



EUGENE M. PAK

Director

Intellectual Property
 Business & Finance
 Business Litigation
 Employment & Labor
 Emerging Businesses & Technologies
 Estate Litigation
 Food & Beverage
 Government Relations & Regulatory
 Privacy & Data Security

Oakland

P: 510.834.6600 F: 510.834.1928

epak@fennemorelaw.com

EUGENE M. PAK

An experienced counselor and litigator, Eugene provides strategic advice to his clients in both transactional and litigation matters. He acts as outside general counsel to many of his clients, and specialized intellectual property and litigation counsel to others. Eugene is a trusted advisor and vigorous advocate for his clients, helping them build and protect their businesses and brands, and to structure favorable deals and agreements.

Eugene's clients include apparel companies, food & beverage companies including craft breweries, restaurants and bars, computer gaming companies, technology companies, and many others. He brings a diverse background to his work, having worked at large and small firms, as in-house counsel at a technology company, and at a nonprofit public interest firm.

Intellectual Property Development, Protection and Litigation

For more than fifteen years, Eugene has advised companies in the selection, registration and maintenance of their trademarks and copyrights both domestically and abroad. He serves as Vice-Chair of the Firm's Intellectual Property Group. Eugene has filed or managed thousands of trademark and copyright applications and registrations worldwide. He advises companies with large, well-established international trademark portfolios, as well as newer companies that are just developing their brands. Eugene also represents clients in related areas such as advertising and marketing issues, social media issues, software licensing, website terms of use, privacy policies, DMCA policies and compliance, and trademark licenses and co-existence agreements. Eugene is also an experienced IP litigator, having litigated numerous IP cases and disputes in federal and state courts. His experience includes disputes involving trademarks, trade dress, copyrights, domain names, anti-counterfeiting, patent, trade secrets, and false advertising issues.

Food & Beverage Law, Alcohol Beverage Law, Craft Beer Law

Eugene regularly advises companies in the food and beverage industry. He serves as outside general counsel to many of his clients, advising them on a wide range of issues from entity formation, trademarks and copyrights, distribution and other contracts, employment issues, alcohol beverage (ABC) and labeling regulations, as well as trade regulation issues (marketing and advertising, social media). Eugene frequently speaks on such issues, including at the Brewers Association and California Craft Brewers Association's annual conferences, and has been quoted in Brewbound, All About Beer, The Daily Journal, and other media outlets. He 'tweets' on legal and business issues facing alcohol beverage companies as @beerattorney.

Business Counsel

Eugene is also an experienced business attorney. He has advised companies at all stages from start up formation to mergers and acquisitions. Recently, he advised several breweries in their sale or purchase of other breweries or their assets. He has also represented companies in a wide range of business and commercial matters, including antitrust issues, broker-dealer disputes, class action cases, investment fraud, bid disputes, real estate disputes, unfair competition matters, California Business & Professions Code §17200 claims, and Commerce Clause issues involving state and federal beverage laws and regulations. In the employment law field, he has advised and represented clients in matters involving non-compete agreements, misappropriation of trade secrets, employment discrimination, independent contractor versus employee status, and wage and hour laws. In addition to representing clients in court, he has represented clients in employment disputes before administrative agencies such as the California Labor Commissioner and New York Stock Exchange (arbitration).

EDUCATION

- J.D., University of California, Berkeley, School of Law
- B.A., University of Michigan

AREAS OF PRACTICE

- Intellectual Property
- Business & Finance
- Business Litigation
- Employment & Labor
- Emerging Businesses & Technologies
- Estate Litigation
- Food & Beverage
- Government Relations & Regulatory
- Privacy & Data Security

REPRESENTATIVE MATTERS

- Represented craft beverage company in Series A and Series B investment rounds.
- Advised craft brewery on fundraising and contract brewing issues.
- Advised apparel company in spin-off of textile technology company and joint venture with large textile maker.
- Represented software company in acquisition by major international media company.
- Represented SaaS company in corporate formation and licensing agreements with major financial institutions.
- Advised agricultural and horticultural products company in formation, intellectual property issues, and distribution contracts.
- Advised textile technology company on corporate formation and intellectual property matters.
- Advised craft breweries and other food & beverage companies on distribution contracts and regulatory matters.
- Advised alcohol beverage companies on alcohol beverage licensing and tied-house issues.

Business Transactions

- Represented software company in acquisition by major international media company.
- Represented software company in corporate formation and licensing agreements with major financial institutions.
- Represented craft beverage company in Series A and Series B offerings.
- Advised agricultural and horticultural products company in formation, intellectual property issues, and distribution contracts.
- Advised textile technology company on corporate formation and intellectual property matters.
- Advised craft brewery on fundraising and contract brewing issues.
- Advised craft breweries and other food & beverage companies on distribution contracts and regulatory matter.
- Advised alcohol beverage companies on alcohol beverage licensing and tied-house issues.

Intellectual Property Litigation & Disputes

- Represented craft beverage company in false advertising and labeling action in federal district court.
- Advised cannabis accessories company in trademark enforcement matters.
- Represented natural skin care products company in trademark litigation against competitor.
- Northern California craft brewery as plaintiff in Lanham Act trademark infringement action in federal district court; obtained consent permanent injunction.
- Represent social gaming company in trademark prosecution and dispute matters.
- Represented leading game publisher in several domain name arbitration proceedings (UDRP).
- Represented building developer in copyright infringement action involving architectural drawings.
- Represented television set-top box manufacturer in copyright infringement action involving BusyBox open source software and GNU General Public License (GPLv2).
- Represented a large manufacture of networking hardware and software products in anti-counterfeiting disputes and enforcement efforts.
- Represented leading ATM company in dispute with Korean manufacturer over ownership of trademark (ICDR arbitration).
- Defended office products company in trade secret litigation involving use of customer lists and information; engaged in expedited discovery and successfully limited scope of TRO and injunction.
- Represented lifestyle apparel company in trademark infringement and TTAB cancellation proceeding involving mark and logo.
- Represented a well-known nonprofit organization in trademark and trade dress infringement and dilution action and related design patent infringement counterclaim.

- Counsel for a newswire service in trade secret litigation; obtained a preliminary injunction requiring former employee to cease working for competitor and from using customer information.
- Trial counsel for a jewelry designer in a trade dress infringement action in the Southern District of New York.
- Represented an online document-sharing company in a DMCA dispute regarding copyrighted documents posted by customers.
- Represented a leading Silicon Valley content management software firm in copyright litigation involving the scope of a software license agreement.

Intellectual Property Litigation & Disputes

- Represented a well-known Napa Valley winery in Lanham Act litigation against a Canadian wine kit manufacturer.
- Represented an online document delivery service in class action copyright infringement litigation involving indexing and delivery of copies of print articles.
- Intellectual Property Counseling & Prosecution
- Advise and represent companies on all aspects of trademark prosecution, protection, enforcement and licensing, including clients in the technology, computer game, entertainment, food and beverage, and consumer retail products fields; handled wide range of trademark issues before the Patent and Trademark Office and Trademark Trial and Appeal Board; manage worldwide trademark portfolios and provide strategic branding advice and counsel.
- Advise and represent clients on copyright issues, including registration and enforcement issues, DMCA issues, and copyright licensing, in wide variety of fields; advise clients on right of publicity and privacy issues.
- Advise social gaming company in various intellectual property matters and disputes including trademark prosecution, TTAB proceedings, and copyright counseling.
- Advise and represent a leading Korean apparel company in trademark matters in the United States.
- Serve as intellectual property counsel for a leading manufacturer and distributor of motorcycle parts, clothing and accessories, including handling trademark prosecution and enforcement actions worldwide.
- Advised a leading computer game publisher on worldwide sweepstakes promotion in connection with the FIFA World Cup.
- Negotiated a trademark license agreement relating to distribution and publication of music used in computer games.
- Draft and negotiate license agreements (SLA, SaaS, ASP) for leading GIS mapping and technology provider.
- Worked as in-house counsel for Silicon Valley CRM software company; drafted and negotiated license and business development agreements.
- Advised client on privacy issues and policies for website and customers' websites; negotiated licensing agreement regarding use of large business information database.

Other Litigation

- Represented non-profit organization in quiet title and real estate fraud litigation regarding Koreatown retail shopping plaza.
- Counsel for a leading investment brokerage firm in an employment discrimination class action and related breach of duty of loyalty counterclaim; successfully compelled arbitration to avoid class claims, prevailed on defense of discrimination claim, and obtained damages award on firm's breach of duty of loyalty claim.
- Represented leading foods and pharmaceutical companies in class action antitrust and unfair competition litigation.
 - Represented leading cereal maker in class action antitrust and unfair competition litigation; obtained summary judgment.
- Represented state food and agriculture department in litigation regarding milk nutritional, labeling and pooling regulations, and successful appeal to Ninth Circuit.
- Defended brokerage firm in NASD arbitration involving claims of breach of fiduciary duty, "churning," and related claims; obtained award in defendant's favor.
- Represented various employee groups in class action claims under Cal. Business & Profession Code 17200 for violations of wage and hour and other employment claims.

AWARDS AND HONORS

- Alumnus of the Year Award, Korean American Bar Association of Northern California (KABANC), 2016
- Best Lawyers Under 40, National Asian Pacific American Bar Association (NAPABA), 2005
- Distinguished Service Award, Asian American Bar Association of the Greater Bay Area, 2005
- Unity Award, Minority Bar Coalition and Korean American Bar Association, 2003

ARTICLES AND PRESENTATIONS

- Speaker, "Distribution Contracts: The Beer Industry Pre-Nuptial Agreements," California Craft Brewers Association Spring Conference, May 7, 2019.
- Speaker, "Distribution Agreements: From Formation to Termination and Everything In-Between," Craft Brewers Conference, April 10, 2019

PROFESSIONAL AND COMMUNITY ACTIVITIES

- President, Craft Beverage Lawyers Guild
- Founding Member, Craft Beverage Lawyers Guild
- Member, Brewers Association
- Member, California Craft Brewers Association

- Member, Board of Directors, Asian American Bar Association of the Greater Bay Area (AABA)
- Co-Chair, Community Services Committee, Asian American Bar Association of the Greater Bay Area (AABA)
- Member, Newsletter/Website Committee, Asian American Bar Association of the Greater Bay Area (AABA)
- Regional Governor, Northern California, International Association of Korean Lawyers (IAKL)
- Member, Annual Conference Organizing Committee, International Association of Korean Lawyers (IAKL)
- Treasurer, International Association of Korean Lawyers (IAKL)
- Member, Anti-Counterfeiting Committee, International Trademark Association (INTA)
- Member, Internet Committee, International Trademark Association (INTA)
- Member, Information Resources Committee, International Trademark Association (INTA)
- Member, Trademark Dilution Committee, International Trademark Association (INTA)
- Member, Trademark Reporter Editorial Board, International Trademark Association (INTA)
- Alumnus of the Year, Korean American Bar Association of Northern California (KABANC)
- Board Member, Korean American Bar Association of Northern California (KABANC)
- President, Korean American Bar Association of Northern California (KABANC)
- Treasurer, Korean American Bar Association of Northern California (KABANC)
- Member, California Regional Conference Organizing Committee, National Asian Pacific American Bar Association (NAPABA)
- Recognized as one of "Best Lawyers Under 40," National Asian Pacific American Bar Association (NAPABA)
- Member, Alameda County Bar Association

ADMISSIONS

- California
- U.S. Court of Appeals, Ninth Circuit
- All State and Federal Courts in the State of California