



# Lisa A. Ferrari

## Co-Chair, Copyright Practice

### New York

Iferrari@cozen.com | (212) 297-2699

Lisa is a member of the firm's Intellectual Property Group, practicing out of the firm's New York office. Lisa joined Cozen O'Connor in 2011 after previously practicing intellectual property law at Cohen, Pontani, Lieberman & Pavane LLP in New York.

Lisa litigates trademark, copyright, and patent infringement actions in U.S. federal courts. In addition to her litigation practice, Lisa maintains an active trademark protection and enforcement practice, advising clients in a variety of fields including art, apparel, hospitality, food and beverage products, jewelry and accessories, dentistry, housewares, and electronics. Lisa also prosecutes trademark applications, represents clients in trademark cancellation and opposition proceedings in the U.S. Patent and Trademark Office, and handles matters relating to copyright registration and enforcement.

In addition, Lisa has drafted agreements and negotiated settlements in areas involving licensing, royalties, assignments, liens, trademark co-existence, comparative advertising, and the seizure of counterfeit goods. Lisa also regularly assists clients in filing takedown notices under the DMCA, and addressing issues arising from the sales online of NFTs and gray market and counterfeit goods.

Lisa obtained a B.A. from Brown University in 1986 and a J.D. from New York University School of Law in 1990.

### Experience

Secured a preliminary injunction for an energy industry client against a competitor in a case in which the client brought federal and state claims for counterfeiting, trademark and copyright infringement, cancellation of trademark registration, unfair competition, deceptive trade practices, breach of contract, and cybersquatting after the competitor began trying to pass its own products off as the client's. The court enjoined the competitor from manufacturing, importing, distributing and/or selling any products using the client's trademarks, or any confusingly similar marks, and froze the competitor's assets related to its counterfeiting and other illegal activities.

Represented Lincotek Surface Solutions, a global leader in contract manufacturing services for the aerospace and medical businesses, in its acquisition of Hitemco, LLC, a provider of diffusion and thermal sprayed enhanced surfaces. This transaction drew on the experience of the firm's corporate, tax, antitrust, environmental, real estate, employee benefits and executive compensation, labor and employment, and intellectual property attorneys.

Represented Orthofin, LLC, a company affiliated with Lincotek Group SpA (an Italy-based global leader in contract manufacturing services for the aerospace and medical businesses), in its acquisition of a majority stake in Riepen LLC and other assets constituting the Danco Medical business. This transaction drew on the experience of the firm's corporate, international, labor and employment, employee benefits and executive compensation, intellectual property, and environmental attorneys.

Represented Business Integration Partners (BIP), an Italian strategic consulting firm controlled by the CVC Capital Partners Fund VIII, in its purchase of a majority stake in Monticello Consulting Group, a New York-based consultancy firm specializing in financial services consulting. The transaction drew on the experience of the firm's corporate, international, labor and employment, employee benefits and

### Practice Areas

- Intellectual Property
- Copyright & Content
- Trademark & Brand
- Franchising

### Industry Sectors

- Food & Beverage
- Retail

### Education

- New York University School of Law, J.D., 1990
- Brown University, B.A., 1986

### Bar Admissions

- New York

### Court Admissions

- U.S. Court of Appeals for the Federal Circuit
- U.S. Court of Appeals for the Fourth Circuit
- U.S. District Court -- Eastern District of New York
- U.S. District Court -- Southern District of New York
- U.S. District Court -- Eastern District of Texas
- U.S. District Court -- Western District of Wisconsin

### Affiliations

- Association of the Bar of the City of New York
- The New York Intellectual Property Law Association

### Awards & Honors

- World Trademark Review 1000, 2021-2024

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Iferrari@cozen.com

P: (212) 297-2699 | F: (646) 588-1459

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executive compensation, tax, and intellectual property attorneys.

Represented the owners of HEYDUDE®, a privately-owned casual footwear brand founded in Italy, in connection with its sale to Crocs, Inc. for \$2.5 billion. The acquisition was funded by \$2.05 billion in cash and 2,852,280 shares issued to HEYDUDE's founder. The complexity and cross-border nature of the transaction required extensive collaboration with foreign counsel in Hong Kong, Italy, and other jurisdictions. It also drew on the experience of the firm's corporate; international; antitrust; intellectual property; labor and employment; employee benefits and executive compensation; and technology, privacy, and data security attorneys.

Successfully defended Radiant Yoga, LLC (dba YogaSpark) before the Trademark Trial and Appeal Board (TTAB) in a long-running trademark cancellation dispute. The plaintiff, Spark Yoga, sought to cancel the client's registration for YOGASPARK on grounds of likelihood of confusion. In an effort to leap frog behind Radiant Yoga's priority date, Spark Yoga paid a common law user of the SPARK YOGA mark to assign her rights. When the assignor testified at deposition that she had not used the SPARK YOGA mark for several years, the TTAB dismissed that action. Spark Yoga then found another common law user, this time of the mark YOGASPARK in California, who appeared to have priority over Radiant Yoga, and who, having been paid by Spark Yoga, began another cancellation proceeding against the client. After navigating a long and labyrinthine procedural history, including successfully striking nearly all of the plaintiffs' trial evidence and making the strategic decision to forego introducing evidence at trial and instead to argue that the plaintiffs had not met their burden of proof, we prevailed on the merits.

Successfully represented Marquee Brands, LLC in connection with its multi-million dollar acquisition of Martha Stewart Omnimedia's intellectual property rights -- including patent, trademark and copyrights pertaining to Martha Stewart and Emeril Lagasse. The project involved data privacy issues and investigating extensive worldwide intellectual property rights and employee and contractor rights.

Successfully moved to dismiss a declaratory judgment action filed against our California-based client in federal court in New York by a New York company with which the client had entered into a licensing agreement. The plaintiff filed the action after our client raised concerns that the plaintiff had breached the agreement, pursuant to which the plaintiff was to market her knitting and weaving hand loom tools in craft stores in exchange for royalty payments. We successfully moved to dismiss for lack of personal jurisdiction and improper venue, overcoming the plaintiff's arguments that a New York choice of law provision and a license for the sale of the client's products nationwide established the requisite minimum contacts.

Prevailed in an arbitration in which we represented a manufacturer of fire door systems that terminated an agreement under which it assisted a U.K. company in entering the U.S. market and became the exclusive licensee in the U.S for that company's products. The client terminated the agreement when the company was sold and the buyer engaged in conduct detrimental to the client, in breach of the agreement, including sharing its confidential information with a competitor. We overcame the claimant's demand for a declaration that it was not in breach of the agreement, and succeeded on a counterclaim for a declaration that the claimant was in breach and for damages.

Served as lead counsel to well-known retailer of women's clothing in bringing cybersquatting claim under Lanham Act. Obtained summary judgment in client's favor, resulting in award of statutory damages, attorney fees, costs, sanctions and transfer of infringing domain name. Subsequently argued appeal in Fourth Circuit, obtaining affirmance on all grounds.

Served as lead counsel to vacuum tube manufacturer in opposition proceeding in Trademark Trial and Appeal Board. Obtained summary judgment in client's favor on issue of priority of use, resulting in dismissal of opposition and global settlement assigning worldwide marks to client.

Advises well-known restaurant and hospitality group on issues relating to trademark portfolio, including prosecution of trademark applications, assessment of infringement issues, and development of trademark strategy.

Obtained an Order from U.S. Immigration Court withholding removal from the U.S. of pro bono client from Zimbabwe who had been kidnapped and beaten as the result of his membership in a political group opposing dictator Robert Mugabe.

Won a judgment of non-infringement of multiple patents directed toward vehicular tilt control apparatuses on behalf of a German auto parts maker. These judgments were affirmed by the U.S. Court of Appeals for the Federal Circuit, which agreed with our arguments that intrinsic evidence and the prosecution history supported the district court's constructions of the claim terms at issue and finding of non-infringement based thereon.