COPYRIGHT, TRADEMARK, INTERNET AND ADVERTISING
LITIGATION AND COUNSELING

With decades of experience, the lawyers of Kirkland & Ellis’ Copyright, Trademark, Internet and Advertising (CTIA) Practice Group have handled some of the highest profile matters in these areas of the law with extraordinary results. Our experience spans a wide range of industries, including computer software and other technology, consumer products, entertainment and media, fashion, financial services and pharmaceuticals.

Our lawyers represent 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. Kirkland’s CTIA lawyers 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, we 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 the advertising area, including successfully representing clients before the National Advertising Division of the Council of Better Business Bureaus (NAD).

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.
FOX NEWS NETWORK LLC: In 2018, Kirkland achieved a major victory in its highly publicized representation of Fox News Network, LLC in a copyright infringement lawsuit against TVEyes, Inc., a media monitoring company that provides Fox News’ proprietary 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 the case 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 with Fox that TVEyes’ use of Fox’s audiovisual content was not fair use, and directed the district court to issue an injunction prohibiting TVEyes from offering Fox News’ audiovisual content in any form.

ORACLE AMERICA: Kirkland was co-counsel to Oracle America in its appeal of Oracle America Inc. v. Google Inc. The case involved Google’s copying of source code and computer program 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, and the U.S. Supreme Court denied certiorari after the U.S. Solicitor General filed a brief agreeing with Oracle that the petition should be denied on the case’s merits, sending the case back to the district court.

Kirkland was again co-counsel to Oracle in its appeal to the Federal Circuit from the remand trial at the district court, in which the jury returned a verdict of fair use and the district court denied Oracle’s post-trial motions. The Federal Circuit agreed with Oracle that Google’s copying was not a fair use, finding in favor of Oracle on the two most important fair use factors — the purpose and character of the use, and the effect of the taking on the market for the original. The second appeal garnered significant media attention and resulted in an enormous number of amicus briefs being filed.

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, Inc. 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.

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.

**TAKE-TWO INTERACTIVE SOFTWARE:** Kirkland represents both of Take-Two’s video game brands, Rockstar and 2K, in various matters. Kirkland represents Take-Two in a lawsuit against the creator of a computer program that allows 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 for Take-Two.

Kirkland also is representing Take-Two in a lawsuit brought by Solid Oak Sketches, LLC in the U.S. District Court for the Southern District of New York. Solid Oak has accused Take-Two of infringing copyrights in tattoos inked on NBA players rendered in Take-Two’s *NBA 2K* video game series. In August 2016, the court granted Take-Two’s motion to dismiss Solid Oak’s statutory damages and attorney’s fees claims, holding that Solid Oak’s registration of the tattoos-in-issue was untimely. Take-Two then counterclaimed seeking declaratory judgments of *de minimis* and fair use, as well as fraud on the Copyright Office. Solid Oak moved to dismiss, but the court denied the motion holding that Take-Two’s counterclaims served a useful purpose in the litigation. Kirkland is now representing Take-Two in two additional cases involving the depiction of tattoos in *NBA 2K* and *WWE 2K*.

In addition, Kirkland is representing Take-Two in a lawsuit brought by Psychic Readers Network, which alleges that Take-Two’s *Grand Theft Auto: Vice City* video game contains a character that infringes the copyrights associated with certain infomercials, books, and a set of tarot cards associated with Miss Cleo.

**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.

**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.”

**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.

**THE TETRIS COMPANY:** Kirkland represents 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.

**FOX ENTERTAINMENT:** Kirkland represented Fox Entertainment Group, Inc., and other defendants in a lawsuit brought by an individual alleging that Fox’s “Modern Family” television series infringed the copyright in his treatment and proposed pilot script, as well as other state law rights. On behalf of all defendants, Kirkland successfully moved to dismiss the suit. The district court and the U.S. Court of Appeals for the Second Circuit on appeal determined that “Modern Family” and the proposed pilot were not substantially similar, and also rejected the plaintiff’s idea misappropriation and defamation claims.

**IBM:** Kirkland achieved a victory for IBM in a two-year battle with Teraproc Inc., a competing software developer founded by former IBM employees. The copyright, trade secret, tortious interference and breach of fiduciary duty litigation arose as a result of Teraproc’s creation and distribution of a software product called OpenLava, which incorporated proprietary IBM source code into a stripped down and open sourced program. Putting an end to the case, 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, including the former IBM employees, 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.

Kirkland also obtained dismissal for IBM’s CEO in a copyright and unfair competition action alleging infringement of a book describing a brain-inspired microchip.

**A.M. BEST:** Kirkland represented A.M. Best Co. in a copyright infringement and breach of contract action against SNL Financial LLC concerning SNL’s copying and distribution of A.M. Best’s financial strength ratings and other copyrighted materials as part of its online database product. The case, which involved cutting-edge issues of copyrightability and fair use, settled favorably while the parties’ cross-motions for summary judgment were pending.

**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.

TWENTIETH CENTURY FOX FILM: 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.

ANASTASIA MUSICAL: Kirkland represents Terrence McNally and the producers of the Broadway musical “Anastasia” in a lawsuit brought by Jean-Etienne de Becdelievre, who claims to be the heir of Marcelle Maurette who was the author of a straight play also called “Anastasia.”

ANN INC.: Kirkland provides strategic copyright and trademark clearance advice to ANN INC. related to its Ann Taylor businesses.

ANDREESEN HOROWITZ: Kirkland represented venture capital firm Andreessen Horowitz in copyright litigation filed by the founders of Skype, who alleged copyright infringement by Skype and vicarious and contributory infringement by eBay and investors in Skype’s soon-to-be owner. The litigation was part of a complex series of cases surrounding the sale of a majority interest in Skype by eBay. It ultimately was resolved through a series of agreements that, among other things, gave Skype the intellectual property rights in the underlying technology that it needed to continue and develop its services. The transaction that the lawsuit sought to enjoin was valued at more than $2 billion.

COPYRIGHT RATE-SETTING: 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.

DON JOHNSON: Following a two-week trial, a jury in Los Angeles Superior Court ruled in favor of Kirkland client, actor and producer Don Johnson, in a case related to his copyright ownership and associated profits from the television series “Nash Bridges.” The jury verdict required Rysher Entertainment LLC to pay Don Johnson Productions (DJP) $23.2 million in damages and half of future profits, as well as to recognize Mr. Johnson as co-owner of “Nash Bridges.” In addition to the jury’s verdict, the judge ordered Rysher Entertainment to pay approximately $28.5 million in pre-judgment interest to DJP. The decision resulted in a total judgment of more than $51 million, in addition to more than $75,000 in costs.
F. Schumacher: Kirkland represents well-known textile design company F. Schumacher & Co. in connection with its intellectual property portfolio and the worldwide policing of its IP rights. For example, Kirkland defended Schumacher and its partner, Mary McDonald, Inc., in a lawsuit brought in the U.S. District Court for the District of Massachusetts by popham design, SARL for copyright infringement claims in connection with one of Schumacher’s textile designs.

Sound Recordings: Kirkland has extensive experience advising companies with regard to sound recordings, both under the federal Copyright Act and in connection with claims that pre-1972 recordings are protected by state law. For example, Kirkland is defending a client in federal class action litigations asserting that various defendants reproduced and distributed the plaintiff’s music in violation of their rights under state law. Kirkland also is defending a client in a class action alleging that it failed to pay royalties owed for the use of the plaintiffs’ music.
**CONVERSE:** Kirkland is representing 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 toe cap and midsole design, from entering the United States. After a trial, the Administrative Law Judge 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. An appeal to the U.S. Court of Appeals for the Federal Circuit is pending.

**EQUINOX HOLDINGS:** Kirkland achieved a significant victory for Equinox Holdings, Inc. when it defeated a motion for preliminary injunction filed by Equinox Hotel Management Inc. Equinox Hotel Management filed a trademark infringement action seeking to enjoin Equinox Holdings from using the EQUINOX trademark in connection with its hotel line. The U.S. District Court for the Northern District of California denied the plaintiff’s motion for a preliminary injunction, and granted the defendant’s motion to dismiss the claims for false advertising and for unfair competition based on fraudulent business acts or practices.

**ALIGHT SOLUTIONS:** Kirkland represented Alight Solutions LLC (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.

**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.

**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 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.
**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.

**FGF BRANDS, INC.:** The U.S. District Court for the Central District of California granted summary judgment for FGF Brands, Inc. against Stonefire Grill, Inc., 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.

**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.

**LIFEPROOF/OTTERBOX HOLDINGS:** Kirkland achieved a total victory for TreeFrog Developments, Inc. d/b/a LifeProof (LifeProof) and its parent OtterBox Holdings in a trademark action against Seal Shield LLC, KlearKase LLC and several principals of those companies. That case was consolidated with an earlier-filed trademark infringement case brought by Seal Shield et al., claiming that it was the senior user of LifeProof’s federally-registered LIFEPROOF mark. Despite Seal Shield’s alleged prior use, Kirkland obtained a
preliminary injunction against Seal Shield, barring it from, inter alia, using the LIFEPROOF mark as a product identifier in connection with protective cases for smartphones or tablet devices. Kirkland successfully moved for summary judgment on behalf of LifeProof in both related cases, with the Court finding that LifeProof is the senior user and rightful owner of its LIFEPROOF mark and that Seal Shield infringed that mark by using the phrase “life proof” in connection with its protective cases and covers. After LifeProof’s summary judgment wins, Seal Shield stipulated to a permanent injunction. Seal Shield appealed to the U.S. Court of Appeals for the Ninth Circuit, which affirmed the district court decision in all respects.

CALVIN KLEIN, INC.: 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.

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 Inc. based on their use of “Total Care” for mouthwash products. Kirkland obtained favorable settlements in both cases.

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.

DROGA5: Kirkland defended Droga5, LLC 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, LLC’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.

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.
**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.

**LE TIGRE LLC:** Kirkland’s attorneys represented Le Tigre LLC 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.

**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.

**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.

**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.

**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, Inc. (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.

**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, both appealing the TTAB’s decision and challenging the other party’s marks. With the prospect of re-litigating the case from scratch, Kirkland was able to obtain a settlement that allowed SH Group’s 1 HOTEL marks to co-exist in the marketplace and on the trademark register.

**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.

**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.

**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, Inc. 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.
COMMERCIAL ADVERTISING LITIGATION
Kirkland’s advertising attorneys are skilled and effective courtroom advocates who protect our clients’ advertisements and brands. Whether it is stopping a competitor from making false and misleading advertising claims, fending off a challenge to an advertising campaign during a pivotal business season, or defending against agency actions, Kirkland attorneys have a strong track record of victories for major clients in advertising cases across the country — at the preliminary stage, at trial, and on appeal. Advertising issues often require expedited action immediately before or after the launch of a major advertising campaign. Our attorneys have experience and success both seeking and defending against preliminary injunctions and temporary restraining orders to meet our clients’ business needs at critical times.

NATIONAL ADVERTISING DIVISION OF THE COUNCIL OF BETTER BUSINESS BUREAUS
Our attorneys have extensive experience in defending and challenging claims in front of the National Advertising Division of the Council of Better Business Bureaus (NAD). Indeed, during the past several years, Kirkland lawyers have successfully handled multiple matters before the NAD, both “offensively” and “defensively.” Because of the breadth of our knowledge in this forum, NAD frequently asks Kirkland lawyers to speak at NAD workshops and conferences to share their experiences and recommendations with attendees.

CONSUMER CLASS ACTION LITIGATION
Kirkland represents numerous clients in pending (and threatened) consumer class action litigation, which the plaintiff’s class action bar are bringing in increasing numbers. Drawing on Kirkland’s strengths in the areas of class action litigation and advertising law, our attorneys are able to quickly analyze the often complicated factual and legal background surrounding these cases, and work with clients to develop winning strategies. In several instances, early development of a strong legal and factual case has allowed Kirkland to convince plaintiff’s counsel not to file a class action at all. Where the cases do go forward, early case development allows Kirkland to obtain favorable outcomes at the motion to dismiss and class certification stages of the case.
**DYSON:** Kirkland represented Dyson, Inc., 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.

**VERIZON COMMUNICATIONS INC.:** Kirkland achieved a pair of major courtroom wins for Verizon Communications Inc. 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 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.”

**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.


LIFELOCK, INC.: Kirkland has represented LifeLock, Inc., 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.

E. & J. GALLO WINERY: Kirkland’s attorneys represented E. & J. Gallo Winery in an action brought by Heublein, Inc., 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.

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.
**INTERNET-RELATED**

**SOCIAL MEDIA:** Kirkland advises 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).

**DMCA:** Kirkland represents numerous clients in connection with Digital Millennium Copyright Act issues, including safe harbors, website terms and conditions, and enforcement matters.

**HARRY POTTER:** Kirkland polices the Harry Potter properties worldwide on behalf of J.K. Rowling and Warner Bros., including protecting the famous works against infringement on the Internet by e-books and myriad other unauthorized uses.

**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.

**METAVANTE CORPORATION:** Kirkland achieved a major victory on behalf of Metavante Corporation, a leading technology service provider that helped Emigrant Savings Bank launch one of the most successful Internet direct banks ever. Metavante filed suit alleging that Emigrant breached the parties’ technology outsourcing agreement, but Emigrant counterclaimed for a quarter billion dollars in alleged damages. After a two-week bench trial, Kirkland — retained after three years of litigation and only weeks before the close of discovery — obtained judgment on each and every claim and counterclaim, an affirmative $15 million judgment, and the defeat of Emigrant’s request for more than $250 million in damages, plus unspecified punitive damages. The district court also awarded Metavante more than $10 million in fees and costs under the parties’ fee-shifting agreement. On appeal, the U.S. Court of Appeals for the Seventh Circuit affirmed both the merits and fees judgments in all respects and remanded the case so that Metavante could collect its fees and costs, including post-judgment and appellate fees and costs. The U.S. Supreme Court denied Emigrant’s petition for certiorari.

**NES RENTALS:** Kirkland has obtained multiple transfer orders in domain name disputes under ICANN’s Uniform Domain Name Dispute Resolution Policy.

**TWENTIETH CENTURY FOX FILM:** Kirkland represented Twentieth Century Fox Film Corporation (Fox) in a trademark infringement suit against a non-affiliated entity, 20th Century Fox Universal Pictures Investment Group Inc., and its executives. Fox alleged that the defendants adopted a fraudulent trade name to defraud potential investors into believing defendants are affiliated with Fox, and set up two infringing websites, one in Chinese and one in English, that make use of the famous 20th Century Fox logo. Kirkland ultimately obtained a default judgment in favor of Fox.
STRENGTH, 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, high-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.”

- **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 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.

- **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.” World Trademark Review (WTR) magazine has recognized Claudia 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.”

- **Diana Torres** was recognized for excellence in trademark litigation in the 2010–2018 editions of The Legal 500 United States, remarking that she is “an extremely business savvy lawyer” and “the crème de la crème.”

- **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
Substantial Court Experience
Kirkland’s lawyers have a wealth of experience in handling high-profile matters at the cutting edge of copyright, trademark and Internet law, and were centrally involved in precedent-setting U.S. Supreme Court cases such as *Moseley v. Victoria’s Secret Catalogue* (trademark dilution) and *Dastar v. Twentieth Century Fox* (trademark infringement), 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 high-profile district court victories such as *Warner Bros. and Rowling v. RDR Books* (copyright/fair use) and *Shephard 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 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.

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** was recognized in *The Legal 500 United States* for trademark litigation in the 2013 and 2018 editions, for copyright work in the 2015–2018 editions, and for media and entertainment in the 2017–2018 editions.

- **Joshua Simmons** was named a “Next Generation Lawyer” and recognized for his copyright, trademark litigation, trade secrets, and media and entertainment practices by *The Legal 500 United States*. In addition, *Law360* recognized him as a “Top Attorney” and media and entertainment “Rising Star.”

KEY FACTS

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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

CONTACTS

CHICAGO
Ross M. Weisman, P.C., +1 312 862 2120, ross.weisman@kirkland.com

LOS ANGELES AND PALO ALTO
Diana Torres, +1 213 680 8338, +1 650 859 7088, diana.torres@kirkland.com

NEW YORK
Dale Cendali, P.C., +1 212 446 4846, dale.cendali@kirkland.com
Claudia Ray, +1 212 446 4948, claudia.ray@kirkland.com

WASHINGTON, D.C.
Gregg F. LoCascio, P.C., +1 202 879 5290, gregg.locascio@kirkland.com
ABOUT KIRKLAND & ELLIS

Kirkland & Ellis has a 100-year history of providing exceptional service to clients around the world in complex intellectual property, litigation, corporate and tax, restructuring and counseling matters. Our Firm seeks long-term partnering relationships with clients to provide the best total solution to their legal and business needs. Kirkland’s principal goals are to provide the highest quality legal services available anywhere, to be an instrumental part of each client’s success, and to recruit, retain and advance the brightest legal talent. Over the past decade, directors and general counsel have consistently ranked Kirkland as one of the top firms nationally in the Corporate Board Member survey, “America’s Best Corporate Law Firms.”

Kirkland’s Intellectual Property Law Practice Group is one of the oldest such practices in a full-service firm in the country, having been an integral part of Kirkland since 1925. Located in the Firm’s Chicago, London, Los Angeles, New York, Palo Alto, San Francisco and Washington, D.C. offices, Kirkland has nearly 250 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 70 percent of the lawyers are engineers and scientists trained with degrees and professional backgrounds in technical areas.