



Intellectual Property

The Intellectual Property Group at RMKB understands that, in today's information-based business environment, a company's most valuable asset is often its intellectual property. Our team of specialists provides the complete spectrum of intellectual property services to its corporate and individual clientele. These services range from the registration and licensing of trademarks, copyrights and patents to asserting and defending all aspects of those rights. We provide these services to clients in traditional, technical and scientific fields, high technology, biotechnology, entertainment, service providers and retail establishments.

Copyright, Domain Name and Trademark Litigation

Cases litigated by the Firm in the trademark and trade dress arenas include infringement, dilution, cybersquatting 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.

Copyright, Trade Dress and Trademark Registration

We assist clients with the identification, registration and protection of various forms of intellectual property.

Trademarks

A trademark is a designation used to identify and distinguish the goods of a person. Similarly, a service mark is any word or symbol used to identify services of a person and distinguish them from the services of others.

We work collaboratively with our clients in the mark selection process. Once marks have been identified for protection, we assist clients in the clearance, use, registration, and enforcement of

trademarks, service marks, business names, domain names, trade dress, and packaging design in the United States.

Trademark laws worldwide are ever changing. We monitor the global trends in trademark law and keep our clients informed of developments that may affect their businesses. We also maintain a global network of foreign law firms for counseling, registrations and litigation.

Copyrights

Copyright is secured automatically when an “original work of authorship” is created. Although registration is not a condition of copyright protection, the copyright law provides several advantages to encourage copyright owners to make registration.

We assist clients in the identification and registration of their original works.

International Trademark

RMKB is known for its expertise in the areas of both domestic and international trademark registration. The firm's lawyers in the Intellectual Property group have extensive experience registering and defending trademarks world-wide. Such practice includes experience with the European Union, as well as the prosecution of applications under the Madrid Protocol, and in individual countries around the world. The registration practice includes the pursuit and registration of marks for a wide variety of clients from biotechnology companies to microchip manufacturers to software development companies.

With offices in San Francisco, Silicon Valley, Los Angeles, New York, and Hong Kong, RMKB is uniquely positioned to provide a variety of intellectual property-related services. The firm's attorneys are experienced in addressing complex issues regarding trademarks and their protection, including vast litigation experience in the area of trademark infringement. In addition, significant cases involving the wine industry in California have been handled by this firm. Ropers, Majeski draws on the knowledge and experience of more than 100 U.S. attorneys, including some qualified in multinational jurisdictions, giving the firm an exceptional ability to represent its clients in a truly comprehensive manner.

Patent Prosecution, Licensing and Litigation

RMKB offers the entire range of patent-related services to its clients. These services include the representation of inventors in the prosecution of patent applications before the United States Patent & Trademark Office and the licensing of patent rights both before and after a patent has been issued. We have represented both plaintiffs and defendants in asserting or defending patent infringement claims in litigation. These cases involve both design and utility patents and include inventions such as food and beverage processing devices, paint application devices, the ornamental design of automobile components, utility patents involving electronic circuitry, as well as high-technology patent disputes involving DNA replication technology and telecommunications devices.

Trade Secret Protection and Litigation

To provide fundamental protection of our clients trade secrets, the IP group offers advice and

counseling on internal policies and procedures for handling confidential proprietary matters. Once misappropriation of trade secrets is at issue, however, the Firm has significant experience in litigating such cases, including cases involving former employees who have allegedly made use of trade secret information as well as claims arising from misappropriation committed by third parties. We are also well versed in insuring that our clients trade secrets are protected during the course of litigation, both from the companies or individuals on the other side of a lawsuit and from the public at large.

Unfair Competition

Whether based on the federal trademark statutes or the California Business and Professions Code, the Intellectual Property department at Ropers has the in-depth knowledge of unfair competition claims that only comes from years of litigating and trying such cases. Our experience includes the defense of medical device manufacturers, Internet retailers, nutritional supplement companies and service providers. Since many of these cases are driven by the lure of recovering attorneys fees, we have found that a detailed front-end analysis of the up and down sides of these cases will allow our clients to make cost-effective decisions as to the course of litigation.

Representative Experience

Attorneys: Robert P. Andris

Key Issues: Patent Infringement

Client Type: Manufacturer

In this utility patent infringement claim between the owner of four patents involving automotive parts and a competing after-market parts manufacturer, we are currently negotiating the resolution of these claims before litigation has been filed.

Attorneys: Robert P. Andris

This matter involved negotiations between the owner of certain luminescent lanthanide chelate compounds which are used in developing reagent or assay tests for drug testing companies.

Result:

The negotiations were successful and a license agreement was executed.

Attorneys: James C. Potepan

Key Issues: Trademark Infringement

Venue: State Court

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

Attorneys: James C. Potepan

Key Issues: Legal Malpractice; Copyright

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

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

Key Issues: Trademark Infringement

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

Attorneys: James C. Potepan

Key Issues: Unfair Competition

Venue: State Court

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

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

Key Issues: Copyright Infringement; Trademark Infringement

Venue: Federal Court

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

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

Key Issues: Copyright Infringement; Trademark Infringement

Venue: Federal Court

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

Attorneys: James C. Potepan

Key Issues: Trade Secret

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

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

Key Issues: Trade Dress

Venue: Federal Court

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

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

Key Issues: Copyright Infringement

Venue: Federal Court

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

Attorneys: James C. Potepan

Key Issues: Unfair Competition

Venue: State Court

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

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

Key Issues: Trade Secret

Venue: State Court

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

Attorneys: James C. Potepan

Key Issues: Copyright Infringement

Venue: Federal Court

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

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

Key Issues: Unfair Competition

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

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

Key Issues: Unfair Competition

Venue: State Court

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

Attorneys: Ernest E. Price

Key Issues: Infringement

Venue: Federal Court, Central District, Los Angeles

Client Type: Plaintiff Video Distributors

Represented plaintiff in a cross-complaint in a action between joint venturers for breach of production and video distribution agreements. Key issues involve misappropriation of trade secrets. Obtained favorable verdict following a two-week trial.

Result:

Summary Judgment granted in defendants' favor: plaintiff joint writer no standing to sue for infringement where dialogue jointly written and other writers licensed the dialogue to production company. Case declared "exceptional"—defense fees subsequently awarded—recovery currently under negotiation.

Attorneys: Ernest E. Price

Key Issues: Trademark Infringement

Venue: Federal Court, Central District, Santa Ana

Client Type: Defendant Delicatessen

We represented the defendant in trademark Infringement case. Issue: mid-sized producer of Italian foods sues family-owned delicatessen for infringing on the use of their gourmet food mark used on sandwiches sold to local schools.

Result:

Summary Judgment granted in defendants' favor based on First Sale Doctrine; case declared "exceptional"—defense fees enhanced and returned to client's carrier.

Attorneys: Ernest E. Price, Arnold E. Sklar
Key Issues: Copyright Infringement
Venue: Federal Court, Southern District, San Diego
Client Type: Defendant Computer Distributor

The plaintiff was a manufacturer and software designer that produces inks and computer "plug-ins" that enables 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 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 plaintiff in the amount of \$155,000 on the trade libel claim only. However, before trial summary judgment was granted in favor of defendant on the copyright infringement claim resulting in defendants being awarded attorneys fees in an amount that exceeded the verdict on the trade libel claim.

Attorneys: Arnold E. Sklar
Key Issues: Copyright Infringement
Venue: District Court
Client Type: Plaintiff Toy Manufacturer

The district court denied the defendant toy manufacturer's motions to dismiss and for summary judgment in a copyright infringement case, 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.

Result:

Favorable for plaintiff.

Attorneys: Arnold E. Sklar
Key Issues: Copyright Infringement
Venue: District Court
Client Type: Plaintiff Designer Watch Manufacturer

The district court granted preliminary injunction in favor of a maker of famous watch designs, finding likelihood of success of copyright infringement.

Result:

On appeal, the court remanded for re-consideration in light of new development. On reconsideration, 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: Arnold E. Sklar
Key Issues: Patent Infringement
Venue: Federal Circuit Court of Appeals
Client Type: Defendant Handbag Manufacturer

The district court granted summary judgment in favor of defendant in a patent infringement suit, on the basis

that defendant's accused product predates the invention.

Result:

Reversed on appeal, finding that the plaintiff had met its burden of showing a genuine issue of fact as to the validity of the patent.

Attorneys: Todd A. Roberts

Key Issues: Breach of Licensing

Company sued prominent Internet DVD company for breach of licensing agreement. Dispute involved implementation issues and failure of product to perform as represented.

Attorneys: Todd A. Roberts

Key Issues: Copyright Infringement; Trademark Infringement

A multinational computer technology corporation filed copyright and trademark infringement suit against hardware and software re-seller in federal court. The plaintiff contended sale of software by company without formal distribution agreement constituted infringing conduct. The plaintiff also alleged some product was counterfeit.

Result:

Case defended on basis of "first sale" doctrine.

Attorneys: James C. Potepan

Key Issues: Trademark Infringement

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

Attorneys: François G. Laugier

Key Issues: Acquisition (for sellers)

Client Type: Selling Shareholders in Acquisition

Represented shareholders of French software company in the sale of their stock to a NASDAQ-traded corporation.

Attorneys: François G. Laugier

Key Issues: Acquisition (for buyer)

Client Type: US Public Company

Represented US public company in its \$3.5 million asset purchase of a Swiss company equipment and technology used in the manufacturing of women's apparel.

Attorneys: François G. Laugier

Key Issues: Patent Transfer

Client Type: University Professor

Negotiated for Berkeley University professor transfer of patented technology to publicly-traded company.

Attorneys: François G. Laugier

Key Issues: Outside General Counsel from Formation to Acquisition

Client Type: Software Company

Organized and represented software company specializing in wireless communications software. Drafted and negotiated all bundling, joint development and distribution contracts with US, European and Asian partners.

Prosecuted US trademarks. Handled \$ 17.5 million cash acquisition by US public company.

Attorneys: François G. Laugier

Key Issues: Formation and Growth of Clean-Tech Company

Client Type: Clean Energy Company

We represented an established European solar company (PV and thermal) in the organization and growth of its multi-state US operations. Created library of contracts for all business purposes, Stock Option Plan, trademarks and assisted them in building their corporate team.

Attorneys: François G. Laugier

Key Issues: Formation Through Late-Stage Growth of DSL Solutions Company

Client Type: Mature Private Software Company

Served as general corporate counsel to startup founded by Silicon Valley veteran and Stanford University professor. We represented company in all aspects of incorporation, licensing to hardware and software companies, employment issues, domestic and international registration of trademarks, multiple rounds of financing, Sarbanes-Oxley compliance counseling, and negotiation of multi-year, multi-million dollar license to national and international providers in the communications industry.

Attorneys: François G. Laugier

Key Issues: Formation Through Late-Stage Growth of Internet Company

Client Type: Private Internet Company

Represented a Silicon Valley veteran in the organization of a new venture dedicated to Internet data mining. Organized corporation as investment vehicle for seed financing. Represented corporation in Series A through D Preferred Stock Issuance and coordinated financing from multiple international sources. Drafted technology licenses, Stock Option Plan and agreements, employment contracts, and International (US, EU, Japan, Mexico, Canada) trademark applications.

Attorneys: J. Mark Thacker

Key Issues: Trade Secret; Trade Dress; Unfair Competition

Venue: USDC: Northern District of California

Client Type: Defendant Product Manufacturer

Suit for trademark infringement, misappropriation of trade secret and unfair competition arising out of manufacture and sale of ceiling systems.

Result:

Matter was settled for minimal amount, to the complete satisfaction of the client.

Attorneys: Allan E. Anderson, Bradley P. Boyer

Key Issues: Breach of Franchise Agreement; Misrepresentation; Misappropriation of trade secrets

Venue: Orange County Superior Court

Client Type: Plaintiff Franchisee

Represented plaintiff franchisee in a breach of franchise agreement against franchiser. Key issues included misrepresentation and misappropriation of trade secrets.

Result:

Obtained rescission of original franchise agreements and buyback of facilities for a confidential sum.

Attorneys: Allan E. Anderson, Timothy L. Skelton

Key Issues: Copyright Infringement

Venue: USDC: Southern District of California

Client Type: Defendant Toy Manufacturer

Represented defendant toy manufacturer of novelty rings in a copyright infringement case.

Result:

The matter was resolved by a confidential settlement.

Attorneys: Bradley P. Boyer

Represented television producer in revising agreements for television project and trademark applications for same.

Attorneys: Bradley P. Boyer

Represented a joint venture participant in a dispute regarding reality television show.

Attorneys: Bradley P. Boyer, Richard L. Charnley

Venue: Los Angeles County Superior Court

Represented producers in connection with a dispute regarding the right to make a movie based upon a critically acclaimed novel.

Attorneys: Robert P. Andris, Jesshill E. Love

Key Issues: Trade Secrets; Trademark Infringement

Venue: USDC: Northern District Court of California

Client Type: Defendants

In this misappropriation of trade secrets and trademark infringement lawsuit, we are currently defending ex-employees of the plaintiff who left the company and opened a competing professional services placement business. We were brought into this action thirty days before a hearing on plaintiff's second motion to compel further discovery responses and request for terminating sanctions.

Result:

We filed briefs on the motion and served further discovery responses within two weeks and the motion was ultimately denied.

Attorneys: Robert P. Andris

Key Issues: Trademark Infringement; Trade Secrets

Venue: USDC: Northern District of California

This trademark and trade secrets lawsuit arose when our clients left their former employer and opened a competing temporary placement agency for accountants.

Result:

The matter was settled before the case was set for trial.

Attorneys: Robert P. Andris

Key Issues: Copyright Infringement

Venue: USDC: Northern District of California

Client Type: Defendants Production Company & Rental Car Agency

This action for copyright infringement arose when our clients were accused of producing and using a musical composition substantially similar to one composed by the plaintiff twenty years earlier. The accused work was used during a nation-wide advertising campaign for one of the two largest rental car agencies in the U.S.

Result:

We filed motions for summary judgment on the damages issues and the case was successfully resolved in favor of our clients.

Attorneys: Robert P. Andris

Key Issues: Trademark Infringement

Venue: USDC: Southern District of California

Client Type: Manufacturer

This action for trademark infringement arose between two manufacturers and wholesalers of goods and services to the hair care industry.

Result:

Based in part upon our recommendations, the matter was resolved shortly before trial.

Attorneys: Lael D. Andara, Robert P. Andris

Key Issues: Patent Infringement

Venue: USDC: Northern District of California

Client Type: Plaintiff Manufacturer

This action for patent infringement involved competing manufacturers of integrated electric servo motors used in motion control applications such as robots and assembly lines.

Result:

The court modified its injunction, issued additional sanctions and the matter was resolved shortly thereafter.

Attorneys: Lael D. Andara, Robert P. Andris

Key Issues: Breach of Contract

Venue: USDC: Northern District of California

Client Type: Plaintiff Manufacturer

This breach of contract lawsuit arose out of an earn-out provision in a contract for the purchase of our clients Software as Service (SaS) business that allowed web designers to see what their proposed web pages would look like while users were employing various internet browsers.

Result:

After we took the depositions of several key employees at the defendant company who integrated the plaintiff's software into the products offered by defendant, the matter was successfully settled in favor of our clients.

Attorneys: Lael D. Andara, Robert P. Andris

Key Issues: Patent Infringement

Venue: USDC: Eastern District of Pennsylvania

Client Type: Defendant Manufacturer

In a patent infringement action venued in the Eastern District of Pennsylvania, we represented defendants accused of infringing a patent for cooling devices used in personal computers.

Result:

During a five day jury trial the panel submitted a mixed verdict which found that all of the patents dependent claims were invalid as a obvious but that the independent claims were not. This matter is pending appeal in the Federal Circuit.

Attorneys: Thomas M. O'Leary

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.

Attorneys: Michael J. Ioannou, Lita M. Verrier

Key Issues: Trade Secret

Venue: San Fracisco County Superior Court

Client Type: Defendant

Trade secret claims in environmental testing field.

Result:

Favorable settlement reached.

Attorneys: Michael J. Ioannou, Lita M. Verrier

Key Issues: Patent Infringement

Venue: USDC: Northern District of California

Client Type: Defendant Furniture Reseller

Patent infringement action related to computer keyboard.

Result:

Favorable settlement reached for client.

Attorneys: Robert P. Andris, Thomas M. O'Leary

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.

Attorneys: Allan E. Anderson

Key Issues: Trademark Infringement; Copyright Infringement; Determination of Ownership; Work Made for Hire

Venue: USDC: Central District of California

Client Type: Plaintiff Peripheral Manufacturer

Represented plaintiff computer monitor and peripheral manufacturer in a trademark and copyright infringement counterclaim. Key issues included determination of ownership of work made for hire.

Result:

Successfully defended counterclaim which resulted in a permanent injunction against counterclaimant.

Attorneys: Robert P. Andris, Elise R. Vasquez

Key Issues: Trademark Infringement; Trade Dress

Venue: USDC: Northern District of California, San Francisco Division

Client Type: Defendant

A complaint for trademark and trade dress infringement was filed in the District Court.

Result:

Before we were forced to answer, we successfully negotiated a non-monetary settlement which required client to phase out old labels and replace them with new labels which the client already had in the development stage.

Attorneys: Michael J. Ioannou

Key Issues: Patent Infringement

Venue: USDC: District of Arizona

Client Type: Defendant Semiconductor Manufacturer

Currently representing defendant, a leader in the design and selling of semiconductor products. Largest patent infringement case in the United States involving more than 800 defendants/alleged infringers in lawsuits all over the country related to bar code/auto ID patents.

Attorneys: Robert P. Andris, Elise R. Vasquez

Key Issues: Trademark Infringement

Venue: USDC: Central District of California

Client Type: Defendant Manufacturer

In a trademark infringement and cybersquatting lawsuit which involved competing manufacturers of condoms, and after extensive settlement negotiations, the lawsuit was tried to a jury verdict in the United States District Court, Central District of California.

Result:

While the jury found that the defendant violated the Lanham Act by registering the plaintiff's trademarks as Internet domain names, the jury found that our client had not caused plaintiff any recoverable damage and went onto award a minimal amount of statutory damages under the Anti-Cybersquatting Consumer Protection Act.

Attorneys: Michael J. Ioannou, Lita M. Verrier

Key Issues: Copyright Infringement

Venue: USDC: Eastern District of California

Client Type: Defendant

This case involved copyright infringement action related to use of "Barney" character. Negotiated favorable license agreement and settlement for client.

Attorneys: Robert P. Andris, Elise R. Vasquez

Key Issues: Copyright Infringement; Trademark Infringement

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

Client Type: Defendant Children's Educational Facility

This copyright and trademark dispute between competing after-school educational facilities involved the overall look and feel of a series of hundreds of workbooks designed to teach grade school children mathematics.

Result:

The case was recently resolved for a small fraction of plaintiff's attorney's fees when we successfully moved for summary judgment on plaintiff's claim for statutory damages under copyright law.

Attorneys: Robert P. Andris, Elise R. Vasquez

Key Issues: Infringement

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

Client Type: Plaintiff

An action for infringement of plaintiff's alleged trade dress rights in a line of specialty furniture.

Result:

We negotiated an advantageous non-monetary settlement which required defendant to change only the name of its accused line of furniture.

Attorneys: Stephen J. Erigero

Key Issues: Copyright Infringement; Unfair Competition

Venue: USDC: Central District of California

Client Type: Defendant Toy Importer

Represented a toy importer in a case involving allegation 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: Robert P. Andris, Jesshill E. Love

Key Issues: Trademark

Venue: USDC: Eastern District of California

Client Type: Coffee Manufacturer

Acted as local counsel for Washington-based coffee manufacturer in a trademark dispute.

Result:

Successfully moved to change venue based on lack of personal jurisdiction. The motion was granted and the case

was transferred to the District Court in Washington.

Attorneys: Michael J. Ioannou, Lita M. Verrier

Key Issues: Trademark, Trade Dress

Venue: USDC: Northern District of California

Client Type: Defendant Winery

We represented the defendant in this trademark, trade dress and related tort claims related to the sale of wine nationwide.

Result:

Defeated preliminary injunction. Favorable settlement for client.

Attorneys: Marta B. Arriandiaga

Key Issues: Trademark Infringement

Venue: USDC: Central District of California- Southern Division

Client Type: Defendant

Represented counter-defendant in trademark infringement suit by a clothing manufacturer regarding component parts of a designer line of shoes.

Result:

This matter was resolved by settlement.

Attorneys: Todd A. Roberts

Key Issues: trademark infringement

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

A private research university filed trademark infringement suit in federal court against manufacturer of RF integrated circuits on the eve of their initial public offering. The plaintiff claimed that the use of their name in the name of the defendant's company was likely to cause consumers to believe that it was affiliated or sponsored by the university.

Attorneys: Michael J. Ioannou

Key Issues: Trademark Infringement; Cybersquatting

Venue: USDC: Northern District of California

Client Type: Defendant Manufacturer & Distributor

This was a trademark infringement, cybersquatting and related torts case related to the use of 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 stipulated preliminary injunction.

Result:

Negotiated favorable settlement for client during trial.

Attorneys: Robert P. Andris, Jesshill E. Love

Key Issues: Copyright Infringement

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

Client Type: Defendant

This copyright infringement lawsuit involves the alleged infringement of plaintiff's exclusive importation rights

over DVD's from Hong Kong to the United States. One of our defenses involved the innocent-infringer doctrine based on the fact that plaintiff failed to give any statutory notice of its distribution rights to defendants or the general public.

Attorneys: Lael D. Andara, Robert P. Andris

Key Issues: Trade Secrets

Venue: Santa Clara County Superior Court

Client Type: Defendant Manufacturer

This misappropriation of trade secrets action arose when our clients left their former employer and opened a competing business in the area of manufacturing components for personal computers and other electronic devices.

Result:

We established that the majority of the information that was allegedly "misappropriated" was, in fact, public knowledge in the industry. The matter was settled favorably for our clients.

Attorneys: Thomas M. O'Leary

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).

Attorneys: Robert P. Andris, Elise R. Vasquez

Key Issues: Cybersquatting; Trademark Infringement

Venue: USDC: Northern District of California

Client Type: Defendant Online Gaming Company

We successfully settled a case involving claims of cybersquatting, trademark infringement and conversion of a popular domain name used in the on-line gaming arena.

Result:

Settled. Plaintiff failed to recapture all its costs of the litigation.

Attorneys: Lael D. Andara, Robert P. Andris

Key Issues: Patent Infringement

Venue: USDC: Northern District of Ohio

Client Type: Defendant Metal Tool Manufacturer

This action for patent infringement was venued in the Western District of Ohio, and involved competing

manufacturers of metal cutting and shaping tools known as end-mills.

Result:

While the motions for summary judgment were pending, the plaintiff dismissed its lawsuit against our clients with prejudice and provided our clients with a life-of-the-patent license at no cost. We proceeded to file an action for malicious prosecution in the District Court in California, and that matter is now pending review by the Ninth Circuit.

Attorneys: Ernest E. Price, Arnold E. Sklar

Key Issues: Trademark Infringement

Venue: Federal Court, Central District, Santa Ana

Client Type: Defendant Food Manufacturer

Plaintiff, an international manufacturer of potato chips had manufactured and nationally distributed a product using a specific term 1982. 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: James C. Potepan

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.

Attorneys: John A. Koepfel, James C. Potepan

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.

Attorneys: Lael D. Andara, Robert P. Andris

Key Issues: Patent Infringement

Venue: USDC: Northern District of California

Client Type: Plaintiff Manufacturer

This action for patent infringement arose out of the defendants' manufacture and sale of fans used by computer modelrs with integrated LEDs.

Result:

We vigorously litigated the defendants' claims that the patent was invalid and entered into licensing agreements with each of the defendants involved. The case was dismissed.

Attorneys: Geoffrey W. Heineman

Key Issues: Insurance Coverage; Interpretation of Director and Officer Policy

Venue: Los Angeles County, Superior Court

Client Type: Defendant Insurance Provider

Interpreted insurance coverage for underlying action seeking to recover for allegations of 1) breach of fiduciary duty; 2) statutory violations of trade secrets; 3) unfair competition; and 4) interference with plaintiffs' prospective economic advantage. The claims centered around the alleged misappropriation of plaintiff's client list, which Plaintiff characterized as a "complex database" that included secretive information such as key decision makers, buying trends, buying history and overall Plaintiff's trends. In addition, as part of the unfair competition causes of action, asserted that the insured was responsible for causing an ex-employee of breaching his fiduciary duties by having him disclose salary information concerning plaintiff's sales force. That disclosure, according to Plaintiff, allowed the insured to hire plaintiff's employees.

Result:

Negotiating various insurance coverage issues arising out of the litigation, including late notice, whether the claim was covered under a director and officer liability policy, we assisted our client in reducing the damages it agreed to indemnify during settlement discussions. What originally appeared to be a "policy limits" matter resulted in a payment of less than full policy limits as a result of the coverage defenses developed.

Attorneys: Timothy L. Skelton

Key Issues: Copyright Infringement

Client Type: Defendant Internet Retailer

We recently obtained summary judgment in our client's favor based on the defenses for internet service providers contained in the Digital Millennium Copyright Act. A copyright holder sent a letter to our client, a large internet retailer, alleging that infringing copies of his work were likely to be offered in the future by third parties using the client's site. After a third party later offered the work on the client's site, the plaintiff filed suit.

Result:

Judgment was favorable for our client.

Attorneys: Robert P. Andris, Elise R. Vasquez
Key Issues: Copyright Infringement; Trademark Infringement
Venue: USDC: Northern District of California
Client Type: Defendant Software Manufacturer

This trademark and copyright infringement lawsuit involved the alleged infringement of plaintiff's intellectual property in the metatag language of defendant's Internet website.

Result:

The case was resolved shortly before trial for a small portion of plaintiff's attorneys fees when we successfully moved for summary judgment arguing that plaintiff could not prove any actual damages under the initial interest diversion theory of trademark law or trespass to chattels in cyberspace, and that plaintiff was not entitled to statutory damages under copyright law.

Attorneys: James C. Potepan
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.

Attorneys: James C. Potepan
Key Issues: Copyright Infringement
Venue: USDC: Central District of California

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

Attorneys: James C. Potepan
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.

Attorneys: Ernest E. Price, Arnold E. Sklar
Key Issues: Trademark Infringement
Venue: USDC: Central District of California
Client Type: Defendant Food Importer

Plaintiff, a refrigerated meat producer, began to use a Vietnamese term as a trademark in 1986. Our client and the defendant, an Asian food importer, first used the term in connection with dry foods (noodles, rice) in 1992. In 1999 both parties had obtained federal trademark registrations for the term in different trademark classes. A suit and counter-claims were filed in 2005. The issues at trial included whether the plaintiff had abandoned the mark, whether plaintiff's delay in objecting to the defendant's use constituted laches and whether the plaintiff could establish damages.

Result:

Pre-trial settlement negotiations yielded demands by plaintiff ranging from 1.2 million dollars to 1.4 million dollars. Trial demand prior to opening statement was \$900,000.00. After plaintiff's close of case, plaintiff reduced

demand to \$700,000.00. Three week jury trial. Jury verdict in defense favor, \$ 0 (zero) dollars in money damages awarded and finding of no willful infringement. Equitable issues of laches currently on appeal.

Attorneys: Lael D. Andara

Key Issues: contract, net share, music

Venue: N/A

Client was in negotiations with a record company as to his continuing his activities as a music producer and writer in an exclusive capacity. Review and counseled on offered contract. Counsel as to how to obtain copyrights on music compositions.

Attorneys: Lael D. Andara

Key Issues: web page; airport;

Venue: USDC: Northern District of California

Client Type: Plaintiff County Agency running Airport

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: Lael D. Andara

Key Issues: computer; internet; LED

Venue: USDC: Northern District of California

Client Type: Plaintiff Seller of patent embodiments

United States Patent No. 6,679,771 on a light-emitting computer cooling fan formed by multiple light-emitting diodes (LEDs), which technology was patented in 2004. Initial efforts to license or have the product taken off the market failed

resulting in the lawsuit. We were able to negotiate a settlement including a consent judgment and permanent injunction prior to any significant discovery or claim construction.

Result:

Obtained a settlement for the Patent holder including a consent judgment and permanent injunction

Attorneys: Terry Anastassiou, Susan H. Handelman

Key Issues: Trade Secret

Venue: Santa Clara County Superior Court

Client Type: Internet Based Stock Trading Company

In this trade secret case the court of appeal reversed the trial court's grant of defendant's, an internet based

stock trading company, motion for nonsuit on damages for misappropriation of a trade secret.

Result:

The court remanded the case for trial on the damages issue.

Attorneys: James C. Potepan

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.

Attorneys: Thomas H. Clarke, Jr.

Key Issues: Unfair Business Practices; Unfair Competition

Venue: California Court of Appeal, First District

Client Type: Food & Catering Enterprise

In this Unfair Business Practice Act matter, we represented a food and catering enterprise in an action involving allegations of trade name infringement, unfair competition, and Lanham Act violations.

Result:

We obtained a defense jury verdict.

Attorneys: James C. Hyde

Key Issues: Copyright Infringement

Venue: USDC: Northern District of California

Client Type: Defendant Corporation

Copyright infringement related to use of refurbished semi-conductor equipment of SVG parts/products.

Result:

Negotiated favorable settlement and future business arrangement for client.

Attorneys: Ernest E. Price

Key Issues: Joint Venture; Breach of Production; Trade Secrets

Venue: Los Angeles County Superior Court

Client Type: Plaintiff Video Distributor

We represented the plaintiff in a cross-complaint in an action between joint venturers for breach of production and video distribution agreements. Key issues involve misappropriation of trade secrets. Obtained favorable verdict following a two-week trial.

Result:

Two week bench trial resulted in money recovery.

Attorneys: Allan E. Anderson

Key Issues: Breach of contract; misrepresentation

Venue: Los Angeles County Superior Court

Client Type: Defendant Video Distribution Company

This case involved the representation of a national video distribution company in a dispute over the licensing rights to distribute an animated cartoon series of well known super hero characters on video.

Result:

After extensive discovery and the deposition of a number of high level corporate executives of the licensor, the licensor agreed to dismiss all of its claims against our client's outstanding rights.

Attorneys: Allan E. Anderson, Timothy L. Skelton

Key Issues: Copyright Infringement

Venue: USDC: Central District of California

Client Type: Distributor

Represented distributor of computer printer refills in a libel action with elements of copyright infringement.

Result:

Matter resolved by confidential settlement.

Attorneys: Allan E. Anderson

Key Issues: Dissolution; Trademark

Venue: Los Angeles County Superior Court

Client Type: Defendant Joint Venturer

Represented defendant joint venturer in a dissolution action brought by co-venturer. The matter proceeded to binding arbitration to resolve licensing issues regarding joint venture's exploitation of intellectual property trademark. Post- arbitration proceedings are ongoing.

Result:

Secured intellectual property rights for screenplay at issue in proceeding on behalf of client.

Attorneys: Allan E. Anderson

Key Issues: Copyright Infringement

Venue: USDC: Central District of California

Client Type: Defendant Retailer

Represented co-defendant retailer in a copyright infringement suit involving the sale of videotapes over the Internet.

Result:

The matter was successfully resolved by settlement.

Attorneys: Allan E. Anderson, Timothy L. Skelton

Key Issues: defamation; libel; slander

Venue: Los Angeles County Superior Court

Client Type: Distributor

Plaintiff, an inkjet refilling company, alleged that our client, a former employee, had published defamatory remarks about plaintiff.

Result:

After we filed a series of successful demurrers that gutted plaintiff's case, the parties settled for a waiver of costs.

Attorneys: Allan E. Anderson, Timothy L. Skelton

Key Issues: Trademark Infringement

Venue: USDC: Central District of California

Client Type: Defendant Toy Watch Manufacturer

Plaintiff, a toy manufacturer, sued its competitor for trade dress infringement, arguing that its packaging was confusingly similar to plaintiff's packaging.

Result:

We defeated plaintiff's motion for a preliminary injunction by establishing that plaintiff had failed to adequately describe its trade dress, and had failed to show that it was the first user of the alleged trade dress. The case then settled on favorable terms.

Attorneys: Allan E. Anderson, Timothy L. Skelton

Key Issues: Copyright Infringement

Venue: USDC: Central District of California

Client Type: Internet Retailer

Represented internet retailer in a copyright infringement suit involving the sale of videotapes over the internet.

Result:

The action was resolved for a dismissal in exchange for a waiver of cost.

Attorneys: Allan E. Anderson, Timothy L. Skelton

Key Issues: Copyright Infringement; Misappropriation of Trade Secrets

Venue: Los Angeles County Superior Court, Northeastern District

Client Type: Flexible Moldings Manufacturer

A custom plastic architectural molding manufacturer sued a former employee for misappropriation of trade secrets and copyright and trademark infringement. Plaintiff also named a business in which the former employee had an ownership interest.

Result:

We obtained summary judgment on the federal (copyright and trademark) claims against our clients. We then settled the remaining state law claims on favorable terms.

Attorneys: Allan E. Anderson, Timothy L. Skelton

Key Issues: Copyright Infringement

Venue: USDC: Central District of California

Client Type: Defendant Movie Distributor

A copyright holder sent a letter to our client, a large Internet retailer, alleging that infringing copies of his film were likely to be offered in the future by third parties using the client's site. After a third party later offered the work on the client's site, the plaintiff filed suit.

Result:

We obtained summary judgment in our client's favor based on the defenses for Internet service providers contained in the Digital Millennium Copyright Act. The court held that a DMCA notice is effective only if the work is actually listed on the website on the day that the notice was received. In other words, a copyright holder cannot send a prophylactic notice covering expected future acts of infringement. This would have the effect of improperly shifting the burden of policing the content to the service provider. Decision at 298 F. Supp. 2d 914.

Attorneys: Allan E. Anderson, Bradley P. Boyer, Timothy L. Skelton

Key Issues: Trademark Infringement

Venue: Superior Court of the State of California for the Los Angeles County

Client Type: Clothing Manufacturer

Represented clothing manufacturer in a trademark infringement lawsuit involving "established" designer clothing.

Result:

Resolved matter for waiver of costs.

Attorneys: Todd A. Roberts

Key Issues: Misappropriation of Trade Secrets; Foreign Company

Venue: United States District Court for the District of Michigan

Client Type: Taiwanese Based Company

Represented Taiwanese based company with U.S. operations from allegations of misappropriation of trade secrets relating to alleged proprietary manufacturing process. Claim involved approximately \$10 million in alleged damages.

Result:

Successfully compelled dismissal with prejudice.

Attorneys: Michael J. Ioannou, Lita M. Verrier

Key Issues: Copyright Infringement

Venue: Northern District- San Jose Division District Court

Client Type: Defendant; Software Manufacturer

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

Result:

Negotiated favorable settlement for client.

Attorneys: Michael J. Ioannou, Lita M. Verrier

Key Issues: Trade Secret

Venue: Santa Clara County Superior Court

Client Type: Defendant; Computer Peripheral Manufacturer

This was a trade secret and related torts dispute concerning the computer peripheral industry.

Result:

Defeated preliminary injunction and favorable settlement reached.

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

Represented defendant in a trademark infringement, breach of contract related to licensing/distributorship agreement.

Result:

Obtained favorable settlement for client.

Attorneys: Michael J. Ioannou

Key Issues: Trademark Infringement

Venue: USDC: Northern District of California

Client Type: Defendant; Winery

We represented the defendant in a trademark action related to the sale of wine.

Result:

Favorable settlement for client reached.

Attorneys: Michael J. Ioannou, Lita M. Verrier

Key Issues: Trademark Infringement

Venue: San Luis Obispo County Superior Court

Client Type: Defendant; Sporting Goods Store

Our client, the defendant, is a sporting goods store accused of trademark infringement, trade dress and unfair competition related to the use of State University logos and marks on articles of clothing.

Result:

Preliminary injunction defeated.

Attorneys: Michael J. Ioannou, Lita M. Verrier

Key Issues: Trademark Infringement

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

Client Type: Defendant; Winery

Plaintiff claimed infringement and unfair competition action related to the sale of wine under a specific name.

Result:

Obtained favorable settlement for 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

We represented the defendant in this copyright infringement action concerning consignment and resale of original art/pictures.

Result:

We negotiated a favorable settlement for our client.

Attorneys: Michael J. Ioannou, Lita M. Verrier

Key Issues: Patent; Trademark Infringement

Venue: USDC: Northern District of California

Client Type: Defendant; Software Company

We represented the defendant in this patent, trademark and related torts action related to the sale of software that allegedly infringed both patents and trademarks of plaintiff.

Result:

A favorable settlement was reached after obtaining evidence of fraud on the U.S. Patent & Trademark Office by plaintiff.

Attorneys: Michael J. Ioannou, Lita M. Verrier

Key Issues: Trade Secret

Venue: USDC: District of Colorado

Client Type: Defendant; Computer Peripheral Distributor

This was a trade secret and unfair competition dispute related to employees leaving plaintiff and joining defendant and involving customer lists in the computer peripheral industry.

Result:

A favorable settlement was reached.

Attorneys: Michael J. Ioannou, Lita M. Verrier

Venue: Circuit Court for the State of Oregon, County of Multnomah

Client Type: Plaintiff; Semiconductor

Misappropriation of Proprietary Information and Trade Secrets; Breach of Mutual Non-Disclosure Agreement; Breach of the Implied Covenant of Good Faith and Fair Dealing; Breach of Employment Agreement, Unfair Competition; Breach of Duty of Loyalty, and Declaratory and Injunctive Relief.

Result:

Confidential, favorable result for client.

Attorneys: Michael J. Ioannou, Lita M. Verrier
Key Issues: Copyright Infringement
Venue: USDC: Northern District of California
Client Type: Plaintiff; Technology IT Services Company

Complaint alleging 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:

Favorable settlement for client.

Attorneys: Michael J. Ioannou, Lita M. Verrier
Key Issues: Trade Secret Misappropriation; Trade Dress and Trademark Infringement; Unfair Competition; Fraud
Venue: USDC: Northern District of California
Client Type: Defendant; Doll Manufacturer

Suit for trademark, trade name and trade dress misappropriation and unfair competition.

Result:

Settled prior to trial favorably 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

Represented Plaintiff/Defendant, a management consulting group, and Defendant, 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: Patent Infringement
Venue: USDC: District of Arizona
Client Type: Defendant; Semiconductor company

Patent infringement alleged against client and other semiconductor companies.

Result:

Settlement agreement.

Attorneys: Michael J. Ioannou, Lita M. Verrier
Key Issues: Copyright Infringement; Wine label; Photograph
Venue: USDC: Northern District of California
Client Type: Defendant; Winery

Copyright infringement related to wine label and photograph.

Result:

Confidential settlement.

Attorneys: Michael J. Ioannou, Lita M. Verrier

Key Issues: Trademark infringement, False Advertising

Venue: USDC: Northern District of California, San Jose Division

Client Type: Plaintiff Semiconductor Company

Trademark infringement and false advertising case involving Maxim's flagship "Maxim" mark. Case settled favorably for Maxim after obtaining stipulated order for permanent injunction.

Result:

Favorable settlement for client. Defendant changed its mark.

Attorneys: Allan E. Anderson, Chi-Hung A. Chan

Key Issues: Intellectual Property; International Trademark Infringement

Venue: Los Angeles County Superior Court; USDC: Central District of California

Client Type: Plaintiff; Computer Peripheral Component Manufacturer

Represented plaintiff Mainland China computer peripheral component manufacturer in a breach of contract action. Key issues included trademark infringement counterclaim.

Result:

Following extensive negotiations at mediation, the matter was resolved in a confidential settlement agreement.

Attorneys: Gregory M. Gentile

Key Issues: Negligence; Misrepresentation

Venue: San Mateo County Superior Court

Client Type: Defendant; Home Inspection Company

Successfully represented a home inspection company and home inspector as to claims of negligence and misrepresentation. The claims against the firms clients were part of a group litigation filed by a homeowner against the various real estate agents, their brokers, and inspectors who were involved in the sale of the home. The homeowner claimed undisclosed and undocumented defects pertaining to their purchase of their home.

Result:

Successfully resolved the matter on behalf of the clients by bringing a motion for summary judgment.

Attorneys: Gregory M. Gentile

Key Issues: Intellectual Property; Breach of Contract; Defamation; Fraud; Misrepresentation

Venue: Santa Clara County Superior Court

Client Type: Defendant; Private Client

Successfully represented a local business entrepreneur in a complex partnership dispute between two joint venturers, involving intellectual property. The claims were for breach of contract, defamation, and fraud. We prosecuted on behalf of the client those claims while defending claims of misrepresentation and conversion. We defended those claims at binding arbitration, obtaining a large monetary award from the arbitrator.

Result:

Defense case at binding arbitration and successfully prosecuted claims of client.

Attorneys: Courtney E. Curtis, Thomas M. O'Leary, James C. Potepan, E. Lacey Rice

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.

Attorneys: Thomas M. O'Leary, James C. Potepan

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.

Attorneys: Thomas M. O'Leary, Brian C. Vanderhoof

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.

Attorneys: Thomas M. O'Leary, Brian C. Vanderhoof

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.

Attorneys: Thomas M. O'Leary, E. Lacey Rice

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.

Attorneys: Thomas M. O'Leary, Brian C. Vanderhoof

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.

Attorneys: Gregory M. Gentile

Key Issues: Intellectual Property; Breach of Contract; Defamation; Fraud; Misrepresentation

Venue: Santa Clara County Superior Court

Client Type: Defendant; Private Client

Successfully represented a local business entrepreneur in a complex partnership dispute between two joint venturers, involving intellectual property. The claims were for breach of contract, defamation, and fraud. We prosecuted on behalf of our client those claims while defending claims of misrepresentation and conversion.

Result:

We defended those claims at binding arbitration, obtaining a large monetary award from the arbitrator.

Attorneys: Lael D. Andara, Robert P. Andris

Key Issues: Patent; Computer; Microchip; Server; Transfer

Venue: USDC: Wyoming

Client Type: Defendant: Blade Server Manufacturer

A twelve-patent infringement action filed against more than 100 computer component manufacturers and suppliers in the USDC in Wyoming.

Result:

In a total of less than six months, we obtained dismissal from the district court in Wyoming based on lack of personal jurisdiction. We then filed a declaratory judgement action in the Northern District of California. These events led to a settlement for less than 4% of the plaintiff's original demand.

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: Life Science Company

Represented in numerous jurisdictions 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.

Result:

We quashed numerous subpoenas demanding trade secret and unpublished developmental validation information.

Attorneys: Ernest E. Price, Timothy L. Skelton

Key Issues: Copyright Infringement

Venue: USDC: Eastern District of Pennsylvania

Client Type: Costume Designer

The district court held that no copyright infringement was shown because the copyright of a costume mask was invalid due to lack of originality.

Result:

During a one week trial, the infringement claim was defended. Defense fees were awarded. Later, malicious prosecution threat resulted in further recovery.

Attorneys: Richard L. Charnley

Key Issues: Distribution Rights

Venue: Los Angeles County Superior Court

Client Type: Defendant Entertainment and Media Company

The plaintiff, producer of a feature film successful in both commercial and critical arenas, brought action against our client, a diversified entertainment and media company for improper marketing and errors in the "profit accounting" for the film. Universal Studios released the film, and Universal was also a defendant.

Result:

In binding arbitration, the judge found for the defendants on all issues. The "pre-arbitration demand" was in excess of \$1,000,000, and instead of recovering on their claim, the plaintiffs faced an \$900,000 judgment in favor of the defendants for their attorney fees and costs. their attorney fees and costs.

Attorneys: Robert P. Andris

Key Issues: Cybersquatting; Trademark Infringement

Accusations of cybersquatting.

Result:

A standoff was declared when we demonstrated that the Anti-Cybersquatting Consumer Protection Act does not apply to our client's registration of a domain name, since that registration occurred before the claimant adopted the trademark in question.

Attorneys: Robert P. Andris

Key Issues: Trademark

Client Type: Plaintiff Manufacturer

Competing businesses in the automobile after market care products industry became involved in a dispute over the validity of a registered trademark owned by our client.

Result:

The case settled successfully after we defeated plaintiff's motion for summary judgment which involved the naked license doctrine of trademark law.

Attorneys: Robert P. Andris

Key Issues: Trade Dress

Client Type: Defendant Snow Sled Manufacturer

We are currently defending the manufacturer of a line of snow sleds in negotiations where plaintiff claims it has trade dress rights which are being violated. In these negotiations, we have demonstrated that the features of plaintiff's snow sled which it claims trade dress in are functional and, therefore, not subject to trade dress protection.

Attorneys: Michael J. Ioannou

Key Issues: Trade Secret

Client Type: Plaintiff Computer Manufacturer

Represented plaintiff and cross-defendant. Claims by Defendant, computer manufacturer, of breach of fiduciary duty and misappropriation of trade secrets.

Result:

Obtained a \$3 million settlement for plaintiff and release of cross-claims.

Attorneys: Michael J. Ioannou

Key Issues: Patent Infringement

Client Type: Defendant Software Manufacturer

Plaintiff claimed our client of software patent infringement.

Result:

The case settled favorably.

Attorneys: Michael J. Ioannou

Key Issues: Trademark Infringement

Client Type: Defendant

We represented the defendant, a golf shop, against a golf resort in this trademark infringement action.

Result:

Negotiated license and favorable settlement for client.

Attorneys: Michael J. Ioannou

Key Issues: Breach of Settlement; Trade Dress; Trademark Infringement

Client Type: Defendant Winery

Breach of settlement agreement, trademark, trade dress and related tort claims related to the sale of wine nationwide.

Result:

Defeated preliminary injunction and temporary restraining order. Favorable settlement for client.

Attorneys: Michael J. Ioannou

Key Issues: Breach of Fiduciary

Client Type: Defendant Shelving Manufacturer

This case included related cross-complaint for breach of fiduciary duty and misappropriation of trade secrets.

Result:

We achieved a favorable settlement for our client.

Attorneys: Michael J. Ioannou

Key Issues: Tort Claims

Client Type: Defendant Enterprise Software Company

The plaintiff filed claims against our client for termination of Asia distributorship, including breach of fiduciary duty and other related tort claims.

Attorneys: James C. Potepan

Key Issues: Infringement

Venue: Federal Court

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

Attorneys: James C. Potepan

Key Issues: Trade Secret; Copyright Infringement

Venue: Federal Court

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

Attorneys: James C. Potepan

Key Issues: Trademark Infringement

Venue: State Court

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

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

Key Issues: Patent Infringement

Venue: Federal Court

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

Attorneys: James C. Potepan

Key Issues: Trade Dress

Venue: Federal Court

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

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

Key Issues: Patent; Trademark

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

Attorneys: James C. Potepan

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.

Attorneys: James C. Potepan

Key Issues: Trademark Infringement

Venue: State Court

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