

IP MVP: Sheppard Mullin's Carlo Van Den Bosch

By **Vin Gurrieri**

Law360, New York (November 17, 2015, 12:14 PM ET) -- Sheppard Mullin Richter & Hampton LLP's Carlo F. Van den Bosch this year became the first lawyer in nearly a decade to argue — and win — a trademark case before the U.S. Supreme Court, successfully representing Hana Bank in a dispute involving the use of its name, earning him a spot on Law360's 2015 list of Intellectual Property MVPs.

Van den Bosch, an Orange County, California-based partner in Sheppard Mullin's IP group, convinced each of the justices in January to rule that the application of the semi-obscure doctrine of trademark tacking — which allows a company to slightly tweak a trademark while maintaining the original first-use date — is a factual question that should be dealt with by juries. The ruling resolved a circuit split on whether it is the province of a judge or a jury to decide if the doctrine applies.

Not only was the ruling the first substantive trademark decision by the high court in a decade, it was also the first analysis of tacking principles by the high court in nearly a century.

"I certainly wouldn't have predicted I'd be at the Supreme Court," Van den Bosch says. "It's not something you could ever hope to do as a trademark lawyer because of the infrequency of trademark cases [heard by the court] — but you can hope to do so."

In reflecting on the case, Van den Bosch noted that one aspect that particularly struck him about arguing a matter before the nation's highest court was that it is "a remarkably intimate proceeding."

"You are physically close to the justices and there is a comfortable dialogue that takes place," Van den Bosch says. "It also struck me how incredibly well-prepared the justices were given the time constraints. They got right to the heart of the matter."

The dispute began when Korean firm Hana Financial sued similar sounding Hana Bank for infringement after the latter first announced its plans to open branches in the United States. But the case was tossed after a jury found that Hana Bank could tack the new name onto the priority date of an older, different name — Hana Overseas Korean Club — it had begun using a few years before Hana Financial got started.

MVP



Carlo Van Den Bosch
Sheppard Mullin

Hana Financial took that ruling to the Ninth Circuit and then to the Supreme Court, arguing that juries like the one that ruled in its case against Hana Bank are “not equipped” to handle a complex question that goes beyond a mere comparison of the two marks, and that leaving the question to juries would create inconsistencies in legal precedent.

But in a unanimous opinion penned by Justice Sonya Sotomayor, the high court firmly rejected each of Hana Financials' reasons for why only judges should be in charge of tacking, ruling instead that the technical legal test of whether two “tacked” marks are so similar that consumers “consider both as the same mark” is a test perfectly suited for a jury of regular people.

“The outcome of the case couldn't have [been] better,” Van den Bosch says, while adding that “it remains to be seen” what impact the court's ruling could have on trademark infringement cases involving likelihood of confusion, a key test of how consumers are likely to view an allegedly infringing mark.

Prior to the high court ruling, Van den Bosch had argued two appeals in the case before the Ninth Circuit and acted as Hana Bank's lead trial attorney.

Despite his own role in guiding Hana Bank to victory in the case, Van den Bosch noted that it was actually a team effort, touting “a great team of associates” that he worked with and singling out Sheppard Mullin associate Michelle Wisniewski, whom he says “was there from the beginning” of the decadelong case.

That continuity of representing Hana Bank from the outset of the matter, Van den Bosch says, gave his side an advantage since Hana Financial went through “at least eight sets of lawyers” over the duration of the case.

“The continuity really helped us a great deal — we were very familiar with the case and with the issues,” he says.

The Hana Bank case marked the latest career milestone for Van den Bosch, who was named a Law360 Rising Star in 2010.

A native of Belgium who moved to the United States as a teenager, Van den Bosch was also formerly a co-chair of Sheppard Mullin's IP group for about eight years before stepping aside from the role earlier this year. He has now practiced at the firm for about 20 years, joining as soon as he earned his law degree from the University of Southern California.

“I've been very fortunate in my career. I'm still relatively young, but you can't predict what will happen,” Van den Bosch says, adding that he is “sure they'll be plenty more trials and appeals” in his future.

--Additional reporting by Bill Donahue. Editing by Rebecca Flanagan.

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