'd* 15-30472 (5th Circuit 2017)
- *Pinterest Inc. v. Pintrips Inc.*, 313cv04608 (N.D. CA 2015)
- *Fishman Transducers, Inc. v. Stephen Paul D/B/A Esteban, Daystar Productions, and HSN Interactive LLC*, 07cv10071 (D. MA 2011), *aff'd* 11-1663 (1stCircuit 2012)
- *Jim Beam Brands Co. v. Tequila Cuervo La Rojeña S.A. de C.V.*, 08cv600122 (NY Supreme 2011)
- *Brennan v. Brennan*, 2:00cv2413 (E.D. LA 2002), *aff'd* 03-30470 (5th Circuit 2004)
- *Maker's Mark v. Diageo*, 03cv93 (W.D. KY 2010), *aff'd* 10-5508/5586/5819 (6thCircuit 2012)
- *Fleming v. CVS Caremark Corporation*, 7:09cv2462 (N.D. AL 2012), *aff'd* 13-11954 (11thCircuit 2013)
- *Charles White v. Constellation Brands, Inc., et al.*, 2:10cv07175 (C.D. CA 2011)
- *Tequila Cuervo La Rojeña S.A. de C.V. v. Jim Beam Brands Co.*, 10cv0203 (S.D. NY 2011)

- *Univision Radio, Inc. v. Texas CBS Radio Broadcasting, L.P. v. Educational Media Foundation* (PTO 2010)
 - *Zimmer v. CooperNeff Advisors, Inc.*, 2:04cv03816RK (E.D. PA 2010)
 - *The Pilot Corporation of America, Inc. v. Fisher-Price, Inc.*, 3:04cv00977 (D.CT. 2008)
 - *Federal Treasury Enterprise Sojuzplodoimport, et al. v. Spirits International NV, et al.* (S.D. NY 2011), aff'd 11-4109 (2nd Circuit 2013); certiorari denied, (2014)
 - *On-Line Tech Inc. v. Perkin-Elmer Corp., et al.*, 3:99cv02146 (D. Conn. 2006)
 - *Frey v. Allied Domecq*, 2:2005cv05216 (C.D.CA 2005)
 - *Simon Systems, Inc. v. LSI Logic*, 8:02cv4168 (D. MD 2004)
 - *Hispanic Broadcasting Corp., et al. v. Educational Media Foundation*, 2:02cv07134 (C.D. Cal. 2003)
 - *Scimed Life Systems and Medinol Ltd. v. Johnson & Johnson*, 1:99cv00904 (D. DE 2004)
 - *America Online, Inc. v. AT&T Corp.*, 98cv01821 (E.D. VA 2001)
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Memberships

- Arbitrator for the International Court of Arbitration for Sport in Lausanne Switzerland and for the American Arbitration Association
 - Fellow of the Litigation Counsel of America
 - Member of the Intellectual Property section and the Antitrust Section of the American Bar Association
 - The INTA Panel of Distinguished Neutrals
 - The International Trademark Association
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Awards & Recognition

- Recognized as a Washington, DC Super Lawyer in Intellectual Property Litigation, *Super Lawyers* by *Thomson Reuters* (published in *Washington Lawyer* magazine) (2007-2018)
- Profiled as one of the leading Copyright (2013-2015, 2018), Trademark Litigation (2013-2018), Trademark Non-Contentious (2013-2018), Patent Litigation (2017), Patents: Licensing (2017, 2018) and Patents: Prosecution (2017) lawyers in the United States, *The US Legal 500*
- Named an “IP Star” in Washington, DC (2013, 2014), a “Patent Star” in Washington, DC (2016-2018), and a “Trademark Star” in Washington, DC (2016-2018) in the *IP Stars Handbook* published by *Managing Intellectual Property*
- Recognized as a “Top Five Lawyer” in the D.C. Metro area for trademark enforcement and litigation (2016), *World Trademark 1000* (2016)
- Recognized as a Leading National Litigator (2012, 2018, 2019), a Leading Trademark Professional (2012-2015, 2017-2019) and a Top Litigation Partner (2016), *World Trademark Review 1000*
- Named as a 2013 Washington “Power Player” in Intellectual Property law, *SmartCEO* magazine

Insights

Alerts

Give Me a ©!: Supreme Court Holds that Copyright Protects Decorative Elements of Useful Articles, March 24, 2017

Copyright Office Promulgates New Regulations for Designation of Registered Agent Under the Digital Millennium Copyright Act, November 10, 2016

Supreme Court Rules TTAB Findings May Have Preclusive Effect on Article III Court Decisions, March 24, 2015

SERVICES

Industries

Food Industry

Hospitality

Retail and Consumer Products

Retail

Consumer Products

Practices

Advertising and Marketing Compliance and Regulatory Counseling

Advertising and Marketing Litigation

Corporate Governance and Board Advisory

Arbitration and Mediation

Issues and Appeals

Retail and Consumer Products Litigation

Class Action, Multidistrict Litigation

International Arbitration and Transnational Litigation

Rocket Docket Practice (US District Court for the Eastern District of Virginia)

Mergers and Acquisitions

North America

Intellectual Property

Copyright Counseling and Litigation

Intellectual Property and Technology Transactions

Patent Litigation

Trade Secrets Counseling and Litigation

Trademark – Non-Contentious

Trademark Proceedings

Litigation

EDUCATION

JD, University of Maryland School of Law, *with honors, Maryland Law Review*, 1972

AB, University of Maryland, 1970

BAR ADMISSIONS

District of Columbia

New York

Maryland

COURT ADMISSIONS

US Supreme Court

US Court of Appeals, First Circuit

US Court of Appeals, Second Circuit

US Court of Appeals, Third Circuit

US Court of Appeals, Fourth Circuit

US Court of Appeals, Fifth Circuit

US Court of Appeals, Sixth Circuit

US Court of Appeals, Seventh Circuit

US Court of Appeals, Ninth Circuit

US Court of Appeals, Tenth Circuit

US Court of Appeals, Eleventh Circuit

US Court of Appeals, District of Columbia Circuit

US Court of Appeals, Federal Circuit

US District Court, District of Columbia

US District Court, Northern District of California

US District Court, District of Maryland

US District Court, Northern District of New York

US District Court, Northern District of Illinois

US Court of Federal Claims

NEWS

Hunton Andrews Kurth Secures Appellate Victory for DISH Network, LLC, August 16, 2018

Andrews Kurth Kenyon Receives High Marks from *World Trademark Review 1000 2018*, January 29, 2018

Mentioned in “Vodka Maker Can’t Get A Jury In TM Suit Against Beam,” *Law360*, November 7, 2017

Andrews Kurth Kenyon Elects 2017-2018 Policy Committee, October 17, 2017

Andrews Kurth Kenyon Recognized in 2017 Edition of *IP Stars Handbook* Published by *Managing Intellectual Property*, June 14, 2017

The 2017 *Legal 500 Guide* Ranks Andrews Kurth Kenyon in 22 Practice Areas, June 5, 2017

Andrews Kurth Kenyon Lawyers Named in Washington, DC Super Lawyers and Rising Stars 2017, April 24, 2017

Andrews Kurth Kenyon Receives High Marks from *World Trademark Review 1000 2017*, February 1, 2017

Andrews Kurth Celebrates 114 Year Anniversary and Adds 55 Attorneys from Kenyon & Kenyon, September 26, 2016

Kenyon Managing Partner Instrumental in Bringing Baseball and Softball Back to Olympics, August 4, 2016

Kenyon Wins Trademark Infringement Case On Behalf of Start-Up Client Pintrips, October 23, 2015

Quoted in “Pinterest Loses Trademark Suit Over ‘Pin’ Marks,” *Law360*, October 21, 2015

Quoted in “Kenyon & Kenyon Partner Tapped for PTAB Judge Post,” *Law360*, October 16, 2015

Featured in “Kenyon Leader Takes Helm at Time of Transition,” *New York Law Journal*, September 24, 2015

Featured in “Kenyon & Kenyon Elects Stephen Colbert’s Brother as Managing Partner,” *Bloomberg BNA*, September 23, 2015

Featured in “Colbert Takes the Stage - As Kenyon & Kenyon Managing Partner,” *The American Lawyer*, September 22, 2015

Quoted in “Second Circuit Chills Russia’s Stolichnaya Trademark,” *The AMLaw Litigation Daily*, August 6, 2015

Quoted in “Stephen Colbert’s Brother Might Save International Baseball,”
The Daily Beast, February 5, 2015

Mentioned in “WBSC appoints Kenyon & Kenyon’s Colbert as General
Counsel,” *Around The Rings*, February 4, 2015

Mentioned in “Kenyon Gets Role in Baseball-Softball Olympic Bid,” *USA
Today*, February 3, 2015

Quoted in “Mattel Defeats Copyright Claim in ‘Princess Charm School’ IP
Suit,” *Law360*, June 21, 2013

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