

Intellectual Property Trademarks, Copyright & Licensing

Sullivan & Worcester LLP uses its extensive experience in both business and legal matters to find cost-effective and cost-appropriate solutions to clients' needs. S&W handles all aspects of our clients' intellectual property programs, including counseling in the acquisition and licensing of trademarks and copyrights, initiating and maintaining extensive trademark and copyright registration programs, including defense and prosecution of opposition proceedings before the Trademark Trial and Appeal Board, and enforcing intellectual property rights worldwide against infringers, counterfeiters, dealers in gray market goods, and cyber-squatters.

LICENSING

S&W also has considerable experience assisting clients with the business advice, business connections, and legal expertise necessary to create successful and profitable licensing programs. Such work has included negotiating and preparing a wide array of intellectual property-related agreements, including multi-million dollar licensing agreements, as well as endorsement, distribution and manufacturing agreements. Through our efforts, the City of New York was able to create the first commercially viable municipal licensing program.

INTELLECTUAL PROPERTY ENFORCEMENT

Our enforcement work includes extensive experience in domestic and international investigations into infringing, counterfeiting and gray market activity for a wide variety of consumer goods, using a select network of investigators and local counsel. We establish comprehensive enforcement programs using a variety of tools and techniques, such as service of cease and desist letters, criminal prosecutions, U.S. Customs enforcement to bar importation of unauthorized goods, and civil actions. Our experience has shown that vigorous enforcement of intellectual property rights outside of the litigation context can effectively reduce reliance on litigation, and result in cost-savings to our clients.

REGISTRATIONS

Our intellectual property registration and maintenance programs include full service work in connection with the clearance, prosecution and maintenance of trademark and copyright registrations, both domestically and abroad.

CASE STUDIES

New York City Police Foundation

In the aftermath of 9/11, the symbols and logos of the New York City Police Department became some of the

most widely recognized symbols in the United States. Prior to 9/11, however, the City of New York had done little to protect, let alone exploit, the tremendous commercial value of its trademarks. Working with the New York City Police Foundation, a not-for-profit corporation that raises funds for the NYPD, S&W lawyers developed for the NYPD trademarks the nation's first commercially successful municipal licensing program. This program, which included both establishing a licensing program and enforcing the City's rights against bootleggers and other manufacturers and sellers of counterfeit merchandise, allowed the NYPD to supplement its income stream, better control the commercial use of its intellectual property, and ensure that consumers purchasing NYPD-branded goods could do so with the confidence that their purchases would be benefiting the brave men and women who serve in the NYPD. As part of the municipal licensing program, the Intellectual Property Group further developed a program to ensure that television and movie producers, who historically have used the symbols and trademarks of the NYPD without permission or compensation to the NYPD, recognize the City's rights in the trademarks and, where appropriate, make charitable contributions to the NYPD.

Arnold Palmer, Jack Nicklaus and Tiger Woods

With the burgeoning growth of the sports memorabilia industry in the 1990's, these legendary golfers found that professional autograph collectors and merchandisers had been creating, without their consent, a nationwide memorabilia business where unlicensed photographs of their images, and autographs – some legitimate, most forged -- were being sold to fans for hundreds or, in some cases, thousands of dollars. Working with the golfer's licensing agents, S&W lawyers embarked on a multi-year, nationwide enforcement program to eliminate this illegal trade. The enforcement program consisted of using investigators and handwriting experts to locate and identify purveyors of the illicit materials, and sending hundreds of cease and desist letters, as well as obtaining press coverage in connection with the efforts. In the handful of incidents where investigation targets refused to cooperate, the Intellectual Property Group brought civil actions alleging trademark infringement as well as violation of the golfers' publicity rights, all of which resulted in successful conclusions.

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L’Koral Industries

Since its product launch in the fall of 2000, *Seven for All Mankind* Jeans, also known as *7 Jeans*, have been one of the hottest trends in upscale jeans, with fashion and brand-conscious purchasers paying well over \$120 per pair for these “must have” jeans. Without the benefit of any advertising, 7 Jeans have received extensive coverage in leading national fashion magazines such as *Cosmopolitan*, *Glamour* and *Vanity Fair*, and have appeared on television shows such as “Friends,” “Will and Grace,” “Sex and the City,” “The Sopranos,” “Buffy the Vampire Slayer,” and movies such as “Bruce Almighty” and “The Italian Job.” With this success, however, comes knock-off artists and counterfeiters. L’Koral turned to S&W to deploy a nationwide anti-counterfeiting enforcement program, which recently led to the seizure of 1,400 pairs of highly sophisticated fake jeans from a New York distributor, as well as the voluntary turnover of hundreds of additional pairs of fakes from retailers across the United States. S&W also has worked with U.S. Customs to stop the shipment of counterfeit merchandise from crossing U.S. borders.

The University of Notre Dame

With its long history of successful athletic teams and an extremely loyal and proud alumni base, the University of Notre Dame has been able to develop a licensed-merchandise program that rivals many professional sports teams. However, the popularity of the University and merchandise bearing the Notre Dame trademarks, including the famous “Fighting Irish” Leprechaun, also results in numerous unauthorized uses of these trademarks by merchandise vendors and others that want to associate themselves with Notre Dame. S&W lawyers have successfully protected the Notre Dame trademarks in a wide variety of cases, including, preventing the use of the term “Notre Dame” in the name of a web site selling tickets to collegiate sporting events, forcing a tavern to take down signage bearing reproductions of the Notre Dame Leprechaun, and seizing counterfeit merchandise bearing Notre Dame trademarks from unlicensed manufacturers.

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For further information about our Intellectual Property – Trademarks, Copyright & Licensing practice group, please visit our website at www.sandw.com or contact:

Kimberly B. Herman at kherman@sandw.com or 617 338 2943
Mitchell C. Stein at mstein@sandw.com or 212 660 3042

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Current & Former Clients

The All-England Tennis Club (Wimbledon)

Arnold Palmer Enterprises

John Calipari

Comedy Partners/Comedy Central/South Park

ETW Corp. (Tiger Woods)

FDNY Fire Safety Education Fund, Inc.

Flexor Sports Training, LLC

International Management Group

Joester Loria Group

King World

L'Koral Inc. (Seven For all Mankind jeans)

Madison Square Garden Corp.

Major League Baseball Properties, Inc.

NBA Properties, Inc.

NCP Marketing Group, Inc. (Billy Blank's Tae-Bo Fitness Program)

NFL Properties, Inc.

NHL Enterprises, Inc.

Nassau Veterans Memorial Coliseum

New York City Police Foundation, Inc.

Nintendo

Pasadena Tournament of Roses Association

Pearl Jam

Radio City Music Hall Productions, Inc.

Pete Sampras

Spice Girls, Ltd.

Time-Warner Entertainment Company L.P.

University of California at Los Angeles (UCLA)

University of Notre Dame Du Lac

University of Southern California (USC)