**FASHION**

**Our Clients**

Katten’s Fashion attorneys represent clients from all areas of the $375 billion fashion industry, counseling companies that manufacture, design, market, source and sell lines of clothing, jewelry, accessories and luxury goods. Our team assists clients in preserving their core brand identities while they grow and expand into new markets or consolidate.

**Our Services**

We advise companies on international expansion and consolidation as well as the production, distribution, advertising, marketing and sale of their products and services. We help our clients keep up with new strategies and business and licensing plans and mitigate issues before they arise. With lawyers fully dedicated to the fashion industry and its unique challenges, we secure, protect and enforce clients’ business names, trademarks, service marks, trade names, brand names, logos, designs, patents, proprietary technology and trade secrets. We also offer assistance with creating an Internet presence, software agreements, contracts with Internet e-signers and providers, disclaimers and copyright notices, copyright protection, consent agreements, photo use policies and sponsorship agreements. Clients turn to us to monitor, enforce and protect against the unauthorized sale of products or use of their property, including addressing domain infringements, false advertising and unfair competition claims.

The Fashion attorneys tap into the cumulative knowledge of our intellectual property, licensing and distribution, media, Internet and litigation attorneys.

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**RECOGNIZED BY**

- *The Legal 500 United States*
  - Trademarks: Litigation 2018, 2017
- *Managing Intellectual Property IP Stars*
  - Trademark Contentious (United States) 2017
  - Trademark Prosecution (United States) 2017
- *Managing Intellectual Property Annual Awards*
  - Trademark Contentious (Midwest Region) 2017
- *U.S. News – Best Lawyers® “Best Law Firms”*
  - Litigation – Intellectual Property (National, Chicago) 2019, 2018
  - Trademark Law (National, New York) 2019, 2018

Working both in the United States and internationally, our lawyers perform detailed patent, trademark and ownership searches, prepare and file applications, and maintain an extensive and thorough in-house database and docketing system to ensure that our clients’ intellectual property rights are fiercely guarded. We protect our clients’ rights and help them avoid infringing others’ rights through extensive investigations, domain name enforcement and registration, preparation of notice letters, commencement of litigation, and recordation of intellectual property rights with US Customs and Border...
Protection (CBP). We also zealously defend our clients against claims asserted by others.

Our attorneys draft, negotiate, implement and administer all types of agreements, including transfer, sponsorship, endorsement, distribution, sourcing, consulting, retail store and in-store, export customer, manufacturing and other commercial agreements. By developing, investigating and researching a client’s intellectual property portfolio, reviewing existing agreements, recording proper title and security interests and preparing all related documents, Katten attorneys shepherd clients through the ever-changing fashion industry.

Our Experience


- Trademark litigation counsel to 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. Most recently, Katten represented Arcadia against Slovenian company Studio Moderna in a matter involving rights to TopShop for retail services in the United States.

- 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 (US District Court for the Southern District of California).

- 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 (US District Court for the Central District of California).

- Representation of Kellwood, Inc., through its Vince LLC division, in concluding a license to expand its Vince mark to children’s apparel.


- Representation of client in a multi-defendant patent case involving more than 100 defendants. Achieved dismissal of case after favorable claim construction ruling. Paul N. Ware v. Abercrombie & Fitch Stores, Inc. et al.

- Representation of Republic Clothing Corporation in connection with its acquisition of the renowned luxury apparel and accessories brand Premise from Premise Holdings LLC.

- 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. (US District Court for the Northern District of Illinois).

- Successful defense of Speedo USA, the US distributor of the Speedo brand swimsuit, in a false advertising, Lanham Act, antitrust and unfair competition case brought by a competitor in connection with the marketing and promotion of the Speedo LZR, the revolutionary competitive racing suit worn by more than 70% of the medalists at the 2008 Summer Olympics in Beijing. Plaintiff, Speedo’s primary competitor in the sale of competitive racing swimsuits, sued Speedo in the US District Court for the Central District of California for false leading advertising, Lanham Act violations, monopolization, exclusive dealing and other alleged torts. Plaintiff claimed that Speedo misrepresented the test results of swim time improvements achieved using the LZR Racer. Plaintiff also claimed that Speedo’s sponsorship of USA Swimming—the national governing body for amateur swimming in the United States—and its head coach gave Speedo an unfair advantage in marketing its suits to elite swimmers and other swimmers who race. After a motion to dismiss, in which some of plaintiff’s claims were dismissed, the parties engaged in extensive discovery. After two motions for summary judgment, plaintiff's remaining claims were dismissed. Plaintiff did not appeal. Tyr Sport, Inc. v. Warnaco Swimwear, Inc., dba Speedo USA.

- 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 The Warnaco Group, Inc. in its merger with Philips-Van Heusen Corp.
- Representation of Philips-Van Heusen Corp. in its disposition and sale to Polo Ralph Lauren Corp. of the Chaps licensed business acquired in its merger with The Warnaco Group, Inc.
- Representation of The Warnaco Group in connection with its $200 million senior secured term loan agreements and documentation. The loan supported the client's accelerated repurchase of its stock. The loan was secured by the client's vast inventory of intellectual property.
- Representation of The Warnaco Group, Inc. in a series of transactions, resulting in the formation by the client of a new joint venture for the sale of Calvin Klein apparel and accessories in India. The joint venture was formed together with Brand Marketing India, a current distribution partner of the client. Representation included strategic evaluation and direction concerning the form and format of the transaction; coordination with corporate and tax counsel; preparation of all intellectual property documents; and preparation, editing and finalizing all trademark license agreements, extensions and amendments. The transaction also involved the extension and amendment of multiple license agreements and related agreements with Warnaco's licensor, Calvin Klein, Inc.
- Successful representation of The Warnaco Group, Inc. and Calvin Klein Trademark Trust in connection with a Uniform Domain-Name Dispute-Resolution Policy (UDRP) complaint filed with the World Intellectual Property Organization (WIPO) Arbitration and Mediation Center. A third party had registered five domain names incorporating the client's federally registered Calvin Klein trademark and was using those domain names to intercept Internet traffic intended for the client's products, misdirecting them to sites selling unauthorized products bearing the client's trademarks. WIPO held in favor of the client on all three prongs of the UDRP complaint, and the domain names at issue were ordered to be transferred to Warnaco Group, Inc.
- Representation of HMX, LLC, the purchaser of the intellectual property assets of Hartmarx Corporation (and its successor entity XHM Corp), in a bankruptcy court sale and transaction in connection with litigation against Pusser's (2001) Ltd. Specifically, Katten commenced a proceeding in the US Bankruptcy Court for the Northern District of Illinois by filing a motion to compel compliance with the sale order issued by the bankruptcy court. The sale order included the transfer, free and clear of all claims, of intellectual property and trademarks, including the Pusser's trademarks, trademark registrations and related goodwill. Pusser's had attempted to interfere with the client's ownership of and right to use and exploit the Pusser's trademarks it acquired as a result of the bankruptcy court sale order. This interference included filing a challenge before the TTAB. The bankruptcy court granted HMX's motion to compel compliance, and ordered Pusser's to dismiss its proceeding commenced before the TTAB.
- Representation of apparel and accessories retailer and designer Aéropostale Inc. in connection with a brand ambassador agreement with actress and model Chloé Grace Moretz. Ms. Moretz provides her endorsement services exclusively to Aéropostale, serving as a spokesperson and brand ambassador for the Aéropostale products and the Aéropostale stores.
- Representation of Haute Hippie LLC/Patricia Westcoat Pound in actions commenced against Helly Hansen, ASA, in connection with steps taken to cancel trademark registrations for formatives of the mark, HH, in the categories of fashion bags and wearing apparel. On behalf of the client, Katten overcame submissions of evidence by the opposing party based on the exportation of product from Panama and other attempts to substantiate the opposing party's position pursuant to the Andean Pact.
• Provision of advice to the Seven Bar Foundation, a nonprofit organization dedicated to providing microfinancing for women (its focus is on linking with luxury brands to create sustainable funding, including through sponsorships and cause-marketing campaigns). Katten's representation of Seven Bar covers the range of branding, taxation and contractual issues, including the implementation of Seven Bar's "Lingerie London" event in October 2012.


• Representation of Aéropostale in a copyright infringement action involving fabric design. The court found that L.A. Printex could not prevail on its copyright infringement claim, resulting in a win for the client. *L.A. Printex Industries, Inc. v. Aeropostale, Inc.*

• Representation of apparel retailer and designer Alice + Olivia in connection with a co-branding and license agreement with Courtaulds Brands Ltd. pursuant to which the parties launched a hosiery collaboration under the co-branded "Alice + Olivia for Pretty Polly" name.

• Representation of PVH Corp. in connection with its Warnaco subsidiary's sale of assets to Ralph Lauren Corp. in connection with the termination of Warnaco's license to sell Chaps-branded apparel products owned by Ralph Lauren Corp.

• Representation of Elie Tahari, Ltd. in connection with a licensing agreement with Modern Shoe Company to design, manufacture, promote and sell certain footwear under the Elie Tahari brand name.

• Representation of apparel retailer and designer Elie Tahari Ltd. in connection with a license agreement entered into with Colors in Optics, Ltd. pursuant to which Colors in Optics manufactures, designs and sells a line of Elie Tahari brand eyewear.

• Representation of Tommy Hilfiger in connection with the apparel and retail company's early termination of its current license/distributorship arrangement for its products in Brazil; the acquisition of certain assets from its current licensor/distributor in Brazil; and the formation of a new joint venture with Inbrands S.A. to operate the sales, distribution and marketing of Tommy Hilfiger products in Brazil starting in 2013. The move permits Tommy Hilfiger to be directly involved in the stewardship of the brand in Brazil, and reflects the company strategy of acquiring direct interests in the Tommy Hilfiger businesses in key markets globally.