

Trademark & Brand

Trademarks and branding are about building a unique marketplace identity as much as they are about securing enforceable intellectual property rights. All trademarks are informed by the law but in service of a client's core character and mission.

Cozen O'Connor's nationally recognized trademark practice is full service and global. Our attorneys advise on every aspect of the trademark and branding process, from clearance and registration to licensing and enforcement, and regularly operate in jurisdictions around the world. We represent major clients operating in diverse industries, including Aramark Corporation, BODi, Comcast-Spectacor, Endo Pharmaceuticals, Incyte Corporation, The Wine Advocate, and the maker of Sweet'N Low.

Prosecution & Counselling

Cozen O'Connor registers thousands of federal trademarks each year and is ranked among the most prolific filers of successful trademarks by the U.S. Patent and Trademark Office. We also handle state trademark registration, U.S. Customs and Border Protection registration, and trademark procurement in foreign jurisdictions. The firm has significant in-house resources dedicated to clearance and registrability as well as a lot of practical knowledge about what works and what doesn't.

Every client is unique, so our trademark attorneys design tailored protection strategies that maximize value and limit risk. We advise on internal protocols, licensing and distribution agreements, marketplace monitoring, counterfeiting prevention, and transactional due diligence.

Disputes & Litigation

Disputes over trademarks and brand are a frequent occurrence, and companies must be prepared to respond quickly and decisively. Lex Machina recently named Cozen O'Connor among the best law firms for trademark litigation — and one of the only firms in the Top 20 as both plaintiff and defense counsel.

Cozen O'Connor's trademark attorneys have deep knowledge of the unique legal and procedural aspects of trademark litigation. They regularly represent clients in *ex parte* and *inter partes* proceedings before the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office, as well as in trademark litigation in federal courts and before government and administrative venues around the world. The firm's trademark attorneys also have significant commercial litigation experience and routinely handle complex commercial litigation cases and arbitration matters, including breach of contract, that have a trademark component.

Services

- Advise on the availability and registrability of trademarks
- Prosecute trademark applications around the world
- Counsel on internet domain names, social media, and online branding
- Assist clients with domestic and international portfolio management
- Develop trademark protocols to support permitted usage
- Negotiate licensing, transfer, and other complex IP-sharing agreements
- Provide anti-counterfeiting counseling and enforcement
- Represent clients in emergency TRO and preliminary injunction proceedings
- Handle litigation in federal, state, and appellate courts, before the U.S. Patent and Trademark Office and Trademark Trial and Appeal Board (TTAB), and under the Uniform Domain Name Dispute Resolution Policy (UDRP)



Amy F. Divino
Co-Chair, Trademark Prosecution Practice

adivino@cozen.com
Phone (212) 883-4909
Fax (866) 850-7498



Lorraine Linford
Co-Chair, Trademark Prosecution Practice

llinford@cozen.com
Phone (206) 373-7269
Fax (206) 455-8236



Camille M. Miller
Co-Chair, Intellectual Property

cmiller@cozen.com
Phone (215) 665-7273
Fax (215) 701-2273

Related Practice Areas

- Artificial Intelligence
- Copyright & Content
- Entertainment Law
- Franchising
- Hatch-Waxman & Biologics
- Intellectual Property
- Intellectual Property Litigation
- IP Transactions & Licensing
- Patents
- Product Regulatory & Compliance
- Trade Secrets, Restrictive Covenants, and Computer Abuse

Industry Sectors

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 fine jewelry designer Stephanie Gottlieb in connection with an agreement under which singer Taylor Swift wore a Stephanie Gottlieb necklace featuring football star Travis Kelce's number to Super Bowl LVIII.

Served as lead trial counsel for Dansko Shoes against the unauthorized use of its KANE trademark.

Handle the global IP portfolio and all copyright-related issues for The Wine Advocate. We also handle enforcement and assist in IP due diligence and contract negotiations and licensing.

Handle the global trademark, copyright, and patent portfolios and related enforcement and litigation for Dansko.

Handle the global intellectual property portfolio and related enforcement and litigation for Nielsen-Kellerman.

Handle Celgene's intellectual property matters on a global basis, including trademark, copyright, anti-counterfeiting, enforcements, customs litigation, and transactional matters.

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.

Secured a hard-fought victory for a large costume jewelry retailer based in Paris, with stores worldwide, in a consolidated Trademark Trial and Appeal Board proceeding involving seven applications and registrations. During the course of discovery, the individual whose trademark our client opposed sued for infringement in federal court in New York, resulting in the suspension of the TTAB case. After we successfully moved for summary judgment in the infringement case (with the win being affirmed by the U.S. Court of Appeals for the Second Circuit), the TTAB proceedings resumed.

We first won judgment on the pleadings with respect to a cancellation counterclaim the other side had filed, and we then secured victory for the client on its own claims in almost all respects.

Successfully represented Marquee Brands, LLC in connection with a substantial due diligence project culminating in its multi-million dollar acquisition of the outdoor sports and lifestyle brand Dakine, and all related intellectual property. The project involved investigating Dakine's extensive worldwide trademark and patent portfolio, third-party rights in Europe, employee and contractor intellectual property rights concerning copyright and patent issues in the United States and Europe, as well as data privacy issues.

Represented the New York Observer in a protracted trademark dispute. Over the course of a five-year proceeding before the Trademark Trial and Appeal Board (TTAB), we overcame vigorous opposition to our trademark application, with the TTAB ultimately dismissing the objection to the mark in a detailed decision. We also secured dismissal of a parallel lawsuit filed in federal court against six individuals, including the New York Observer's high-profile publisher, by the individual who objected to our trademark application.

Served as lead trial counsel for Patriot National Insurance in a trademark cancellation action before the Trademark Trial and Appeal Board successfully invalidating the PATRIOT RISK INSURANCE trademark registration.

Served as lead trial counsel for Beachbody, LLC in prosecuting a trademark infringement, unfair competition, and counterfeiting case adverse to Walmart and Universal Nutrients.

Served as trial counsel for American Music Theater in defending against copyright and trademark infringement claims brought by The Walt Disney Co.

Served as lead trial counsel for Barcade in prosecuting various establishments that are attempting to use the incontestable BARCADE registration, all resulting in defendants discontinuing use of BARCADE.

Represented Cumberland (Sweet'n Low) against Monsanto (NutraSweet) in a trade dress case for the use of the color blue on sweetener packets. Lower court ruling in our favor was affirmed by the seventh circuit.

Served as lead trial counsel for Clark Capital Management Group in multiple trademark infringement actions involving unauthorized use of its NAVIGATOR marks.

Represented Fame Jeans Inc. in a trademark matter stemming from a TTAB action relating to mark for clothing. After heated discovery, prevailed on motion to dismiss one count from complaint. Subsequently negotiated multimillion-dollar settlement for Fame Jeans relating to mark.

Defended our client in a preliminary injunction motion to its right to its name in a \$10 million trademark infringement claim and convincing a judge that not enough evidence existed to create a trademark challenge when our client, a top video adventure game manufacturer, was sued by another top producer of video games.

Served as lead counsel for a cigar manufacturer, now owned by Altria, where we won a summary judgment motion on product trade dress protection for the appearance of a cigar which led to a favorable settlement in which the opposing cigar manufacturer agreed to phase out all use of the trade dress in question.

Served as lead trial counsel representing Jon Bon Jovi and the Philadelphia Soul Arena Football Team in prosecuting a trademark and copyright dispute.

Served as lead trial counsel for Oasys Mobile, Verizon Wireless, AT&T, and Thumbplay in defense of a trademark infringement claim filed by Mantra Entertainment.

Served as lead trial counsel for Triumbari Corporation in a motion to intervene and a motion to set aside a consent decree filed by Bug Juice concerning product trade dress on a plastic bottle.
