

TOMASZ ROMAN BARCZYK

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EDUCATION

UNIVERSITY OF CALIFORNIA, BERKELEY, SCHOOL OF LAW – Berkeley, CA

Juris Doctor, Specialization Certification in Law & Technology, May 2016

Journal: *Berkeley Technology Law Journal*: Symposium Editor, Articles Editor

Clinic: Samuelson Law, Technology & Public Policy Clinic: co-authored amicus brief to Second Circuit on behalf of libraries and archives, advocating that recording and indexing copyrighted television content constitutes fair use

Activities: Written & Oral Advocacy: Teacher's Assistant; Comparative Human Rights Law: Research Assistant; California Asylum Representation Clinic: Volunteer Advocate; Patent Law Society: V.P. of External Relations

NORTHWESTERN UNIVERSITY – Evanston, IL

Bachelor of Arts, Psychology (Neuroscience) & Political Science (International Political Economy), June 2011

Honors: Dean's List; Greek Emerging Leader; Kaplan Humanities Scholar; S.A.E. True Gentleman of the Year

Foreign Studies: Institut d'Études Politiques ("Sciences Po") – EU Studies Scholar – Paris, France

EXPERIENCE

TAILORED IP SOLUTIONS – *Principal Attorney* – Chicago, IL / San Francisco, CA

11/2021 – present

- Founded and manage a solo practice, serving primarily as a one-stop-shop for all client legal trademark needs throughout the entirety of the brand development cycle; counsel clients on nuanced issues such as online platform and other third-party liability, IP protection tools offered by e-commerce platforms, gray market goods enforcement, and the ownership and protection of NFTs and AI-created content; advise clients on copyright and other IP and related business matters; negotiate and draft various IP agreements such as licensing, settlement, and coexistence agreements; draft and respond to cease and desist letters involving IP infringement claims
- Created and implemented a system to improve access to intellectual property protection for IP owners by tailoring unique plans for each client based on each client's specific needs, goals, and resources; liaise with marketing experts on the projected performance of candidate marks in promoting brand recognition; nurture client relationships through initiatives such as holding IP training sessions and conducting routine portfolio audits and due diligence analyses as a matter of course; assist clients in creating and implementing internal IP policies for protecting their IP assets and minimizing legal risk
- Cultivate and maintain a global network of foreign counsel to facilitate seamless trademark and copyright services across jurisdictions, as well as collaborate on the development and execution of anti-counterfeiting strategies; collaborate with law enforcement agencies to facilitate the seizure of counterfeit goods and prosecute offenders; conduct market surveillance to identify and monitor counterfeit products in various marketplaces, both online and offline; lead cross-functional teams in the execution of anti-counterfeiting operations, including raids on manufacturing and distribution facilities; advise e-commerce platforms on avoiding liability based on the sale of counterfeit goods by third-party sellers

LEWIS KENT LLP – *Attorney* – San Francisco, CA

08/2020 – 11/2021

- Counseled small to mid-sized clients on securing, enforcing, and transferring IP rights domestically and abroad
- Collaborated with clients to develop targeted and effective IP registration strategies; prosecuted copyright and trademark registration applications, including by drafting effective responses to USPTO office actions; represented clients in opposition and cancellation proceedings before the TTAB
- Monitored third-party trademark usage to identify potential infringement or dilution concerns, and prepared cease-and-desist letters to address potential infringing activities
- Educated clients on proper trademark usage, including best practices for displaying and enforcing their marks

KRONENBERGER ROSENFELD, LLP – *Associate* – San Francisco, CA

02/2018 – 02/2020

- Advised clients on adopting comprehensive branding strategies; managed trademark portfolios through U.S. and foreign clearance, prosecution, monitoring, maintenance, enforcement, and dispute resolution, including

in TTAB proceedings; counseled clients on copyright issues such as ownership, use, enforcement, and DMCA provisions

- Designed and implemented initiative to educate clients on ways to boost probability of successful trademark registration and to encourage monitoring of registered marks; oversaw foreign counsel in trademark and copyright prosecution and enforcement abroad, including by developing novel anti-counterfeiting strategies
- Represented clients in matters involving trademark & right of publicity, copyright, false advertising, UDRP, First Amendment, and business disputes before federal and state courts and administrative bodies; drafted demand letters, pleadings, and dispositive and non-dispositive motions; argued pretrial motions and attended status conferences; spearheaded offensive and responsive discovery efforts; collaborated with experts on conducting trademark distinctiveness and consumer confusion surveys and preparing opinion reports

SAPER LAW OFFICES, LLC – Associate – Chicago, IL

11/2016 – 11/2017

- Counseled clients on IP protection and enforcement strategy; prosecuted trademark and copyright applications; drafted operating agreements and EULAs; reviewed and negotiated IP licensing and employment contracts
- Litigated matters involving intellectual property, privacy, and business disputes; authored cease-and-desist letters, pleadings, pre-trial motions, and discovery requests and responses; prepared deposition and arbitration outlines

U.S. ATTORNEY'S OFFICE, CIVIL DIVISION (N.D. Cal.) – Law Clerk – San José, CA

08/2015 – 12/2015

- Defended federal government entities in litigation, including by authoring several successful 12(b)(2) and 12(b)(6) motions; researched and drafted mediation briefs and legal memoranda analyzing substantive issues in civil matters

SAN FRANCISCO CITY ATTORNEY'S OFFICE – Certified Legal Intern – San Francisco, CA

06/2015 – 08/2015

- Drafted pleadings, motions, and memoranda in civil litigation matters on behalf of the City, County, and State; researched, analyzed, and provided written recommendations regarding litigation strategies and risks

JUDGE JOAN H. LEFKOW, U.S. DISTRICT COURT (N.D. Ill.) – Judicial Extern – Chicago, IL

05/2014 – 08/2014

- Researched substantive and procedural issues involving intellectual property and other legal topics; drafted memoranda and opinions on motions to dismiss, for summary judgment, and for judgment on the pleadings

KIRKLAND & ELLIS LLP – Project Assistant – Chicago, IL

12/2011 – 08/2013

- Worked with attorneys to complete projects at all stages of commercial and intellectual property litigation; prepared and managed witness files, expert materials, and various exhibits; filed documents with court; managed paralegal teams; performed document review; coordinated document productions

ADDITIONAL INFORMATION

STATE BAR ADMISSIONS: California; Illinois

LANGUAGES: Polish (fluent); Spanish (proficient); French (intermediate)

LEADERSHIP POSITIONS: American Bar Association: Anti-Counterfeiting & Piracy Committee - *Vice Chair*; ABA Artificial Intelligence/Machine Learning Task Force – *Member*; Trademark Litigation Committee Case Law Monitoring Subcommittee – *Chair*; Trademark Litigation Committee TTAB Precedential Decision Analysis Subcommittee – *Chair*; Trademark Legislative Committee INFORM Consumers Act Subcommittee – *Chair*

PROFESSIONAL MEMBERSHIPS: American Bar Association; International Trademark Association; Chicago Bar Association; Illinois State Bar Association; Los Angeles Bar Association; Bar Association of San Francisco; Barristers Club of the Bar Association of San Francisco; San Francisco Bay Area Intellectual Property Inn of Court; Lawyers for the Creative Arts

SPEAKING ENGAGEMENTS & PUBLICATIONS: 2023 USPTO Roundtable: Future Strategies in Anti-Counterfeiting and Anti-Piracy – *Panelist*; World Intellectual Property Review Trademarks North America 2022 – *Speaker, Moderator*; World Intellectual Property Review Trademarks Live 2022 – *Speaker, Moderator*; Internet Law Leadership Summit 2019: Use of Surveys in Trademark Litigation – *Speaker*; California Lawyers Association / Continuing Education Bar: INTERNET LAW AND PRACTICE IN CALIFORNIA (2019 Ed.) – *Contributing Author*; LAWYERS' GUIDE TO CAPITAL RAISING (forthcoming) – *Contributing Author*