

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

World Trademark Review *WTR 1000*: 2018 – 2015, described as “tough negotiator with a high level of respect in the Bar;” “really smart, hard-nosed and very knowledgeable;”

ExpertGuides: Trademark 2018, included in list of “leading practitioners within the field;”

Super Lawyers®: 2018 – 2006, including “Top Women Attorneys in New York,” 2017 – 2015; and, “New York Times Best Women Lawyers” Supplement, Intellectual Property Litigation, 2015;

Managing Intellectual Property *IP Stars Handbook*: 2018 – 2014;

The Legal 500: 2016 – 2015, recognized as “excellent” in the 2015 edition, and noted for “trademark litigation and dispute resolution,” 2007 – 2006;

Women in Business Law: 2017 – 2013;

Who’s Who Legal 100: 2018, 2014 – 2013;

IP Law360: 2014, feature interview, “Female Powerbrokers;”

Euromoney’s Guide to the World’s Leading Women in Business Law: 2013, named a “leading practitioner in the field;”

Euromoney’s Guide to the World’s Leading Trade Mark Law Practitioners: 2008, 2006 and 2004;

Fross Zelnick litigation department named “Top Trademark Litigation Team” in the United States by Managing Intellectual Property: 1999

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

United States Supreme Court

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.

Selected Cases

[Royal Crown Co. v. Coca-Cola Co.](#)

892 F.3d 1358 (Fed. Cir. 2018)

On behalf of Royal Crown Company, Inc. and Dr Pepper/Seven Up, Inc. (together, “RC”), the Firm prevailed at the Federal Circuit Court of Appeals after a nearly decade-long battle concerning whether The Coca-Cola Company (“TCCC”) could claim exclusive trademark rights to ZERO for soft drinks. The Federal Circuit vacated the decision of the Trademark Trial and Appeal Board (“TTAB”), finding, among other things, that the TTAB had applied the wrong legal standard to the question of whether ZERO is generic, had failed properly to assess the degree of the term’s descriptiveness, and had incorrectly weighed evidence, including by improperly discounting RC’s evidence of third-party use of ZERO. The Federal Circuit remanded the case to the TTAB for further proceedings.

[Chanel, Inc. V. Camacho & Camacho LLP](#)

Opp. No. 91/229126 (T.T.A.B. 2018)

The firm succeeded in establishing fame for purposes of dilution by presenting historic evidence that resulted in an opinion from the Trademark Trial and Appeal Board of the U.S. Patent & Trademark Office (“TTAB”) that Chanel’s CC Monogram mark is famous under the federal dilution laws, that such fame existed prior to 2002, and that Chanel’s CC Monogram mark is a household name.

[Soft Serve Fruit Co. LLC v. BC Hospitality Group LLC and Esquared Hospitality LLC](#)

Civ. No. 17-Cv-9735(ER) (S.D.N.Y. 2018)

The firm overcame several obstacles to obtain a Temporary Restraining Order that enjoined defendants from selling non-dairy frozen dessert pints under the mark CHILL BY CHLOE and BY CHLOE in retail outlets. Following the TRO, the firm obtained a favorable settlement for the client and the case was dismissed.

[Chanel, Inc. v. Makarczyk](#)

110 U.S.P.Q.2d 2013 (T.T.A.B. 2014)

In a precedential decision before the Trademark Trial and Appeal Board of the U.S. Patent & Trademark Office ("TTAB"), the Firm successfully represented Chanel, Inc. in its challenge to a Canadian real-estate developer's attempt to register the mark CHANEL for condominium and other real-estate services on grounds of dilution. Following the submission of extensive evidence, the TTAB found CHANEL to be a household name and that the fame preceded any use of the mark by applicant.

[Kraft Foods Group Brands LLC v. Cracker Barrel Old Country Store, Inc.](#)

No. 1:13-cv-00780 (N.D. Ill. July 1, 2013), aff'd 735 F.3d 735 (7th Cir. 2013)

The Firm obtained a preliminary injunction on behalf of Kraft Foods Group Brands, LLC, owner of the CRACKER BARREL trademark in connection with cheese, against restaurant company, Cracker Barrel Old Country Stores, Inc. and prominent meat distributor, John Morrell & Co. The decision was affirmed by the U.S. Court of Appeals for the Seventh Circuit.

[Volvo Trademark Holding AB v. Hebei Aulion Heavy Indus. Co.](#)

Opp. Nos. 91178281, 91178290, 91178297 and 91178410 (consolidated) (T.T.A.B. Feb. 7, 2013)

The Firm successfully defended Hebei Aulion Heavy Industries Co., Ltd. ("Hebei Aulion"), a Chinese company, in its bid to register LOVOL.

[Clinique Laboratories LLC v. Absolute Dental, LLC](#)

Opp. No. 91181263 (T.T.A.B. Apr. 28, 2011)

The firm successfully represented Clinique Laboratories, LLC in its challenge to Nevada-based Absolute Dental LLC's attempt to register the mark CLINIQUE DENTIQUÉ for "cosmetic dentistry services."

[Clinique Laboratories LLC v. Absolute Dental, LLC](#)

2011 WL 1652171 (T.T.A.B. 2011)

On behalf of our client Clinique Laboratories LLC—owner of the famous CLINIQUE trademark in connection with cosmetics and cosmetic services—we successfully opposed Absolute Dental LLC's attempt to register the trademark CLINIQUE DENTIQUÉ for "cosmetic dentistry services" with the United States Patent and Trademark Office.

[Rodan & Fields, LLC v. Estee Lauder Companies, Inc.](#)

Case No. 5:10-cv-02451 HLK, 2010 WL 3910178 (N.D. Cal. Oct. 5, 2010)

The Firm successfully defended our clients, The Estee Lauder Companies Inc. and Clinique Laboratories LLC, against a motion for preliminary injunction filed by Rodan & Fields, LLC.

[Dr Pepper/Seven Up, Inc. v. Krush Global Limited](#)

Opposition No. 91180742 & Cancellation No. 92048446m 2010 WL 3798550 (T.T.A.B. 2010)

Prevailed at trial on behalf of Dr Pepper/Seven Up, Inc. in consolidated opposition and cancellation proceedings against the mark, CRUSSH.

[Perfetti Van Melle USA v. Cadbury Adams USA LLC](#)

732 F. Supp. 2d 712 (E.D. Ky. 2010)

On behalf of our client Cadbury Adams USA LLC--maker of the famous DENTYNE brand of chewing gum--we defeated a motion for a preliminary injunction brought by plaintiff which sought to block the launch of Cadbury's new breath purifying gum, DENTYNE PURE, on the

grounds that the name DENTYNE PURE was confusingly similar to plaintiffs' MENTOS PURE FRESH and MENTOS PURE WHITE names used for chewing gum.

[Creative Arts by Calloway, LLC v. Brooks](#)

82 U.S.P.Q.2d 1319 (S.D.N.Y. 2007); No. 01 Civ. 3192 (CLB) (S.D.N.Y. Dec. 11, 2001), *aff'd*, 2002 WL 31303241 (2d Cir. Oct. 11, 2002)

Our firm successfully defended Cab Calloway's grandson, Christopher Brooks, against multiple attempts by his step-grandmother, her family, and their company to prevent him from performing his grandfather's music under the name "The Cab Calloway Orchestra." Most recently, we obtained a dismissal on *res judicata* grounds of the plaintiffs' copyright infringement claims against Mr. Brooks for his use of Cab Calloway's songs. Judge Richard Owen held the claims should have been brought in an action the plaintiffs filed against Mr. Brooks in 2001 concerning use of the CAB CALLOWAY trademark. In the 2001 action, we obtained summary judgment for Mr. Brooks, which was affirmed by the U.S. Court of Appeals for the Second Circuit.

[De Beers LV Trademark Ltd. v. DeBeers Diamond Syndicate, Inc.](#)

440 F. Supp. 2d 249 (S.D.N.Y. 2006)

The firm won a trial before the United States District Court for the Southern District of New York on behalf of plaintiffs De Beers LV Limited and De Beers LV Trademark Limited, owners of rights in the famous DE BEERS mark. 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.

[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. - [See more](#)

[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 determination of 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 in an infringement analysis.

[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. - [See more](#)

[Sun Pharmaceuticals v. Tanning Research](#)

No. 90-CV-06147 (S.D. Fla. June 30, 1992)

We obtained a preliminary injunction on a trade dress claim concerning the design of suntan lotion packages.

[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.

[Jane Ring v. Estee Lauder, Inc.](#)

874 F.2d 109 (2d Cir. 1989)

We obtained summary judgment for defendant in a decision that clarifies the circumstances under which confidentially disclosed information loses its protectable character.

Published Works

Can the Lanham Act Protect Tiger Woods? An Analysis of the Uncomfortable Fit Between Right of Publicity and Unfair Competition94 The Trademark Reporter 1202 (November-December 2004)

[Download](#)

Domain Name Disputes: New Developments and Open Issues91 The Trademark Reporter 833 (July-August 2001)

[Download](#)

Two New Tools to Combat Cyberpiracy: A ComparisonIntellectual Property Forum, Sept. 2000 and 90 The Trademark Reporter 679 (May - June 2000)

[Download](#)

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

Co-author: [Susan Upton Douglass](#)