

Julia Huston

Partner, Co-Chair, Intellectual Property Department

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Julia Huston is well known for achieving outstanding results for clients in high-stakes intellectual property cases. She is Co-Chair of Foley Hoag LLP's Intellectual Property Department.

Julia provides a full range of services to clients in connection with their valuable intellectual property, with a focus on litigation and strategic counseling. Julia's experience extends to:

- Trademarks
- Copyrights
- False advertising
- Patents
- Defamation and commercial disparagement
- Domain name disputes
- Unfair competition
- Trade secrets
- Licensing and contracts

In the litigation arena, Julia acts as lead counsel in cases before the federal courts, the U.S. Patent and Trademark Office, the U.S. Customs and Border Protection, and the National Advertising Division of the Better Business Bureau. Our clients entrust Julia with enforcing and defending their key intellectual property assets.

A forceful and creative courtroom advocate, Julia has obtained multimillion-dollar judgments and settlements in numerous cases. For example, Julia obtained a \$20.7 million verdict in a case involving the false advertising and commercial disparagement of musical instruments, which Music Trades magazine described as "the largest financial judgment in music industry history." Julia played a significant role in defending a major motion picture company from allegations that its blockbuster film infringed the plaintiff's copyright, thereby defeating a claim for over \$100 million in damages. Julia invalidated a patent for speech recognition software, which not only protected the client from a multi-million dollar claim for damages but also paved the way for the client to develop new technologies that have altered the course of how consumers interact with their electronic devices.

Julia represents clients in fields as diverse as pharmaceutical products, food and beverages, health care, consumer products, electronics, software and hardware, insurance, financial services, energy, education, publishing, and entertainment. Julia's extensive experience in litigation and dispute resolution enables her to build her clients' IP portfolios strategically



INDUSTRIES

Education

Energy & Cleantech

Life Sciences

Technology

PRACTICES

Advertising & Marketing

Entrepreneurial Services

Litigation

Trademark, Copyright & Unfair
Competition

Advertising & Marketing Litigation

Trademark, Copyright & Unfair
Competition Litigation

Intellectual Property Litigation

Patent, Trade Secrets and Related
Rights Litigation

EdTech

Privacy & Data Security

EDUCATION

Boston University School of Law,
J.D., *magna cum laude*, 1992

Harvard University, Ed.M., 1989

Boston University, B.S., *magna cum
laude*, 1987

with an eye toward enforcement and defense in the marketplace.

A frequent author and lecturer on intellectual property topics, Julia's articles have appeared in *World Trademark Review*, *Managing Intellectual Property*, *Intellectual Property Today*, and other prominent publications. Julia has publicly commented on high-profile intellectual property cases for Channel 4 WBZ-TV, Channel 7 WHDH, Fox 25 News, and major metropolitan newspapers.

Julia is particularly well known in the fields of trademark and advertising law. The WTR 1000, an international review of trademark attorneys in which she has consistently earned high rankings, recently stated, "The remarkable Julia Huston manages the set with a steady hand and is a go-to for prestigious trademark owners. Her judicious insight serves clients equally well in both sophisticated prosecution and enforcement. In addition, her leadership and litigation skills are superb. It's easy to resolve a dispute with her because she takes a firm but practical stance. Unlike lawyers who refuse to give a straight answer, she covers all the bases and is direct with her responses."

Julia has held leadership positions in several civic, professional and charitable organizations, and previously served as President of the Boston Bar Association (BBA), President of Greater Boston Legal Services (GBLS) and President of the Women's Bar Association of Massachusetts (WBA). Julia is the immediate past Chair of the Parallel Imports Committee of the International Trademark Association (INTA), which addresses the unauthorized movement of parallel imports, also known as gray market goods, across country borders.

BAR ADMISSIONS

- Massachusetts
- New York

COURT ADMISSIONS

- U.S. Court of Appeals Federal Circuit
- U.S. Court of Appeals First Circuit
- U.S. Court of Appeals Second Circuit
- U.S. District Court for the District of Massachusetts
- U.S. District Court for the Eastern District of New York
- U.S. District Court for the Southern District of New York
- U.S. District Court for the Northern District of New York
- U.S. District Court for the Western District of New York
- U.S. Court of Federal Claims

REPRESENTATIVE EXPERIENCE

Trademarks

- Counsel for major food manufacturer defending a high profile trademark infringement action involving tagline.
- Counsel in lawsuit involving trademarks for software for autonomous vehicles and geolocation mapping technologies.
- Counsel for craft brewery in lawsuit by another brewery alleging trademark

infringement based on product name.

- Counsel for financial services company enforcing rights in famous mark against provider of higher education services.
- Counsel for American college asserting trademark rights against third parties in multiple jurisdictions in Central and South America.
- Counsel for manufacturer of baby food in trademark dispute with competitor regarding product name.
- Counsel for university asserting dilution claims against online education provider using “not” before client’s famous trademark as its own trademark.
- Counsel for maker of blood glucose monitoring devices in trademark dispute with competitor regarding product names.
- Counsel for provider of health care services and medical monitoring devices enforcing trademark rights in house mark in connection with skin moisturizer.
- Counsel for developer of search engine and software for curating and sharing data on social networks in trademark dispute with social media network.
- Counsel for company selecting global name for antibiotic, which involved trademark and regulatory clearance in multiple jurisdictions and ancillary cancellation actions.
- Counsel for owner of famous trademark for clothing defending against genericide challenge in TTAB.
- Counsel for domain name company defending against reverse domain name hijacking claims and related claims brought by media company.
- Counsel for leading coffee shop chain enforcing rights in famous name of beverage against competing chain.
- Counsel for publisher of business documents defending trademark and EULA claims based on use of font names.
- Counsel for hair care company defending against trademark infringement allegations brought by a competitor in multiple jurisdictions worldwide.
- Counsel for educational software and SaaS company in international dispute with European provider of education-related goods and services.
- Counsel for industrial manufacturer asserting famous trademark against generic uses of trademark in the United States and abroad.
- Counsel for leading computer manufacturer defending trademark infringement action by computer distributor and tech support provider in connection with anti-virus software.
- Counsel for statistical computing software company in TTAB trial against provider of software for entity relationship modeling.
- Counsel for maker of portable electric fans in TTAB trial against competitor involving allegations of descriptiveness and mutilation.
- Counsel for security company asserting trademark rights and defending against genericness allegations in connection with account security software.
- Counsel for automotive company obtaining Lever Rule protection against gray market auto parts from U.S. Customs and Border Protection.
- Oversaw numerous takedowns on third party websites involving counterfeit and/or infringing products, including Amazon, Ebay, and Alibaba.

- Testified as expert witness in federal and state court proceedings regarding trademark infringement, trademark assignments and licenses, and intellectual property holding companies.

Trade Dress

- Counsel for OTC consumer products company asserting trade dress in product packaging for fiber supplement against competitor.
- Counsel for company asserting trade dress rights in pattern of non-woven disposable wipes and fabrics.
- Counsel for apparel manufacturer defending against allegations of infringement of allegedly famous trade dress for sneakers.
- Counsel for manufacturer of portable electric fans asserting trade dress rights against competitors.
- Counsel for one of the country's oldest and most historic jewelers asserting trade dress rights in fish-shaped pitcher design.
- Counsel for musical instrument company asserting trade dress rights in product packaging.
- Counsel for pharmaceutical company analyzing its ability to challenge a competitor's claim to exclusive use of a specific color in connection with its product.
- Counsel for automotive company obtaining trade dress registrations for the interior and exterior design of its dealerships.

Copyrights

- Counsel for major movie studio defending copyright claims based on alleged authorship of the main characters and plot lines in a blockbuster film franchise that earned over \$1.8 billion at box offices worldwide.
- Counsel for developers of translation software enforcing copyright and related rights against world's largest privately held language services provider.
- Counsel for diagnostics company seeking to protect and enforce copyright in format of proprietary reports.
- Counsel for software company defending copyrights claims based on the interface screens and menu structure of its CAD software.
- Counsel for cryogenics company accused of infringing copyright in photographs used on website.
- Counsel for owner of widely known blog devoted to fashion and popular culture in trademark dispute with non-profit that provided a fashion blog collateral in connection with its charitable and fundraising activities.
- Counsel for major sports franchise accused of infringing the copyright in a popular song.
- Successfully argued appeals of the U.S. Copyright Office's refusal to register business logos and sculptural works.
- Counseled clients with respect to copyright protection for works as diverse as medical record templates, computer software, cartoon characters, musical recordings, photographs, paintings, religious texts, firms, websites, and multimedia presentations.

False Advertising & Disparagement

- Counsel for major food manufacturer defending against false advertising and disparagement claims in relation to use of preservatives in competitor's products.
- Counsel for client defending NAD action in relation to accused depiction of competitor's products containing non-natural ingredients in an allegedly disparaging manner.
- Counsel for musical instruments company asserting false advertising and disparagement claims against retailers seeking to discourage the purchase of school band instruments at big box stores.
- Counsel for manufacturer of baby food in false advertising dispute regarding advertising claims about ingredients made by competitor.
- Counsel for food manufacturer asserting claims in NAD against comparative advertising based on a consumer taste test.
- Counsel for client defending NAD action based on reliance on USDA Nutrient Database for Standard Reference in advertising sugar content of food products.
- Counsel for major big box retailer chain in challenging competitors' advertisements and responding to competitor challenges.
- Counsel for food company defending against false advertising claims based on comparative advertisements calling out the characteristics of sucralose.

Patents

- Counsel for provider of online language learning products and services asserting patent against competitor in relation to a system and method for teaching foreign languages over a network.
- Counsel for global pharmaceutical manufacturer of anti-anemia drugs defending against claims of patent infringement directed to methods for creating synthetic forms of erythropoietin.
- Counsel for leading speech recognition software company defending against claims of patent infringement for method and system of pattern recognition.
- Counsel for market-leading manufacturer of computer monitors, laptops and tablets in defending claims of patent infringement involving gallium nitride thin film semiconductors.
- Counsel for athletic cleats manufacturer asserting patent directed to cleat locking mechanism against competitors.
- Counsel for athletic cleats manufacturer defending against patent claims directed to golf cleats.
- Counsel for CAD software company defending against patent infringement claims directed to keyboard template.
- Counsel to manufacturer of component parts for computers and other electronic devices asserting patents in DC fans.
- Counsel to designer of baby products asserting patent for rear-facing car mirror against former licensee.
- Counsel for leading software company asserting patent directed to speech recognition system in a non-wireline communications network against competitors.

- Counsel for musical instruments company asserting utility patents for percussion instrument tension member and retail product packaging against competitors.
- Counsel for musical instruments company asserting design patents for the retail packaging for drums against a competitor.
- Counsel for musical instruments company asserting a design patent for a guitar case against a competitor.
- Counsel for consumer products manufacturer asserting patent infringement claims directed to a portable humidifier.
- Counsel for company challenging patents on video games through multiple inter partes reexamination proceedings.

PROFESSIONAL EXPERIENCE

- Taught intellectual property law topics at the MIT Sloan School of Management as a guest lecturer (2010, 2011, 2012).

HONORS & INVOLVEMENT

Honors

- Named as one of the global Top 250 Women in IP by Managing Intellectual Property in IP Stars (2017, 2018/19)
- Named Best Lawyers' Boston Copyright Law Lawyer of the Year (2017)
- Named Best Lawyers' Boston Trademark Law Lawyer of the Year (2015)
- Listed in Best Lawyers in America in the field of Copyright Law and Trademark Law (2015-2019)
- Ranked in top tier of Massachusetts trademark attorneys in World Trademark Review's WTR 1000 Ranking (2011-2017)
- Received Top Women of Law Award and inducted into the Circle of Excellence by Massachusetts Lawyers Weekly (2016)
- Received Women of Justice award from Massachusetts Lawyers Weekly, in partnership with the Women's Bar Association and Massachusetts Association of Women Lawyers (2009)
- Received Lelia Josephine Robinson Award from Boston University School of Law Women's Law Association for exemplary leadership in the community (2008)
- Received Dow-Gardiner-Landrum Award from Greater Boston Legal Services for outstanding commitment to legal services for the poor (2011)
- Named as a "Super Lawyer" in the field of Intellectual Property Litigation, limited to top 5% of attorneys in Massachusetts, numerous years since 2004
- Named as a top 100 lawyer in New England and a top 50 woman lawyer in New England numerous years since 2005

Involvement

- Boston Bar Foundation, Vice-Chair of Grants Committee and Past Trustee
- Boston Bar Association, Past-President
- Greater Boston Legal Services, Past-President

- Equal Justice Coalition of Massachusetts, Past-Chair
- Women's Bar Association of Massachusetts, Past-President and member of Emeritus Board
- International Trademark Association, Immediate Past-Chair of Parallel Imports Committee and member of the Public Information Committee
- Sponsor of Model State Trademark Bill in Massachusetts, which was signed into law in August 2006, on behalf of the International Trademark Association and the Boston Bar Association
- Intellectual Property Owners Association, U.S. Trademark Law Committee, Past Vice-Chair
- First Unitarian Society in Newton, Social Action Committee

PUBLICATIONS

- *Happy Birthday To Me: An Iconic Song Enters The Public Domain After Copyright Settlement*, IP Frontline (October 20, 2016)
- *Op-Ed: Will The National Parks Get Their Trademarks Back?*, National Parks Traveler (September 4, 2016)
- *Liability for Commercial Speech: A Guide to False Advertising, Commercial Disparagement, and Related Claims* (March 2015)
- *Top 5 Reasons To Audit Your Trademark Portfolio In 2013*, IP Law360 (January 24, 2013)
- *IP Clinic: How do I spot and deal with IP scams?*, Managing Intellectual Property (November 2012) (co-contributor)
- *Applicants Beware: The Rising Menace of Trademark Solicitations and Scams*, World Trademark Review (August/September 2012)
- *Trademark Toolkit: Enforcement and Reputation*, World Trademark Review (February/March 2012) (co-contributor with Anthony Rufo)
- *Case Study: Starbucks v. Wolfe's*, IP Law360 (January 13, 2012)
- *Court Orders Identity of BitTorrent Users to Be Revealed in Copyright Case*, IP Frontline, IP & Technology Magazine (November 9, 2011)
- *The Rundown On Reebok's False Ad Settlement*, Privacy & Consumer Protection Law360 (October 12, 2011)

Foley Hoag Alerts and Updates

- SCOTUS Holds Copyright Owners Must Wait For Registration Certificate Before Suing (March 5, 2019)

SPEAKING ENGAGEMENTS

- Moderator, "Ethical Considerations in Conducting Pretext Investigations in the U.S.," International Trademark Association Annual Meeting, Seattle, May 23, 2018
- Panelist, "Parallel Imports in the United States: An interactive discussion and training on the current legal landscape, recent court decisions, and what it all means for the transportation industry," INTA Parallel Imports Committee, New York City, August 29, 2017

- Panelist, "Legal Ethics for In-House Trademark and Copyright Attorneys," Foley Hoag Webinar, August 1, 2017
- Panelist, "False Advertising Law for the Generalist In-House Counsel," Foley Hoag Webinar, June 14, 2017
- Moderator, "Building an Effective Copyright Strategy," Second Annual Trademark & Copyright Summit, New York City, March 16, 2017
- Panelist, "Intellectual Property Law in 2017," New England Corporate Counsel Association, Inc., February 1, 2017
- Panelist, "Intellectual Property Year in Review," Boston Bar Association, January 26, 2017
- Moderator, "Strategies for In-House Counsel Selecting Trademarks for Pharmaceuticals and Biologics," Foley Hoag Webinar, January 25, 2017
- Moderator, "Working with U.S. and European Customs Authorities to Exclude Infringing Imports," Foley Hoag Webinar, September 21, 2016
- Moderator, "Trademarks for the Generalist In House Counsel," Foley Hoag Webinar, July 26, 2016
- Moderator, "Liability for Commercial Speech: A Guide to False Advertising, Commercial Disparagement, and Related Claims," Boston Bar Association, December 18, 2013
- Panelist, "Trademark and Copyright Fair Use," Intellectual Property Owners Association Annual Meeting, Boston, September 16, 2013
- Moderator, "Strategies for Combatting Gray Market Goods in the U.S.," Table Topic Discussion at the International Trademark Association Annual Meeting, Dallas, May 4, 2013
- Panelist, "Parallel Imports and Gray Market Goods Under U.S. Law," International Trademark Association webcast, September 13, 2012
- Co-Facilitator, Roundtable Discussion with Commissioner of Trademarks Deborah Cohn, INTA-USPTO Roundtables, Boston, June 14, 2012 (with Co-Facilitator Craig Morris, USPTO)
- Moderator, "Working With U.S. Customs to Address Parallel Imports," Table Topic Discussion at the International Trademark Association Annual Meeting, Washington, D.C., May 9, 2012
- Moderator, "gTLDs: Status, Process and How is It Working?," International Trademark Association Roundtable, Boston, April 4, 2012
- Panelist, "Intellectual Property Year in Review," Intellectual Property Section of the Boston Bar Association, January 18, 2012
- Moderator, "The Domain Name Deluge: What In-House Counsel Need to Know About ICANNs New gTLD Program," Association of Corporate Counsel (ACC) webinar, December 12, 2011
- Moderator, "Strategies for Conducting a Successful Trademark Audit," Table Topic Discussion at the International Trademark Association Annual Meeting, San Francisco, May 18, 2011
- Panelist, "The Trademark Trial and Appeal Board Comes to Boston," Boston Patent Law Association, April 29, 2011
- Moderator, "You Said What?!? Recognizing When Your Marketing has Crossed the

Line,” Association of Corporate Counsel Annual Meeting, San Antonio, October 26, 2010

- Moderator, “Use and Abuse of Trademarks on the Internet,” Intellectual Property Owners Association Annual Meeting, Atlanta, September 13, 2010
- Panelist, “Intellectual Property Year in Review,” Intellectual Property Section of the Boston Bar Association, January 13, 2010
- Panelist, “Brand Theft: Where Has My Goodwill Gone,” American Bar Association Section of Litigation Annual Conference, Atlanta, April 30, 2009
- Panelist, “Life is Unfair but Competition Shouldn't Be: Red Flags, Fouls, and Other Dangers in a Competitive World,” American Bar Association Committee on Corporate Counsel, Orlando, February 13, 2009