

# Trademark, Copyright & False Advertising Newsletter

Welcome to the new quarterly newsletter from our Trademark, Copyright & False Advertising Practice! We recognize that the law often lags behind business when it comes to innovation, particularly when it comes to IP issues. We hope that you will find our newsletter of value to enhance your understanding of more general trademark and copyright issues, and to keep you abreast of relevant matters on which we recently advised.

## Supreme Court Applies “First Sale” Doctrine to Imported Works



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In a significant decision addressing the Copyright Act’s “first sale” doctrine and the ability of copyright owners to control geographic distribution of their copyrighted works, the Supreme Court recently construed the doctrine’s applicability to works manufactured abroad. *Kirtsaeng v. John Wiley & Sons, Inc.*, No. 11-697, 2013 U.S. LEXIS 2371 (March 19, 2013). The first sale doctrine, codified in 17 U.S.C. § 109(a), generally permits the lawful owner of a copy of a copyrighted work to resell or distribute that copy. In *Kirtsaeng*, the Court held that a work manufactured abroad can still be “lawfully made under” the Copyright

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Act, as that phrase is used in Section 109(a), and, therefore, a copyrighted work legally manufactured abroad and later imported into the United States can lawfully be resold in the United States.

## Background

In *Kirtsaeng*, plaintiff John Wiley & Sons, Inc. published and sold various academic, scientific, and educational journals and books (including textbooks) both abroad and within the US. The goods sold abroad and domestically were often similar, and in some cases identical, although the books sold in international markets in certain instances differed somewhat from John Wiley's domestic versions. Copies sold abroad bore legends indicating the countries in which John Wiley authorized the book to be sold.

Defendant Kirtsaeng allegedly solicited shipments of foreign textbooks from his friends and family living in Asia, in order to resell these textbooks within the US using eBay.com. At trial, the district court prohibited Kirtsaeng from raising the first sale doctrine as a defense, holding that the Copyright Act can only regulate domestic conduct, and an imported book manufactured abroad was therefore not "manufactured pursuant to the US Copyright Act." The Second Circuit affirmed, interpreting the wording "lawfully made under this title" as a geographic requirement that works be manufactured within the US. *John Wiley & Sons, Inc. v. Kirtsaeng*, 654 F.3d 210, 224 (2d Cir. 2011).

The Supreme Court was presented with three potential interpretations of the phrase "lawfully made under this title," reflecting the disagreement of the parties, as well as a split among circuit courts. Wiley and the Second Circuit panel, as well as the Solicitor General as an amicus, all embraced interpretations that limited the first sale doctrine to works manufactured domesti-

cally. Kirtsaeng asserted, instead, that "under this title" means only that a copy was made "in accordance with" or "in compliance with" the Copyright Act—an interpretation tentatively embraced by the Third Circuit in *Sebastian Int'l, Inc. v. Consumer Contacts (PTY) Ltd.*, 847 F.2d 1093, 1098 n.1 (3d Cir. 1988), which had confessed "some uneasiness" with an interpretation of "lawfully made under this title" that implicitly emphasized the place of manufacture. Finally, the Ninth Circuit in *Omega S.A. v. Costco Wholesale Corp.*, 541 F.3d 982 (9th Cir. 2008) had interpreted the statutory language to require *either* that a copy was manufactured in the US or that an authorized first sale occurred within the US. As the Supreme Court had previously been unable to reach a majority opinion in *Omega*, the Ninth Circuit's opinion establishing this middle ground view of territoriality had controlled that case.

## The Decision

The Supreme Court primarily relied on three avenues of analysis in order to interpret "lawfully made under this title": linguistic analysis, statutory context, and the common law history of the first sale doctrine. The Court's linguistic analysis begins with the recognition that Section 109(a) does not explicitly make any reference to geography or location. The Court cited dictionary definitions of "under" to show that while that term has no consistent legal meaning, it can mean "in accordance with." The Court was particularly inclined towards a non-geographic meaning of the statutory language because it allowed each term to have meaning: "lawfully made" distinguishes from copies not lawfully made, and "under this title" sets forth the standard for lawfulness. The Court was skeptical of Wiley's geographic interpretation, under which "lawfully" was largely superfluous.

The Court was further unconvinced that the Copyright Act is not “applicable” to foreign-manufactured copies of a work. While it is true that the Copyright Act cannot “instantly *protect*” against foreign piracy, the Court perceived the Act as still applicable to foreign copies. The Court cited to Section 104 of the Copyright Act, establishing that unpublished works are subject to protection regardless of the author’s domicile, as evidence that the Act is still “applicable” to copies printed abroad. The Court took particular issue with the Ninth Circuit’s holding in *Omega*, which applied the first sale doctrine to works “manufactured or first sold domestically.” As the Court explained, the Ninth Circuit’s position was a compromise in order to prevent a “parade of horrors,” but could not be justified by the language of the Copyright Act. Even if “lawfully made under this title” could be read to require domestic manufacture, the Court saw no reading of those words that could justify an exception for foreign-manufactured works first sold in the US.

Turning to the historical and contemporary context of Section 109(a), the Court compared the section’s current wording to the “immediate predecessor” provision in the Copyright Act of 1909. That earlier section applied to copies “the possession of which has been lawfully obtained” before being amended in the current statute to refer to “the owner of [a copy] lawfully made under this title.” The Court viewed this change from “lawfully obtained” to “the owner of a copy lawfully made” as intended to prevent a party who only leased copies (such as theaters) from selling those leased copies. The Court concluded that Congress’s amendment was intended only to require ownership, not to implicitly create a geographic requirement.

The Court also noted that Congress had been attempting to phase out the distinction between

domestic and foreign manufacture in other aspects of the Copyright Act, which the Court saw as at odds with interpreting Section 109(a) to have a geographic limitation. Furthermore, reading a geographic interpretation into the phrase “lawfully made under this title” would lead to strange consequences in other sections using that wording, such as Section 110(1), which allows a teacher to use copies of a work “lawfully made under this title” for face-to-face teaching activities. Wiley’s interpretation would prevent teachers from using foreign-manufactured works in their teaching activities, without obtaining authorization for each copy.

The Court’s third area of analysis focused on the common law doctrine which preceded Section 109(a). In a broad review of the history of the common law first sale doctrine, the Court remarked on the doctrine’s goal of increasing competition through encouragement of reselling used copies. Importantly, the Court found no geographical distinctions in the common law first sale doctrine. Nor did the Court find any geographic limitation in the Court’s own original recognition of the first sale doctrine in *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339 (1908), or in the first codification of the first sale doctrine a year after *Bobbs-Merrill*. Notably, the Solicitor General acknowledged that a strict application of *Bobbs-Merrill* would not require the geographic limitation that the Solicitor General was urging.

Having determined that each of these three avenues of analysis supports a non-geographic interpretation of “lawfully made under this title,” the Court addressed the potential “parade of horrors” that would result from Wiley’s proposed reading of the statute. Associations of libraries, used-book dealers, technology companies, consumer-goods retailers and museums submitted amici briefs detailing their fears of the consequence of adopting Wiley’s interpre-

tation. These groups had “for centuries” relied on the protections of the first sale doctrine. The Court acknowledged that a geographic interpretation of the first sale doctrine would require the reseller of a car, for example, to obtain permission from the copyright holder of each piece of software included in that car. Neither Wiley nor its amici supporters refuted that such results could, in principle, ensue from Wiley’s interpretation. Wiley, instead, insisted that these harms were artificial dangers, invented by Kirtsaeng and his supporters, that would never come to pass. The Court suggested that, on the contrary, these harms might have already been observed if the museums, libraries and resellers had not been relying for so long on the first sale doctrine. Were the Court to adopt Wiley’s proposed interpretation, it could incentivize copyright holders to begin asserting geographic limits on resale rights and might force institutions such as libraries to begin defensively seeking rights for imported goods. Ultimately, the Court believed that these potential results were “too serious, too extensive, and too likely to come about” to be ignored.

The remainder of the majority’s opinion was dedicated to rebutting arguments advanced by Wiley and in dissent by Justice Ginsburg (joined by Justice Kennedy and, in part, by Justice Scalia). Of particular interest is Justice Ginsburg’s claim that the majority opinion would make it difficult for publishers to divide foreign and domestic markets. The majority explicitly concedes this point, admitting that a copyright holder may now find it difficult to charge different prices for a work in different geographic markets. The majority is unconvinced that this potential difficulty should be given weight, however, as there is “no basic principle of copyright law that suggests that publishers are especially entitled to such rights.” On the contrary, the Court points to the first sale doctrine as

evidence that Congress *intended* to limit the ability of copyright holders to divide domestic markets. The Court leaves it to Congress to determine whether or not copyright holders *should* have an inherent right to charge different rates in different geographic markets.

Similarly, at oral argument, Justice Ginsburg had urged Kirtsaeng’s counsel to confirm that his position would push the US to a regime of “international exhaustion,” by which “once a copy is sold anywhere, the copyright owner loses control of distribution everywhere.” Justice Ginsburg reiterated this point in dissent, arguing that the US did not intend to adopt such a regime. The majority countered by noting that the Solicitor General agreed, at oral argument, that the consequences from Wiley’s geographic reading of the statute would be “worse” than the consequences of Kirtsaeng’s interpretation.

In addition to the majority opinion, a brief but forward-looking concurrence by Justice Kagan, with whom Justice Alito joined, is likely to be of interest to copyright litigants, lobbyists and observers. Justice Kagan concurs fully in the Court’s opinion regarding the interpretation of Section 109(a) and the first sale doctrine. Justice Kagan also recognizes, however, that the Court’s opinion combined with precedent “constricts the scope of §602(a)(1)’s ban on unauthorized importation.” Justice Kagan suggests that any problems resulting from this decision should not be attributed to the *Kirtsaeng* opinion, but instead are a consequence of the Court’s holding in the case of *Quality King Distributors, Inc. v. L’anza Research Int’l, Inc.*, 523 U.S. 135 (1998). In *Quality King*, the Court held that where the first sale doctrine of Section 109(a) applies, the anti-importation restrictions of Section 602(a)(1) cannot prohibit importation. It is Justice Kagan’s view that a reversal of the *Quality King* decision would simultaneously allow copyright



holders to divide international markets and allow groups such as libraries and used book dealers to display, circulate or resell works without being concerned that the books “happen to have been manufactured abroad.” Justice Kagan explains that a reversal of *Quality King* would “target unauthorized importers alone,” as Section 602(a)(1) already only prohibits importation “without the authority of the owner of copyright.” Thus, authorized imports would be permitted even under a restored Section 602(a)(1) and could then be subject to the first sale doctrine once in the US, while unauthorized imports would be prohibited regardless of sales abroad.

In light of *Quality King*, Justice Kagan interprets Wiley and the dissent as encouraging the Court to “misconstrue §109(a) in order to restore §602(a)(1) to its purportedly rightful function of enabling copyright holders to segment international markets.” Justice Kagan believes that sacrificing the first sale doctrine in order to rectify *Quality King* would be a “much worse” mistake and would merely take the statute further from Congress’s intent. Thus, while Justice Kagan realizes that it is Congress’s prerogative to amend the statute, she specifically encourages Congress to adopt the arguments that were rejected in *Quality King*, rather than Wiley’s position in *Kirtsaeng*.

## The Road Ahead

The Court’s decision in *Kirtsaeng* resolves a significant open question in copyright law by limiting the rights of copyright holders to prevent importation of copies manufactured abroad. By applying the first sale doctrine to works manufactured abroad, the Court has seemingly paved the way to import cheaper copyrighted works from abroad into the US. Copyright holders who are concerned about the diversion of foreign goods into the US might

change their pricing structure by reducing the price differential so that it would not make economic sense to purchase works abroad and then import them to the US for resale.

Copyright owners might also consider other potential avenues of enforcement, such as trademark law, which permits a trademark owner to prevent the importation of “grey goods” in certain circumstances. With the advent of digital distribution, such as e-books, which are not sold but are leased, thus making the first sale doctrine inapplicable, owners of copyrights in books should be able to preserve their ability to maintain distinct geographical markets. Similarly, owners of copyrights in software can continue to charge varying prices by licensing their software for use only by the lessee, although, under the Court’s ruling, this will not prevent the importation of products, such as automobiles, that contain licensed software but are themselves sold.

This said, Congress may respond to the Supreme Court’s ruling by amending the Copyright Act’s first sale doctrine and importation provisions. To varying degrees, all three opinions in *Kirtsaeng* acknowledge that the Court’s ruling will create problems by preventing copyright holders from segmenting international markets, and Justice Kagan’s concurrence practically urges Congress to amend the law, going so far as to map out the particular manner in which Congress should do so. It remains to be seen whether Congress sees this issue as ripe for legislative action.

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## Supreme Court Holds Covenant Not to Sue Moots Trademark Cancellation Claim



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A trademark owner can avoid a declaratory judgment challenge to the validity of its mark by executing a broadly worded “covenant not to sue.” So held a unanimous Supreme Court in *Already, LLC v. Nike, Inc.*, No. 11-982, 2013 WL 85300, 2013 U.S. LEXIS 602 (Jan. 9, 2013). The Court’s decision provides trademark owners with a potential low-cost alternative to defending an invalidity counterclaim, but presents some risks to trademark owners with respect to future enforcement efforts.

Nike commenced the litigation, alleging that Already’s “Sugars” and “Soulja Boys” shoes infringed and diluted Nike’s “Air Force 1” shoe design trademark. Already counterclaimed, seeking a declaratory judgment that the mark was invalid. Nike then issued a “covenant not to sue” “unconditionally and irrevocably” promising not to enforce the mark against

Already, its customers or its distributors “on account of any possible cause of action based on or involving trademark infringement, unfair competition, or dilution, under state or federal law.” The covenant covered both lines of shoes at issue, any “current and/or previous footwear product designs and any colorable imitations” that Already might sell in the future. Nike then moved to dismiss its claim with prejudice and Already’s counterclaim without prejudice. The district court dismissed Already’s counterclaim as moot. The Second Circuit and Supreme Court both affirmed.

In a unanimous opinion, Chief Justice Roberts ruled that under the “voluntary cessation” doctrine, Nike, as the party asserting mootness, had the “formidable burden” of showing “that it ‘could not reasonably be expected’ to resume its enforcement efforts against Already.” This burden is met if “the court, considering the covenant’s language and the plaintiff’s anticipated future activities, is satisfied that it is ‘absolutely clear’ that the allegedly unlawful activity cannot be reasonably expected to recur.”

The broad language of Nike’s covenant was sufficient to meet this burden. Although Already submitted an affidavit from its president stating that it planned to introduce new shoe lines, it never asserted any concrete plans to introduce a potentially infringing design that fell outside the scope of the covenant. The Court also rejected Already’s arguments that, as a competitor, it suffered inherent injury that gave it standing to challenge Nike’s invalid trademark, or that the existence of Nike’s trade-

mark continued to deter potential investors from investing in *Already*. In the Court's view, these injuries were too hypothetical or conjectural to confer Article III standing. Nor was the Court concerned that its decision would permit trademark owners to bully smaller competitors, noting that overuse of covenants not to sue could result in the loss of significance of a trademark through extensive third-party use, which, in turn, could result in cancellation of a registration and loss of all trademark rights.

The Court was careful to emphasize the high burden of establishing mootness. This should help trademark owners in opposing motions to dismiss by defendants asserting that the case against them is moot. As the Court stated, “[w]e have recognized ... that a defendant cannot automatically moot a case simply by ending its unlawful conduct once sued,” because, “[o]therwise, a defendant could engage in unlawful conduct, stop when sued to have the case declared moot, then pick up where he left off, repeating this cycle until he achieves all his unlawful ends.”

In a concurrence joined by three other Justices, Justice Kennedy cautioned that a trademark owner asserting mootness must show that the withdrawal of the litigation did not result in any ongoing disruption to its competitor's business, or saddle the competitor with costly satellite litigation over mootness or latent issues in the covenant.

In sum, the Court's opinion provides a roadmap for trademark owners, in certain circumstances, to avoid declaratory judgment challenges asserting invalidity by executing a broad covenant not to sue. But this tactic should be used sparingly, given the high burden of proof to show mootness, and because the use of covenants not to sue may erode the very

rights that the trademark owner is seeking to protect. Indeed, the decision does not address the many potential implications of executing covenants not to sue trademark infringers. For example, the beneficiary of such a covenant might attempt to supply products to (or itself be bought by) a major competitor of the trademark owner, with significant commercial implications.

Others accused of infringement may assert that the trademark owner has essentially granted a “naked license” to the trademark at issue, thereby limiting its trademark rights, or may argue that the trademark owner effectively has conceded that the type of use covered by the covenant not to sue is not infringing or does not threaten irreparable harm. Trademark owners should proceed cautiously, and weigh these risks against the benefits of mooting a case, in deciding whether to use a covenant not to sue of the type the Supreme Court upheld in *Already*.

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## Too Successful to Be Your Intellectual Property?

How the *Apple v. Samsung* Case Illustrates a Growing Legal Trend That Can Punish Product Designers for Being Too Good at What They Do

This article originally appeared in *IndustryWeek* on October 25, 2012.



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The iPhone has already staked its place as a great achievement in aesthetic industrial design. Apple's billion dollar verdict against Samsung, in part for copying that design, signals the legal system will protect innovators from those who would copy another's efforts. But lately, some courts have begun to accept a radical argument that the more successful an aesthetic design, the less likely it will be protected from copying. In fact, even Samsung was allowed to make this argument to the jury, known in legal jargon as "aesthetic functionality," in its lawsuit against Apple. While Apple escaped with its rights to the iPhone design intact, every manufacturer's heart should skip a beat knowing that its best designs could be deemed too successful for protection by a group of twelve randomly selected citizens.

A product's design can be protected as "trade dress." The purpose of trade dress law, a

branch of trademark law, is to protect consumers from confusion about what company is behind the product. Trade dress is like a brand name or logo but in the form of product packaging or design. That means trade dress will protect only unique, distinctive aspects of a product design that tell the consumer who makes it. Examples of protectable trade dress include the shape of a Ferrari Daytona Spyder, the Big Bertha golf club, and Nabisco's Goldfish crackers. In *Apple v. Samsung*, Apple successfully claimed rights in the iPhone's rectangular design with rounded corners, flat clear face, large display screen, black borders, metallic bezel and other features.

Trade dress has never protected features that have only a utilitarian function. This is because, unless a product feature is so novel that it deserves patent protection, functional features should be free for everyone to use.

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**When courts adopt aesthetic functionality, they arguably punish those who create great designs by taking away protection routinely granted to lesser designs.**

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Ferrari can own the exclusive right to cars with distinctive shapes but not the exclusive right to cars with four wheels. Nabisco can own goldfish-shaped crackers but not crackers covered with salt. Apple can be the exclusive maker of



iPhones but not all phones with touch screens. This concept is known as “traditional” or “utilitarian functionality” and is not controversial.

“Aesthetic functionality,” some might say, is an oxymoron because it applies to product features that have no function other than being so aesthetically pleasing that they allow the product to dominate the market. When courts adopt aesthetic functionality, they arguably punish those who create great designs by taking away protection routinely granted to lesser designs.

Samsung’s arguments in *Apple v. Samsung* illustrate the danger in the logic behind aesthetic functionality. Samsung claimed that “if the ‘elegant design’ of Apple’s products makes them more appealing to consumers, then it may not be exclusively appropriated under trademark law.” Resisting the growing aesthetic functionality trend, Apple argued vigorously that the legal doctrine should not apply at all to trade dress.

The judge in the *Apple v. Samsung* case essentially punted the issue to the jury. The judge rejected Apple’s argument that aesthetic functionality could never apply to trade dress, but she also did not adopt Samsung’s maximalist views on the issue. When it came to instructing the jury on aesthetic functionality, the judge issued an ambiguous instruction that Apple could not protect features if it would “impose a significant non-reputation-related competitive disadvantage” to Samsung, but that “the fact that the feature contributes to consumer appeal and saleability of the product does not mean that the trade dress is necessarily functional.” One can easily speculate this instruction doomed Samsung, assuming one could understand the instruction in the first place.

Shortly after the *Apple v. Samsung* verdict, a federal appeals court in New York gave a bigger boost to the aesthetic functionality doctrine in *Christian Louboutin v. Yves Saint Laurent*. In that case, Louboutin sought to enforce its registered trade dress in high-heeled shoes with red soles against copycat shoes made by Yves Saint Laurent. Yves Saint Laurent ultimately won the case because the court found its shoes were not close enough copies. Nevertheless, the appeals court went out of its way to write a mini-tome on the history of aesthetic functionality, point out decisions from courts that doubted the validity of the doctrine, and rule that the doubters were wrong.

The New York court also attempted to explain where the doctrine applies: “where the protection of the mark significantly undermines competitors’ ability to compete in the relevant market” because of the aesthetics of the product as opposed to its “branding success.” The court noted, with classic judicial understatement, that “aesthetic function and branding success can sometimes be difficult to distinguish.” Trade dress owners will be dealing with this difficulty for as long as courts continue to apply aesthetic functionality.

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**Given this uncertainty, what can trade dress owners do to better their chances of protecting their intellectual property?**

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First, they should register their trade dress rights with the US Patent and Trademark Office and not just rely on common law rights. A registration puts the burden of proof on the accused infringer to prove functionality. A trade dress owner claiming common law rights has the

burden of disproving functionality. When a government office has approved a trade dress claim, juries are much more hesitant to invalidate it than they are to find a common law right enforceable. The *Apple v. Samsung* jury is an example: it invalidated none of Apple's registered trade dress claims but found three of Apple's five very similar common law trade dress claims unprotectable.

And, second, consult an intellectual property lawyer on alternatives to trade dress. US law provides for copyright, utility patent, and design patent protection. All of these have the potential to protect a product's design, and aesthetic functionality is not a valid defense to any of them. With aesthetic functionality on the rise, product manufacturers will need all the help that they can get.

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## Practice News & Events

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### Paul Llewellyn to Moderate at INTA's Annual Meeting

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On May 6, 2013, Partner Paul Llewellyn, Co-Head of the firm's Trademark, Copyright and False Advertising Practice, is moderating a discussion on "In-House Trademark Counsel as Witnesses in Infringement Litigation - Benefits and Pitfalls" at the International Trademark Association's Annual Meeting in Dallas, TX.

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### U.S. News & World Report Recognizes Kaye Scholer As Among Nation's Finest IP Firms

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*U.S. News & World Report*, in conjunction with *Best Lawyers in America*, recently issued its 2013 "Best Law Firms" survey results. Kaye Scholer practices were ranked 67 times, including in five IP areas:

- National Tier 1 Ranking (Trademark Law)
- National Tier 1 Ranking (Patent Law)
- National Tier 1 Ranking (Patent Litigation)
- National Tier 1 Ranking (Information Technology)
- National Tier 3 Ranking (Copyright Law)

We humbly thank all those clients who supported us by participating in the *U.S. News & World Report* survey!

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### Kaye Scholer Ranked Among the World's Leading Trademark Firms

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We recently were ranked as one of the world's top leading trademark firms by *World Trademark Review 1000 2013—The World's Leading Trademark Professionals*. Kaye Scholer was selected for inclusion based on its depth of experience, market presence and the level of work on which the firm is typically instructed. Published by *World Trademark Review*, the *WTR 1000* serves as a user-friendly, one-stop source of reference for trademark professionals.

In addition to ranking the [Trademark, Copyright & False Advertising Practice](#) as a whole, *WTR 1000* also recognized Practice Co-Heads [Rhonda Trotter](#) and [Paul Llewellyn](#) as among the top trademark professionals, who were selected based on interviews with more than 1,300 trademark specialists, both in private practice and in-house, in more than 60 key jurisdictions. Interviewees' opinions were specifically sought on the firms and practitioners who are leading the field in terms of their work, their skills and their level of client service.

# Trademark, Copyright & False Advertising

Kaye Scholer's Trademark, Copyright & False Advertising Practice is unique in that we have both highly experienced IP trial counselors and trial attorneys. This experience is key to developing a strategy at the early stages that will protect your interests if the matter ends up in litigation. We develop a winning strategy from the outset of a dispute, focusing our efforts on preparing for the turning point of the case, avoiding costly side skirmishes along the way, and bringing maximum pressure at the key moment—whether it is in expert discovery, a motion for summary judgment or even a trial.

Our experience allows us to effectively handle disputes on an expedited basis through TROs and preliminary injunction proceedings, efficiently manage targeted discovery, and often set the stage for early disposition of disputes by summary judgment or settlement.

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