

Trademarks and Trademark Litigation

Overview

Trademarks and trade identity protections do more than safeguard well-known brands. They protect valuable goodwill, prevent consumer confusion, enhance brand distinction and foster enduring protections. Katten evaluates thousands of trademark searches every year and polices clients' marks against threats worldwide. We defend clients against claims by competitors or plaintiffs seeking a "lottery-type payday." Whether challenging designs on behalf of mega-retailers or knocking out infringement claims against world-famous beverage companies, tech companies and movie studios, our litigators preserve and extend the value of your intellectual property (IP) protections.

Upholding trade identity rights in the digital age

The digital age has reshaped global competition and visibility. We provide commonsense counsel on evolving trademark registration and pre-litigation issues. We are well-schooled in your obligations in domain name procedures governed by the Internet Corporation for Assigned Names and Numbers (ICANN). Additionally, our litigation teams move aggressively to obtain or defend against temporary restraining orders and preliminary injunctions.

From protection of product launches to defense against infringement claims, we resolve trademark disputes and lawsuits related to:

- Deceptive trade practices
- Descriptive word marks or ornamental designs
- Fair use or infringement
- First Amendment rights
- Forward confusion and reverse confusion
- Fraud
- Laches and estoppel defenses
- Lanham Act
- Service marks
- Trade dress
- Unfair competition

- Uniform Domain-Name Dispute-Resolution Policy (UDRP)

Practical dispute resolution in high-profile industries

Wherever your trademarks and trade protections come under attack, Katten's litigation bench forms an effective force. We appear before the US Trademark Trial and Appeals Board and the US International Trade Commission, and in courtrooms nationwide. Several litigators are also mediators skilled at creative dispute resolution.

Immersion in our clients' industries keeps commercial and legal developments at the forefront. We are recognized authorities on fashion, media and entertainment IP law. In addition, leading food and beverage makers as well as video game, technology, pharmaceutical, health care and manufacturing companies turn to Katten to assert and defend their most valuable trademark protections worldwide.

Our Experience

- Protected TopShop, one of the most famous brands in fashion with a tremendous international value, through US federal litigation (with related actions abroad) regarding rights to a mark that achieved fame overseas before substantial recognition was reached in the United States. Our representation included a matter with global scope against Slovenian company Studio Moderna involving rights to the Topshop brand for retail services in the United States. We obtained a favorable, confidential global settlement.
- Defended 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. As a result of the allegations asserted by AirWair's counsel and their perceived scope of intellectual property rights, we 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. The market/style trend towards this type of footwear appears to have since shifted in order to avoid litigation claims.
- Represented Agave Loco LLC in obtaining a successful federal court ruling against Sazerac Co. Inc., Sazerac named its new signature drink "Orchata," confusingly similar to our client's already enormously popular RumChata rum liqueur drink. We 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. The parties reached a confidential settlement.
- Defended 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 EVEROAST 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 TTAB. Dietz & Watson ultimately dismissed its case.

- Defended XL Group, including Kohl's Department Stores, Forever 21 and The Walt Disney Company, against a trademark infringement claim brought in the US District Court for the Central District of California. Toni Basil, singer of the 1981 song "Mickey," alleged all three companies used her image and voice in advertising, falsely designating the origin of the music. The court granted our motion to dismiss, stating that the Lanham Act cannot be used to extend rights governed by copyright laws.
- Represented Bausch & Lomb in a 20-year trademark feud with Karl Storz GmbH stemming from overlapping use of the trademark "Storz". In 2008, the US Patent and Trademark Offices' Trademark Trial and Appeal Board granted summary judgment to our client which Karl Storz appealed. The parties entered discussions with a Federal Circuit mediator and reached a global settlement in 2009.
- Defended FilmDistrict Distribution, GK Films and director Angelina Jolie against alleged copyright infringement regarding the motion picture *In the Land of Blood and Honey*. We defeated an *ex parte* motion for a temporary restraining order to prevent the film's release in the US District Court for the Northern District of Illinois. After heated oral argument, the court sided with our clients and convinced plaintiff to withdraw the motion.
- Defended American radio broadcasting company Cumulus Media in a high-profile lawsuit involving the purportedly unauthorized radio and Internet broadcast of pre-1972 sound recordings, which are not covered by federal copyright law but plaintiffs claim violation of state copyrights. We persuaded the US District Court for the Central District of California to strike both the class action certification bid and the class allegations from the litigation. The case was dismissed as to Cumulus with agreement of the plaintiff.
- Represented Microsoft Corp. in connection with the "Kinect" brand name. We successfully argued that the client's popular Xbox 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."
- Defended 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.
- Counsel for ENVE, a world-renowned manufacturer of high-end bicycle parts, in filing an action for trademark infringement and unfair competition against Giant Bicycle, one of the largest manufacturers of bicycles in the world. The complaint, filed in the US District Court for the District of Utah, sought relief under the Federal Lanham Act, and for trademark infringement, unfair competition and deceptive practices under the laws of the State of Utah. Settled on confidential terms.
- Defended Panther Premium Logistics, a subsidiary of Arkansas Best, in a trademark infringement lawsuit in the US District Court for the Northern District of Ohio. Jaguar Land Rover Limited alleged false designation or origin, dilution, and unfair competition regarding its leaping feline logo. The court dismissed based on an undisclosed settlement that pleased both parties.
- Represented 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, we filed a motion for judgment on the pleadings that was granted by the TTAB, and the third party's application for registration was refused.

- Represented Scripps Networks in a trademark infringement claim related to the TV show *Private Chefs of Beverly Hills*. Plaintiff moved for a TRO, arguing the trademark "Private Chefs" would confuse consumers. The US District Court for the Central District of California refused, ruling that plaintiff had not shown it would be irreparably harmed without the order.
- Defend three public companies in important litigation in Chicago, where a "reverse confusion" trademark claim has been asserted. A sports nutrition company alleged that our client Gatorade's tagline, "Gatorade. The Sports Fuel Company," and related advertising, infringed on its mark "Sportfuel;" plaintiff sought an accounting of profits and other relief. The US District Court for the Northern District of Illinois found in our favor, ruling the slogan is clearly fair use. PepsiCo and Gatorade deny any infringement and we are vigorously defending an appeal in the Seventh Circuit on their behalf.
- Represent American clothing retailer Forever 21 in a California trademark litigation against Adidas over the use of a three-stripe mark. After receiving a cease-and-desist letter, our client filed a declaratory judgment suit in Los Angeles federal court. Adidas responded with an infringement action in Oregon federal court, where the battle will now be fought. The outcome of this Lanham Act case will be closely monitored in trademark circles for its potential impact on fashion designs.
- Defended Penthouse Digital Media Productions against alleged trademark infringement through use of the mark "Route 66" in connection with video entertainment. The US District Court for the Central District of California granted our motion for summary judgment based on the protections of the First Amendment.
- Defended Universal Studios against alleged trademark infringement via an acronym parody in a film. The US District Court for the Southern District of New York granted our motion for summary judgment, finding the usage was entitled to full protection under the First Amendment and safe harbors for comical expression.

Key Contacts



Karen Artz Ash

Partner and Co-Chair, Trademark/Copyright/Privacy Group

New York
+1.212.940.8554
karen.ash@katten.com



Floyd A. Mandell

Partner and Co-Chair, Trademark/Copyright/Privacy Group

Chicago

+1.312.902.5235

floyd.mandell@katten.com

Recognitions

Recognized or listed in the following:

- *Best Law Firms*
 - Litigation – Intellectual Property
 - National, 2012–2024
 - Chicago, 2012–2024
 - Trademark Law
 - Law Firm of the Year, 2024
 - National, 2016–2024
 - Chicago, 2020–2024
 - Los Angeles, 2024
 - New York, 2016–2024
- *BTI Litigation Outlook*
 - IP Litigation Honor Roll, 2018
- *Chambers USA*
 - Intellectual Property
 - Illinois, 2006–2022
 - Intellectual Property: Trademark, Copyright & Trade Secrets
 - Illinois, 2021–2023
 - Intellectual Property: Litigation
 - District of Columbia, 2021–2023
- *Managing Intellectual Property Annual Awards*

- Trademark Contentious
 - Midwest Region, 2017
- *Managing Intellectual Property IP Stars*
 - Copyright & Related Rights
 - United States, 2017, 2020
 - Patent Contentious
 - United States, 2017, 2020–2021
 - Ranked Firm
 - United States (National), 2023
 - Top Tier Firm
 - New York, 2023
 - Illinois, 2023
 - Trademark Contentious
 - United States, 2017, 2020–2021
 - Trademark Prosecution
 - United States, 2017, 2020–2023
- *The Legal 500 United States*
 - Trademarks
 - Litigation, 2016–2023
- *World Trademark Review 1000*
 - The World's Leading Trademark Professionals
 - National, 2013–2020
 - Chicago, 2017–2020
 - New York, 2013–2020
 - Washington, DC, 2013–2020