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James C. Potepan is a partner in RMKB's Intellectual Property Litigation Practice. He heads an intellectual property litigation team based in the firm's Los Angeles office that includes six attorneys.

Mr. Potepan's practice focuses on complex business litigation with a major emphasis on intellectual property matters involving copyright, trademark, trade secret, right of publicity, franchise law, licensing and unfair competition issues. He represents clients in a broad range of industries including consumer products, fashion, publishing, entertainment, education, and high technology. With more than twenty years of experience litigating complex intellectual property matters, Mr. Potepan has resolved more than 200 intellectual property disputes.

Some of Mr. Potepan's significant appellate matters include: *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387 (2001), and *Bagdadi v. Nazar*, 84 F. 3d 1194 (9th Cir. 1996).

Mr. Potepan been listed for several years in *Los Angeles Super Lawyer Magazine*.

Mr. Potepan earned his J.D. from Loyola Law School.

Some representative matters recently handled by Mr. Potepan include:

Mr. Potepan represented an LSAT test preparation company as trial counsel in a three month jury trial in state court. The dispute involved claims of trade secret misappropriation, breach of the duty of loyalty, and unfair competition. The plaintiff alleged that the clients, who were former employees, improperly used confidential information when starting a competing test-prep company. The plaintiff contended that the course materials used by the start-up was based on knowledge gained by the clients during their employment. Plaintiff requested \$18 million in damages. The jury awarded less than 2% of the requested amount. Significantly, the court denied the plaintiff's request for a permanent injunction allowing the clients to continue use of the course materials. The matter is currently on appeal.

Mr. Potepan represented an internationally known fashion designer and his companies in an action in federal court in Los Angeles in which an artist claimed that more than 50% of the garments sold by the designer infringed his copyrighted designs. Significant issues in the case included whether an oral license agreement permitted the designer to sublicense the subject works and whether the failure to prominently display the artist's logo on each garment sold by the designer constituted an infringement of copyright or merely a breach of contract. The artist demanded several million dollars to resolve the case. Shortly before trial, the case settled on terms favorable to the client designer.

Mr. Potepan represented a noted furniture designer in an action for trade secret misappropriation and trademark/trade dress infringement in a California state court. The client went into partnership with another designer in order to market furniture. After the parties had a falling-out, the client's partner left the partnership and sued the client over issues related to the furniture designs. After numerous efforts were made to resolve the case, the firm brought a motion for summary judgment on behalf of the client. In granting the motion, the court found no evidence of trade secret misappropriation. The court dismissed the remainder of the case on the first day of trial.

Practice Areas

- Business And Commercial Litigation
- Insurance Services
- Intellectual Property
- Copyright, Domain Name and Trademark Litigation
- Copyright, Trade Dress and Trademark Registration
- Patent Prosecution, Licensing and Litigation
- Unfair Competition

Education

- University of California, Riverside, 1972 B.A.
- University of California, Los Angeles, 1974 M.A.
- Loyola Law School Los Angeles, 1982 J.D.

Court Admissions

- California
- US Court of Appeals for the Ninth Circuit
- USDC: Central District of California
- USDC: Eastern District of California
- USDC: Northern District of California
- USDC: Southern District of California

Representative Experience

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Infringement

Venue: Federal Court

An infringement case involving use of name "Mashti" for sugar products.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property, Trade Secret Protection and Litigation

Key Issues: Trade Secret; Copyright Infringement

Venue: Federal Court

This was a trade secret, copyright infringement matter in which we acted as monitoring counsel.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Copyright Infringement; Trademark Infringement

Venue: Federal Court

A copyright and trademark infringement action alleging defendants distribution of counterfeit software.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Copyright Infringement; Trademark Infringement

Venue: Federal Court

A federal court copyright and trademark infringement action. Represented a manufacturer of jeans alleging improper use by a rock-n-roll band of a cartoon character.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Copyright Infringement; Trademark Infringement

Venue: Federal Court

A trademark infringement/counterfeiting action alleging defendant knowingly sold counterfeited printer ribbon.

Practice Area: Intellectual Property, Trade Secret Protection and Litigation

Key Issues: Trade Secret

Trade secret dispute involving rights to customer list in gaming industry.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Trademark Infringement

Venue: Federal Court

A trademark infringement action by the heirs of a famous painter and sculptor alleging infringing use by defendant as to artist's signature and images on its jackets and other products.

Practice Area: Copyright, Trade Dress and Trademark Registration, Intellectual Property

Key Issues: Trade Dress

Venue: Federal Court

A federal court trade dress infringement action alleging the defendant copied plaintiff's store design.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Copyright Infringement

Venue: Federal Court

A copyright infringement action against defendants who compiled a library of sounds using plaintiff's computer chip. The underlying case was the basis for important coverage determination in *Midiman v. Farmers Insurance Exchange* (1999) 76 Cal.App.4th 102.

Practice Area: Copyright, Domain Name and Trademark Litigation, Copyright, Trademark Registration and Protection, Entertainment, Intellectual Property

Key Issues: Copyright Infringement

Venue: Federal Court

Federal court copyright infringement action by a television production company alleging that defendants imported toys violating their copyright.

Practice Area: Business And Commercial Litigation, Intellectual Property

Key Issues: Breach of Contract

Client Type: Defendant Water Filtration Product Manufacturer

Defense of breach of contract and prosecution of anticipated patent infringement cross-complaint related to portable water filtration product.

Practice Area: Copyright, Trade Dress and Trademark Registration, Intellectual Property

Key Issues: Trade Dress; Trademark Infringement

Venue: Federal Court

A federal court trademark and trade dress infringement action alleging defendant's style of purse violated a leading fashion brand's trademark in its handbag design.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Copyright Infringement

Venue: Federal Court

A federal court copyright infringement case involving disputed rights to use of religious artworks.

Practice Area: Intellectual Property, Unfair Competition

Key Issues: Unfair Competition

Venue: State Court

An unfair competition matter involving the copying of advertising and brochures.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Trademark Infringement

Venue: Federal Court

A federal court trademark infringement case filed in Los Angeles objecting to the use of the name of a chain of popular California pizza franchises by holdover franchisee.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Trademark Infringement

Venue: Federal Court

A trademark infringement matter filed in Los Angeles involving the use of the name of a premium jasmine rice for rice products.

Practice Area: Copyright, Domain Name and Trademark Litigation, Copyright, Trade Dress and Trademark Registration, Copyright, Trademark Registration and Protection, Entertainment, Intellectual Property

Key Issues: Trademark Infringement

Venue: Federal Court

Federal court trademark infringement case involving the usage of an American production company's cartoon character in connection with the sale of hair products.

Practice Area: Intellectual Property, Trade Secret Protection and Litigation

Key Issues: Trade Secret

Venue: State Court

State court trade secret dispute involving alleged use of customer list.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Copyright Infringement

Venue: Federal Court

This was a federal court copyright infringement matter involving the copying and distribution of Chinese language videos.

Practice Area: Intellectual Property, Unfair Competition

Key Issues: Unfair Competition; Freedom of Expression

Venue: State Court

A state court unfair competition, trade disparagement and freedom of expression action involving competitors in architectural lighting industry.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Infringement; Trade Dress

Venue: Federal Court

A federal court infringement action alleging violation of trade dress and the design of after market auto accessories such as spoilers and fender skirts.

Practice Area: Intellectual Property, Unfair Competition

Key Issues: Unfair Competition

An unfair competition case involving use of website content and source codes.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Infringement

Venue: Federal Court

An infringement case involving use of the name of a premium line of rare teas and trade dress connected to the packaging of tea.

Practice Area: Intellectual Property

Key Issues: Unfair Competition

Venue: State Court

A state court unfair competition action involving competing gaming businesses' sales of children's game.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property, International, International Trademark

Key Issues: Trademark Infringement

This was a federal court trademark infringement case brought by British airliner against an oil distributor.

Practice Area: Intellectual Property, Patent Prosecution, Licensing and Litigation

Key Issues: Patent

Defense of declaratory relief action in federal court seeking determination of non-infringement related to portable water filtration product and engaged by client to bring patent infringement action.

Practice Area: Intellectual Property, Unfair Competition

Key Issues: LSAT; Copyright

Venue: Los Angeles County Superior Court

Client Type: Test Preparation Company

This was a copyright and defamation action between two test preparation companies providing instructional services for the Law School Admissions Test ("LSAT"). The plaintiff accused the defendants, former employees who started a competing company, of copying its course materials and defaming the defendant on internet discussion boards using pseudonyms to disguise their identities. Summary judgment was granted in favor of defendants on plaintiff's unfair competition claim that defendants helped students cheat on the LSAT. The plaintiff expended more than \$8 Million in fees and costs to litigate the case

Result:

The plaintiff demanded \$5 Million and a permanent injunction that would force the defendants out of business. The plaintiff rejected a settlement offer and after a 25 day trial, the jury denied the plaintiff's request for \$18.5 Million and instead awarded \$256,000. The plaintiff's claims for trade libel, intentional interference with prospective economic advantage were dismissed on non-suit and directed verdict. The court denied the plaintiff's request for a permanent injunction and stated that the course materials separately developed by defendants added significant originality to the to the test prep industry. Media Coverage: Two articles about the trial were published in IP Law 360. Appeal: A number of pre-trial issues are on appeal.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: trademark infringement

Venue: Court of Appeals for the Ninth Circuit

The court's opinion on lack of trademark protection for domain names. We performed coverage analysis in underlying case.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Copyright Infringement

Venue: USDC: Central District of California

This was a copyright infringement case involving ownership of designs for garden accessories.

Practice Area: Intellectual Property, Patent Prosecution, Licensing and Litigation

Key Issues: Patent

Venue: USDC: Central District of California

A federal patent case involving the validity of the insured's patent for a bed leg as well as trade disparagement.

Practice Area: Entertainment, Unfair Competition/Business Practices

Key Issues: Right of Publicity

Venue: USDC: Central District of California

Right of publicity case involving rights to use of the image of John Wayne.

Practice Area: Appellate, Entertainment

Key Issues: First Amendment

Venue: California Supreme Court

Client Type: Artist, T-shirt Manufacturer

In this right to publicity case involving the likeness and image of "The Three Stooges" the defendant artist created silkscreen lithographs of the former comedy team and used them to make silk-screened T-shirts. The plaintiff that owned the right of publicity for the former comedy act sued. The court of appeal held that the lithographs and T-shirts were not entitled to protection under the First Amendment of the U.S. Constitution since they were reproductions rather than works of art.

Result:

The Supreme Court held that the reproductions were equally entitled to protection under the First Amendment. The Supreme Courts also formulated a balancing test between the First Amendment and the right of publicity based on whether the work included sufficient creative elements so as to transform the work into something more than a mere celebrity likeness or image.

Practice Area: Appellate, Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Copyright Infringement

Venue: US Court of Appeals for the Ninth Circuit

Client Type: Defendant

In this copyright infringement case involving Spanish language instructional videos, defendants filed a motion for summary judgment claiming to be innocent infringers. The motion was granted by the district court and the plaintiff appealed.

Result:

The Ninth Circuit affirmed holding that the facts amounted to the type of situation for which the innocent infringer defense was created. The defendants had relied upon an unambiguous copyright notice and the plaintiff failed to raise any questions of fact as to whether the reliance was reasonable.

Practice Area: Intellectual Property, Patent Prosecution, Licensing and Litigation

Key Issues: Unfair Competition; Patent Invalidity

Venue: USDC: Central District of California

Client Type: Defendant; Appliance Recycling Center

The plaintiff, the nation's only publicly traded appliance recycling company, sued defendant an upstart competitor for unfair competition and patent invalidity. The defendant's patent was for the incineration of CFC-11 found in polyurethane foam in refrigeration appliances. Plaintiff claimed the patent was obvious art, invalid and that the defendant's publicizing of the patent in responses to bids from utility companies comprised unfair competition in misleading the public. Defendants had secured several large recycling projects from Southern California Edison, Sacramento Municipal Utilities District and Pacific Gas and Electric which otherwise would have gone to plaintiff. Plaintiff sought damages of \$3-5 million (its estimated profit from the recycling contracts over three years).

Result:

After the initial trial date, a 9th Circuit Court of Appeal opinion issued adopting a 5th Circuit Court of Appeal decision requiring that the publication of the patent be made "in bad faith." A previously filed motion for summary judgment urged the trial court to adopt the standard, but the court refused and denied the motion. A renewed motion for summary judgment was filed after the 9th Circuit opinion and the court granted summary judgment for the defendant and ordered plaintiff to pay defendant's costs of suit.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Copyright infringement; apparel design; fabric patterns

Venue: USDC: Central District of California

Client Type: Fabric Vendor

The issue was whether fabric used to make children's dresses used a design protected by a copyright and damages. Whether the infringement was innocent, ordinary or willful. Client imported fabric in solid colors. An independent contractor/ fabric salesman noticed a paisley pattern print and shipped it to several dressmakers. One dressmaker used it to create children's dresses and sold them to national retailers.

Result:

Three weeks before trial \$200,000 was offered to settle the client's case. It was rejected. Plaintiff demanded \$400,000. Two days after the jury was picked, \$50,000 was offered to settle. It was rejected. Jury returned a verdict finding the client responsible for \$32,000 in damages.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Trademark Infringement

Venue: State Court

A trademark infringement and partnership dispute involving the use of designs on fashion jackets.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Infringement

Venue: Federal Court

A federal court infringement action alleging violation of design mark on bottles containing medicinal oils alleged to be confusingly similar to plaintiff's registered marks.

Practice Area: Copyright, Domain Name and Trademark Litigation, Copyright, Trademark Registration and Protection, Entertainment, Intellectual Property

Key Issues: 9th Circuit Court of Appeals

Venue: Federal Court

A trademark infringement action alleging use of the phrase "The Three Stooges" on the website infringed upon plaintiff's trademark.

Practice Area: Copyright, Domain Name and Trademark Litigation, Copyright, Trade Dress and Trademark Registration, Intellectual Property

Key Issues: Trademark Infringement

Venue: Federal Court

This was a trademark infringement case filed in New York concerning defendants alleged copying of design of "Lady Diana" handbag.

Practice Area: Business And Commercial Litigation, Unfair Competition

Key Issues: Constitutional Freedom; Harassment

Venue: State Court

A state court lawsuit involving constitutional freedom of expression as a defense to a city tenant harassment ordinance.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Trademark Infringement; Trade Dress

Venue: Federal Court

Client Type: Defendant Golf Club Distributor

This was a trademark, trade dress and copyright infringement case alleging infringement as to the sale of premium quality golf clubs including irons and drivers.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Trademark Infringement; Copyright Infringement

Venue: Federal Court

A federal court trademark and copyright infringement suit involving the usage of brewer's trademarks on Hispanic images and garments.

Practice Area: Business And Commercial Litigation

Key Issues: Federal Visual Artists Rights Act

Venue: Federal Court

A case involving artist's claim of unfair competition and damages under Federal Visual Artists Rights Act.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Trademark Infringement

Venue: Federal Court

This was a trademark infringement action involving the alleged improper use of the image of a dragon in connection with the sale of beer.

Practice Area: Intellectual Property, Patent Prosecution, Licensing and Litigation

Key Issues: Patent Infringement

Venue: Federal Court

A federal court patent infringement case involving sales of alleged infringing vehicle security systems.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Trade Dress

Venue: Federal Court

A trade dress infringement action alleging defendant infringed in connection with its advertising of horse health products.

Practice Area: Intellectual Property, Trade Secret Protection and Litigation

Key Issues: Trade Secret

Venue: State Court

This was a trade secret violation case involving a former employee's alleged theft of trade secrets, customer lists, supplier lists and production strategy information.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property, Patent Prosecution, Licensing and Litigation

Key Issues: Patent; Trademark

A U.S. patent and trademark cancellation proceeding involving use and advertising of name "Frisco" by three parties.

Practice Area: Intellectual Property, Trade Secret Protection and Litigation

Key Issues: Trade Secret

Venue: State Court

A state court trade secret action involving customer lists, pricing, product source by former employee and allegations of corporate espionage.

Practice Area: Business And Commercial Litigation, Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Trademark Infringement

Venue: State Court

A trademark infringement action involving the use of similar names for competing businesses in home warranty industry.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Trademark Infringement

Venue: State Court

A trademark infringement suit involving rights to use of restaurant name.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Legal Malpractice; Copyright

State legal malpractice matter involving the handling of a copyright issues in the underlying litigation.

Practice Area: Copyright, Trade Dress and Trademark Registration, Intellectual Property

Key Issues: Infringement; Breach of License Agreement

Venue: State Court

A state court action involving breach of license agreement and alleged infringing use of a top family entertainment enterprise's characters on fashion jackets.

Practice Area: Intellectual Property

Key Issues: Deceptive Advertising

Venue: State Court

An unfair competition case involving allegations of deceptive advertising and allegations of theft of trade secrets in computer inkjet business.

Practice Area: Intellectual Property, Trade Secret Protection and Litigation

Key Issues: Trade Secret

Venue: State Court

A state court trade secret action involving alleged use of a customer list by a previous employee at plaintiff's insurance agency.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Trademark Infringement

Venue: Federal Court

A federal court trademark infringement case alleging trademark infringement as to mail solicitations for crematory services and violation of concurrent use agreement.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Trademark Infringement

A trademark infringement case involving usage of trade dress in the manufacturing of bicycles.

Practice Area: Intellectual Property, Trade Secret Protection and Litigation

Key Issues: Unfair Competition

Venue: State Court

State court unfair competition case involving alleged use of customer list by former employee.

Practice Area: Copyright, Domain Name and Trademark Litigation, Intellectual Property

Key Issues: Copyright Infringement; Trademark Infringement

Venue: Federal Court

A federal court copyright and trademark infringement action alleging pirating of multinational computer technology corporation's software.

Publications

- Author, *Orthopedic Systems v. Schlein*, IP Case Alert - 12/29/2011
- Author, Does a Stock Photography Agency's Copyright Registration Extend to Each Photography Contained in Its Database?, *New Matter Winter 2011 Volume 36, Number 4*, December 1, 2011

Speaking Engagements

- Insurance & Casualty Litigation 2011 - 2012: The Year in Review, May 23, 2012
- Insurance & Casualty Litigation 2011 - 2012: The Year in Review, May 22, 2012