

Andrew T. O'Connor

Counsel

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Andrew O'Connor's practice focuses primarily on securing and protecting clients' intellectual property rights. With extensive experience in matters concerning patents, design patents, trademarks, trade dress, false advertising, product disparagement, trade secrets and copyrights, Andrew devotes extensive strategic planning and skilled advocating both in and out of the courtroom in order to assist clients with successfully navigating the constantly evolving intellectual property law landscape. Andrew also prosecutes and manages the trademark portfolios of clients before the U.S. Patent and Trademark Office.

Andrew focuses on the broader goals of each client's business model and overall brand, negotiating intellectual property license agreements, corporate mergers and intellectual property asset management projects for a broad array of companies, ranging from entrepreneurs, start-ups and laboratories to Blue Chip multi-national corporations. Andrew's extensive experience in the pharmaceutical, medical device, retail, software and video gaming industries has produced consistent and successful implementation of each individual client's specific goals and interests in highly sophisticated industries. In addition, Andrew is a member of the Goulston & Storrs Professional Liability practice, with experience defending lawyers and law firms in a wide variety of claims of professional misconduct and legal malpractice, with a particular focus on defending against claims involving intellectual property rights.

Andrew is the Chair of the Intellectual Property Litigation Committee of the Massachusetts Bar Association and a frequent speaker and panelist at industry events with judges and other leading members of the IP community, including a recent [Intellectual Property Insights Roundtable](#) hosted by Goulston & Storrs and published in *Massachusetts Lawyers Weekly*. In 2017, Andrew was appointed by the judges of the U.S. District Court for the District of Massachusetts to a committee charged with drafting proposed revisions to the local rules governing patent infringement cases.

Affiliations

- Boston Bar Association
- Massachusetts Bar Association, Chairman, IP Litigation Committee

- Boston Patent Law Association
- Boston IP American Inn of Court, Barrister

Admissions

- Massachusetts
- U.S. Court of Appeals, First Circuit
- U.S. Court of Appeals, Federal Circuit

Education

- Villanova University School of Law (J.D., 2005)
- Boston College (B.A., 1998)

Representative Matters

Claims of Design Patent and Trade Dress Infringement

Representation of client against claims of design patent and trade dress infringement of office supply designs. Successfully dismissed all claims, which was affirmed by the U.S. Court of Appeals for the Federal Circuit.

Claims of Misappropriation of Trade Secrets and Inequitable Conduct

Representing patent attorneys against claims of misappropriation of trade secrets and inequitable conduct, was successful in having the federal court dismiss the plaintiff's claims with prejudice.

Claims of Patent Infringement by a Non-Practicing Entity

Representation of client against claims of patent infringement by a non-practicing entity brought against nearly fifty companies and successfully negotiated the dismissal of all claims without any payment or conditions

Claims of Trademark Infringement and Unfair Competition

Representing a multi-national retail chain, successfully defeated claims of trademark infringement and unfair competition brought by a competitor and obtained award of attorneys' fees, which was affirmed by the U.S. Court of Appeals for the Federal Circuit, and enabled client to continue marketing products under its valuable brand.

Digital Millennium Copyright "Takedown" Enforcement

Representation of an international video game developer in Digital Millennium Copyright "takedown" enforcement and litigation concerning the scope of copyright and trade dress protections for online video game software, server code and website display, and successfully obtaining permanent injunctions and awards of damages and attorneys' fees.

Hatch-Waxman/ANDA Litigation

Representation of client in protecting its patent covering life-saving therapeutic drugs from claims of invalidity in Hatch-Waxman/ANDA litigation and secured an award of client's attorneys' fees, which was affirmed by the U.S. Court of Appeals for the Federal Circuit.

Patent Covering a Popular Over-the-Counter Pharmaceutical

Representing a world-renowned teaching hospital assert its patent covering a popular over-the-counter pharmaceutical against a generic pharmaceutical company, the jury found the patent was valid and willfully infringed, awarding client over \$10 million.

Patent Infringement Litigation Involving 29 Patents and Over 200 Products in a "Rocket Docket" Jurisdiction

Representation of a multi-national corporation in a patent infringement litigation involving 29 patents and over 200 products relating to photocopier technology in a "rocket docket" jurisdiction.

Trademark and Trade Dress Rights Associated With Medical Devices

Representation of client in successfully enforcing the valuable trademark and trade dress rights associated with its medical devices.

Trademark Rights and Brand Recognition

Representation of publishing company in enforcing its valuable trademark rights and brand recognition in litigation that resulted in successfully preventing the launch of a competing line of products from another publisher.

Blog Posts: Retail Law Advisor

This blog keeps you connected to timely developments and emerging issues in retail law and covers a wide range of topics related to the retail, restaurant and consumer industry. We invite you to learn more about Goulston & Storrs and our Retail, Restaurant & Consumer Group.

July 22, 2020

Supreme Court Affirms "Booking.com" Trademark

On June 30, 2020, The Supreme Court of the United States issued its opinion in *United States Patent and Trademark Office v. Booking.com B. V.*, holding that a mark consisting of a generic term combined with ".com" is...

March 5, 2020

An Unintended Interruption to the Global Supply Chain

The current outbreak of COVID-19 (the coronavirus) will be a test of the global supply chain's strength in the face of unintended interruptions, and can be a lesson on building-in supply-chain contingency plans. As a result of COVID-19, many...

September 12, 2019

The Game of Malls. What Is Dead May Never Die.

It's no secret that consumers have been shifting away from shopping at traditional brick-and-mortar stores in favor of shopping online. Nor that the shift in consumers' shopping habits has resulted in a wave of store closures in malls throughout...

August 14, 2019

Are U.S. retailers keeping your data safe?

Sharing limited personal information with retailers has its benefits, including targeted ads, discounts, incentives, and coupons. But at what cost? Do the risks of disclosing your personal information to retailers outweigh the benefits to which time-sensitive consumers have grown...

May 29, 2019

A Hometown Affair: Boston Hosts INTA 2019 Annual Meeting

Last week, members of the Goulston & Storrs intellectual property practice group joined over 11,000 attendees from around the world for the 141 st Annual Meeting of the International Trademark Association (INTA). For us it was a hometown affair...

December 7, 2018

Year-End Trademark Audits Ensure Complete Brand Protection

With the end of the year approaching and the holiday shopping season in full swing, now is an ideal time for brand owners to audit their trademark portfolios. A trademark audit is an excellent tool for ensuring brands are...

October 23, 2018

Protecting the Popular Brand: Considerations to Avoid Genericide

When it comes to trademark registration, there is such a thing as being too popular. Marks such as Aspirin, Fiberglass, Zipper and Flip Phone became so ubiquitous that they were found to be generic—a commonly used name or description...

September 12, 2018

New Massachusetts Trade Secret Laws Effective October 1, 2018

The retail industry closely guards customer and distribution lists, the software and code for the operation of its websites and downloadable mobile apps, and, in many cases, algorithms used to evaluate and monitor sales trends. In many cases, these valuable...

July 18, 2018

A Trademark Licensee's Rights after its Licensor's Bankruptcy May Vary Depending on the Venue of the Bankruptcy Case

In this tumultuous retail climate, a string of recent conflicting court decisions remind retailers that the potential impact of a licensor bankruptcy on a trademark licensee's rights may vary dramatically depending on the location of the licensor's bankruptcy...

June 6, 2018

A World of Trademarks at INTA 2018 Annual Meeting in Seattle

During the week of May 20, 2018, members of the Goulston & Storrs Intellectual Property Group joined over 10,500 attendees from around the world for the 140th Annual Meeting of the International Trademark Association (INTA). Held in Seattle, Washington, the...

November 29, 2017

Supreme Court Removes Patent Litigation from the Heartland of Texas

For years, patent assertion entities have filed patent lawsuits against retailers in federal court in Texas. The Supreme Court's recent decision in TC Heartland LLC v. Kraft Foods Group Brands LLC may give retailers the ability to insist they defend...

April 19, 2017

Supreme Court Says 'Give Me a ©' to the Fashion Industry

A recent U.S. Supreme Court copyright decision analyzing cheerleader uniforms may have a profound impact on retailers, and on the fashion industry in particular. On March 22, 2017, the Supreme Court held in *Star Athletica, L.L.C. v. Varsity Brands*...

June 1, 2016

The Newly Enacted Defend Trade Secrets Act: What Retailers Should Know

On May 11, 2016, President Obama signed into law the Defend Trade Secrets Act of 2016 (the DTSA), creating the first Federal civil cause of action for misappropriation of trade secrets. The DTSA overlaps substantially with, and does not...

May 13, 2015

INTA 2015 Annual Meeting Recap

Last week, members of Goulston & Storrs joined over 9,900 attendees from around the world who converged on San Diego for the 2015 Annual Meeting of the International Trademark Association (INTA). This 137th meeting of INTA was its largest...

February 25, 2015

Recent Guidance on Geographically Descriptive Trademarks May Help Brand Owners

Brand owners frequently adopt geographic terms to describe the origin or a characteristic of goods, such as NANTUCKET NECTARS for beverages from Nantucket and HYDE PARK for high end apparel. They may also adopt such terms to describe the...

Publications

February 22, 2022

The Inevitable Disclosure Doctrine In Employment Litigation: Two Perspectives

Boston Bar Journal

September 9, 2021

Traps for the Unwary

April 7, 2021

Supreme Court Finds Google's Use of Oracle's Java Code in Android Operating System to Be Fair Use

June 15, 2020

Goulston & Storrs Wins Complete Dismissal of Section 11 Class Action Claims Against Sogou and Sohu

June 1, 2020

Employer Beware: Avoiding Fraudulent Unemployment Claims

May 28, 2020

USPTO Grants Further Limited Relief in Light of COVID-19

May 18, 2020

Supreme Court Changes Lucky Brand's Luck in 20-Year Trademark Dispute

March 31, 2020

USPTO Announces Extension of Certain Patent and Trademark-Related Deadlines

July 2, 2019

U.S. Attorney Required for Foreign Trademark Applicants and Registrants, Beginning August 3, 2019

August 2018

Massachusetts Federal Court Warns that IP Practitioners Should Anticipate Potential Conflicts Among Existing Clients

Spring 2018

Is Massachusetts Becoming a Leading Patent Litigation Venue?

ComCom Quarterly

December 2017

U.S. District Court for the District of Massachusetts Seeks Public Comment on Proposed Revisions to Local Patent Rules

June 2017

Intellectual Property Insights Roundtable

February 2017

"Jurisdictional Considerations Involving Intellectual Property," MassBar ComCom Quarterly

February 2014

Federal Circuit Continues its De Novo Review of District Court Patent Claim Construction Rulings

