

Dear Friends and Colleague

Happy 2022! We hope your year is off to a good start. As we look forward to the year ahead, we are pleased to share with you some exciting news about our firm since we published our last e-News.

### **Selected Decided or Settled Cases**

#### **KARS 4 KIDS Service Mark Appeal**

#### ***Case sent back to District Court to consider our arguments***

[Jonathan Z. King](#) successfully represented Kars 4 Kids, Inc. (“K4K”), after we were engaged as co-counsel in an appeal to the Third Circuit. K4K and a Texas company named America Can! Cars for Kids (“AC”) are charities that sell donated vehicles to raise funds for children’s programs. The parties had sued each other for infringement.



We were not involved in the trial in which the jury had found that K4K infringed AC’s rights only in Texas. The District Court had enjoined K4K’s use of the mark in Texas, and following a bench trial on remedies, the District Court declined to apply laches and ordered K4K to disgorge over \$10 million in profits relating to its Texas activities.

Both parties appealed. The Third Circuit accepted our arguments that the District Court had misapplied the law of laches by failing to consider AC’s actual and constructive knowledge of K4K’s activities, and by failing properly to analyze with specificity the prejudice K4K suffered by the delay. The Circuit Court also accepted our argument that the District Court had failed to consider all the equitable factors necessary to justify the award of profits. This case was remanded to the District Court to consider the issues raised by the Third Circuit. *Kars 4 Kids, Inc. v. America Can! Cars for Kids*, Nos. 20-2813, 20-2900 (3d Cir. August 10, 2021).

## **JUMANJI Trademark**

### ***Prevails against effort to register JU'MAÑJI for clothing***

[Richard S. Mandel](#), [Lynn S. Fruchter](#), and [Joelle A. Milov](#), succeeded on behalf of our client TriStar Pictures in opposing an application to register JU'MAÑJI for clothing based on the continuing fame and recognition of the original JUMANJI movie starring Robin Williams. Although the JUMANJI mark had not been licensed for clothing for many years following the original theatrical release in the 1990's, the motion picture remained in continuous distribution through cable television, DVDs, streaming and other platforms.



Finding those entertainment uses to be sufficiently related to clothing to create a likelihood of confusion, the Trademark Trial and Appeal Board (TTAB) sustained the opposition despite the applicant's insistence that he was unaware of the movie when he filed the application before the release of our client's sequel JUMANJI: WELCOME TO THE JUNGLE and the revived licensing program that accompanied it. *TriStar Pictures, Inc. v. Christian St. Fort*, Opposition No. 91239967 (T.T.A.B. July 13, 2021).

## **Lehman Brothers Trademarks**

### ***Protected Against Bogus Investment Company***

[Eric J. Shimanoff](#), [Joelle A. Milov](#), and [Justin I. Karasick](#) handled a successful complaint on behalf of clients Barclays PLC and Barclays Capital, Inc., which had acquired many Lehman Brothers bankruptcy assets, including its trademarks. We succeeded in obtaining a consent judgment and permanent injunction against a company that purported to offer financial services under the mark SHEARSON LEHMAN, a LEHMAN BROTHERS Company, using the same font and stylization as Lehman Brothers, listing Lehman Brothers' old address on Vesey Street, and referring to itself as an investment bank with over 100 years of experience.

# LEHMAN BROTHERS

The injunction also required the defendants to withdraw numerous LEHMAN formative trademark applications and registrations worldwide, including in Andorra, Serbia, Panama, Slovenia, Nepal, Belize, Cayman, Anguilla, and the Philippines. The case is significant in that it established the continued vitality and strength of the LEHMAN BROTHERS marks and provided our clients with extra-territorial relief in jurisdictions where trademark enforcement is more difficult. *Barclays PLC v. Sklarov*, 20-cv-08437 (S.D.N.Y. March 17, 2021).

### **Copyright Infringement Claim**

#### ***Defeated musical composition ownership gap***

[Jonathan Z. King](#) and [Thomas Kjellberg](#) obtained summary judgment dismissing all claims against client Atlantic Records on grounds that Plaintiffs could not prove standing and ownership of musical composition “Jam the Box” allegedly infringed by Atlantic’s recording of Flo Rida’s and Will.I.Am’s song “In The Ayer.”



The District Court ruled in our client’s favor, finding that “Music Specialist, Inc.” could not sue for copyright registered in the name of a different entity, “Music Specialist Publishing.” The Court also adopted the holding of the U.S. Court of Appeals for the Second Circuit that a copyright plaintiff is limited to three years of damages, regardless of whether it knew or should have known of its cause of action within the three-year statute of limitations under the Copyright Act. *Nealy v. Atlantic Recording Corporation*, 2021 U.S. Dist. LEXIS 105115 (S.D. Fla. June 4, 2021) (This decision has been appealed to the U.S. Court of Appeals for the Eleventh Circuit).

### **Chicago Cubs Trademark**

#### ***Protected against clothing from an obsessed fan***

[Richard S. Mandel](#), [Mary L. Kevlin](#), and [Joelle A. Milov](#) successfully represented Chicago Cubs Baseball Club, LLC in opposing applications filed by Cubsessed, LLC (a company owned by an admittedly obsessed Chicago Cubs fan) to register CUBSESSED and IAMCUBSESSED for clothing.

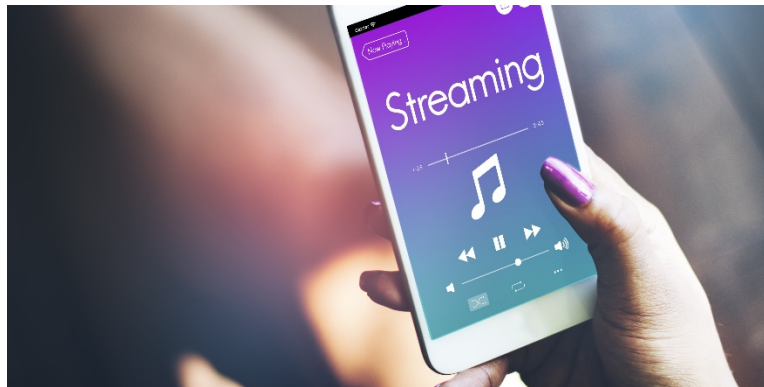


The applicant conceded that the CUBS marks were famous, and the TTAB found that they were “commercially quite strong.” Given the large variation of CUB/CUBS marks combined by the club with other words, the TTAB held that “the term CUBSESSED could very well be perceived as a new CUBS mark coined by the team to cater or refer to its most devoted fans; and CUBSESSED/IAMCUBSESSED clothing could be perceived as team gear designed to enable those fans to proudly display their ‘CUBSESSION.’” *Chicago Cubs Baseball Club LLV v. Cubsessed, LLC*, Opposition No. 91239415 (January 29, 2020).

## **6.6 Million Dollars in Royalties**

### ***Awarded for streaming sound recordings***

[Eric J. Shimanoff](#), [Jonathan Z. King](#), [Joelle A. Milov](#), and [Raphael Nemes](#) represented recording companies Warner Music Group, Sony Music Entertainment and The Orchard in a breach of contract action against a mobile service provider for non-payment of royalties for streaming sound recordings.



After dismissing the defendant’s counterclaims, the Court granted judgment to our clients totaling over 6.6 million dollars. *Warner Music Inc. v. ROK Mobile Inc.*, 651155/2018; *Sony Music Entertainment v. ROK Mobile Inc.*, 652138/2018; *Orchard Enterprises NY, Inc. v. ROK Mobile Inc.*, 652139/2018 (S. Ct., NY Cty. 2020).

## **Military Justice**

### ***Army Discharge Upgraded***

[Ronald Meister](#) and [Raphael Nemes](#) successfully petitioned the Army Discharge Review Board for an upgrade of a veteran’s characterization of service from General to Honorable. Our client, a former soldier, had served almost two years without a disciplinary record when he was arrested off base and ultimately charged with operating a vehicle after consuming alcohol while underage—an infraction under applicable state law. The Army discharged the soldier with a General Discharge, which is normally reserved for more serious offenses, and which deprived him of certain education benefits under the GI Bill of Rights. In addition to emphasizing the minor nature of the driving infraction, we described the soldier's post-discharge accomplishments and goals, obtained helpful references, and were able to persuade the Board to vote unanimously to upgrade his discharge to Honorable.

## Announcement

We are pleased to announce that our firm has elected [Jeffrey Chery](#) as Partner, and [Joelle A. Milov](#) as Counsel.



[Jeffrey Chery](#)

[Jeffrey Chery](#), St. John's University School of Law (JD 2008; CALI Award for Excellence in Constitutional Law and Race and Corporate Law; Dean's List; President, Black Law Students Association; Secretary, Entertainment and Sports Law Society); University of Florida (BS 2003 *cum laude*; President's List; College of Health and Human Performance Dean's List; Golden Key Int'l Honor Society; Co-founder and Vice President, Student Sport Management Association). Jeffrey's practice focuses on a wide variety of trademark matters. Jeffrey counsels clients worldwide regarding domestic and international trademark enforcement, prosecution, clearance, and maintenance matters. In addition, Jeffrey represents clients in contested proceedings before the USPTO Trademark Trial and Appeal Board. He also negotiates and drafts a variety of agreements on behalf of clients, and his clientele includes sports and entertainment, cosmetics, banking and financial, software, apparel, and consumer goods companies. Prior to joining Cowan, Jeffrey worked as a Trademark Attorney Advisor at the United States Patent and Trademark Office and as a Law Clerk for Hon. Delores J. Thomas, Hon. Herbert Kramer (Ret.), and Hon. Yvonne Lewis (Ret.) in the New York State Supreme Court, Kings County.

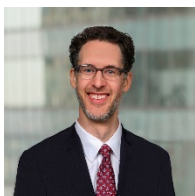


**[Joelle A. Milov](#)**

**[Joelle A. Milov](#)**, Harvard Law School (J.D. 2012; Harvard Journal of Law and Gender); Princeton University (A.B. 2009, *cum laude*; Phi Beta Kappa). Joelle represents clients in all aspects of securing and defending intellectual property rights. She assists clients in prosecuting and enforcing their trademarks domestically and internationally. She also has extensive experience in intellectual property litigations in federal courts and the Trademark Trial and Appeal Board, as well as domain name disputes. Additionally, Joelle has significant experience in litigating cases in New York State courts and has represented clients and served as local counsel in general commercial cases in these venues. She represents clients in a wide range of industries, including those in the music, food, financial services, consumer products, and professional sports industries. Prior to joining Cowan, Joelle was an Assistant Law Clerk to Hon. Saliann Scarpulla in the Commercial Division of the New York Supreme Court and an Associate at an international law firm headquartered in New York City.

## **Attorney Additions**

The following attorneys joined our firm since our last issue of e-News:



**[Adam Siegartel](#)**, Columbia Law School (JD 2001; Senior Editor of Columbia Law Review; James Kent Scholar; Harlan Fiske Stone Scholar; recipient of James A. Elkins Prize); Tufts University (BA 1997; *summa cum laude*; Phi Beta Kappa). As many of you know, he joined us as a partner in our Intellectual Property and Litigation Groups effective December 1, 2020. He is a first-chair litigator with experience in IP enforcement and defense. He also manages worldwide trademark portfolios and assists clients with a wide variety of transactional matters, IP content agreements, and other advertising, copyright, right of publicity, counterfeiting, and other brand management issues.





**Reema Pangarkar**, Penn State University (B.A. in Art History, Classics, and International Politics); University of California, Davis School of Law (J.D. 2018; Intellectual Property Certificate). She is an Associate in our Intellectual Property Group.



**Justin I. Karasick**, Brooklyn Law School (J.D. 2018, *magna cum laude*; Dean's List); New York University (Diploma in Paralegal Studies, 2010); Hofstra University (B.A. in Political Science, 2009). He is an Associate in our Intellectual Property Group.



**Allison R. Furnari**, Fordham Fashion Law Institute (Dean's Fellow, 2019); Fordham University School of Law (J.D., 2019; Concentration in Intellectual Property and Information Law); University of Miami (B.A., *cum laude*, 2016; Psychology/Business Administration). She is an Associate in our Intellectual Property Group.



**Jeremy Berman**, Columbia Law School (JD 2017; Harlan Fiske Stone Scholar; Executive Submissions Editor, Journal of Law and the Arts); University of Pennsylvania (BA 2014; *magna cum laude*). He is an Associate in our Litigation Group.



**Shana Dunning**, Northwestern University Pritzker School of Law (J.D., 2017); Spelman College (B.A., 2014). She is a Staff Attorney in our Intellectual Property Group.

## Diversity & Inclusion Initiatives



We strongly believe that diversity and inclusion at all levels of our firm greatly increases the value and abilities of our lawyers and staff and the services we offer to clients. Our on-going commitment to diversity extends beyond our office walls as we are dedicated to improving diversity within all facets of the legal profession, and importantly, further into our communities.

Our Diversity and Inclusion Committee comprising partners and associates has spearheaded various continuing initiatives:

- Encouraged all lawyers and staff to take several of the Harvard Implicit Bias Tests, and concluded another round of sensitivity training.
- Identified and targeted diverse professional and law student organizations through which the firm can post job openings.
- [Jeffrey Chery](#), [Reema Pangarkar](#) and a diverse panel presented a complimentary on-line Continuing Legal Education program entitled *Careers in Intellectual Property Law: Promoting Diversity and Inclusion* in partnership with the Metropolitan Black Bar Association and Lawline, in June 2021.
- Published a celebration of **Pride Month**: The Life and Legacy of Judge Paul Feinman.
- Published a celebration of **Black History Month**: The contributions of selected black inventors and patent holders.
- Published a celebration of **Asian/Pacific American Heritage Month**: *These Asian-American Designers are Making the World a Better Place*.
- Published a celebration of **National Disability Employment Awareness Month**: The accomplishments of Claudia Gordon, the first deaf Black woman attorney in the U.S.
- Sponsored **The Scales of Justice** held by **Equal Justice Works**, a virtual nonprofit fundraising event celebrating the community of lawyers who exemplify the values of compassion, dedication, and commitment to achieving our nation's promise of equal justice for all. Of the 2,500 Fellows supported by Equal Justice Works, 85% have remained in public service positions, continuing to provide critical legal services to underserved communities across the country.



## Events

Our attorneys have spoken in a number of virtual educational programs, including:



- [Deborah Squiers](#) chaired, and she and [Robert English](#) spoke, at The Practising Law Institute's 2021 *Fundamentals of Trademark Law in Global Marketplace* program
- [Tom Kjellberg](#) spoke on *New Cases in Copyright Law—Internet and Beyond* at the Practising Law Institute's Continuing Legal Education webcast titled *Fundamentals of Copyright Law in the Data Era 2021*



- [Kieran Doyle](#) moderated and spoke along with [Kyle-Beth Hilfer](#) and [Reema Pangarkar](#) at a CLE webinar titled *Hot Topics In Advertising And Marketing Law: How To Protect Your Brand* for members and invited guests of the New York Chapter of the Association of Corporate Counsel (ACC)
- [Tom Kjellberg](#) and [Dasha Chestukhin](#), together with former CLL associate Aryn Emert, Vice President, Assistant General Counsel, Intellectual Property at ViacomCBS, spoke at an ACC program titled *Keeping Up with Copyright Developments: Key Cases In-House Counsel Should Know About*



- [Tom Kjellberg](#), [Joelle Milov](#), and [Dasha Chestukhin](#) spoke at our firm's CLE4Good webinar titled *Recent Developments in Copyright Law*. More than 100 people from across the U.S. registered to see it and our firm made a substantial donation to The Actors Fund, a national human services organization that provides members of the entertainment community with much-needed emergency financial assistance, affordable housing, health care and insurance counseling, senior care, secondary career development, and more.

## Recent Articles and Blog Posts

The following are selections from among the many articles we have published in 2021:

- *Copyright Developments Blog* -- [“All Samples Cleared!” Remembering Biz Markie’s Contributions to Copyright Law](#) by Dasha Chestukhin, Joelle A. Milov
- *On My Mind Blog* – [Beware of Sham Trademark Notifications](#) by William M. Borchard
- *On My Mind Blog* -- [You may not Realize that your Trademark is Deceptive](#) by William M. Borchard
- *Advertising Law Alert* – [Second Circuit Holds You Can Lawfully Prohibit a Competitor from Purchasing Your Trademark as a Search Keyword for Online Advertising](#) by Allison R. Furnari
- *Patent Law Alert* – [Supreme Court Keeps Alive The Doctrine of Assignor Estoppel](#) by Daniel Basov and Reema Pangarkar
- *Trademark Law Alert* -- [The Niche Fame of Monster Energy’s Mark is Unable to De-Claw the Toronto Raptors’ Marks](#) by Jeffrey Chery
- *On My Mind Blog* -- [Avoid Selecting a Generic Term as Your Trademark](#) by Dorothy R. Whitney

## Recent Honors



**World Trademark Review WTR 1000** 2021 edition continued to List CLL in Gold Band of Trademark Firms Nationally and in New York, and it described our firm in glowing terms:

*One of the best anywhere in the world when it comes to trademark counselling, prosecution and litigation, Cowan Liebowitz & Latman renders an A-to-Z service to prestigious companies from a cross-section of brand-intensive industries. The team sustains relationships over long periods of time, which reflects its unswerving commitment to quality and superior service. Further evidence of this can be seen in the superlative feedback garnered by multiple team members.*



**Legal 500 United States** 2021 edition continued to rank CLL nationally in Tier 1 for Copyright Law and for Trademark Litigation. It published the following, among many favorable client comments:

*The trademark team at Cowan, Liebowitz & Latman, P.C. has extensive experience of handling all types of litigation and prosecution matters around the world by managing global trademark portfolio of many large corporate clients. Due to such extensive experience of handling global trademark prosecution matters, they are able to provide effective, efficient and practical advice to its clients.*

## Super Lawyers®

**Super Lawyers** New York Metro 2021 edition named many of our attorneys in the "Super Lawyers" list, including [William M. Borchard](#), [Kieran G. Doyle](#), [Lynn S. Fruchter](#), [Mark Montague](#), [Joel Karni Schmidt](#), and [Deborah K. Squiers](#) in the Intellectual Property practice area; [Richard Dannay](#), [J. Christopher Jensen](#), [Mary L. Kevlin](#), [Jonathan Z. King](#), and [Richard S. Mandel](#) in the Intellectual Property Litigation practice area; [Kyle-Beth Hilfer](#) in the Media & Advertising practice area; [Ronald W. Meister](#) in the Business Litigation practice area; and [Robert J. Giordanella](#) in the Estate Planning and Probate area. Super Lawyers New York Metro 2021 also named seven of our attorneys in the "Rising Stars" list, including [Dasha Chestukhin](#), [Justin I. Karasick](#), [Raphael S. Nemes](#), [Reema Pangarkar](#), [Emily F. Stein](#), [Brian R. Volk](#), and [Lyndsey Waddington](#) in the Intellectual Property area.



**IP Stars** 2021 edition, published by *Managing IP*, ranked CLL in the top firms. In New York, it listed CLL as "Highly Recommended" in the areas of Trademark Contentious, Trademark Prosecution, and Copyright & related rights. Nationally, it listed CLL, in Tier 1 in the area of Copyright & related rights, and in Tier 2 (only a few firms were ranked higher) in the areas of Trademark Contentious and Trademark Prosecution.



**Best Law Firms** 2021 edition. published by *U.S. News & World Report* and *Best Lawyers*, ranked CLL as a National Tier 1 firm in the practice areas of Copyright Law, Information Technology Law, Patent Litigation, and Trademark Law, and in National Tier 2 for Intellectual Property Litigation. In the Metropolitan listings, CLL was ranked in New York City Tier 1 for Copyright Law, Information Technology Law, Intellectual Property Litigation, Patent Litigation, and Trademark Law, and in New York City Tier 3 for Commercial Litigation.

*Prior results do not guarantee a similar outcome*