



## Scott M. Douglass

Shareholder

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Scott Douglass advises clients nationwide on high-stakes intellectual property matters, with a focus on trademarks, software, patents, copyrights, and emerging technologies at the forefront of innovation.

Mr. Douglass leverages his litigation acumen, government service, and licensing experience to help clients protect their brands and maximize the value of their intellectual property in both traditional industries and rapidly evolving technology sectors. He is particularly adept at guiding clients through the acquisition, enforcement, and protection of IP rights in areas at the forefront of innovation, including artificial intelligence (AI), software, and other emerging technologies.

Mr. Douglass litigates trademark, trade dress, copyright, utility patent, and design patent claims in federal courts across the country. He represents both rightsholders and accused infringers, handling matters ranging from emergency injunctions to summary judgment motions and the exclusion of opposing experts. His approach is strategic and forward-thinking, advising clients at every stage of litigation – from initial investigation and complaint through discovery and dispositive motions – with a focus on aligning legal strategies with clients' long term business objectives.

Beyond litigation, Mr. Douglass has significant experience structuring and negotiating IP transactions involving cutting-edge technologies. He advises on trademark, copyright, and patent licensing; software and AI agreements; end-user and SaaS licenses; nondisclosure and confidentiality agreements; and IP asset sales. He counsels clients on brand adoption and protection, including managing more than 500 applications and registrations at the U.S. Patent and Trademark Office and enforcing marks before the Trademark Trial and Appeal Board. Mr. Douglass also assists clients with online brand enforcement, DMCA takedowns, and copyright registrations, helping them safeguard their creative works, plan for brand growth, and maximize the value of their intellectual property in the digital age.

Mr. Douglass assists start-ups, small and mid-sized businesses, and publicly traded companies in a diverse array of industries, including supply chain, transportation, and logistics services; construction services; film, television, music, and entertainment; alcohol and spirits; food and restaurants; pharmaceutical products; manufacturing; and professional services, financial services, and retail services. His breadth of experience across multiple forms of intellectual property enables him to advise clients on emerging technologies and developing trends.

Earlier in his career, Mr. Douglass acquired valuable government experience serving for three years as a legislative aide to two United States senators. His portfolio included homeland security, banking, and finance issues. During law school, he clerked for two federal magistrate judges in Tennessee and for the general counsel of one of the largest tobacco companies in the world. Mr. Douglass also studied Arabic in the Middle East and traveled extensively throughout Africa and the Middle East.



## Representative Matters

### Litigation

- Obtained summary judgment of invalidity of a patent asserted against a client for alleged use of products relating to crane and rigging technology.

- Prevailed in a motion to exclude a plaintiff's patent damages expert on the basis that the expert failed to apportion the royalty base and royalty rate on the client's accused products.
- Achieved dismissal of patent infringement claims against a name-brand automotive manufacturer by investigating and identifying a fatal venue issue, all before having to answer the complaint.
- Obtained summary judgment of trademark infringement on behalf of a nationally recognized construction services brand.
- Acquired an injunction against a defendant for trademark infringement, broadly prohibiting the defendant from further use of the client's mark in advertising, domain names, and search engine optimization (SEO).
- Defeated a motion for a temporary restraining order and preliminary injunction against a client in the entertainment and restaurant industry.
- Achieved a favorable settlement on behalf of a restaurant group seeking to enforce contract terms and prevent trademark infringement by a seller who continued using the trademark after a transaction.
- Defeated a motion for a temporary restraining order and preliminary injunction against a music festival client.
- Achieved a favorable settlement after filing a motion for summary judgment on behalf of a client accused of federal trademark infringement by a Fortune 500 company.
- Defended a client against federal trademark infringement claims, resulting in a voluntary nonsuit by the plaintiff.
- Achieved a favorable settlement in a federal trademark infringement suit against an accused infringer who adopted the client's logo for advertising to client's competitors.
- Successfully pursued a motion for sanctions against a defendant in a federal trademark infringement case.
- Achieved a favorable settlement on behalf of a client accused of federal trademark counterfeiting and infringement by a Fortune 500 company.
- Prevailed on a motion to dismiss for a lack of personal jurisdiction on behalf of defendants improperly sued in federal district court.
- Achieved a favorable settlement in a federal trademark infringement suit against a competitor who violated a decade-old settlement agreement.
- Enforced trademark rights and copyrights in a client's nationally recognized brand against multiple defendants who sought to unlawfully use the brand for commercial development.
- Succeeded in taking down more than a dozen infringing domain names under the Uniform Domain-Name Dispute-Resolution Policy (UDRP).

### **Prosecution, Licensing, and Counseling**

- Registered approximately 200 trademarks with the U.S. Patent and Trademark Office.
- Currently managing multiple foreign trademark portfolios.
- Advised a digital health technology start-up on a licensing agreement to deploy the client's on-demand video and software platform in its first commercial environment.
- Created a license arrangement for an AI start-up to acquire access to a legal library to teach and enable the client's generative AI technology.
- Advised a non-profit dedicated to freedom of speech on the interplay of copyrights, trademarks, and contractual obligations.
- Advised a digital printing company on copyright and trademark issues vis-à-vis third-party design platforms and ultimate rightsholders.
- Advised a major research institution on software licensing issues in light of historical contracts.
- Conducted due diligence and advised companies on issues involving trademarks, copyrights, patents, trade secrets, and other aspects of intellectual property in multiple sales, acquisitions, mergers, and other transactions.

- Facilitated multiple trademark licensing deals in a range of industries, including banking and finance, software, food, restaurants, clothing, and retail stores.
- Overcame USPTO actions based on mere descriptiveness, likelihood of confusion, geographic descriptiveness, and other grounds.
- Protected the intellectual property rights and exposure to liability through licensing, non-disclosure, and settlement agreements of brands, products, and inventions for diverse clients.



## Professional Honors & Activities

- Listed in *Chambers USA* as a leading Intellectual Property lawyer in Tennessee (2025)
- Listed in *Best Lawyers: Ones to Watch® in America* for Intellectual Property Law and Litigation: Intellectual Property (2021 – 2023)
- Selected to Mid-South Super Lawyers "Rising Stars" in Intellectual Property (2018 – 2023)
- Participant – Nashville Bar Foundation Leadership Forum (2019 – 2020)
- Member – American Intellectual Property Law Association
- Member – Copyright Society of the South
- Member – International Trademark Association
- Member – Memphis Bar Association
  - Co-chair, Business Law Section (2021 – present)
- Member – Nashville Bar Association
  - Co-chair, Business Law Committee (2019 – 2020)
  - Former Member of Board of Directors, Young Lawyers Division
- Member – Tennessee Bar Association
- Member – Tennessee Intellectual Property Law Association
- Member – Licensing Executives Society
  - Former Chair – Webinar Committee
  - Former Chair – Emerging Enterprises Committee



## Publications

- "The Fast-Moving Race Between Gen-AI and Copyright Law" (July 2024)
- "Re-Considering the Right of Publicity in the World of Generative AI," republished in *IP Watchdog* (July 2024)
- "Don't Forget About NFTs! USPTO and USCO Issue Joint Study on the Interplay Between NFTs and Intellectual Property," republished August 2024, in *The Licensing Journal* (June 2024)
- "The Supreme Court Draws the Line on the Foreign Reach of the Lanham Act" (July 2023)
- Co-author – "Licensing in Bankruptcy," Scott Douglass, Dominic Rota, and Michael Wennerlund, *American Bankruptcy Trustee Journal*, Vol. 38, Issue 2 (Spring 2022)
- Co-author – "Thinking of Rebranding Post-Pandemic? The 'Tacking' Doctrine May Say Otherwise," *Tennessee Bar Journal* (May/June 2021)
- Co-author – "Trademarks + The Significance of Source," *Barista Magazine* (October/November 2019)
- Co-author – "Right Before Remedy – Supreme Court Requires Businesses to Register Their Copyrights Before Enforcement," *Association of Corporate Counsel Tennessee Focus* (First Quarter 2019)
- Co-author – "Cybersecurity and Your Company: Don't Wait Until You've Been Hacked To Get Serious About Security," *Attorney At Law Magazine* (March 2017)



## Speaking Engagements

- "Drafting Ethical Cease and Desist Letters for Trademark and Copyright Infringers," Association of Corporate Counsel Tennessee (2021)

- "'So You Want to Start A . . . ' – Intellectual Property Considerations for the 'Non-Startup' New Business," Nashville Bar Association, Business Law Institute (2020)
- "Ethics & Professionalism in Intellectual Property Law," Tennessee Bar Association, Intellectual Property CLE Blast (2019)
- "Leveraging Tech for Legal," Roundtable Hosted by Evolve Law
- "IP Curriculum," Entrepreneur Center Accelerators (Project Music/1440)
- "Intellectual Property: Nuts and Bolts," National Business Institute, Manufacturing Law Event, Nashville



## Webinars

- The FTC's Proposed Ban on Non-Competes: What We Know and What You Can Expect (February 2023)
- Recent Developments in IP Law (December 2022)



## Education

- Wake Forest University School of Law, J.D., 2012
  - Managing Editor – *Wake Forest Journal of Law & Policy*
- Rhodes College, B.A., 2006, cum laude



## Admissions

- Tennessee, 2012
- District of Columbia, 2023
- U.S. District Court for the Middle District of Tennessee
- U.S. District Court for the Western District of Tennessee
- U.S. District Court for the Eastern District of Tennessee
- U.S. District Court for the Western District of Texas
- U.S. Court of Appeals for the Sixth Circuit
- U.S. Court of Appeals for the Federal Circuit