



## Timothy L. Capria

PARTNER

THE LINK VIRTUAL  
OFFICE\*

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### OVERVIEW

Tim assists clients, including major multinational brands, with overall management of their intellectual property portfolios.

After initially pursuing a career in a life sciences laboratory, Tim realized that he wanted to work in a field where he could regularly interact with people—specifically, a role that would combine his scientific knowledge with client consulting and advising. Intellectual property law was a perfect fit, and after earning his law degree, Tim began assisting clients with patent prosecution. He later shifted the focus of his practice to trademark law.

Tim provides trademark portfolio management and counseling to clients, including both the registration and filing of trademarks and the policing of potential mark infringement domestically and abroad. Many of the clients Tim represents have hundreds of trademarks worldwide, and he has a special focus on franchisors, consumer goods manufacturers and distributors, and entertainers and music artists.

*"Tim Capria can match our speed, understand our financial scenario, and provide top-tier strategic and quality work."*

— Intellectual Property client,  
*Chambers USA 2023*

### Industry

Financial Services & Capital  
Markets

### Services

Advertising & Marketing  
Copyrights  
Intellectual Property  
Intellectual Property Counseling  
Trademarks

Tim builds IP strategies that fit client resources and client needs—and that add value to client businesses. Determining which trademarks to protect and police, and where around the globe to protect and police them, is an essential part of portfolio management, and Tim draws on his decade of experience to advise clients on high-value, practical strategies.

Although not primarily a litigator, Tim has successfully represented clients in more than a dozen Trademark Trial and Appeal Board (TTAB) proceedings. His experience includes representing a national franchise retailer against a major sporting goods manufacturer in a highly publicized federal trademark infringement lawsuit, and he has successfully defended clients accused of trademark infringement.

Tim routinely works with internationally known brands and is highly knowledgeable about the process of building and protecting a brand through IP strategy. In addition to his trademark practice, he also advises clients on truth in advertising issues, including health and safety or environmental advertising claims.

Clients appreciate that Tim not only knows the trademark world but also the corporate arena: after beginning his legal career in-house at Amazon, he has an inside understanding of how a corporate legal department functions and how outside counsel can be most helpful. Tim has a strong reputation as a business-oriented attorney who intuitively grasps the massive financial value trademarks represent for clients.

## Experience

- Counseled national food manufacturer regarding brand best practices and potential strategies to support manufacturer's nationwide sales to a major warehouse club.
- Represented multiple brand owners in numerous opposition and cancellation proceedings before the TTAB, including proactive cancellations of existing trademark registrations to eliminate uncertainty and strengthen brand owners' marks.
- Served as intellectual property counsel for an apparel on-demand manufacturer and retailer client, including assisting the client in identifying and documenting inventions, preparing and prosecuting patent applications, brand counseling, trademark filing and prosecution, and advising on complex issues of licensing and ownership of client's intellectual property assets.
- Managed domestic and international patent portfolio of a leading medical device company and start-up medical device companies. Prepared new patent applications and prosecuted pending patent applications to secure issued patents on medical devices, including medical devices implementing executable computer software.

## Experience

- Managed domestic and international patent portfolio of a major infant formula manufacturer. Prepared new patent applications and prosecuted pending patent applications to secure issued patents on formulations and containers.
- Advised clients of patent landscape by drafting dozens of freedom to operate and non-infringement opinions for proposed product launches in the U.S. and abroad.
- Managed large trademark portfolio of premier manufacturer of bathroom products, including filing strategy, filing new applications for registration, prosecution of pending applications for registration, and maintenance of existing registrations.
- Coordinated strategy and managed international patent application prosecution for dozens of patent applications in Europe, Japan, China, Canada, Australia, New Zealand, Taiwan, Brazil, India, Mexico, Argentina, Chile, India, and United Arab Emirates, among other jurisdictions. Advised non-U.S. attorneys and their clients regarding obtaining patent protection in the U.S. and represented the non-U.S. clients before the United States Patent and Trademark Office.
- Advised on, procured, and managed international trademark protection for a leading manufacturer of bathtubs, shower units, and spas. Assisted non-U.S. attorneys and their clients in obtaining U.S. trademark protection.
- Counseled Fortune 1000 construction materials company regarding updating its website and mobile application privacy policy.
- Performed due diligence for worldwide intellectual property in relation to an asset sale.
- Advised co-author of a mathematical textbook concerning copyright issues related to rights of a co-author and publisher.
- Performed patent and patent application landscape searches for recently issued patents and filed patent applications by competitors and advise client regarding search results. Monitored and counseled client regarding newly filed patent applications and issued patents on an ongoing basis.

## Experience

- Performed numerous trademark clearance searches to advise clients regarding adoption and registration of proposed marks.

## Recognition

- World Trademark Review 1000; Recommended, 2023; The World's Leading Trademark Professionals, 2024
- *The Best Lawyers in America*; Trademark Law, 2022-2024; Copyright Law, 2024; Ones to Watch, Intellectual Property Law, 2021
- *Chambers USA*, Intellectual Property, Up and Coming, 2021-2023
- Tennessee Supreme Court Access to Justice Commission, Attorney for Justice, 2019 and 2023
- Nashville Bar Association, President's Award, 2018

## Education

- J.D., Duke University School of Law
- B.S., Rochester Institute of Technology
  - with honors

## Admissions

- New York
- Tennessee
- U.S. Patent and Trademark Office

## Community Leadership

Tim is extensively involved with the International Trademark Association (INTA), where he currently serves on a committee to produce guidelines for trademark offices worldwide.

He is also a past vice president of the board of directors for Poverty and the Arts.

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\*Tim works remotely and is licensed in Tennessee, practicing in Nashville. Contact Tim via e-mail or telephone for in person/virtual meetings. Use the address 424 Church St., Suite 2000, Nashville, TN 37219 for mail/deliveries.



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