

# CTIA

**COPYRIGHT, TRADEMARK,  
INTERNET & ADVERTISING  
LITIGATION AND COUNSELING**



**KIRKLAND & ELLIS**

# **COPYRIGHT, TRADEMARK, INTERNET & ADVERTISING LITIGATION & COUNSELING**

**W**ith decades of experience, the lawyers of Kirkland & Ellis' Copyright, Trademark, Internet & Advertising (CTIA) Practice Group have represented clients in numerous of the highest profile matters in the country with extraordinary results. Their experience spans a wide range of industries, including computer software and other technology, consumer products, media and entertainment, fashion, financial services and pharmaceuticals.

Kirkland's CTIA practice represents corporations and individuals in all phases of litigation, from obtaining and defeating initial TROs and preliminary injunctions through final appeals to the U.S. Supreme Court. They understand litigation and formulate legal strategy with the client's business interests in mind. When it comes to trial, Kirkland's CTIA lawyers actually try cases and win them. In addition to federal and state court litigation, they also have experience conducting copyright and trademark prosecutions as well as complicated *inter partes* matters before the Trademark Trial and Appeal Board (TTAB), trademark-related investigation proceedings before the U.S. International Trade Commission (ITC), and proceedings under the Uniform Domain-Name Dispute-Resolution Policy (UDRP). Kirkland's attorneys also have significant experience in trade secret litigation and the advertising area, including consumer class action litigation, commercial advertising litigation, and successfully representing clients before the National Advertising Division (NAD) of BBB National Programs.

In addition, Kirkland's CTIA attorneys advise clients regarding legal, regulatory and policy issues presented by social media (including managing the risks that may arise from use of social media platforms, complying with applicable laws and regulations, and policing IP rights on social media). We also represent clients in connection with Digital Millennium Copyright Act issues, including safe harbors, website terms and conditions, and enforcement matters.

Our lawyers are frequently called on to provide strategic advice on how best to protect, maintain and enhance valuable IP assets—including building brands and businesses—on a worldwide basis. We are experienced in helping clients to coordinate their international IP protection strategies, including bringing litigation and working with Kirkland's international offices as well as with our clients' foreign counsel. Kirkland's attorneys also have worked closely on regulatory and legislative policy developments, including serving on the International Trademark Association (INTA) Presidential Select Committee that helped rewrite the federal dilution statute, and the Copyright Law Reform Task Force of the American Bar Association's Intellectual Property Law Section that was formed in response to the Judiciary Committee of the House of Representatives' copyright review process.

# MEDIA & ENTERTAINMENT

## FOX

Kirkland's lawyers have represented Fox for many years on numerous matters, including before the U.S. Supreme Court in a copyright and Lanham Act case involving General Dwight D. Eisenhower's acclaimed memoirs. After winning bifurcated trials on liability and damages, the case resulted in the Kirkland lawyers obtaining a permanent injunction and a multimillion dollar award.

In 2018, Kirkland achieved a major victory in its highly-publicized copyright infringement lawsuit against TVEyes, a media monitoring company that provided Fox programming to subscribers on its Internet platform. After Kirkland successfully litigated the case at the district court, winning summary judgment and obtaining a permanent injunction against TVEyes, TVEyes appealed to the U.S. Court of Appeals for the Second Circuit. Heralded as a major development in copyright fair use law, the Second Circuit agreed that TVEyes' use of Fox's content was not fair use, and directed the district court to issue a more expansive injunction.

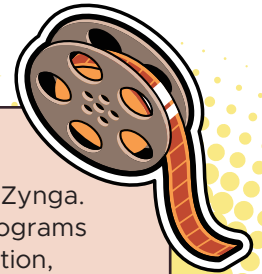
Kirkland also represented Fox and other defendants in a lawsuit concerning the *Modern Family* television series, which was alleged to infringe the copyright in the plaintiff's treatment and proposed pilot script, as well as other state law rights. Kirkland successfully moved to dismiss the suit. On appeal to the U.S. Court of Appeals for the Second Circuit, the court determined that *Modern Family* and the proposed pilot were not substantially similar, and rejected the plaintiff's idea misappropriation and defamation claims.

## EPIC GAMES

On behalf of Epic Games, Kirkland won a motion to dismiss in the first case in U.S. legal history to consider the copyrightability of dance steps. In eight prior lawsuits, actors, rappers, and social media personalities asserted that Epic Games' and Take-Two Interactive Software, Inc.'s *Fortnite* and *NBA 2K* video games, respectively, violated the plaintiffs' copyright, publicity, trademark, and unfair competition rights to dance steps that appeared as emotes in the video game. After Epic and Take-Two moved to dismiss, each of the lawsuits was voluntarily dismissed. Then, celebrity choreographer Kyle Hanagami filed a lawsuit against Epic asserting that it copied steps set to four counts of music from a longer five-minute piece. The court dismissed the case, holding that the steps were not protectable in isolation and the other elements of the works were dissimilar, as well as that the unfair competition claim was preempted by the Copyright Act.

Kirkland similarly won motions to dismiss in other dance step cases. For example, in one, the court held that the plaintiff's right of publicity claims were barred by the First Amendment, his trademark claims were preempted by the Copyright Act, and he failed to satisfy the elements of his unfair competition and unjust enrichment claims. In another, the court held that the plaintiff's state law claims were preempted by the Copyright Act.





### **TAKE-TWO INTERACTIVE SOFTWARE**

Kirkland represents Take-Two's video game brands, Rockstar, 2K, Private Division and Zynga. For example, Kirkland litigated a series of lawsuits against the creators of computer programs that allow users to alter Take-Two's video game *Grand Theft Auto V* without authorization, permitting them to cheat and to "grief" other players. In 2018, Kirkland won a first-of-its-kind, precedent-setting injunction, holding that, because the mod menus alter Take-Two's program without authorization, they create derivative works and that, because the use of mod menus violates the conditions on Take-Two's license to play GTAV, continuing to play the game having violated the terms is a copyright infringement for that reason as well.

Kirkland also won summary judgment on the bases of *de minimis* use, fair use, and license in a lawsuit alleging that Take-Two and its 2K subsidiary committed copyright infringement by accurately depicting NBA players, along with their tattoos, in their *NBA 2K* video game.

### **ASSOCIATION OF AMERICAN PUBLISHERS**

Kirkland represented seven members of the Association of American Publishers in a copyright infringement lawsuit seeking to enjoin Audible Captions, a service that provides audiobook consumers the entire, machine-generated text of literary works. In 2020, the parties reached a settlement, which enjoined Audible from launching Audible Captions, or any similar service, for publishers' works without permission of the copyright owner.

### **THOMSON REUTERS & WEST PUBLISHING**

Kirkland is representing Thomson Reuters and West Publishing in a copyright and tortious interference lawsuit concerning copying of Westlaw's content to train its artificial intelligence and create a competing product.

### **J.K. ROWLING**

For almost 20 years, Kirkland attorneys have represented J.K. Rowling, author of the phenomenally successful Harry Potter books, in connection with the enforcement of her intellectual property rights. For example, our lawyers won a highly publicized copyright fair use trial (named "Copyright Trial of the Year" by *Managing Intellectual Property*) against RDR Publishing halting the proposed publication of an unauthorized Harry Potter "lexicon." Our lawyers also defeated copyright and trademark infringement claims brought by Nancy Stouffer against Ms. Rowling and Warner Bros., and obtained an award of monetary sanctions based on Ms. Stouffer's submission of numerous falsified documents.



### **THE ASSOCIATED PRESS**

Kirkland represented The Associated Press (AP) in the highly publicized lawsuit brought by graphic artist and merchandiser Shepard Fairey arising out of his unauthorized use of the AP's photo of President Barack Obama to create the "Obama Hope" poster, an icon of the 2008 presidential campaign, and related commercial merchandise. Fairey initially claimed he used a different AP photo that looked less like the poster and required more modification. He was later forced to admit that he attempted to destroy documents and fabricate evidence in an effort to conceal the true source photo, which in fact was the one the AP had identified, and ultimately plead guilty to criminal contempt. Fairey and the AP settled their claims.

Meanwhile, the AP and Obey Clothing, Fairey's exclusive licensee for apparel using the "Hope" image, filed cross-motions for summary judgment. The court granted the AP's motion for summary judgment, striking Obey Clothing's fair use defense and denying Obey Clothing's motion in its entirety. Shortly thereafter, the case settled.

### **DAMIEN HIRST**

Kirkland represented prominent artist Damien Hirst and Other Criteria (US), LLC in a copyright infringement, trade dress infringement, and unfair competition lawsuit brought by a Canadian artist who alleged that Mr. Hirst's pharmaceutical pill-inspired jewelry infringed her U.S. and Canadian rights. The court granted Kirkland's motion to dismiss, holding that the works were not substantially similar and that the plaintiff's remaining claims were preempted by the Copyright Act.

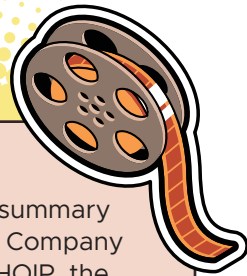
### **SPIDER-MAN MUSICAL**

Kirkland represented the lead producers of the Broadway musical "Spider-Man: Turn Off the Dark" in a lawsuit brought by Julie Taymor, the director of "Lion King" who was fired after the show was savaged by critics who preemptively reviewed it during what became the longest run of preview performances in Broadway history. After the show finally opened, Ms. Taymor sued the producers and others for breach of contract and copyright infringement, the producers countersued, alleging that Ms. Taymor failed to write any of the show's book, breached her fiduciary duties as a board member of the joint venture that managed the production, and caused the show's initial problems. The parties reached a confidential settlement.

### **MARTHA GRAHAM CENTER OF CONTEMPORARY DANCE**

Kirkland's lawyers won a federal trial on behalf of the Martha Graham Center of Contemporary Dance and the Martha Graham School of Contemporary Dance, defeating a claim by Graham's sole heir that the Center and School infringed his trademark rights in the late choreographer's name and technique and breached a license agreement that they had entered into with him. At stake was Martha Graham's legacy as a dancer and choreographer, as the suit threatened the ability of the Center and School that Ms. Graham founded to continue to perform and teach her dances.





### **WALT DISNEY**

Kirkland won two motions for summary judgment for The Walt Disney Company in a trademark case filed by THOIP, the owner of the Mr. Men and Little Miss literary works and related properties, defeating both of THOIP's motions for summary judgment and its claims for forward and reverse confusion and striking THOIP's consumer survey experts. In her opinions, Judge Scheindlin ruled that the sequential array survey testing of THOIP's and Disney's respective T-shirts was so flawed as to warrant exclusion on numerous grounds, including that the array survey failed to approximate market conditions where there was no evidence that the T-shirts tested were ever sold in close proximity and that the "control" was wholly inadequate because it failed to include key non-protectable elements of THOIP's T-shirts.

### **INTERNATIONAL OLYMPIC COMMITTEE**

Kirkland's lawyers obtained TROs and permanent injunctions on behalf of the International Olympic Committee and the U.S. Olympic Committee in parallel cases in Arizona and California. The defendants in these cases were each using the Olympic trademarks deceptively to market and solicit sales of tickets to the Olympic Games in Beijing, preying on Olympic fans around the world, in addition to violating the Olympic and Amateur Sports Act and state unfair business practices laws.

### **SCHOLASTIC**

Kirkland obtained a pre-discovery dismissal for Scholastic, publisher of the Harry Potter books in the United States, of a copyright suit that claimed J.K. Rowling's fourth Harry Potter book, *Harry Potter and the Goblet of Fire*, copied parts of "The Adventures of Willy the Wizard: No.1 Livid Land," a 16-page book written by Adrian Jacobs in 1987. The suit, brought by Jacobs' estate on behalf of his son, sought profits from the sale of *Goblet*. In dismissing the case, the court stated that "the contrast between the total concept and feel of the works is so stark that any serious comparison of the two strains credulity."

### **ANASTASIA MUSICAL**

Kirkland represented Terrence McNally and the producers of the Broadway musical "Anastasia" in a lawsuit brought by Jean-Etienne de Becdelievre, who claimed to be the heir of Marcelle Maurette who was the author of a straight play also called "Anastasia." The parties reached a settlement agreement in 2019.

### **THE TETRIS COMPANY**

Kirkland represented the makers of the Tetris video game in connection with worldwide policing of their intellectual property assets. In one litigation, Kirkland won summary judgment against Xio, the maker of iPhone game "Mino," with the court holding that Mino infringed Tetris' copyright expression and trade dress of Tetris. Kirkland also filed U.S. and U.K. copyright infringement suits against the makers of "Blockles," "Block Drop" and "Free Tetris" infringing games for the Internet and mobile phones; the cases settled favorably.

# SOFTWARE & TECHNOLOGY

## ORACLE

Kirkland was co-counsel to Oracle at the appellate stages of its copyright litigation against Google for copying the Java platform's declaring code and organization to create the Android mobile operating system. In May 2012, in a trial in which Oracle was represented by other counsel, the jury found that Google committed copyright infringement but hung on Google's fair-use defense. The district court then ruled that the copied elements were not copyrightable. The U.S. Court of Appeals for the Federal Circuit held that the copied code and organization elements were protected by copyright. The case proceeded to a remand trial on the issue of fair use, which eventually wound its way to the Supreme Court, which left the copyrightability decision undisturbed but found that Google's copying was fair use.

Kirkland also represented Oracle in its appeal of an order concerning the unauthorized use of software patches for its enterprise operating system. In 2020, the Ninth Circuit reversed the district court in part and remanded as to Oracle's copyright and state law claims. The decision is important to all copyright holders because it reaffirms that they can prove copying through circumstantial evidence, which should be viewed broadly, and that interference with their contracts and business relationships can lead to liability.

Kirkland further represented Oracle and its subsidiaries in another appeal, this one brought by Rimini Street seeking to overturn Rimini's \$88 million loss to Oracle in a software copyright infringement case involving Oracle's PeopleSoft, JDE, and Siebel-branded products.

In 2018, Kirkland successfully preserved the majority of the district court's award to Oracle and defeated Rimini's rehearing request. In 2019, following U.S. Supreme Court proceedings and a Ninth Circuit remand, Kirkland won affirmance of the majority of the district court's judgment. Kirkland defeated Rimini's second cert petition in 2020.

## TRIZETTO AND COGNIZANT

Kirkland represented TriZetto and Cognizant in litigation adverse to Syntel involving healthcare software systems. Syntel alleged trade secret misappropriation, breach of contract, and unfair competition, while TriZetto countered with allegations of trade secret misappropriation, copyright infringement and breach of contract. In October 2020, Kirkland secured a complete jury verdict in favor of TriZetto which included an award of \$855 million in damages. Specifically, the jury found that Syntel misappropriated trade secrets and infringed copyrights, while TriZetto did not misappropriate trade secrets and did not breach an agreement.

## OCULUS VR

Kirkland represented Oculus VR (a virtual reality company that developed the "Oculus Rift" headset and was acquired by Facebook) in a trademark infringement lawsuit filed by Oculus Info (a software services consulting group) in the U.S. District Court for the Eastern District of Virginia. Kirkland successfully defeated Oculus Info's motion for a preliminary injunction, which sought to enjoin Oculus VR from any use of the marks OCULUS, OCULUS VR, and OCULUS RIFT, and stipulation of dismissal was filed shortly thereafter.





### **IBM**

Kirkland achieved a victory for IBM against Teraproc, a competing software developer founded by former IBM employees. The copyright and trade secret litigation arose as a result of Teraproc's creation of a software product called OpenLava, which incorporated proprietary IBM source code into a stripped down and open-sourced program. The U.S. District Court for the Southern District of New York entered a judgment and permanent injunction against Teraproc and any parties working in concert with it, prohibiting any further infringement of IBM's copyrights or misappropriation of IBM's trade secrets. As a result of IBM's lawsuit, Teraproc has ceased all development and distribution of OpenLava.

### **COMPUTER & MOBILE DEVICE COMPANY**

Kirkland represented a client in a copyright rate-setting proceeding brought by The American Society of Composers, Authors and Publishers (ASCAP) in federal court. ASCAP sought a determination of the appropriate royalty for a blanket license covering the online public performance of works by ASCAP's members. Shortly before Kirkland's client was to have filed a motion for summary judgment on a key aspect of ASCAP's legal position, the parties reached a favorable settlement. Kirkland also is representing a client in a rate-setting proceeding before the Copyright Royalty Board relating to mechanical rights.

### **LIVEPERSON**

Kirkland won a \$30 million trade secret and unfair competition jury verdict for LivePerson in a lawsuit concerning 24[7]'s misappropriation of LivePerson's chat engagement rule and data trade secrets. After trial, the court awarded more than \$4 million in additional pre- and post-judgment interest, as well as rejecting each of [24]7's arguments seeking to overturn the jury verdict.

### **MOTOROLA SOLUTIONS**

Kirkland represented Motorola in lawsuits alleging patent infringement, misappropriation of trade secrets and copyright infringement against Hytera companies, involving patents, confidential information and source codes on digital two-way radio communication systems. At the trade secret misappropriation and copyright infringement jury trial, Kirkland won \$764 million when the jury rejected Hytera's statute of limitations defense and awarded Motorola its full requested compensatory and punitive damages.

### **ASTRONICS TEST SYSTEMS**

Kirkland is representing ATS and its parent company in a patent, copyright, and state law lawsuit concerning aerospace test instruments. Kirkland won an initial motion to dismiss all of Teradyne's claims as improperly pleaded and lacking personal jurisdiction; and a second motion to dismiss Teradyne's indirect and willful patent infringement, unfair competition, and prospective economic advantage claims, as well as a motion to dismiss ATS's parent company due to a lack of personal jurisdiction. Kirkland then invalidated Teradyne's automatic test equipment patent in an *inter partes* review proceeding.



# CONSUMER BRANDS & RETAIL

## NIKE

In 2015, the U.S. District Court for the District of Oregon dismissed a copyright infringement and Digital Millennium Copyright Act (DMCA) case against Nike. Photographer Jacobus Rentmeester, who took a photograph of Michael Jordan executing a dunk in 1984 that was published in LIFE magazine, had claimed that Nike copied his protected expression in creating the iconic “Jumpman” logo for its Brand Jordan products. The court accepted Kirkland’s arguments that the plaintiff could not monopolize the idea of Jordan dunking a basketball in a particular way, and that Nike’s photograph and Jumpman logo were not substantially similar to the plaintiff’s photograph as a matter of law. The U.S. Court of Appeals for the Ninth Circuit affirmed the district court’s decision in 2018, issuing a precedential opinion which has become the court’s leading decision on substantial similarity and meaningfully clarified issues such as the inverse ratio rule. In 2019, the Supreme Court denied *certiorari*.

## TJX

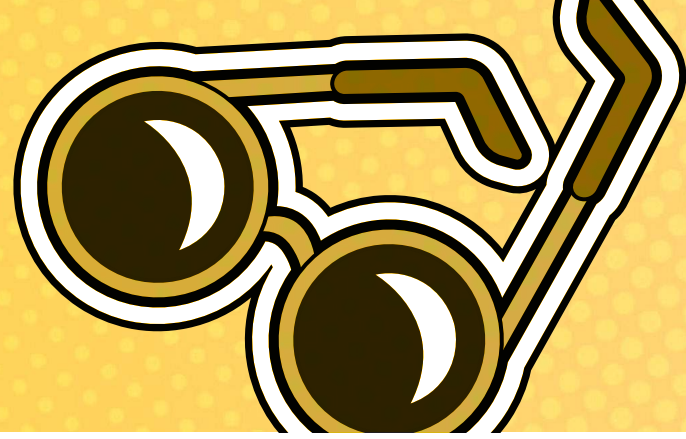
Kirkland successfully represented TJX in a high-profile suit brought by Burberry, obtaining an early, favorable settlement of claims of trademark counterfeiting, infringement and dilution under the Lanham Act, violations of New York state common law, and a count of unfair competition based on TJX’s sale of several products that Burberry claimed infringed its registered plaid design. Burberry originally sought treble damages, or, alternatively, statutory damages of as much as \$2 million per violation, as well as attorneys’ fees and costs. Kirkland also provides ongoing strategic advice to TJX in a variety of matters.

## CONVERSE

Kirkland represented Converse in a hotly contested trademark case at the ITC. Converse, which is owned by Nike, instituted the action against more than 30 companies, seeking an order excluding knockoff shoes that infringe Converse’s trademark in its iconic “Chuck Taylor” shoe design, specifically the toecap and midsole design, from entering the United States. After a trial, the Administrative Law Judge (ALJ) found Converse’s three asserted trademark registrations valid and infringed by all respondents — validating Converse’s intellectual property of its iconic shoe design and supporting its enforcement efforts against knockoffs. However, in a controversial ruling, the ITC reversed the ALJ’s decision and determined that Converse did not hold valid trademark rights in the key design elements it had asserted in the case. In 2018, the U.S. Court of Appeals for the Federal Circuit reversed the ITC’s ruling and remanded for further proceedings, holding that the ITC applied the wrong standards for determining secondary meaning and infringement. On remand, the ITC ruled that elements of Converse’s claimed trade dress were indeed protectable. Ultimately, some products were found infringing and others were found non-infringing.

## DICK’S SPORTING GOODS

Kirkland defended Dick’s Sporting Goods against claims that its SECOND SKIN trademark infringed Tommy John, Inc.’s alleged common law rights in the same term and that Dick’s Sporting Goods’ federal trademark registrations should be cancelled. Kirkland obtained a settlement before Dick’s Sporting Goods was required to answer the complaint and before discovery.



### **LUCKY BRAND**

Kirkland represented Lucky Brand and its affiliates in trademark litigation brought by Florida-based wholesale company Marcel Fashions, alleging reverse confusion and infringement of its GET LUCKY mark, in relation to the defendants' use of the word "lucky." In 2016, Kirkland's motion to dismiss was granted, but was subsequently vacated and remanded by the Second Circuit. In 2020, the Supreme Court unanimously reversed the judgment and remanded the case, finding that Lucky Brand was not barred from raising new defenses against Marcel.

### **COLGATE-PALMOLIVE**

Kirkland advises Colgate-Palmolive and its subsidiary, Hill's Pet Nutrition, on a wide range of trademark matters. Among other things, Kirkland represented Colgate-Palmolive in trademark infringement litigation involving the "Total" brand for oral care products, its crown jewel, filing two separate suits alleging various trademark-related claims against defendants Johnson & Johnson and Chattem based on their use of "Total Care" for mouthwash products. Kirkland obtained favorable settlements in both cases.

### **LIONEL**

Kirkland provides strategic advice to Lionel on a wide range of trademark and copyright issues related to its toy trains and related products. Kirkland manages Lionel's worldwide trademark portfolio and advises on enforcement issues.

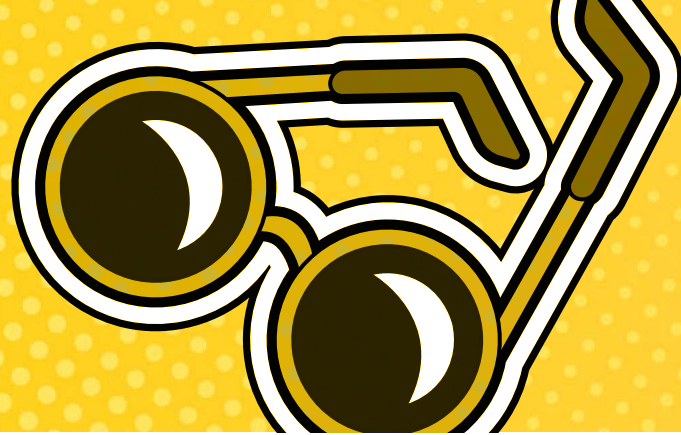
### **HERMÈS INTERNATIONAL**

Kirkland won two separate jury trials against retailers selling knock-offs of Hermès' famous leather products, including the famous "Kelly handbag," obtaining verdicts that included findings of intentional infringement, damages and punitive damages. Kirkland also obtained a decisive ruling by the U.S. Court of Appeals for the Second Circuit on behalf of Hermès that "knock-offs harm the public." In addition, Kirkland won a suit for breach of a prior settlement agreement by knock-off retailer Lederer de Paris Fifth Avenue. Previous litigation between the parties had concluded with a jury verdict in Hermès' favor, followed by a settlement agreement. Kirkland amassed enough evidence of litigation misconduct and perjury to convince the court to take the extraordinary step of striking Lederer's answer and counterclaims as a sanction, and ruling from the bench in Hermès' favor. The case ultimately settled on terms favorable to Hermès.

### **GENERAL MOTORS**

Kirkland represented General Motors in a suit brought by DaimlerChrysler, asserting that the H2 Hummer SUV grille infringed its alleged trademark rights in a "family" of Jeep grilles. Kirkland defeated DaimlerChrysler's application for a preliminary injunction and then persuaded the district court that DaimlerChrysler had no right to challenge GM's use of the Hummer grille on a commercial vehicle like the H2 by virtue of an agreement in which DaimlerChrysler's predecessor, American Motors, transferred all intellectual property rights in the Hummer design to GM's predecessor in interest.





### LE TIGRE

Kirkland's attorneys represented Le Tigre in a trademark infringement and breach of contract suit against its exclusive licensee after the licensee failed to make royalty payments and started selling Le Tigre apparel in unauthorized retail channels. Kirkland's attorneys obtained a temporary restraining order directing the licensee to, among other things, provide weekly sales reports indicating where LE TIGRE-branded merchandise was being sold. After determining that the licensee was continuing to make unauthorized sales to off-price stores rather than to the better department stores and high-end specialty stores that were Le Tigre's target customers, Kirkland's attorneys moved for a modification of the existing injunction. After hearing from witnesses for both sides, the court found for Le Tigre and granted further injunctive relief. The matter settled shortly thereafter on favorable terms.

### CALVIN KLEIN

Kirkland provides strategic advice to Calvin Klein in a variety of matters. For example, Kirkland advised on the marketing campaign for the ck one brand, which involved a significant social media component as well as in-store, web-based, print and video elements.

### BYRNA TECHNOLOGIES

Kirkland represented Byrna in litigation against Duke Defense USA and former Byrna employees, alleging the misappropriation of trade secrets, trademark and trade dress infringement, and breach of contract, among other claims. In September 2021, the court granted a broad preliminary injunction against the defendants.



### DYSON

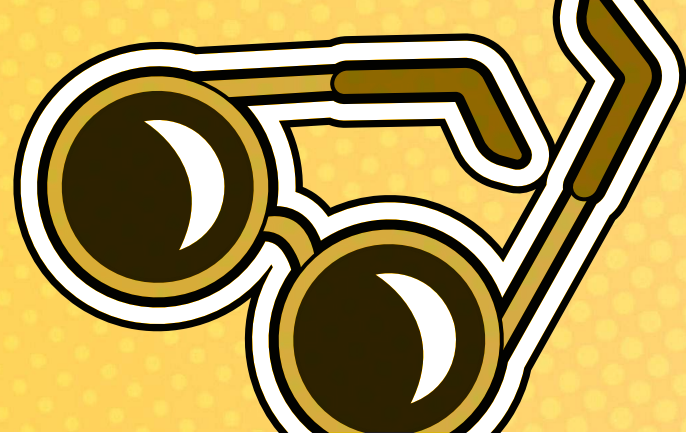
Kirkland represented Dyson, an innovative technology company and maker of Dyson-brand vacuums, in litigation against its vacuum competitor SharkNinja in the U.S. District Court for the Northern District of Illinois.

In this dispute, filed in November 2014, Dyson challenged the advertising claim of SharkNinja, which had advertised that its Shark Rotator Powered Lift-Away cleaned carpets better than Dyson's "Best" vacuum, which at the time was the DC65. The parties litigated this matter for four years. In June 2018, after a 10-day trial, the jury unanimously found that Shark's advertising was false and that Shark's false advertising was willful and awarded \$16 million in damages for Kirkland's client, Dyson. Kirkland also represented Dyson in a related suit brought by SharkNinja against Dyson in the District of Massachusetts, which SharkNinja withdrew with prejudice on the eve of trial.

### TRADER JOE'S

Kirkland's attorneys obtained a temporary restraining order on behalf of Trader Joe's barring the Gristede's supermarket chain from proceeding with its planned opening of a new store under the name "Gristede's Trader John's," and from using trade dress that copied the distinctive Trader Joe's style. The case settled on favorable terms shortly thereafter.





### LIMITED BRANDS

Kirkland has represented Limited Brands, including its Victoria's Secret and Bath & Body Works (BBW) businesses, on myriad intellectual property issues, including protection of the well-known Victoria's Secret "Pink" brand. Kirkland attorneys represented Victoria's Secret in a trademark suit against Victor Moseley, owner of adult novelties shop Victor's Little Secret, which went up to the U.S. Supreme Court and ultimately resulted in a new dilution statute. After the Supreme Court ruled on appeal that dilution requires actual harm, rather than mere likelihood of harm, Congress passed the Trademark Dilution Revision Act (TDRA), overturning the Supreme Court's decision. Kirkland attorney Dale Cendali served on the INTA President's Select Task Force on Dilution, which drafted the TDRA, and helped prepare INTA's president for testimony before Congress regarding the proposed statute. After passage of the TDRA, the Sixth Circuit remanded the case and the district court ruled for Victoria's Secret under the TDRA.

In addition, Kirkland defended BBW against claims by the producer of *The Twilight Saga* film series that BBW's Twilight Woods product line infringed Summit's trademark rights, including defeating Summit's motion for summary adjudication. The parties settled immediately before motions *in limine* were to be argued.

### COLSON GROUP

Kirkland represented Colson Group in trademark infringement and unfair competition litigation brought by its competitor, involving Colson's AX wheel which it intended to offer in industry standard orange and maroon colors. CCI claimed that it owned a trademark in the color orange in connection with wheels and sued Colson, seeking a temporary restraining order to enjoin all marketing, sales, or promotion of Colson's AX wheel. In 2020, Colson convinced the court to deny the TRO and convert the request into one for a preliminary injunction. Following substantial briefing and evidentiary submissions, the court not only granted Colson's motion to strike a great deal of CCI's improper evidence, but also denied CCI's request for a preliminary injunction and denied CCI's motion to dismiss Colson's counterclaim for cancellation of CCI's trademark registration. Following these decisions, the case settled. This was a significant victory for Colson, as it had hundreds of thousands of dollars in inventory that was able to sell freely in the market.

# BUSINESS, CONSUMER & FINANCIAL SERVICES

## VERIZON COMMUNICATIONS

Kirkland achieved a pair of major courtroom wins for Verizon Communications in its multi-front advertising litigation with Cablevision Systems Corporation. In August 2015, Kirkland obtained a rare temporary restraining order (TRO) against Cablevision's recent anti-FiOS ad campaign that portrayed Verizon as a "liar" for touting the superior aspects of its FiOS service. The U.S. District Court for the Eastern District of New York ruled that Cablevision's claims that Verizon "lies" are false, shut down Cablevision's campaign and required all such advertising claims to be removed from TV, radio, newspaper and Internet advertising within days. Even more unusual, Cablevision began its aggressive "liar" campaign while the parties were involved in a pending lawsuit. Cablevision challenged Verizon's advertising claim to have the "fastest WiFi available from any provider" because its in-home router was technically comparable to Verizon's router. After a three-day evidentiary hearing, the court denied Cablevision's challenge and found that Verizon's superior services justified its "fastest WiFi" claims. The parties reached a settlement and filed a joint stipulation of dismissal in September 2015.

Kirkland also successfully defended Verizon against a temporary restraining order and preliminary injunction in the Eastern District of New York. Cablevision sought to enjoin a major television advertising campaign Verizon launched in the New York designated market area (DMA). After the temporary restraining order was denied, Kirkland filed an opposition brief for Verizon that exposed Cablevision as the entity that was, in fact, falsely advertising services to

consumers. After the opposition was picked up and quoted by the media, Cablevision voluntarily dismissed the complaint with prejudice based on a confidential "settlement."

## MANPOWER

Kirkland successfully defended global staffing company Manpower, Inc. (d/b/a ManpowerGroup) and its affiliate, Right Management, Inc., against trademark infringement claims brought by Humanly Possible, Inc. Plaintiff moved for a preliminary injunction, arguing that Manpower's use of the phrase "humanly possible" in a series of advertisements and related marketing materials infringed its federally registered HUMANLY POSSIBLE mark. The court denied Plaintiff's motion for an injunction and its pre-discovery summary judgment motion and granted Manpower's cross-motion for summary judgment, finding that there was no likelihood of confusion between Plaintiff's mark and Manpower's use of "humanly possible."

Kirkland also represented Manpower in a case involving an attempt by Workforce Brokers, LLC to cancel Manpower's registrations for its MANPOWER marks based on the argument that the mark is generic. Manpower asserted counterclaims for trademark infringement under federal law as well as related state law claims. Shortly after the deposition of Workforce Brokers' purported expert was noticed, the case settled. The resolution of the case in Manpower's favor, which is a matter of public record, not only included an agreement by Workforce Brokers to cease its use of MANPOWER-formative marks, but also included acknowledgment that the MANPOWER marks are not generic and are valid and protectable.



### **AT&T**

Kirkland defeated a preliminary injunction motion brought by Citigroup related to AT&T's launch of a customer appreciation program called AT&T THANKS. Citigroup filed suit in the U.S. District Court for the Southern District of New York, alleging that AT&T THANKS infringed on Citigroup's trademarks related to its THANKYOU FROM CITI customer loyalty and rewards program. The court sided with AT&T on every issue, finding that Citigroup failed to adequately show irreparable harm and was unable to establish that AT&T's program name would lead to consumer confusion. Notably, in just a few weeks, Kirkland commissioned multiple surveys showing there was no likelihood of consumer confusion.

### **ALIGHT SOLUTIONS**

Kirkland represented Alight Solutions in a declaratory judgment action that it brought against Alight, Inc. in late 2017, seeking a declaration that its use of ALIGHT-formative marks did not infringe Alight, Inc.'s purported ALIGHT trademark. Alight, Inc. asserted counterclaims and moved for a preliminary injunction and expedited discovery, after which Alight Solutions was granted leave to assert an additional claim for cancellation of Alight, Inc.'s registrations based on fraud on the PTO. Shortly thereafter, the matter settled.

### **LIFELOCK**

Kirkland has represented LifeLock, the industry leader in identity theft protection, in various false advertising and unfair competition litigation, and continues to advise and represent the company in related matters.

### **DROGA5**

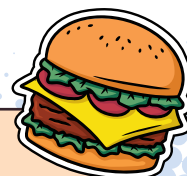
Kirkland defended Droga5 against trademark infringement, unfair competition and right of publicity claims brought by Dov Seidman and LRN Corp. arising out of the "How Matters" advertising campaign that Droga5 created for co-defendant Chobani's Greek Yogurt products. After discovery and with motions for summary judgment imminent, Seidman and LRN moved to voluntarily dismiss their Lanham Act claims. The court granted the motion but kept jurisdiction based on the defendants' counterclaims and required plaintiffs to bring any state law claims in the pending federal case, in an effort to prevent any attempt at belated forum shopping. Plaintiffs then dropped their state claims and brought claims in New York state court against Droga5 and Seidman's literary agent. The case settled prior to trial.

### **CALIFORNIA CREDIT UNION**

Kirkland represented California Credit Union in trademark litigation against competitor California Coast Credit Union, and in obtaining registration of the CALIFORNIA CREDIT UNION mark, despite prior failed efforts by other counsel to do so.



# FOOD & BEVERAGE



## PEPSICO

Kirkland represents PepsiCo in a high-profile trademark dispute brought by a company using the mark Rise Brewing Company, for nitro-brewed coffee, challenging PepsiCo's use of the trademark "Mountain Dew Rise Energy" for its carbonated, fruit-flavored energy drink. After the district court entered a preliminary injunction that required PepsiCo to stop sales of products with the disputed packaging, PepsiCo hired Kirkland to handle the expedited appeal and ongoing district court litigation. In a widely reported, unanimous opinion, the Second Circuit reversed and found that the district court abused its discretion by enjoining PepsiCo's use of the Mountain Dew Rise Energy mark. The court also agreed with PepsiCo's position that the plaintiff's trademark is entitled to limited protection and that the plaintiff is not likely to succeed on the merits of its claim.

## SANDERSON FARMS

Kirkland represented Sanderson Farms, one of the nation's largest chicken producers, in false advertising lawsuits brought by nonprofit advocacy organizations challenging Sanderson's poultry advertising. The lawsuits generally alleged that Sanderson's advertising was false and misleading in light of Sanderson's use of antibiotics in raising its chickens. Kirkland successfully obtained dismissal of the advocacy organizations' initial challenge for lack of standing, which was affirmed on appeal. The organizations returned with a new co-plaintiff in an attempt to manufacture standing. In 2021, Kirkland again secured dismissal.

## MERISANT

Kirkland represented Merisant, the maker of Equal artificial sweetener, in its lawsuit against McNeil Nutritionals, a subsidiary of Johnson & Johnson and the maker of Splenda artificial sweetener, alleging that Splenda's "made from sugar so it tastes like sugar" and related claims were false and misleading. After a five-week trial and as the court prepared to announce the jury's verdict, the parties reached a confidential settlement. Subsequent press coverage of juror interviews reported that the jury had found for Merisant, concluding that McNeil's campaign was false and misleading, and awarded Merisant "substantial" monetary damages.



### **FGF BRANDS**

The U.S. District Court for the Central District of California granted summary judgment for FGF Brands against Stonefire Grill, which had alleged that FGF Stonefire Authentic Flatbreads brand infringed its federal and state trademark rights in the mark “Stonefire Grill” for use in connection with restaurant services. The court dismissed Stonefire Grill’s claims in their entirety, finding that it failed to establish a likelihood of confusion and that the record developed by Kirkland through targeted discovery left no room for trial. After Stonefire Grill agreed not to appeal the Court’s summary judgment ruling, the case was closed.

Kirkland also represented FGF Brands in false advertising litigation concerning the characteristics of its baking process. In 2019, Kirkland won dismissal of claims brought under the Illinois Uniform Deceptive Trade Practices Act. A favorable settlement was achieved in 2021.

### **E. & J. GALLO WINERY**

Kirkland’s attorneys represented E. & J. Gallo Winery in an action brought by Heublein, alleging that Gallo had engaged in false and misleading commercial advertising and promotion and unfair competition in connection with its margarita-flavored malt beverages, sold under the BARTLES & JAYMES brand. Following discovery targeted at Heublein’s own labeling practices with respect to its flavored beverages, the case settled on favorable terms as Gallo was about to file its motion for summary judgment.

### **KRAFT PIZZA COMPANY**

Kirkland won summary judgment for Kraft Pizza Company in its trademark lawsuit against its frozen pizza rival Schwan’s, which claimed trademark rights in “brick oven” for use in connection with frozen pizza. The court concluded that Schwan’s claimed trademark was generic and thus not protected as a matter of law. The U.S. Court of Appeals for the Eighth Circuit affirmed Kraft’s win in a unanimous opinion.

# HEALTHCARE & LIFE SCIENCES

## ALCON

Kirkland defended Alcon in a patent and copyright lawsuit concerning laser eye surgery technology, including defeating a preliminary injunction motion that sought to enjoin sales of Alcon's LenSx systems, winning summary judgment motions based on the copyright statute of limitations and related J&J entities not being beneficial owners of the asserted works, and defeating J&J's motion for summary judgment on ownership of the asserted software. Kirkland helped Alcon secure a favorable settlement on the eve of trial.

## ZOETIS

A French company opposed our client's trademark applications for the ZOETIS house mark in the United States, before OHIM, and in various European countries. Kirkland represented Zoetis in the TTAB. Although the TTAB does not generally allow foreign witnesses to be deposed, Kirkland issued a subpoena pursuant to 35 U.S.C. § 24 and obtained a district court ruling requiring a witness from the French company to be deposed. The case settled soon thereafter, with the parties entering into a global co-existence agreement.

Kirkland also defeated a reverse cybersquatting claim brought against Zoetis in an effort to reverse a UDRP decision requiring OTC Outlet to transfer the domain name ALPHATRAK.COM to Zoetis. After Zoetis moved to dismiss the complaint for failure to state a claim, OTC Outlet voluntarily dismissed the case.

## ABBOTT LABORATORIES

Kirkland achieved a major victory for Abbott Laboratories in a putative class action alleging false and deceptive advertising when the U.S. District Court for the Central District of California denied the plaintiff's motion for class certification. The plaintiff alleged that a key ingredient in Abbott's Ensure Muscle Health product is not effective for certain consumers and that Abbott failed to disclose that fact. The district court agreed with Abbott that because the effect would not be the same for all members of the putative class, a class action would not be proper for certification because individual inquiries would predominate. In 2017, the U.S. Court of Appeals for the Ninth Circuit affirmed the district court's decision and dismissed the class certification appeals, resulting in a complete win for Abbott.

Also for Abbott, in *Colucci v. Zone Perfect Nutrition Company*, Kirkland obtained denial of class certification in a putative nationwide class action alleging that Zone Perfect Nutrition Bars were falsely advertised as "natural" under California UCL, FAL, CLRA, and other state laws.





# TRAVEL & HOSPITALITY



## DELTA

Kirkland represented Delta Air Lines in litigation brought by American Airlines, involving American's five federal trademark registrations for marks containing the word "flagship." American alleged trademark infringement and unfair competition in relation to Delta's use of the word "flagship" to describe its aircraft and airport lounges. Delta then sought declaratory judgments of invalidity and noninfringement, as well as cancellation of the marks. In 2021, a day before the jury trial was scheduled to begin, the parties resolved their dispute.

## EQUINOX HOLDINGS

Kirkland, representing Equinox Holdings, defeated a motion for preliminary injunction filed by Equinox Hotel Management alleging a trademark infringement over Equinox Holdings' use of the EQUINOX trademark in connection with its hotel line. The U.S. District Court for the Northern District of California denied the motion and granted the defendant's motion to dismiss the claims for false advertising and for unfair competition based on fraudulent business acts or practices.

## SH GROUP

Kirkland represented SH Group after the TTAB affirmed the PTO's refusal to register its 1 HOTEL marks because of an alleged likelihood of confusion with THE ONE for nightclubs and hospitality services. With the launch of 1 HOTEL just three months away, Kirkland filed a complaint in the U.S. District Court for the Southern District of New York, appealing the TTAB's decision and challenging the other party's marks. As a result, Kirkland was able to obtain a settlement that allowed the marks to co-exist in the marketplace and at the PTO.

Kirkland also represented SH Group in a trademark dispute relating to the 1 HOMES marks, against the condominium association for the 1 HOTEL & HOMES property. Kirkland successfully moved to dismiss Defendants' counterclaims in the U.S. District Court for the Southern District of Florida. The matter settled during discovery.

## VIRGIN CRUISES

Kirkland represented Virgin Cruises against Colin Veitch, the former CEO of Norwegian Cruise Lines who sought more than \$300 million for Virgin Cruises' alleged misappropriation of Veitch's business idea to launch a Virgin-branded cruise line with two "Ultra Ships." Virgin Cruises denied the allegations stating that its business plan was independently developed by a team of industry veterans and that the "trade secrets" were publicly known. Virgin Cruises also emphasized that its business plan was not sufficiently similar to Veitch's, as Virgin Cruises intends to set sail with a fleet of new mid-sized ships that differ substantially from those Veitch proposed. The parties settled and Veitch dismissed the claims in February 2016.

# KEY FACTS

## **STRONG, HIGHLY ESTEEMED ATTORNEYS**

Our lawyers repeatedly have been recognized by *The National Law Journal*, *Chambers Global*, *Chambers USA*, *Law360*, *The Legal 500 United States*, *Managing Intellectual Property* and *World Trademark Review*, among others, as among the very best of the best. According to *The Legal 500 United States*, Kirkland's trademark practice "'demonstrates valuable business acumen and appropriateness of advice' and is 'extremely professional and responsive with tremendous expertise,' with a client base that includes leading names in the fields of entertainment, hi- technology, consumer products and fashion brands." *Chambers USA* commented that our advertising practice is "Well known for handling high-profile litigation in the advertising arena, including consumer class action cases and NAD disputes and challenges. [Kirkland] utilizes its attorneys' strong technical skills to offer representation in matters involving complex IP issues."

## **DALE CENDALI**

*Chambers USA* has recognized Kirkland partner **Dale Cendali**, who teaches copyright and trademark litigation at Harvard Law School, as "one of the best lawyers in the country for soft IP" who combines "intellectual acuity" with a "tough, hard-working attitude" calling her a "superb litigator" who "thinks quickly on her feet and vigorously defends her clients." *Managing Intellectual Property* named her "Outstanding IP Litigator for New York" in 2017. *The World Trademark Review* (WTR) has recognized her as a "Trademark Experts' Expert." *The National Law Journal* has named her as one of the "100 Most Influential Lawyers in America," as one of the "Most Influential Lawyers" in the country, and as one of "America's Top 50 Women Litigators." Euromoney Legal Media Group named Dale as both "Best in Copyright" and "Best in Trademark" in the Americas at its Women in Business Law Awards. *Law360* named Dale as one of the "Icons of IP" who have made an indelible mark on the profession, as well as a 2018 "Media & Entertainment MVP."

## **CLAUDIA RAY**

**Claudia Ray** has been recognized by *Chambers USA*, where clients described her as a "leading authority throughout the country and beyond" and a "terrific and wonderful attorney" rapidly making a name for herself as an "outstanding courtroom performer." *WTR* magazine has recognized Ray every year since its inaugural ranking of the leading law firms and individual practitioners in the area of trademark law, in which clients noted they "would recommend her without hesitation" and praise her "amazing clarity of verbal and written expression."

### **JOSHUA SIMMONS**

**Joshua Simmons** has been ranked by *Chambers* for his copyright, trademark, trade secret, and media & entertainment practices, describing his “notable expertise” with “entertainment and technology sector clients.” *World Trademark Review* referred to Josh as a “dexterous all-rounder,” ranking him for trademark enforcement, litigation, prosecution and strategy. And, due to Josh’s “broad-based expertise in IP litigation” and “record at trial and appeals, including cases before the US Supreme Court,” *Legal 500* recognized his copyright, trademark litigation, trade secrets, and media and entertainment practices.

### **DIANA TORRES**

**Diana Torres** has been recognized for excellence in trademark litigation each year since 2010 in *The Legal 500 United States*, remarking that she is “an extremely business savvy lawyer” and “the crème de la crème.”

### **ROSS WEISMAN**

**Ross Weisman** has been nationally recognized for his advertising work in *The Legal 500 United States* each year since 2011. In the 2015 edition of *Chambers USA*, one client noted, “His presentation skills are outstanding, which is one of the reasons why he is on our shortlist, or rather he IS our shortlist!”

### **JOHANNA SCHMITT**

**Johanna Schmitt** has been recognized in *The Legal 500 United States* for trademark litigation, copyright, and most recently media and entertainment litigation.

### **SUBSTANTIAL COURT EXPERIENCE**

Kirkland’s lawyers have a wealth of experience in handling high-profile matters at the cutting edge of copyright, trademark, Internet and advertising law. They were centrally involved in precedent-setting U.S. Supreme Court cases such as *Moseley v. Victoria’s Secret Catalogue* (trademark dilution), *Lucky v. Marcel* (trademark defenses), and *Dastar v. Twentieth Century Fox* (trademark infringement). They also have led myriad ground-breaking circuit court cases such as *Fox v. TVEyes* (copyright fair use), *Rentmeester v. Nike* (copyright substantial similarity), and *Oracle v. Google* (copyrightability of software). And their high-profile district court victories include *Warner Bros. and Rowling v. RDR Books* (copyright/fair use) and *Shepard Fairey v. Associated Press* (copyright fair use).

### **THOUGHT LEADERSHIP AND COMMUNITY INVOLVEMENT**

Kirkland attorneys frequently speak and write on significant legal issues that are likely to affect our clients, including artificial intelligence, copyrightability of software, copyright fair use, trademark keywords, social media and DMCA safe harbor issues. Kirkland’s lawyers also are involved with numerous bar organizations in leadership roles, including chairing several committees.



# ABOUT KIRKLAND & ELLIS

Kirkland & Ellis is an international law firm that serves a broad range of clients around the world in intellectual property, litigation, white collar and government disputes, private equity, M&A and other corporate transactions, and restructurings. We offer the highest quality legal advice coupled with extraordinary, tailored service to deliver exceptional results to our clients and help their businesses succeed. We invest in the brightest legal talent and build dynamic teams that operate at the pinnacle of their respective areas. And we believe in empowering our lawyers, encouraging entrepreneurialism, operating ethically and with integrity, and collaborating to bring our best to every engagement. These principles have guided us in building successful long-term partnerships with clients since our founding in 1909.

Kirkland's Intellectual Property Law Practice Group protects our clients' ideas, technology, products and brands. Global clients in wide-ranging industries engage us on complex IP litigation, transactions and counseling matters. From market leaders to dynamic startups, we help clients protect their market position and maximize their intellectual property. Located in the Firm's Austin, Bay Area, Boston, Chicago, Houston, London, Los Angeles, New York, Salt Lake City and Washington, D.C. offices, Kirkland has more than 200 intellectual property lawyers who are experienced in a variety of technical disciplines and registered to practice before the U.S. Patent and Trademark Office. Approximately 75 percent of the lawyers are engineers and scientists trained with degrees and professional backgrounds in technical areas.

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## PRACTICE AREAS

Copyright Litigation | Copyright and Trademark Clearance and Prosecution  
Defamation | False Advertising | Intellectual Property Counseling  
Internet-Related Litigation and Counseling *including Domain Name Disputes and the DMCA*  
National Advertising Division Disputes | Privacy and Publicity Rights | Trade Secrets  
Trademark and Trade Dress (Product Packaging and Design) Litigation | Unfair Competition



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