



*I believe that my clients appreciate not only my legal skills but that I am their faithful ally, authentic and personalized in my approach, responsive to their needs within or beyond my areas of practice, and clear in my communications.*

**PRACTICE FOCUS**

Matthew Asbell assists clients in clearing, obtaining, enforcing, and defending trademark rights in the United States and throughout the world. He also provides advice on patents, copyrights, domain names, and other related areas. With prior background in the entertainment industry, information technology, and medicine, he is comfortable working with a wide range of clients in diverse industries. In addition, his certifications as a Social Media Strategist and software Master Instructor equip him to handle complex intellectual property matters arising in the Web 2.0 space.

Matthew frequently collaborates on and authors articles on intellectual property on subjects ranging from social media and domain names to licensing, branding, and information technology. He is an active speaker and lecturer and is a frequent moderator and panelist at ABA, INTA, and other conferences. He has been an adjunct professor of law at Fordham University, The Benjamin N. Cardozo School of Law, and Columbia University. Matthew co-produced a series of 5 informational videos for the American Bar Association that illustrate intellectual property rights in different settings.

Matthew received his B.S. in Psychology with a minor in Music Composition from Carnegie Mellon University and attended the Medical College of Pennsylvania, (now part of Drexel University). He received his J.D. from the Benjamin N. Cardozo School of Law, where he was president of the Intellectual Property Law Society and Acquisitions Editor of the top-ranked Cardozo Arts and Entertainment Law Journal. As an active alumnus, he serves on the Alumni Executive Committee, chairs the Alumni Intellectual Property Practice Group, and mentors numerous young attorneys and law students.

Prior to becoming a lawyer, he managed emerging singer-songwriters and recording artists, trained corporate employees of a pharmaceutical company to use software applications, and studied medicine. Matthew's passion for his work in intellectual property arises from a deep appreciation for creativity, whether in the form of invention, design, expression, or marketing. He regularly applies his love of technology, language, and culture.

Outside of work, Matthew, a native of Philadelphia, enjoys spending time with his wife, a Brazilian staff member of the United Nations, and their twin children. His interests range from music (including songwriting, piano, guitar, and percussion), cooking, SCUBA diving, and martial arts.

**SPEAKING ENGAGEMENTS**

- "Reexamining Reexamination (and Expungement): A Practitioner's Guide to the Early Days of Ex Parte TMA Proceedings", Intellectual Property Law Spring Conference, April 2022
- "U.S. Trademark Law Developments," *Emily C. & John E. Hansen Intellectual Property Institute at Fordham Law School*, April 2022 (Moderator)
- "Mobile Apps: Navigating Intellectual Property, Data Privacy, and Cybersecurity," *Strafford*, October 2020 (Presenter)
- "Temporary Non-Use of Trademarks in the Age of COVID," *American Bar Association Section of Intellectual Property Law*, August 2020 (Presenter)
- "Global Search and Trademark Filing Strategies Post-Madrid," *24<sup>th</sup> Annual Intellectual Property Law: The Year in Review, Law Society of Ontario*, January 2020 (Speaker)
- "The Madrid Protocol: Practical Strategies to Filing a 'Universal Application'...or Not, Panelist, Canada's New Trademark Regime: The Practical, Tactical Guide to Navigating the Sweeping Changes," *Osgoode Professional Development Centre*, April 2019 (Speaker)
- "Fundamentals of U.S. Intellectual Property Law," *Centro de Estudios Garrigues, Fordham University*, May 2019 (Speaker)
- "Building and Protecting Your Brand in a New Media Environment," *Korea Trade-Investment Promotion Agency (KOTRA)*, May 2019 (Speaker)
- "On the Mark Advising: An Insider's Perspective," *American Bar Association Section of Intellectual Property Law 34<sup>th</sup> Annual IP Law Conference*, April 2019 (Moderator)
- "Making Section 2(f) Claims: Demonstrating Acquired Distinctiveness," *Strafford*, November 2018

**MATTHEW D. ASBELL**

Principal, New York  
 Pronouns: He/Him/His

**PRACTICE AREAS**

- FinTech Practice Group
- Hospitality
- Intellectual Property
- International Practice

**ACTIVITIES**

- Co-Chair, Intellectual Property Alumni Practice Group, Benjamin N. Cardozo School of Law
- Events/Programming Committee, OK Women LEAD Initiative
- Education/Programming/Awareness Committee, OK R.I.S.E. Diversity Initiative
- European American Chamber of Commerce, NY Chapter
- International Trademark Association (INTA), Member of the Leadership Committee
- American Bar Association (ABA), Section of Intellectual Property Law, Member of the CLE Board & Vice-Chair of the Trademark USPTO Practice and Policy Committee
- New York State Bar Association (NYSBA)
- Intellectual Property Section New York County Lawyers Association (NYCLA)

- New York Intellectual Property Lawyers Association (NYIPLA)
- Association of the Bar of the City of New York
- Adjunct Professor, Cardozo Law School, Intellectual Property Externship Seminar
- Adjunct Professor, Fordham Law School, Counseling and Advocacy for the Intellectual Property and Information Technology Client

(Presenter)

- "6<sup>th</sup> Annual ABA-IPL Trademark Day: Getting to Know the USPTO," *the United States Patent and Trademark Office*, September 2018 (Speaker)
- "Intellectual Property for the Modern, Multi-National Business," *Benjamin N. Cardozo School of Law*, July 2018 (Presenter)
- "Intellectual Property Overview, Summer Institute," *Fordham University School of Law*, July 2018 (Presenter)
- "Fraud in Trademark Applications and Registrations: Proving or Defeating Allegations," *Stratford*, March 2018 (Presenter)
- "Personal Names as Fashion Brands," *New York Law School IP Lunch*, March 2018 (Presenter)

\*Other speaking engagements available upon request.

## PUBLICATIONS

- "The USPTO Has Enacted the Trademark Modernization Act: But Now What?", *Landslide*, Vol. 14, No. 4, June/July 2022 (Co-Author)
- IP Fridays, Episode 119: *Rise of Mass Trademark Filers and Register Clutter – Interview with Matthew D. Asbell*, May, 28, 2021
- "Pan-demic, Pan-cakes, Pan- (inclusion)," *Medium.com*, February 2021 (Author)
- "Warning: New Third Party Solicitations of U.S. Registered Trademark Owners Falsely Represent Registration Date to Gain Early Payment for Maintenance and Renewal," *Lexology.com & others*, May 2019 (Author)
- "Medical Device Trademarks, IP Strategies for Medical Devices: Be Your Own Incubator," *American Bar Association*, October 2018 (Author)
- "TTAB Decision Underscored Difficulty of Proving Fraud Before USPTO," *World Trademark Review*, June 2018 (Author)
- "So, Your U.S. Trademark Registration Is Being Audited," *com, Lexology.com & others*, January 2018 (Author)
- "The Designer Formerly Known As...Intellectual Property Issues Arising From Personal Names As Fashion Brands, Trademark Reporter," *International Trademark Association*, November/December 2017 (Author)
- "Registering a European Trademark (EUTM)," *Practice Note, Practical Law*, November 2017 (Author)
- "Technology Evolution in the Media Industry Supported by Pilot Program Allowing U.S. Trademark Registrations to be Updated," *Media Law International*, September/October 2017 (Author)
- "Generic Top Level Domains May Not Be Generic," *World Trademark Review*, October 2017 (Author)
- "Cheerios Yellow Box Rejected for Trademark Registration," *World Trademark Review*, September 2017 (Author)
- "Under the 2ea: TTAB holds LITTLE MERMAID merely descriptive for dolls," *World Trademark Review*, July 2017 (Author)
- "It Started with a Mouse: TTAB Reverses Refusal of Application by Me and the Mouse Travel," *World Trademark Review*, June 2017
- "Evaluating The USPTO's Efforts To Clean Up The U.S. Trademark Register," *Practical Law*, February 2017 (Author)
- "The Designer Formerly Known As...Intellectual Property Issues Arising From Personal Names As Fashion Brands, Bright Ideas," *Intellectual Property Law Section of the New York State Bar Association*, Spring/Summer 2017 (Author)
- "The Designer Formerly Known As...Intellectual Property Issues Arising From Personal Names As Fashion Brands," *com, Lexology.com & others*, February 2017 (Author)
- "Intellectual Property Resolutions For The C-Suite," *The Licensing Journal*, Vol 37, No. 2, February 2017 (Author)

\*Other publications available upon request.

## CLIENT TESTIMONIALS

*"I've known Matthew for years through bar association events and knew him to always be thoughtful and extremely knowledgeable. When the opportunity came for me to seek expert counsel in trademark matters, I knew to talk to Matthew and his team. He provides high level advice, anticipating where we could stumble and offering innovative solutions every step of the way. He is on top of changes in the law and procedure, and appreciates the need for a business solution to business problems."*

*— Jennifer Chung, General Counsel, Accuweather, Inc. and formerly, Assistant General Counsel, Time, Inc.*

## HONORS

- World's Leading Trademark Professionals (WTR1000):
  - 2021 (noted for "social media, internet and software expertise" and as "a valuable addition to the team")
- World's Leading Trademark Professionals (WTR1000):
  - 2020 (noted for being a "creative problem solver" and named as an "authority on USPTO practice" and is a "strong IP generalist")
- IP Stars - United States & New York, 2014-Present, Managing Intellectual Property Magazine
- 2017 Leaders League: Intelligence Report & Directory Series on Innovation - Technology & Intellectual Property, Highly Recommended (USA Best Law Firms): Trademark Prosecution
- SuperLawyers List, New York, Rising Stars 2013 - 2017
- Rated Superb, Avvo.com. Click [here](#) to review.

*\*The Superlawyers lists are issued by Thomson Reuters. A description of the selection methodology can be found at [http://www.superlawyers.com/about/selection\\_process\\_detail.html](http://www.superlawyers.com/about/selection_process_detail.html). No aspect of this advertisement has been approved by any Court.*

## EDUCATION

- Carnegie Mellon University (B.S., 1993)
- Medical College of Pennsylvania and Hahnemann University School of Medicine (1996-1998)
- Benjamin N. Cardozo School of Law (J.D., 2007)
- Certified Social Media Strategist, Social Media Magic University (2010)

## ADMISSIONS

- New York
- New Jersey
- U.S. Patent and Trademark Office

## AWARDS

