

# Trademark, Copyright & False Advertising Newsletter

## Second Circuit Splits From Sixth Circuit in Holding That Use “As a Mark” Is Not Required for Trademark Infringement Claim



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In a significant recent decision, the Second Circuit held that, to state a claim for trademark infringement, a plaintiff need not allege that the defendant used the plaintiff's mark in a trademark sense (i.e., “as a mark”). The holding disagrees with the contrary approach taken by the Sixth Circuit, which has held that use other than as a mark is not confusing to consumers and therefore is not actionable.

Kelly-Brown owns the service mark OWN YOUR POWER® for a motivational services business. Oprah Winfrey—the well-known talk show host and, as the court put it, the head of a “vast media

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empire”—began using the phrase “Own Your Power” in various ways: it was prominently featured in issues of Oprah’s magazine; it was the title of an event sponsored by the magazine and other Oprah-related businesses; and it was featured on at least 75 Oprah-related webpages.

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Kelly-Brown sued Oprah and several of her media companies for, among other things, trademark infringement under the Lanham Act. The district court dismissed the claims on a Rule 12(b)(6) motion, holding that the trademark infringement claim failed as a matter of law because plaintiff could not show that defendant used “Own Your Power” as a trademark, and that defendants’ use was fair use because it was descriptive, non-trademark use made in good faith. The Second Circuit reversed.

To state a claim for trademark infringement in the Second Circuit, a plaintiff need only allege that the defendant used the mark in commerce—that is, the defendant “displayed [the mark] to consumers in connection with a commercial transaction.” The plaintiff is not required to allege that the defendant’s use was

“as a mark”—that is, that the defendant used the plaintiff’s mark in a trademark sense “as a symbol to attract public attention.”

In so holding, the Second Circuit disagreed with the Sixth Circuit, which has held that use “as a mark” is a threshold requirement for trademark infringement. The Second Circuit rejected the Sixth Circuit’s conclusion that “no consumer will be confused unless the defendant is using the infringing content as a mark,” stating that that approach “does not cohere” with the Second Circuit’s Lanham Act jurisprudence.

Turning to the defendants’ fair use defense, the Second Circuit held that Kelly-Brown had plausibly alleged that defendants’ uses of the phrase “Own Your Power,” taken together, “suggest that the defendants were attempting to build an association with consumers between the phrase . . . and Oprah.” While a single use of the phrase in a magazine would likely not suffice, the allegations regarding defendants’ repeated use of the phrase were sufficient to survive a motion to dismiss. The court of appeals also held that the defendants had not met their burden, at the motion to dismiss stage, to establish the remaining two elements of their fair use defense—that the use was made in a descriptive sense and in good faith—were “evident on the face of the complaint.”

The case is *Kelly-Brown v. Winfrey*, 717 F.3d 295, 106 U.S.P.Q.2d 1875 (2d Cir. 2013).

## Eleventh Circuit Vacates Judgment of Trademark Validity Where Defendant Wins on Non-Infringement Grounds



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When a trademark owner sues for infringement and loses, but succeeds in defending its mark against an affirmative defense of unenforceability, should the final judgment reflect the court's decision regarding the trademark's validity? In *Unique Sports Prods., Inc. v. Ferrari Importing Co.*, No. 11-15586, 2013 WL 3369153, 2013 U.S. App. LEXIS 13738 (11th Cir. July 8, 2013), the Eleventh Circuit vacated the portion of the lower court's judgment that related to the trademark's validity, holding that its inclusion was improper.

The parties, Unique and Ferrari, manufacture competing tennis racket grip tape. Unique, which has a trademark registration for the light blue color of its grip tape, sued Ferrari, which manufactures grip tape in a teal blue color. As an affirmative defense, Ferrari asserted that Unique's registration was unenforceable. Following a bench trial, the court held that the registration was enforceable, but that the defendant's product did not infringe. On appeal, the Eleventh Circuit vacated the portion of the district court's judgment that related to the enforceability of Unique's trademark. The court held that the judgment of enforceability was an unnecessary resolution of a controversy that was rendered hypothetical by the district court's finding of non-infringement.

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**The Eleventh Circuit's decision in *Unique Sports* highlights the importance of what goes into a trial court's final judgment.**

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The Eleventh Circuit's decision in *Unique Sports* highlights the importance of what goes into a trial court's final judgment. If the judgment had not specifically addressed the affirmative defense of unenforceability and had simply entered judgment in Ferrari's favor, Ferrari would not have had standing to appeal because the Court of Appeals would have lacked appellate jurisdiction.

## Eighth Circuit Holds That TTAB Determination of Likelihood of Confusion Is Not Binding in Subsequent Infringement Action



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When the Trademark Trial and Appeal Board (TTAB) refuses to register a mark based on a finding of likelihood of confusion, does that finding have a preclusive effect in a subsequent trademark infringement action in federal court? In a recent decision, a divided panel of the US Court of Appeals for the Eighth Circuit not only denied preclusive effect to a TTAB finding, but held that the district court properly excluded the finding from evidence.

B&B Hardware, owner of the mark SEALTIGHT, successfully opposed Hargis Industries' attempt to register the mark SEALTITE. The TTAB found that there was a likelihood of confusion between the two marks. When B&B subsequently brought

a trademark infringement suit in federal court, however, the judge declined to admit the TTAB finding into evidence and refused B&B's request that the decision be given preclusive effect, or any deference whatsoever. A jury found that there was no likelihood of confusion between the marks.

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The Eighth Circuit panel affirmed the district court's ruling. First, because the TTAB is not an Article III court, the district court was not required to give the TTAB decision preclusive effect. Second, the factors the TTAB considers for trademark registration purposes differed from the factors considered under the Eighth Circuit's likelihood-of-confusion test for trademark infringement. In particular, the TTAB test places greater emphasis on the appearance and sound of the marks, while the Eighth Circuit test places greater emphasis on marketplace usage of the marks and products. Third, the burden of persuasion was reversed. At the TTAB, Hargis had the burden; in the infringement action, B&B had the burden. For these reasons, the Eighth Circuit agreed with the district judge that the TTAB's ultimate conclusion was not entitled to preclusive effect and had minimal probative value, that it

would have been misleading and confusing to the jury, and that it was properly excluded from evidence.

The dissenting judge would have given preclusive effect to the TTAB's determination of likelihood of confusion, at least in cases where the TTAB had considered the marks in a marketplace con-

text. The different analytical approach taken by the TTAB was not enough, according to the dissent, to justify re-litigation of the issue.

The case is *B&B Hardware, Inc. v. Hargis Industries*, 716 F.3d 1020, 106 U.S.P.Q.2d 1660 (8th Cir. 2013).

## TTAB: Confusion Over Medical Device Names Not Avoided by Need for Doctor's Prescription



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In a recent decision, the Trademark Trial and Appeal Board sustained an opposition to the mark EPI-KEY based on a likelihood of confusion with EPIPEN, both medical devices containing epinephrine for the treatment of allergies. The board's decision, while designated as non-precedential, is nonetheless significant for its rejection of the ap-

plicant's argument that any confusion would be negated by the requirement that the products be prescribed by a doctor.

The TTAB acknowledged that doctors and pharmacists act as gatekeepers for medications, but noted that many drugs and medical devices are marketed directly to patients. The board found it "plausible" that a patient, after seeing an advertisement for EPIPEN or EPI-KEY, would visit his or her physician and mistakenly request the wrong device. Even if the patient received the correct device, he or she might mistakenly believe that both devices were manufactured by the same company. Further, the board could not discount the possibility that physicians might think that the products came from the same source, since even "[s]ophisticated purchasers are not immune from source confusion."

The decision is of interest to manufacturers of prescription drugs and medical devices, as it signals the TTAB's willingness to recognize the dangers of source confusion even when the products at issue are prescribed by sophisticated intermediaries.

The case is *Mylan, Inc. v. Beaufort County Allergy*, Opposition No. 91195868 (TTAB June 19, 2013). [READ THE DECISION HERE](#)



## Second Circuit Stalls *Google* Class Certification Until Fair Use Issues Are Determined



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On July 1, 2013, a Second Circuit panel reversed the class certification decision of fellow Circuit Judge Denny Chin (sitting as trial judge by designation) in the *Google* case, holding that the defendant's fair use defense as to the named plaintiff should be resolved before the issue of class certification is addressed.

The Google Books Library Project seeks to digitize and make searchable the collections of major research libraries. Search queries will yield responsive "snippets" of books, not full copies. Certain author organizations initiated a class action against Google on behalf of copyright holders. Judge Chin certified a United States author class.

Google appealed, arguing, among other things, that its "fair use" defense required individual inquiries into the particular copyrights and au-

thors, making class certification inappropriate. Fair use is a defense to copyright infringement in which the court must evaluate the defendant's use of the plaintiff's work—whether it is for commercial or nonprofit or educational purposes, the nature of the work (e.g., whether it is a work of fiction or non-fiction), how much of the original work was copied, and whether the defendant's use of the plaintiff's work diminishes the potential market for, or value of, the copyrighted work.

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The Second Circuit reversed, but on different grounds than the ones Google argued. In an opinion by Judge Leval, a noted jurist and scholar in the field of fair use, the court stated that "we believe that the resolution of Google's fair use defense in the first instance will necessarily inform and perhaps moot our analysis of many class certification issues, including those regarding the commonality of plaintiffs' injuries, the typicality of their claims, and the predominance of common questions of law and fact." The court's decision is in tension with the Supreme Court's recent decisions in *Comcast Corp. v. Behrend*, 133 S. Ct. 1426 (2013), and *Wal-Mart v. Dukes*, 131 S. Ct. 2541 (2011).

In *Comcast* and *Wal-Mart*, the Supreme Court held that in ruling on a class certification motion, the court must undertake a “rigorous analysis,” which “generally involves considerations that are enmeshed in the factual and legal issues comprising the plaintiff’s cause of action” and the defendant’s defenses. *Comcast*, 133 S. Ct. at 1432. The purpose of this analysis is to determine if the requirements of class certification have been met. In the *Google* case, however, the Second Circuit held that the fair use defense of the named plaintiff should be determined *on the merits*.

In addition to being in tension with the Supreme Court’s rulings, the Second Circuit decision may present a no-lose situation for the absent class members. If Google loses on fair use, potential class members will benefit either as later class members or because Google may be bound under the doctrine of collateral estoppel. If Google prevails and class certification is later granted, the trial court’s finding of fair use will not be binding on unnamed potential class members who choose to opt-out of the class and re-litigate the issue in another forum.

The court, in passing, also addressed Google’s claim that the plaintiffs could not fairly and adequately represent the certified class, as Rule 23(a)(4) requires. Google argued that “many members of the class, perhaps even a majority, benefit from the Library Project and oppose” the lawsuit. The court stated that Google’s argument “may carry some force,” which could be significant in any later attempt by plaintiffs to obtain class certification.

The case is *Authors Guild, Inc. v. Google Inc.*, No. 12-3200-cv, 2013 WL 3286232, 2013 U.S. App. LEXIS 13389 (2d Cir. July 1, 2013).

## Second Circuit Decision Gives Artists Substantial Leeway to Transform Copyrighted Works for Artistic Purposes



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A Second Circuit panel has unanimously held that the use of copyrighted photographs “as raw material” to create new works can constitute fair use even though the new works do not “comment” on the plaintiff photographer, the photographs “or on aspects of popular culture closely associated with” the photographer or the photographs.

Rejecting the district court’s conclusion that the defendant must “transform” the copyrighted work for one of the specific purposes mentioned in the fair use provision of the Copyright Act—“criticism, comment, news reporting, teaching, . . . scholarship, or research”—the Second Circuit held that “alter[ing] the original with ‘new expression, meaning, or message’” to create new works that differed in composition, presentation, scale, color palette and media, could also constitute fair use.

The court’s expansive view of fair use should provide artists with substantial leeway to transform copyrighted works for artistic purposes, although the court’s failure to provide a clear standard by which it determined that 25 of the 30 photographs were fair use as a matter of law will likely result in additional litigation as courts struggle with defining the application of fair use to artistic works. Undoubtedly, courts also will be asked to address the extent to which the Second Circuit’s analysis of fair use applies outside the context of artistic works.

The decision is *Cariou v. Prince*, 714 F.3d 694, 106 U.S.P.Q.2d 1497 (2d Cir. 2013). [READ THE DECISION HERE](#)



## Second Circuit Holds That Conclusions in Scientific Study Are Not Actionable as False Advertising



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Can a company state a claim for relief for false advertising based on its competitor's sponsoring and promoting a scientific study on the ground that the study's conclusions are allegedly incorrect and therefore false? In a recent decision of particular importance to advertisers of pharmaceutical products, the Second Circuit answered in the negative, holding that a study's conclusions were protected speech under the First Amendment.

### Background

Ony and Chiesi manufacture competing drugs for the treatment of respiratory distress in neonatal infants. According to Ony's complaint, Chiesi paid to have a database created containing effectiveness data on the parties' drugs. Chiesi then hired doctors to present the data at medical conferences. The doctors ultimately published an article, appearing in a peer-reviewed medical journal, which concluded that Chiesi's drug was associated with a lower rate of infant mortality than Ony's drug. Chiesi distributed the study and used the study's conclusions in its promotional material.

Ony alleged that the study was methodologically unsound because, among other things, the study addressed only mortality rate data and did not include in its analysis the data relating to another key endpoint (length of hospital stay) that would have shown the effectiveness of Ony's drug. Ony asserted a claim against Chiesi for false advertising under the Lanham Act, as well as state law unfair trade practices and common law tort claims. The district court dismissed the complaint in its entirety, and the Second Circuit affirmed.

## The Second Circuit's Ruling

The Second Circuit held that the study's publication itself was not actionable. Generally, the First Amendment protects statements of opinion but not false or misleading statements of fact. While scientific conclusions are, in theory, statements of fact, courts are not well-equipped to be arbiters of the truth of scientific facts, particularly in the context of academic or scholarly research directed at educated readers. The Second Circuit concluded that "to the extent a speaker or author draws conclusions from non-fraudulent data, based on accurate descriptions of the data and methodology underlying those conclusions, on subjects about which there is a legitimate ongoing scientific disagreement, those statements are not grounds for a claim of false advertising." The court rejected the argument that Ony could state a claim for false advertising because, according to Ony, "competent scientists" would have included other variables from the database in their analysis. Importantly, Ony did not allege that the data the authors chose to present in the article were fabricated or fraudulently created. The court's conclusions also applied to Ony's claims for unfair trade practices under New York General Business Law § 349 and to Ony's claims under New York common law.

The court of appeals also held that Chiesi's use of the study's conclusions in promotional materials was not actionable as tortious interference with prospective business relations, because Ony did not allege that Chiesi misstated the study's conclusions. (The court of appeals did not specifically address whether the use of the study's conclusions in promotional materials could constitute false advertising, perhaps because Ony did not raise this argument on appeal.) Finally, the court held that Ony could not claim any injury resulting from the relationship between the study's authors and Chiesi, because the authors disclosed the potential conflict of interest.

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**While the court's opinion signals that the conclusions of a scientific study can be subject to significant First Amendment protection, it does not foreclose false advertising claims based on the use of a study in promotional materials.**

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Notably, the court did not address the threshold question of whether the publication of the article, or whether Ony's subsequent dissemination of the article, was "commercial advertising or promotion" as required to state a claim under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(B).

## **Lessons From *Ony, Inc. v. Cornerstone Therapeutics, Inc.***

While the court's opinion signals that the conclusions of a scientific study can be subject to significant First Amendment protection, it does not foreclose false advertising claims based on the use of a study in promotional materials (or based on studies that use fabricated data, for example). A defendant that misstates a study's conclusions or data or omits material data in promotional or advertising materials could still be subject to a false advertising claim. Nor did the court address whether a defendant that promotes the conclusions of one scientific study by expressly or impliedly stating that the conclusions were "proved" by the study, without mentioning contrary results of other, more rigorous or more numerous studies, would be subject to a so-called establishment claim. Similarly, the court did not address the cases that have held that an establishment claim can be based on the accurate reporting of an unreliable study.

The case is *Ony, Inc. v. Cornerstone Therapeutics, Inc.*, No. 12-2414-CV, 2013 WL 3198153, 2013 U.S. App. LEXIS 13067 (2d Cir. June 26, 2013), *aff'g*, No. 11-CV-1027S, 2012 WL 1835671, 2012 U.S. Dist. LEXIS 69956 (W.D.N.Y. May 18, 2012). [READ THE SECOND CIRCUIT'S SLIP OPINION HERE](#)

## On the Horizon: Pending Legal Developments

### Supreme Court Grants Certiorari to Resolve Split Among Courts of Appeal Regarding Lanham Act Standing

Although the plain text of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), grants statutory standing to “any person who believes that he or she is or is likely to be damaged” by the defendant’s conduct, courts have not interpreted the statute literally. Courts have consistently held that consumers do not have standing under Section 43(a). See Richard A. De Sevo, *Consumer Standing Under Section 43(a)—An Issue Whose Time Has Passed*, 88 Trademark Rep. 1 (1998). As for non-consumers, the courts of appeal have developed different tests—three Circuits require that the plaintiff be a direct competitor of the defendant, four Circuits apply the test for antitrust standing, and two Circuits apply a more flexible “reasonable interest” test. On June 3, 2013, the Supreme Court granted a certiorari petition to determine the appropriate standard for statutory standing under Section 43(a). (The case is *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, No. 12-873.)

### Supreme Court Asks Solicitor General to Weigh in on Lanham Act Case Involving Food Labeling

Pom Wonderful sued Coca-Cola, alleging that the latter’s sale of “Pomegranate Blueberry” juice containing only 0.3 percent pomegranate juice and 0.2 percent blueberry juice constituted false advertising under the Lanham Act. The Ninth Circuit held that the claim was barred because the product’s labeling was regulated by the FDA under the Food, Drug & Cosmetic Act (FDCA), and the name and labeling of Coca Cola’s product complied with FDA regulations. Pom Wonderful filed a certiorari petition in December 2012, arguing that the Ninth Circuit’s decision is contrary to the Supreme Court decision in *Wyeth v. Levine*, 555 U.S. 555 (2009) (holding that the FDCA did not preempt state failure-to-warn claims based on prescription drug labeling), and that it creates a Circuit split regarding the interplay between the Lanham Act and the FDCA. Coca-Cola filed an opposition in February. On March 25, the Court issued an order inviting the Solicitor General to submit a brief expressing the views of the United States. (The decision is *Pom Wonderful LLC v. Coca-Cola Co.*, 679 F.3d 1170, 102 U.S.P.Q.2d 1781 (9th Cir. 2012).)

## **Supreme Court Vacates and Remands Two Consumer Fraud Class Actions—Both Involving Washing Machine Purchasers—In Light of *Comcast v. Behrend***

### **On Remand, Sixth Circuit Reaffirms Grant of Class Certification**

In two cases brought in different circuits, consumers brought putative class actions against washing machine manufacturers, alleging that the machines had design defects that caused them to produce mold and offensive odors. Defendants in both cases argued that there was no predominance of common issues—as is required to certify a class under Federal Rule of Civil Procedure 23(b)(3)—because, among other things, many consumers never experienced mold problems. In the first case, *In re Whirlpool Corp. Front-Loading Washer Prods. Liab. Litig.*, 678 F.3d 409 (6th Cir. 2012), the district court certified a class, and the Sixth Circuit affirmed. In the second case, *Butler v. Sears, Roebuck & Co.*, 702 F.3d 359 (7th Cir. 2012), the district court declined to certify a class regarding the mold issue, but the Seventh Circuit reversed. In both cases, the Supreme Court granted the defendants’ certiorari petitions and summarily vacated the decisions below and remanded for further proceedings in light of the Court’s recent decision in *Comcast Corp. v. Behrend*, 133 S. Ct. 1426 (2013). In *Comcast*, the Court held that class certification was improperly granted in an antitrust case because, among other things, individual questions of damages would “inevitably overwhelm questions common to the class.”

On July 18, 2013, the Sixth Circuit issued its decision on remand, once again affirming class certification. The court—26 pages into a 29-page opinion—briefly distinguished *Comcast* on the ground that the case there involved certification of both liability and damages questions, whereas the district court in *In re Whirlpool* certified a class only as to liability, leaving damages issues for later determination on an individualized basis. (Notably, the court did not address *how* the individualized issues of damages (or injury) could be manageably addressed where the class consists of thousands of consumers.) The Sixth Circuit found that the circumstances of the case before it more closely aligned with another recent Supreme Court decision, *Amgen Inc. v. Conn. Retirement Plans & Trust Funds*, 133 S. Ct. 1184 (2013), which upheld certification of a securities law class action premised on a fraud-on-the-market theory.

It is now up to the Seventh Circuit to determine whether it agrees with the Sixth Circuit’s application of *Comcast* or whether it reads *Comcast* to require that damages must be capable of classwide proof—setting up a potential circuit split.

The Sixth Circuit decision is *In re Whirlpool Corp. Front-Loading Washer Products Liab. Litig.*, No. 10-4188, 2013 WL 3746205, 2013 U.S. App. LEXIS 14519 (6th Cir. July 18, 2013).



## Practice News & Events

### **Paul Llewellyn Led Working Group at ACI Summit on Food & Beverage Marketing and Advertising**

On July 16, 2013, Partner Paul Llewellyn, Co-Head of the firm's Trademark, Copyright & False Advertising Group, co-led a pre-summit interactive working group on "Food and Beverage Claim Substantiation: A Cradle-to-Grave Approach on the Use of Evidence, Experts, Studies and Scientific Reliability" at the American Conference Institute's 3rd Advanced Regulatory Summit on Food & Beverage Marketing and Advertising in Washington, DC. The session featured an intensive working group discussing health, therapeutic, structure/function and quantified claims regarding food marketing and/or advertising campaigns.

### **Rhonda Trotter to Discuss Developments in Technotainment Litigation at a PLI Program**

Partner Rhonda Trotter, Co-Head of the firm's Trademark, Copyright & False Advertising Group, will present "Cutting Edge Developments in Technotainment Litigation" at the Practising Law Institute (PLI) program on "Technology and Entertainment Convergence 2013: Hot Business and Legal Issues in Technotainment" on September 18, 2013 in San Fran-

cisco and October 3, 2013 in New York City. In her presentation, Rhonda, who is a PLI faculty member for this year, will explore recent case developments at the intersection of technology and entertainment, including copyright protection in the digital television arena, contributory liability for infringing content on the Internet, and rights of privacy and publicity in new media.

### **Kaye Scholer's Stars Shine in *Managing IP* 2013**

Kaye Scholer's IP practice was recognized as one of the top firms nationally in the 2013 edition of the *Managing IP Handbook*, with 11 lawyers highlighted as "IP Stars" in the US, the first year the publication has awarded such a distinction.

Noting that "the firm is widely acknowledged for expertise in patent litigation, particularly on behalf of clients in the life sciences and pharmaceutical industries," *Managing IP* ranked Kaye Scholer Tier 1 among "Highly Recommended" firms for both Patent Contentious and Trademark Contentious work in New York. In California, we ranked Tier 1 among "Recommended" firms for Patent Contentious,

Trademark Contentious and Copyright work. The publication went on to rank Kaye Scholer nationally for its Patent Contentious, Bio Life Sciences and Trademark Contentious work. We also secured our first-ever individual ranking in Chicago.

Ten Kaye Scholer Intellectual Property partners and one Media & Entertainment partner received the designation of 2013 “United States IP Star”:

#### California

- Sheri Jeffrey (Media & Entertainment)
- Michael Malecek
- Peter Root
- Rhonda Trotter

#### Illinois

- Robert Unikel

#### New York

- David Barr
- David Benyacar
- Daniel DiNapoli
- Paul Llewellyn
- Aaron Stiefel
- William Tanenbaum

# 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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