



Influential Women In IP Law

Dale Cendali



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Having halted publication of an unauthorized Harry Potter encyclopedia and led The Associated Press to victory in an infringement case over the Obama “Hope” poster, Kirkland & Ellis LLP partner Dale Cendali is consistently on the front lines in some of the biggest cases in copyright and trademark law, making her one of *Law360*’s Most Influential Women In IP Law.

Cendali, who is based in the firm’s New York office, focuses her practice on representing entertainment, technology and consumer products companies. She said that when she was president of the Yale Dramatic Association as an undergraduate, she was attracted to the theater of law and trial arguments, as well as the idea of protecting creators.

After graduating from Harvard Law School, she decided to specialize in intellectual property, even though it was something of a backwater then compared with its prominent place in the legal profession today.

“When I was a summer associate, I read a *Wall Street Journal* article that said 90 percent of lawyers are bored with what they do,” she said. “I vowed

not to be in that 90 percent, so I picked a field that interested me, even though when I started out, it seemed less promising than something like M&A.”

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In more than 20 years in practice, Cendali has represented clients like Victoria’s Secret and Oracle Corp. in landmark cases that have reshaped an area of the law that has continued to grow in economic significance, confirming to her that she made the right choice.

“Over the course of my career, it’s been anything but boring,” she said.

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When RDR Books planned to publish a book called the “Harry Potter Lexicon” that purported to be an encyclopedia of spells, creatures and other terms in the book series, author J.K. Rowling and Warner Bros. Entertainment Inc. turned to Cendali to bring a copyright and trademark infringement suit.

According to Cendali, the book simply restated words from Rowling’s books, with “virtually no analysis, commentary or background information you’d expect from a true encyclopedia or reference book.” In 2008, a judge agreed, finding that the book would cause “irreparable injury” to the copyright owners and issuing a

permanent injunction barring its publication.

“It was an important case to establish the rights of authors to their own words,” Cendali said.

In a case that garnered even more media attention, Cendali represented The Associated Press when it sued artist Shepard Fairey over his “Hope” poster and related merchandise, which the company alleged was based on one of its photos of then-Sen. Barack Obama.

While Fairey initially claimed that his work was based on a different image and was protected as fair use under copyright law, Cendali and the AP uncovered during discovery that Fairey had destroyed and fabricated evidence to fend off the infringement allegations.

The AP settled with the artist and won summary judgment on the fair use claim by his apparel licensee. Fairey was eventually sentenced to probation after pleading guilty to criminal contempt of court for tampering with evidence.

Cendali said she has worked on several cases where the opposing side had fabricated evidence, so she was skeptical of Fairey’s claims to have used a different photo and kept pushing for documents until he was forced to admit what he’d done.

“When you’ve had a case where someone has done something like this, you start looking critically at the evidence,” she said.

When Cendali represented Victoria’s Secret in a trademark suit against the

owner of Kentucky-based adult novelty store called Victor’s Little Secret, the long-running case ended up rewriting the law on trademark dilution.

Although a lower court ruled that the store’s name tarnished Victoria’s Secret’s trademark, the U.S. Supreme Court reversed and remanded in 2003, ruling that the company had to show actual harm, not just a likelihood of harm, to prevail in a trademark dilution case.

Dale is “very thoughtful and creative in her ability to come up with proposed solutions.”

In response, the International Trademark Association lobbied Congress to pass the Trademark Dilution Revision Act, which effectively overturned the Supreme Court’s decision. Cendali, who was a member of the INTA panel that helped write the new law and prepare for congressional hearings, said the Supreme Court decision “was an opportunity for an overhaul of the statute.”

“The requirement of showing actual harm made the statute essentially unworkable,” since companies want to halt trademark dilution before it occurs, she said. In 2010, the Sixth Circuit found that the Victor’s Little Secret name created a likelihood of dilution under the new law and enjoined the store from using it.

Cendali’s most recent high-profile victory came in May, when the Federal Circuit reversed a lower court’s ruling

that the application programming interfaces for Oracle’s Java software are not entitled to copyright protection.

Cendali, along with co-counsel from Orrick Herrington & Sutcliffe LLP, persuaded the court to revive Oracle’s suit accusing Google Inc.’s Android operating system of infringement and hold that functional computer programs can be copyrightable. Google is expected to appeal to the U.S. Supreme Court.

In-house counsel who have worked with Cendali praised her breadth of expertise in IP law and sensitivity to the business goals of clients.

“She’s just very client-focused. She’s a tenacious advocate on behalf of Oracle and always thinks about us and what we need,” said Deborah Miller, the company’s vice president and associate general counsel.

While Oracle’s appeal was pending at the Federal Circuit, Cendali was responsible for lining up amicus briefs from groups like BSA-The Software Alliance in support of the company’s position that Java was copyrightable, which Miller said was an important part of the case.

“What we get from her that I find very valuable is that she’s extraordinarily business-centric,” said Nadine Flynn, vice president and senior associate general counsel at Colgate-Palmolive Co., who has consulted with Cendali on a variety of potential trademark litigation matters.

The company is often just not interested in full-blown litigation in many matters, Flynn said, and Cendali

understands that and is “very thoughtful and creative in her ability to come up with proposed solutions.”

“She is extraordinarily humble, extraordinarily approachable and easy to deal with,” Flynn said. “It’s just always a pleasure. She’s a real credit to the legal profession.”

Cendali also does a great job of teaching the younger attorneys she works with, according to Flynn, who hired one attorney who worked with Cendali at Kirkland, Melanie Bradley, as a trademark attorney at Colgate-Palmolive after seeing how well she’d been trained.

Although there are still relatively few women in senior positions in IP law, Cendali said she is hopeful that will change. Today, it’s common for her opposing counsel to be a woman, she said — something that would have been surprising early in her career. And there are many more female judges and in-house counsel, she added.

Cendali said her advice for young associates is that a legal career is “a marathon, not a sprint,” and that they should set short-term goals, such as writing articles and working with bar associations, that will add to their resume to make clients want to hire them and partners want to staff them on cases.

“You have to do more than a good job on what you’ve been assigned; you have to go beyond that with energy and commitment,” she said.

In addition to her work in the courtroom, Cendali teaches copyright and trademark litigation as an adjunct professor at Harvard Law School. She said she is often told by her students that she is one of the few professors they’ve had who strongly believes in the concept of intellectual property rights, since many full-time law school professors tend to believe in narrower IP protection.

Her classes involve lively debates about IP issues, where her views

sometimes run counter to those of some of her students, some of whom have later joined firms representing her opponents in the courtroom.

“I always put in bold on the exams, ‘Feel free to take the opposite view of your professor,’” she said. “Frequently, they do, and they still get As.”

Cendali said she tries to convey to her students the importance of IP law in the development of creative work.

“If we don’t continue to create an incentive for people to write the Harry Potter books or create vast photo archives like The Associated Press or spend hundreds of millions of dollars to create something as complex as Java, there won’t be original work for others to get to use,” she said.

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