

James D. Weinberger



Practice Description

James Weinberger is a Partner in Fross Zelnick's litigation practice, focusing on litigation, mediation and arbitration in the areas of copyright, trademark and trade dress infringement, unfair competition, false advertising, trademark dilution, right of publicity, First Amendment and Internet-related matters. Recognized by Chambers USA (2010-2017), Legal 500 (2011-2017), Managing Intellectual Property IP Stars (2014-2017), New York SuperLawyers Rising Stars (2011-2012), New York SuperLawyers (2013-2017), the 2014 and 2016 Guides to the World's Leading Trade Mark Lawyers, Who's Who Legal (Trademarks 2017), World Trademark Review (2017) in the areas of copyright and trademark law as well as a World Intellectual Property Review Leader in 2017 and 2018, James regularly counsels and advises clients across a broad range of industries, including apparel, beverages, cosmetics, entertainment, finance, personal care products, sports, pharmaceuticals, publishing and software on matters relating to intellectual property rights. In addition to federal and state court litigation, James's expertise includes copyright and trademark enforcement strategy and execution, portfolio management, clearance, as well as negotiating and drafting trademark and copyright licenses, coexistence and settlement agreements. James also litigates opposition proceedings in the Trademark Trial and Appeal Board and Uniform Domain Name Dispute Resolution Policy proceedings in the World Intellectual Property Organization.

Education

Wesleyan University (B.A., 1996, with honors); Columbia University School of Law (J.D., 1999). Harlan Fiske Stone Scholar. Recipient, Carroll G. Harper Prize. Editor-in-Chief, Columbia-VLA Journal of Law & the Arts.

Professional Activities

Member, Judicial Administration and Trademark Litigation Subcommittee, International Trademark Association ("INTA") (2014-15 term); Member, Discovery Practices & Procedures Subcommittee of the Enforcement Committee, INTA (2012-13 term, 2008-2009 term); Associate Member, Pharmaceutical Trade Marks Group (PTMG); Member, Intellectual Property Committee, Federal Bar Council; Member, American Bar Association, Intellectual Property Law Section; Member, New York State Bar Association, Intellectual Property Law Section; Director, Columbia Law School Association, (2010-2015).

Speaking Engagements

Strategic Partnering with In-House Trademark Counsel, IPO Annual Meeting (Panelist, San Francisco, CA 2017); POW! BOFF! THWACK! What *DC Comics v. Towle* Means for Copyright Character Protection, Los Angeles Copyright Society (Speaker, February 2016); Holy Copyright Law! The Batmobile Case and Licensing Fictional Characters, Derivatives and Products, American Bar Association (Panelist, December 2015); Product Trade Dress and Non-Traditional Trade Marks - Update from the US, PTMG Spring Conference (Panelist, Barcelona, Spain 2012); Understanding the Use-Based Trademark System in the US, Managing Intellectual Property China-International IP Forum (Speaker, Beijing, PRC 2011); A Conversation Between Brand Owners, Retailers and Manufacturers About Private Label in the United States, INTA Annual Meeting (Panelist, San Francisco, CA 2011); Speaker: Discovery Practice, Procedure and Strategy, Navigating Trademark Practice Before the PTO 2007: From Filing Through the TTAB Hearing, Practising Law Institute; Guest Instructor: Columbia-VLA Clinical Seminar in Law and the Arts, Columbia Law School (2006-2012).

Admissions

U.S. Supreme Court; New York, Court of Appeals, Appellate Division, 1st Dep't; U.S. Court of Appeals, Second Circuit, Third Circuit, Ninth Circuit, Eleventh Circuit; United States District Court, S.D.N.Y., E.D.N.Y., N.D. Ill.

Selected Cases

[Asuragen, Inc. v. Accuragen, Inc.](#)

2018 WL 558888, Case No. 16-cv-5440-RS (N.D. Cal. Jan. 25, 2018)

On behalf of our client, plaintiff Asuragen, Inc., the Firm defeated defendant Accuragen, Inc.'s motion for summary judgment in an infringement action between two providers of genomic services and their respective ASURAGEN and ACCURAGEN trademarks.

[DC Comics v. Oliveri](#)

Opp. No. 91219587 (T.T.A.B. Aug. 8, 2017)

The Firm prevailed on behalf of longtime client DC Comics ("DC") before the Trademark Trial and Appeal Board (the "Board") in an opposition involving THE FLASH character and related trademarks. DC had opposed an application to register the mark FLASH TEC together with a lightning bolt design in connection with clothing. In a lengthy decision dated August 8, 2017, the Board held that THE FLASH was "a valuable intellectual property asset with marketplace strength" and found that FLASH TEC was likely to cause confusion.

[Hits From the Bong, Inc. v. Javen Mitchell](#)

Opp. No. 91224082 (T.T.A.B. July 26, 2017)

The Firm prevailed in an opposition brought by a company affiliated with the seminal hip-hop group Cypress Hill against an application to register the mark GREENE THUMB in connection with music based on our client's rights in the mark DR. GREENTHUMB.

[Athleta, Inc. v. David Sales](#)

Opp. No. 91218461 (T.T.A.B. July 19, 2017)

On behalf of client Athleta, the Firm prevailed in an opposition against applications to register ATHLETIKA and ATHLETIKA SP in connection with sports medicine products. The claim was based on Athleta's rights in the ATHLETA mark for women's fitness and active wear.

[FameFlynet, Inc. v. AMC Networks Inc.](#)

1:16-cv-07571-LAP (S.D.N.Y.)

Represent AMC Networks and related entities in a copyright infringement action involving the alleged unauthorized use of celebrity photographs online.

[DC Comics v. Beling](#)

Opp. No. 91205751 (T.T.A.B. Dec. 21, 2016)

On behalf of DC Comics, the Firm prevailed in an opposition against an individual's attempt to register SUPER DOGS in connection with a contemplated entertainment series and merchandising program. DC relied on its SUPERMAN family of trademarks, including those relating to the KRYPTO THE SUPERDOG character.

[WeWork Companies Inc. v. WE Labs, Inc.](#)

2:16-cv-04637-GW-E (C.D. Cal.)

Represent WeWork Companies Inc. in a trademark infringement action against WE Labs, Inc. of Long Beach, California.

[Brookfield Office Properties Inc v. Manhattan West Hotel et al](#)

1:16-cv-01854-VM (S.D.N.Y.)

Represent Brookfield Office Properties Inc., owner and developer of the MANHATTAN WEST superblock in New York City, in a trademark infringement action against the Manhattan West Hotel.

[DC Comics v. Towle](#)

802 F.3d 1012 (9th Cir. 2015), cert. denied, 136 S.Ct. 1390 (2016)

On behalf of client DC Comics, the Firm prevailed in a decision by the U.S. Court of Appeals for the Ninth Circuit holding that the Batmobile, Batman's famous car, was subject to copyright protection as a character. In reaching its decision, the Court set forth a new, three-part test for determining protection of a character appearing in comic books, television programs or films under the 1976 Copyright Act, independent of any specific work in which it has appeared and irrespective of whether it "lacks sentient attributes and does not speak." Upon finding that the Batmobile met all of the necessary criteria, the Court then held that DC had the right to bring suit because it had reserved all merchandising rights when it granted licenses for the creation of the 1966 Batman television series starring Adam West and the 1989 Batman film starring Michael Keaton. In the alternative, because the 1966 program and 1989 film were derivative works of the original Batman comics, any infringement of those derivative works also gave rise to a claim for DC, the copyright owner of the underlying works. Finally, the Court found that the replica Batmobiles created by mechanic Mark Towle infringed DC's in the Batmobile as it appeared in the 1966 program and 1989 film. The Court also upheld the District Court's refusal to allow Towle to assert a laches defense on DC's trademark claims because the infringement was found to be willful. The U.S. Supreme Court denied Towle's petition for certiorari on March 7, 2016.

[Rockefeller & Co., Inc. v. Rockefeller Merchant Capital, LLC](#)

1:15-cv-09227-VSB (S.D.N.Y.)

Represent client Rockefeller & Co. in trademark infringement action against company making unauthorized use of ROCKEFELLER trademark and family name.

[Industria de Diseno Textil, S.A. et al v. Zara Terez LLC](#)

1:15-cv-05324-JPO (S.D.N.Y.)

Represent defendant in trademark infringement action brought by apparel manufacturer and retailer ZARA.

[DC Comics v. Mad Engine, Inc.](#)

117 U.S.P.Q.2d 1327 (C.D. Cal. 2015)

On behalf of plaintiff DC Comics in a claim for infringement of its Superman Shield trademark, the Firm was successful in defeating a motion to dismiss brought by defendant Mad Engine, Inc. on the ground that its use was parody.

[T.R.B. International, S.A. v. Old Navy, LLC](#)

1:15-cv-05675-PKC (S.D.N.Y.)

Represent Old Navy in copyright infringement action brought by owner of Vilebrequin swimwear.

[Rockefeller & Co., Inc. v. Rockefeller Hughes Corporation](#)

1:15-cv-05411-VEC (S.D.N.Y.)

Represent Rockefeller & Co. in trademark infringement action against Rockefeller Hughes Corp.

[DC Comics v. Gotham City Networking, Inc.](#)

2015 WL 4464694, Opp. No. 91194716 (T.T.A.B. July 17, 2015)

On behalf of DC Comics, the Firm successfully opposed two applications to register GOTHAM BATMEN and a batwing design in connection with entertainment and business networking services. In sustaining the opposition, the Trademark Trial & Appeal Board held that BATMAN was "a famous mark in connection with . . . comic books and movies" and further that such "fame is transferred to a vast array of collateral or merchandising products that are purchased because they bear the BATMAN trademark; that is, consumers have come to associate the fame of BATMAN with the products bearing that mark."

[Coolmath.com, LLC v. Coolmathgames.com](#)

1:14-cv-01185-CMH-MSN (E.D. Va.)

Represent Coolmath.com in action under the Anti-Cybersquatting Piracy Act in the Eastern District of Virginia.

[Whole Oats Enterprises v. Early Bird Foods & Co., Inc.](#)

1:15-cv-1124-RMM-JO (E.D.N.Y.)

Represent defendant granola producer in trademark infringement action brought by musical group Hall & Oates over use of HAULIN' OATS.

[Coolmath.com, LLC v. Evertap LLC](#)

8:14-cv-02638-VMC-TBM (M.D. Fl.)

Represent Coolmath.com in trademark infringement and cybersquatting action in the Middle District of Florida.

[Christian v. Kensington Publishing Corp.](#)

3:14-cv-02301 (M.D. Tenn.)

Represent defendant Kensington Publishing Corp. in action involving claims of copyright infringement and right of publicity.

[Thompson v. Kensington Publishing Corp.](#)

1:14-cv-2949-CM (S.D.N.Y.)

Represent defendant Kensington Publishing Corp. in copyright infringement litigation based on alleged unauthorized production of e-books under publishing agreement.

[General Assembly Space, Inc. v. Fourth Wall Restaurants, LLC](#)

1:14-cv-01163-GBD (S.D.N.Y.)

Represented defendant restaurant in a trademark infringement action brought by a technology education company involving the name GENERAL ASSEMBLY.

[Laser Spine Institute, L.L.C. v. Laser Spine & Pain Institute L.L.C.](#)

1:13-cv-06255-LLS (S.D.N.Y.)

Represented defendant medical practice in trademark infringement action brought by plaintiff Laser Spine Institute, L.L.C.

[Albert M. Watson Photography et al. v. Cao et al.](#)

No. 13 Civ. 02175 PAE (S.D.N.Y.)

Represented artist David Datuna in copyright infringement action brought by photographer Albert Watson in connection with Datuna's alleged infringement of Watson's portrait of Steve Jobs in Datuna's visual installation Steve Jobs-Ayn Rand.

[Foey v. Gap](#)

No. 12 C 5713, 2013 WL 2237515 (N.D. Ill. May 17, 2013)

On behalf of Gap, Inc., successfully obtained dismissal of a copyright action brought by clothing retailer Foey Inc. in the U.S. District Court for the Northern District of Illinois. On Gap's motion to dismiss under Fed. R. Civ. P. 12(b)(6), the Court determined that "no ordinary observer . . . could reasonably conclude that defendant misappropriated plaintiff's protectable expression," and that the works in question "each . . . impresses upon the ordinary observer its own distinct 'total concept and feel.'"

[McNeil-PPC, Inc. v. Walgreen Co.](#)

Opposition No. 91184978, 2013 WL 223400 (T.T.A.B. Jan. 22, 2013)

The Firm successfully represented our client, McNeil-PPC, Inc., a subsidiary of Johnson & Johnson and the exclusive licensee of the ZYRTEC mark for allergy products in the United States, in a five-year challenge before the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office to Walgreen Co.'s attempt to register the mark WAL-ZYR in connection with an allergy product containing the identical active ingredient to ZYRTEC.

[Athleta, Inc. v. Pitbull Clothing Co.](#)

No. CV 12-10499-CAS (FMOx). 2013 WL 142877 (C.D. Cal. Jan. 7, 2013)

The Firm was successful in obtaining a preliminary injunction for our client, Athleta, Inc., a subsidiary of Gap Inc., against Pitbull Clothing Co. and Cory Peck, operators of the website athletica.net.

[Jumbo Bright Trading Limited v. The Gap, Inc.](#)

CV 12-08932 DDP (MANx), 2012 WL 5289784 (C.D. Cal. Oct. 25, 2012), 2012 WL 6721082 (C.D. Cal. Dec. 27, 2012)

On behalf of our client The Gap, Inc., the Firm successfully defeated an emergency motion for a temporary restraining order and a second motion for a preliminary injunction brought by plaintiffs Jumbo Bright Trading Limited and Charles Pozzi against Gap's offering and sale of certain women's loafers.

[Frank Sinatra Enterprises, LLC v. Loizon](#)

Opp. No. 91198282 (T.T.A.B. Sept. 12, 2012)

The Firm successfully represented our client, Frank Sinatra Enterprises, LLC, which holds the exclusive right to commercially exploit Mr. Sinatra's name and likeness, in its challenge before the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office to Michigan-based caterer Bill Loizon's attempt to register the mark FRANKS ANATRA in connection with his catering business.

[Lopez v. Gap, Inc.](#)

833 F. Supp. 2d 400 (S.D.N.Y. 2012)

The firm successfully defended our clients, The Gap, Inc., Gap International Sourcing, Inc., Old Navy, LLC and Old Navy (Apparel), LLC against a trademark infringement and unfair competition action brought by Robert Lopez, who prints and sells t-shirts and other apparel promoting his neighborhood, the Lower East Side of New York City.

[Jackson v. Booker](#)

No. 2:10-cv-05371-JLL-CCC, 2011 WL 3236062 (D.N.J. July 27, 2011), aff'd, 465 Fed.Appx. 163 (3d Cir. 2012)

The firm successfully defended our clients, who include Sundance Channel, Mayor Cory A. Booker and the documentary producers, Marc Benjamin and Marc Levin, against a copyright infringement action brought by author, E. Adam Jackson. Jackson's October 2010 lawsuit alleged that the Sundance Channel's Emmy Award-winning documentary series Brick City infringed Jackson's novel of the same name.

[Screen Media Ventures, L.L.C. v. Castle Hill Productions, Inc. et al.](#)

No. 11 Civ. 0229 LTS (S.D.N.Y.)

Represented defendant and impartial sublicensee Independent Film Channel in a breach of contract and copyright infringement suit between plaintiff licensor and co-defendant licensee over broadcast rights to certain films on client's television network.

[Stark v. Banana Republic LLC](#)

No. 1:11-cv-01364 (N.D. Ill.)

Represented defendant Banana Republic in copyright infringement action involving store window display designs.

[Sandler Systems, Inc. v. Ingersoll-Rand Company et al.](#)

No. 1:10-cv-02661-WMN

Represented Defendants in an action alleging that sales training manuals created by a former employee of Plaintiff subsequently hired by Defendants constituted copyright and trademark infringement.

[Gemma Redux Inc. v. Banana Republic LLC et al.](#)

No. 10 Civ. 03568 JSR (S.D.N.Y.)

Represented defendant Banana Republic in copyright infringement action involving jewelry designs.

[The Gap, Inc. v. Murphy](#)

3:10-cv-04354-EDL (N.D. Cal.)

Represented plaintiff Gap in trademark infringement action against proprietor of GAPNOTE website and social media network.

[The Gap, Inc. v. Twin Tiger USA LLC et al.](#)

2:09-cv-09439-DSF-PLA (C.D. Cal.)

Represented plaintiff The Gap in trademark infringement action involving parallel imported jeans.

[Superman Copyright Termination Litigation](#)

[view case history](#)

The firm was part of the defense team for clients Time Warner Inc., Warner Communications, Inc., Warner Bros. Entertainment Inc., Warner Bros. Television Production Inc. and DC Comics in the ongoing litigation in the U.S. District Court for the Central District of California over the copyright termination interest in certain works featuring the Superman and Superboy characters allegedly owned by the heirs of co-creator, Jerry Siegel. The decisions in which the firm was involved resulted in a number of significant decisions in the complex area of copyright termination and in other areas, relating to, inter alia, defenses to termination claims of work made for hire, co-ownership, derivative work exception, limitation of copyright termination recapture to U.S. rights under copyright and inapplicability of copyright termination to trademark rights; res judicata; jury trial right, and the fair market value of copyright rights in the entertainment arena, among others. Summaries of decisions and links can be found by clicking through "view case history" above.

[Nippon Menard Cosmetic Co. Ltd. v. Colgate-Palmolive Co.](#)

Case No. 2:2008cv04908 (D.N.J.)

Represented Colgate-Palmolive Co. in a declaratory judgment action seeking to invalidate a 1983 settlement agreement and consent judgment resolving a prior trademark dispute between the parties. Obtained favorable settlement.

[Payne v. Anvil Knitwear, Inc.](#)

No. CV 06-8100 SVW SSX, 2007 WL 1953438 (C.D. Cal. June 27, 2007), aff'd, 293 Fed. Appx. 475 (9th Cir. 2008)

Represented Anvil Knitwear, Inc. in a successful motion for summary judgment dismissing claims for copyright infringement in the U.S. District Court for the Central District of California. The Court granted Anvil's motion in its entirety and dismissed the case and awarded a substantial amount of attorneys' fees. The U.S. Court of Appeals for the Ninth Circuit affirmed the decision in its entirety.

[Kensington Publishing Corp. v. Gutierrez](#)

No. 05 Civ. 10529 LTS (S.D.N.Y.)

Represented plaintiff Kensington Publishing Corp. in trademark infringement action against author involving the BAD BOYS series of romance novels.

[Alexander v. AOL Time Warner, Inc. et al.](#)

132 Fed.Appx. 267 (11th Cir. 2005)

Obtained summary judgment on collateral estoppel grounds for defendants Kensington Publishing Corp. and author and former DEA agent Jerry Speziale on claims brought by Paul Lir Alexander for invasion of privacy and violation of right of publicity by Speziale's inclusion of information about Alexander's role as a DEA informant in his book Without a Badge. The U.S. Court of Appeals for the Eleventh Circuit affirmed.

[Quicksilver Inc. v. Quick Sports International BV et al.](#)

8:03-cv-01548-DOC-AN (C.D. Cal.)

Represented defendants Quick Sports International, a well-known Dutch soccer brand, along with its principals, in connection with a trademark infringement lawsuit brought by plaintiff Quicksilver.

[Alberto-Culver Co. v. E. Sunwoo Inc. et al.](#)

2:03-cv-08357-GPS-SS (C.D. Cal.)

Represented defendants in trademark infringement action involving plaintiff Alberto-Culver's VO5 mark.

[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.

[Echo Design Group, Inc. v. Zino Davidoff S.A.](#)

283 F. Supp. 2d 963 (S.D.N.Y. 2003)

Successfully defeated a preliminary injunction motion brought by The Echo Design Group, Inc., a fashion and home accessories manufacturer, against Zino Davidoff S.A., Davidoff & Cie S.A., Davidoff of Geneva (NY), Inc., Coty Inc., and Lancaster Group LLC to prevent the US launch of ECHO DAVIDOFF, a new fragrance line.

[Glow Indus., Inc. v. Lopez](#)

252 F. Supp. 2d 962 (C.D. Cal. 2002), 273 F. Supp. 2d 1095 (C.D. Cal. 2003)

On behalf of Jennifer Lopez and Coty Inc., defeated a motion for a preliminary injunction brought by Glow Industries in the United States District Court for the Central District of California. The motion sought to block the launch of the GLOW BY J.LO fragrance line. Subsequently defeated motion for summary judgment in which Glow Industries sought to invalidate acquisition of GLOW KIT mark and declaration of non-infringement.

Published Works

The Arbitrary Nature of Reverse Confusion Claims Litigation and Enforcement Focus 2004, Managing Intellectual Property
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Baseball Trademark Licensing and the Antitrust Exemption: An Analysis of New York Yankees Partnership v. Major League Baseball Enterprises, Inc.
Look Before You Leap Into Naming Rights Agreements, Managing Intellectual Property, October 2009
[Download](#)