

Overview

Your product and the brand it carries are your core assets. You need a legal team that understands the industry, your business and goals to drive the success of that brand from end to end. That's Katten. Our Fashion attorneys can advise you on all legal aspects of the fashion business and at every phase of a product's life cycle. From the creation of a brand or a design, through its success in the marketplace, you can count on our team to help guide you every step of the way.

A Team Tailored to Meet Your Exacting Needs

Whether your business manufactures, designs, markets, sources or sells lines of clothing, jewelry, accessories, home goods, cosmetics or eyewear, you can trust our decades-long experience in this ever-changing market. Tap into the knowledge of our multidisciplinary team, which includes brand and design clearance and registration, enforcement, licensing and distribution, media, internet, data privacy and litigation attorneys. Working both in the United States and internationally, they perform services such as:

- Advising on international expansion and consolidation
- Counseling on production, distribution, advertising, marketing and sale of products and services
- Securing, protecting and enforcing business names, trademarks, service marks, trade names, brand names, logos, designs, patents, proprietary technology and trade secrets
- Creating an internet presence, software agreements, disclaimers and copyright notices, copyright protection, consent agreements, photo use policies, privacy terms, data protection protocols and sponsorship agreements
- Monitoring, enforcing and protecting against the unauthorized use of proprietary rights or the sale of infringing products
- Performing detailed patent, trademark, copyright and ownership searches, preparing and prosecuting applications, and maintaining a thorough in-house database and docketing system
- Managing investigations, domain name enforcement and registration, preparation of notice letters, prosecuting and defending claims in litigation, and recording and addressing intellectual property rights with Customs and Border Protection worldwide
- Drafting, negotiating, implementing and administering a wide range of agreements and everything else you need to conduct a fashion business

Our Experience

- Represented HMX, LLC, the purchaser of the intellectual property assets of Hartmarx Corporation (and its successor entity XHM Corp), in bankruptcy court sale and transaction in connection with litigation against Pusser's (2001) Ltd. Specifically, we commenced a proceeding in US Bankruptcy Court for the Northern District of Illinois by filing a motion to compel compliance with sale order issued by bankruptcy court. Sale order included 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 client's ownership of and right to use and exploit the Pusser's trademarks it acquired as result of bankruptcy court sale order. Interference included filing challenge before TTAB. Bankruptcy court granted HMX's motion to compel compliance, and ordered Pusser's to dismiss its proceeding commenced before the TTAB.
- Represented 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.
- Represented The Warnaco Group, Inc. and Calvin Klein Trademark Trust in a UDRP complaint filed with the WIPO Arbitration and Mediation Center. A third party had registered five domain names incorporating our 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 our client on all three prongs of the UDRP complaint, and the domain names at issue were ordered to be transferred to Warnaco Group, Inc.
- Defended 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 over 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 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. Following two motions for summary judgment, plaintiff's remaining claims were dismissed. Plaintiff did not appeal.
- Represented brand development and licensing company that owns various trademark rights relating to a deceased iconic celebrity as plaintiff in the US District Court for the Southern District Court of New York. Our

client asserted claims for trademark infringement, trademark dilution and unfair competition by a New York City-based manufacturer and wholesaler of intimate apparel through the use of the celebrity's image and attributed quotes without a license. A consent judgment was entered in favor of our client and parties reached a settlement.

- Represented apparel retailer and designer in a license agreement pursuant to which the licensee was granted the right to manufacture, distribute and sell certain men's women's, children's and unisex apparel and accessories under certain client brands in the People's Republic of China (including mainland China, Hong Kong and Macau). Client also obtained the right to open freestanding stores and shop-in-shops under the client's name in the People's Republic of China.
- Represent one of the world's largest apparel companies in establishing a joint venture that will license from its wholly owned subsidiaries the rights to operate and manage the distribution of client-branded products in Mexico.
- Represented leading performance apparel and accessories brand focused on temperature-control technologies in negotiating a brand ambassador agreement with an actress and recording artist who became the face of the client's newly launched women's apparel collection.
- Represented fashion house in negotiating model contracts for the lead actors of a 2017 Academy Award-winning picture to star in the client's new advertising campaign for underwear.
- Represent fashion house in its global intellectual property portfolio, including with respect to trademark and copyright prosecution and enforcement matters such as a worldwide branding and style expansion, acquisition of third-party property and comprehensive integration of a brand portfolio.
- Represent fashion house in exploiting its historical association with a model/actress and a photographer, including the simultaneous completion of agreements with each that support the use of a new logo design, graphic and artwork for jeanswear.
- Represented apparel retailer and designer in completing new licensing arrangements for broad categories of skincare and makeup products, initially in Asia, and then for domestic sale and promotion. The transaction involved complicated structural coordination for the brands, manufacturing and licensed territories, as well as coordination with other related agreements.
- Represented international fashion house in dispute in Netherlands relating to competitor allegations that strips on coin pockets of our client's jeans infringed plaintiff's pocket strip. Working with local Dutch counsel, we defeated plaintiff's effort to obtain temporary restraining order, with courts finding that there was no infringement.
- Represent luxury hip hop sneaker designer in obtaining multiple design patents for leatherwear and worldwide trademark registrations for a design and logo.
- Represent American fashion house in licensing its watch line, giving another company permission to manufacture and sell watches bearing client's brands. Licensee experienced some issues that warranted review with counsel as to best practices.
- Represent apparel retailer and designer in enforcing family of marks against use of similar mark in sneaker collaboration between a fashion house and a rapper.
- Represented 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.

- Trademark litigation counsel to Arcadia Group Brands Ltd. in 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. We represented Arcadia against Slovenian company Studio Moderna in a matter involving rights to TopShop for retail services in the United States.
- Defended Mansur Gavriel in a trademark registration, where the owner of a jewelry mark opposed our client's registration of MANSUR GAVRIEL for handbags and wallets. The TTAB dismissed the Section 2(d) opposition, finding the plaintiff failed to prove priority and the marks were not confusingly similar.
- Represent Phillips-Van Heusen Corporation in opposition proceeding involving famous Izod and iPod trademarks. *Phillips-Van Heusen Corporation v. Apple Inc.*

Key Contacts



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Recognitions

Recognized or listed in the following:

- *Managing Intellectual Property* Annual Awards
 - Trademark Contentious
 - Midwest Region, 2017
- *Managing Intellectual Property* IP Stars
 - Trademark Contentious
 - United States, 2017, 2020–2021

- Trademark Prosecution
 - United States, 2017, 2020–2021
- The Legal 500 United States
 - Trademarks
 - Litigation, 2016–2021
- *U.S. News Best Lawyers – “Best Law Firms”*
 - Litigation – Intellectual Property
 - National, 2012–2022
 - Chicago, 2012–2022
 - Trademark Law
 - National, 2016–2022
 - Chicago, 2020–2022
 - New York, 2016–2022