

# Trademark and Copyright Litigation

The value placed on established brands has grown dramatically, as has the cost of protecting those brands. Our team represents and advises clients in the Fashion and Retail, Media and Entertainment, Hospitality, Digital Media and Technology, and Food, Personal Care and Consumer Health Products industries, among others. Our trademark and copyright practice is unique in that our primary attorneys have experience in both IP prosecution and litigation.

## About

Our team is adept at all aspects of trademark and copyright law, including clearance, prosecution, maintenance and enforcement of trademarks and copyrights worldwide; distribution and licensing arrangements; grey market and counterfeiting issues; marketing practices; and adversarial proceedings in U.S. Federal District Court, U.S. Trademark Trial and Appeal Board (TTAB), and ICANN Domain Dispute proceedings. As a result, we are able to offer our clients far more breadth and depth of practice than most of our peers. We not only help our clients build and protect their intellectual property rights through strategic counseling and domestic and international prosecution, but also aggressively represent such clients in court and other adversarial proceedings.

“Success” is measured differently in each unique dispute we handle. We strive to devise a litigation strategy that is cost effective and tailored to reach our clients’ business objectives. Our Trademark and Copyright practice is highly respected in the field. For the second year in a row, our Intellectual Property litigation practice was named an “IP Litigation Powerhouse” and to “Most Feared Law Firms” by BTI Consulting in its Litigation Outlook 2017 and 2018. This recognition speaks to the talent and conviction of the firm’s attorneys, and to the firm’s strategic preparation in large, high-stakes litigation. In addition, our IP team received a National ranking for Litigation–Intellectual Property in the “2017 U.S. News & World Report” and “Best Lawyers” joint ranking of “America’s Best Law Firms,” and regional rankings in New York City, Washington, D.C. and Chicago for IP Litigation. Each year we are recognized as a leading practice by *Chambers USA*, which noted that we had a team of “phenomenally smart lawyers” with “very strong technical skills.” The team is also consistently ranked in *Legal 500* for both Trademarks: Litigation and Trademarks: Non-contentious.

Our IP litigators have earned a reputation as tough adversaries. Unlike many of our competitors, we are known for trying cases to judge or jury if to do so is in our clients’ best interests. Our track record of trial victories, coupled with our technical know-how and cross-discipline teamwork, often enables us to achieve advantageous settlements for our clients in the early stages of a dispute. We also have extensive experience in successfully arbitrating IP disputes both domestically and in international arbitration tribunals. The international flavor of Kelley Drye’s practice has proven advantageous in handling the diverse legal problems of the globalized economy.

Many times, the key strategic decisions in intellectual property cases are made before the suit or arbitration is started. Trademark, trade dress, trade secrets, false advertising, copyright and unfair competition cases may be won or lost on threshold motions for preliminary injunctive relief. Our team combines seasoned trial lawyers with practitioners with extensive experience in survey research and the substantive law, enabling us to meet the tight deadlines required by such motion practice. We have obtained preliminary injunctions and fended off opponents’ requests for

emergency relief on numerous occasions.

The type of disputes we handle include:

- Trademark and trade dress infringement, dilution and unfair competition actions in federal and state courts
- Actions for §43(a) Lanham Act violations, false advertising and deceptive consumer practices in federal and state courts
- Copyright infringement actions in federal court
- Trademark proceedings in the Trademark Trial and Appeal Board of the United States Patent and Trademark Office
- UDRP, URS and other ICANN Domain Dispute proceedings
- Appeals to the Federal Circuit Court of Appeals
- Proceedings before U.S. International Trade Commission and U.S. Customs Service

Our record of success, as shown in the representative matters tab, speaks for itself.

## Experience

### Trademark and Unfair Competition

- *Maxim Integrated Products, Inc. v. Altronix Corp.*: Represented a defendant electronics company in a trademark and trade dress infringement action brought in the U.S. District Court for the Northern District of California. Negotiated a confidential settlement that was favorable to the client prior to trial.
- *NSI International, Inc v. Imperial Toy LLC*: Obtained a Temporary Restraining Order in the U.S. District Court for the Southern District of New York on behalf of NSI International in trademark litigation dispute relating to Imperial's Googly ball knock-off of the trade dress packaging of NSI's Wubble Bubble toy. Case settled favorably after win on preliminary injunction.
- *S.A.R.L. Divertis Properties Group v. Denmay, Inc.*: Represented Divertis, a French game company, in its lawsuit in the Southern District of New York against Denmay, Inc.: dba Blue Orange Games. This action was for an order enforcing a judgment of the Tribunal Grande Instance de Paris, a permanent injunction and damages for unfair competition and trademark, copyright and trade dress infringement caused by Blue Orange's continued promotion, distribution and sale of Divertis' SPOT IT! games in the U.S. after termination of the parties' license agreement. The matter settled favorably. The plaintiff's card game is sold under license by Divertis in 25 countries and is a best seller, amounting to approximately \$91 million in sales worldwide since 2009, including over \$41 million in sales in the U.S. alone since 2010.
- *Fashion Week, Inc. v. Council of Fashion Designers of America, Inc.*: Successfully defended WME/IMG in a TRO and preliminary injunction action in the Southern District of New York seeking to enjoin our client WME, "IMG and the Council of Fashion Designers of America from using NEW YORK FASHION WEEK and NYFW trademarks in connection with the famous biannual fashion events in New York City. Plaintiff withdrew all claims after the court denied its motion for a TRO and preliminary injunction.

- *Lodestar Anstalt v. Bacardi & Co. Ltd., et al.*: Representing Bacardi Group in TTAB opposition proceeding and trademark infringement litigation pending in the Central District of California regarding its use and registration of the BACARDI UNTAMEABLE mark.
- *Sterling Jewelers, Inc. v. Artistry Ltd.*: Represent Sterling Jewelers, Inc., the largest specialty jewelry retailer in the United States, in a declaratory judgment action in the U.S. District Court for the Northern District of Ohio seeking a judgment that Sterling's ARTISTRY DIAMOND trademarks for the sale of jewelry at the retail level do not infringe common law trademark rights held by Artistry Ltd., a wholesale jewelry company. Summary judgment motion pending.
- *Pernod Ricard USA, LLC v. Bacardi U.S.A., Inc.*: Represented Bacardi USA at trial in a false designation of origin and unfair competition suit involving the HAVANA CLUB trademark originally filed by Pernod USA in federal court in Delaware. The Third Circuit's unanimous decision confirmed that surveys are not essential in trademark and false advertising cases.
- *US Polo Association v. PRL USA Holdings, Inc.*: Represented Polo Ralph Lauren in trademark infringement litigation in the U.S. District Court for the Southern District of New York. Obtained judgment granting a broad injunction against the USPA parties. The decision tested the application of the new "irreparable harm" standard as applied in an action seeking a preliminary injunction for trademark infringement. The Second Circuit unanimously affirmed the decision.
- *Havana Club Holding, S.A. v. Galleon, S.A.*: Represented Bacardi at trial against claims brought by a joint venture owned by the Castro regime and Pernod-Ricard, S.A. The trial court cancelled the joint venture's federal registration of the HAVANA CLUB mark and dismissed all of plaintiffs' unfair competition claims. The decision was affirmed by the Second Circuit on appeal.
- *Rexall Sundown, Inc. v. Perrigo Co.*: Defended OTC drug manufacturer at trial in an unfair competition lawsuit brought in the Eastern District of New York. The jury unanimously found that defendant's statement, used on wholesalers' and retailers' store-brand packaging for joint-care products is not false and misleading and does not violate Section 43 of the Lanham Act, and awarded damages on our client's counterclaims.
- *Star Indus. Inc. v. Bacardi*: Represented Bacardi in trademark infringement litigation. Obtained judgment for the client after a bench trial in the Southern District of New York.
- *New York, New York Hotel LLC v. New York Stock Exchange*: Served as appellate counsel for the New York Stock Exchange. We were successful in reversing a summary judgment granted below in the Southern District of New York. This involved novel issues of law.
- *Academy of Motion Picture Arts and Sciences v. Avon Products, Inc.*: Defended one of the world's largest cosmetics and personal care products with respect to copyright infringement, trademark infringement and other related claims stemming from Avon's use of a photograph of an award-winning actress holding an Academy Award statuette in Avon's catalog advertising. Defended a motion for preliminary injunction in the United States District Court for the Central District of California, and the parties amicably settled their differences before a decision was made on the motion.
- *CMSI, Inc. v. Pacific Cycle, Inc.*: Defended distributor of motor scooters from claims of reverse passing off under the Lanham Act. The case, in the Western District of Washington, was dismissed with prejudice after denial of plaintiff's preliminary injunction motion.

- *Miss Universe L.P., LLP v. Community Marketing, Inc.*: Obtained judgment on behalf of an international beauty pageant enterprise in sustaining opposition after trial in opposition proceeding before the United States Trademark Trial and Appeal Board. Successfully prevented registration of applicant's trademark.
- *Cartier et al. v. Aaron Faber et al.*: Defended a watch retailer in litigation brought by a major international luxury goods enterprise alleging trademark infringement and counterfeiting in the U.S. District Court for the Southern District of New York. Obtained dismissal of all claims against client and obtained favorable settlement prior to trial.
- *Toughlove America, LLC v. MTV Networks, Flower Films and High Noon Productions*: Defeated a 2009 motion for preliminary injunction that was sought, based on alleged infringement of plaintiff's trademark, to prevent the distribution of a popular reality television program on a prominent cable network.
- *Survivor v. CBS*: Defending the broadcast network and the merchandise distributor of a pioneering reality television show against a trademark lawsuit filed in Hawaii, won summary judgment against "reverse confusion" claims brought by a Hawaiian company that marketed similar products under a similar trademark; that trial court victory was affirmed by the U.S. Court of Appeals for the Ninth Circuit.
- *Sullivan v. CBS Corp.*: Defended CBS Corporation against trademark infringement and other claims brought by Survivor rock band regarding use of the "Survivor" mark in connection with the reality television series of the same name. The U.S. Court of Appeals for the Seventh Circuit affirmed dismissal on summary judgment.
- *Infinity Broadcasting v. Playa Del Sol Broadcasters*: Defending the world-famous trademark of a Los Angeles radio station, secured a TRO and preliminary injunction to prevent a Palm Springs station from using a confusingly similar name; the trademark injunction was unanimously affirmed by the U.S. Court of Appeals for the Ninth Circuit.

## Copyright

- *A Black Bike, Inc. v. Club Monaco, Inc. et al.*: Obtained the dismissal of claims against an international apparel retailer prior to the conclusion of discovery in an action filed in the United States District Court for the Southern District of New York alleging, among other things, copyright infringement, trade dress, false advertising, and trademark infringement.
- *Valentino v. MGA Entertainment*: Defended leading toy manufacturer in copyright infringement and trade dress action. Case dismissed by plaintiff following early discovery and motion practice.
- *Adams v. The Hartz Mountain Corp.*: Represented The Hartz Mountain Corporation in a lawsuit filed in the Western District of Washington by artist Juli Adams. Adams alleged Hartz violated a license of IP copyrighted illustrations and a trademark claim with Adams through its use of the ANGRY BIRDS trademark in connection with the sale of pet toys. Just weeks before trial, the case settled favorably.
- *Saks Inc., v. Attachmate Corp.*: Represented Saks in a declaratory judgment action pending in the Southern District of New York seeking a declaratory judgment that it did not breach agreements or violate copyrights of software company. Obtained favorable settlement after

pretrial briefings.

- *The Bon-Ton Stores, Inc. v. Attachmate Corp. and Micro Focus (US), Inc.*: Represented The Bon Ton Stores in an action in the U.S. District Court for the Southern District of New York seeking a declaratory judgment that, among other things, it did not infringe upon the defendant's copyrights. Obtained a confidential settlement favorable to the client prior to discovery.
- *Polo Ralph Lauren Corp. et al., v. Attachmate Corp.*: Represented Polo Ralph Lauren in an action in the U.S. District Court for the Southern District of New York seeking a declaratory judgment that, among other things, it did not infringe upon the defendant's copyrights. Obtained a confidential settlement favorable to the client prior to discovery.
- *Anna Sui Corp. v. Forever 21, Inc. et al*: Litigation counsel for international fashion designer in bringing copyright infringement action in the U.S. District Court for the Southern District of New York. Obtained permanent injunction and confidential settlement favorable to client prior to trial.
- *Miss Universe L.P., LLP v. Adan Perez et. al*: Represented international beauty pageant enterprise in bringing a trademark and copyright litigation in the U.S. District Court for the District of Nevada. Obtained permanent injunction in connection with favorable settlement agreement prior to discovery.
- *PortfolioScope, Inc. v. Oracle Financial Services Software Limited*: Defended Oracle in a federal jury trial in Boston, MA against claims of copyright infringement and unfair competition, relating to computer code underlying one of the most widely used financial services back-office function software. Case settled favorably during cross-examination of plaintiff's second witness.
- *Antonio Mari v. The Brazilians Press and Publications, Inc.*: Defended Brazilian newspaper publishing company in copyright infringement litigation in the U.S. District Court for Southern District of New York. Obtained dismissal of claims and obtained favorable settlement prior to discovery.
- *Abend Trust v. Spielberg, et al.*: Defending a major studio, a highly honored producer, and several other defendants against a copyright lawsuit in New York federal court, won summary judgment in 2010 against claims that a recent hit movie infringed the copyright of a short story upon which a 1954 classic film was based.
- *Gilbert v. Warner Bros., et al.*: Defending more than 30 named defendants, including a major motion picture studio and three well-known actresses, in 2009 and 2010 secured the dismissal of numerous copyright and RICO claims based on the release and distribution of a successful romantic comedy.
- *New Line Cinema v. Cedar Fair L.P.*: Represented New Line Cinema and related entities in U.S. District Court in California in a copyright infringement action against Knott's Berry Farm over unauthorized use of New Line's copyrighted material in connection with the "Knott's Scary Farm" Halloween show.
- *Kimbell v. HBO, Chris Rock, et al.*: Protecting the release of a 2009 premium cable documentary, defeated both an application for temporary restraining order and a motion for preliminary injunction based on claims of copyright infringement, paving the way for the film's timely release and forcing the dismissal of the action.

- *Zella v. E.W. Scripps Co., et al.*: Secured the dismissal, with prejudice, of a copyright infringement claim against a leading television cooking show. Persuaded the district court to issue groundbreaking rulings that copyright infringement claims may be dismissed at the pleading stage based on lack of substantial similarity; no amount of access can establish actionable copying if the works are not substantially similar; and judicial notice is appropriate to establish that allegedly copied elements are generic and therefore not copyright protected.
- *Marder v. Lopez et al.*: Defended a major motion picture studio in a copyright infringement action growing out of a hit 1980s motion picture. Secured the dismissal, with prejudice, of all claims, and successfully defended that dismissal on appeal in the U.S. Court of Appeals for the Ninth Circuit in 2006.
- *Trilenium Pictures v. Walt Disney Co.*: Secured the early dismissal, with prejudice, of copyright and accounting claims brought in 2005 against the producers, distributor and director of one of the most financially successful films of 2002.

## Related Services

Intellectual Property

Patent Litigation and Post-Grant Proceedings

Patent Prosecution

Trademark and Copyright Prosecution

## Contacts

[Andrea L. Calvaruso](#)

[acalvaruso@kelleydrye.com](mailto:acalvaruso@kelleydrye.com)