

Intellectual Property

Primary Practice Contact Wendi E. Sloane

Barack Ferrazzano's Intellectual Property Group offers expertise in the protection, management and enforcement of our clients' intellectual property assets. Our IP group understands the value of trademarks, copyrights, and trade secrets, and how best to select, use and protect these valuable assets. We have extensive experience in all facets of IP practice, including business counseling, licensing, strategic planning, business transactions involving intellectual property, and registration and enforcement of all non-patent intellectual property rights. We represent clients in a broad range of industries, including fashion, cosmetics, automotive, manufacturing, technology, health care, food and beverage, real estate, and financial services.

Trademarks and Trade Dress

We understand that our clients' trademarks, logos and trade dress are the cornerstone of their brands. We have extensive experience in all aspects relating to the development and protection of our clients' trademarks and trade dress, and we count among our clients some of the world's most well-known brands. Our trademark practice includes:

- Trademark Clearance. We conduct trademark clearance on a thorough and cost-effective basis for trademarks and trade dress, both domestically and worldwide.
- Counseling. We counsel our clients on how to strengthen the protection of their trademarks, on proper trademark usage, and on the most cost-effective way to build their brands.
- Prosecution and Maintenance. We regularly handle the registration and maintenance of large worldwide trademark portfolios, as well as opposition and cancellation proceedings. We have a network of skilled foreign associates with whom we have worked extensively.
- Policing. We routinely advise clients on the importance of policing their marks to prevent third-party use, and handle those activities in a cost-sensitive manner, including the implementation of watch services and counseling regarding potentially infringing marks.

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- Complex Transactions. We have handled corporate transactions for famous brands, both domestically and internationally, in the context of acquisitions and sales. Not only are the attorneys in our group skilled at structuring transactions to enhance the protection of all aspects of IP rights, our strong litigation background enables us to identify and provide advice to minimize transactional risks.
- Licensing. We negotiate and draft a wide variety of trademark licenses. We also routinely handle assignments, security interests, and other agreements relating to trademark rights.
- Litigation. Our attorneys have nationwide experience in all aspects of trademark and trade dress litigation, including infringement, counterfeiting, and dilution.

Copyright

Our IP practice group has a strong background in counseling and in protecting our clients' copyrights, including:

- Counseling clients on how to avoid infringement claims;
- Counseling clients on how to develop and protect their ownership of their copyrighted works;
- Drafting license and assignment agreements;
- Advising clients in complex transactions; and
- Litigating copyright infringement lawsuits.

Trade Secrets

We have expertise in the protection of our clients' trade secrets and sensitive business information. We counsel our clients on how to protect their valuable trade secrets by developing trade secret protection programs. We draft, negotiate, and enforce confidentiality and non-compete agreements, and we regularly litigate trade secret disputes across the country.

Software

Our intellectual property attorneys counsel entities and individuals engaged in the development, distribution, licensing and other commercialization of software. This portion of our practice includes software licensing and other agreements, protection of the intellectual property rights attendant to our clients' software assets, and addressing software issues as they arise in the context of mergers and acquisitions. Our work in this area includes:

- Drafting and negotiating software development agreements, distribution agreements, reseller agreements, and traditional and custom licensing agreements;
- Assisting our clients with the preparation of enforceable invention assignment and confidentiality agreements for use with employees and independent contractors;

- Counseling clients on how to protect the proprietary elements of developed and licensed software, including source code, documentation, websites, content, trademarks, copyrights, trade secrets, algorithms and enhancements;
- Identifying and addressing software-specific issues in mergers and acquisitions, including addressing ownership issues, transition matters, and “open source” licensing concerns; and
- Developing software development policies designed to prevent unauthorized use of “open source” software.

Internet

We recognize that the legal issues relating to the Internet, including domain name protection, e-commerce, and the hidden use of trademarks, such as in metatags and key words, constitute a dynamic and increasingly important area of the law. Our IP group is well-versed on these issues and our practice includes:

- Internet domain name acquisition and registration;
- Negotiating agreements and policies relating to Internet issues, including website terms of use and privacy policies;
- Internet domain name infringement and cybersquatting disputes;
- Metatag and key word disputes; and
- Copyright infringement and trade dress claims regarding website copying.

Our Team

Having practiced extensively in both large firm and boutique environments, our intellectual property attorneys bring years of experience and a creative approach to their work. Our intellectual property group includes attorneys with experience in complex contract negotiation, strategic transactions, ongoing business counseling, litigation and dispute resolution. As a result, we maintain an impressive record of crafting favorable outcomes to a wide array of challenges in both transactional and litigation scenarios. Some of our attorneys focus on IP counseling, licensing, business transition and portfolio management matters, while others specialize in IP litigation. Our practice is supported by a highly skilled paralegal and a state-of-the-art intellectual property asset management database system.

Representative Matters

- Copyright Infringement: Literary Works
Represented an author in successfully resolving a copyright infringement claim, without the need for litigation.

- **Copyright Infringement: Textiles**
Represented a quilt manufacturer in successfully defending a copyright infringement claim concerning the fabric patterns used for quilts, without the need for litigation.
- **Intellectual Property Acquisition & Counseling: Luxury Goods**
Represented various divisions of LVMH in the intellectual property aspects of their acquisitions of Bliss, Fresh, Benefit, Urban Decay, Hard Candy, Donna Karan, Belvedere Vodka and other luxury goods manufacturers and distributors, including overseeing all intellectual property-related due diligence activity and negotiating all intellectual property-related provisions of the transaction documents.
- **Intellectual Property Acquisition and Counseling: Alcoholic Beverages**
Represented a division of LVMH in the intellectual property aspects of its acquisition of Millennium Imports, LLC, which held the worldwide rights to Belvedere and Chopin brand vodkas, including overseeing all due diligence activity, and negotiating all intellectual property provisions of the transaction documents.
- **Intellectual Property Acquisition and Counseling: Travel Agency Services**
Represented Accor S.A. in the intellectual property aspects of its sale of an interest in Carlson Wagonlit Travel, including overseeing all due diligence activity, and negotiating all intellectual property provisions of the transaction documents.
- **Trade Dress Infringement**
Represented GIBC, Inc., a well-known micro-brewery (Goose Island Beer), in a trademark infringement action, successfully enjoining a competitor's use of a beer tap handle that infringed upon GIBC's trademarked "Goose Head" beer tap handle.
- **Trademark Infringement**
Represented GoSmile, Inc., in a trademark infringement action filed against CVS, alleging that CVS's USMILE product infringed GoSmile's trademark rights. This case was successfully settled on terms that are confidential.
- **Trademark Infringement: Appellate**
Represented Louis Vuitton Malletier, a division of LVMH, in successful appeal to U.S. Court of Appeals for the Second Circuit from denial of Louis Vuitton Malletier's motion for preliminary injunction against Dooney & Bourke in trademark infringement action.

- Trademark Infringement: Counterfeiting

Represented Fendi, a division of LVMH, in a trademark infringement action against a major discount retailer, arising out of the defendant retailer's alleged sale of counterfeit Fendi handbags, wallets, and other accessories in its warehouse stores and alleged failure to take necessary and appropriate steps to ascertain the legitimacy of trademarked products it purchased from third-party suppliers. The lawsuit was settled on favorable, but confidential, terms.

- Trademark Infringement: Luxury Goods

Represented a division of LVMH in a trademark infringement action, obtaining not only a consent injunction against the infringing party, but also an agreement from the infringer to permanently cease and desist all infringing activity and to pay all legal fees incurred by our client in bringing the action.

- Trademark Prosecution, Policing and Licensing: Cosmetics

Ongoing representation of several cosmetic companies in connection with the prosecution, maintenance, and licensing of their worldwide trademark portfolios, which work has involved preparing cease-and-desist letters to infringing entities and initiating litigation to the extent necessary to protect the client's intellectual property rights.

- Trademark Prosecution, Policing and Licensing: Wine & Spirits

Ongoing representation of a prominent wine and spirits manufacturer and distributor in connection with the prosecution, maintenance, and licensing of its worldwide trademark portfolio, which work has involved preparing cease-and-desist letters to infringing entities and initiating litigation to the extent necessary to protect the client's intellectual property rights.