

COVINGTON'S TRADEMARK
PRACTICE



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COVINGTON'S TRADEMARK PRACTICE

Over the past sixty years, Covington has built a world-class trademark advisory and prosecution practice that includes over a dozen lawyers and specialist paralegals with extensive domestic and international expertise. We have far-reaching experience with managing high value and global trademark portfolios. Among the clients to which we currently provide or have provided trademark advisory and/or prosecution services are many well-known companies, including:

- American Automobile Association (AAA)
- AstraZeneca
- Bacardi
- Balkrishna Industries
- Boehringer Ingelheim
- Borgata Hotel Casino & Spa
- Business Software Alliance
- Daiichi Sankyo
- Home Shopping Network
- John Deere
- Kentucky Fried Chicken King Pharmaceutical
- Long John Silver's
- M Financial Group
- Microsoft
- National Basketball Association
- National Football League
- National Geographic Society
- NAVIGON
- New Skies Satellites
- Promontory Financial Group
- Public Broadcasting Service
- Roche Pharmaceuticals
- Smithsonian Institution
- Spirits International
- U.S. Soccer Federation
- The Washington Post Company
- Verizon

We have designed and supervised worldwide registration, maintenance, opposition, cancellation, and policing programs for our clients in foreign countries all over the world, with assistance from our network of foreign trademark counsel in over 175 countries.

ACCOLADES

- *The Best Lawyers in America* (2007-2010).
- *Chambers USA - America's Leading Business Lawyers* (2006-2010)
- *Legal 500 EMEA - Intellectual Property, Belgium* (2010)
- *Legal 500 USA - Trademarks: non-contentious - full coverage: National* (2007-2009)
- *Managing Intellectual Property Global Awards*, short-listed in the pan-European category "New Media/Internet" (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 PORTFOLIO MANAGEMENT

From a client's first inquiry concerning a proposed mark, we undertake to understand and take full account of the client's business needs and brand strategy. We design our trademark advice to respond to the nature of the client's product or service, the manner, scope and duration of its marketing and distribution, the geographic area of use of the mark, the importance to the client of a mark's registrability, and its plans for licensing and other exploitation. We conduct searches of computerized and other trademark databases, evaluate the search results, and depending on a client's needs, we provide either summary or detailed analyses of search results. In addition to including critical data about prior registrations and applications and common law rights that present potential problems, we provide analysis of any problems inherent in the proposed mark and suggest strategies for dealing with any such problems.

Our analysis includes real world considerations such as whether a potential adverse party is known to be litigious. We have prosecuted thousands of trademark applications for registration in the United States and in foreign countries. We inform clients promptly of all developments regarding an application and prepare detailed monthly, quarterly, or as-needed trademark status reports, which we generate electronically from our computerized trademark database and customize to meet our client's needs. These status reports are a useful and cost-effective tool for monitoring developments in each trademark portfolio. We also conduct periodic strategic reviews of our clients' trademark portfolios to ensure that the portfolio's depth and breadth is consistent with the client's brand strategy and business plans.

Although we tailor each trademark management program to meet our client's specific needs, a comprehensive management strategy typically entails:

- a global inventory of trademark registrations and applications;
- an assessment of potential gaps or weaknesses in the portfolio;
- negotiation and execution of assignments and licenses, in consultation with Covington's tax experts; and
- creation of a centralized trademark database to maintain and track all information associated with the trademark portfolio, including important deadlines.

Over the years, Covington has built a global network of trusted local trademark experts, who assist us in researching national trademark registries, registering foreign marks and recording assignments. Our trademark management database is specifically structured to track and manage all filing, registration, renewal, and other deadlines. To reduce the client's overall costs, Covington employs specialist trademark paralegals to perform much of the day-to-day work associated with trademark maintenance.

TRADEMARK TRANSACTION EXPERIENCE

Our trademark lawyers have extensive experience in negotiating and drafting trademark licenses, assignments, coexistence and consent agreements and other complex commercial IP agreements for numerous clients, including AstraZeneca, Boehringer Ingelheim, Bacardi, Borgata, Dunlap Slazenger, Goodyear, King Pharmaceutical, Major League Baseball, NASCAR, National Geographic Society, the National Football League, the National Hockey League, Public Broadcasting Service, UCB and Verizon. As needed, we provide factual and legal analyses of relevant business considerations, including potential liability claims against the licensor, antitrust implications, and the like.

Our trademark lawyers also have been integrally involved in domestic and international corporate transactions involving trademarks and other intellectual property assets, including corporate acquisitions and restructurings. We are frequently called upon to conduct due diligence review of intellectual property portfolios, to perfect security interests in trademarks, and to prepare, supervise and record trademark assignments throughout the world. Our US, European and China offices have worked seamlessly together on complex international acquisitions with significant trademark elements.

TRADEMARK LITIGATION

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.

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- 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.
- 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.

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- 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.
- 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.

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- 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.
- 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

Like trademark litigation, false advertising litigation is governed at the federal level by the Lanham Act. 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.

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 (FTC) 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.

DOMAIN NAME ENFORCEMENT

In the area of domain name-related enforcement and policy issues, our experience and expertise is unparalleled. We have a system in place that allows us to monitor newly-registered domain names for client marks or other keywords, and then to monitor the relevant domain names for fraudulent activity -- in which case, we would take action to cause the activity to cease. In addition, we can work toward a longer term solution such as recovering the domain or taking action against its registrant.

Our relationships with registries, registrars, and ICANN compliance staff often allows us to recover infringing domain names without having to send a demand letter or initiate any proceeding. When it is necessary to initiate a proceeding or send a demand letter, our team has been highly successful. We have recovered hundreds of domain names through UDRP proceedings, litigation under the AntiCybersquatting Consumer Protection Act, demand letters, and acquisitions.

We remain undefeated in UDRP proceedings and ACPA litigation, and recently won the largest victory to date in a UDRP proceeding against a proxy service by recovering 55 domain names registered to Domains by Proxy.

In addition, one of our lawyers sits on the 21-member ICANN GNSO Council and has been deeply involved in policy development in the areas of Whois, domain tasting, and the introduction of new gTLDs. Most recently, she led the efforts for the creation by the ICANN Board of Directors of a team of trademark experts to develop and propose solutions to the issue of trademark protection in the introduction of new gTLDs, and was selected as one of 16 team members.

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MEMBERS OF COVINGTON'S TRADEMARK GROUP

Cox, Evan	Partner	San Francisco
Dove, Ronald	Of Counsel	Washington
Frankel, Simon	Partner	San Francisco
Gallagher -Duff, Kathleen	Of Counsel	Washington
Hamilton, Hope	Associate	Washington
Hanley, Victoria	Associate	Brussels
Hansen, Marty	Partner	Washington
Hoff Varner, Gretchen	Associate	New York
Lavalleye, Marie	Special Counsel	Washington
Leverich, Bingham	Senior Counsel	Washington
Ma, Jason	Special Counsel	Beijing
Nash, Bradley	Associate	New York
Nestor, Shannon	Associate	Washington
Peberdy, Morag	Of Counsel	London
Peets, Lisa	Partner	London
Roman, Neil	Partner	Washington
Rosette, Kristina	Special Counsel	Washington
Saharko, Peter	Associate	Washington
Self, Laurie	Partner	Washington
Strowel, Alain	Of Counsel	Brussels
Tiedrich, Lee	Partner	Washington
Tonsager, Lindsey	Associate	Washington
Wells, Bert	Partner	New York
Young, Mark	Associate	London

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