

James D. Weinberger

Partner

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Overview

“I love helping clients solve their IP problems by looking at the commercial perspective. There’s sometimes a tendency to ‘silo’ our work, as though there were a strict division between copyright protection and trademark protection. But that’s not how the world works and how creative, intangible property appears in the marketplace. Seeing the big picture helps me work to craft practical, commercially viable solutions that clients want and need.”

James Weinberger is an accomplished litigator who excels at developing strategies to help clients protect, enforce, and manage their brands and copyrightable content. For clients including global and national brands, James advises on copyright, trademark, and trade dress infringement, as well as unfair competition, false advertising, trademark dilution, right of publicity, First Amendment, and internet-related matters.

Recognized by Chambers and other legal industry publications, James seeks remedies for clients

through federal and state court litigation, mediation, arbitration, administrative litigation in the Trademark Trial and Appeal Board, and Uniform Domain Name Dispute Resolution Policy proceedings in the World Intellectual Property Organization. He counsels clients on copyright and trademark enforcement strategy, execution, portfolio management, and clearance, and negotiates and drafts trademark and copyright licenses, coexistence and settlement agreements.

With clients including prominent entertainment properties, characters, and celebrities, James also represents both established and startup clients across diverse industries, including apparel, personal care products, beverages, cosmetics, financial and professional services, sports, pharmaceuticals, publishing, and software.

Representative Experience

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

- **1979 Family Trust Licensor, LLC v. Darji**, 1:19-cv-04389-VEC (S.D.N.Y.). Represented a

Rockefeller family trust and its licensee Rockefeller Capital Management in trademark infringement action against an individual making unauthorized use of ROCKEFELLER trademark and family name.

- **Colgate-Palmolive Co. v. PrevDent International BV**, 1:18-cv-09078-DLC (S.D.N.Y.). Represented Colgate-Palmolive Company in action enforcing its rights in its PREVDENT trademark against a manufacturer of toothpaste and related goods.
- **Chin v. The Gap, Inc.**, 1:18-cv-02158-DLC (S.D.N.Y.). Represented Gap in copyright infringement action involving images of dogs on clothing.
- **Colgate-Palmolive Co. v. Ranir, LLC**, 1:18-cv-02158-VEC (S.D.N.Y.). Represented Colgate-Palmolive Company in action enforcing its rights in its 360° trademark against a manufacturer of toothbrushes.
- **Ampac Enters., Inc. v. Force 3 Pro Gear, LLC**, 3:2018-cv-00314 (D. Ct.). Represented defendant in trade dress, design patent and false advertising lawsuit between competitors offering hockey-style baseball catcher helmets and masks.
- **Hasbro, Inc. v. DC Comics**, 1:17-cv-06558-LGS (S.D.N.Y.). Represented DC Comics and Warner Bros. Entertainment Inc. in action brought by Hasbro in which it claimed that its rights in the trademark BUMBLEBEE as used in connection with action figures from its TRANSFORMERS franchise were infringed by DC and Warner Bros.' use of BUMBLEBEE in connection with action figures of a character from their TEEN TITANS and DC SUPER HERO GIRLS properties.
- **Ferring Pharm. Inc. v. Serenity Pharm., LLC**, 1:17-cv-09922-CM (S.D.N.Y.). Represented Ferring Pharmaceuticals in connection with trademark claims based on its NOCDURNA product.
- **Warner Bros. Pictures v. Octane Film Cars, LLC**, 1:17-cv-04848-AT (S.D.N.Y.). Represent Warner Bros. Pictures in dispute over breach of contract suit involving provision of exotic car for use in *Ocean's 8*.
- **FameFlynet, Inc. v. AMC Networks Inc.**, 1:16-cv-07571-LAP (S.D.N.Y.). Represented AMC Networks and related entities in a copyright infringement action involving the alleged unauthorized use of celebrity photographs online.
- **WeWork Companies Inc. v. WE Labs, Inc.**, 2:16-cv-04637-GW-E (C.D. Cal.). Represented WeWork Companies Inc. in a trademark infringement action against WE Labs, Inc. of Long Beach, California.
- **Brookfield Office Properties Inc v. Manhattan West Hotel**, 1:16-cv-01854-VM (S.D.N.Y.). Represented Brookfield Office Properties Inc., owner and developer of the MANHATTAN WEST superblock in New York City, in a trademark infringement action against the Manhattan West Hotel.
- **Rockefeller & Co., Inc. v. Rockefeller Merchant Capital, LLC**, 1:15-cv-09227-VSB (S.D.N.Y.). Represented Rockefeller & Co. in trademark infringement action against company

making unauthorized use of ROCKEFELLER trademark and family name.

- **Industria de Diseno Textil, S.A. et al v. Zara Terez LLC**, 1:15-cv-05324-JPO (S.D.N.Y.). Represented defendant in trademark infringement action brought by apparel manufacturer and retailer ZARA.
- **T.R.B. International, S.A. v. Old Navy, LLC**, 1:15-cv-05675-PKC (S.D.N.Y.). Represented Old Navy in copyright infringement action brought by owner of Vilebrequin swimwear.
- **Whole Oats Enterprises v. Early Bird Foods & Co., Inc.**, 1:15-cv-1124-RMM-JO (E.D.N.Y.). Represented defendant granola producer in trademark infringement action brought by musical group Hall & Oates over use of HAULIN' OATS.
- **Thompson v. Kensington Publishing Corp.**, 1:14-cv-2949-CM (S.D.N.Y.). Represented defendant Kensington Publishing Corp. in copyright infringement litigation based on alleged unauthorized production of e-books under publishing agreement.
- **General Assembly Space, Inc. v. Fourth Wall Restaurants, LLC**, 1:14-cv-01163-GBD (S.D.N.Y.). Represented defendant restaurant in a trademark infringement action brought by a technology education company involving the name GENERAL ASSEMBLY.
- **Albert M. Watson Photography et al. v. Cao et al.**, No. 13 Civ. 02175 PAE (S.D.N.Y.). Represented artist David Datuna in copyright infringement action brought by photographer Albert Watson in connection with Datuna's alleged infringement of Watson's portrait of Steve Jobs in Datuna's visual installation Steve Jobs-Ayn Rand.
- **Screen Media Ventures, L.L.C. v. Castle Hill Productions, Inc. et al.**, No. 11 Civ. 0229 LTS (S.D.N.Y.). Represented defendant and impartial sublicensee Independent Film Channel in a breach of contract and copyright infringement suit between plaintiff licensor and co-defendant licensee over broadcast rights to certain films on client's television network.
- **Stark v. Banana Republic LLC**, No. 1:11-cv-01364 (N.D. Ill.). Represented defendant Banana Republic in copyright infringement action involving store window display designs.
- **Gemma Redux Inc. v. Banana Republic LLC**, No. 10 Civ. 03568 JSR (S.D.N.Y.). Represented defendant Banana Republic in copyright infringement action involving jewelry designs.
- **Gap, Inc. v. Murphy**, 3:10-cv-04354-EDL (N.D. Cal.). Represented plaintiff Gap in trademark infringement action against proprietor of GAPNOTE website and social media network.
- **Gap, Inc. v. Twin Tiger USA LLC**, 2:09-cv-09439-DSF-PLA (C.D. Cal.). Represented plaintiff Gap in trademark infringement action involving parallel imported jeans.
- **Nippon Menard Cosmetic Co. Ltd. v. Colgate-Palmolive Co.**, Case No. 2:2008cv04908 (D.N.J.). Represented Colgate-Palmolive Co. in a declaratory judgment action seeking to invalidate a 1983 settlement agreement and consent judgment resolving a prior trademark dispute between the parties. Obtained favorable settlement.

- ***Payne v. Anvil Knitwear, Inc.***, No. CV 06-8100 SVW SSX, 2007 WL 1953438 (C.D. Cal. June 27, 2007), *aff'd*, 293 Fed. Appx. 475 (9th Cir. 2008). Represented Anvil Knitwear, Inc. in a successful motion for summary judgment dismissing claims for copyright infringement in the U.S. District Court for the Central District of California. The Court granted Anvil's motion in its entirety and dismissed the case and awarded a substantial amount of attorneys' fees. The U.S. Court of Appeals for the Ninth Circuit affirmed the decision in its entirety.
- ***Kensington Publishing Corp. v. Gutierrez***, No. 05 Civ. 10529 LTS (S.D.N.Y.). Represented plaintiff Kensington Publishing Corp. in trademark infringement action against author involving the BAD BOYS series of romance novels.
- ***Alexander v. AOL Time Warner, Inc. et al.***, 132 Fed.Appx. 267 (11th Cir. 2005). Obtained summary judgment on collateral estoppel grounds for defendants Kensington Publishing Corp. and author and former DEA agent Jerry Speziale on claims brought by Paul Lir Alexander for invasion of privacy and violation of right of publicity by Speziale's inclusion of information about Alexander's role as a DEA informant in his book *Without a Badge*. The U.S. Court of Appeals for the Eleventh Circuit affirmed.
- ***Quiksilver Inc. v. Quick Sports International BV et al.***, 8:03-cv-01548-DOC-AN (C.D. Cal.). Represented defendants Quick Sports International, a well-known Dutch soccer brand, along with its principals, in connection with a trademark infringement lawsuit brought by plaintiff Quiksilver.

- ***Alberto-Culver Co. v. E. Sunwoo Inc. et al.***, 2:03-cv-08357-GPS-SS (C.D. Cal.). Represented defendants in trademark infringement action involving plaintiff Alberto-Culver's VO5 mark.

Education

Columbia Law School (JD, 1999)

Harlan Fiske Stone Scholar

Carroll G. Harper Prize

Editor-in-Chief, *Columbia-VLA Journal of Law & the Arts*

Wesleyan University (BA, *with honors*, 1996)

Admissions

Bar Admissions

New York

Court Admissions

U.S. Court of Appeals, 11th Circuit

U.S. Supreme Court

New York, Appellate Division (1st Dep't)

U.S. Court of Appeals, 3rd Circuit

U.S. Court of Appeals, 2nd Circuit

U.S. Court of Appeals, 9th Circuit

U.S. District Court, Eastern, New York

U.S. District Court, Southern, New York

U.S. District Court, Northern, Illinois

Focus

- Sports

- Food & Beverage
- Publishing
- Professional Services
- Startup & Emerging Growth
- Personal Care & Cosmetics
- Entertainment Properties
- Fashion
- Celebrities, Bands & Athletes
- Pharmaceuticals

Services

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

Associations

International Trademark Association (INTA)
(Member, Famous and Well-Known Marks Committee, 2020-21; Judicial Administration and Trademark Litigation Subcommittee, 2014-15; Member, Discovery Practices & Procedures Subcommittee of the Enforcement Committee, 2012-13, 2008-2009)

Pharmaceutical Trade Marks Group (PTMG)
(Associate Member)

Federal Bar Council (Member, Intellectual Property Committee)

American Bar Association (Member, Intellectual Property Law Section)

New York State Bar Association (Member, Intellectual Property Law Section)

Columbia Law School Association (Director, 2010-2015)

Recognition

- *Chambers USA*, 2010-2021
- *Legal 500*, 2011-2019
- *Managing Intellectual Property* IP STARS, 2014-2021
- *Who's Who Legal: Trademarks*, 2017-2018; *Global Leader - Trademarks*, 2019-2020
- *World Trademark Review's* WTR 1000, 2017-2021 in the areas of copyright and trademark law "*James is simply one of the best, most efficient and creative trademark lawyers you could have the privilege of connecting with.*"
- *The Best Lawyers in America*© 2021
- *World Intellectual Property Review* Leader, 2017-2020
- *Expert Guides: World's Leading Trade Mark Lawyers*, 2014-2018
- *Super Lawyers*® New York, 2013-2021
- *Super Lawyers*® New York Metro Rising Stars, 2011-2012

Decisions

- Garan Inc. & Garan Services Corp. v. Manimal, LLC
- Asuragen, Inc. v. Accuragen, Inc.
- DC Comics v. Towle
- Athleta, Inc. v. Pitbull Clothing Co.
- Jumbo Bright Trading Limited v. The Gap, Inc.
- Jackson v. Booker
- DC Comics v. Oliveri
- Hits From the Bong, Inc. v. Javen Mitchell
- Athleta, Inc. v. David Sales
- DC Comics v. Beling
- DC Comics v. Mad Engine, Inc.
- DC Comics v. Gotham City Networking, Inc.
- Fooley v. Gap
- McNeil-PPC, Inc. v. Walgreen Co.
- Lopez v. Gap, Inc.
- Frank Sinatra Enters., LLC v. Loizon
- Superman Copyright Termination Litigation
- Alexander v. AOL Time Warner, Inc.
- M&G Elecs. Sales Corp. v. Sony Kabushiki Kaishi
- Echo Design Group, Inc. v. Zino Davidoff S.A.
- Glow Indus., Inc. v. Lopez

Speaking Engagements

- *Brand Authenticity: Reacting to Social Movements Quickly and Appropriately*, INTA

Annual Meeting & Leadership Meeting (moderator), November 2020

- *Strategic Partnering with In-House Trademark Counsel*, IPO Annual Meeting (panelist), San Francisco, CA 2017
- *POW! BOFF! THWACK! What DC Comics v. Towle Means for Copyright Character Protection*, Los Angeles Copyright Society, February 2016
- *Holy Copyright Law! The Batmobile Case and Licensing Fictional Characters, Derivatives and Products*, American Bar Association (panelist), December 2015
- *Product Trade Dress and Non-Traditional Trade Marks - Update from the US*, PTMG Spring Conference (panelist), Barcelona, Spain, 2012
- *Understanding the Use-Based Trademark System in the US*, Managing Intellectual Property China-International IP Forum, Beijing, PRC, 2011
- *A Conversation Between Brand Owners, Retailers and Manufacturers About Private Label in the United States*, INTA Annual Meeting (panelist), San Francisco, CA, 2011
- *Discovery Practice, Procedure and Strategy, Navigating Trademark Practice Before the PTO 2007: From Filing Through the TTAB Hearing*, Practising Law Institute
- Columbia-VLA Clinical Seminar in Law and the Arts, Guest Instructor, Columbia Law School, 2006-2012