

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

# Our US Litigation Practice

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## INTRODUCTION

Fross Zelnick is a premier intellectual property law firm devoted exclusively to trademark, copyright, false advertising and right of publicity matters. Approximately one-third of our lawyers focus on US litigation, handling virtually every type of lawsuit in our field.

Our litigators are experienced in handling all phases of lawsuits — from preliminary injunction motions to bench and jury trials and appeals, as well as alternative dispute resolution and negotiation of favorable and cost-effective settlements for our clients.

Leading global corporations trust us to represent them and to protect their valuable marks and copyrighted properties. Our substantive knowledge, courtroom skills, and depth of experience are widely recognized by judges and adversaries. We have won a long list of high-profile cases, making new law in the process, and prevailing against prominent US general practice and IP firms. What is more, we do this cost-effectively and efficiently.

CLINIQUE

CHANEL

SPEEDO

MOVADO  
the art of time



just imagine...

“As a result of Fross Zelnick’s expertise in the field of copyright law, it does not expend any extra time to understand the issues involved in a copyright case, and therefore spends only a reasonable number of hours to litigate the case.”

US District Judge Colleen McMahon  
Crown Awards, Inc. v. Discount  
Trophy & Co. (S.D.N.Y. 2008)

## OUR ATTORNEYS

Fross Zelnick has one of the largest and most seasoned litigation departments exclusively dedicated to handling trademark, copyright, false advertising and right of publicity cases. We hire only well-credentialed, trained attorneys (as opposed to hiring directly out of law school). Our reputation has enabled us to selectively recruit some of the “best and brightest” who graduated from the nation’s leading law schools — including Harvard, Columbia, NYU and Stanford — and who learned their litigation skills at large corporate law firms such as Davis Polk, Cravath, Debevoise, Paul Weiss, and Skadden Arps.

Our lawyers have lectured extensively and have held senior positions in the leading trade associations in our field, including the International Trademark Association, the Copyright Society of the USA and the American Intellectual Property Law Association. One of our partners is also an adjunct professor at Columbia Law School, where he teaches a seminar in Trademark and Copyright Litigation.

More than one-third of the lawyers in our Litigation Department held prestigious clerkships with federal judges, including in the US Courts of Appeals for the Second and Sixth Circuits and the US District Courts for the Southern and Eastern Districts of New York and Northern District of California.

In general practice firms and patent-oriented IP firms, trademark and copyright law often have secondary importance, and lawyers are not always well versed in those fields. At Fross Zelnick, however, our litigators all have a demonstrated commitment to trademark and copyright law and are focused on excellence in our areas of IP practice. Simply put, our clients have access to top litigators with unrivaled experience, knowledge and sophistication in our field.

### Trademark, Trade Dress and Unfair Competition

Fross Zelnick has litigated countless trademark and unfair competition cases in courts across the country, protecting famous marks such as CHANEL, LACOSTE, CHAP STICK, SPEEDO and VEUVE CLICQUOT. We have handled cases involving every kind of trademark issue — from validity and ownership to infringement and fair use.

Our pre-eminence in trademark litigation has been recognized year in and year out. Most recently, we were one of three firms (and the only boutique firm) named in the top-tier of trademark litigators in the 2008 *Managing Intellectual Property* survey.



We have won a series of leading trademark cases involving characters and other entertainment properties, including BATMAN, TARZAN, THE RUGRATS and THE BRIDGE OVER THE RIVER KWAI.



We successfully argued to the US Court of Appeals for the Federal Circuit that VEUVE ROYALE was confusingly similar to our client's famous VEUVE CLICQUOT mark.

### Copyright

Fross Zelnick has litigated some of the leading cases in almost every area of copyright law. We regularly handle copyright infringement claims and ownership disputes involving websites, photographs, advertisements, books, movies, television programs, music, characters, artwork, textile designs, computer software and video games.

In a seminal fair use case under the 1976 Copyright Act, Roger Zissu successfully litigated the infringement claim brought by Harper & Row and Reader's Digest against The Nation magazine, which had printed excerpts of President Ford's memoirs without permission.



Roger Zissu

Harvard Law School, LL.B.,  
cum laude, 1963

Clerkship: Hon. John F. Dooling, Jr.,  
US District Judge, Eastern District  
of New York, 1963-1965

Placed in the first tier of copyright  
and trademark practitioners in  
New York by *Chambers USA* 2008

For example, in a case brought by Disney and the granddaughter of A.A. Milne — who were represented by copyright treatise author David Nimmer and a team of big-firm lawyers — Roger Zissu and David Donahue thwarted the plaintiffs' effort to terminate a grant of WINNIE THE POOH merchandising rights to our client and to cut off royalties valued in the range of \$100 million. In a case of first impression, we prevailed on appeal before the Ninth Circuit, which affirmed summary judgment in our client's favor.

### Recent Highlights

We represented Warner Brothers Entertainment and DC Comics in a multi-million dollar copyright action brought by the heirs of the creators of SUPERMAN, helping to obtain a series of successful decisions involving issues of infringement, statutory termination of transfers, the overlap of copyright and trademark law, and complex ownership issues under the 1909 Copyright Act.



**John Margiotta**

Harvard Law School, J.D.,  
cum laude, 1996

Columbia University School of  
Journalism (M.S. 1997)

Adjunct Professor, Brooklyn Law  
School, 2004 (Trademark Law)

John Margiotta led the team that recently secured a \$2.1 million judgment for our client Kam Hing Enterprises, Inc., a major manufacturer of bedding products, in a copyright infringement case against both a competing manufacturer and a global big-box retailer. After prevailing on a summary judgment motion to determine the defendants' liability for an infringing fabric design, we then won the monetary award after a bench trial to determine the defendants' profits from the infringement. These decisions were both affirmed on appeal by the United States Court of Appeals for the Second Circuit.

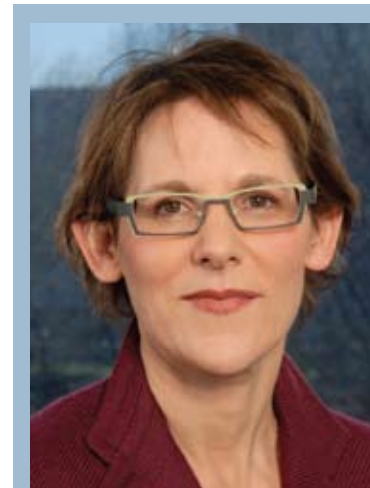
### Rights of Publicity

Fross Zelnick has litigated a number of the leading right of publicity cases in various states. For example, Barbara Solomon successfully defended the grandson of jazz legend Cab Calloway in a lawsuit seeking to enjoin his use of the Cab Calloway name for a tribute band, and won affirmance in the Second Circuit Court of Appeals. Barbara was also retained by the Estate of Diana, Princess of Wales, to take over a Ninth Circuit appeal against the Franklin Mint in a case of first impression addressing the availability of post-mortem rights of publicity for a UK citizen under California's right of publicity laws.

### Idea Submission and Misappropriation

We have litigated numerous cases involving idea submission, misappropriation and similar state law claims. We obtained summary adjudication for The Jim Henson Company, Viacom and Simon & Schuster in California state court on the plaintiffs' primary claims in an idea submission dispute concerning various children's entertainment properties,

including Blue's Clues and Bear in the Big Blue House. On behalf of the National Basketball Association, we won a trial in the US District Court for the Southern District of New York against the makers of a handheld device providing real-time scores and other data for basketball games.



**Barbara Solomon**

Harvard Law School, J.D.,  
cum laude, 1984

WIPO panelist for cases brought  
under the UDRP

Frequent lecturer on Internet-  
related trademark issues,  
domain names, rights of publicity,  
fair use and licensing.

### Internet and New Media Conflicts

Fross Zelnick has handled a number of the leading cases involving the Internet and emerging technologies. Roger Zissu successfully argued in the Second Circuit on behalf of Rosetta Books that Random House's contractual right to publish novels by Kurt Vonnegut, William Styron and Robert Parker did not extend to the electronic publication rights exploited by our client.

We filed the first lawsuit to recover a domain name (mtv.com) in 1994, and have successfully prosecuted numerous claims under the later-adopted Anticybersquatting Consumer Protection Act (ACPA) in addition to recovering thousands of domain names through Uniform Domain-Name Dispute-Resolution Policy (UDRP) arbitration proceedings and enforcement actions.

On behalf of a major US brewery, we defeated a motion for a preliminary injunction brought by a competitor claiming that our client's television and radio commercials disparaged its beer.

### Contractual Disputes

We frequently litigate commercial matters involving intellectual property, including disputes under licenses and coexistence agreements.

In a leading Second Circuit case, Roger Zissu and Craig Mende defeated an effort by the owner of *Field & Stream* magazine to terminate trademark coexistence agreements with the maker of FIELD & STREAM merchandise, winning more than \$1.8 million in damages in a trial on our client's counterclaim for breach of the agreements.

### False Advertising

We also represent clients in false advertising proceedings both in court and before the National Advertising Division of the Better Business Bureau.



### Anti-Counterfeiting Enforcement

Fross Zelnick has implemented enforcement programs, including John Doe warrants and seizures, for a number of leading brand owners to stop the distribution of counterfeits and other knock-offs. We also have a dedicated team that monitors the Internet to identify counterfeits and remove them from online commerce. The team has recovered hundreds of thousands of dollars for our clients.

### Multi-Jurisdictional Disputes

Our firm has extensive experience protecting trademarks and copyrights internationally. We have the familiarity with foreign IP laws and the relationships with foreign IP counsel that are necessary to effectively litigate multi-jurisdictional disputes and negotiate comprehensive worldwide agreements. For example, John Margiotta worked with members of our International Department to defend a watch manufacturer against suits in multiple jurisdictions — including a claim for copyright and trade dress infringement in the US and claims for industrial design infringement in the UK and Switzerland — which resulted in a favorable global settlement for the client.



Craig Mende

New York University School of Law, J.D., magna cum laude, 1991.  
Elected to the Order of the Coif.

Clerkship: Hon. Alan E. Norris, US Court of Appeals, Sixth Circuit, 1991-1992.

Named one of the “Top 50 under 45” intellectual property lawyers by *IP Law and Business* in 2008

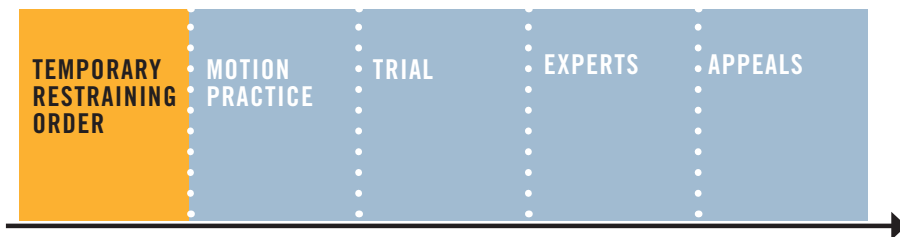
The members of our Litigation Department have unparalleled depth in their areas of intellectual property law, but first and foremost they are litigators, adept at handling every phase of litigation.

## Temporary Restraining Orders and Preliminary Injunction Motions

Because intellectual property owners can suffer irreparable harm if an infringer is permitted to continue its activities until trial, our clients frequently need us to secure urgent injunctive relief. With vast experience in this area, we can prepare TRO and preliminary injunction motion papers on a few days' notice, and our litigators have the knowledge and experience to think on their feet during fast-moving proceedings for preliminary relief.

We have also been successful in defeating preliminary injunction motions brought against our clients. For instance, in an action named one of the "Ten Favorite Trademark Cases" of the year by *IP Worldwide* and [www.law.com](http://www.law.com), Richard Lehv and John Margiotta defeated an Illinois spa that sought to enjoin our client from operating its own spa and selling products under its BLISS mark in Illinois. (We also won the appeal in the Seventh Circuit.) In another recent case, on behalf of singer/actress Jennifer Lopez and her licensee, Coty, a Fross Zelnick team including James Weinberger defeated a motion to enjoin the launch of the GLOW BY J.LO fragrance line. We have also defeated preliminary injunction motions brought against Movado, Sony Corp., Columbia House, Davidoff and many others.

We secured a preliminary injunction against the use of frozen dessert packaging held to violate the FROZFRUIT trade dress of our client.



## Motion Practice

From years of experience, our litigators know the “ins-and-outs” of motion practice in the federal courts. For example, when a Big Four accounting firm and a related intellectual property holding company were served with a declaratory judgment action in California by a West Coast media company, Craig Mende and David Donahue filed a rival infringement action in New York on behalf of our clients. They then won a dismissal of the California action against the holding company due to lack of personal jurisdiction, and a transfer of the remainder of the case to New York.

We also have a long track record of winning motions to secure victory before trial. Most recently, David Donahue successfully defended an appeal from the New York Supreme Court’s dismissal of defamation, intentional infliction of emotional distress, and fraud claims arising out of a 9/11-related *Dateline* television program on the grounds that our clients — two documentary filmmakers — were not subject to jurisdiction in New York State.

In a trademark infringement case involving movie titles, Fross Zelnick achieved the same results for our client at trial that a large firm with 600+ lawyers achieved for the co-plaintiff, but at two-thirds of the overall cost. Both plaintiffs were granted an injunction and an award of attorneys’ fees.



Laura Popp-Rosenberg

Columbia University School of Law,  
J.D., 2000

Harlan Fiske Stone Scholar

Special Issue Editor, Columbia  
Journal of European Law.

Clerkship: Alvin K. Hellerstein,  
United States District Court for the  
Southern District of New York  
2001-2002

## Trials

Over the years, our litigators have won significant trademark and copyright trials before both judges and juries. From decades of trial experience, we know how to present the issues and zero in on the critical evidence in a case to persuade judges and juries to rule for our clients.

In one recent example, on behalf of the owners of the famous DE BEERS mark, Barbara Solomon and David Donahue successfully tried claims for trademark infringement, trademark dilution and unfair competition to prevent unauthorized use of the DE BEERS trademark to sell diamonds over the Internet.

Richard Lehv recently won a copyright infringement trial in which the court ruled that the defendant's trophies were "strikingly similar" to our client's popular Spin Trophy, and granted a permanent injunction and an award of profits and attorneys' fees.

The Second Circuit recently affirmed this decision.

We successfully defended The Jim Henson Company's use of Spa'am as a character at trial in a landmark trademark case against Hormel. We also won on appeal in the US Court of Appeals for the Second Circuit.



**David Donahue**

St. John's University School of Law, J.D., magna cum laude, 1998

Clerkships: Hon. Milton Pollack, District Judge, United States District Court for the Southern District of New York, 1998-1999;

Hon. Joseph M. McLaughlin, Circuit Judge, United States Court of Appeals for the Second Circuit, 2001-2002

# ALL PHASES OF LITIGATION

## Experts

We have worked with almost all of the top US trademark survey experts to design and carry out consumer perception surveys used at preliminary injunction hearings and trials. As a result, we have unparalleled skills in attacking survey evidence submitted by our adversaries, which is often crucial to success at preliminary injunction hearings in trademark cases.



Richard Lehv

Columbia University  
School of Law, J.D., 1972

Harlan Fiske Stone Scholar

Adjunct professor at Columbia  
University School of Law,  
where he teaches a seminar  
on federal court trademark and  
copyright litigation.

Richard Lehv won summary judgment dismissal of a trademark case by establishing that the mark **BREAK & BAKE** for frozen cookie dough was merely descriptive. Richard successfully attacked a consumer survey submitted by the plaintiff, securing a ruling that the survey was “completely untrustworthy and unreliable.” The court also awarded our client attorneys’ fees, and the plaintiff’s trademark registration was cancelled.



## Appeals

We handle appeals in the federal courts around the country, both for clients we represented at trial and for clients that wish to bring in new appellate counsel. For example, we were recently retained by Timex to appeal a jury verdict in a copyright and trademark infringement case involving the unauthorized use of surf video excerpts in TIMEX trade show materials. Roger Zissu and John Margiotta convinced the Ninth Circuit to vacate the entire profit award of \$2.1 million as unduly speculative and cut the damage award by another \$200,000 on the same grounds. On remand to the district court we secured dismissal of the plaintiff's trademark infringement claims, and then successfully defended a second appeal concerning the dismissed claims.

In a case of first impression involving “restored” copyrights in works of foreign authors, Craig Mende recently secured a preliminary injunction and then won an appeal in the Second Circuit. The Court ruled that our client, copyright owner of the famous fuzzy-haired Good Luck Troll, could enforce its copyright against the seller of Wish-nik dolls. We successfully argued that our client's copyright had been restored from the public domain after forfeiture in the 1960s, and that the defendant's dolls infringed the restored copyright.

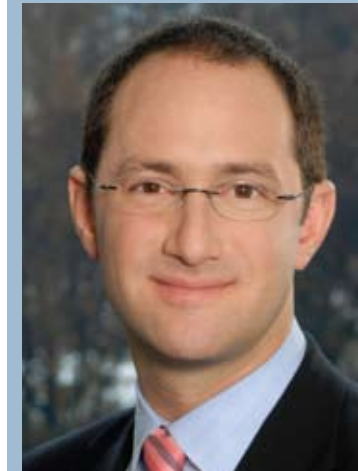


## Arbitrations, Mediations and Settlements

While we prepare every case with a view toward trial, in many instances we are able to negotiate favorable settlements without the expense of a trial. Settlements do not always come easily, but our experience enables us to find weaknesses in our adversary's case and create opportunities for settlement when that is our client's goal.

For plaintiffs, we have negotiated large settlement payments, as well as consented injunctive relief and/or phase-out agreements. For defendants, we have negotiated licenses and coexistence agreements, creatively protecting clients confronted with infringement claims by others.

In addition, our attorneys have achieved positive resolutions for clients through arbitration and mediation proceedings in all parts of the country, both through private arbitration and mediation services and through court-sponsored procedures. Some of our partners have



James Weinberger

Columbia University School of Law,  
J.D., 1999

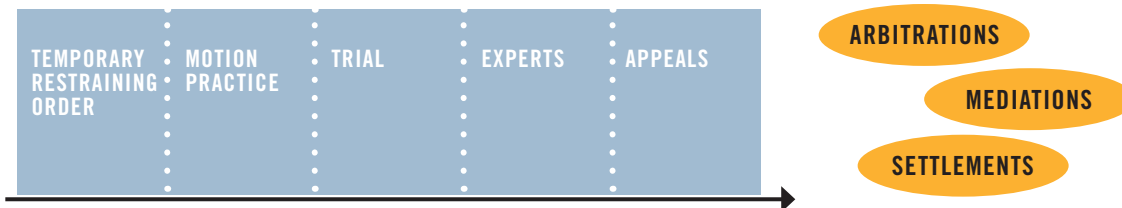
Harlan Fiske Stone Scholar

Recipient, Carroll G. Harper Prize  
for excellence in intellectual  
property studies

Guest Instructor: Columbia-VLA  
Clinical Seminar in Law and the Arts,  
Columbia University School of Law

been selected to serve as mediators, arbitrators and even expert witnesses in such proceedings.

We also know when not to settle. In one recent case, a cybersquatter appealed a domain name arbitration in our client's favor to a US district court and simultaneously asserted a claim to cancel our client's famous marks, alleging that they had become generic. With the cybersquatter seeking a high six-figure payout, and discovery looming, we successfully moved to dismiss the genericness claim. His leverage gone, the cybersquatter capitulated to a settlement requiring him to return the domain names in question without payment.





Over the years, clients have told us that our fees are significantly lower than those of the large corporate firms we regularly (and successfully) litigate against. How do we do it?

### **Appropriate Staffing**

Given the depth of our knowledge in our field, we do not need to enlist scores of lawyers to learn the law, analyze the issues or formulate and execute a strategy for success. Although we have a deep bench to staff large trial teams as needed, our typical staffing includes one partner and one associate during most phases of litigation. This is in stark contrast to the teams of general practice lawyers we often litigate against and defeat.

According to data compiled from recent news accounts, Fross Zelnick's average partner hourly rate is approximately 40% less than the average for large corporate US law firms.

### **No "On-The-Job" Legal Training**

We have no summer associate program and do not hire associates straight out of law school. As a result, our clients do not fund "on-the-job" litigation training.

### **There are Few Issues in Our Field That We Have Not Already Addressed**

Our litigators are thoroughly familiar not just with the major precedents, but also with the nuances that would escape lawyers with less experience in our field. In fact, we have litigated many of the key cases that are taught in law schools every day. Our lawyers can quickly determine and focus on the material issues in a case without taking the time to "get up to speed" on trademark and copyright law basics. And, because we focus almost exclusively on trademark and copyright law, there are few issues in these areas that we have not already encountered and litigated.


### **Competitive Hourly Rates**


As a firm focused exclusively on IP law with comparatively low overhead, our hourly rates are considerably lower than those of most large corporate law firms.




## AWARDS & ACCOLADES


Our litigators have been recognized as leaders in the field year after year. In addition to individual honors, in 2008 our litigators were named top trademark litigation team by *Managing Intellectual Property* magazine and we were identified as one of two firms in *Legal 500's* first tier of trademark litigation firms. Selected additional honors are listed below:


 In 2010, *Chambers USA* ranked **Roger Zissu**, **Richard Lehv**, **John Margiotta** and **James Weinberger** as Leaders in their Field in the area of Intellectual Property: Trademark and Copyright.


 **Roger Zissu**, **Barbara Solomon** and **Craig Mende** were all included in the 2009 edition of *New York Super Lawyers*.


 In 2008 and 2009, **Richard Lehv** and **Barbara Solomon** were recognized in *Euromoney's Guide to the World's Leading Trade Mark Law Practitioners*.


 In 2008, *Chambers USA* placed **Roger Zissu** in the first tier of trademark and copyright practitioners in New York. The rankings are based on conclusions drawn from more than 14,000 interviews of law firm attorneys and clients. In 2007 and 2008, **Fross Zelnick** also received a number one ranking for trademark and copyright law from *Chambers USA*.


 In 2008, **Craig Mende** was named one of the "Top 50 under 45" intellectual property lawyers by *IP Law and Business*


 **Fross Zelnick** has repeatedly been ranked #1 by our clients and peers in *Managing Intellectual Property* ("MIP") magazine's annual survey of trademark law firms.


 At MIP's 2008 North American awards dinner Fross Zelnick Lehrman & Zissu was identified as "the quintessential IP firm." **David Donahue** and **James Weinberger** were praised for having "significantly boosted the firm's depth in trademark and copyright litigation matters."


 In 2008, **Fross Zelnick** was named "Global Trademarks Law Firm of the Year" for the third consecutive time by the *International Who's Who of Business Lawyers*.

 In 2007, *Legal 500* recognized **Barbara Solomon** as a "key contact for US contentious matters," **Craig Mende** as a "copyright and trademark litigator...[who is] emerging as one of the firm's go-to attorneys for advice on anti-counterfeiting enforcement measures" and **Roger Zissu** as "superb, a truly great lawyer."

 In 2008, *Legal 500* placed **Fross Zelnick** among the top-ranked firms specializing in copyright and trademark litigation. The guide described Fross Zelnick's copyright group as "pre-eminent worldwide for copyright matters" and in the field of trademark litigation enthused, "whatever the question, there is always someone there who can answer it." **Roger Zissu**, **Craig Mende**, **David Donahue**, and **James Weinberger** all received individual mention.

 In 2008, **Fross Zelnick** was placed in the top tier of US trademark litigation firms in the MIP Survey.

 **Roger Zissu** was profiled in the September 2008 edition of *New York Super Lawyers* and our litigation partners **Richard Lehv** and **Barbara Solomon** were also listed as *Super Lawyers*.

 In 2006, 2007 and 2008 both **Richard Lehv** and **Roger Zissu** were selected by their peers for inclusion in *The Best Lawyers in America Guide* and were also selected for the Best Lawyers in New York issue of *New York Magazine*.

# FROSS ZELNICK LEHRMAN & ZISSU, P.C.



We are proud of the firm's litigation capabilities, professional awards and long track record of success, and are honored by the trust that major rights owners have placed in us to protect their valuable brands and properties. We strive to create value for our clients by exceeding their expectations — both in the results we achieve and our efficiency in achieving them.

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