



## Barbara A. Solomon

### Practice Description

Counseling in the areas of trademark, trade dress, copyright, false advertising, unfair competition, rights of privacy, rights of publicity, parody and Internet-related matters; advising on domain name issues, including litigating and adjudicating UDRP cases; litigation in the federal district courts and appellate courts; handling opposition and cancellation proceedings in the Trademark Trial and Appeal Board; negotiating and preparing various intellectual property agreements including consent agreements, co-existence agreements, assignments, licenses, and representation agreements; advising and counseling on issues concerning counterfeiting including online counterfeiting and customs issues; advising on and reviewing searches for the clearance and registration of trademarks.

### Education

Brown University (A.B., magna cum laude, 1981, Phi Beta Kappa); Harvard Law School (J.D., cum laude, 1984).

### Professional Activities

Member: The Association of the Bar of the City of New York (Secretary, 1990-1992, Committee on Copyright and Literary Property).

Speaker: Frequent lecturer on issues concerning the Internet, domain names, right of publicity, fair use and licensing.

Appointments: WIPO panelist for cases brought under the UDRP; Adjunct Professor, Brooklyn Law School, 2004 (trademark law).

### Honors

Member of Fross Zelnick litigation department named "Top Trademark Litigation Team" in the United States by Managing Intellectual Property Magazine in 1999; Recognized in the 2004, 2006 and 2008 editions of Guide to the World's Leading Trade Mark Law Practitioners, published by Euromoney Legal Media Group; Included in the list of New York Super Lawyers in Intellectual Property by "New York Super Lawyers 2006 - Manhattan Edition," "New York Super Lawyers 2007 - Metro Edition," "New York Super Lawyers 2008 - Metro Edition," and "New York Super Lawyers - Corporate Counsel Edition." Recognized in the trademark litigation and dispute resolution category in the 2006-2007 edition of the Legal 500 US Guide.

### Admissions

New York State

United States Courts of Appeals for the Second, Third, Ninth, Eleventh and Federal Circuits

United States District Courts for the Southern, Eastern and Northern Districts of New York

### Selected Cases

*De Beers LV Trademark Ltd. v. DeBeers Diamond Syndicate*,

Case No. 04 CIV 4099 (DLC), 2006 WL 1582035 (S.D.N.Y. June 9, 2006).

In a trial before the United States District Court for the Southern District of New York the Court found that Plaintiff's registration based on an ITU filing gave it prior rights even though defendant's use predated both the plaintiff's use and the issuance of the registration. This is one of the only decisions explicitly applying the ITU statute to establish priority in such circumstances.

Calling the DE BEERS mark "one of the most famous brands in the world," the District Court ruled that the defendants' attempt to use the DE BEERS name to sell diamonds over the Internet was "entirely in bad faith" and accordingly found the defendants liable for trademark infringement, trademark dilution and unfair competition.

*Viacom Int'l Inc. v. Fanzine, Inc.*,

98 Civ. 7448 (S.D.N.Y. 2000).

In a copyright case of first impression, the court held that Viacom's distribution of publicity materials featuring its television characters did not allow a recipient under the guise of media coverage or a fair use defense to commercially reproduce these materials as posters that were folded up to look like a magazine without the authorization of the copyright owner.

*Lane Capital Mgmt. Inc. v. Lane Capital Mgmt. Inc.*,

15 F. Supp.2d 389 (S.D.N.Y. 1998), aff'd, 1999 U.S. App. LEXIS 22965 (2d Cir. Sep. 22, 1999).

We successfully represented the plaintiff in a case of first impression in the Second Circuit on the issue of when a trademark, "Lane", is primarily merely a surname. In affirming the District Court's grant of summary judgment enjoining the defendant from using the Lane Capital Management name, the Second Circuit set the standard for determining the surname issue.

*Buffett v. Cheeseburger in Paradise, Inc.*

97 CV 00214 (3/18/97) 98 CV 01730 (3/11/98) (C.D. Cal.).

In a case of first impression, we successfully argued that in a federal court action seeking to cancel the defendant's trademark registration, the applicable factors to be applied are those established by the Federal Circuit, not the likelihood of confusion factors applied by federal courts in an infringement analysis.

*Pump, Inc. v. Collins Management*,

746 F. Supp. 1159 (D. Mass. 1990).

In one of the first decisions of its kind, the district court ruled in favor of our clients in finding that there was no likelihood of confusion when the identical mark "Pump" was used as the name of an album by our client, the rock band Aerosmith, and as the name of a lesser-known band.

*Creative Arts by Calloway LLC v. Christopher Brooks*,

01 Civ. 3 192 (S.D.N.Y. 2001), aff'd, 2002 WL 31303241 (2d Cir. 2002).

We successfully represented the grandson of Cab Calloway who was sued by a corporation established by Cab Calloway's widow for the purposes of managing, promoting, licensing and exploiting all rights associated with Cab Calloway's name and intellectual property. The district court granted summary judgment to Christopher Brooks on the grounds that under New York's right of publicity law, the plaintiff had no right to the Cab Calloway name, that the Cab Calloway name did not function as a trademark, and that in any event the use of the name Cab Calloway as part of the name of a tribute band was a fair use. The Second Circuit affirmed on the grounds that no trademark rights in the Cab Calloway name were passed to plaintiff.

*Cairns v. Franklin Mint Company*,

292 F.3d 1139 (9th Cir. 2002).

While our client, the Estate of Diana, Princess of Wales, was unsuccessful in overturning a grant of summary judgment against it, the case is significant for its discussion of the scope and extent of nominative fair use as a defense to trademark infringement.

*MTV Networks, a division of Viacom International Inc. v. Adam Curry*,

(S.D.N.Y. 1994).

This was the first case ever filed alleging that a domain name infringed on a trademark and that sought to apply Lanham Act principals to the registration and use of a domain name.

In addition to the above, Ms. Solomon has been successful in dozens of UDRP cases before WIPO.

### **Selected Transactions**

Acted as trademark counsel in connection with sale of IBM's PC division to Lenovo; sale of IBM's Printed division to Ricoh; sale of Kraft Food's Post Cereal Division.

### **Published Works**

#### **Overview of Basic Principles of Trademark Law. How to Handle Basic Copyright and Trademark Problems**

PLI, 1989, 1990, reprinted in 20 The Lawyer's Brief, Issue 21 (Business Laws, Inc., 1990)

Co-author: Susan Upton Douglass

#### **Two New Tools to Combat Cyberpiracy: A Comparison**

Intellectual Property Forum, Sept. 2000 and 90 The Trademark Reporter 679 (May – June 2000)

#### **Domain Name Disputes: New Developments and Open Issues**

91 The Trademark Reporter 833 (July-August 2001)

#### **Can the Lanham Act Protect Tiger Woods? An Analysis of the Uncomfortable Fit Between Right of Publicity and Unfair Competition**

94 The Trademark Reporter 1202 (November-December 2004)