



OFFICE OF THE COUNTY ATTORNEY

Marc Elrich
County Executive

Marc P. Hansen
County Attorney

MEMORANDUM

TO: Sidney Katz, President
Montgomery County Council

FROM: Marc P. Hansen *Marc Hansen*
County Attorney

DATE: February 4, 2020

RE: Appointment of Special Counsel – Sterne, Kessler, Goldstein & Fox

Under Charter Section 213, I request that the Council approve the appointment of Sterne, Kessler, Goldstein & Fox as special counsel to represent Montgomery County in connection with securing proprietary rights with the U.S. Patent and Trademark Office to a new name for the County's retail liquor stores. Securing the rights to a new name will avoid potential liability associated with the County infringing on any pre-existing rights of another in the same or similar name.

As part of its rebranding efforts, the Department of Alcohol Beverage Services is in the process of securing a new name for the County's retail liquor stores. In order to secure a proprietary right in the new name, the County will need to register the new name as a trademark with the U.S. Patent and Trademark Office. The Trademark Office encourages those seeking to secure trademark protection to engage a trademark attorney to perform a full and comprehensive search prior to registering the trademark.

The County previously engaged Sterne, Kessler, Goldstein & Fox in 2017 to assist with a patent law matter. Sterne, Kessler specializes in the practice of intellectual property law, including patent and trademark issues. Sterne, Kessler has over 170 intellectual property professionals and represents a wide variety of clients.

Accordingly, I request Council confirmation of Sterne, Kessler, Goldstein & Fox as special counsel in connection with procuring proprietary rights to a new name for the County's retail liquor stores.

Sidney Katz, President
February 3, 2020
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cc: Marc Elrich, County Executive
Andrew Kleine, Chief Administrative Officer
Dale Tibbitts, Special Assistant to the County Executive
Neal Anker, Associate County Attorney
Robert Drummer, Sr. Legislative Attorney
Selena Mendy Singleton, Clerk, County Council
Karen Pecoraro, County Council

MPH:tjs