



## Trademark and Copyright Practice Profile

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Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

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**FINNEGAN**



## I. Introduction and General Information

Finnegan is a full-service IP firm, with more than 375 attorneys, that has been providing IP legal services to global Fortune 500 companies for more than 45 years.

Numerous significant surveys of in-house counsel and our peers confirm our reputation as the leading firm practicing all forms of U.S. IP law. These include:


- **North American Full Service IP Firm of the Year, 2008-2010** (*Managing Intellectual Property*)
- **#1 Tier U.S. Law Firm for Intellectual Property, 2007-2010** (*Chambers USA: America's Leading Lawyers for Business*)
- **#1 Tier U.S. Law Firm for Trademark Litigation & Non-Contentious Work, 2008-2010** (*Managing Intellectual Property's World IP survey*)
- **#1 Tier Law Firm for Trademark Litigation, 2007-2010** (*The Legal 500 U.S.*)
- **#1 Tier Law Firm for Trademark Non-Contentious, 2008-2010** (*The Legal 500 U.S.*)
- **#1 or #2 Tier U.S. Law Firm for Copyright Work, 2008-2010** (*Managing Intellectual Property's World IP survey*)

Our clients include small and large companies, associations and other non-profits, and several government agencies, including the U.S. Securities and Exchange Commission. The range of industries we represent includes pharmaceuticals, medical devices, biotechnology, hospitality, entertainment, insurance, financial services, computers, software, the Internet, chemical, manufacturing, textiles, and consumer products. Our extensive experience with virtually every type of business, product, and service and every facet of IP protection helps us advise clients on the best path to protect, advocate, and leverage valuable IP assets.

## II. Trademark Expertise

Finnegan's trademark practice is renowned for its experience, sophistication, creativity, and depth. We have more than 25 lawyers who practice solely or primarily trademark law. Among our ranks, we have seasoned litigators, two former trademark counsel for major corporations, a European trademark lawyer, and a former Examining Attorney and Administrative Law Judge from the Trademark Trial and Appeal Board (TTAB). Stability is an important hallmark of our trademark practice. The group has seven attorneys with 20+ years of experience with the firm; six attorneys with 10+ years of experience with the firm; and seven attorneys with 5+ years of experience with the firm.


The firm's trademark lawyers are frequently recognized as leaders in the field. Examples include:

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- Two members of the firm's Trademark Practice Group were identified among the top 15 trademark experts in the world in 2009 and 2010, including Dave Kelly, by in-house counsel and peers in Legal Media Group's *Guide to the World's Leading Trade Mark Law Practitioners*.
  - Three members of the Group, including Dave Kelly, were identified among the top 25 trademark experts in the USA by in-house counsel and peers in Legal Media Group's *Expert Guides to the Leading U.S. Lawyers - Best of the Best USA 2009*.
  - In the 2007-2009 U.S. editions of *The Legal 500*, various members of the Group, including Dave Kelly, were highlighted for their reputation in trademark litigation and dispute resolution.
  - *Managing Intellectual Property* named eight of Finnegan's lawyers, including Dave Kelly, in its *2008 Guide to the World's Leading Trademark Law Practitioners*.
  - In 2008, *Legal Times* named Dave Kelly as one of the top 10 "Leading Lawyers" in trademark and copyright law in the Washington, DC area.
  - Three members of the Group, including Dave Kelly, were identified among the top 25 trademark experts in the USA by in-house counsel and peers in Legal Media Group's *Expert Guides to the Leading U.S. Lawyers - Best of the Best USA 2007*.
  - In 2006, *Managing Intellectual Property* named 11 of Finnegan's lawyers, including Dave Kelly, in its *2006 Guide to the World's Leading Trademark Law Practitioners*, with three ranked in the top 20 trademark lawyers in the U.S.

Our practice also includes an enviable core of experienced trademark legal assistants. The experience within our legal assistants runs deep, including twelve with 10+ years of experience. As with our trademark lawyers, there is also great stability with our legal assistants. Eight legal assistants have been with the firm 10+ years, and six have been with the firm for 7+ years. We rely heavily on our legal assistants to deliver high-quality, cost-effective trademark services to our clients, which at many other firms are provided by attorneys billing at much higher rates.


#### **A. Relevant Experience**

The firm's trademark practice is comprehensive and follows the life of a mark from selection, clearance, prosecution, and maintenance to portfolio management, trademark audits, licensing, watch services, and litigation and other contested matters. Finnegan's experience in preparing trademark opinions and in filing, prosecuting, and maintaining both U.S. and international trademark applications and registrations is clearly demonstrated by the number of trademark matters we handle. During a typical year, we provide thousands of trademark clearance opinions. We are currently responsible for nearly 28,000 trademark applications and registrations (U.S. and international), and we regularly manage large global trademark portfolios, including portfolios totaling more than 10,000 registrations/applications covering over 200 countries.



As you can see from the sampling of our client list below, Finnegan has substantial experience representing famous and well-known brands, including some of the world's most valuable brands.

- ABC Television
- ATP (Association of Tennis Professionals)
- Baby Einstein Company
- BBC
- Bridgestone Firestone
- Caterpillar
- Disney
- Emilio Pucci
- Fox Entertainment
- Freddie Mac
- Fuente Cigar
- Genzyme
- Harley-Davidson
- Head
- Human Genome Sciences
- Juniper Networks, Inc.
- KFC
- LG Electronics
- Marriott
- Moody's
- Mitsubishi
- Philips
- Pioneer Hi-Bred
- Pizza Hut
- Ritz-Carlton
- SAIC
- Starbucks
- Subaru
- Symantec
- Taco Bell
- Toshiba

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- Travelers
  - U.S. Securities and Exchange Commission
  - Welch's
  - Yahoo!
  - Yamaha

We also count among our clients numerous associations and certification organizations, including: The American Petroleum Institute, PhRMA, the American Chemical Society, the National Council for Interior Design Qualification, National Council for Therapeutic Recreation Certification, Behavior Analyst Certification Board, National Board for Certification of Hospice and Palliative Nurses, the Certified Financial Planner Board of Standards, ABRET, and The Optical Society.

#### **B. U.S. Clearance, Prosecution, and Portfolio Management**


Before clients adopt a trademark, we advise them on strategies for selecting “strong” marks that are immediately protectable and registrable. If a client prefers to use a term or mark descriptively, we advise on how to use the term to place the client in the best possible position should it be challenged. Our counseling during the early phases of trademark development helps avoid costly conflicts or enforcement problems in the future.

Once a mark is selected, we conduct availability searches and render clear, practical opinions. We carefully evaluate each search request to ascertain the goods or services to search, the type of search to order, and whether to search any supplemental sources. Moreover, our opinions are not based solely on the search results as they appear in the search report. With the assistance of our in-house investigators, we investigate relevant marks and names to determine if they are in use and, if so, the nature and extent of any rights their owners may possess. Our extensive litigation experience allows us to provide realistic opinions on a mark's availability, as well as practical recommendations on using and registering the mark to avoid or minimize potential problems.

Once a mark is cleared, trademark filings are not simply routine administrative matters—we work to develop an appropriate strategy regarding the form of the mark and how broadly or narrowly to describe goods or services. We take into account the search results and possible disputes down the road. We also consider future plans for the mark to make sure all relevant goods or services are covered by the application. In prosecuting applications, we provide practical advice on the best and most efficient ways to respond to refusals.

#### **C. Trademark Litigation**

Our counseling services often begin at a trademark's inception with proactive advice during the selection and prosecution process to help avoid or minimize the chances of litigation. But when problems arise and valuable trademark rights are at stake or an accusation of infringement has



been made, we believe it pays to have seasoned litigators on your side. Finnegan's singular focus on intellectual property brings a peerless depth to our litigation practice. We have handled cases that span numerous industries and implicate all types of trademark rights. Representing both plaintiffs and defendants, our lawyers have decades of experience litigating both large and small trademark cases before courts throughout the country. We regularly appear before the U.S. Patent and Trademark Office's Trademark Trial and Appeal Board, the International Trade Commission, and federal district courts. When you work with Finnegan, you have a smart, seasoned champion in your corner. For example, we have:


- Filed and defended 600+ U.S. trademark oppositions and cancellations in the past five years
- Filed and defended 140+ U.S. trademark civil litigations in the past five years
- Filed or defended 450+ complaints under ICANN's Uniform Dispute Resolution Policy (UDRP)
- Filed and defended 75+ civil litigations in the U.S. involving domain names

Our vast litigation experience makes our attorneys well versed in the best ways to approach cases, whether large or small or complex or straightforward. We assess the potential risks and rewards of disputes and provide creative solutions and effective settlement strategies for clients of all sizes. At Finnegan, we understand that "victory" comes through many channels and in many forms. With our experienced trademark litigators, we are fully prepared and qualified to litigate through trial and appeal. We also have an impressive track record of achieving our clients' goals before verdict. Our ability to obtain successful results in summary judgment or other pre-trial proceedings, PTO proceedings, arbitrations, and settlement negotiations means we often resolve cases long before trial and at considerable savings to clients. Simply stated, a successful litigation outcome is one that meets your business goals in the most cost-efficient manner possible.

Summaries of our recent U.S. trademark litigation successes are provided below.

#### **Infringement and Dilution**

- Successfully defeated a motion for preliminary injunction filed by the owner of the mark SOOTHIES for gel pads for breast feeding to enjoin Philips and Learning Curve from selling SOOTHIE-branded baby bottles and bottle nipples.
- Defeated a motion for preliminary injunction filed by Wells Fargo subsidiary, H.D. Vest, Inc., seeking to enjoin defendant from using his personal name H.D. Vest in connection with his businesses.
- Contrary to plaintiff's allegation that X/Open falsely claimed ownership of the UNIX trademark in an opposition proceeding against plaintiff, the Court ruled on summary judgment that undisputed fact established (1) X/Open and co-defendants Novell and SCO's prior agreements and dealings confirmed X/Open's ownership of the UNIX mark, (2)




X/Open had the right to assert the UNIX mark against plaintiff in the opposition proceeding, and (3) plaintiff suffered no damages as a result of the defendants' actions.

- Obtained a preliminary injunction for Caterpillar against use of the word marks GAI, GAIERBILLART, GAIERPILLAR, GAIERPOLLAR, the yellow and black color combination for footwear and any associated packaging or labels, and/or any other trademarks, trade names, trade dress, logos, or other names or identifiers that are confusingly similar to the CATERPILLAR or CAT marks and/or Caterpillar's footwear trade dress.
- Obtained a preliminary injunction for Capital One against use of the CAPITAL ONE mark and name and any confusingly similar marks and names in the solicitation and marketing of limited-merchandise credit cards; following an evidentiary hearing on a motion for contempt, obtained a modified injunction imposing added requirements on the defendant's business activities, including that defendant must record all phone solicitations in their entirety.
- Obtained summary judgment that Toyota's use of the mark TOYOTA MATRIX for passenger automobiles did not infringe plaintiff's mark MATRIX for race cars and related components and parts; finding the case to be exceptional, the Court awarded Toyota its attorneys' fees and costs. On appeal, the Ninth Circuit affirmed both the grant of summary judgment as well as the fees and costs award.
- After a full trial on the merits, obtained a decision that Gateway's cow-spots trademark is strong and famous, and that the defendant's black-and-white spotted plush novelty computer monitor wraps infringed Gateway's trademark and trade dress rights. Obtained an affirmance of the decision on appeal before the U.S. Court of Appeals for the Eighth Circuit.
- Obtained a jury verdict (as co-counsel) that use of the marks CITIZENS BANK and CITIZENS for banking services infringed the senior user's rights in the mark CITIZENS for banking services; and a reversal on appeal (as co-counsel) of the district court's refusal to enjoin the infringer and its injunction against the senior user.
- Obtained summary judgment that plaintiff's YKK mark for zippers is "afforded the widest ambit of protection from infringing uses" because it is "famous throughout the world," and that defendant's use of the name and mark YPP for zippers infringed plaintiff's mark, even among sophisticated industry purchasers.

#### **Counterfeiting/Gray-Market Goods**

- Obtained an ex parte seizure order and a temporary restraining order in a Missouri case against the defendant's sale of counterfeit gaming miniatures, sold primarily on the eBay online auction website. After an evidentiary hearing, later obtained injunctive relief and monetary sanctions against defendant. Subsequently obtained summary judgment on liability and an award of attorneys' fees and costs.
- We obtained ex parte seizure orders in a case in New Hampshire involving counterfeit memory modules, some of which had been sold to the Department of Energy for use in two government atomic power labs. The resulting seizure netted millions of dollars worth of counterfeit products, each of the defendants paid significant fines, and permanent injunctions entered against all the defendants. The U.S. Attorney's Office, in conjunction



with the FBI and the U.S. Postal Service, continue to investigate potential criminal action against the defendants.


- Handled cases in California and Florida involving counterfeit cigars, which resulted in the seizure of a substantial amount of counterfeit products and packaging, and entry of injunctions against such activity.
- Handled a series of nine lawsuits in Alabama, Arizona, Connecticut, Nevada, and Texas (Dallas and Houston) involving counterfeit and/or gray-market prescription human-growth hormones. Our work in these matters resulted in nine ex parte TROs and five ex parte seizure orders, which led to the seizure of more than 20,000 packages of counterfeit products.
- Obtained a seizure order in a Florida case involving counterfeit toothbrushes, leading to the seizure of thousands of counterfeit toothbrushes.
- Obtained an ex parte seizure order in a California case involving counterfeit over-the-counter cold medicine and pain relievers, leading to the seizure of massive quantities of counterfeit products and packaging.

#### **False Advertising**

- Obtained summary judgment that client's press releases about a separate design patent case between the parties did not constitute false advertising because they were not material, nor were they likely to harm plaintiffs.
- Obtained a temporary restraining order enjoining a nightclub from falsely advertising that Cirque du Soleil would be performing at a New Year's Eve party.
- Obtained a decision in a binding arbitration for a major dishwasher detergent and rinse-aid manufacturer that a competitor's use of the wording "built-in rinse aid" for its dishwasher detergent was false and deceptive.

#### **TTAB Litigation**

- Successfully overturned on appeal the PTO's refusal to register the certification mark CERTIFIED THERAPEUTIC RECREATION SPECIALIST on grounds of genericness and lack of secondary meaning.
- Obtained a decision from the Federal Circuit reversing the TTAB's refusal to register the mark THE AMERICAN SOCIETY FOR REPRODUCTIVE MEDICINE on the ground that the wording SOCIETY FOR REPRODUCTIVE MEDICINE was generic.
- Successfully opposed an application for the mark AAPS PHARMSCI for "[c]omputer services, namely, providing an on-line journal of interest to researchers in the pharmaceutical and drug field," based on common-law rights in the mark PHARMSCI for a print journal in the field of pharmaceutical sciences.
- The TTAB granted judgment in favor of Italian design house Emilio Pucci (subsidiary of luxury goods conglomerate LVMH Moët Hennessy), finding that the defendant's mark EMIDIO TUCCI for apparel and accessories is confusingly similar to the client's long-used



EMILIO PUCCI mark for fashion products and that the mark had developed “substantial renown” in the field of apparel and accessories and become a “well-established brand.”

- Successfully litigated an opposition against the mark HOLY-DIVINESON and design for “hats; headwear; shirts; t-shirts” on the ground of likelihood of confusion with the HARLEY-DAVIDSON and HARLEY trademarks and Harley-Davidson’s BAR & SHIELD logo for, among other things, motorcycles, clothing, and headwear. This decision is significant because it is one of a few decisions to hold that the HARLEY-DAVIDSON and HARLEY marks, and the BAR & SHIELD logo are famous and entitled to a broad scope of protection in connection with motorcycles, parts and accessories, clothing and headwear. It is also the first decision to hold that Harley-Davidson’s “bar and shield logo, regardless of wording and other matter, is itself a famous mark in connection with at least motorcycles, clothing and headwear.”
- Prevailed in an opposition against the GAP ONE mark for general business merchandising services, namely, marketing, on the ground of likelihood of confusion with the GAP trademarks for retail store services and clothing; the TTAB ruled that the “GAP trademarks are famous and thus entitled to a broad scope of protection” in deciding the likelihood-of-confusion claim.
- Successfully opposed an application for an embossed design for paper towels, facial tissues, paper napkins, and toilet paper on the ground that it was confusingly similar to the registered embossed designs used by Opposer on its BRAUNNY paper towels.
- Successfully opposed an application for the mark INQUEST for database and research software based on likelihood of confusion with the registered mark PROQUEST for information retrieval software, databases, and services; in assessing the strength of the PROQUEST mark, the TTAB held that the PROQUEST mark was famous within the academic, research, and education fields.
- Successfully opposed an application for the mark LESSBUCKS COFFEE for coffee, tea, and coffee and tea-based beverages and related retail store services based on a likelihood of confusion with the famous STARBUCKS and STARBUCKS COFFEE trademarks; the TTAB determined that STARBUCKS is truly a famous trademark, and that the evidence presented in this case of extensive public recognition and renown exceeded that in other cases involving famous trademarks. 78 U.S.P.Q.2d 1741 (TTAB 2006).
- Successfully argued that the applicant/registrant’s marks SCREAMIN’ EAGLE and SCREAMING EAGLE for clothing, bags, jewelry, pins, mugs, posters, and other goods were confusingly similar to opposer/petitioner’s common law mark SCREAMIN’ EAGLE for similar goods sold as collateral products to its SCREAMIN’ EAGLE line of motorcycle parts and accessories. 2004 TTAB LEXIS 595 (TTAB 2004).
- Successfully opposed an application to register the mark INNOJECT for “medical syringes” based on the registered mark INNOLET for “medical disposable hypodermic syringes.”
- Successfully opposed an application for the mark FRIO CAPPUCCHINO for “non-alcoholic coffee-based beverages containing milk” on descriptiveness grounds; prevailed on summary judgment.


- Obtained a decision from the Federal Circuit vacating and remanding the TTAB's decision that the mark FIDO LAY for dog biscuits was not confusingly similar to the mark FRITO-LAY for snack foods, and then a decision from the TTAB finding that the marks were confusingly similar.
- Successfully opposed an application for the mark MAGIC SWINGDOM for children's instructional sports videos based on Disney's mark MAGIC KINGDOM for theme-park services.

#### **D. Domain Name/Internet Conflicts**

Finnegan has developed an international reputation as a leading expert in the field of domain names and other trademark-related Internet issues such as metatags, linking, spamming, and keywords. We have handled more than 75 civil litigations in the U.S. involving domain names. The firm has also filed or defended more than 450 complaints under ICANN's Uniform Dispute Resolution Policy (UDRP) for more than 100 different clients. Dave Kelly is a UDRP panelist for WIPO. We have also handled disputes under the ccTLD disputes of various countries, including .ir, .uk, and .us.

Because of the pervasive nature and extent of cybersquatting and infringement activity on the Internet, we have assisted clients in developing domain-name registration strategies to help avoid or minimize more costly enforcement work down the road. We also help clients manage and prioritize enforcement efforts by developing enforcement guidelines and strategies. Our recent successes in domain name litigation include:

- Obtained an order in an in rem case involving 1,866 domain names to waive the publication requirement of ACPA, which meant that Yahoo! did not have to incur the substantial expense of publishing notice of the action in foreign newspapers in each of the 85 different countries where the 640+ registrants were located; that same order also permitted service of the order and further papers on the remaining domain name owners only by e-mail, which meant that Yahoo! did not also have to incur the expense and time of serving papers by postal mail; we recovered virtually every one of the 1,866 domain names through settlement agreements and consent judgments or through default judgment.
- Obtained an award of \$225,000 in statutory damages under the ACPA as well as attorney's fees based on the defendant's registration and use of the domain names yahoomoving.com, yahoomovers.com, and yahoovanlines.com for a website to promote its moving business.
- Obtained an award of \$100,000 in statutory damages under the ACPA as well as attorney's fees based on the defendants' use and registration of the domain name yahoo loans.com for online loan services.
- Obtained an ex parte temporary restraining order for KFC in an in rem action against use of the domain name kfclolitas.com for a pornographic website along with an order transferring the domain name to KFC pending final disposition of the case.

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- Successfully prosecuted an in rem action under the ACPA on behalf of Disney against 35 domain names owned by 24 different registrants.
  - Obtained a temporary restraining order for Yahoo! enjoining the defendants from using the domain name 21yahoo.com for a website at which it was offering free stock in 21Yahoo.com, Inc.
  - Obtained an ex parte temporary restraining order for The Washington Post against typosquatters who registered the domain name washintonpost.com and used it for an adult-entertainment website.

### **III. Copyright Expertise**


Finnegan has been a leader in copyright protection and counseling for more than 45 years. Among other distinctions, Finnegan has been recognized by *Managing Intellectual Property* as a #1 and #2 tier U.S. law firm for copyright work (2008-2010). Finnegan boasts several copyright experts including Art Levine, former Copyright Office official and executive director of the National Commission on New Technological Uses of Copyrighted Works, which ensured that digital works and computer programs were protected by copyright law; John Hornick, who litigated one of the first open source cases in the U.S. and has broad experience with copyright development agreements and licenses; Larry Robins, who served as Worldwide Copyright Counsel for Digital Equipment Corporation and recently secured a preliminary injunction in a copyright infringement dispute regarding code developed in China; Jay Westermeier, founder of Georgetown University Law Center's Advanced Computer and Internet Law Institute, and a frequent expert in disputes regarding all aspects of copyright law; and Margaret Esquetet who has particular expertise in Copyright Office rules and practice, legislative developments, rights-clearance, and social-media issues.

#### **Copyright protection in a digital world**

The Internet and today's digital technology have singularly changed the ability to disseminate and share information around the globe. Traditional copyright principles have come under attack, drastically affecting copyright owners and those who wish to make full use of digital media. To maintain a competitive advantage, companies and organizations need clear guidance and creative solutions to protect and enforce their copyrighted works. Companies that rely on third-party content need guidance regarding their responsibilities to copyright owners.

#### **Full-service protection across a wide range of industries**

We counsel associations, publishers, multi-billion dollar entertainment companies, numerous manufacturers, nonprofit organizations large and small, standard-setting entities, major retailers, and other business entities on protecting their copyrights and fair use of third-party copyrighted works. We register copyrights, expedite applications, record documents, and perform title searches. We render opinions on copyrightability, fair use, infringement, ownership and title, notice, security interests, and foreign protection. We also draft and negotiate agreements involving copyrighted works, including joint-development agreements,



licenses, assignments, rights-clearance, and distribution agreements. Our copyright practice covers the spectrum of copyrightable works, including: logos and product packaging; secured exams; study and continuing education materials, including podcasts, webinars; software and databases; film and video productions; technical and architectural designs; and books, magazines, and other publications. We also know social media and guide our clients through constantly-changing best practices. Our standards-setting clients use our knowledge of ISO and ANSI to ensure that their rights are respected.

### **Realizing the full potential of your copyrighted works**

Depending on your business, a copyright audit may reveal opportunities for registration, enforcement, and licensing that can generate revenue streams and open new markets. These contracts may be simple licenses or complex strategic alliances. Finnegan is a pioneer in licensing and in the development of IP transactions. Our lawyers played an instrumental role in the establishment and ongoing leadership of the Licensing Executives Society.

### **Litigation experience makes a world of difference**

Copyright litigation can be highly complex, and when there is no other means of settling a dispute, Finnegan provides a formidable force. Whether the issue is enforcing your copyrights or protecting you from infringement claims, our team draws on decades of litigation experience in courts throughout the country. We represent many clients before the U.S. Copyright Office and the U.S. Customs Service, and our lawyers frequently serve as expert witnesses.

### **Representative Copyright Engagements**

- **Finnegan helps a secured exam publisher enforces its rights**

An organization of scientists implemented Finnegan's proposed copyright registration and enforcement strategy for its secured exams and study materials. Now, when the organization finds its study materials or exams posted on the Internet or exchanged by email, it is ready to take quick and forceful action. For example, we filed an infringement suit, which quickly concluded with a Consent Judgment. Our client was then able to use this enforcement effort in an advertising campaign aimed at educating the community about its rights. The registrations also allow Finnegan to quickly issue persuasive notices and subpoenas under the DMCA and obtain the identity of infringers.

- **Finnegan acts quickly after secure certification exam compromised**

When an organization that certifies medical personnel discovered that its secure certification exam had been compromised, Finnegan acted quickly to minimize the harm by obtaining an expedited certificate of registration from the U.S. Copyright Office and negotiating a favorable settlement for the client, including reimbursement of the organization's attorney's fees and costs of dealing with the comprised exam.



- **Represented developer of wireless networking technology after joint venture failure**

When the developer of a wireless networking technology found that its relationship with a joint venture partner had failed, Finnegan represented the developer in a copyright litigation in federal court in the Eastern District of Pennsylvania.

- **Represented plaintiff between two social-networking websites in Federal Court over copyright claims**

Finnegan represented the plaintiff in a long-running copyright battle between two social networking websites in Massachusetts and California federal courts, which established new law on subject matter jurisdiction over copyright claims in federal court.

- **Major media company on the defensive**

When a major new organization was accused of copyright infringement, it relied on Finnegan to evaluate the claims and defend against the spurious suit in the Eastern District of Michigan. Finnegan's mediation brief established that our client did not infringe, and a favorable settlement followed.

- **Software code for video-game controllers developed in China is protected in a copyright infringement claim**

The United States District Court for the Eastern District of Virginia ruled in favor of firm clients SplitFish AG, SplitFish Gameware, Inc., and Nabon Corp., granting a preliminary injunction against Bannco Corp. that prohibits Bannco from selling video-game controllers that incorporate or use software code copied from our clients' "FragFX" video-game controllers. The case is unusual in that the software in question was developed in China and the Court applied Chinese law in order to establish that our client was the copyright owner.

- **A fabric design gets the protection it deserves**

After its own efforts at registering a fabric design failed, this couture fashion client came to Finnegan to handle the appeal and obtain protection for the coveted and often-infringed pattern. Our knowledge of Copyright Office appeal procedures and substantive law persuaded the Office to overturn the examiner's decision and register the design.

- **A U.S. registration saves the day in China**

A prominent restaurant chain needed a certified copy of its deposit, the chain's logo, on an expedited basis, to file as evidence in a litigation in China. The deposit copy was lost and the client was unsuccessful in convincing the Copyright Office to remedy the problem. The restaurant chain turned to Finnegan, counting on our expertise in Office practices and our



relationships with Office personnel. We persuaded the Office to accept and certify a new copy of the logo, in time to meet the Chinese deadline.

- **We know ANSI and ISO**

Your organization sets the standards. Literally. That may mean that you would like ISO and ANSI to adopt your standard; or you want to be the standards developer; or you qualify to be the ISO 17024 certifier. Or, you want the space to yourself. Finnegan helps standard-setting organizations navigate the ISO and ANSI processes to ensure that our clients' interests are respected and its copyrights are protected.

### **III. Conclusion**

If you have any questions or need additional information, please contact Dave Kelly at 202.408.4050 or [david.kelly@finnegan.com](mailto:david.kelly@finnegan.com), or Margaret Esquenet at 202.408.4007 or [margaret.esquenet@finnegan.com](mailto:margaret.esquenet@finnegan.com).