

# Trademark

**Fross Zelnick is the gold standard of trademark firms in the United States. With our 50-year history, there is likely no trademark issue that we have not handled – in the U.S. or around the world. Because of our known strengths and comprehensive experience, other law firms frequently seek our advice on unique or hard-to-handle U.S. and international issues. Our lawyers who represent clients around the world are so knowledgeable in the laws of many foreign countries that, uniquely, we often can provide initial opinions without consulting foreign trademark attorneys or agents.**

We counsel U.S. and international clients – ranging from individuals to startups to companies valued at billions of dollars – on the best strategies to clear their trademarks for U.S. and worldwide use. We secure, protect, and enforce these rights, and manage large U.S. and global trademark portfolios for top brand owners across industries, including in the cosmetics, apparel, luxury goods, housewares, toys, retail services, consumer products, technology, publishing, financial, hospitality, pharmaceutical, real estate, food, beverage, hotel, and entertainment industries.

## **Strengths that Matter to our Clients**

**Selection – TM Search and Clearance** – Clients benefit from our ability to recommend the quickest and most cost-effective search process, tailored to the nature of the mark and goods or services concerned, the countries of interest and the client's budget. Our decades of experience enable us to give clients clear and succinct advice based on sophisticated risk evaluations and to carefully distinguish between infringement risk (availability of a mark for use) and possible barriers to obtaining registration. We investigate potentially problematic third-party marks to determine whether they truly pose a significant risk or justify the expense in attempting to overcome them. For international trademarks, clients derive a strategic benefit from our deep knowledge of – and experience with – relevant international treaties and systems, including the Paris Convention, the Madrid Agreement and Madrid Protocol IR registration system, the Community Trade Mark system of the European Union, the TRIPS Agreement, the Andean Pact and more. Lawyers in our international practice also direct foreign counsel on overcoming office actions and refusals, taking a consistent approach to similar issues as they arise in different countries – this is much better for our clients. In doing so, our understanding of

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laws governing various international jurisdictions helps to ensure that action is not taken for success in one country that would put clients' rights at risk elsewhere.

**Adoption – TM Registration** – We are particularly successful at overcoming blocking citations of prior marks and we take great care to identify inherent registrability or weakness issues that may undermine registration or enforcement, or increase the long-term costs associated with securing registrations for a proposed mark. The goal is to ensure that there are no surprises after a mark is adopted – in the U.S. or internationally – at both the use and registration levels, and as to enforcement. We maintain an extensive database of responses to Office Actions which saves clients precious time and money.

**Protection – TM Enforcement and Defense** – We manage U.S. and global enforcement programs for some of the world's most iconic trademarks, by establishing appropriate watch services and evaluating third-party marks for which an opposition or cancellation action appears warranted – and distinguishing between serious encroachments, which may affect revenues, and more technical "maintenance" enforcement. When necessary, we implement sophisticated enforcement programs – including multi-jurisdictional international programs – to prevent the importation, sale and distribution of infringing or counterfeit products. Our [Litigation](#) team steps in when matters escalate to court.

**Portfolio Management – TM Maintenance, Recordals and Renewals** – Fross Zelnick's proprietary trademark filing and prosecution database is constantly updated with the filing requirements of every jurisdiction in the world where trademark protection is possible. In the U.S., where there are strict use requirements, we take great care to ensure that maintenance of filings reflect the current status of use or excusable non-use. Because of these capabilities and the broad knowledge of Fross Zelnick lawyers, in-house legal teams often prefer that we carry out their filing programs through registration, recordals and renewals.

**[Transactions](#) and Growth – Brand Licensing and M&A** – We help to achieve the business goals of our clients by negotiating and drafting purchase, licensing, consent and coexistence agreements. We also provide critical guidance for clients to protect IP assets in the context of diverse business transactions, from advising on branding and licensing strategies to conducting due diligence in connection with an acquisition or divestiture – often working with traditional M&A law firms who appreciate our special abilities in this area. Upon completion of these transactions, we record them in the appropriate IP offices around the world.

Representative experience includes:

- Among our more noteworthy registrations are the Red Sole for Christian Louboutin shoes, the TARZAN Yell for toys (among other things), the TIFFANY Blue Color and the TIFFANY Blue Box.
- We advised on the trademark issues in an international joint venture transaction in which the lead lawyers for the transaction had developed representations and warranties for our client's trademarks which were ambiguous, prone to unnecessary risk, and which failed to take account of different trademark regimes in the U.S. and multiple foreign countries. Fross Zelnick's lead trademark lawyer led a call with 20 other lawyers to explain how all of the trademarks worked. With this solid background and detail to guide them, there were no further arguments and the \$100 million deal closed.
- For one of our pharmaceutical clients that was negotiating a joint venture, we searched 100 marks in 50+ countries in three weeks. We know how to uncover where the problems and what the issues are; we know precisely where to look and how to look so we can do it efficiently. We learned that outside counsel for the other company had charged its client ten times more for its work.

## Decisions

Robert Kirkman, LLC v. The Toking Dead

Retrobrands USA LLC v. Intercontinental Great Brands, LLC

Saleh v. Sulka Trading Ltd., et al.

Three Thirteen Licensing, LLC v. Marshall B. Mathers III

Garan Inc. & Garan Services Corp. v. Manimal, LLC

Old Navy (Apparel), LLC v. Blissman

UMG Recordings, Inc. v. Siggy Music, Inc.

Royal Crown Co. v. Coca-Cola Co.

Asuragen, Inc. v. Accuragen, Inc.

Cartier International AG v. Coachman

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Hoop Culture, Inc. v. The Gap, Inc.

Dr Pepper/Seven Up, Inc. v. Krush Global Limited

Chanel, Inc. v. Camacho & Camacho LLP

JR Tobacco of America, Inc. v. Davidoff of Geneva (CT), Inc.

Tri-Star Pictures, Inc. v. Unger

Market Corner Realty Assoc's, LLC v. CGM-GH LLC

Movado Corp. v. Global Computer Corp.

Lane Capital Mgmt. Inc. v. Lane Capital Mgmt. Inc.

Creative Arts by Calloway, LLC v. Brooks

Perfetti Van Melle USA v. Cadbury Adams USA LLC

Hormel Foods Corp. v. Jim Henson Productions, Inc.

Henri Bendel, Inc. v. Sears, Roebuck and Co.

Buffett v. Cheeseburger in Paradise, Inc.

Carvel Corp. v. The Ice Cream Bakery, Inc.

Citizen Watch Co. of Am. v. BJ's Wholesale Club

EFS Marketing, Inc. v. Russ Berrie & Co.

Times Mirror Magazines, Inc. v. Field & Stream Licenses Co.

Glow Indus., Inc. v. Lopez

Echo Design Group, Inc. v. Zino Davidoff S.A.

M&G Elecs. Sales Corp. v. Sony Kabushiki Kaishi

Swatch Group (U.S.) Inc. v. Movado Corp.

American First Run Studios v. Edgar Rice Burroughs, Inc.

Wyeth v. Fempro, Inc.

DC Comics v. Kryptonite Corp.

Nabisco Brands, Inc. v. Conusa Corp.

Rolls-Royce Motors Ltd. v. Custom Cloud Motors, Inc.

Rolls-Royce Motors v. A.&A. Fiberglass, Inc.

DC Comics v. Powers

Warner Bros., Inc. v. Gay Toys, Inc.

Inwood Laboratories v. Ives Laboratories

DC Comics, Inc. v. Filimation Associates, Inc.

Harper & Row Publishers, Inc. v. Nation Enterprises, Inc.

Maher & Maher, Inc. v. Unisonic Products Corp.

Fruit-Ices Corp. v. Coolbrands Int'l, Inc.

American Express Co. v. Vibra Approved Labs Corp.

Pump, Inc. v. Collins Management

Sun Pharmaceuticals v. Tanning Research

Kenner Parker Toys Inc. v. Rose Art Indus., Inc.

Schieffelin & Co. v. Jack Co. of Boca Inc.

Anheuser-Busch, Inc. v. Balducci

Financial Matters v. PepsiCo, Inc.

Novus Group, Inc. v. Dean Witter, Discover & Co.

Luv N'Care, Ltd. v. Babelito, S.A.

Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772

Tea Board of India v. Republic of Tea, Inc.

De Beers LV Trademark Ltd. v. DeBeers Diamond Syndicate, Inc.

Overbeck Corp. v. Overbeck GmbH

Entrepreneur Media, Inc. v. EYGN Ltd.

UMG Recordings, Inc. v. O'Rourke

DC Comics v. Oliveri

Lacoste Alligator S.A. v. Maxoly, Inc.

Lion Capital LLP v. Stone Lion Capital Partners L.P.

Missing Cougar Co. v. Edgar Rice Burroughs, Inc.

Rodan & Fields, LLC v. Estee Lauder Cos.

Clinique Laboratories LLC v. Absolute Dental, LLC

Lopez v. Gap, Inc.

Inter-IKEA Systems B.V. v. Arsen Manasyan

Frank Sinatra Enters., LLC v. Loizon

Jumbo Bright Trading Limited v. The Gap, Inc.

Athleta, Inc. v. Pitbull Clothing Co.

McNeil-PPC, Inc. v. Walgreen Co.

Volvo Trademark Holding AB v. Hebei Aulion Heavy Indus. Co.

Cabot Company Limited d/b/a Cabot Watch Company v. Combat Watch Company, LLC

Kraft Foods Group Brands LLC v. Cracker Barrel Old Country Store, Inc.

Body Wisdom Media, Inc. v. Athleta, Inc.

Inter-IKEA Systems B.V. v. Akea, LLC

Chanel, Inc. v. Makarczyk

Solid 21, Inc. v. Hublot of America

DC Comics v. Gotham City Networking, Inc.

DC Comics v. Mad Engine, Inc.

Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.

DC Comics v. Towle

DC Comics v. Beling

Athleta, Inc. v. David Sales

Hits From the Bong, Inc. v. Javen Mitchell