



## Keith Toms

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Food & Beverage | Intellectual Property | IP Litigation | Trademarks & Copyrights | Design, Fashion & Luxury | Sports & Entertainment

*Keith provides his clients with “clued-in counsel and designs sturdy global brand protection and enforcement programmes.” —World Trademark Review 1000*

Keith Toms is a skilled intellectual property attorney with extensive experience helping his clients get the most out of their IP. He makes it a point to understand his clients' business goals so he can provide incisive advice on how to transform their ideas, creativity, and reputation into a sustainable and protectable business advantage.

Keith is an adept IP litigator, with extensive experience enforcing patents, trademarks, and copyrights, both in the federal courts and before administrative bodies, such as the Trademark Trial & Appeal Board. Keith has litigated trademark rights in a variety of contexts, including obtaining an injunction against a client's former U.S. distributor who had claimed rights in a valuable mark, enforcing famous footwear trademarks and trade dress against national retailers, and defending a restaurant's right to use and register its housemark against an aggressive spirits company. Keith has also litigated patents covering numerous technologies, including pharmaceuticals, gene sequencing, computer programs, LED lighting, and sporting equipment, and enforced copyrights against national retail chains.

In addition, Keith regularly counsels clients on optimal strategies for securing and enforcing their trademark portfolios, both in the United States and internationally. He has advised clients on trademark selection and clearance issues in the fields of pharmaceuticals, consumer products, alcoholic beverages, and business consulting, among others. Keith also has experience counseling clients on the issues surrounding rebranding and maintaining and reviving legacy brands.

### Representative Matters

#### Family Inada—Trademark Litigation

Represented a Japanese manufacturer in a trademark ownership dispute with its former U.S. distributor. Distributor had claimed ownership over a critical brand name, which it had used to launch a competing product line. Obtained a Preliminary Injunction in Delaware federal court that prevented former distributor from using the contested trademark, which ultimately lead to a rebrand and favorable settlement.

#### ArcherDX (Invitae)—Patent litigation

Represented biotech company ArcherDX in a jury trial in Delaware federal court. Jury found that European genetic testing company Qiagen willfully infringed a pair of patents owned by ArcherDX and Massachusetts General Hospital, awarding royalties and lost profits totaling about \$4.7 million.

### Boston Intellectual Property Law Association—Bar association branding

As president of the 98-year old Boston Patent Law Association, Keith helped guide the association through an evaluation of whether its branding supported its mission of promoting all forms of intellectual property. While the association had previously voted against changing the BPLA name, Keith developed wide support for the initiative, which culminated in over 90% support for a By-Law amendment to change the name to the Boston Intellectual Property Law Association (BIPLA).

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## Education

Harvard Law School, JD, 2005

Executive Editor, *Harvard Journal of Law & Technology*

Augustana College, BA Philosophy and Political Science, *summa cum laude*, 2002

## Bar Admissions

Massachusetts

## Court Admissions

U.S. Court of Appeals, Federal and First Circuits

U.S. District Court, District of Massachusetts

U.S. District Court, Eastern District of Texas

U.S. District Court, Northern District of Illinois

## Memberships and Certifications

Boston Intellectual Property Law Association  
(formerly, Boston Patent Law Association)  
Immediate Past President

Boston Bar Association

Boston IP Inn of Courts

International Trademark Association

## Recognitions\*

*The Best Lawyers in America*, Litigation–Intellectual Property; Trademark Law, Massachusetts, 2023 and 2024

*World Trademark Review 1000*, Leading Trademark Professional, Massachusetts, 2017–2024

*Massachusetts Super Lawyer*, 2021–2023 Massachusetts Rising Star, *Super Lawyers*, 2008 and 2010–2020

"Toms fulfils the roles of litigation, dispute resolver and counsellor perfectly and is cited by the market for his 'precision, tenacity, intellect and engaging personality.'"—*World Trademark Review 1000*, 2020 Edition

\* No aspect of this or any advertisement has been approved by the Supreme Court of New Jersey. For ranking methodologies, please see [here](#).

## Speaking Engagements

Demand Letters in the Court of Public Opinion, Boston Intellectual Property Law Association, 4.10.2024

Making Connections in Boston's IP Community, Boston Patent Law Association, 11.2.2022

USPTO Stakeholder Listening Session with Director Kathi Vidal, United States Patent and Trademark Office, 5.7.2022

Trademark Trial and Appeal Board Panel, American Intellectual Property Law Association, 5.7.2019

Effectively Managing Brand Transitions—Brand Refreshes, New Brands, and Legacy Phase-Outs, The 2018 Midwest IP Institute, 9.27.2018

PR Nightmare: When Cease and Desist Letters Go Wrong, 2017 Midwest IP Institute, 9.29.2017

Avoiding Pitfalls and Achieving Success in IP Licensing: Software, Music, and Marketing, Boston Patent Law Association, 4.19.2017

Mind the Gap: IP Protection for Software After Alice Corp. v. CLS Bank International, The New England Chapter of the Copyright Society of the United States and the Boston Patent Law Association, 4.13.2017

Mind the Gap: IP Protection for Software After Alice Corp. v. CLS Bank International, The New England Chapter of the Copyright Society of the United States and the Boston Patent Law Association, 4.13.2017

When Demand Letters Go Bad: A Field Guide to Interesting Times, Boston Bar Association, 4.12.2017

The Boston Patent Law Association 2016 Annual Meeting, 12.7.2016

IP for Makers: What You Should Know to Protect Your Creations (And To Protect Yourself From Other People's IP), Artisan's Asylum Speaker Series, 4.26.2016

IP Basics for Startups, McCarter & English Entrepreneurs Series, 3.17.2016

IP Strategies for a 3D Printable World, Boston Bar Association, 4.22.2014

## Quoted

On Trademark Law, US Courts Thinking Beyond Borders, Law360, 9.2.2016

5 Tips To Avoid Stepping On TTAB Landmines, Law360, 5.20.2016