



“As IP counsel, our primary task is to make clients aware of potential risks and repercussions.”

– Christina M. Licursi  
Shareholder and Executive  
Committee Member  
Trademark & Copyright  
Wolf, Greenfield & Sacks, P.C.

## Interview with Christina Licursi

### What’s the back story on your master’s degree in public health?

I had worked for a few years at two large companies and knew that law school was on the horizon for me. I was also intrigued by many aspects of business management and had considered pursuing an MBA when I learned about a program jointly sponsored by Northeastern Law School and Tufts Medical School that offered a combined JD/MPH degree. It was a unique program that involved traditional legal training as well as practical experience, which appealed to me. At that point, I was unsure about what type of law I wanted to practice, but I liked the healthcare angle, so I entered the program.

Many of my current clients are pharmaceutical and biotechnology companies, and my combined degree has provided a great background for a lot of the work I perform for them. When you’re working with biotech and life sciences clients, many of them have technical degrees or highly specialized expertise; I think they appreciate working with an attorney who understands at least some of what they are talking about.

### Has your early business experience been of any help to you as an attorney?

My first job out of law school was in an intensive general management program at an engineering supply company. It was the type of experience where they throw you in right away. In the four years I was there, I did just about everything: from supply chain management, to finance, to marketing and space management. For me, the most valuable lessons I learned involved leadership and working effectively within a team environment. Many of the lessons I learned at that company I still carry with me today, both in working with my colleagues and my clients.

### What aspects of your current role at Wolf Greenfield do you enjoy most?

That’s difficult for me to answer because there is not one aspect that I prefer over another. In fact, the assignments I find most gratifying enable me to be involved in the entire lifecycle of a client relationship. For example, it might start by helping them to develop a strong, enforceable trademark and providing guidance on how they can leverage that asset.

Then it would move to legal clearance of the mark, then ushering them through the prosecution process and helping to build their brand portfolio. Finally, it might involve working with them on the other end; either in an enforcement campaign, or in litigation. I may not be directly involved in every aspect of a client's lifecycle, but the advantage of working at a law firm that's dedicated to intellectual property is that there are no gaps in our ability to cover all of their needs, with attorneys who are the best in their respective fields.

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### **Are you sometimes required to provide guidance on issues that are more subjective than they are legal?**

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I'm frequently required to weigh in on subjective, non-legal issues. Those decisions, for example, often involve brand strategy and marketing, and might include what to call a product or service, what a mark should look like, or what sort of symbolism should be associated with the brand. This is one area where having had some prior work experience and helping to negotiate business decisions is very helpful for me with clients. There can sometimes be stereotypes to overcome regarding the role of lawyers, as marketers and creative teams often expect the legal department to shoot down their ideas. So it's very important that I establish credibility by wearing both hats, and have parallel conversations with the client's marketing

department and legal team. My role as an educator is critical because in order to avoid internal friction and produce effective solutions, both sides need to have a shared vision as well as a common framework with a clear understanding of the legal consequences of decisions. This is where outside counsel can play a very valuable role for clients.

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### **Do you feel there any advantages or disadvantages to being a female attorney at an IP law firm?**

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There are no simple answers to that question. The legal profession, no matter how you look at it, is male dominated. And at an IP law firm, experience in engineering and hard sciences are often prerequisites, which are disciplines that tend to be male dominated as well. As a firm, however, Wolf Greenfield has made great strides in leveling the gender playing field. When you look at the makeup of attorneys here, we are pretty close to a 50/50 ratio.

With that said, there are still a lot of gender-based stereotypes in the business world. Every situation with clients and prospects is different, but it can be argued that in some cases being a female can be advantageous while in others it can be an obstacle. On occasion, I have either been told or made to feel that I'm too young or don't have enough experience. Although it's always been implicit, I've also experienced gender bias on

rare occasions. Regardless of whether you're male or female, I believe it's important to develop a general awareness of how you are perceived and to always be mindful of the image you're portraying, whether it be with a client or a legal adversary.

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### **What's the most difficult type of IP dispute to handle?**

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Difficult cases come in many different flavors. One end of the spectrum involves an early adopter of a trademark who lacks an awareness of someone else's rights, and they've launched a new product line that's very close to something that already exists. In that case, the senior trademark owner has an obligation to enforce their rights and notify the person who is encroaching on their rights. It can be difficult to educate the newcomer—particularly when it's an adversary and not your client—regarding what they can or cannot do.

Sometimes the most difficult challenges involve clients, for example, when they adopt a mark very early on, despite the advice they are given not to proceed. As counsel, our primary task is to make clients aware of potential risks and repercussions. However, sometimes an entrepreneur or business is willing to assume those risks, and managing those situations can be very tricky.

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## Is there a short list of trademark “do’s & don’ts” that companies should follow?

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The end goal is to create and register a strong, enforceable mark for your product or service that will help you succeed in the marketplace, and the best way to achieve that is to do your homework. This starts by gaining a deep understanding of what your competitors are doing, and what they are calling their products or services. You need to be sure that whatever you’re considering is not too close for comfort. I always tell our clients that their impressions are the best litmus test; we ask them whether they’re bothered by the competitor’s use of the name or mark. The “don’t” side of this practice often involves taking short cuts by simply conducting a Google search and not properly vetting a mark, which often leads to legal problems down the road.

The other “do” is to think ahead. Business owners need to consider not only what they’re doing right now, but also plan for where they’re going to be in three or five years. Trademark rights differ from country to country and jurisdiction to

jurisdiction. Many countries have legal landscapes that are unlike what exists in the US. So if there’s a global component to your business in your long-term plan, it’s best to consider how that will impact filing strategies sooner rather than later.

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## Is the online world still considered the “Wild West” in terms of enforcement, and will that ever change?

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An evolution is currently taking place on the internet and it is not necessarily the “Wild West” anymore. If you look at companies like Amazon and Ebay, for example, they now have robust policies that allow trademark and copyright owners to address and remove infringing content. But even with those emerging safeguards, I would encourage any business owner or company that owns a trademark or copyright to have a mechanism in place to monitor potential infringement of a mark or an image. If not outside legal counsel, then employ a dedicated team or individual responsible for policing any type of unauthorized use. That surveillance process should include

social media as well. If you have a product or service with a presence on Facebook or Instagram and you are advertising on those platforms, you need to know what other users in that space are doing and address issues as quickly as possible.

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## Are there risks involved in using images downloaded from the internet?

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In addition to patent trolls, there are also copyright trolls looking to seek damages for unauthorized use of licensed images downloaded from the internet. In fact, we deal with a lot of cases involving someone taking an image they found online. There is usually a fee associated with this type of copyright violation, along with a demand to take down the infringing content. If you are using images from the internet for your own personal use or for business purposes, I strongly encourage you to take a close look at whatever license terms are associated with those images. To be safe, you should use a common resource or other public repository of free images that have very liberal terms of use for creative applications.

## Christina Licursi Biography

Christina Licursi is a Shareholder in Wolf Greenfield's Trademark & Copyright Group, where she advises clients and international associates on branding strategies and understanding the business and legal risks associated with the adoption, use and registration of trademarks.

Christina has a strong business acumen and demonstrated ability to work closely with all levels of business. Her clients cover a variety of industries, including food and beverage, clothing, biotechnology, medical equipment, and software and telecommunications. In addition to trademark matters, Christina also handles various copyright issues, domain name portfolio management and related disputes, and social media and internet matters.

She is particularly passionate about the startup community in the Boston area and currently serves on the Board of Directors of the MIT Enterprise Forum of Cambridge, where she has been a volunteer and active participant in their Innovation Series programming.