

TRADEMARK, FALSE ADVERTISING,  
COPYRIGHT & TRADE SECRET LITIGATION



# TRADEMARK, FALSE ADVERTISING, COPYRIGHT & TRADE SECRET LITIGATION

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### TRADEMARK, FALSE ADVERTISING, COPYRIGHT & TRADE SECRET LITIGATION AT COVINGTON

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Covington's intellectual property attorneys have extensive experience in litigation to protect our clients' rights in all kinds of intellectual property, including trademarks, copyrights, trade secrets, and claims of false advertising.

We have litigated such cases in numerous trial and appellate courts, including the Supreme Court, the United States Court of Appeals for the Federal Circuit, and federal District Courts and state courts throughout the country, as well as in administrative bodies such as the United States Patent and Trademark Office, the Trademark Trial and Appeal Board, the United States Copyright Office, the Copyright Royalty Board, and the Federal Trade Commission. Our extensive patent litigation practice is described in a separate Covington brochure.

#### ACCOLADES

- *The Best Lawyers in America* (2007-2011).
- *Chambers USA - America's Leading Business Lawyers* (2006-2011)
- *Chambers Asia* - Recognized as a leader in the category China: Intellectual Property, International Firms (2011).
- *Legal 500 US* - Recognized as a leading US practice in the areas of Copyright, Trademarks: Litigation and Trademarks: Non-Contentious, Trade Secrets (2011)
- *Legal 500 UK, IP* (2012)
- *Legal 500 EMEA, Intellectual Property and EU Regulatory, Information Technology* (2011)
- Inaugural European Women in Business Law - One attorney recognized as "Best in Copyright" (2011)
- *Managing Intellectual Property Global Awards*, short-listed in the pan-European category "New Media/Internet" (2010)
- *Intellectual Property Magazine Awards* - Recognized as the Sports, Media and Entertainment Team of the Year (2010)
- *The Practical Law Company (PLC) - Life Sciences, Which Law Firm?* - Recognized for Intellectual Property (2009)
- WORLDLeaders IP Awards, short-listed in the worldwide categories "Excellence in Domain Name Policy Implementation" (2008) and "Domain Name Strategy and Management" (2009)
- *Managing Intellectual Property Global Awards*, "US IP Firm in Europe" for EU and regulatory work (2008)
- *IP Law & Business* - Laurie Self named one of "Top IP People Under 45" (2008)
- WORLDLeaders European Awards for trademark excellence (North America/Canada) (2007).

### TRADEMARK LITIGATION

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Covington has litigated trademark infringement, trademark dilution, counterfeiting, cyberpiracy, unfair competition, gray market, and rights of publicity cases in courts throughout the United States on behalf of numerous clients, including Microsoft, American Automobile Association (AAA), American Express, Armani, Atari, Bacardi, Cartier, Coty, MasterCard, Montblanc, National Basketball Association (NBA) and its member teams, National Geographic Society (NGS), Public Broadcasting Service (PBS), SPI Group, Sun Life of Canada and Yahoo!.

We also have recovered hundreds of domain names registered by cybersquatters, utilizing enforcement programs featuring court actions, including *in rem* actions, under the Anticybersquatting Consumer Protection Act, as well as UDRP proceedings under the arbitration rules adopted by ICANN. We have litigated numerous opposition and cancellation proceedings before the United States Trademark Trial and Appeal Board. In addition to many important litigation victories, we have achieved significant favorable outcomes for our clients through mediation, arbitration, and negotiated settlements.

- Representation of **American Automobile Association (AAA)** in numerous federal and state court actions and arbitration proceedings against third party infringers of AAA's famous marks.
- Representation of **American Express** in the United States District Court for the Northern District of California against claims by Visa that Advanta, in conjunction with American Express, used Visa marks beyond the scope of a trademark license and contrary to the Lanham Act.
- Representation of **Armani** in trademark litigation in the United States District Court for the Eastern District of Virginia to recover the ARMANI.COM domain name from a man whose initials and last name are A.R. Mani.
- Representation of **Atari Games** in litigation involving home video game trademarks in the United States District Court for the Northern District of California.
- Representation of **Bacardi & Company Limited** and **Bacardi U.S.A., Inc.** as third-party intervenors in a proceeding in which plaintiffs seek to execute a judgment against the Republic of Cuba pursuant to proceedings supplementary against Cubaexport and other agencies and instrumentalities of the Cuban government. One of the assets at issue is Cubaexport's interest in the HAVANA CLUB trademark – an interest that is also the subject of separate pending legal proceedings between Bacardi and Cubaexport. We also represent Bacardi in those proceedings.
- Representation of **Bradley Pharmaceuticals** in trademark litigation, including a preliminary injunction hearing, involving the KERALAC mark in the United States District Court for the Eastern District of Pennsylvania.
- Representation of **Cartier** in an *in rem* action in the United States District Court for the Eastern District of Virginia to recover more than 100 infringing CARTIER domain names.
- Representation of **Chloé** in trademark litigation in the United States District Court for the Middle District of Florida concerning defendant's use of the CHLOÉ mark for women's clothing offered for sale on its website and for a women's clothing store.

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- Representation of **Corporate Risk International** in a trademark action involving its CORPORATE RISK mark that was tried to a jury in the United States District Court for the Eastern District of Virginia.
- Representation of **DIHK** and several other plaintiffs in a complex trademark infringement lawsuit pending in the Southern District of California, in which plaintiffs seek, among other things, to enjoin defendants from using the marks GERMAN AMERICAN CHAMBER OF COMMERCE CALIFORNIA and related acronyms.
- Representation of **Encore Marketing** in a trademark action against Travelocity involving the PREFERRED TRAVELER mark for travel club services in the United States District Court for the District of Delaware.
- Representation of **Government of the District of Columbia** in connection with its appeal before the U.S. Trademark Trial and Appeal Board of the PTO's refusal to allow registration of a mark consisting of an official seal of the District of Columbia.
- Representation of **Lorillard** in a petition for certiorari to the United States Supreme Court raising the question whether undisputed evidence that a retailer sold counterfeit goods establishes "irreparable harm" supporting entry of a preliminary injunction.
- Representation of **MasterCard** in trademark litigation in the United States District Court for the District of Utah against a bank that was using a MASTER CARD mark for various banking services offered to account holders.
- Representation of **McGraw-Hill** and other major textbook publishers in gray goods trademark and copyright litigation in the United States District Court for the Eastern District of New York to prevent the illegal importation and sale over the Internet of textbooks published abroad and not intended for sale in the United States.
- Representation of **Microsoft** as a defendant in trademark infringement suits challenging keyword advertising practices and alleging reverse confusion.
- Representation of luxury goods makers **Montblanc** and **Coty** in trademark infringement litigation in federal district and appellate courts resulting in injunctive relief against unauthorized sellers of imported gray market goods.
- Representation of luxury goods makers **Montblanc** and **Davidoff** in trademark infringement litigation against unauthorized sellers of imported gray market goods in the United States District Court for the District of Massachusetts and the United States Court of Appeals for the Eleventh Circuit.
- Representation of **National Geographic Society**
  - in the United States District Court for the District of Massachusetts against claims of infringement of an alleged family of ZONE marks asserted by the author of a series of ZONE books on health and nutrition; and
  - in an opposition proceeding before the U.S. Trademark Trial and Appeal Board, claiming that applicant's EXPLORE CHANNEL mark is likely to cause confusion with National Geographic's EXPLORER marks.
- Representation of **NAVIGON** companies in trademark infringement litigation involving the NAVIGON and NAV N GO marks for competing GPS devices in the United States District Court for the Northern District of Illinois and the United States District Court for the District of Nevada.

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- Representation of **NBA Properties** and the NBA member teams in trademark litigation concerning the DREAM TEAM mark in the United States District Court for the Eastern District of Missouri, and also in anti-counterfeiting litigation concerning other NBA marks brought in the United States District Court for the District of Columbia against purveyors of counterfeit NBA merchandise in connection with an NBA All-Star game.
- Representation of **Public Broadcasting Services (PBS)**
  - in trademark litigation to recover the PBS.COM domain name in the United States District Court for the Eastern District of Virginia; and
  - in an opposition proceeding before the U.S. Trademark Trial and Appeal Board, claiming that applicant's mark BE MORE RESPONSIBLE is likely to cause confusion with PBS's BE MORE mark.
- Representation of **Ringling Bros.** in a petition for certiorari to the United States Supreme Court in an important trademark dilution case involving the mark THE GREATEST SNOW ON EARTH.
- Representation of **Rosie O'Donnell** in an action in the United States District Court for the District of Oregon asserting trademark and right of publicity claims based on the ROSIE name and logo against a radio station using ROSIE as the station name and a very similar logo.
- Representation of **The Society of Permanent Cosmetic Professionals** and **The Distinguished Citizens Society International** in an amicus brief to the United States Supreme Court in the *KP Permanent Make-Up* trademark fair use case.
- Representation of **SPI Group** in the United States District Court for the Southern District of New York and the United States Court of Appeals for the Second Circuit in defense of its rights to the famous STOLICHNAYA trademarks in litigation brought by the Russian Federation claiming ownership of the STOLICHNAYA marks in the United States.
- Representation of **Spirits International**, an affiliate of SPI Group, on appeal to the United States Court of Appeals for the Federal Circuit from a decision of the U.S. Trademark Trial & Appeal Board denying registration of the mark MOSKOVSKAYA on the ground that it is primarily geographically deceptively misdescriptive. The Court vacated the decision by the TTAB and ruled in our client's favor.
- Representation of **Sun Life of Canada** in two trademark actions against Sun Life of America and SunAmerica concerning the SUN LIFE mark in the United States District Court for the Northern District of Georgia and on appeal in one of the actions to the United States Court of Appeals for the Eleventh Circuit.
- Representation of **Yahoo!** in a trademark infringement suit in the United States District Court for the Central District of California in which Yahoo was accused of infringing the mark "Street Buzz" by using the term on its website in connection with web-based video segments.
- Representation of a subsidiary of **Zomba Music Publishing** in a trademark infringement action concerning the mark ESSENTIAL in the United States District Court for the Middle District of Tennessee.

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- Representation of **American Automobile Association, Bacardi, Bank of America, John Deere, Newsweek, Pfizer, Public Broadcasting Services, Ringling Bros.** and **Sotheby's** in an amicus brief to the United States Supreme Court in the *Victoria's Secret* trademark dilution case.
- Representation of numerous clients, including **Microsoft, Verizon, New Skies Satellites, LIN Television, American Automobile Association** and **Ourisman Dodge** in UDRP domain name proceedings.
- Representation of numerous clients, including **Verizon, Spirits International, National Geographic Society, Public Broadcasting Services, M Financial, Promontory Financial Group, U.S. Soccer Federation, Lewis Brothers Bakeries** and **Rosie O'Donnell** in opposition and cancellation proceedings before the United States Trademark Trial and Appeal Board.

### FALSE ADVERTISING LITIGATION

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Like trademark litigation, false advertising litigation is governed at the federal level by the Lanham Act, and trademark infringement and false advertising actions have much in common, including the need to prove consumer confusion or deception and the use of consumer surveys to do so (see below).

As with trademark litigation, our lawyers have litigated numerous false/misleading advertising cases in courts throughout the country. We have also represented numerous clients in false advertising proceedings initiated by the Federal Trade Commission and in proceedings brought under the rules of the National Advertising Division of the Better Business Bureau (NAD).

#### REPRESENTATIVE MATTERS

- Representation of **Adams Laboratories** in a false advertising action challenging pharmaceutical advertisements by Carolina Pharmaceuticals in the Southern District of New York.
- Representation of **American Petroleum Institute** against false advertising claims based on its protocol for certification of branded motor oils that were tried in a preliminary injunction proceeding in the Southern District of New York.
- Representation of **American Institute of Physics and the American Physical Society** against false advertising claims based on their comparative surveys of scientific journals that were tried in the Southern District of New York.
- Representation of **ASM Modular** in false advertising litigation against a competitor in the modular flooring business in the District of Maryland.
- Representation of **AT&T** in a trial in the District of Maryland concerning claims by a competitor that AT&T's advertisements for telephone calling cards were misleading.
- Representation of **Bacardi** in its defense of a false advertising lawsuit concerning HAVANA CLUB rum in the District Court of Delaware.
- Representation of **InterMune** against a false advertising claim brought under Section 17200 of the California Business & Professions Code in the Northern District of California.
- Representation of **International Dairy Foods Association** against a class action in Virginia state court alleging deceptive marketing of the potential weight-loss benefits of consuming milk.
- Representation of **Kentucky Fried Chicken (KFC)** against false advertising claims based on a KFC promotion that were asserted as a class action in the Western District of Virginia.
- Representation of **Public Broadcasting Service (PBS)** in a trial of false advertising claims brought by PBS challenging a video marketer's use of the phrase "public television presents" in the Eastern District of Virginia.
- Representation of **SPI Group** against false advertising claims concerning STOLICHNAYA vodka in the Southern District of New York.
- Representation of **Spirits International**, an affiliate of SPI Group, against false advertising claims concerning its STOLICHNAYA vodkas in the Superior Court of the State of California for the County of Los Angeles.

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- Representation of **Wells Fargo Bank** in numerous consumer class actions brought in state and federal courts in California invoking the state's false advertising statutes with respect to the bank's sales of products and services.
- Representation of **KFC, Microsoft, Dayton Technologies** and others in connection with false advertising claims brought before the NAD.
- Representation of numerous clients in connection with false advertising investigations and proceedings conducted by the FTC.

### CONSUMER SURVEY EXPERTISE

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Trademark and false advertising litigation often calls for the presentation of expert consumer survey evidence and/or expert testimony concerning the flaws in consumer survey evidence offered by opposing counsel. Covington has retained and worked closely with survey experts in numerous trademark and false advertising cases and has assisted them with the creation of effective survey designs, analysis of survey results, preparation of expert reports based on the survey results, and preparation for their depositions and trial testimony. We have also worked closely with survey experts we have retained to criticize survey results submitted by experts on behalf of opposing parties, and we have cross-examined the survey experts of opposing parties.

The clients on whose behalf we have presented expert survey evidence include Armani, NBA Properties and the NBA member teams, Rosie O'Donnell, Spirits International, and Sun Life of Canada. We have also worked with experts in designing and analyzing the results of surveys that ultimately were not presented in any litigation, but that nevertheless served a useful purpose for our clients, including clients who are leaders in the pharmaceutical, financial, software, communications and consumer products industries.

### COPYRIGHT LITIGATION

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Over the past two decades, Covington lawyers have brought or supervised hundreds of civil and criminal copyright-related actions against thousands of infringers throughout the United States and in over 60 countries. These actions range from traditional litigation over substantially similar and counterfeit works to actions against Internet, satellite and broadcast pirates. We have litigated copyright infringement cases in US district and appellate courts and have drafted and submitted amicus briefs on important copyright issues.

Covington has also conceived and implemented copyright-based enforcement campaigns against distributors of gray market products and packaging. We generally deploy small teams of lawyers, utilizing the firm's expertise in copyright law along with its reservoir of knowledge in substantive areas such as new technology, software, sports, media and communications, and luxury goods.

As part of these various efforts, Covington has built and trained a far-reaching network of local counsel and investigators, and has also developed important relationships with public authorities worldwide, including government officials, police, prosecutors, and customs authorities with responsibility for copyright enforcement.

#### REPRESENTATIVE MATTERS

- Representation of **Business Software Alliance** and software publishers in preparation of amicus briefs filed in appellate and Supreme Court cases involving seminal copyright issues, including the *Napster*, *AOL* and *Grokster* cases.
- Representation of **Corbis Corporation** in numerous copyright enforcement actions to enforce rights in images licensed by Corbis.
- Representation of **Microsoft**:
  - in DMCA copyright litigation brought by Blues Destiny and filed in Northern District of Florida; and
  - in preparation of an amicus brief filed in the Eleventh Circuit concerning parody and fair use of *Gone with the Wind*.
- Representation of various software publishers, including **Microsoft** and the **Business Software Alliance**, in supervising civil and criminal copyright and Internet anti-piracy enforcement actions in over 50 countries throughout the Americas, Europe, the Middle East and Africa.
- Representation of the **National Football League** in multiple federal court cases to enjoin the unauthorized retransmission and public performance of NFL game telecasts across US borders via satellite and the Internet and within US borders where games are locally blacked-out, or otherwise unauthorized.
- Representation of the **National Football League**, the **National Basketball Association** and **other sports leagues** in copyright actions to obtain temporary restraining orders, seizure orders and preliminary and permanent injunctions against the piracy of game telecasts and the sale of counterfeit merchandise.
- Representation of the **National Football League** and the **National Basketball Association** in a federal court action to enjoin a Canadian website operator from unauthorized streaming of copyrighted sports broadcasts into the United States over the Internet.

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- Representation of **Parfums Givenchy** in federal court litigation to enjoin over 40 wholesalers and retailers from distributing gray market perfume products bearing copyrighted designs not authorized for importation into the United States.
- Representation of **Public Broadcasting Service** in multi-party litigation before the Copyright Royalty Board seeking to recover public television's share of more than \$750 million in royalties paid by cable operators for the distant retransmission of broadcast programming.
- Representation of **McGraw-Hill** and other major textbook publishers in gray goods trademark and copyright litigation to prevent the illegal importation and sale over the Internet of textbooks published abroad and not intended for sale in the United States.
- Representation of **Samsung Electronics Co. Ltd., Samsung Electronics America, Inc., and Samsung Networks, Inc.** against claims brought by CCP Systems alleging copyright and patent infringement filed in the District of New Jersey.
- Representation of **Washington National Cathedral** in a copyright action in the United States District Court for the Eastern District of Virginia to enjoin a major movie studio from its unauthorized use of a Cathedral sculpture in a popular feature film.
- Representation of **Zomba Recording Corporation and Zomba Music Publishing** in numerous litigations, including claims regarding sound recording and musical copyright infringement, as well as claims concerning breaches of music publishing and music recording contracts.

### TRADE SECRET LITIGATION

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Covington trade secret litigators are successful because they are strategic and because they are experienced both with litigation and with how people create, protect and use confidential information, especially in technology industries. We have been particularly successful in developing and pursuing, as well as defending, trade secret cases arising out of patent infringement litigation. Our trade secret litigators include lawyers who have negotiated non-disclosure and confidentiality agreements and counseled enterprises on how to protect their proprietary information.

We litigate with expertise in technology industries such as life sciences, computer hardware and software, and communications, so we know where to look for proprietary information and how to show that it has been misappropriated. We understand the incentives in these industries for maintaining trade secret protection and for seeking patent protection despite its disclosure requirements. Our experience also encompasses the federal Economic Espionage Act, with its criminal penalties for trade secret misappropriation.

#### REPRESENTATIVE MATTERS

- Representation of **Azul** in litigation involving alleged trade secrets and alleged patent infringement. The technologies at issue included transactional memory, use and integration of multiple core processors, distributed processing, garbage collection techniques, and array bounds checking.
- Representation of **BSDI** in a copyright and trade secret action involving claims that BSDI's UNIX operating system violated USL's operating system copyright, and that BSDI misappropriated USL's alleged trade secrets in its source code.
- Representation of **Caliper Technologies** in a trade secret and patent infringement trial concerning microfluidics technologies.
- Representation of **Computational Dynamics North America** in a trade secret, unfair competition, and tortious interference suit brought by ANSYS in the District of New Hampshire and then in the First Circuit. Computational Dynamics North America (CDNA), and its larger rival, ANSYS, account for 80 percent of the world market for "computational fluid dynamics" (CFD) software.
- Representation of **Computer Associates** in a copyright, trade secret and contract action involving mainframe software.
- Representation of **Huawei Technologies** in trade secret lawsuits against Motorola Solutions involving wireless base station technology; obtained a preliminary injunction preventing the transfer of confidential information in the context of a corporate acquisition.
- Representation of **Hewlett-Packard** in a trade secret case involving electronic design automation (EDA) technology.
- Representation of **Huawei Technologies** in an action relating to router technology that involved claims of copyright infringement, trade secret misappropriation, infringement of five patents, violations of the Lanham Act and Texas state law, and counterclaims alleging unfair competition.
- Representation of **Informix Software** in trade secret litigation regarding a database server and middleware software.

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- Representation of **Integrated Circuit Systems** in trade secret litigation involving high performance clocks for networking applications.
- Representation of **Maxim Integrated Products** in trade secret litigation involving analog-to-digital converters.
- Representation of **Mercury Interactive** in copyright and trade secret litigation concerning automated software testing tools.
- Representation of **Monsanto** in antitrust/contract litigation concerning genetically modified crops, pesticides, and herbicides in which we asserted trade secret misappropriation counterclaims.
- Representation of **National Geographic** in trade secret litigation, including a lawsuit and an arbitration, in defending against allegations of misappropriation of trade secrets relating to a database schema and functionality and a website.
- Representation of **Northrop Grumman** against allegations of misappropriation of proprietary information concerning electrodeless lighting technology.
- Representation of plaintiff **Omniplex**, a government contractor, in a trade secret misappropriation case against SAIC in the Eastern District of Virginia.
- Representation of **OPNET Technologies** in defending against allegations of patent infringement and in asserting trade secret misappropriation claims against a competitor.
- Representation of **Promontory Financial Services** and other defendants against claims of copyright infringement and trade secret theft brought by Vitale AML Consultants, Inc.
- Representation of **QUALCOMM** in a patent infringement and trade secret action involving three patents relating to high-speed data transmission, graphics accelerators, and an integrated circuit for blending graphics and video.
- Representation of **SAP AG** in a trade secret and copyright dispute regarding Customer Relationship Management software.
- Representation of **Sonic Solutions** in a copyright and trade secret action between two manufacturers of software for authoring DVDs.
- Representation of **Symantec Corporation** in a copyright and trade secret dispute over an uninstaller program for personal computers.
- Representation of **Texas Instruments** in litigation involving alleged trade secret misappropriation and breach of a non-disclosure agreement. The technology at issue related to technology being considered for a new DDR memory standard.
- Representation of **Texas Instruments** with respect to trade secret and copyright claims arising out of the development by TI of an interpreter program, which permits software developed to run on Qantel hardware to run in a UNIX environment on a TI platform.
- Representation of **uPI** in an ITC investigation initiated by Richtek, involving allegations of trade secret misappropriation and patent infringement in the context of DC-DC controllers. Richtek alleged that its former employees misappropriated a variety of its business and technical trade secrets, when they founded and/or joined uPI and began selling competing products.
- Representation of **Visa International Service Association** and **Visa U.S.A.** in a patent and trade secret case involving payment card holder identity authentication technology.

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