



Joseph V. Mauch

PARTNER

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AREAS OF EXPERTISE

Litigation, Intellectual Property, Trademarks, Copyrights, Patents, Trade Secrets

Overview

Mr. Mauch is a partner in the Litigation Department. He has over ten years of experience in a number of areas of business litigation, with a particular focus on intellectual property litigation. He has extensive experience in state and federal court, as well as private arbitration. His practice also focuses on counseling clients in a variety of industries on intellectual property rights and best practices, including in relation to trademark and copyright portfolios, brand protection, and doing business online. He has worked with clients ranging from large public companies to small start-ups to individuals.

Experience

Mr. Mauch's recent work includes:

Trademark

- Achieving a preliminary injunction in a trade dress infringement action in the Northern District of California that lead to a favorable settlement.
- Responding to U.S. Patent and Trademark Office (USPTO) office actions to secure trademark registration for clients in numerous industries, including medical devices, financial services, and software-as-a-service.
- Prosecuting and defending a variety of trademark opposition and cancellation proceedings in front of the USPTO's Trademark Trial and Appeal Board for clients that included a winemaker, a developer of a popular smartphone app, and a manufacturer of gluten-free food products.
- Achieving a decision that a trademark application was not likely to be confused with existing registrations owned by a large company after a full trademark opposition proceeding with oral hearing.
- Securing a default judgment against a trademark infringer that required transfer of the infringing domain name and social media platform user names.
- Successfully protecting a start-up company's trademark after receipt of a cease-and-desist letter from an established competitor.

Copyright

- Advising small and large companies on proper use of copyrighted images.
- Forcing a blogger to remove infringing photographs owned by an auction house.
- Representing a public company in the construction industry regarding infringement of copyrighted product catalogs.

Patent

- Securing a judgment of over \$3 million for breach of contract and patent infringement in the Northern District of California.
- Achieving a preliminary injunction in a utility and design patent infringement action in the Northern District of California that lead to a favorable settlement.
- Defeating a preliminary injunction motion brought by a competitor in a utility patent infringement action in the Northern District of California.
- Securing a favorable settlement for the patent owner in an infringement action in the Middle District of Florida
- Acting as local counsel in high stakes patent litigation involving consumer electronics and smartphones in the Northern District of California

Trade Secrets, False Advertising, and Unfair Competition

- Stopping a former executive in the healthcare industry from breaching his fiduciary duties and using company trade secrets to establish a competing company.
- Filing a complaint for violation of the federal Defend Trade Secrets Act against a competitor and the client's former leader engineer that survived a motion to dismiss
- Defending a public healthcare company in arbitrations and a state court action against competitors alleging various claims related to misappropriation of confidential information and unfair competition.

Other

- Securing favorable settlements in a series of breach of contract disputes for a client in the construction industry.
- Securing a favorable settlement for a foreign national telephone company in an international arbitration against a large U.S. telecommunications company.
- Acting as second chair at a judicial reference bench trial in the successful defense of a large municipality against nondisclosure claims related to the sale of a commercial real estate project.
- Acting as "outside general counsel" assisting a food and beverage company and SAAS company with all of their litigation and potential litigation matters.

Publications/Speaking

Presentation, "How to Win a Trade Dress Case After Apple v. Samsung (2018 Update)," California Lawyers Association, Litigation Section, March 2018

Presentation, "How to Win a Trade Dress Case After Apple v. Samsung," San Francisco Intellectual Property Law Association (SFIPLA), December 2016

5.18.20 / Media

[Hurricane Protection Straps Suit Blown Out Of Court](#)

2.24.20 / Articles

[On Trademarks](#)

11.16.18 / Media

[National Exclusive: Former Sen. Barbara Boxer's Son and California Powerbroker Found Bilking Indian Tribe](#)

5.1.17 / Articles

[On Trademarks - Infringement and Social Media](#)

9.1.15 / Articles

[On Trademarks](#)

5.25.15 / Articles

TTAB Determination of Likelihood of Confusion May Have Preclusive Effect

Professional Activities

Mr. Mauch is a member of the Bar Association of San Francisco, the Association of Business Trial Lawyers, and the San Francisco Intellectual Property Lawyers Association.

He is also a member of the International Trademark Association (INTA), where he has acted in a leadership position on the Enforcement Committee, the Internet Committee, and a task force working on ways to address online trademark infringement.

Mr. Mauch has also taught a segment on taking and defending depositions in a Litigation Skills course at Stanford Law School and been a regular guest presenter in an Intellectual Property course at the University of California, Hastings College of the Law.

Education

Santa Clara University

B.A. in English, *magna cum laude*, 1999

University of North Carolina at Chapel Hill

M.A. in Comparative Literature, 2003

University of California,

Hastings College of the Law

J.D., *cum laude*, 2007

Admissions

California State Bar

All California State Courts

U.S. District Court for the Northern, Central and Southern Districts of California

U.S. District Court of Nevada

U.S. District Court for the Middle District of Florida

Ninth Circuit Court of Appeals

Accolades

Super Lawyers "Rising Star" in Northern California in 2013-2017

Hastings College of the Law Thurston Society

Witkin and CALI award for excellence in Civil Procedure, Constitutional Law, and Islamic Law

