



Stephen J. Barrett

Partner

stephen.barrett@wilsonelser.com

New York, NY – 212.915.5479

Stephen J. Barrett is an accomplished intellectual property attorney with a wealth of experience in prosecuting and defending complex commercial and IP actions. His prowess in copyright, trademark, trade dress, false advertising, cybersquatting and data privacy law has made him a trusted adviser to clients across a range of industries. Stephen represents clients in a variety of fields including entertainment, fashion, media, technology, and consumer goods and services.

As a member of the firm's Intellectual Property & Technology Practice, Stephen has developed a reputation for excellence in all aspects of litigation. He is skilled in developing prosecution and defense strategies, managing investigation and discovery, drafting and arguing substantive motions, and taking tough depositions.

Stephen's experience extends beyond litigation to counseling clients on a range of legal compliance issues. He regularly provides strategic advice and counseling to entrepreneurs and multinational corporations on questions regarding the protection, exploitation and enforcement of intellectual property and other content, and on the application of intellectual property and related laws to evolving technologies, business activities and branding initiatives. Stephen is a Certified Information Privacy Professional (CIPP/US), which enables him to offer clients invaluable insights into data privacy compliance and risk management.

Stephen also is adept at negotiating and drafting commercial agreements, such as master services agreements, employment separation agreements, and copyright and trademark transfers and licenses. Through his extensive experience, Stephen has developed a deep understanding of the legal issues facing businesses today. His ability to navigate complex legal challenges and provide strategic guidance has made him a valuable asset to clients seeking to protect their intellectual property and manage legal risk.

Services

- Commercial Litigation
- Intellectual Property & Technology
- Financial Services
- Professional Liability & Services

Intellectual Property

Throughout his career, Stephen has represented clients in intellectual property and media liability matters, including copyright and trademark infringement, domain name disputes, Digital Millennium Copyright Act (DMCA), unfair competition, false advertising, right of publicity, trade secret misappropriation and defamation claims. He also handles domestic and international copyright and trademark registrations and related administrative procedures, and counsels his clients on intellectual property protection through strategic planning, monitoring and enforcement.

Before admission to the bar, Stephen worked at a music publishing house collecting royalties for jazz era musicians and interned at Volunteer Lawyers for the Arts, assisting attorneys who provide free and low-cost legal counseling to low-income artists in New York City. He also worked at a large nonprofit organization, where he aided in copyright clearances and royalty collection for authors. From that background, Stephen developed a passion for helping both content creators and their customers succeed in their respective industries.

Stephen understands the challenges facing artists and businesses – particularly in the age of digital content – and is dedicated to helping them navigate the legal landscape. With his command of copyright and trademark law, defamation, music law, art law, contracts and legal issues facing social media creators, he has the skills and knowledge to help clients achieve their goals and protect their rights.

Commercial Services

With a keen eye for detail and a deep understanding of legal complexities, Stephen has helped countless clients navigate complex commercial disputes and draft comprehensive contracts that protect their interests. Stephen applies his expertise in dispute resolution to his transactional practice with an eye toward dispute avoidance. Stephen's clients appreciate his ability to think creatively and his diligent approach to every project.

Cybersecurity & Data Privacy

Stephen's practice also focuses on data privacy and security issues, including incident response, related litigation, compliance and risk management advice. Stephen counsels businesses and individuals regarding the applicability of legal obligations relating to data privacy and security, and assists with analyzing, drafting and revising website privacy policies, terms of use and various related contracts.

Emerging Technologies

Stephen's passion for emerging technologies began early in his career, when he recognized the enormous potential of groundbreaking technologies to revolutionize industries and change the world. Since then, he has dedicated his practice to helping clients overcome the unique legal challenges they face in the ever-shifting technology landscape.

What sets Stephen apart from other attorneys in his field is his deep understanding of emerging technologies, as well as the social media environment in which clients operate. He stays current on the latest trends and developments, and is always thinking creatively about how to help his clients succeed. Stephen is known for his ability to provide practical,

actionable advice that helps his clients achieve their objectives.

With an acute fascination for the latest developments in AI and machine learning, blockchain, and augmented and virtual reality, Stephen is uniquely positioned to provide his clients with authoritative advice on a wide range of legal issues, including intellectual property protection, regulatory compliance and contract negotiations.

Education

- Brooklyn Law School (J.D., *cum laude*, 2008)
 - Executive Articles & Research editor, Brooklyn Law Review; ABA National Team Member, Moot Court Honor Society
- Brandeis University (Graduated, 2004)

Bar Admissions

- New York

Court Admissions

- U.S. Court of Appeals, Second Circuit
- U.S. Court of Appeals, Federal Circuit
- U.S. District Court, Eastern District of New York
- U.S. District Court, Southern District of New York

Professional Affiliations

- American Intellectual Property Law Association
- DRI: The Voice of the Defense Bar, Intellectual Property Litigation Committee

Awards & Honors

- Selected for inclusion in *Rising Stars for New York Super Lawyers*, 2015-2021

Client Wins

Barrett and Rios Prevail on Motion to Dismiss in Trade Dress Suit in Southern District of New York

Stephen J. Barrett (Partner-New York, NY) and Gabriela Rios (Associate-New York, NY) recently prevailed on behalf of a manufacturer client on a motion to dismiss in the Southern District of New York on a trade dress case. Plaintiff brought claims under the Lanham Act for trade dress infringement and trade dress dilution, along with state law claims, related to a unique piece of farming equipment that previously enjoyed patent protection. The plaintiff sought to prevent competitors from using the design of the previously patented product under the theory that the product's non-patented elements were separately protectable under trademark law. In their motion to dismiss, Stephen and

Gabriela argued that the alleged trade dress is functional and therefore not protectable, and that the trade dress is not famous, which is a separate requirement necessary for trade dress dilution. The court agreed with their arguments, stating that the complaint only offered conclusory statements that did not sufficiently plead non-functionality or the trade dress's requisite level of fame. Plaintiff attempted to bolster its arguments by referencing an expired design patent, to which the court responded that the assertion of a legal presumption of non-functionality stemming from a design patent is not supported in the caselaw.

Barrett Secures Summary Judgment For Bank Officers Defeating Fraud Allegation

Stephen Barrett (Of Counsel-New York) obtained summary judgment in the Southern District of New York on behalf of Wilson Elser's clients, two officers of a large regional bank accused of fraud in connection with a loan transaction. The plaintiff is an investment firm specializing in subordinated and other high-risk debt offerings. Our clients extended a seven-figure loan to a consumer lending company. When the lending company sought additional capital, the bank made an introduction to the plaintiff's firm because of its specialized offerings. The lending company ultimately failed and could not repay the loan from our clients' bank and the subordinated loan from the plaintiff. The plaintiff then sued our clients, alleging they fraudulently induced the plaintiff to make the subordinated debt offering to the lending company.

After successfully narrowing the scope of the plaintiff's claims via a pre-answer motion to dismiss, the parties engaged in extensive discovery related to the various loan instruments at issue. After obtaining the complete record, Stephen filed a lengthy, detailed motion for summary judgment. In a comprehensive 32-page opinion, the district court judge accepted our clients' arguments in their entirety. The court held that the plaintiff failed to identify any potentially fraudulent statements and, in any event, could not have reasonably relied on any such statements considering the plaintiff's affirmative obligation to conduct due diligence regarding its loan offering. The complaint was dismissed with prejudice, and the plaintiff declined to file an appeal.

Publications

February 18, 2025

Westlaw Today Publishes Barrett and Rios Overview of U.S. Copyright Office Report on "Copyrightability" of AI Output

Westlaw Today

September 13, 2024

Westlaw Today Publishes Barrett and Rios on Federal Rights of Publicity for AI and Digital Replicas

Westlaw Today

April 30, 2024

Law360 Publishes Barrett and Rios on Trademark Use by Resellers

April 12, 2024

Luxury Brands Assert Intellectual Property Rights Against Resellers

February 8, 2024

“Handle” with Care: Second Circuit Clarifies Ownership Test for Social Media Accounts