

Trademark & Copyright

Cozen O'Connor represents a wide range of companies, from small start-ups to multinational blue chips, that operate in diverse industry sectors, including pharmaceuticals, biotechnology, computer software, luxury goods, industrial science, engineering, finance, education, manufacturing, telecommunications, managed services, retail, arts, and sports. We advise clients on clearance, registration, ownership, renewal, and termination rights; secure valuable brands and copyrights; develop acquisition, sales, and licensing strategies; and enforce and defend clients' IP rights. Our attorneys enjoy close working relationships with U.S. Customs and Border Protection officers around the world. Through these ties, we are able to facilitate prompt seizure of counterfeit materials, a notably effective and inexpensive solution for our clients.

The trademark and copyright practice is no place for uninspired lawyering. The law, technology, and economic dynamics governing trademarks and copyrights are in constant flux, so this is an area where clients need their most tenacious and vigilant counsel. As leaders in the copyright and trademark arena, Cozen O'Connor lawyers are aware of critical developments as soon as they happen. More importantly, we bring a competitive zeal to the defense of intellectual property that drives our tireless supervision of regulators, peer companies, and would-be infringers.

Much of our practice revolves around developing tailored protection and enforcement schemes that allow clients to both leverage their intellectual property assets and maintain full control over their marks and copyrights. There are numerous components to a successful anti-counterfeiting and anti-infringement strategy—proper registration, custom enforcement, third party assistance, trade monitoring—and no two clients should employ the exact same approach. We bring all of our legal, business, and technical knowledge to bear on the task of designing the best enforcement protocol for each client.

SERVICE AREAS

- Research trademark and copyright availability and registrability
- Handle trademark and copyright clearance, prosecution, and maintenance
- Conduct trademark and copyright enforcement
- Negotiate IP agreements and conduct due diligence
- Register IP with *U.S. Customs* and Border Protection and serve as liaison to CBP offices around the world on counterfeiting enforcement and seizures
- Negotiate trademark, trade dress, and copyright licensing and franchising
- Defend entertainment rights
- Design online enforcement strategies
- Represent clients in domain name registration and disputes
- Develop website privacy policies, and user and membership agreements
- Handle trademark and copyright litigation

Experience

Secured a hard-fought victory for a large costume jewelry retailer based in Paris, with stores worldwide, in a consolidated Trademark Trial and Appeal Board proceeding involving seven applications and registrations. During the course of discovery, the individual whose trademark our client opposed sued for infringement in federal court in New York, resulting in the suspension of the TTAB case. After we successfully moved for summary judgment in the infringement case (with the win being affirmed by the U.S. Court of Appeals for the Second Circuit), the TTAB proceedings resumed.



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Related Practice Areas

- Biologics/Biosimilars
- Domains
- e-commerce
- Entertainment Law
- Franchising
- Hatch-Waxman Litigation
- Intellectual Property
- Intellectual Property Litigation
- Licensing & Transfer
- Patents
- Trade Secrets & Unfair Competition

Industry Sectors

- Health Care & Life Sciences
- Media & Entertainment
- Sports

We first won judgment on the pleadings with respect to a cancellation counterclaim the other side had filed, and we then secured victory for the client on its own claims in almost all respects.

Represents companies engaged in the design and manufacture of giftware and tabletop products in procuring copyright registrations and prosecuting and defending copyright infringement actions.

Represented the New York Observer in a protracted trademark dispute. Over the course of a five-year proceeding before the Trademark Trial and Appeal Board (TTAB), we overcame vigorous opposition to our trademark application, with the TTAB ultimately dismissing the objection to the mark in a detailed decision. We also secured dismissal of a parallel lawsuit filed in federal court against six individuals, including the New York Observer's high-profile publisher, by the individual who objected to our trademark application.

Served as lead trial counsel for Patriot National Insurance in a trademark cancellation action before the Trademark Trial and Appeal Board successfully invalidating the PATRIOT RISK INSURANCE trademark registration.

Served as lead trial counsel for Beachbody, LLC in prosecuting a trademark infringement, unfair competition, and counterfeiting case adverse to Walmart and Universal Nutrients.

Represented Cumberland (Sweet'n Low) against Monsanto (NutraSweet) in a trade dress case for the use of the color blue on sweetener packets. Lower court ruling in our favor was affirmed by the seventh circuit.

Served as lead trial counsel for Clark Capital Management Group in multiple trademark infringement actions involving unauthorized use of its NAVIGATOR marks.

Represented Fame Jeans Inc. in a trademark matter stemming from a TTAB action relating to mark for clothing. After heated discovery, prevailed on motion to dismiss one count from complaint.

Subsequently negotiated multimillion-dollar settlement for Fame Jeans relating to mark.

Defended our client in a preliminary injunction motion to its right to its name in a \$10 million trademark infringement claim and convincing a judge that not enough evidence existed to create a trademark challenge when our client, a top video adventure game manufacturer, was sued by another top producer of video games.

Served as lead trial counsel for Celgene Corporation against various internet pharmacies to stop the unauthorized sale of products, all resulting in defendants discontinuing online sales of unauthorized products.

Served as lead counsel for a cigar manufacturer, now owned by Altria, where we won a summary judgment motion on product trade dress protection for the appearance of a cigar which led to a favorable settlement in which the opposing cigar manufacturer agreed to phase out all use of the trade dress in question.

Served as co-counsel representing National Association for Stock Car and Auto Racing, Inc., where NASCAR won a summary judgment leading to a ruling that NASCAR owns the worldwide copyrights to the NASCAR NEXTEL Cup Series Trophy. This ruling was upheld by the Third Circuit.

Served as lead trial counsel for the estate of the author of the song "Disco Inferno," where we succeeded in negotiating a settlement which confirmed the author's estate was the copyright owner in the renewal rights, could appoint their own administrator of such rights, and could collect licensing fees relating to such rights.

Assisted in the IP due diligence of the \$2.9 billion Altria Group, Inc. acquisition of John Middleton.

Served as lead trial counsel representing Jon Bon Jovi and the Philadelphia Soul Arena Football Team in prosecuting a trademark and copyright dispute.

Served as lead trial counsel for Beachbody, LLC in prosecuting a copyright and counterfeiting case adverse to Costco Wholesale Corporation.

Served as lead trial counsel for Oasys Mobile, Verizon Wireless, AT&T, and Thumbplay in defense of a

trademark infringement claim filed by Mantra Entertainment.

Served as lead trial counsel for Triumbari Corporation in a motion to intervene and a motion to set aside a consent decree filed by Bug Juice concerning product trade dress on a plastic bottle.

Served as lead trial counsel for Arora Board Review and various doctors in defense of claims of copyright infringement and breach of contract filed by the American Board of Internal Medicine.