

John P. Margiotta

Partner

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Overview

“The part of my job that I like best is becoming familiar with the businesses that I represent, learning what the business objectives are, the risk tolerance and budgets, and tailoring my advice so that each client has the program and strategy that works best for its needs. I have more than twenty years’ experience working with clients to maximize the effectiveness of their IP strategies.”

John Margiotta’s practice is broadly focused on both contentious and non-contentious matters relating to intellectual property. He advises, litigates, mediates, and arbitrates in the areas of copyright, trademark and trade dress infringement, design patent, anti-counterfeiting, unfair competition, false advertising, trademark dilution, breach of contract, right of publicity, First Amendment, and internet-related matters. Though John practices across many industries, the majority of his clients are in the luxury fashion, watch, and jewelry industries, and he has specialized knowledge in those areas.

Recognized by leading legal industry publications, John appears in federal district and appellate courts across the country, and before the USPTO’s Trademark Trial and Appeal Board, acting on behalf of plaintiffs and defendants alike. He also appears in domain-name recovery cases before the World Intellectual Property Organization.

On the non-contentious side, John negotiates and drafts a wide range of commercial agreements, including vendor agreements, celebrity endorsement contracts, appearance contracts, personal services contracts, apparel and consumer goods licenses, transfer and assignments of rights agreements, commissioned art and author-publisher agreements, software and SAS licenses, sponsorship agreements, dealer and distribution agreements, and trademark coexistence agreements.

John regularly advises clients on trademark clearance and registration issues, gray goods enforcement, copyright registration and protection, trademark and anti-counterfeiting enforcement strategies, as well as international portfolio

management. He works with clients spanning a wide range of industries, including luxury brands, watches, jewelry, shoes, apparel, wine and liquor, banking, auditing, consulting, entertainment, cosmetics, pharmaceuticals, facilities management services, publishing, and software.

Representative Experience

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

Federal Court Cases:

- ***The P.O.D. Partnership, et al. v. Leonarist Johnson***, Civ. No. 02-CV-0357 (LAB) (S.D. Cal.). On behalf of band The P.O.D. obtained permanent injunction and award of fees against defendant for his use of the mark P.O.D. in connection with providing musical services.
- ***Chanel, Inc. v. Nichols***, Case No. C 02-5536 (N.D. Cal.). Obtained consent judgment against defendant ordering transfer of a variety of Chanel-inclusive domain names to Chanel, Inc.
- ***NBTY, Inc. v. USA Nutritionals, Inc. and Action Labs, Inc.***, 02 Civ. 1685 (E.D.N.Y.). Successfully represented defendants sued for alleged trademark infringement of the U.S. NUTRITION mark used in connection with vitamins and nutritional supplements based on their use of the mark USA NUTRITIONALS for vitamin and nutritional supplements.
- ***Forbes Inc. v. Best of Boulder, Inc.***, Civ. No. 01 CV 1214 (S.D.N.Y.). Obtained consent judgment against defendants who had made and sold without permission plaques and other

awards commemorating companies' appearances in Forbes published rankings.

- ***Bliss Salon Day Spa. v. Bliss World, LLC***, 268 F.3d 494 (7th Cir. Ill. 2001). Successfully defeated plaintiff's preliminary injunction motion based on its rights in the BLISS mark for day spas and Bliss World's use of the identical mark on identical services.
- ***Moss v. Gryphon Development, Inc.***, Case No. SA CV00-347 AHS (C.D. Cal.). On behalf of defendant Sears, Roebuck & Co., successfully defended suit brought to enjoin its use of the mark TIME OUT for beauty products; also obtained award of legal fees.

Trademark Trial and Appeal Board Cases

- ***Anvil Knitwear, Inc. v. Success Ware Inc.***, Opp. No. 91117782 and Canc. No. 92030393 (T.T.A.B. 2004). Successfully cancelled Success Ware, Inc.'s registration for SUCCESS WARE SPORTWEAR and Design (an anvil) and opposed Success Ware's attempt to register an anvil design for clothing based on Anvil Knitwear, Inc.'s prior rights in the anvil word mark and an anvil design mark.
- ***Gillette Canada Co. v. Kivy Corp.***, Opp. No. 91116804, 2003 WL 203123 (T.T.A.B. Jan. 29, 2003). Successfully opposed Kivy Corporation's attempt to register ORAL MAGIC for toothbrushes based on Gillette's rights in the ORAL-B mark.

World Intellectual Property Organization Cases

- ***Avon Products, Inc. v. Lee***, WIPO Case No. D2001-0272 (June 6, 2001). Obtained an order transferring to complainant the domain name AVONKOREA.COM that had been used by a

Japanese representative of Avon in connection with a web site selling Avon and other beauty care products.

- **ADT Services AG v. ADTSUCKS.COM**, WIPO Case No. D2001-0213 (Apr. 26, 2001). Obtained an order transferring the domain name ADTSUCKS.COM to ADT Services AG.
- **Deloitte Touche Tohmatsu v. Thorp**, Case No. D2001-1431 (Jan. 31, 2001). Obtained an order transferring the domain name deloittetouche.net to Deloitte Touche Tohmatsu from one of its current employees.
- **Veuve Clicquot Ponsardin Maison Fondée en 1772 v. Intercosma SA**, WIPO Case No. D2000-0469 (July 20, 2000). Obtained an order transferring the domain names VEUVECLICQUOT.COM and .NET to complainant.
- **Veuve Clicquot Ponsardin Maison Fondée en 1772 v. Polygenix Group Co.**, WIPO Case No. D2000-0163 (May 9, 2000). Obtained an order transferring the domain name VEUVECLICQUOT.ORG to complainant.

Education

Columbia University School of Journalism (MS, 1997)

Harvard Law School (JD, *cum laude*, 1996)

College of the Holy Cross (AB, *with honors*, 1993)

Admissions

Bar Admissions

New York

Court Admissions

U.S. Court of Appeals, 11th Circuit

U.S. Court of Appeals, 7th Circuit

U.S. Court of Appeals, 9th Circuit

U.S. District Court, Eastern, New York

U.S. District Court, Southern, New York

Focus

- Jewelry & Watches
- Fashion
- Publishing

Services

- Trademark
- Litigation

Recognition

World Trademark Review's WTR 1000 2020-21, "Versatility is the watchword of Margiotta, who can take care of the total needs of clients thanks to specialization not just in trademarks, but also in copyright, trade dress, design patent, anti-counterfeiting, unfair competition and false advertising law."

Best Lawyers - Copyright Law 2018-2021

Chambers USA 2009-2015

Legal 500 2011-2015

Managing Intellectual Property IP Stars 2014-20

Super Lawyers® New York Metro Rising Stars 2011

Super Lawyers® 2012-2020



World Trademark Review's WTR 1000 2016
(handles counterfeiting work "exceedingly well")

Decisions

- Saleh v. Sulka Trading Ltd., et al.
- Cartier International AG v. Coachman
- Solid 21, Inc. v. Hublot of America
- Kam Hing Enters., Inc. v. Wal-Mart Stores, Inc.
- Polar Bear Productions, Inc. v. Timex Corp.
- Palm Bay Imports, Inc. v. Veuve Clicquot
Ponsardin Maison Fondée en 1772
- Wyeth v. Fempro, Inc.