



Thomas M. O'Leary
515 South Flower Street, Suite 1100
Los Angeles, CA 90071
Direct: (213) 312-2018
Office: (213) 312-2000
Fax: (213) 312-2001
Email: toleary@rmkb.com
Web: www.rmkb.com

Thomas M. O'Leary is a partner in the Los Angeles office. His practice focuses on the defense of intellectual property litigation involving trademarks, copyrights, trade name and patent infringement actions. Additional casework involves misappropriation of likeness litigation and trade secret violation actions. Other representative cases include actions involving right to perform under former rock band name; model's claim for misuse of likeness; corporate espionage/trade secret violations; and copyright infringement under the Digital Millennium Copyright Act. Mr. O'Leary has tried fifteen cases to verdict.

Mr. O'Leary obtained his law degree from the University of San Diego School of Law in 1986 after attending the Trinity College Institute of International and Comparative Law in Dublin, Ireland in 1984. He obtained his master's degree from San Diego State University in 1983 and his bachelor's degree from the University of La Verne in 1980. Mr. O'Leary was elected Mayor of the City of Covina twice during his ten year tenure on the City Council.

Practice Areas

- Business And Commercial Litigation
- Catastrophic/Personal Injury
- Intellectual Property

Education

- University of La Verne, 1980 B.A.
- San Diego State University, 1983 M.A.
- University of San Diego School of Law, 1986 J.D.

Court Admissions

- California
- USDC: Central District of California
- USDC: Eastern District of California
- USDC: Northern District of California
- USDC: Southern District of California

Memberships & Associations

- Irish-American Bar Association

Representative Experience

Practice Area: Intellectual Property

Key Issues: Misappropriation of trade secrets; customer list

Venue: Los Angeles County Superior Court

Client Type: Defendant, Demo Reel Creators for Actors

Clients were former employees of plaintiff who formed own company to make demo reels for actors. Former employer sued for misappropriation of trade secrets in client list, archived media (demo reels) and accounting software.

Result:

Non suit of 7 of 9 claims by court following presentation of plaintiff's case. This included two of three misappropriation claims. Jury returned a verdict of misappropriation of customer list and awarded \$250,000. Plaintiff asked jury to award \$500,000.

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

Key Issues: Patent

Venue: USDC: Central District of California

Client Type: Plaintiff

In patent litigation involving a utility patent issued to the manufacturer of bed legs, we filed a motion for summary judgment which is currently pending in the United States District Court, Central District of California which proves that plaintiff's arguments regarding novelty, the on-sale bar and obviousness under section 103 are meritless.

Practice Area: Advertising Injury, Intellectual Property

Key Issues: Trademark Infringement; copyright infringement; misappropriation of likeness; cybersquatting

Venue: USDC: Central District of California

Client Type: Defendant, Restaurant

Client purchased pizza restaurant from plaintiff in San Francisco. Opened up another in Los Angeles, and then 10 years later opened another in Hollywood. Plaintiff claimed second Los Angeles restaurant a breach of oral license to use trademark. Also claimed use of domain name Village Pizzeria a cybersquatting violation, despite fact plaintiff's pizza restaurant never had nor intended to use a website.

Result:

Plaintiff demanded \$100,000 to settle; \$15,000 offered prior to trial. Verdict 6-0 that plaintiff infringed Village Pizzeria trademark and 6-0 that he did not commit cybersquatting. Jury returned \$0.00 in damages. Plaintiff obtained injunction only. Client awarded attorneys' fees for plaintiff's asserting a misappropriation of likeness claim (which was dismissed by judge by motion for non-suit following presentation of plaintiff's case).

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 defendants 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: Banking/Consumer Credit, Business And Commercial Litigation, International

Key Issues: Defamation, Non-Payment of Invoices, Recission of Loan

Venue: USDC: Central District of California

Client Type: Defendant Distributor

This case revolved on whether a letter written to a banking factor regarding the reasons for non-payment of outstanding invoices caused the loss of a \$100 million loan which was to be used for product development. Plaintiff was the manufacturer of flat screen televisions that the defendant purchased and marketed to big box retailers in North America. The televisions had a high return rate and a soldering problem caused mechanical difficulties. As a result, the defendant stopped paying on outstanding invoices. The invoices were "factored" meaning a bank lent money to plaintiff based upon the purchase orders. The bank made an inquiry to defendant about the lack of payments and defendant responded in writing why payments ceased. The bank withdrew from a syndicated loan to plaintiff for \$100 million; plaintiff claimed it was because of the content of the letter. Plaintiff asked for \$3 million in damages for the defamation.

Result:

Plaintiff demanded \$3 million. Plaintiff was awarded \$375,000 in damages for defamation per se. The intentional

interference with prospective economic advantage claim was rejected.

Practice Area: Advertising Injury, Insurance Services

Key Issues: Internet Defamation

Venue: Los Angeles County Superior Court

Client Type: Defendant; New Employer, Iron Door Manufacturer

Client hired former employee of plaintiff to manage Pasadena showroom. Employee had tumultuous relationship with former employer, who had called former employee's developmentally disabled son a "pumpkin headed retard." Employee, while at work, wrote disparaging comments about former employer on website "pissedconsumer.com." Former employer sued for defamation and trade libel. Co-defendant was franchisor of iron door manufacturer who sued client for defense and indemnity pursuant to franchise agreement.

Result:

Settled on day of trial for \$1,500. This was 10 days after settlement demand for \$140,000. Franchisor co-defendant settled indemnity and defense claim for waiver of costs.

Practice Area: Advertising Injury, Insurance Services, Intellectual Property, International Trademark

Key Issues: Misappropriation of Likeness

Venue: USDC: Central District of California

Client Type: Real Estate Broker

Client, real estate broker retained an independent contractor as a business broker. Previously, the business broker owned a franchise of plaintiff, but was forced to file bankruptcy due to economic conditions in 2009. Plaintiff sued broker and client for copyright infringement, trademark infringement and unfair business practices.

Result:

Settled day before trial for \$32,500. Demand three days before settlement was \$1 million.

Practice Area: Advertising Injury, Insurance Services, Intellectual Property

Key Issues: Photograph Copyright Infringement; Internet Copyright Infringement

Venue: USDC: Central District of California, Southern Division

Client Type: Restaurant/ Nighclub

Client operated trendy nightclub/restaurant and hired plaintiff to photograph menu entrees for use in local magazine advertising. Photographer sued alleging violation of license to use photographs for limited purpose.

Result:

Settled \$21,500 early in litigation.

Practice Area: Advertising Injury, Insurance Services, Intellectual Property

Key Issues: Misappropriation of Likeness

Venue: Los Angeles County Superior Court

Client Type: Nightclub/ Dance Promoter

Plaintiff was a Playboy Magazine Swimsuit Model of the Year and a contestant on Dancing with the Stars. Client owned a nightclub and was approached by an independent promoter of dance events to host a DJ dance party. Promoter used an independent graphic artist to create an internet poster of the event called Temptation Island. The graphic artist found a picture on the internet of two women in bikinis for use on the poster, not realizing it was Plaintiff and her sister, another model. The sisters sued for misappropriation of their likenesses.

Result:

Settled early in the litigation for \$3,000 per plaintiff. Initial demand was \$50,000 per plaintiff.

Practice Area: Advertising Injury, Copyright, Domain Name and Trademark Litigation, Insurance Services, Intellectual Property

Key Issues: Trademark Infringement; Misappropriation of Trade Secrets; Unfair Competition

Venue: Orange County Superior Court

Client Type: Semiconductor Distributor

Client started electronic component distribution company in 1982, which was bought by another company in 1995. The new company kept client as general manager and initiated a new software program for inventory control that failed miserably. As a result, it was forced into bankruptcy. The assets were purchased by plaintiff, including all trademarks. The client, believing that the semiconductor division was closing for good, started a new company using the old name and logo.

Result:

Directed verdict for client on claim for conversion. Jury verdict for client on claims for intentional interference with prospective economic advantage and misappropriation of trade secrets. Verdict for plaintiff on trademark infringement for \$396,000. Plaintiff asked jury to award \$1.8 million and pre-trial settlement demand was \$1 million.

Practice Area: Advertising Injury, Insurance Services

Key Issues: Defamation; Trade Libel; Breach of Contract

Venue: Los Angeles County Superior Court

Client Type: T-shirt Manufacturer

Client manufactures t-shirts. Entered into a contract with a screen printing and licensing company which held licenses for popular comic strip characters. Client sued screen printing and licensing company for breach of contract under the agreement to make t-shirts with the characters on them. Screen printing and licensing company cross-complained including a claim of defamation for statements made by client to other t-shirt manufacturers.

Result:

Settled for confidential sum, with client receiving favorable settlement on breach of contract claim.

Practice Area: Advertising Injury, Insurance Services

Key Issues: Misappropriation of Likeness; Trademark Infringement; Internet Advertising

Venue: Los Angeles County Superior Court

Client Type: Hair Extension Store

Plaintiff was assignee of rights to an actress who used hair extensions purchased from a human hair extension store. Client was former employee who believed had an ownership interest in the store. Opened her own store with slightly different name, but used part of the name of former employer and put photographs of actress in store and on website as endorsement.

Result:

Settled for a small amount.

Publications

- Author, Law Art with Tom O'Leary, *Gallery Row Art Walk News*, 4/10/2012
- Author, Law Art Withn Tom O'Leary: Copyrights vs. Trademarks, *Gallery Row Art Walk News February 2012, Volume 2 No. 5*, 2/10/2012
- Author, Law Art with Tom O'Leary, *Gallery Row Art Walk News*, 1/11/2012
- Author, Law Art with Tom O'leary, *Gallery Row Art Walk News*, 12/10/2011