

Trademark, Trade Dress, Unfair Competition/False Advertising, and Publicity Rights Litigation

We have represented some of the world's best known trademark owners in false advertising, unfair competition, trademark and trade dress disputes. These include marks such as: Academy Awards, Benchmark Capital, Pennzoil, Green Bay Packers, Wal-Mart, UGG Boots, Indianapolis Colts, Cleveland Browns, Converse, ESPN, and Casino de Monte Carlo. Our expertise covers the range of false advertising and unfair competition claims under both federal and state laws. Often this requires the preparation of injunction motions literally overnight. We have extraordinary experience at trial in dealing with the impact on consumers of both brands and advertisements and work with an array of the top consumer marketing experts and psychologists to interpret the message conveyed either by a brand or an advertisement. We also represent prominent brands in connection with right of publicity claims. *The Global 100 – 2018* named us “Law Firm of the Year” for our Trademark & Copyright practice in New York.

SELECT RECENT REPRESENTATIONS

- *Girl Scouts of the United States of America v. Boy Scouts of America* (S.D.N.Y. 2022). We successfully represented the **Boy Scouts of America (BSA)** in a trademark infringement case brought by the Girl Scouts of the United States of America (GSUSA) in the Southern District of New York. In 2018, the BSA began welcoming girls into its two core programs, Cub Scouts and Boy Scouts (re-named Scouts BSA). GSUSA alleged that the BSA's use of the terms “Scout” and “Scouting” in connection with these two programs was infringing because GSUSA claimed it held exclusive rights to the term “Scout” when used in connection with youth service programs that included girls. After more than two years of litigation, the Court rejected GSUSA's claims, agreed with the BSA that its uses were not infringing, granted the BSA's motion for summary judgment, and dismissed GSUSA's complaint in its entirety.
- *Nike v. Wu* (S.D.N.Y. 2021). We represented five largest Chinese state-owned banks in successfully opposing a motion to hold the non-party banks in contempt because they refused, on the basis of Chinese law's prohibitions and New York's separate entity rule, to freeze bank accounts in China pursuant to a U.S. court's asset freeze orders.
- *United States Soccer Federation Foundation, Inc. v. United States Soccer Federation, Inc.* (D.D.C. 2020). We successfully represented the **U.S. Soccer Foundation (the “Foundation”)** in a trademark action against the U.S. Soccer Federation (the “USSF”), seeking a declaration that the Foundation is the owner of the trademark “U.S. Soccer Foundation” that it has used for over 25 years. The Foundation filed suit after the USSF demanded that the Foundation cease using the name “U.S. Soccer Foundation” and logos and threatened to hijack the Foundation's trademarks for its own use—likely

in an effort to capitalize on lucrative business opportunities when the United States hosts the World Cup in 2026. The suit settled on favorable terms.

- TechShop Inc. v. Dan Rasure et al (N.D. Cal. 2019). We represented **Defendants Dan Rasure, TheShop.Build, LLC, and TheShop.Build San Fran, LLC** in a pro bono matter. Plaintiff TechShop, Inc. sued our clients for trademark infringement in the Northern District of California, alleging that the former name of their business, TechShop 2.0, and the current name, TheShop.Build infringed its TECHSHOP marks. Quinn Emanuel was retained after discovery closed to try the case. After a 7-day jury trial, the jury came back with a verdict that our clients infringed TechShop's marks, but awarded TechShop no damages.
- Charlie Kessler v. Matt and Ross Duffer (Cal. 2019). We represented **Matt & Ross Duffer**, creators of Netflix's hit TV show Stranger Things, after they were accused of basing the show on ideas allegedly described to them at a party by Charlie Kessler. The Duffer brothers hired us two weeks prior to trial to act as lead counsel. Plaintiff dismissed his case before the trial commenced.
- Alibaba Group Holding Limited v. Alibabacoin Foundation et al. (PTAB 2018). We were engaged by our client, **Netflix, Inc.**, in two inter partes review proceedings challenging the validity of patents owned by Affinity Labs of Texas, LLC relating to streaming systems for digitally stored audio, video, and textual content. Following the Oral Hearing, the PTAB issued Final Written Decisions in each proceeding finding that all challenged claims were unpatentable. We represent Netflix in an appeal of the PTAB's ruling that was recently filed by Affinity and is currently pending before the Federal Circuit. We also represent Netflix in the related District Court proceeding that currently is stayed.
- We represented **Gucci** in a case against Forever 21, which brought claims for declaratory judgment of non-infringement and cancellation of trademark registrations against Gucci America, Inc. relating to Gucci's famous green-red-green and blue-red-blue striping trademarks. The matter settled on terms satisfactory to our client.
- The Lincoln Electric Company et al. v. Harbor Freight Tools USA, Inc. (N.D. Ohio 2018). **Lincoln** is a prominent maker of welding power supplies. Lincoln filed an omnibus complaint against Harbor Freight in the Northern District of Ohio (Lincoln's home district) asserting patent infringement, trade dress infringement, and other ancillary claims in connection with Harbor Freight's line of competing welding power supplies. Shortly thereafter, Lincoln moved for a preliminary injunction to block future all future sales of Harbor Freight's products based on their alleged infringement of three Lincoln patents. Operating under a highly compressed schedule, we took discovery and put together a robust opposition to Lincoln's motion. Based on the strength of our opposition, Lincoln voluntarily withdrew two of the three patents and provided Harbor Freight with Covenants Not to Sue. The Court denied the preliminary injunction based on the remaining patent.

- Edible International, LLC et al v. Google, LLC (D. Conn. 2018). We represented **Google, LLC** in a case involving allegations of trademark infringement, trademark dilution, and unfair competition, brought by a customer of Google’s advertising services. We successfully won a motion to compel the dispute to arbitration.
- Moldex-Metric, Inc. v. McKeon Products, Inc. (9th Cir. 2018). We represented **Moldex-Metric, Inc.**, which manufactures ear plugs. Since 1982, Moldex has made a specific ear plug in a lime-green color. Over the years, that color became associated with Moldex and Moldex claimed to have a common-law trademark on the color. Years later, McKeon Products began to sell an ear plug in a nearly identical color. Moldex-Metric sued in the U.S. District Court for the Central District of California. McKeon defended by arguing that the lime-green color is functional (insofar as it allows for easy visibility) and therefore is ineligible for trademark protection. The district court granted summary judgment to McKeon, and Moldex appealed. In an unpublished 2-1 decision, the Ninth Circuit vacated, ruling that the district court had failed adequately to consider the U.S. Supreme Court’s decision in *Qualitex*. On remand, the district court again granted summary judgment to McKeon, purporting to distinguish *Qualitex*. Moldex again appealed, and on June 5, 2018, in a published decision, a different panel of the Ninth Circuit vacated and remanded, holding that the issue of functionality cannot be determined on summary judgment in the context of this case, and more specifically that the availability of alternative colors that are equally visible as Moldex’s lime-green shade must be considered by the factfinder.
- Jeremy Southgate v. United States et al. (E.D.V.A. 2018). We obtained a dismissal with prejudice of an unusual complaint against our client, **the Academy of Motion Picture Arts and Sciences**, in the Eastern District of Virginia. Pro se plaintiff Jeremy Southgate brought claims of racketeering, trademark and copyright infringement, and more. He claimed that certain stage arrangements, spoken words, and a musical performance in the Oscars infringed his company’s logo as part of a conspiracy involving Barack Obama, Google, and other high-profile figures. On April 9, 2018, the Court granted our motion to dismiss with prejudice.
- Snap-on, Inc. v. Harbor Freight Tools USA, Inc. (E.D. Wisc. 2017) We represent **Harbor Freight Tools** in a suit by rival tool company, Snap-on. After Harbor Freight’s motion to dismiss trade dress claims led to Snap-on dropping that claim, Harbor Freight defeated Snap-on’s motion for preliminary injunction, in which Judge Lynn Adelman found that Snap-on’s design patent infringement claim had no likelihood of success on the merits. The case continues with Harbor Freight having filed its own counter-claims of false advertising and inequitable conduct.
- Amanda Blackhorse v. Pro Football, Inc. This January, the United States Supreme Court heard argument on a central question in the Blackhorse case: whether Section 2(a) of the Lanham Act’s prohibition against marks that “disparage” is an unconstitutional violation of the First Amendment. On behalf of our client **the Washington Redskins**, we submitted an amicus brief in *In Re Tam* (the case heard by the U.S. Supreme Court) agreeing that section 2(a) is indeed unconstitutional. Meanwhile, the Blackhorse case has

been stayed by the US Court of Appeals for the 4th Circuit pending the U.S. Supreme Court's decision, expected in June of this year.

- American Airlines, Inc. v. Despegar.com USA, Inc., et al. (S.D. Fla. 2016). We represented **Despegar.com** in a false advertising lawsuit brought by American Airlines. Just before initiating suit, American withdrew its tickets from all of Despegar's websites throughout the world. In addition to mounting a vigorous defense against American's claims, we brought an antitrust counterclaim on behalf of Despegar's U.S.-based subsidiary relating to American's anticompetitive air fare distribution scheme. On the eve of depositions we obtained a favorable settlement agreement which paved the way for Despegar to resume selling American tickets.
- Federal Treasury Enterprise Sojuzplodoimport v. Spirits Int'l B.V. (2d Cir. 2016). We represent a Russian government agency, **Federal Treasury Enterprise Sojuzplodoimport (FTE)**, which is seeking to establish that it is rightful owner of the world-famous Stolichnaya trademarks. The district court dismissed FTE's trademark infringement claims for lack of standing, ruling that the Russian Government's assignment of its ownership interest in the trademarks to FTE violated Russian law and was therefore invalid. We obtained unanimous reversal in the Second Circuit. The panel held that the district court violated principles of international comity and the act of state doctrine by even considering the validity of the Russian Government's actions under Russian law. As a result, the panel reversed the district court and reinstated FTE's trademark infringement claims.
- Mattel, Inc. v. Excite Inc. (C.D. Cal. 2016). We represented **Mattel** in a suit for infringement and dilution of Mattel's famous BARBIE trade dress. Suit settled on favorable terms that included a permanent injunction.
- Apple v. Samsung (Fed. Cir. 2015). We represented **Samsung** in its high-profile litigation brought by Apple that, among other claims, alleged infringement and dilution of Apple's alleged trademark and trade dress rights in its iPhone and iPad products. After discovery, Apple abandoned all of its iPhone infringement claims, but continued to pursue its iPhone trade dress dilution claims and iPad trade dress infringement and dilution claims. At trial, we obtained a defense verdict in Samsung's favor on Apple's iPad trade dress claims. On appeal, in a landmark Federal Circuit decision, we invalidated Apple's iPhone trade dresses, both registered and unregistered, in their entirety on functionality grounds.
- WildFireWeb, Inc. v. Tinder Inc. and IAC/Interactive Corp. (C.D. Cal. 2015). We represented **Tinder, Inc. and IAC/InterActiveCorp** in a trademark infringement lawsuit brought by a website designer called WildFireWeb, which had a prior federal registration in a "Tinder" trademark for one of its product offerings. The plaintiff alleged substantial actual confusion resulting from Tinder's use of its name for its hugely popular social media application, and sought an order requiring Tinder to change its name. Despite the similarity between the parties' marks and the evidence of alleged

actual confusion, we obtained a highly favorable settlement for Tinder that has allowed Tinder to continue to own and use its valuable mark.

- Exclaim Marketing, LLC v. DIRECTV, LLC (E.D. N.C. 2015). We represented **DIRECTV** in a case brought by Exclaim Marketing involving unfair and deceptive trade practices and cross-claims for trademark infringement. After a seven-day jury trial and post-trial briefing, we not only obtained a complete defensive victory for DIRECTV, but also won substantial damages and a sweeping nationwide permanent injunction against Exclaim.
- Academy of Motion Picture Arts and Sciences v. Lash Fary d/b/a Distinctive Assets (C.D. Cal. 2015). On behalf of the **Academy of Motion Picture Arts & Sciences**, we filed trademark infringement and dilution claims against a company that was using the Academy's famous OSCARS trademark to promote and publicize "gift bags," creating the false impression that the Academy sponsored or was in some way affiliated with the "gift bags." We quickly obtained a consent judgment permanently enjoining the unlawful uses.
- Hanginout, Inc. v. Google Inc. (S.D. Cal. 2014). We represented **Google Inc.** in a case against Hanginout, Inc. Hanginout claimed that Google's use of HANGOUTS infringed Hanginout's alleged common law HANGINOUT trademark. Hanginout moved for a preliminary injunction, but was soundly defeated. The Court's 34-page opinion found in Google's favor on all of the preliminary injunction factors, including likelihood of confusion. The Court's opinion also raised serious doubts that Hanginout even owned common law trademark rights in its alleged mark. The case ended when the plaintiff moved to dismiss its own claims with prejudice.
- Parts.com, LLC v. Google Inc. (S.D. Cal. 2014). We represented **Google Inc.** in a trademark case in which Parts.com alleged that Google impermissibly used its trademark in its AdWords program constituting federal and state trademark infringement, dilution, and unfair competition. In the first decision we are aware of to do so, the Court dismissed all claims against Google at the pleading stage under the doctrine of laches. The Court also found the state law claims barred by the Communications Decency Act's immunity provision.
- Academy of Motion Picture Arts and Sciences v. De La Rosa (W.D. Tex. 2014). Our client, the **Academy of Motion Picture Arts & Sciences**, sued a retailer of counterfeit Oscar statuettes. We asserted claims for copyright infringement, trademark infringement, trademark dilution and false advertising. The Academy was granted judgment on all claims, including a permanent injunction and damages. This case was important to set a deterrent for future infringers who continue to infringe the Academy's intellectual property.
- Chih Lin v. American Rena (Los Angeles Superior Court 2014). We defended **American Rena International Corporation** in a \$25 million breach of contract and fraud lawsuit brought by a former sales representative, defeated the suit on summary judgment, and won summary judgment of liability on American Rena's cross-complaint

for trademark infringement. At the damages trial, we obtained an award of the former sales representative's profits, together with American Rena's attorney's fees and costs.

- J. Christopher Burch, et al. v. Tory Burch, et al. (Del. Ch. 2013). In less than four months, we achieved a highly favorable settlement for **Chris Burch** and his new fashion brand, **C. Wonder**. After Mr. Burch was blocked from selling his interests in Tory Burch LLC—the successful label he co-founded—by Tory Burch and other directors of the Company, we brought claims for breach of fiduciary duties in Delaware Chancery Court before Chancellor Strine. We then pursued an aggressive litigation strategy by convincing Chancellor Strine to grant expedited discovery and proceedings, thereby forcing the company to face the prospect of a trial in six months, or else accept a settlement on unfavorable terms. The confidential settlement resulted in the dismissal of the company's trade dress allegations, and enabled Mr. Burch both to consummate a sale of his interests in Tory Burch LLC in a very successful M&A transaction, and to operate C. Wonder free from the cloud of Ms. Burch's interference.
- Apple v. Samsung (District Court Düsseldorf 2013). We obtained a full defense victory for **Samsung** against Apple in German proceedings regarding various smartphones, defeating alleged unfair competition claims.
- Jurin v. Google Inc. (E.D. Ca. 2012). We won a complete summary judgment for **Google Inc.**, by which all remaining claims that decorative home trim supplier Daniel Jurin had asserted based on Google's advertising programs and trademark policies were dismissed with prejudice. In a comprehensive opinion, the Court held that Google was not liable for trademark infringement (whether direct, contributory, or vicarious) or dilution. The summary judgment order was the ultimate victory in a string of successful motions for Google. At the pleading stage, Quinn Emanuel obtained dismissal of Jurin's state law negligent and intentional interference with contractual relations and prospective economic advantage claims, as well as his unjust enrichment and breach of contract claims. Google also was awarded its costs and fees under Rule 41(d) after Jurin re-filed his case in the Eastern District of California after having dismissed a similar complaint against Google in the Central District of California without prejudice.
- adidas America, Inc. and adidas AG v. Wolverine World Wide, Inc. (D. Oregon 2012). We represent **Wolverine Worldwide, Inc.**, manufactures of casual footwear under well-known brands such as Merrill, Patagonia and Hush Puppies, in a suit brought by adidas America, Inc. in the U.S. District Court of Oregon alleging that certain styles of athletic shoes put out by Wolverine infringe and dilute adidas' Three Stripe trademark.
- Google AdWords litigation. Since 2009 we have represented, and continue to represent, **Google Inc.** in a number of actions primarily alleging trademark infringement in connection with its offering advertisers the opportunity to bid on keywords that include third-parties' trademarks to trigger advertising. In many of those cases—Ascentive LLC v. Google Inc. (E.D. Pa.); Dazzlesmile v. Epic Advertising (D. Utah); Flowbee Int'l, Inc. v. Google Inc. (S.D. Tx., transferred, on our motion, to N.D. Cal.); Groupion, LLC v. Groupion Inc. (N.D. Cal.); and Soaring Helmet Corp. v. Nanal, Inc. (W.D. Wa.), All Star Remodeling, LLC v. YP Advertising & Pub'g, et al (Tenn.)—the plaintiffs voluntarily

dismissed their claims from Google; they simply walked away with no payment or settlement agreement from Google, usually after the first motion we filed in each case. In another case, Jurin v. Google Inc. (E.D. Cal.), we made several successful motions to dismiss, which narrowed the scope of the case, and then obtained summary judgment on all remaining claims.

- Ugglebo Clogs, LLC v. Deckers Outdoor Corporation (D. Minn. 2011). We represented **Deckers Outdoor Corporation** (“Deckers”) in a suit in which Ugglebo Clogs, a Swedish clog manufacturer, claimed that its designation UGGLEBO had priority over the Deckers’s UGG trademark and sought to enjoin the sale of UGG-brand boots nationwide; Deckers filed counterclaims alleging that Deckers had priority and Ugglebo Clogs was, in fact, the infringer. After successfully moving to amend its counterclaims to add a breach of contract claim that would have entitled Deckers to immediate injunctive relief and attorneys’ fees, the parties settled on terms favorable to Deckers.
- Benchmark Capital v. The Benchmark Company (N.D. Cal. 2011). We represented the well known venture capital firm of **Benchmark Capital** in a trademark suit against financial advisor Benchmark Company. The case settled very favorably to Benchmark Capital.
- Moracconoil v. Folica (C.D. Cal. 2010). We represented **Folica** in a false advertising, trademark infringement and counterfeiting lawsuit relating to the domestic and international distribution and sale of consumer salon products.
- Pennzoil/Quaker State v. Nervous Tattoo, Inc. (LA Superior 2010). We represented **Pennzoil/Quaker State** in a trademark action and breach of license agreement relating to the sale of after-market automobile products. The case resolved favorably by the defendant trademark holder providing a license to Pennzoil’s successor.
- Mattel, Inc. v. MGA Entertainment, Inc. (C.D. Cal. 2010). On the trade dress claims in this wide-ranging action, we succeeded in obtaining summary judgment on behalf of **Mattel** in defense of MGA’s trade dress infringement and dilution claims concerning Mattel’s packaging for various Barbie and “Wee 3 Friends” dolls. The trial court agreed that MGA’s asserted trade dresses, including a registered trade dress, were not protectable on two independent grounds: they had not acquired secondary meaning and were functional. The trial court also agreed that even if the trade dresses were valid, there was no likelihood of confusion, and therefore no infringement. In addition, the trial court found the asserted packaging ineligible for protection under the dilution statute and found that Mattel’s accused packaging could not dilute MGA’s as a matter of law because it was too dissimilar.
- Deckers Outdoor Corporation v. Tom Romeo and Romeo & Juliette, Inc. (C.D. Cal. 2010) and Deckers Outdoor Corporation v. Emu Australia, Inc. (C.D. Cal. 2010). We represented **Deckers** in two disputes involving trademark rights associated with Deckers’s famous and popular UGG-brand boots. In the Romeo action, we brought claims against the manufacturer and seller of BearPaw boots—shoddy imitations of Deckers’s most popular boots, including the Classic, the Cardy, and the Sundance II—

for trade dress infringement. In the Emu Australia action, we brought claims against Emu, a manufacturer and seller of pull-on sheepskin boots, for referring to its own boots as “ugg boots” on its website—a blatant attempt to “genericize” the UGG trademark and deprive Deckers of its long-standing U.S. trademark rights in the designs. The firm successfully moved to dismiss Romeo & Juliette’s counterclaims, and successfully the defendants in both actions to voluntarily withdraw multiple affirmative defenses. Both cases thereafter settled on favorable terms.

- Major League Baseball Properties, Inc. v. The Upper Deck Company (S.D.N.Y. 2010). We represented **The Upper Deck Company** (“Upper Deck”) in a lawsuit brought by Major League Baseball Properties, Inc. (“MLBP”) in a trademark dispute over baseball trading cards. MLBP sought a TRO against Upper Deck, alleging that Upper Deck infringed MLBP’s trademarks and trade dress, and breached its contract with MLBP, by selling certain baseball card sets in early 2010 after a license between the parties had expired. Specifically, MLBP sought an injunction barring the sale of three sets of baseball cards that had already been released to Upper Deck distributors. Quinn Emanuel opposed the TRO, arguing that Upper Deck’s use of baseball players in uniform was a fair use of MLBP’s trademarks and trade dress in baseball cards, and that MLBP had not established irreparable injury, given that a license previously existed between the parties. After reviewing Quinn Emanuel’s briefing, MLBP’s motion for a TRO was denied by Judge Sweet, and Upper Deck was able to continue selling its already-released baseball trading sets unencumbered. The parties settled the action shortly after Judge Sweet’s denial of the TRO.
- Louis Vuitton Malletier, S.A. v. Hyundai Motor America (S.D.N.Y. 2010). We represented **Hyundai Motor America** (“Hyundai”) in a dispute concerning the use of a basketball bearing a parodic design of Louis Vuitton’s “LV” design trademark in a television commercial for the 2010 Hyundai Sonata. While Louis Vuitton alleged in its complaint that this use constitutes trademark infringement, the use of the LV design was less than one second long and couched in a 30-second commercial that portrayed humorous combinations of ordinary activities with luxury experiences. Hyundai’s defenses included important discussions of parody, satire, trademark fair use and the First Amendment and led to a favorable settlement agreement for Hyundai.
- Miller International, Inc. v. Clinch Gear, Inc. et al. (D. Colo. 2010). We represented **Collective Brands Inc.** in a dispute between two trademarks: CINCH and CLINCH GEAR. Miller is the owner of CINCH, a trademark used in association with jeans, button-down shirts and marketed exclusively toward rodeo and western-wear enthusiasts. Collective Brands is the owner of CLINCH GEAR, a trademark used in association with mixed-martial arts (“MMA”), grappling, and wrestling performance gear, and marketed exclusively toward MMA athletes and enthusiasts. In defending Collective Brands, we first successfully moved the Court to dismiss six of Miller’s claims, including fraud, conspiracy, and alter-ego liability. Next, we convinced the Court that Miller’s motion for a preliminary injunction was premature, and as a result, the Court instructed Miller to withdraw its motion. The parties then settled on terms favorable to Collective Brands.

- Coty Inc. v. Harvey P. Alstodt; Bruce C. Kowalsky; Diversified Beauty Products (f/k/a MBA Beauty, Inc.); and Harvey P. Alstodt Associates, Inc. (N.Y. State Supreme Court 2010). We obtained a TRO against two former executives of client **Coty, Inc.**, stopping them from violating their covenant not to compete by marketing a nail polish line which, “coincidentally,” consisted of many colors identical to Coty’s line.
- Fifth Avenue of Long Island Realty Associates v. Caruso Management Company, Ltd. (E.D.N.Y. 2010). After a six-day bench trial, we obtained a complete defense victory for **Caruso Management Company, Ltd.** in a trademark infringement action brought in the Eastern District of New York. The Court not only found that Caruso did not infringe or dilute any of Plaintiff’s trademarks, but granted Caruso’s counterclaim and canceled Plaintiff’s federal registration of the AMERICANA mark. This lawsuit, which sought disgorgement of profits and a permanent injunction preventing Caruso from using the name THE AMERICANA AT BRAND for its town center development in Glendale, California, was critically important to Caruso since the Plaintiff strategically filed suit a few short months before Caruso’s town center was scheduled to open to the public, and after a significant amount of time and money had been invested in promoting THE AMERICANA AT BRAND name throughout the Los Angeles area.
- Rosetta Stone Ltd. v. Google Inc. (E.D. Va. 2010, 4th Cir. 2012). At the pleading stage, Quinn Emanuel obtained dismissal of Rosetta Stone’s false endorsement claim under 15 U.S.C. 1125(a) and its state law business conspiracy and unjust enrichment claims. We then won a complete summary judgment for **Google Inc.**, by which all remaining claims that language software provider Rosetta Stone had asserted based on Google’s advertising programs and trademark policies were dismissed with prejudice. In a lengthy opinion, the Court held that Google was not liable for trademark infringement (whether direct, contributory, or vicarious) or dilution. On appeal, the Fourth Circuit upheld the ruling on vicarious infringement and dismissal of the unjust enrichment claims, agreed with our legal analysis of the dilution claim, and found disputed issues of fact on the direct and contributory infringement claims and remanded those issues. We then moved in limine to lay the grounds for a new summary judgment motion. Following argument on that motion, the case quickly resolved.
- Dallas Cowboys Football Club and NFL Properties v. America’s Team Properties (N.D. Tex. 2009). We obtained summary judgment for clients the **Dallas Cowboys** Football Club and NFL Properties LLC in a dispute concerning ownership of the trademark **AMERICA’S TEAM** in federal district court in Dallas, Texas. The Defendant in the case, a Minnesota-based company, claimed that it owned the rights to the famous trademark because it had obtained a federal registration in 1990. We were tasked with proving that the Cowboys rights in “America’s Team” were superior to those of Defendant, notwithstanding that the Cowboys did not own a federal trademark registration for the mark. In a forty-page decision the Court granted the Cowboys and NFL Properties summary judgment on all claims, finding that they had proven federal and common law trademark infringement, unfair competition, dilution and that Defendant had committed fraud on the on the United States Patent and Trademark Office. America’s Team—a nickname understandably despised by rivals of the Dallas

Cowboys—remains today, as it has been for decades, an enduring part of the Cowboys’ great legacy.

- Autodesk v. Dassault SolidWorks Systemes, 685 F. Supp.2d 1023 (N.D.Ca. 2009). We represented **Dassault SolidWorks** in a false advertising, false designation of origination and unfair competition suit involving CAD software marketing. The case settled the day the jury was to be picked, in no small part because of a ruling following a SolidWorks summary judgment motion holding that Autodesk’s claimed “dwg” file format was unprotectible as a trademark and could be used by any Autodesk competitor in competing products.
- LDM Group v. Catalina Marketing (E.D. Mo. 2009). We represented Catalina Marketing in the defense of a false advertising suit related to the field of electronics coupon distribution. The suit settled very favorably to Catalina Marketing.
- George V Restauration S.A. and Creative Designs for Restaurants and Bars, Ltd. v. Little Rest Twelve, Inc. (N.Y. App. Div. 1st Dept. 2009). We represented **George V** and **Creative Designs**, owners of the world-famous (and federally-registered) **BUDDHA-BAR** trademark and proprietary restaurant concept in a case brought against their former licensee for trademark infringement and dilution regarding their unauthorized use of the BUDDHA BAR trademark and concept in connection with a Manhattan restaurant. The Appellate Division of the Supreme Court, First Department, reversed the trial court’s denial of our clients’ motion for preliminary injunction and held that the small disclaimer placed on defendant’s website was not sufficient to dispel likely consumer confusion.
- adidas America, Inc. v. Payless ShoeSource, Inc. (9th Cir. 2009). We represented **Payless ShoeSource, Inc.** on the appeal to the Ninth Circuit of a jury verdict rendered against it in the United States District Court for the District of Oregon finding that Payless infringed adidas’ trademark and trade dress and awarding adidas over \$66 million dollars in damages. On appeal, Payless argued that the district court erred by, *inter alia*, allowing the jury to hear consumer survey evidence that tested allegedly infringing shoes put out by manufacturers other than Payless, by permitting monetary damages for post sale confusion absent a showing of any actual injury and based upon a reasonable royalty theory and by failing to dismiss adidas’ trademark dilution claims because Payless used the allegedly infringing stripes as decoration. Although the case settled before the argument, we helped Payless reduce the largest trademark verdict in history.
- Pro-Football, Inc. v. Harjo (U.S. Supreme Court 2009). In defending the long-running challenge by six Native American petitioners to the **Washington Redskins’** trademark registrations, we employed the infrequently used “de novo” appeal to the D.C. District Court to overturn an adverse decision by the Trademark Trial and Appeal Board. The decision was appealed by the Native Americans to the D.C. Circuit, which found no abuse of discretion and affirmed the grant of summary judgment in all respects. The petitioners next filed a petition of certiorari with the U.S. Supreme Court, arguing that the Circuit Courts are split as to whether laches is available as a defense to the

cancellation of an allegedly disparaging trademark. Quinn Emanuel opposed the petition, arguing that no such split existed. The U.S. Supreme Court denied the petition in November 2009, thus ending the case. It was a complete win for Quinn Emanuel's clients Pro-Football and the Washington Redskins.

- PlayShare PLC v. Societe des Bains de Mer et du Cerle des Estrangers a Monaco (S.D.N.Y. 2008). We represented Société des Bains de Mer et du Cercle des Etrangers à Monaco ("SBM"), the founder and manager of Monaco's five casinos, including the famous **Casino de Monte-Carlo**, in an action against PlayShare, an online casino gaming operating operator in the District Court for the Southern District of New York. SBM alleged that the PlayShare's Grand Monaco Casino website and use of at least 100 domain names employing the terms "Monaco," "Monaco Casino," or variations thereof in connection with the online casino website constitutes unfair competition, trademark infringement, and cybersquatting. Our representation led to a quick and favorable settlement agreement for SBM.
- Yuri Kucklachev v. Mark Gelfman (E.D.N.Y. 2008). We represented **Ticketmaster L.L.C** ("Ticketmaster") in an action for trademark and copyright infringement, unfair competition, and violations of the right of publicity, brought by Plaintiffs, who purport to be world famous clowns, brought this action against the Gelfman Defendants, the plaintiff's former U.S. promoter. The complaint alleges that in 2007, after the Plaintiffs returned to Russia after a successful U.S. tour their show entitled "Moscow Cats Theatre," the Gelfman defendants misappropriated the Plaintiff's show, including its title and copyrighted cat-tricks, conducting performances in the United States without Plaintiffs' consent. Ticketmaster was among a set of named Defendants who unknowingly sold tickets to the allegedly infringing show. Plaintiffs moved for a preliminary injunction prohibiting all of the Defendants from continuing to sell tickets to the allegedly infringing show. On the strength of the briefing submitted by Quinn Emanuel on behalf of Ticketmaster, the Court denied Plaintiffs' request for injunctive relief against Ticketmaster and Defendant Onlineseats.com (who had not yet appeared in the action, but was deemed to be similarly situated to Ticketmaster) on the grounds that that Plaintiffs failure to put Ticketmaster on notice of the alleged infringement for well over a year precluded the possibility of injunctive relief. An injunction did issue, however, against all of the other appearing Defendants.
- Argus Research v. Argus Media (D. Conn. 2008). We were retained by the board of an **English publishing company** when trademark and fraud claims filed by a U.S. equity research firm proved intractable. With our client's regular IP counsel, we conducted depositions to support a successful multi-faceted motion gutting all but a single claim, and moved in limine to strike all three of the plaintiff's experts. The case settled shortly thereafter with a global co-existence agreement and no payment by our client.
- CMG Worldwide v. The Upper Deck Company (S.D. Ind. 2008). We defended **Upper Deck** in a suit alleging the use of various images and signatures of deceased baseball players that had previously been licensed to Upper Deck but were then exclusively licensed to Topps. We were hired after a TRO issued enjoining our client's usage of certain player images in its entire line of 2008 trading cards. We succeeded in

overturning the TRO several days later, persuaded the court to transfer the case from Indiana to New York, and moved to dismiss the plaintiff's claims, which motion is pending.

- The Romantics v. Activision Publishing, 532 F. Supp. 2d 884 (E.D. Mich. 2008). We defeated a lawsuit seeking to enjoin **Activision's** sales of its phenomenally popular "Guitar Hero" videogame, brought by members of the '80s rock band "The Romantics," who asserted that the use of their signature song "What I Like About You" in the game violated their rights of publicity and constituted an implied endorsement. We later secured a complete dismissal on the merits, effectively validating the business model underpinning the billion-dollar "Guitar Hero" franchise. *See* 574 F. Supp. 2d 758.
- Gillette v. Dorco (D. Mass. 2008). Representing **Pace Shave** and various **Dorco** entities as defendants, we successfully obtained an early, cost-effective global settlement in a razor-industry litigation involving eleven patents spanning over 250 claims, as well as numerous assertions of trademark and trade dress.
- Bouchat v. Bon-Ton Department Stores (4th Cir. 2007). In the first phase of this case, we defended the **NFL** and **Baltimore Ravens** against claims brought by an artist regarding the Raven's helmet logo. After the NFL and Ravens – represented by a different firm – lost on liability, we tried the damages case. We obtained a verdict of no damages and persuaded the jury that the logo did not derive any revenue-generating activity and that our clients' large revenues were solely the result of the inherent power of the NFL brand and the sport itself. The verdict was affirmed by the Fourth Circuit and the Supreme Court denied *cert.* Later, we prevailed on behalf of hundreds of licensees in separate actions on the basis of claim preclusion principles, again through the 4th Circuit and the U.S. Supreme Court.
- Applied Information Sciences v. eBay Inc. (C.D. Cal., 9th Cir. 2007). We obtained summary judgment for **eBay** against trademark infringement and unfair competition claims related to its use of the terms "Smart Search" as the label for a hyperlink on its website home page. The Ninth Circuit affirmed summary judgment in eBay's favor. 511 F.3d 966 (9th Cir. 2007).

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