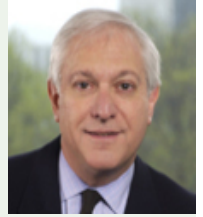


## Richard Z. Lehv



### Practice Description

Litigation of trademark, copyright, false advertising, and unfair competition cases in federal trial and appeals courts; opposition and cancellation proceedings in the Trademark Trial and Appeal Board. Significant experience with issues related to comparative advertising, the entertainment industry (such as protection of film titles), use of surveys in litigation, trade dress, Internet-related issues; and parody and First Amendment issues.

### Education

Union College (B.A., magna cum laude, 1969); Columbia University School of Law (J.D., 1972). Harlan Fiske Stone Scholar; Phi Beta Kappa.

### Professional Activities

Member: International Trademark Association, Trademark Mediators Network (2012 — present); Copyright Society of the U.S.A. (Trustee and Member of Executive Committee, 1999 — 2002); Association of the Bar of the City of New York (Member, Committee on Copyright and Literary Property, 1983 — 1986; Committees on: Legal Assistance, 1977—1981).

Speaker: "Cancellation of Registrations for Defamatory Trademarks," in "Washington Redskins: A Multi-Disciplinary Discussion" at Columbia University School of Law, New York, NY, April 21, 2015; "Recent U.S. Trademark Law Developments" 14th International Trademark Conference, at the European Office for Harmonization in the Internal Market, in Alicante, Spain, October 23-24, 2014; "Television and Disruptive Technologies: Copyright's New Frontier" Copyright Society of the USA Panel Discussion, New York, NY, December 11, 2012; "Painting with Too Broad a Brush" in "Functionality and Trademark Law in the U.S. and EU." 20th Annual Intellectual Property Law & Policy Conference at Fordham University School of Law, New York, NY, April 13, 2012; "Trademarks, a Year in Review." American Intellectual Property Law Association Annual Meeting, Washington DC, October 23, 2010; "Jury Trials in Trademark and Copyright Cases." New York State Bar Association, Intellectual Property Law Section, 2009 Fall Meeting, Bolton Landing New York, October 16, 2009; "The Trademark Dilution Revision Act New Opportunities and Challenges for Surveys." American Intellectual Property Law Association, 2007 Spring Meeting, Boston, Mass., May 10, 2007. "Surveys in TTAB Cases." International Trademark Association, forum on Trademark Trial and Appeal Board Practice for Advanced Practitioners, Arlington, Va., December 11, 2003; "Working With Survey Experts." American Intellectual Property Law Association, 2003 Annual Meeting, Washington, DC, October 30, 2003; "Summary Judgment in Copyright Cases." Copyright Society of the USA, Luncheon Seminar on Copyright Litigation, New York, NY, May 22, 2003.

Instructor: Lecturer in Law at Columbia Law School (since 2004), where he teaches a seminar in Trademark and Copyright Litigation. In 2006 he taught Trademark Law at Columbia. From 1994 to 2003, he taught Trademark Law at Brooklyn Law School.

### Honors

Named to the 2019 edition of *The Best Lawyers in America*® for the 13th consecutive year for Copyright Law, Litigation-Intellectual Property, and Trademark Law; Selected for inclusion in Chambers guide; described as highly regarded for his trademark litigation expertise and highly specialized knowledge in the IP field. Named one of "The World's Leading Trade Mark Law Practitioners" in a survey of 4,000 practitioners conducted by Managing Intellectual Property Magazine in June, 2008; Member of Fross Zelnick litigation department, named "Top Trademark Litigation Team" in the United States by Managing Intellectual Property Magazine in 1999; Named one of the "Best Lawyers in New York" by New York Magazine, June, 2008; Recognized in the 2008 edition of Guide to the World's Leading Trade Mark Law Practitioners, published by Euromoney Legal Media Group; Included in New York Super Lawyers®, 2006-2018, Intellectual Property Litigation, Intellectual Property, and Alternative Dispute Resolution.

### Admissions

New York State

### Selected Cases

[Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.](#)

797 F.3d 1363 (Fed. Cir. 2015), **cert. denied**, 136 S.Ct. 982 (2016)

On behalf of our client Jack Wolfskin Ausrüstung Fur Draussen GmbH, we obtained a reversal of a decision of the Trademark Trial and Appeal Board ("TTAB") at the U.S. Court of Appeals for the Federal Circuit. The TTAB had found that our client's application was likely to cause confusion with the appellee's registered mark, but the Federal Circuit held that the TTAB erred by improperly dissecting the appellee's mark and by giving insufficient weight to voluminous evidence of third party use we submitted supporting our client's position. Following the decision, New Millennium filed a petition for certiorari in the U.S. Supreme Court. On behalf of Jack Wolfskin, we filed a brief opposing the petition. On January 25, 2016, the Supreme Court denied the petition and declined to hear the case, letting the Federal Circuit decision stand.

[Inter-IKEA Systems B.V. v. Akea, LLC](#)

Opp. No. 91196527 (T.T.A.B. 2014)

The Board sustained, in part, the Firm's opposition, filed on behalf of IKEA, to the registration of AKEA for retail direct sales services in the field of nutritional supplements, finding a likelihood of confusion.

[Frida Kahlo Corporation v. Tupperware Corporation](#)

Case No. 13-21039 (S.D. Fla. Mar. 31, 2014)

The court granted the Firm's motion to dismiss the case, based on lack of subject matter jurisdiction, because the allegedly infringing acts occurred in Mexico and other Central and South American countries. The court held that foreign websites that can be seen in Florida were not sufficient to give the court subject matter jurisdiction, nor was one shipment to Florida by a non-party dealer. The court did not give the plaintiff leave to replead.

[Inter-IKEA Systems B.V. v. Arsen Manasyan](#)

Opp. No. 91194783 (T.T.A.B. 2012)

The Board sustained the Firm's opposition, filed on behalf of IKEA, to the registration of NIKEA for chocolates and candy, finding a likelihood of confusion.

[Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc.](#)

696 F.3d 206 (2d Cir. 2011)

The Firm successfully filed an *amicus* brief on behalf of long-standing client, Tiffany & Co., urging reversal of the district court's decision denying injunctive relief to the plaintiff. The brief explained that the district court applied the "aesthetic functionality" doctrine far too broadly. The Second Circuit reversed the relevant portion of the district court decision; the Court followed the arguments we made in the *amicus* brief.

[Lacoste Alligator S.A. v. Maxoly, Inc.](#)

2009 WL 1227922 Opp. No. 91177866 (T.T.A.B. 2009)

On behalf of Lacoste, the owner of the famous alligator logo, the Firm filed an opposition to Maxoly's application to register a mark consisting of the words COLBA ISLAND and a similar alligator logo for clothing. Following a trial, the Board sustained the Firm's opposition, holding that, in view of the fame of the Lacoste mark and similarity of the marks and goods, Maxoly's mark was likely to cause confusion.

[Crown Awards, Inc. v. Discount Trophy & Co., Inc.](#)

564 F.Supp.2d 290 (S.D.N.Y. 2008), *aff'd*, No. 08-1674-CV, 2009 WL 1054109 (2d. Cir. Apr. 21, 2009)

Following a trial, the court held that the defendant infringed the copyrights in our client's popular Spin Trophy, by selling a trophy that court found "strikingly similar" to the Spin Trophy. The judgment permanently enjoins the defendant from selling the infringing trophy and orders it to pay Crown its profits from the infringement. In July, 2008, the Court granted our motion to recover attorneys' fees. The Court said that Crown and the Firm "prevailed in every stage of the litigation" and that Crown was entitled to recover its legal fees in full. The Court went on to write that "Fross Zelnick hourly rates for legal services have repeatedly been found to be fair by courts evaluating them," and that "as a result of Fross Zelnick's expertise in the field of copyright law, it does not expend extra time to understand the issues involved in a copyright case, and therefore spends only a reasonable number of hours to litigate the case." On April 21, 2009, the U.S. Court of Appeals for the Second Circuit affirmed the district court ruling on infringement and damages, as well as the award of Crown's attorneys' fees.

[Overbeck Corp. v. Overbeck GmbH](#)

No. 03-CV-0844 (DRH) (ETB), 2007 WL 1029025 (E.D.N.Y. Mar. 30, 2007)

The firm prevailed a motion to strike a jury verdict against its clients, the German grinding machine company, Overbeck GmbH, its parent, the Spanish cooperative, Danobat S. Coop., and its U.S. affiliate, Danobat Machine Tool Co., Inc., in the U.S. District Court for the Eastern District of New York. After a full trial, in which plaintiff was forced to drop most of its nine causes of action, and defendants successfully moved in limine to dismiss all of plaintiff's claims for monetary damages because of its discovery abuses, the jury nevertheless found for plaintiff, a local company. Prior to the verdict, defendants timely moved to strike plaintiff's jury demand, and they renewed this motion thereafter. The court granted the motion, deeming the jury decision against defendants merely advisory.

[Luy N'Care, Ltd. v. Babelito, S.A.](#)

306 F. Supp. 2d 468 (S.D.N.Y. 2004)

We won a decision in the U.S. District Court for the Southern District of New York dismissing a trade dress infringement claim brought against our firm's client, Babelito, an Argentine manufacturer of products for infants, on the ground that the defendant had not been properly served in the United States.

[M&G Elecs. Sales Corp. v. Sony Kabushiki Kaishi](#)

250 F. Supp. 2d 91 (E.D.N.Y. 2003)

Defeated a motion for a preliminary injunction brought by a Long Island-based electronics company against Sony Electronics in an action involving use of the mark MG in connection with digital copyright management software.

[Bliss Salon Day Spa v. Bliss World LLC](#)

263 F.3d 494 (7th Cir. 2001)

Our client, the owner of the service mark BLISS for a famous New York spa, was sued by an Illinois salon, which claimed to have begun using the BLISS mark for similar services prior to our client's first use. The plaintiff sought a preliminary injunction to stop our client from opening in Illinois and selling its products there. The court denied the motion on the grounds that plaintiff's marks were merely descriptive and had not acquired secondary meaning, and the Court of Appeals affirmed. This was named one of the Ten Favorite Trademark Cases of the year by IP Worldwide and [law.com](#).

[Carvel Corp. v. The Ice Cream Bakery, Inc.](#)

1999 TTAB LEXIS 217 (T.T.A.B. May 19, 1999)

We represented Carvel Corporation in its successful opposition against a former licensee's attempt to register the mark THE ICE CREAM BAKERY. The applicant argued that Carvel had abandoned THE ICE CREAM BAKERY through naked licensing, because Carvel's licensee's use of the mark was not identical to Carvel's use. The Board held that although the uses were not identical, there was no abandonment where Carvel had the contractual right to inspect its current licensee and had done so numerous times, and where the applicant itself admitted that consumers continued to associate the mark THE ICE CREAM BAKERY with Carvel.

[Tri-Star Pictures, Inc. v. Unger](#)

88-CV-9129-DNE (July 13, 1998)

We successfully represented the producer of the famous film, "Bridge on the River Kwai," in a trademark infringement suit against the producer of "Return from the River Kwai." We asserted that the title, "Return from the River Kwai," is likely to cause confusion because it suggests the film is a sequel to "Bridge on the River Kwai," when in fact it is not a sequel. The district court held the defendants guilty of intentional infringement and awarded a permanent injunction and attorneys' fees. The court later ordered defendants to pay our client \$400,000 in attorneys' fees. This Second Circuit decision affirms a decision of the district court ordering the defendants to post security for costs on appeal.

[JR Tobacco of America, Inc. v. Davidoff of Geneva \(CT\), Inc.](#)

1997 U.S. Dist. LEXIS 1501 (S.D.N.Y. February 13, 1997)

The court granted the motion for summary judgment we filed on behalf of Davidoff, a maker of premium cigars. JR used Davidoff's trademarks in advertising for "JR Alternative" cigars, which JR claimed duplicated famous brands. Davidoff asserted that the use of its trademarks in JR's ads constituted trademark infringement and that JR's advertising claims were false.

[American Express Co. v. Accu-Weather, Inc.](#)

105 F.3d 863 (2d Cir. 1997)

A dispute between our client, American Express, and Accu-Weather over ownership of the 1-900 WEATHER trademark for an interactive telephone weather service. The district court granted summary judgment in our favor, holding American Express owns the mark. The court of appeals affirmed.

[Anheuser-Busch, Inc. v. Balducci](#)

28 F.3d 769 (8th Cir. 1994)

In this action by our client Anheuser-Busch over misuse of the MICHELOB trademark in what the defendants claimed was a parody advertisement, the Eighth Circuit reversed a district court decision holding the ad was protected by the First Amendment.

[Twin Peaks Productions, Inc. v. Publications International, Ltd.](#)

996 F.2d 1366 (2d Cir. 1993)

Our client, the producer of the "Twin Peaks" television series, brought suit for copyright and trademark infringement against the publisher of an unauthorized trivia book about the series. The district court found that the defendant was a willful infringer, and the Second Circuit affirmed.

[Coors Brewing Co. v. Anheuser-Busch Companies, Inc.](#)

802 F. Supp. 965 (S.D.N.Y. 1992)

Coors claimed that television and radio commercials run by our client Anheuser-Busch stating that Coors' beer was shipped in railroad tankers and diluted with local water, disparaged its beer. The court denied Coors's motion for a preliminary injunction and allowed the commercials to continue running because of Coors' failure to show literal or implied falsehood, bad faith, or that the commercials were materially misleading.

[Papercutter, Inc. v. Fay's Drug Co., Inc.](#)

900 F.2d 558 (2d Cir. 1990)

The Second Circuit not only affirmed the district court's finding that our client, Fay's Drug Co., was not guilty of trademark infringement, but also granted our cross-appeal, in which we sought to cancel the plaintiff's trademark registration on the ground that the mark was merely descriptive of the plaintiff's goods and should never have been registered by the Patent and Trademark Office.

[Pump, Inc. v. Collins Management](#)

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

In one of the only 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.

[815 Tonawanda Street Corp. v. Fay's Drug Co., Inc.](#)

842 F.2d 643 (2d Cir. 1988)

In this case for Fay's Drugs, we successfully argued that our client was not guilty of trademark infringement because the plaintiff's trademark was merely a personal name and was not protectable in the absence of "secondary meaning."

[DC Comics, Inc. v. Reel Fantasy, Inc.](#)

696 F.2d 24 (2d Cir. 1982)

In this case, our client, DC Comics, the publisher of BATMAN comics, sued for copyright and trademark infringement. The appeal concerns the proper standard for the grant of summary judgment in trademark and copyright cases.

[Pioneer Kabushiki Kaisha v. Jazzy Electronics](#)

661 F.2d 910 (2d Cir. 1981)

Affirming without opinion 212 U.S.P.Q. 591 (E.D.N.Y. 1980). In this case, we successfully stopped a company selling "knock-offs" of PIONEER car stereo products.

**Published Works**  
**The Domain Name Fightback Begins**  
**Cybersquatting in Focus**  
**Trademarks and Art**