

Jason D. Jones

Partner

212.813.8279

jjones@fzlz.com



Overview

“Over the years, I have represented clients on all sides of intellectual property matters – sometimes I act on behalf of the plaintiff while other times I represent the defendant. Knowing what’s important to both sides enables me to better craft creative litigation strategies that can lead to a negotiated resolution or a successful litigation outcome.”

Jason Jones counsels clients and litigates matters relating to copyright, trademark, unfair competition, false advertising, design patent, and related commercial matters. He also negotiates trademark and copyright licenses, as well as coexistence and settlement agreements.

Jason’s litigation experience includes federal trial and appellate courts, as well as state courts and the USPTO’s Trademark Trial and Appeal Board, representing clients across diverse industries, including publishing, fashion, cosmetics, entertainment, pharmaceuticals, consumer products, automotive, and insurance. He also is an

adjunct professor at New York Law School, where he teaches a seminar on litigating intellectual property cases.

Prior to joining Fross Zelnick, Jason was an associate in the litigation department of large international law firm.

Representative Experience

- ***UMG Recordings, Inc. v. Siggys Music, Inc.*** -- After a seven-year battle before the Trademark Trial and Appeal Board of the U.S. Patent & Trademark Office, prevailed on behalf of client UMG Recordings, Inc. (“UMG”)—owner of the JACKSON 5 trademark—in its challenge to an attempt to register the mark J5 for clothing and related merchandise by Siggys Music, Inc., a company owned by original Jackson 5 musical group member Sigmund Esco “Jackie” Jackson. In a lengthy decision dated July 19, 2018, the Board confirmed that UMG, as successor to Motown Records, owned the JACKSON 5 trademark as well as its functional equivalents, including the short form J5. It further held that

UMG's JACKSON 5 trademark is "famous" and "commercially strong" and that Siggy Music's use and registration of J5 would likely cause confusion in the marketplace.

- ***Hoop Culture, Inc. v. The Gap, Inc.*** Following an evidentiary hearing, on behalf of client The Gap, Inc. and its Old Navy brand, was successful in defeating a motion for a preliminary injunction brought by plaintiff Hoop Culture, Inc. over its alleged EAT...SLEEP...BALL. trademark. The U.S. District Court for the Middle District of Florida held that the plaintiff did not show a substantial likelihood of success on the merits of its claims on either ownership of a valid mark - despite the fact that it had a federal registration - or likelihood of confusion. The Court also held that plaintiff failed to establish the requisite irreparable injury. This decision was affirmed by the U.S. Court of Appeals for the Eleventh Circuit.
- ***Institute for the Development of Earth Awareness v. People for the Ethical Treatment of Animals.*** Obtained summary judgment in favor of client, People for the Ethical Treatment of Animals ("PETA"), dismissing copyright infringement claim brought against PETA in the U.S. District Court for the Southern District of New York on basis of alleged use in PETA animal rights campaign of historical facts and not-new idea of comparing mistreatment of slaves in 19th century America to mistreatment of animals today.
- ***Perfetti Van Melle USA v. Cadbury Adams USA LLC.*** On behalf of client Cadbury Adams USA LLC--maker of the famous DENTYNE brand of chewing gum-- defeated a motion for a preliminary injunction brought by plaintiff which sought to block the launch of Cadbury's new breath purifying gum, DENTYNE PURE, on the grounds that the name DENTYNE PURE was confusingly similar to plaintiffs' MENTOS PURE FRESH and MENTOS PURE WHITE names used for chewing gum.
- ***Body Wisdom Media, Inc. v. Athleta, Inc.*** Successfully defeated a motion for a preliminary injunction motion on behalf of client Athleta, Inc., a leading retailer of women's performance apparel and gear and part of The Gap, Inc.'s portfolio of companies. Plaintiff Body Wisdom Media, Inc. sought a preliminary injunction to stop Athleta's use of a pinwheel design as a logo, alleging likelihood of confusion with Body Wisdom's own pinwheel design logo used in connection with fitness DVDs. Athleta had adopted the challenged pinwheel logo seven years prior and had used it across its business since that time. The U.S. District Court in Maryland denied Body Wisdom's motion, ruling that Body Wisdom was not likely to succeed on the merits of its infringement claim, because, inter alia, the parties' goods are different and had coexisted under the respective marks without confusion for a number of years. The court also held that any injunction would harm Athleta, which uses the challenged pinwheel design across its entire business.
- ***Frank Sinatra Enterprises, LLC v. Loizon.*** Successfully represented our client, Frank Sinatra Enterprises, LLC, which holds the exclusive right to commercially exploit Mr. Sinatra's name and likeness, in its challenge before the Trademark Trial and Appeal Board of

the U.S. Patent and Trademark Office to Michigan-based caterer Bill Loizon's attempt to register the mark FRANKS ANATRA in connection with his catering business.

Education

University of Texas School of Law (JD, 2004)

Order of the Coif

Hendrix College (BA, *cum laude with distinction*, 2000)

Admissions

Bar Admissions

New York

Court Admissions

U.S. Court of Appeals, 11th Circuit

U.S. Court of Appeals, Federal Circuit

U.S. Court of Appeals, 2nd Circuit

U.S. District Court, Eastern, New York

U.S. District Court, Southern, New York

Focus

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

Services

- Trademark
- Litigation

Associations

Federal Bar Council (Vice-chair, Intellectual Property Committee, 2014-present)

New York State Bar Association (Member, Intellectual Property Law Committee, 2016-present)

New York Law School (Adjunct Professor, 2015 to present)

Recognition

Super Lawyers® 2019-20

Super Lawyers® Rising Stars 2012 - 2018

Decisions

- Robert Kirkman, LLC v. The Toking Dead
- Retrobrands USA LLC v. Intercontinental Great Brands, LLC
- UMG Recordings, Inc. v. Siggys Music, Inc.
- Asuragen, Inc. v. Accuragen, Inc.
- Hoop Culture, Inc. v. The Gap, Inc.
- Body Wisdom Media, Inc. v. Athleta, Inc.
- Frank Sinatra Enters., LLC v. Loizon
- Clinique Laboratories LLC v. Absolute Dental, LLC
- Institute for the Development of Earth Awareness v. People for the Ethical Treatment of Animals



- Perfetti Van Melle USA v. Cadbury Adams USA LLC
- Revelations Perfume v. Prince Rogers Nelson

Publications

International Comparative Legal Guide to Copyright 2020, contributed the U.S. chapter with David Donahue

International Comparative Legal Guide to Copyright 2019, contributed the U.S. chapter with David Donahue

Supreme Court Rules on TTAB Preclusion, Managing IP, co-author with David Donahue, May 2015

Clerkship

Law Clerk to the Hon. Vaughn R. Walker, Chief Judge, U. S. District Court for the Northern District of California (2004-2005)