

## Dora M. Peñagaricano

Capital Member, Litigation Practice Group

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Co-Leader, Retail Practice Team

Co-Leader, Intellectual Property Practice Team

### PRACTICES

Cuba

Data Privacy & Cybersecurity Practice Team

Intellectual Property

Litigation

Product Liability

Retail

### BAR ADMISSIONS

- Commonwealth of Puerto Rico
- U.S. District Court District of Puerto Rico
- U.S. Court of Appeals First Circuit
- U.S. Supreme Court

### CLERKSHIPS

- Law clerk to the Hon. Wilfredo Alicea López, Extraordinary Writs Section of the Superior Court of Puerto Rico
- Law clerk to the Hon. Pedro López Oliver, Extraordinary Writs Section of the Superior Court of Puerto Rico
- Law clerk to the Hon. Arnaldo López Rodríguez, Extraordinary Writs Section of

She concentrates her practice in intellectual property and commercial litigation cases.

Ms. Peñagaricano was part of the State Department Committee that drafted the new Trademarks Act of Puerto Rico and the Regulation for the Registration of Trademarks in Puerto Rico. She was the President of the Intellectual Property Committee of the PR Bar Association and, under her presidency, the Committee drafted the Right of Publicity bill, the Trade Secrets bill, and the Moral Rights bill which were signed into law between 2011 and 2012.

She has been an active member of the International Trademark Association (INTA) for many years, and member of its Sub-Committee on Legislation in Latin America, and its Sub-Committee on Trade Dress. Ms. Peñagaricano has been a speaker in many Intellectual Property seminars and conferences in Puerto Rico and in the United States.

She is ranked as one of Puerto Rico's Leading Attorneys in the Intellectual Property field by the renowned international publication *Chambers & Partners* in its Latin America Guide. She is also ranked in the Intellectual Property Law field of *The Best Lawyers in Puerto Rico* guide. In 2017 Ms. Peñagaricano was recognized by Best Lawyers® as the Intellectual Property Law "Lawyer of the Year" in San Juan, Puerto Rico.

Before joining McConnell Valdés, she was a Law Clerk to the Hon. Wilfredo Alicea López, the Hon. Pedro López Oliver, and to the Hon. Arnaldo López Rodríguez, Extraordinary Writs Section of the Superior Court of Puerto Rico.

### REPRESENTATIVE CASES

Her representative cases include:

- Winning a landmark case in 1998 garnering a permanent injunction against a company illegally using the name of former Miss Universe Dayanara Torres in

the Superior Court of Puerto Rico

#### EDUCATION

B.A., *Cum Laude*, Georgetown University

J.D., *Magna Cum Laude*, University of Puerto Rico Law School

#### MEMBERSHIPS

- Puerto Rico Bar Association
- Federal Bar Association
- International Trademark Association (INTA)

the first “right of publicity” action brought in federal court in Puerto Rico.

- Winning a precedent setting case in the First Circuit Court of Appeals for The Clorox Company in which the Appeals Court reversed the dismissal of a Lanham Act false advertising action brought by Clorox against Procter & Gamble. This decision, *The Clorox Company Puerto Rico v. The Procter & Gamble Commercial Company*, 228 F.3d 24 (1st Cir. Oct. 3, 2000), was the first false advertising case decided in the First Circuit.
- Filing the first case before the Federal Court of Puerto Rico under the Anticybersquatting Consumer Protection Act and obtained from the defendant the domain name of her client.
- Successfully defending PGD, Inc. against a claim of trademark infringement involving the name of a generic drug in the case *Doral Pharmamedics v. PGD*, 148 F. Supp. 2d 127 (D.P.R. 2001).
- Ms. Peñagaricano was part of the legal team that obtained an injunction in favor of McNeil and against Merisant ordering the withdrawal from the Puerto Rico market of the yellow artificial sweetener product SAME, since its trade dress was a copy of the trade dress of the SPLENDIA artificial sweetener product.
- Litigating the first “right-of-publicity” case brought in state court in Puerto Rico in which the Supreme Court of Puerto Rico established the rights of the parties.
- Obtaining an ex-parte TRO and seizure order in a jewelry copyright infringement case.
- Obtaining an ex-parte TRO and seizure order in the BRITTO counterfeit, trademark and copyright infringement case against 177 defendants.
- Presenting claims against various stores for selling Creative Recreation shoes in violation of the design patents of her client.
- Presenting claims against various stores for selling gray goods in Puerto Rico.
- Obtaining an ex-parte TRO and seizure order in the TOUS counterfeit, trademark and copyright infringement case against 177 defendants.
- Obtaining an ex-parte TRO and seizure order in the Nicole Lee copyright infringement case against Novus Shoe Stores.
- Obtaining a Judgment from the Supreme Court dismissing 93 DACO penalties issued against Toys R' Us.
- Obtaining a Judgment from the United States District Court for the District of Puerto Rico holding that plaintiff, a former employee of Church's Chicken Puerto Rico, was not the owner of the PechuSandwich trademark and

holding that such ex-employee did not have copyrights over the PechuSandwich recipe – since recipes are not subject to copyright protection. In 2015, this Judgment was affirmed by the First Circuit Court of Appeals.

- Successfully litigating intellectual property claims for such clients as Kraft Foods, Gillette, Clorox, Shell, Carvajal, S.A., Century 21, Wells Fargo, Vitamin World, Mattel, JWT, McNeil, PGD, ConAgra, Cajun Operating Company (Church's), Aggreko, Pernod Ricard, Kabushiki Kaisha Pilot, Danone, Quest Beads & Cast, Nobox Marketing Group, Ponte Fresco, Gymboree, Pottery Barn, and Elba Jewelers (Sophia Fiori).