



## Copyright, Domain Name and Trademark Litigation

Cases litigated by the Firm in the trademark and trade dress arenas include infringement, dilution, cyberpiracy and unfair competition claims involving trade names, service marks, trademarks, packaging, domain name disputes, initial interest confusion through misappropriation of website metatags, misappropriation of styles of doing business and trespass to chattels through the use of Internet web-crawlers. In the copyright arena, our experience ranges from claims based on computer source code, the “overall look and feel” of printed publications, attribution disputes over a series of historical murals and claims involving the distribution and importation rights of CDs and DVDs. Our Intellectual Property Group also has substantial experience with other forms of copyright litigation, including matters involving architectural drawings and ornamental designs.

### Representative Experience

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**Attorneys:** Arnold E. Sklar

**Key Issues:** Copyright Infringement

**Venue:** District Court

**Client Type:** Plaintiff Toy Manufacturer

**Description:** Represented the plaintiff, a toy manufacturer, in a copyright infringement case.

**Result:** The district court denied the defendant toy manufacturer’s motions to dismiss and for summary judgment, holding that the memorialization of a previous oral assignment of the copyright to the plaintiff satisfied the applicable copyright laws and established the plaintiff as the copyright owner.

**Attorneys:** Arnold E. Sklar

**Key Issues:** Copyright Infringement

**Venue:** District Court

**Client Type:** Plaintiff Designer Watch Manufacturer

**Description:** Represented the plaintiff, a designer watch manufacturer, in a copyright infringement case.

**Result:** The district court granted a preliminary injunction in favor our client, finding likelihood of success of copyright infringement. On appeal, the court remanded for re-consideration in light of new developments. On reconsideration, the district court affirmed the preliminary injunction on copyright grounds and also added likelihood of success of trade dress infringement as grounds for preliminary injunction.

**Attorneys:** David M. McLaughlin

**Key Issues:** Intellectual Property; Trade Secret; Copyright

**Venue:** State and Federal Court in Australia, Canada, Germany, South Africa, California, Colorado, Florida, Illinois, Kansas, Louisiana, Oregon, Minnesota, Missouri, Nevada, New Hampshire, New York, South Carolina, Washington, Washington DC,

**Client Type:** Defendant Life Science Company

**Description:** Represented a biotechnology/life sciences company - Applied Biosystems and Applera (now known as Life Technologies, Inc.)-in trade secret and copyright protection matters involving DNA test kits and sequencing devices which use polymerase chain reaction (PCR) technology in numerous jurisdictions.

**Result:** Successfully quashed numerous subpoenas demanding trade secret and unpublished developmental validation information

**Attorneys:** Arnold E. Sklar

**Key Issues:** Trademark Infringement

**Venue:** Federal Court, Central District, Santa Ana

**Client Type:** Defendant Delicatessen

**Description:** Represented the defendant in a trademark infringement case in which a mid-sized producer of Italian foods sued our client, a family-owned delicatessen, for infringing on the use of their gourmet food mark used on sandwiches sold to local schools.

**Result:** Summary Judgment was granted in the defendants' favor based on the First Sale Doctrine. The case was declared "exceptional" and the defense fees were enhanced and returned to the client's carrier.

**Attorneys:** Arnold E. Sklar

**Key Issues:** Trademark Infringement

**Venue:** Federal Court, Central District, Santa Ana

**Client Type:** Defendant Food Manufacturer

**Description:** The plaintiff, an international manufacturer of potato chips, had manufactured and nationally distributed a product using a specific term in 1982. The defendant, a competing potato chips manufacturer, had used the same term on its own brand of potato chips since 1986. Neither party had obtained federal trademark registrations for the term. The plaintiff filed suit for trademark infringement and false designation of origin. Prior to trial the plaintiff voluntarily dismissed all claims for money damages to avoid a jury trial. Upon receiving survey evidence during a two and one half week bench trial, the court rendered a verdict in favor of the defense determining that the term was generic and thus not protectable.

**Result:** Settlement negotiations resulted in no agreement to stop use of the term, or payment of monies to the

plaintiff. Prior to trial, the plaintiff dismissed all claims for money damages, to avoid jury trial. Two and half week Court trial. Court verdict in defense favor, term deemed generic, free for use by all producers of these types of potato chips. Favorable decision published Classic Foods Int'l Corp. v. Kettle Foods, Inc., 468 F.Supp.2d 1181 (C.D. Cal. 2007).

**Attorneys:** Arnold E. Sklar

**Key Issues:** Copyright Infringement

**Venue:** Federal Court, Southern District, San Diego

**Client Type:** Defendant Computer Distributor

**Description:** The plaintiff was a manufacturer and software designer that produced inks and computer "plug-ins" that enabled the user to print black and white photos in commonly available desktop printers designed to print photos in color. Our client was a marketing company that sold the plaintiff's products under contract. Upon termination of the business relationship, the plaintiff accused the defendant of copyright infringement by improperly continuing sales of the software. The defendant was also accused of trade disparagement.

**Result:** Pre-trial negotiations yielded an initial demand from the plaintiffs of \$2 million which was further reduced to \$995,000 right before trial. After a two week trial, the jury returned a verdict favorable to the plaintiff in the amount of \$155,000 on the trade libel claim only. However, before trial, summary judgment was granted in favor of the defendant on the copyright infringement claim resulting in the defendants being awarded attorneys fees in an amount that exceeded the verdict on the trade libel claim.

**Attorneys:** Michael J. Ioannou, Lita M. Verrier

**Key Issues:** Trademark Infringement; Breach of Contract

**Venue:** USDC: Northern District of California - San Francisco Division District Court

**Client Type:** Defendant Call Center

**Description:** Represented the defendant, a call center, in a trademark infringement and breach of contract related to licensing/distributorship agreement lawsuit.

**Result:** Obtained a favorable settlement for our client.

**Attorneys:** Michael J. Ioannou, Lita M. Verrier

**Key Issues:** Copyright Infringement; Trade Secret

**Venue:** USDC: Northern District of California

**Client Type:** Plaintiff Management Consulting Group

**Description:** Represented the plaintiff/defendant, a management consulting group, and the defendant, the president of the management consulting group, in this copyright, trade secret case.

**Result:** A favorable settlement was reached.

**Attorneys:** Michael J. Ioannou, Lita M. Verrier

**Key Issues:** Copyright Infringement

**Venue:** USDC: Eastern District of California

**Client Type:** Defendant

**Description:** Represented the defendant in a case involving a copyright infringement action related to the use of the "Barney" character.

**Result:** Negotiated a favorable license agreement and settlement for the client.

**Attorneys:** Michael J. Ioannou, Lita M. Verrier

**Key Issues:** Copyright Infringement

**Venue:** Northern District- San Jose Division District Court

**Client Type:** Defendant; Software Manufacturer

**Description:** Represented the defendant in a copyright infringement and related torts case concerning a license agreement in the medical software field.

**Result:** Negotiated a favorable settlement for our client.

**Attorneys:** Michael J. Ioannou, Lita M. Verrier

**Key Issues:** Trademark Infringement

**Venue:** San Luis Obispo County Superior Court

**Client Type:** Defendant Sporting Goods Store

**Description:** Defended a sporting goods store accused of trademark infringement, trade dress violations and unfair competition related to the use of State University logos and marks on articles of clothing.

**Result:** Defeated a preliminary injunction on behalf of our client.

**Attorneys:** Michael J. Ioannou, Lita M. Verrier

**Key Issues:** Trademark Infringement

**Venue:** USDC: Northern District of California- San Francisco Division

**Client Type:** Defendant Winery

**Description:** Defended a winery in a case in which the plaintiff claimed infringement and unfair competition related to the sale of wine under a specific name.

**Result:** Obtained a favorable settlement for our client.

**Attorneys:** Michael J. Ioannou, Lita M. Verrier

**Key Issues:** Copyright Infringement

**Venue:** USDC: Northern District of California- San Jose

**Client Type:** Defendant; Broadcasting Company

**Description:** Represented the defendant, a broadcasting company, in this copyright infringement action concerning consignment and resale of original art/pictures.

**Result:** Negotiated a favorable settlement for our client.

**Attorneys:** Michael J. Ioannou

**Key Issues:** Trademark Infringement; Cybersquatting

**Venue:** USDC: Northern District of California

**Client Type:** Defendant Manufacturer & Distributor

**Description:** Defended a manufacturer and distributor in a trademark infringement, cybersquatting and related torts case concerning the use of an allegedly similar trade name, words and marks in the golf accessory industry. We were brought in two weeks prior to trial with admitted liability and a stipulated preliminary injunction.

**Result:** Negotiated a favorable settlement for client during trial.

**Attorneys:** Michael J. Ioannou, Lita M. Verrier

**Key Issues:** Patent; Trademark Infringement

**Venue:** USDC: Northern District of California

**Client Type:** Defendant Software Company

**Description:** Represented the defendant, a software company, in this patent, trademark and related torts action involving the sale of software that allegedly infringed both patents and trademarks of the plaintiff.

**Result:** A favorable settlement was reached after obtaining evidence of fraud from the U.S. Patent & Trademark Office on the part of the plaintiff.

**Attorneys:** Stephen J. Erigero

**Key Issues:** Copyright Infringement; Unfair Competition

**Venue:** USDC: Central District of California

**Client Type:** Defendant Toy Importer

**Description:** Represented a toy importer in a case involving allegations of copyright infringement and unfair competition over an advertisement. Obtained the dismissal of right of publicity claims brought by individuals who appeared in the advertisement based upon the principle of copyright preemption of right of publicity claims.

**Result:** The case was resolved by settlement.

**Attorneys:** Lael D. Andara

**Key Issues:** web page; airport;

**Venue:** USDC: Northern District of California

**Client Type:** Plaintiff County Agency running Airport

**Description:** Trademark Infringement and Cyberpiracy related to government website. When a user typed in "Sonoma County Airport" into an internet search, two sites would appear: one for the "Charles M. Schulz Sonoma County Airport," and "Sonoma County Airport.com--Visit Sonoma County." The latter was defendant's

"travel" site, she had registered the domain name sonomacountyairport.com in June of 2001, which we asserted was creating consumer confusion for those seeking information about the airport. The County who held a common law trademark on "Sonoma County Airport," first used the mark in connection with the Airport in 1946, a year before the County accepted transfer of the Airport's property from the federal government. After written discovery and deposition the matter reached a confidential settlement and Sonoma County acquired the disputed URL for the Charles M. Schulz Airport.

**Result:** Confidential settlement and acquisition of the disputed URL for the Charles M. Schulz Airport.

**Attorneys:** Michael J. Ioannou, Lita M. Verrier

**Key Issues:** Copyright Infringement

**Venue:** USDC: Northern District of California

**Client Type:** Plaintiff Technology IT Services Company

**Description:** Represented the plaintiff, an IT services company, in a matter involving copyright infringement, unfair competition, misappropriation of trade secrets and declaratory relief related to the selling and licensing of products that enable integration and migration solutions for different business processes across heterogeneous systems by and through intelligent adapters.

**Result:** Obtained a favorable settlement for the client.

**Attorneys:**

**Key Issues:** Trademark and Copyright Infringement

**Client Type:** Defendant Private Tutor School

**Description:** Defended a private tutor school against claims of trademark and copyright infringement.

**Result:** The lawsuit was settled with favorable terms for our client.

**Attorneys:** Spencer C. Martinez

**Key Issues:** Breach of Contract, Fraud, Trademark Infringement, Domain Name

**Venue:** Marin County Superior Court

**Client Type:** Plaintiff Online Business

**Description:** Represented the plaintiff in action against a foreign business for breach of a contract to create a collaborative website and to redress theft of trade secret data, trademark infringement and cybersquatting.

**Result:** The defendant brought a motion to transfer the action to the United Kingdom, relying on Hague Convention's provisions regarding forum selection as applied to the parties' written agreements. We defeated the motion, and the defendant thereafter opted not to defend the claim.

**Attorneys:** Stacy Monahan Tucker

**Venue:** Northern District of California

**Client Type:** Defendant, Internet Website

**Description:** Plaintiff sued Defendant, an online price comparison and shopping website, direct and contributory and vicarious trademark violations for listings of allegedly counterfeit products. Defendant explained that the listings were not generated by the Defendant and its service terms and online fraud prevention efforts as outlined by *Tiffany Inc. v eBay*, 600 F.3d 93 (2d. Cir. 2010.)

**Result:** After extensive discovery motion practice in which defendant consistently prevailed, the parties reached a confidential settlement.

**Attorneys:** Robert A. Rivas

**Key Issues:** Trademark media technology international

**Venue:** United States District Court

**Client Type:** Optical Media Manufacturer

**Description:** Client US optical media manufacturer and brand owner brought action in US District Court alleging trademark and trade dress infringement against Taiwanese manufacturer and competitor.

**Result:** Settled favorably and obtained permanent injunction.

**Attorneys:** Robert A. Rivas

**Key Issues:** Trade dress, label, packaging

**Venue:** United States District Court, Central District

**Client Type:** Non-Alcoholic Beverage Manufacturer

**Description:** Client non-alcoholic beverage manufacturer sued competitor for trade dress infringement over design of packaging and label.

**Result:** Settled favorably.