

Fashion

Katten is one of the nation's premier law firms serving the intellectual property (IP) needs of domestic and multinational fashion, retail, luxury and beauty businesses. Leading names in the global fashion industry view our attorneys as trusted advisors who counsel clients on all legal aspects of their business and through every phase of a product's life cycle. Our team offers comprehensive legal services for safeguarding and enforcing the proprietary rights of designers, manufacturers and retailers, from the initial creation of brands and designs to the successful exploitation and protection of those IP assets in the marketplace.

Sophisticated counsel tailored to clients' needs

Led by Partner and National Co-Chair of Katten's Trademark/Copyright/Privacy Group Karen Artz Ash, who is lauded as a "doyenne of the industry" (2022 *World Trademark Review 1000*), Katten has been named among the leading law firms for IP work in the fashion world. *Women's Wear Daily*, in particular, has featured the team as one of five law firms recommended as legal counsel for fashion companies.

From haute couture to streetwear, businesses across the fashion spectrum rely on Katten's deft IP counsel as a key component of their commercial strategies. We assist clients with navigating legal issues and developing bespoke strategies related to brand and design registration, as well as enforcement, product manufacturing and distribution, third-party licensing, marketing and promotional activities, domain name registration and enforcement, endorsement and sponsorship, and co-branding and collaborations.

Additionally, our team provides comprehensive support for mergers and acquisitions (M&A) in the fashion industry by conducting thorough reviews of IP assets, including patents, trademarks and copyrights, to identify potential opportunities or risks that could impact deal value. Our M&A work includes verifying IP ownership, analyzing agreements and advising on transaction strategies to ensure seamless integration and protection of acquired assets. Katten's proficiency in this area is demonstrated through our representation of clients, including manufacturers, retailers and brand development/licensing companies, in their significant asset sales and purchases, as well as the license back of IP rights for the continued operation of brands.

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Katten's diverse range of fashion legal services include:

- Clearing and securing business names, brand names, designs, logos, patents, technology, trademarks and trade secrets;
- Monitoring against the unauthorized use of proprietary rights or sale of infringing products;
- Initiating opposition or cancellation proceedings before the US Patent and Trademark Office's (USPTO) Trademark Trial and Appeal Board (TTAB), recording and addressing intellectual property rights with US Customs and Border Protection, and prosecuting and defending claims in litigation before domestic and international courts;
- Drafting, negotiating, implementing and administering a variety of agreements, including transactions covering manufacturing, distribution, licensing, sponsorship and endorsement arrangements with celebrities; and
- Preparing disclaimers and copyright notices, copyright protection, consent agreements, photo use policies, privacy terms and data protection protocols.

Katten's interdisciplinary team combines the extensive skills and knowledge of attorneys who are well-versed in IP-related enforcement and litigation, management and protection of portfolios, and data privacy and security. As the dynamic digital landscape continues to change how fashion is created and consumed, especially as artificial intelligence (AI) continues to rapidly develop and is used increasingly across industries, our versatile team steers clients through new manufacturing and marketing challenges. Through seamless collaboration among our attorneys, we deliver effective results and a holistic perspective when addressing legal issues.

At the forefront of an ever-evolving industry

Technological innovations, including the rise of AI, have driven widespread changes, transforming brands' creative processes and the consumer experience. Katten attorneys stay on top of how technology and fashion intersect and, in turn, partner with their clients to ensure the appropriate documentation and resources are in place to protect and promote their brands amid continuous developments.

As with so many industries, environmental, social and governance (ESG) factors are also driving change in fashion. While brands face greater scrutiny of their environmental and social impacts across the globe, Katten helps designers, manufacturers and retailers navigate the growing body of ESG-related measures to ensure their compliance with new sustainability and social accountability requirements, both domestically and abroad.

Katten serves clients ranging from luxury brand designers, apparel manufacturers and retailers to home goods, beauty and eyewear brands. Our client roster features globally recognized companies such as Aeropostale, Authentic Brands Group, Brooks Brothers, Calvin Klein, Charlotte Tilbury, Kenneth Cole, Kith, Marc Jacobs International and PVH Corp.

Additionally, our firm publishes its very own quarterly fashion newsletter, the award-winning *The Katten Kattwalk*. Katten has also contributed to external fashion publications such as *Fashion Law – A Guide for Designers, Fashion Executives and Attorneys* and the 2013 book *Becoming a Fashion Designer* by Lisa Springsteel, for which Karen wrote the "Intellectual Property Checklist" in the chapter titled "Launching Your Own Fashion Collection." Karen has also educated future lawyers as an Adjunct Professor at New York Law School for more than 15 years and ongoing, teaching practical substantive and drafting skills for IP licensing in the fashion industry. The school recognized Karen with its "New York Law School Big Apple Award," commemorating her for "Creativity That Moves Fashion Forward." In addition, Karen was honored with a Global Lifetime Achievement Award for her more than 30 years of successfully and creatively handling IP matters, ranging from strategic trademark licensing to international distribution agreements, for some of the world's most innovative companies and iconic fashion brands (*Managing Intellectual Property*, 2018). She has also been named among the 2018 "Leading Women Lawyers in New York City" and 2020 "Notable Women in Law" (*Crain's New York 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.*

Recognitions

Recognized or listed in the following:

- *Best Law Firms*
 - Litigation – Intellectual Property
 - National, 2012–2025
 - Chicago, 2012–2025
 - Los Angeles, 2025
 - Trademark Law
 - Law Firm of the Year, 2024
 - National, 2016–2025
 - Chicago, 2020–2025
 - Los Angeles, 2024–2025
 - New York, 2016–2025
- *Managing Intellectual Property Annual Awards*
 - Trademark Contentious
 - Midwest Region, 2017
- *Managing Intellectual Property IP Stars*
 - Trademarks, 2023
 - Trademark Contentious
 - United States, 2017, 2020–2024 Trademark Prosecution
 - United States, 2017, 2020–2024
- *The Legal 500 United States*
 - Trademarks
 - Litigation, 2016–2024