TRADEMARKS AND TRADEMARK LITIGATION

Our Clients

We protect some of the most famous brands in the world across a variety of industries, including retail, apparel, consumer products, sports, hospitality, insurance, technology, media and entertainment. We also represent individuals in claims of rights to publicity.

Our Services

Long recognized as being on the cutting edge of trade identity protection, Katten's Trademark attorneys and litigators handle a wide range of matters involving trade names, trademarks, service marks, trade dress, logos, taglines, slogans, designs and domain names. Our team guides clients in the development of trade identity rights and actively works to protect those rights and defend claims should litigation ensue.

We evaluate thousands of trademarks searches every year and counsel clients on their availability for use. In addition, we police our clients' marks to ensure that no attempted registration or use threatens the rights of our clients, and evaluate and render opinions on potential conflicts among trademark users. Our trademark attorneys also prepare, prosecute and maintain trademark applications and registrations in the United States and around the world.

Katten's skilled trademark litigators offer pre-litigation counseling and effective representation in courtrooms across the United States and before the Trademark Trial and Appeals Board. Clients turn to us to handle expedited proceedings involving temporary restraining orders and motions for preliminary injunction. We have successfully defended infringement actions involving defenses of invalidity of plaintiffs' marks, lack of likelihood of confusion, fair use, the First Amendment and fraud, as well as equitable defenses such as laches, unclean hands and estoppel. Our team offers significant experience in all types of business torts and defamation claims as well as advertising law, including cases

RECOGNIZED BY

- **Chambers USA**
- **The Legal 500 United States**
- **Managing Intellectual Property IP Handbook**
  - Trade Mark Contentious (United States) 2014
  - Trade Mark Prosecution (United States) 2014
  - “Highly Recommended” firm for intellectual property (Illinois) 2014, 2013
- **U.S. News – Best Lawyers® “Best Law Firms”**
- **World Trademark Review 1000**

Whenever possible, we work to achieve dismissal well before trial. Our team includes several experienced mediators who can resolve disputes in an advantageous manner, alleviating the need to continue protracted and expensive litigation.

With a strong group of attorneys equally skilled at counseling and prosecuting and defending claims, Katten's Trademarks and Trademark Litigation practice offers clients a complete solution for protecting their trade identity.

Our Experience

- Representation of Aéropostale, Inc. in a lawsuit against H&M Hennes & Mauritz AB regarding claims of trademark infringement, false designation of origin, dilution and counterfeiting under the Lanham Act, and state law causes of action. The suit, filed in the US District Court for the Southern District of New York, contended that H&M sold items that infringed on Aéropostale's trademarked phrase "Live Love Dream," and its "Aéropostale" and "87" trademarks. Under the terms of the consent injunction, H&M is permanently enjoined from manufacturing, importing or exporting any clothing, fashion accessories or related goods that incorporate any of the subject trademarks, and from distributing, licensing or in any way promoting merchandise that contains Aéropostale trademarks in any US retail store or through any website owned or controlled by H&M that is targeted toward US consumers.

- Defense of Aéropostale, Inc. against trademark and trade dress infringement allegations asserted by AirWair (makers of the DOC MARTENS brand of boot). AirWair filed more than 12 complaints against multiple retailers and brand owners, each alleging trademark and trade dress infringement, relating to the sale of a variety of combat boot-styled footwear. The case was ultimately settled and resolved in a confidential settlement agreement. Of note, as a result of the allegations asserted by AirWair’s counsel and their perceived scope of intellectual property rights, Katten worked with several clients to develop consistent guidelines for their own designs of combat boot-style footwear in manners that did not infringe (and could not support allegations of infringement) rights that AirWair has asserted in litigation. Interestingly, as a result of the litigations filed by AirWair, and as a result of these and similar guidelines developed by other advising counsel, the market/style trend towards this type of footwear appears to have shifted in order to avoid litigation claims.

- Representation of Agave Loco LLC in connection with a successful federal court ruling against Sazerac Co. Inc., where the parties reached a confidential settlement. Sazerac named its new signature drink "Orchata," confusingly similar to Agave Loco's already enormously popular RumChata rum liqueur drink. Katten argued that respected research shows RumChata and Chata drinks are now the most-asked-for such liqueurs in the United States as its makers announced the sale of their two-millionth bottle in 2012.

- Representation of Arcadia Group Brands Ltd. in connection with protecting TopShop, one of the most famous brands in fashion with a tremendous international value, through ongoing federal litigation in the United States (with related actions pending abroad) and by dealing with rights to a mark which achieved fame overseas before substantial recognition was reached in the United States. Katten’s representation included a matter against Slovenian company Studio Moderna involving rights to the Topshop brand for retail services in the United States, although the case was global in scope. Resulted in favorable confidential global settlement.

- Representation of a global paints and chemical coatings company on intellectual property matters, including handling and coordinating trademark infringement litigation and disputes in Europe, multiple Community Trade Mark proceedings, and multiple trademark disputes and administrative oppositions in China, Brazil, Columbia, India and other countries involving the client's house mark and other trademarks through foreign counsel. On prosecution, we handle approximately 1,550 trademarks globally, using our network of trademark lawyers in every country in the world.

- Representation of Bausch & Lomb Incorporated in connection with trademark litigation arising out of its corporate tagline "See Better. Live Better" mark. Katten successfully argued against a Florida
ophthalmologist that the phrase is so commonly used in the eye care field that the doctor's mark should be withdrawn. The case was dismissed in full.

- **Representation of Bausch & Lomb Incorporated in a matter filed against Bayer Aktiengesellschaft with the USPTO's Trademark Trial and Appeal Board (TTAB).** Bayer wanted to register "ALLERAY" for allergy medication, while Bausch & Lomb owns strong trademark rights to "ALAWAY... the best allergy eye drops on the market for red/itchy eyes." Bayer dropped the registration and abandoned its use.

- **Representation of one of the world's largest auto and industrial battery companies in coordinating multiple trademark oppositions and cancellations in China, Europe and South America including prosecution and licensing of approximately 1,250 global trademarks.**

- **Defense of Frank Brunckhorst Co., Inc., producers of "Boar's Head" deli meat products, against a claim by Dietz & Watson that Boar's Head's use of EVEROST for chicken infringes Dietz & Watson's use of EVERBEST for ham.** The case was pending in the US District Court for the Eastern District of New York as well as before the USPTO's TTAB. Dietz & Watson ultimately dismissed its case.

- **Defense of FriendFinder against a case involving the use of "face book" in a domain name and the counterclaim for infringement of "FriendFinder" marks by Facebook.**

- **Successful prosecution of a trademark infringement suit on behalf of Fruit of the Loom centering on the manufacture and sale of garments bearing the mark Fruitz. Fruit of the Loom v. Carnation (U.S. Dist. Court, S.D. Cal.).**

- **Prosecution of a trademark infringement suit on behalf of Fruit of the Loom centering on the sale of apparel items under the mark Fruit Flops. Fruit of the Loom v. Girouard (U.S. Dist. Court, C.D. Cal.).**

- **Representation of an aerospace and defense company and its subsidiary which designs, develops and manufactures business-jet aircraft in connection with a lawsuit in Chinese court and several litigations in administrative tribunals for trademark infringement and related claims, including prosecution and licensing of approximately 1,380 global trademarks.**

- **Representation of an aerospace and defense company in securing a large judgment against a defendant for infringing on a trademark held by Katten's client in operating as a supplier to the US Department of Defense.** The judgment comprises a trebling of the defendant's profits plus court costs. The court also authorized an award of attorneys' fees.

- **Representation of Helmut Lang New York LLC in a UDRP Complaint filed with the WIPO Arbitration and Mediation Center.** A third party had registered a domain name incorporating our client's federally registered HELMUT LANG trademark and was using such domain name in connection with a website that sought to intercept and siphon off Internet traffic intended for our client's products. WIPO held in favor of our client and ordered that ownership of the domain name at issue be transferred to our client.

- **Representation of I Am That Girl LLC in a pro bono case for a charitable organization where Nike infringed its trademark.** The matter was successfully resolved on confidential terms. I Am That Girl LLC v. Nike.

- **Representation of Microsoft Corp. in connection with the "Kinect" brand name, where Katten successfully argued that its popular gaming device could not be confused with Kinbook LLC's older Kinbox Facebook application trademark.** Judge Marjorie Rendell of the US Court of Appeals for the Third Circuit agreed with a lower court ruling, explaining that "No reasonable jury could find a likelihood of confusion between the parties' marks," and that "we see no need to expand upon the district court's thorough analysis."

- **Representation of Penthouse Media Group, Inc. and its carrier AIG in the dismissal of all seven counts of a complaint and in the granting of a motion for summary judgment on First Amendment grounds.** Plaintiff claimed rights to a 1960s television show called Route 66 that is still sold on DVD and featured on certain cable stations. Penthouse used "Route 66" as the title of one of its adult entertainment videos. The court agreed that use of "Route 66" as part of the title is authorized under the First Amendment of the US Constitution.
• Representation of Point 3 Basketball, LLC, a manufacturer of basketball accessories, in a trademark claim against Nike for use of an infringing logo. Settled on confidential terms in September 2011. Point 3 Basketball, LLC v. Nike, Inc.

• Representation of Republic Clothing Corporation in the acquisition from Premise Holding LLC of all rights, title and interest to the Premise trademarks in Asia. Katten previously represented this client in the 2010 acquisition of all rights, title and interest to the Premise trademarks in the United States, Canada and the European Union.

• Prosecution of trademark infringement action for Sears centering on the infringement of Sears Classmates' mark for children's school uniforms. Sears, Roebuck and Co. v. Strategic Partners, Inc. (U.S. Dist. Court, N.D. Ill.).

• Defense of Scripps Network Interactive against a trademark infringement claim brought by U.S. Foods. The case claimed that proposed use of "Food Fanatics" as part of the title of a television series on the Cooking Channel that featured food fanatics violated the claimed trademark rights of the plaintiff in the term "Food Fanatics." Scripps claimed fair use and First Amendment rights, and the case settled in December 2013 on confidential terms.

• Representation of a software company in connection with a federal lawsuit in Texas for use of trademarks in AdWords-related advertising.

• Defense of Skype/Microsoft and its successful group messaging business, GroupMe, in a trademark dispute involving a company using "Groupie" that was seeking to stop use of the "GroupMe" mark. GroupMe is owned by Skype, which is owned by Microsoft. Case was resolved successfully on the eve of trial in US District Court for Southern District of New York.

• Representation of Summit Entertainment in a $300 million trademark suit regarding use of "Twilight." Bath & Body Works argued that Summit's trademarks of the Twilight name relate to the movie series and are not for personal care items, making product labels such as "Twilight Woods" and "Twilight Crush" fair use. The US District Court for the Southern District of New York concluded that whether or not the product marks are likely to blur the distinctive source of Summit's marks is a triable issue of fact.

• Representation of Tommy Hilfiger, the famous lifestyle brand, in a trademark case involving the use of Commune Hotel's TOMMIE brand. The case is currently pending before the Trademark Trial and Appeal Board.

• Primary counsel to Triumph International, a multinational family-owned underwear and lingerie manufacturer, in all matters pertaining to guarding its trademark throughout the United States.

• Representation of Food Network Inc. in the settlement of a trademark infringement suit. Private Chefs claimed that Food Network stole the concept for the celebrity chef reality show Private Chefs of Beverly Hills. The settlement came after the judge rejected the plaintiff's bid for a temporary restraining order.

• Representation of Trustmark National Bank, a federally chartered bank with more than $7.5 billion in fiduciary assets, in an opposition proceeding before the USPTO's TTAB. Trustmark offers a comprehensive range of banking services under its long-established (and federally registered) Trustmark™ name and mark. A third party called "U.S. Trustmark Company" had sought to register the identical Trustmark™ mark with the USPTO. During the course of the opposition proceeding, the Katten team filed a motion for judgment on the pleadings that was granted by the TTAB, and the third party's application for registration was refused.

• Defense of Yahoo! Inc. in an opposition proceeding filed by IdeaBlade, Inc. before the USPTO's TTAB. The case involved the mark "COCKTAIL" for software applications used by both parties. Katten successfully convinced IdeaBlade to drop its case as Yahoo! had superior rights.

• Representation of Yahoo! Inc. in a trademark dispute with Axis Communications AB, a Swedish company that sells surveillance equipment and applications. Axis is challenging Yahoo!'s use of the Axis name in Yahoo! Axis, a new app for smartphones and tablets.