

Joshua L. Simmons

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REPRESENTATIVE MATTERS BY INDUSTRY

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COMPUTER AND COMMUNICATIONS

- ▶ *Fox News Network, LLC v. TVEyes Inc.* (S.D.N.Y./2d Cir./U.S. Supreme Court): Won summary judgment, obtained permanent injunction, and prevailed on appeal for Fox News in a copyright infringement action against a media monitoring service. The Second Circuit held that permitting users to view video clips of telecasts was not fair use and constituted volitional conduct leading to direct infringement liability.
- ▶ *Oracle Am., Inc. v. Google Inc.* (Fed. Cir./U.S. Supreme Court): Obtained reversal in Oracle's highly publicized appeal of a district court order finding elements of its Java Application Programming Interfaces, which Google admitted to have copied when creating its Android operating system, uncopyrightable, as well as a remand for further proceedings on the issue of fair use.
- ▶ *Oracle Am., Inc. v. Google Inc.* (Fed. Cir.): Obtained reversal in Oracle's appeal from the remand fair use trial mentioned above, wherein the Federal Circuit held that Google's copying was not fair use as a matter of law.
- ▶ *Take-Two Interactive Software, Inc. v. Mod Menu Creators* (S.D.N.Y.): Obtained preliminary and permanent injunctions, defeated motions to dismiss, and secured maximum statutory damages, and attorney's fees in series of copyright, breach of contract, and tortious interference lawsuits involving computer programs that alter Take-Two's Grand Theft Auto V video game, allowing users to cheat and perform unauthorized actions.
- ▶ *Epic IP LLC v. Sharp Electronics Corp.* (S.D.N.Y.): Defended Sharp in a patent infringement litigation concerning web chat technology by moving to dismiss on the basis that Epic's patent was directed to patent-ineligible subject matter. The patent was invalidated, and the case was dismissed.
- ▶ *IBM Corp. v. Teraproc Inc.* (S.D.N.Y.): Secured permanent injunction for IBM in a copyright, trade secret, and business tort lawsuit concerning the copying by IBM's former employees of proprietary source code for a high-performance computing program into an open sourced project without IBM's authorization.
- ▶ *Bitetto v. Rometty* (N.D.N.Y.): Obtained dismissal for IBM's CEO in a copyright and unfair competition action alleging infringement of a book describing a brain-inspired microchip.
- ▶ *IpLearn LLC v. K12 Inc.* (D. Del.): Defended K12 and won multipotential infringement action involving computer-assisted learning technology, resulting in the parties stipulating to the dismissal of one patent as not infringed, and the other patent being held invalid on summary judgment because it was directed to unpatentable subject matter.
- ▶ *LivePerson, Inc. v. [24]7.ai, Inc.* (S.D.N.Y./N.D. Cal.): Representing LivePerson in a lawsuit concerning 24[7]'s misappropriation of LivePerson's chat engagement rule, variable, and data trade secrets, including defeating [24]7's summary judgment motion.
- ▶ *[24]7.ai, Inc. v. LivePerson, Inc.* (N.D. Cal.): Representing LivePerson in a patent infringement lawsuit brought by 24/7, in which six patents were held invalid because they were directed to unpatentable subject matter.
- ▶ *Oracle Am., Inc. v. Hewlett Packard Enters. Co.* (9th Cir.): Representing Oracle in its appeal of an order concerning the unauthorized use of software patches for its enterprise operating system.
- ▶ *Chronicle Books, LLC v. Audible, Inc.* (S.D.N.Y.): Representing 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.
- ▶ *Motorola Solutions, Inc. v. Hytera Commc'ns Corp.* (N.D. Ill.): Representing Motorola in a trade secret misappropriation and copyright infringement lawsuit involving Motorola's digital radio systems technology and software.
- ▶ Advising technology company to protect its artificial intelligence technology.
- ▶ Representing American medical device and health care company in enforcing its rights to the software used in its devices.
- ▶ Counseling multinational computer technology company on legislative and regulatory copyright policy issues.
- ▶ Advising various organizations with regard to the alleged infringement of copyrights in typeface software.
- ▶ Advertising American multinational corporation and technology company on the protectability of and infringement by artificial intelligence.
- ▶ Counseled American technology company on anti-circumvention issues related to its next generation technologies.

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COMPUTER AND COMMUNICATIONS

- ▶ Advised American multinational technology conglomerate on the protectability of its user interfaces.
- ▶ Counseled American travel company on copyright and data issues related to its website.
- ▶ Advised American technology company regarding its use of a third party's software in its products.
- ▶ Counseled American multinational information technology company on copyright and Computer Fraud and Abuse Act issues related to its web crawling activities.
- ▶ Registered computer program copyrights for audio, visual, and voice technology company.
- ▶ Advised American health care company on open source software-related issues.
- ▶ Counseled American data communications and telecommunications equipment provider on potential copyright and trade secrets claims related to its software offerings and telecommunications signaling.
- ▶ Advised hospitality industry software service company on its copyright portfolio and potential infringements thereof.
- ▶ Counseled audio, visual, and voice technology company on its copyright portfolio.
- ▶ Advised worldwide IT company in developing its copyright registration program.
- ▶ Counseled high-tech product manufacturing company regarding enforcement of software licensing terms.
- ▶ Provided trademark advice to startup company.
- ▶ Advised multinational technology and consulting company regarding new service that utilizes web crawling technologies.
- ▶ Counseled cloud-based data and analytics service regarding intellectual property issues related to web crawling and real-time content acquisition.
- ▶ Advised U.S. software company on copyright-related tax issues.
- ▶ Prepared social media presentation for multinational technology company.
- ▶ Counseled multinational technology and consulting company on copyright issues related to new software as a service offering.
- ▶ Prepared congressional testimony for multinational computer technology company related to U.S. House of Representatives copyright review process.
- ▶ Advised teaching equipment company on trademark prosecution matters.
- ▶ Counseled social recruitment and job distribution network on trademark issues.

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CONSUMER AND LEISURE PRODUCTS

- ▶ *Bath & Body Works Brand Mgmt., Inc. v. Summit Entm't, LLC* (S.D.N.Y.): Defended BBW against claims by the producer of *The Twilight Saga* film series that BBW's Twilight Woods product line infringes Summit's trademark rights, including defeating Summit's motion for summary adjudication.
- ▶ *Hage v. Shenzhen Xiaohuangfeng Trading Co.* (T.T.A.B.): Achieved a sustained opposition and refusal of Shenzhen's trademark application.
- ▶ *Converse, Inc. v. Int'l Trade Commission* (I.T.C./Fed. Cir.): Represented Converse in an administrative proceeding and subsequent appeal seeking to bar various defendants from importing into the United States footwear that infringes and dilutes Converse's midsole trademark for its Chuck Taylor All Star shoes.
- ▶ *Drybar Holdings LLC v. PetSmar Inc.* (C.D. Cal.): Represented Drybar in a trademark and trade dress infringement lawsuit concerning an unauthorized petoriented brand extension of Drybar's product line.
- ▶ *Express, LLC v. Forever 21, Inc.* (9th Cir.): Negotiated dismissal of appeal and previously litigated district court case on behalf of Express.
- ▶ *popham design, SARL v. F. Schumacher & Co.* (D. Mass.): Lead counsel for Schumacher and Mary McDonald, Inc. in a copyright infringement lawsuit concerning cement tile and textile designs.
- ▶ *Car-Freshner Corp. v. DIRECTV, Inc.* (N.D.N.Y.): Defended DIRECTV in a trademark infringement suit arising out of its use of a pine tree-shaped air freshener in a promotional campaign for its satellite service.
- ▶ *NES Rentals* (W.I.P.O.): Obtained multiple transfer orders in domain name disputes under ICANN's Uniform Domain Name Dispute Resolution Policy.
- ▶ Negotiating agreements on behalf of F. Schumacher & Co. related to its world-renowned textiles with a variety of collaborators and influencers.
- ▶ Representing F. Schumacher & Co. in copyright enforcement matters concerning unauthorized use of its textile designs.
- ▶ Advising F. Schumacher & Co. on its trademark portfolio related to its textile design business.
- ▶ Counseled product testing company on protecting its intellectual property rights.
- ▶ Advised hygiene product company on issues associated with influencer advertising.
- ▶ Counseled luxury fashion company on copyright issues associated with a retrospective of a collection that incorporated a third party's works.
- ▶ Advised furniture manufacturer and supplier on its copyright and trademark infringement lawsuit.
- ▶ Counseled American fashion company on a right of publicity dispute.
- ▶ Advised private equity company on social media influencer issues related to its acquisition of a clothing brand.
- ▶ Counseled consumer product company on its compliance with federal and state social media influencer laws.
- ▶ Advised private equity company on trademark issues in its acquisition of a nationwide product distribution network.
- ▶ Counseled American multinational footwear and apparel designer on copyright policy issues related to its famous brands.
- ▶ Prepared license agreements for non-profit historical society.
- ▶ Counseled innovative, luxury furniture and lighting boutique on copyright and trademark issues relates it to its IP portfolio and infringing use thereof.
- ▶ Advised home technology product company on social media policy.
- ▶ Counseled product database company on copyright enforcement issues.
- ▶ Advised toy manufacturer in trademark enforcement dispute.
- ▶ Represented luxury goods producer in copyright and trademark enforcement matter.
- ▶ Counseled pet food company on social media-related issues.
- ▶ Advised global consumer products company on social media issues.
- ▶ Counseled luggage and accessories maker in negotiations with its licensor.
- ▶ Advised cargo moving company on copyright and trademark issues involved in adding advertising functionality to its website.

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FINANCIAL SERVICES

- ▶ *A.M. Best Co. v. SNL Financial LLC* (D.N.J.): Represented A.M. Best in a copyright infringement and breach of contract action concerning SNL's copying and distribution of A.M. Best's ratings as part of its online database product.
- ▶ Represented Bain Capital on trademark matters in connection with its acquisition of the Apple Leisure Group.
- ▶ Counseled bank on domain name issues.
- ▶ Advised real estate finance company on its use of third party software and termination of its agreement with the third party.
- ▶ Counseled private equity firm on trademark issues related to its acquisition of a snack company.
- ▶ Advised American private equity firm on transfer of general top-level domain names.
- ▶ Counseled investment firm on copyright issues related to one of its restaurants.
- ▶ Advised private equity company on social media influencer issues related to its acquisition of a clothing brand.
- ▶ Counseled private equity company on trademark issues in its acquisition of a nationwide product distribution network.
- ▶ Drafted social media policy for private equity firm's portfolio companies.
- ▶ Advised commercial real estate finance company regarding copyright enforcement issues.
- ▶ Represented donation service for charities in copyright enforcement matter.
- ▶ Counseled global private equity investment firm on potential acquisition of content delivery network.
- ▶ Advised global private equity firm on potential acquisition of a moving and storage company.
- ▶ Counseled global private equity firm on copyright issues related to its potential acquisition of a social media platform.
- ▶ Advised global hedge fund and asset management company on intellectual property issues related to web scraping.
- ▶ Counseled global hedge fund and asset management company on intellectual property issues related to internal computer systems.
- ▶ Advised global investment manager on intellectual property issues associated with web scraping.
- ▶ Counseled investment firm on trademark protection matters.

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HEALTH CARE AND PHARMACEUTICALS

- ▶ *Syntel Sterling Best Shores Mauritius Ltd. v. TriZetto Grp., Inc.* (S.D.N.Y.): Representing TriZetto and Cognizant Technology Solutions Corp. in a copyright, trade secret, unfair competition, and breach of contract litigation concerning healthcare software and related software consulting services.
- ▶ Advising GoodRx on its trademark portfolio related to its prescription drug price comparison and coupon business.
- ▶ Representing American medical device and health care company in enforcing its rights to the software used in its devices.
- ▶ Counseled pharmaceutical company on copyright, trademark, and right of publicity issues related to its product marketing.
- ▶ Advised American health care company on open source software-related issues.
- ▶ Represented global biopharmaceutical company in advertising disputes with competitor pharmaceutical company.
- ▶ Investigated global biopharmaceutical company's advertising substantiation related to new pharmaceutical compound.
- ▶ Counseled multinational pharmaceutical company on advertising issues related to social media campaigns.
- ▶ Guided multinational pharmaceutical company through copyright and trademark issues concerning a world-wide social media campaign.
- ▶ Counseled worldwide health care and personal product producer on social media issues.

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MEDIA AND ENTERTAINMENT

- ▶ *Fox News Network, LLC v. TVEyes Inc.* (S.D.N.Y./2d Cir./U.S. Supreme Court): Won summary judgment, obtained permanent injunction, and prevailed on appeal for Fox News in a copyright infringement action against a media monitoring service. The Second Circuit held that permitting users to view video clips of telecasts was not fair use and constituted volitional conduct leading to direct infringement liability.
- ▶ *Alexander v. Murdoch* (S.D.N.Y./2d Cir.): Obtained dismissal and won appeal for Fox Entertainment Group, along with other defendants, in a lawsuit alleging that Fox's *Modern Family* television series infringes the plaintiff's copyright in his treatment and proposed pilot script, as well as other state law rights.
- ▶ *Take-Two Interactive Software, Inc. v. Mod Menu Creators* (S.D.N.Y.): Obtained preliminary and permanent injunctions, defeated motions to dismiss, and secured maximum statutory damages, and attorney's fees in series of copyright, breach of contract, and tortious interference lawsuits involving computer programs that alter Take-Two's *Grand Theft Auto V* video game, allowing users to cheat and perform unauthorized actions.
- ▶ *Wolstenholme v. Hirst* (S.D.N.Y.): Obtained dismissal for prominent artist Damien Hirst and Other Criteria (US), LLC in a copyright infringement, trade dress infringement, and unfair competition lawsuit concerning pharmaceutical pill-inspired jewelry created by Mr. Hirst.
- ▶ *Tetris Holding, LLC v. Xio Interactive Inc.* (D.N.J.): Won summary judgment for the makers of the world-famous "Tetris" electronic game in a copyright and trade dress lawsuit against an infringing game maker.
- ▶ *Fairey v. Associated Press* (S.D.N.Y.): Won summary judgment for the AP on the issue of fair use in a declaratory judgment suit brought by Shepard Fairey, in which the AP asserted copyright infringement claims, among others, arising out of his unauthorized use of the AP's photo of President Obama to create a poster and commercial merchandise.
- ▶ *Individuals v. Epic Games, Inc. and Take-Two Interactive Software, Inc.* (C.D. Cal./D. Md./E.D. Pa.): Defending Epic Games and Take-Two in lawsuits asserting that their video games *Fortnite* and *NBA 2K*, respectively, violate the plaintiffs' copyright, publicity, trademark, and unfair competition rights to dance steps. After Epic and Take-Two moved to dismiss the eight initial lawsuits, each of the lawsuits was voluntarily dismissed.
- ▶ *Hayden v. 2K Games, Inc.* (N.D. Ohio): Defending 2K Games and Take-Two Interactive Software Inc. in a lawsuit alleging that they committed copyright infringement by accurately depicting tattoos inked by the plaintiff on certain NBA players in their *NBA 2K* video game, including winning a motion to dismiss the plaintiff's claims for unjust enrichment and for a declaratory judgment that Take-Two should have credited the plaintiff for creating the tattoos.
- ▶ *Solid Oak Sketches, LLC v. 2K Games, Inc.* (S.D.N.Y.): Defending 2K Games and Take-Two Interactive Software Inc. in a lawsuit alleging that they committed copyright infringement by accurately depicting the tattoos of three NBA players in their *NBA 2K* video game, including winning a motion to dismiss Solid Oak's statutory damages and attorney's fees claims and defeating Solid Oak's motion to dismiss Take-Two's counterclaims seeking declaratory judgments of *de minimis* and fair use, as well as fraud on the Copyright Office.
- ▶ *Chronicle Books, LLC v. Audible, Inc.* (S.D.N.Y.): Representing 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.
- ▶ *Graham v. Take-Two Interactive Software, Inc.* (S.D.N.Y.): Defending Take-Two in a trademark lawsuit concerning use of the RWTW acronym on a video game cover depicting LeBron James, with whom the acronym is associated.
- ▶ *Alexander v. Take-Two Interactive Software, Inc.* (S.D. Ill.): Defending Take-Two, along with other defendants, in a lawsuit alleging that they committed copyright infringement by accurately depicting tattoos inked by the plaintiff on WWE wrestler Randy Orton in their *WWE 2K* video game.
- ▶ *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC* (U.S. Supreme Court): Counsel for American Bar Association as *amicus curiae* concerning the meaning of the term "registration" in the Copyright Act.
- ▶ *de Beccdelievre v. Anastasia Musical, LLC* (S.D.N.Y.): Defended the Broadway musical *Anastasia* and Tony-winning playwright Terrence McNally in copyright lawsuit concerning a dissimilar play about the same historical subject matter.

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- ▶ *Take-Two Interactive Software, Inc. v. Pinkerton Consulting & Investigations Inc.* (S.D.N.Y.): Represented Take-Two and Rockstar Games, Inc. in a trademark case concerning whether their *Red Dead Redemption II* video game, set in the Wild West, was permitted by the First Amendment to make references to the historical Pinkerton detective agency and its agents' activities in the 1800s.
- ▶ *Psychic Readers Network, Inc. v. Take-Two Interactive Software, Inc.* (S.D. Fla.): Defended Take-Two in a copyright lawsuit asserting that *Grand Theft Auto: Vice City* video game infringed PRN's infomercials for psychic services.
- ▶ *Taymor v. 8 Legged Productions, LLC* (S.D.N.Y.): Defended the producer of the Broadway musical *Spider-Man: Turn Off the Dark* against copyright, breach of contract and other claims brought by the show's former director, Julie Taymor.
- ▶ *Car-Freshner Corp. v. DIRECTV, Inc.* (N.D.N.Y.): Defended DIRECTV in a trademark infringement suit arising out of its use of a pine tree-shaped air freshener in a promotional campaign for its satellite service.
- ▶ *Cengage Learning, Inc. Bankruptcy* (Bankr. E.D.N.Y.): Advised Cengage Learning on copyright issues related to its Chapter 11 bankruptcy.
- ▶ Advising Take-Two Interactive, and its brands Rockstar Games and 2K Games, on copyright, trademark, and right of publicity matters related to their world-famous video games.
- ▶ Representing well-known author J.K. Rowling in copyright and trademark matters relating to the popular *Harry Potter* book series and films, including protecting the famous works against infringement on the Internet.
- ▶ Represented Twentieth Century Fox Film and Twentieth Century Fox Television in various copyright and trademark matters, including enforcement matters concerning the popular television series *Modern Family*.
- ▶ Represented Fox News Network in copyright and trademark enforcement matters concerning unauthorized use of its content.
- ▶ Represented Big Think in a copyright enforcement matter concerning the unauthorized use of its content in an advertisement.
- ▶ Prosecuted trademark applications for Jamtown, LLC, the Bay Area's first premium basketball destination.
- ▶ Counseled the makers of the world-famous "Tetris" electronic game in copyright and trademark matters related to their puzzle game.
- ▶ Enforced photographer's copyright against political campaign that used a photograph in a political advertisement without authorization.
- ▶ Counseled American artist on the copyrightability of her sculptures.
- ▶ Advised American media services provider on copyright issues related to its services.
- ▶ Counseled International video game company on various copyright and trademark matters related to its world-famous games.
- ▶ Advised American mass media corporation on copyright issues related to media monitoring.
- ▶ Counseled American magazine on copyright dispute with product review website.
- ▶ Registered copyrights to articles of international daily newspaper.
- ▶ Advised American multinational telecommunications company regarding a dispute with a celebrity's performance of its influencer agreement.
- ▶ Represented American video game publisher in dispute involving the unauthorized rental of its video games.
- ▶ Advising international entertainment creator, producer, and distributor on copyright and right of publicity issues involving its prime time, serial drama, and factual entertainment brands.
- ▶ Counseling professional sports organization on copyright and trademark enforcement matters.
- ▶ Advised American video game publisher on potential acquisition of copyright and trademark portfolio of first-person action role-playing video game.
- ▶ Represented television production company in trademark enforcement matter.
- ▶ Advised film and television company in copyright and trademark enforcement matters.
- ▶ Counseled theatrical organization in its negotiation of a joint venture agreement.



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MEDIA AND ENTERTAINMENT

- ▶ Negotiated royalty-free trademark licensing agreement on behalf of nonprofit organization in order to resolve trademark infringement dispute.
- ▶ Counseled live entertainment company regarding musical production based on pre-existing motion picture.
- ▶ Advised multinational electronic game publisher on intellectual property issues related to the publication of a new comic book series.
- ▶ Counseled newspaper publisher on copyright and trademark matters.
- ▶ Advised mass media company in copyright matters relating to potential new products and competitors' infringing products.
- ▶ Counseled cloud-based publication platform on First Amendment issues.
- ▶ Advised producers of theatrical production on copyright licensing matters.
- ▶ Counseled theatrical producers on contract and copyright licensing matters.
- ▶ Counseled rock band on re-negotiation of music contract.



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OTHER INDUSTRIES

- ▶ Prosecuted trademark applications for 50 Bowery Holdings LLC, including its 50 BOWERY service mark for its boutique, Manhattan hotel.
- ▶ Counseling charity focused on the wellness of young people.
- ▶ Advising fitness training studio on copyright and trademark enforcement matters.
- ▶ Advised educational non-profit on copyright and trademark protection for its materials and services.
- ▶ Represented non-profit in negotiation of copyright enforcement claim by a photographer.
- ▶ Counseled private equity firm on trademark issues related to its acquisition of a snack company.
- ▶ Advised investment firm on copyright issues related to one of its restaurants.
- ▶ Counseled non-profit organization on its trademark portfolio and potential infringement thereof.
- ▶ Advised private K–8 school in copyright and trademark dispute involving the transfer of the school’s domain name and website from a former board member.