

# Barbara A. Solomon

Partner

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## Overview

**“I consider myself a counselor, not a litigator. My job is not to jump into litigation but to listen to my client, understand its concerns, and work with the client to find the best way of achieving its goals. When litigation can’t be avoided or if it is the best option, you pursue it. But the focus must not be on my title as a litigator – it must be on achieving the client’s ultimate goal and finding the best way to get there, taking the client’s business and financial interests into account. The best way often is not the most expensive or the most aggressive.”**

Barbara A. Solomon works with iconic brands across diverse industries to protect and enforce their valuable IP assets. Her pragmatic and business-focused approach, coupled with a clear understanding of her clients’ business and their ultimate goal, is what keeps clients coming back – they appreciate her deft ability to achieve desired results through strategic negotiation. When litigation is necessary, clients know that Barbara has achieved many successes in trial and appellate

courts across the country, in opposition and cancellation proceedings before the USPTO’s Trademark Trial and Appeal Board, and in UDRP cases.

With clients in industries ranging from luxury goods, beauty, and fashion to entertainment, consumer products, and financial services, Barbara has deep experience in issues relating to trademarks, trade dress, copyright, false advertising, unfair competition, rights of privacy, rights of publicity, parody, counterfeiting, and the internet. In addition to advising on searches for trademark clearance and registration, she also negotiates and drafts agreements, including co-existence agreements, assignments, distribution agreements, licenses, and representation agreements.

## Representative Experience

Beyond the reported decisions listed above, Barbara has worked on the following matters:

### Litigation

- ***MacDonald et al v. WGBH Educational Foundation***, 1:18-cv-10773 (D. Mass.). Representing WGBH, PBS Distribution and The Taunton Press Inc. in a trademark infringement and preliminary injunction action over the title of a television series.
- ***Big Storm Brewery, LLC v. Due South Brewing Co. Inc.***, 8:16-cv-02405 (M.D. Fla.). Represented local brewery in declaratory judgment action concerning beer names.
- ***Tiffany Inc. v. eBay, Inc.***, 131 S. Ct. 647 (2010). Submitted amicus brief in support of Tiffany for its appeal to the Supreme Court seeking to hold eBay responsible for its alleged direct and contributory trademark infringement, trademark dilution, and false advertising since it facilitated and advertised counterfeit jewelry on its online market.
- ***Viacom Int'l Inc. v. Fanzine, Inc.***, 98 Civ. 7448 (S.D.N.Y. 2000). In a copyright case of first impression, the court held that Viacom's distribution of publicity materials featuring its television characters did not allow a recipient under the guise of media coverage or a fair use defense to commercially reproduce these materials as posters that were folded up to look like a magazine without the authorization of the copyright owner.
- ***MTV Networks, a division of Viacom International Inc. v. Adam Curry*** (S.D.N.Y. 1994). This was the first case ever filed alleging that a domain name infringed on a trademark and that sought to apply Lanham Act principals to the registration and use of a domain name.

## Non-Litigation

- Acted as trademark counsel in several high profile corporate transactions conducting due diligence and drafting and negotiating applicable agreements, including licenses.
- Negotiate license and distribution agreements in cosmetics, beauty, fashion, luxury goods, and consumer product areas.

## Education

Harvard Law School (JD, *cum laude*, 1984)

Brown University (AB, *magna cum laude*, 1981)

*Phi Beta Kappa*

## Admissions

### Bar Admissions

New York

### Court Admissions

U.S. Court of Appeals, 11th Circuit

U.S. Supreme Court

U.S. Court of Appeals, Federal Circuit

U.S. Court of Appeals, 7th Circuit

U.S. District Court, Central District of Illinois

U.S. Court of Appeals, 3rd Circuit

U.S. Court of Appeals, 2nd Circuit

U.S. District Court, Northern, New York

U.S. District Court, Eastern, New York

U.S. District Court, Southern, New York

## Focus

- Fashion

- Personal Care & Cosmetics
- Consumer Products
- Food & Beverage
- Entertainment Properties
- Celebrities, Bands & Athletes
- Jewelry & Watches
- Toys
- Pharmaceuticals

## Services

- Trademark
- Litigation
- Copyright
- Social Media & Domain Names
- Transactions
- Publicity & Privacy

## Associations

### Professional

The Association of the Bar of the City of New York (Secretary, 1990-1992; Committee on Copyright and Literary Property)

World Intellectual Property Organization (WIPO) (panelist for cases brought under the UDRP)

Brooklyn Law School (Adjunct Professor, trademark law) 2004

## Recognition

*The Legal 500* - Leading Lawyer, Trademarks: Litigation 2015-2020, recognized as "excellent" in

the 2015 edition, and noted for "trademark litigation and dispute resolution," 2006-2007

*World Trademark Review* Global Leader 2020-21

*WTR 1000 2021: The World's Leading Trademark Professionals*, "... brilliant at setting strategy to enable the continuous growth of brand value and executes flawlessly and at amazing speed."

*World Trademark Review's* WTR 1000 Gold: 2015-2020, "Barbara is just so impressive intellectually and a seasoned practitioner who understands business intimately."

*Managing Intellectual Property* Trademark IP Star 2014-20

*ExpertGuides: Trademark and Women in Business Law*, included in list of "leading practitioners within the field" 2018-20

*Super Lawyers®* 2006-2020, including "Top Women Attorneys in New York" 2015-2017; "New York Times Best Women Lawyers" Supplement, Intellectual Property Litigation 2015

*Who's Who Legal* Trademarks Global Leader 2013-2020

*Law360's* "Female Powerbrokers" feature interview 2014

*Managing Intellectual Property* named Fross Zelnick "Top Trademark Litigation Team" in the United States, 1999

## Decisions

- Retrobrands USA LLC v. Intercontinental Great Brands, LLC
- Sawicky v. AMC Networks Inc.
- Chanel, Inc. v. Camacho & Camacho LLP

- Royal Crown Co. v. Coca-Cola Co.
- Chanel, Inc. v. Makarczyk
- Kraft Foods Group Brands LLC v. Cracker Barrel Old Country Store, Inc.
- Volvo Trademark Holding AB v. Hebei Aulion Heavy Indus. Co.
- Clinique Laboratories LLC v. Absolute Dental, LLC
- Rodan & Fields, LLC v. Estee Lauder Cos.
- Perfetti Van Melle USA v. Cadbury Adams USA LLC
- Dr Pepper/Seven Up, Inc. v. Krush Global Limited
- De Beers LV Trademark Ltd. v. DeBeers Diamond Syndicate, Inc.
- Lane Capital Mgmt. Inc. v. Lane Capital Mgmt. Inc.
- Buffett v. Cheeseburger in Paradise, Inc.
- Sun Pharmaceuticals v. Tanning Research
- Pump, Inc. v. Collins Management
- Jane Ring v. Estee Lauder, Inc.

## **Speaking Engagements**

Frequent lecturer on issues concerning the Internet, domain names, right of publicity, fair use and licensing