



Debevoise
& Plimpton

Intellectual Property

Recognized Leaders

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BUSSES ONLY



ONE WAY



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“Intellectual Property Law Firm of the Year”

—*Chambers USA Awards 2022*

Band 1 firm for Intellectual Property: Trademark,
Copyright & Trade Secrets in the United States.

—*Chambers USA*

“Top-class practice with a sophisticated
focus on the most complex copyright,
trademark and false advertising matters.”

—*Chambers USA*

Top tier for Trademarks: Litigation.

—*The Legal 500 US*

Named “Trademark Contentious Firm
of the Year” and awarded “Impact Case
of the Year” for US Supreme Court
representation of Booking.com

—*Managing IP*, 2020

“Debevoise & Plimpton operates at the apex of
the branding market”

—*World Trademark Review*

“One of the finest law firms in the country”

—*The Legal 500 US*

2020 Intellectual Property Practice Group of the Year

—*Law360*

A Formidable Presence in Intellectual Property

Debevoise & Plimpton has one of the nation's leading Intellectual Property practices.

Our team has developed a stellar reputation for handling the most difficult cutting-edge cases, transactions and counseling projects in trademark, copyright, advertising, right of publicity, privacy, technology, design and utility patents, and related matters. We not only litigate leading cases around the country, but we also are thought leaders, teaching and writing on intellectual property law, advocating for regulatory and legislative improvements in the law, and promoting efficient alternative dispute resolution mechanisms for intellectual property cases.

Our teams help clients win: achieving courtroom victories and efficient, business-friendly solutions to novel legal challenges across a wide range of industries, including automotive, broadcast television, consumer products, cosmetics, coworking, entertainment, fashion, financial services, food and beverage, healthcare, insurance, Internet, luxury goods, motion pictures, pharmaceuticals, professional sports, publishing, recorded music, retail, technology, travel, telecommunications, and wines and spirits.

Clients benefit from lean, highly experienced and expert teams that offer thorough analysis of the law, refined to its most practical application.

Finding the right business answer is always the priority.

Trademark & Unfair Competition

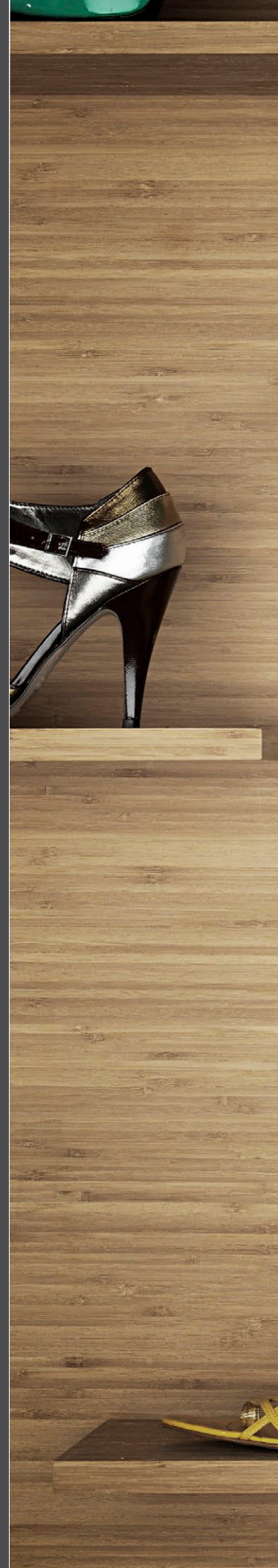
“The firm that I want as my top-notch litigation counsel and partner in a trademark infringement suit”

Our team, led by David H. Bernstein and Megan Bannigan, protects the world's highest-profile brands in complex trademark disputes around the globe.

We have extensive experience litigating the most difficult trademark, trade dress, unfair competition, and anti-counterfeiting cases, including both obtaining and defending against temporary restraining orders and preliminary injunctions, and at trials that often are conducted in expedited time frames. We examine all available arguments and defenses, including invalidity of marks, likelihood of confusion and/or dilution, fair use, functionality, crowded fields, First Amendment, fraud, and the equitable defenses of laches, unclean hands, and estoppel. We also have unique knowledge related to the design, supervision and critique of consumer perception surveys, which often play a vital role in trademark, trade dress and advertising cases, having been involved in the design or critique of hundreds of surveys conducted by dozens of the nation's leading survey experts. We represent clients in state and federal courts - up to the Supreme Courts - and before the Patent and Trademark Office, Trademark Trial and Appeal Board, International Trade Commission, and domestic and international arbitral tribunals.

Our team prides itself on its deep knowledge of our clients' industries and businesses. When it suits the client's objectives, we work to find creative solutions well before trial. But we are trial lawyers first, always ready to win in court.

In addition to our litigation experience, we regularly advise clients in the clearance of rights and the selection, development, acquisition, registration, and protection of trademarks, trade dress, and trade names.



Booking.com

We were co-counsel to Booking.com in an 8-1 U.S. Supreme Court victory holding that Booking.com could register its eponymous domain name, BOOKING.COM, as a trademark. The decision validated the reality that millions of consumers already recognize BOOKING.COM as a valuable brand in the market and paved the way for protecting many other marks that would have been in jeopardy from an adverse ruling.



In a case that was vigorously tried both in the court of law and at the court of public opinion, we successfully defended Yves Saint Laurent's right to produce red shoes by defeating a motion for a preliminary injunction filed by Christian Louboutin, which held a U.S. trademark registration for use of a red sole on women's high-heeled shoes. We successfully defended that victory on appeal, winning a complete dismissal from the U.S. Court of Appeals for the Second Circuit, and then prevailed in a subsequent proceeding in the Trademark Office where we obtained a critical limitation to the Louboutin trademark registration.



We represented Costco Wholesale Corp. before the U.S. Court of Appeals for the Second Circuit in successfully overturning the lower court's summary judgment decision that it counterfeited and willfully infringed Tiffany & Co.'s TIFFANY trademark for diamond engagement rings. In addition to obtaining reversal of the liability findings, we also obtained reversal of more than \$25 million in damages and attorneys' fees. The case was remanded for a new trial, and was subsequently resolved amicably.



MSCHF Product Studio, Inc.

We represented MSCHF Product Studio, Inc. – a provocative Brooklyn art collective – in a high-profile dispute with Nike regarding MSCHF's "Satan Shoes" – customized Nike Air Max 97 sneakers, featuring Satan-related iconography and drops of human blood and designed in collaboration with rapper Lil Nas X. Nike sued MSCHF for trademark infringement and dilution, but the judge recognized that "rights of artistic expression are paramount" and declined to order a recall of the 665 shoes MSCHF had already shipped to customers. MSCHF's artistic message having been amplified by the suit and its shoes having been sold, we negotiated a favorable settlement with Nike.



Following a five-day trial, Debevoise won a decisive verdict for Kate Spade & Co. which ensured its right to use the trademark Kate Spade Saturday despite a challenge from Saturdays Surf, a popular clothing line that claimed the exclusive right to use SATURDAY in connection with clothing.



In a series of litigations over a decade that included a multiday evidentiary hearing focused on the complexities of Soviet and Russian law, dismissals by two different district judges, two appeals to the Second Circuit, and a petition for certiorari to the Supreme Court, Debevoise achieved a complete victory for our client Pernod Ricard in obtaining dismissal of ownership claims filed by a Russian Federation entity related to the Stolichnaya trademark. While a third appeal was pending, Debevoise negotiated a highly-favorable resolution that permanently removed our client from any future claims related to this ongoing dispute.



We represented NBCUniversal, Rory McIlroy and their affiliates in a trademark and antitrust lawsuit arising out of their use of the name GOLFPASS. After securing dismissal of all of the claims against McIlroy and the antitrust claims against NBCU, the matter was settled confidentially on terms very favorable to NBCU.



We negotiated a highly successful global resolution for our client, WeWork, in a multi-jurisdictional trademark dispute against a global coworking rival which launched in the U.S. market under the confusingly similar name UrWork. On the eve of a preliminary injunction hearing, we secured a highly favorable, confidential settlement agreement. UrWork has since announced that it changed its name globally to UCommune.

David Bernstein is a "rockstar," "just incredible in terms of strategic planning" and "indisputably one of the very best trademark lawyers in the country."



Copyright

“Debevoise has built an outstanding reputation as a heavyweight in copyright litigation.”

Our copyright practice, led by Megan Bannigan, spans our litigation (including enforcement and defense), licensing, corporate and counseling practices. We offer full-service protection for clients that are seeking to build, enhance, and defend the value of their copyright assets, as well as clients that use copyrighted materials. Our lawyers work both on enforcing copyrights and on cutting-edge litigation at the intersection of copyrights and technology. We have played a significant role in seminal copyright cases, including before the United States Supreme Court, and regularly advise clients on a wide range of matters, including the acquisition and licensing of copyrighted materials, publishing and development agreements, technological and product developments and issues of fair use and the application of the Digital Millennium Copyright Act.

We cover the full spectrum of copyright matters in the content development, retail, technology and not-for-profit sectors, including motion pictures, television, visual art, music, literature, computer software, packaging and fashion design.



We represented NBC Universal, CBS Broadcasting and Disney/ABC in precedent-setting copyright litigation involving the public performance right, in successfully challenging Aereo's unauthorized streaming of broadcast television programs over the internet using thumbnail-sized antennas. We helped secure an ultimate victory for our clients at the U.S. Supreme Court, which held that Aereo's service was infringing. *The New York Times* dubbed the case one that "will shape TV's future."



We represented five major U.S. book publishers in bringing a copyright infringement action challenging Google's mass digitization of books from U.S. libraries into its Google Library Project, making them searchable and offering users "snippets" of the books. We negotiated a widely-publicized settlement agreement that would have established new business models among publishers, authors and Google. Although that landmark class action settlement agreement ultimately was not approved by the court, we subsequently negotiated a successful settlement for our clients.



We were retained by Costco Wholesale to represent it before the United States Court of Appeals for the Ninth Circuit in long-running copyright litigation asserting that it was infringing Swiss watchmaker Omega SA's copyright in a tiny globe design engraving on the back of the watches that Costco had bought on the "gray market" and was selling in the U.S. We were successful in the appellate court affirming the district court's judgment for Costco, which included a precedent setting concurrence that Omega had engaged in copyright misuse.



We successfully represented, Prada in defending against a baseless copyright infringement claim related to Prada's use of its iconic Robot design in its gold jewelry. In the face of an artist's claims that Prada's jewelry violated her 2012 copyrighted robot designs, we were able to resolve the dispute by demonstrating that Prada designed its Robot design prior to the creation of the artists' copyrighted work.

Advertising & Healthcare

“Renowned for its litigation capabilities and displays significant experience in the handling of advertising disputes.”

Led by David Bernstein, Michael Schaper, and Paul Rubin, our team of advertising lawyers have decades of experience in handling every part of advertising campaigns. From designing substantiation studies to vetting advertising copy to defending ads before regulators to litigating false advertising disputes in court and before the FTC, NAD and television networks, our team has deep familiarity with every stage of an advertising campaign and advertising challenges.

Leveraging our keen understanding of the FDA regulatory landscape, we also have a long history representing drug, cosmetic, food, dietary supplement and device companies, among others, in a wide range of commercial disputes, state AG investigations, Lanham Act false advertising lawsuits, class-action lawsuits, the FTC and NAD, trademark application, opposition and cancellation disputes before the Trademark Trial and Appeal Board.

We pride ourselves on a practical, business-oriented approach to advice, and often work with scientists in a wide variety of fields to substantiate clients' advertising claims and to expose the weaknesses in competitors' claims. Thanks to this experience, we have an enviable record of success. Debevoise lawyers have won and defended motions for preliminary injunctions, efficiently resolved class action advertising cases, defended against regulatory investigations in the advertising arena, and prevailed in more than 100 matters at the NAD. Our team is frequently asked to speak at the nation's leading conferences, and we have authored the leading treatise in advertising law in the United States.

**Paul Rubin is a *LMG Life Sciences*:
“Life Sciences Star”**



L'ORÉAL

We successfully represented L'Oréal USA, Inc. in multiple class actions, as well as FTC and FDA investigations, related to claims that anti-aging skin care products from the company's Lancôme and L'Oréal Paris product brands do not perform as advertised.

AMERICAN EXPRESS

For more than a quarter century, we have represented American Express in advertising disputes against its major competitors (including Visa and MasterCard) and against banks and other parties that issue competing credit cards. Both in court and at the NAD, we have successfully challenged claims that disparaged the acceptance of the American Express card, have forced the abandonment of claims that exaggerated the benefits of other cards, and have defended claims touting the superiority of the services provided by American Express.



We represented Unilever in a high profile false advertising challenge to the name and labeling of Just Mayo sandwich spread. Unilever argued that the name and label, which showed an image of an egg, were false because the product contained no eggs and was therefore not mayonnaise. Ultimately, the FDA agreed to take the lead on the challenge.



In a precedent-setting advertising dispute that created new law on the substantiation of advertising claims, Debevoise won a preliminary injunction against Mylanta NightTime on the ground that the name deceptively implies that the product was specially designed for nighttime heartburn and would prevent heartburn all night long. Debevoise successfully defended that injunction on appeal before the Court of Appeals for the Third Circuit, and beat back a request for rehearing en banc and for certiorari.



We negotiated a successful settlement on behalf of Foundation Medicine Inc., a leading cancer diagnostic company, in critical false advertising litigation against Guardian Health, a competitor in the space. Following disqualification of its initial counsel, Foundation Medicine invited many of the nation's leading advertising law firms to pitch to take over the matter and ultimately selected Debevoise to handle this important project.



We represented Kind LLC in a series of advertising challenges before the NAD against Clif. In one case – the first ever decided by the NAD under its fast-track SWIFT procedure – we won a decision barring Clif from advertising its energy bars as being “better performing” for “sustained energy.” In another, we won the right for Kind to continue to show that the first ingredient in Clif's leading bar is brown rice syrup and that Kind's leading bar has 75% less sugar.



Although obtaining shape and color trademark registrations can be challenging, we were successful in obtaining approval from the U.S Patent and Trademark Office for GSK's trademark applications consisting of the color purple applied to the surface of GSK's ADVAIR DISKUS inhaler products, used for the treatment of asthma and other respiratory ailments. In 2016, two companies that intend to enter the market with generic equivalents of ADVAIR filed oppositions to GSK's application. We resolved the challenges early in the process, and the oppositions were withdrawn. We also stand ready to challenge in court any generic equivalent of ADVAIR that improperly infringes on the distinctive color and shape of GSK's ADVAIR inhalers.



Entertainment, Media & Sports

Our lawyers have broad knowledge and experience on a range of issues affecting the entertainment and media industries, covering both litigation and transactional matters. We regularly provide advice and aggressively and effectively litigate a variety of issues impacting the industry, such as the right of publicity, defamation, First Amendment and the licensing, sale, distribution and transfer of rights, as well as other business or contractual disputes. We also counsel our corporate clients and litigate in the increasingly busy area of employment-related defamation matters.

Our team, led by Michael Schaper and David Bernstein prides itself on truly understanding the business of entertainment and our creative, solution-oriented and responsive approach to each matter.





Debevoise represents Fox Corporation with respect to its launch of a new football league, the United States Football League, which is using team names and logos that recall the nostalgia for the old United States Football League of the 1980s. Although the old league abandoned its trademarks more than thirty-five years ago, a group that includes some of the owners of the 1980s USFL teams created a new entity that purports to own the rights to the old league's trademarks and filed suit against Fox in federal court in California to stop the new league's use of the USFL name and team marks and to essentially shut down the new league, just weeks before kickoff. In April, 2022 we defeated plaintiff's motion, ensuring that the new USFL season could proceed.



We won a major victory at the summary judgment stage for the National Football League in a case brought by retired NFL players seeking to enjoin and be compensated for the NFL's continued use of game action footage taken during their playing careers. We also successfully settled a class action involving the same claims. Summary judgement and approval of the settlement were both affirmed by the Eighth Circuit.

TimeWarner

We obtained summary judgment dismissing a libel suit brought by Donald J. Trump against our clients, Time Warner Book Group and *New York Times* editor Timothy L. O'Brien, involving the book *TrumpNation: The Art of Being The Donald*.



In the first New York case to address right of publicity claims within video games, we secured dismissal of two cases brought by Lindsay Lohan and another celebrity against Take-Two Interactive Software concerning the alleged use of their likenesses in the *Grand Theft Auto* video game.



Debevoise successfully represented the NHL and the Toronto Maple Leafs in connection with a dispute with Snoop Dogg regarding his applications for the trademark "Leafs By Snoop" and an accompanying design mark resembling the Maple Leafs' design mark. Debevoise was retained on the heels of widespread press coverage regarding the nascent dispute. After three years of discussions, during which we repeatedly focused on the strength of the Maple Leafs' marks, the risk of confusion, and the practical reality of NHL's and Snoop Dogg's interest in continuing to work together, Snoop Dogg finally agreed to abandon the LEAFS BY SNOOP applications, in favor of proceeding simply under the trademark LBS. As a result, the NHL's oppositions to Snoop Dogg's various trademark applications were sustained with prejudice.

Domain Name Disputes

We have earned a reputation for being both “dedicated and experienced” and “an excellent IP firm packed with top-notch litigators.”

From the start of the commercial Internet, Debevoise has been a key advisor to clients worldwide on the development of their Internet strategy. From the protection of content and brands online, to defense against online counterfeiting, to the cutting-edge issues created by new gTLDs, Debevoise lawyers are at the forefront of advising clients on practical strategies for IP protection in the digital age.

When it comes to domain names, our experience with the Uniform Domain Name Dispute Resolution Policy is unmatched. Debevoise lawyers are intimately familiar with the UDRP because they consulted with WIPO on the development of the UDRP, and David Bernstein is one of the world’s leading UDRP panelists, having written hundreds of decisions that have shaped key aspects of domain name law. Drawing on this experience, the Group has recovered hundreds of cybersquatted domain names for its clients.

“You wouldn’t want to spill any blood in the water with these guys around. They are tough, efficient and highly effective trial lawyers.”





We represented Kibar, a major Turkish conglomerate, and The Law Society of the United Kingdom in litigations in U.S. courts filed in an effort to block those brand owners from implementing their UDRP victories. In both cases, we quickly resolved the litigations and were successful in helping those clients recapture their eponymous domain names.



The Law Society



We represented the National Hockey League in a UDRP complaint against a cybersquatter that had posted a pornographic website at a domain name incorporating the Philadelphia Flyers trademark.



Debevoise assisted the Educational Broadcasting Corporation in research, drafting, and filing of Uniform Domain Name Dispute Resolution proceedings against cybersquatters who control domain names incorporating trademarks owned by WNET.



We successfully represented UNTUCKit in a Nominet proceeding and secured the domain name untuckit.uk.co from a cybersquatter attempting to extort UNTUCKit.



On behalf of our client Ambac, a provider of financial guarantees, we filed a UDRP proceeding and secured the transfer of a domain name from a cybersquatter that created a fraudulent website designed to obtain customers' financial information using Ambac's trademarks.



In addition to regularly working with our clients to combat domain name fraud and phishing attacks, we sought and won a preliminary injunction ordering turnover of two fraudulent domains imitating Debevoise under the Lanham Act's anti-cybersquatting provisions.

"The Preeminent" David Bernstein has "a larger-than-life reputation in this profession and he's the real deal. He has an unmatched knowledge base, but also brings a ton of energy to his practice."

Trade Secrets & Restrictive Covenants

Our team, led by Jyotin Hamid and Jay Neukom, has extensive experience on both sides of disputes involving trade secrets, executive restrictive covenant agreements, and other legal issues that arise when companies hire top executive talent from the competition. We have been successful in both obtaining and defeating motions for temporary restraining orders and preliminary injunctions, as well as motions for expedited discovery aimed at quickly preventing the movement of key teams and business leaders and preserving confidential business information.

We also provide strategic advice to help clients in a broad range of industries protect their human capital, business relationships, confidential information and trade secrets. Our team works closely with the Employee Benefits & Executive Compensation Group to navigate group hires and to draft confidentiality, non-compete, non-solicit and employment agreements, and related employer policies aimed at securing confidential and proprietary information.

Clients believe one would be “hard pressed to find a more hard-working, responsive team than Debevoise”

—Chambers USA



BODYARMOR

On the eve of the preliminary injunction trial in a case alleging misappropriation of trade secrets, we settled claims on confidential terms on behalf of our clients, Body Armor and a sales executive employed at the company. The former employer of the sales executive, Keurig Dr Pepper Inc. (“KDP”) attempted to prevent the sales executive from working at Body Armor, claiming breach of contract, actual and threatened misappropriation of trade secrets under the Texas Uniform Trade Secrets Act, and violation of the federal Defend Trade Secrets Act.

THE CARLYLE GROUP

On behalf of Carlyle, we successfully defeated motions for a temporary restraining order and for a preliminary injunction, and we ultimately obtained dismissal of the complaint, in a case alleging that Carlyle launched a portfolio company based on a business plan “stolen” in violation of a nondisclosure agreement.

JAB

Debevoise currently represents a former senior leader at Mars, as well his new employer, JAB Holding LLC company and Pret Panera Holding Company, Inc. in a lawsuit filed by Mars alleging trade secret misappropriation and other claims. Mars alleges that before leaving, the former leader at Mars downloaded and retained Mars’s proprietary information and shared certain of those documents with a number of colleagues at Pret Panera and JAB. Mars also alleges that the former executive, through fraudulent requests for reimbursement, caused Mars to reimburse him for travel-related expenses he incurred in order to facilitate his transition to his new position at Pret Panera.

Jyotin Hamid is “very reflective and responsive, a good listener, an excellent writer and good at interpreting what [clients] are trying to accomplish.”

Intellectual Property Transactions

“What we really like about Debevoise is that all the lawyers tend to be very commercial. They drive the corporate transaction by shaping the question and the dialogue.”

Our team, led by Henry Lebowitz, represents domestic and international clients who acquire and sell businesses that own intellectual property, including patents, copyrights, trademarks and trade secrets, and that license, sell, purchase, and develop intellectual property.

Our practice encompasses intellectual property aspects of mergers, acquisitions, divestitures, initial public offerings, bankruptcy-related reorganizations, and financings. We advise on intellectual property licenses, intellectual property and information technology-agreements, development, publishing, distribution and service agreements, and joint venture arrangements in which intellectual property is the key asset. In addition to our transactional work, we regularly advise clients in the clearance of rights and the selection, development, acquisition, registration and protection of trademarks, trade dress, and trade names.

Reflective of our collaborative approach, we work regularly with our mergers and acquisitions, finance, capital markets, employee benefits, tax, litigation, and bankruptcy practices to craft practical, commercially savvy and cost-effective solutions.





We represented Sarah Thomas, the founder of the Colorado start-up company Healthyish Foods LLC, in a trademark dispute against mass media empire Condé Nast. Despite Ms. Thomas' federal trademark registration for HEALTHYISH, Condé Nast – through its Bon Appétit brand – launched its own Healthyish website, directly competing with Ms. Thomas's brand. After threat of litigation from Debevoise, the parties were able to negotiate a lucrative and innovative licensing deal for Ms. Thomas, which allows both brands to coexist, continue to grow and even partner together to give Ms. Thomas's brand access to and visibility within Bon Appétit's large and established customer base.



When Alibaba.com acquired Yahoo! Inc.'s China business, Debevoise represented Alibaba.com in the acquisition, which included licensing of proprietary Yahoo! technology and investment by Yahoo! in Alibaba.



We represented Warner Music Group in its investment in and licenses with Interlude Music, a joint venture technology company specializing in interactive music videos, to utilize its proprietary technology to jointly develop, create, produce and distribute innovative interactive music video content.



We represented Harvard Pilgrim in the renewal and renegotiation of its license with Harvard University covering its right to use the mark HARVARD as part of its name.

"I have never worked with better partners in my life. They are extremely responsive, extremely knowledgeable and able to see the big picture."

The background of the entire page is a blurred image of a fashion design studio. It shows various fashion sketches, fabric swatches, and design notes pinned to a wall. One visible sketch is titled 'The Dress' and shows a garment with a high collar and long sleeves. Other sketches show different styles of dresses and trousers. The overall tone is creative and professional.

Design Patents

In today's ever-changing, global consumer marketplace, product designs have taken on an increasing importance. Debevoise's team, led by Megan Bannigan and Henry Lebowitz (a former USPTO patent examiner), aggressively protects clients' design patent rights with efficient, creative and pragmatic strategies. We are not the typical patent lawyers: our expertise in patent law is enhanced by our deep experience with trademarks, trade dress, copyright, and other IP protection, which can also be critical in design protection. This multidisciplinary approach, combined with Debevoise's renowned litigation skills, make us uniquely well-equipped to enforce and protect our clients' design rights, whether on the plaintiff or defense side.

Our team is also well-versed in fighting against invalid design patents. We do not hesitate to assist our clients in invalidating design patents that are unfairly asserted against them, including designs that are indefinite, functional or simply not novel.

When allegations of design patent infringement or other IP-related disputes arise, the Debevoise team takes immediate, effective action to protect our clients' interests. We tailor our strategies to meet our clients' overall objectives, protecting all of their important IP rights and enabling our clients to focus on the business and designs at hand. If litigation does become necessary, we stand ready to leverage our skill and experience, as well as that of our deep network of prior art investigators, industry experts and survey experts.



We represented Clayton, Dubilier & Rice in a case filed by bridal designer Jenny Yoo in which claimed both David's Bridal and CD&R, a former investor in David's Bridal, infringed her design patent and trade dress rights in a convertible bridesmaids gown. After a strong showing by defendants at the patent claim construction hearing, where Debevoise succeeded in severely limiting Jenny Yoo's design experts testimony, CD&R was voluntarily dismissed from the case and David's Bridal and Jenny Yoo settled.

STEVE MADDEN

We represented Steve Madden in a case filed against Rothy's. After receiving a cease and desist from Rothy's, asserting that Steve Madden infringed its alleged patent rights and trade dress rights in a standard knitted, pointed-toe design for women's flats, Steve Madden filed this action seeking a declaration that Rothy's has no valid design patent or trade dress rights in the identified design and, even if it did, Steve Madden was not infringing those rights. Rothy's in turn filed counterclaims asserting infringement. Debevoise aggressively prosecuted Madden's claims, defended against the counterclaims, and the case was ultimately settled.

Megan Bannigan 'translates complex legal issues into clear pragmatic legal advice'.

Ongoing Representations



We are representing H&R Block in a high-profile trademark infringement suit against Twitter-founder Jack Dorsey's payment company Square Inc., which announced in December 2021 that it was changing its name to Block, Inc. and that it would start to offer free tax preparation and filing services through its Cash App. In April, 2022, we won a preliminary injunction against Block, Inc. in the Western District of Missouri, barring Block, Inc. from using its name in connection with its Cash App tax services. Block, Inc. has appealed the decision to the Eighth Circuit; in parallel, we are preparing for a January 2023 trial in Jefferson City, Missouri.



A team of Debevoise lawyers secured a stunning reversal for Grubhub by persuading an Illinois federal district judge to reject a Magistrate Judge's recommendation that proposed entering a preliminary injunction against Grubhub's logo, which consists of a knife and fork inside an orange house. Accepting Debevoise's arguments, the district court found that the logo is not likely to be confused with Kroger's Home Chef logo, which also consists of a knife and fork inside a house design, and it therefore rejected Kroger's motion for a preliminary injunction. The case is now on appeal before the U.S. Court of Appeals for the Seventh Circuit.



In the latest legal chapter of this long-running dispute, Debevoise is representing Arcesium in a trade secret and breach of contract litigation dispute brought by SS&C Technologies Holdings, Inc. and its affiliate Advent Software. Arcesium has counterclaimed for breach of contract, unfair competition and tortious interference against SS&C as part of its vigorous defense against SS&C's meritless and anticompetitive claims.



Debevoise represents Rauch Industries, Inc. in connection with a lawsuit against Defendants Christopher Radko and Heart Artist LLC, involving rights to CHRISTOPHER RADKO trademarks for use in connection with Christmas ornaments. Although Mr. Radko sold his rights to the RADKO Marks to Rauch for millions of dollars, he continues to unlawfully trade on the goodwill of those trademarks. Rauch has alleged claims of breach of contract, trademark infringement, and trademark dilution based on Mr. Radko's pervasive use of the RADKO Marks in connection with his new, competing line of Christmas ornaments.

**STND
INTL**

We represent Standard International in a trademark litigation filed by real-estate developers JWR Holdings and Landmark Properties regarding Standard's newly announced STANDARD RESIDENCES condominium project in Miami. Debevoise has filed counterclaims against the developers, seeking, among other things, to cancel their STANDARD related-trademarks.

MSCHF

We represent MSCHF in the defense of trademark claims filed by Vans against MSCHF's Wavy Baby sneaker art. After the district court rejected MSCHF's defenses based on its right to artistic expression and entered a preliminary injunction against Wavy Baby, MSCHF filed an emergency appeal to the U.S. Court of Appeals for the Second Circuit. The Court of Appeals granted MSCHF's request for an expedited appeal and is now fast tracking this appeal, which will address the balance between trademark law and the First Amendment in the context of artistic works.

StockX

Debevoise is defending online resale platform StockX in a lawsuit brought by Nike for alleged trademark infringement. StockX has developed a revolutionary new business model that allows sneakerheads to buy and sell famous sneaker drops without ever taking possession. Instead, the sneakers are stored in StockX's vault and StockX issues a unique non-fungible token (NFT) to prove ownership of the sneaker. That NFT can be freely sold on the market. Nike objects to the use of its trademarks and sneaker images on the NFTs, and has alleged StockX is falsely suggesting that Nike is sponsoring or approving the sale of these NFTs.

Ongoing Representations (cont.)

SatoshiStreetBets

We represent Diamond Hands Consulting, Ltd. (“DHC”) in successfully challenging a scheme by Internet fraudsters to misappropriate the SATOSHISTREETBETS trademark - which DHC uses for popular online cryptocurrency discussion forums - and use it to sell deceptive cryptocurrencies and non-fungible tokens (NFTs). After extensive briefing and argument, the Court confirmed DHC’s rights in the SatoshiStreetBets trademark based on its extensive, prior use of the mark (despite defendant’s first-filed trademark applications), found that defendants’ uses were likely to cause and were causing actual confusion, and entered preliminary injunctions that required defendants to transfer their infringing social media accounts to DHC.

SPACEX

We represent SpaceX in opposing Subaru of America’s petition to cancel SpaceX’s STARLINK trademark registrations. SpaceX is a cutting edge aerospace company that provides broadband satellite internet service under the STARLINK mark. Subaru uses its STARLINK mark for an interactive user interface in its cars. Debevoise’s representation of SpaceX in this matter will address important distinctions in emerging technology, and will ensure that SpaceX can continue to use its mark as it delivers high-speed broadband internet to locations where access has been unreliable or completely unavailable.

Snap Inc.

We represent Snap, Inc. in a federal district court appeal of the U.S. Trademark Office’s refusal to register the SPECTACLES trademark for Snap’s brand of wearable “smart glasses” on the ground that SPECTACLES is a generic term. The appeal argues that SPECTACLES is a brand name for the smart glasses that Snap sells, not a generic term that consumers understand as the name of a product that allows users to take pictures and experience augmented reality.



In what is one of the world's longest-running trademark disputes, Debevoise represents the owners of the internationally-famous rum brand, HAVANA CLUB, in a dispute pending for more than 20 years over ownership of the HAVANA CLUB trademark in the United States.



In a multijurisdictional dispute pending in more than ten jurisdictions, we represent Merck KGaA, Darmstadt, Germany in a trademark, false advertising, cybersquatting, and breach of contract dispute against Merck & Co. involving the use of the name Merck.

BANK OF AMERICA

We are defending Bank of America in a challenge to its ownership and use of the trademark ERICA for its new virtual financial assistant brought by a former candidate for governor in Colorado who claims to own the trademark E.R.I.C.A for an avatar. After successfully beating back a motion for a preliminary injunction, we won summary judgment cancelling plaintiffs' Georgia trademark registration and finding that plaintiffs owned no common law rights in ERICA. The U.S. Court of Appeals for the Tenth Circuit affirmed summary judgment in favor of Bank of America, and remanded for the district court to apply the correct legal standard on one narrow point.

Our Team



Megan Bannigan

Partner

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Megan K. Bannigan is a partner in the Intellectual Property Group, representing clients across a range of industries in trademark, copyright, false advertising, rights of publicity, design patents, licensing and other contract disputes and related matters. Ms. Bannigan has extensive trial experience, helping to secure an over \$20 million jury verdict for client Learning Annex in the United States District Court for the Southern District of New York, among other trial victories. She also has experience representing clients before the United States Patent and Trademark Office, the Trademark Trial and Appeal Board and the International Trade Commission. Recognized by *Managing Intellectual Property's* IP STARS, *The World Trademark Review* and named a Rising Star in 2019 by both *Law360* and *The Legal 500*, Ms. Bannigan also regularly writes and speaks on intellectual property-related issues and is an adjunct professor of Fashion Law and other classes.



David Bernstein

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David Bernstein chairs Debevoise's Intellectual Property Group and has broad experience in all aspects of intellectual property, including trademarks, copyrights, false advertising, rights of publicity, and domain names. He is widely recognized as one of the nation's leading intellectual property litigators. Mr. Bernstein is acknowledged as an intellectual property "Star" in the *IFLR Benchmark Litigation Guide* and as an Intellectual Property "Trailblazer" and "Pioneer" by the *National Law Journal*. He is ranked in the top tier by *Chambers Global* and *Chambers USA*, which notes that he is a "rockstar" and "is roundly considered to be one of the finest trademark litigators in the nation" and where clients note he is "an exceptional, dynamic lawyer and a tenacious litigator" and "just incredible in terms of strategic planning," and *The Legal 500 US*, where he is seen as "a brilliant litigator," and "the dean of the IP litigation bar."



Jyotin Hamid

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Jyotin Hamid, a partner in the New York office, is a seasoned litigator with extensive courtroom experience. He is also deeply involved in Debevoise's market-leading intellectual property practice, having litigated trademark and trade dress cases involving some of the most well-known brands in the world. In addition to intellectual property, he handles a diverse array of other complex litigation matters, with particular focus on employment litigation. In the employment area, he has successfully handled numerous discrimination, whistleblower, contract, compensation and corporate raiding litigations involving high-level executives in a broad range of industries.



Henry Lebowitz

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Henry Lebowitz is a corporate partner and a member of the corporate intellectual property practice, focusing on leading the IP and technology aspects of mergers and acquisitions, financings, capital markets and other corporate transactions. Mr. Lebowitz has advised companies on complex transactions, litigation, portfolio development and other IP matters in an array of industries. He also regularly assists clients in evaluating patents, trademarks and other intellectual property, developing effective IP portfolios, assessing the merits of IP-related litigation and other disputes and implementing strategies to avoid or favorably resolve such disputes.



John Neukom

Partner

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John (Jay) Neukom is a litigation partner and a member of the firm's Intellectual Property Litigation Group. He is veteran trial lawyer with extensive experience advising major Bay Area companies on complex business and intellectual property disputes, including trade secret misappropriation, patent and copyright infringement matters. Mr. Neukom has served as lead counsel for a broad range of Fortune 500 technology companies in high-stakes matters focused on intellectual property, contract and competition issues. He possesses broad expertise in the technology sector with deep subject matter knowledge in a range of areas including semiconductors, network security, software and the Internet of Things. He has litigated over 100 intellectual property disputes and chaired jury and bench trials in state and federal courts across the U.S., as well as successfully argued before various domestic and international arbitration tribunals, and the International Trade Commission.



Jim Pastore

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Jim Pastore is a litigation partner and a member of the firm's Data Strategy & Security practice and Intellectual Property Group. His practice focuses on privacy and cybersecurity issues. Prior to rejoining Debevoise in 2014 as counsel, Mr. Pastore served for five years as an Assistant United States Attorney in the Southern District of New York. While he was with the Criminal Division of the U.S. Attorney's Office, Mr. Pastore spent most of his time as a prosecutor with the Complex Frauds Unit and Computer Hacking and Intellectual Property Section.

Our Team



Paul D. Rubin

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Paul Rubin is a corporate partner representing FDA-regulated drug, device and consumer product companies on a wide range of issues ranging from strategic regulatory counseling to complex compliance and enforcement matters. Mr. Rubin has substantial experience helping clients navigate complex advertising and promotion-related issues including FTC investigations, disputes before the National Advertising Division of the Better Business Bureau (NAD) and advertising lawsuits under Section 43(a) of the Lanham Act.

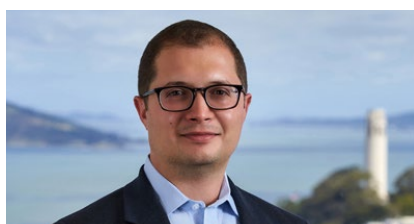


Michael Schaper

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Michael Schaper is a litigation partner whose practice focuses on intellectual property and antitrust law, among other areas of complex civil litigation. Mr. Schaper regularly speaks on legal issues involving intellectual property and was former co-chair of PLI's annual Hot Topics in Advertising Law conference. He has also taught at the Institute for Perception's Advertising Claims Support course.



Christopher S. Ford

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Christopher S. Ford is counsel in the firm's Intellectual Property and Data Strategy & Security groups. His practice focuses on trademark, cybersecurity, and data privacy issues. He has represented clients in trademark and trade dress cases in federal court and before the Trademark Trial and Appeals Board ("TTAB"). His practice also regularly involves counselling clients on trademark applications to the PTO, as well as litigating opposition and cancellation proceedings. Mr. Ford is a member of the International Trademark Association's Non-Traditional Marks committee, and the chair of its U.S. Litigation task force. He has guest lectured on trademark and trade dress issues at New York University School of Law and Rutgers School of Law.



Jared Kagan

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Jared Kagan is counsel in the firm's Intellectual Property group. His practice includes litigation and counselling on trademark, false advertising, copyright, and defamation matters, and he has litigated cases in state and federal courts, before the Trademark Trial and Appeal Board and before the National Advertising Division of the BBB National Programs. His recent representations have included a victory before the U.S. Supreme Court in *USPTO v. Booking.com B.V.*, a victory for Costco before the Second Circuit in the Tiffany counterfeiting case, and obtaining summary judgment for Bank of America in the Erica trademark case. *The Legal 500 US* (2021) recognizes Mr. Kagan for his trademark litigation work, describing him as "outstanding," and he is designated a Rising Star by *Managing IP's IP Stars*. Mr. Kagan is a member of the Sports Law Committee and is co-chair of the Trademarks and Unfair Competition Committee of the New York City Bar Association.

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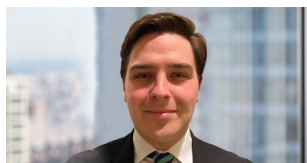


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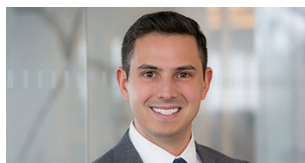


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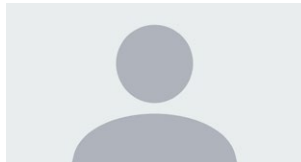
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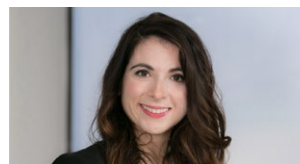
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About Debevoise & Plimpton

Debevoise is a premier law firm with market-leading practices and a global perspective. Approximately 800 lawyers work in nine offices across three continents, within integrated global practices, serving clients around the world. Our clients include domestic and multinational enterprises in almost every industry. They look to us to bring a distinctively high degree of quality, intensity, and creativity to provide effective, pragmatic, and cost-efficient legal advice. Deep partner commitment, industry expertise, and a strategic approach enable us to bring clear commercial judgment to every matter.

Some examples of how working with our community of engaging, intense, and creative lawyers would differ to others are set out below:

- **We put our clients first:** We place a high value on character and diverse interests and draw on the strength of our collaborative culture—across disciplines and regions—to deliver the best of our firm to every client. As a result, clients benefit from the dedication, cohesiveness, and superior quality that we bring to all of our work worldwide.
- **We are committed to diversity and inclusion:** We are recognized as one of the leading firms for diversity, and are proud to be a founding member of *Catalyst CEO Champions for Change*, a transformational diversity and inclusion initiative to recognize and celebrate leaders who support and drive diversity and inclusion within their organizations. We have also earned a reputation for the strength of our women lawyers and the development of several generations of women leaders at the firm. 38% of Debevoise lawyers promoted to partner since 2008 have been women.

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- **We advocate for serving others:** Our U.S. attorneys performed an average of 114.5 hours of pro bono work in 2019 and we were ranked No. 1 overall in pro bono in *The American Lawyer's* “10-Year A-List.”
 - **We are leaders in the profession:** During 2016 alone, Debevoise lawyers led the four preeminent bar associations in the world: the American Bar Association, the International Bar Association, the New York City Bar Association, and the International Council for Commercial Arbitration. In 2017, the immediate past **SEC Chair** and **Director of Enforcement** rejoined our litigation and white-collar team, which includes 13 former Assistant U.S. Attorneys or senior Department of Justice attorneys.
 - **We are recognized market leaders:** Nearly 90% of our partners are recognized by *Chambers & Partners*, *The Legal 500*, or *IFLR*. In fact, a **higher percentage** of our U.S. partners are recognized by the leading legal directory than any of our competitors.

In addition to the above, our cohesive and collaborative approach to serving our clients allows us to eliminate obstacles that many firms have to efficiently and effectively serve the client's needs. As one client said, “They are our trusted counsel for everything important.” (*Chambers USA*).

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