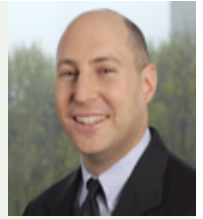


Craig S. Mende



Practice Description

Craig Mende is a Partner in the firm's litigation department. He litigates and counsels on a broad range of trademark, copyright, right of publicity and new media matters; drafts, negotiates and advises on trademark and copyright licenses, purchase agreements and website agreements; and oversees anti-counterfeiting enforcement programs for clients in the apparel, healthcare and other industries.

Prior positions: Associate in the litigation department at Cravath, Swaine and Moore, and Counsel at Arista Records.

Education

Haverford College (B.A., with Honors in Philosophy, 1986); New York University School of Law (J.D., magna cum laude, 1991). Order of the Coif. Libel Defense Resources Center Fellowship, 1990-1991.

Judicial Clerkship

Law Clerk to Hon. Alan E. Norris, U.S. Court of Appeals, Sixth Circuit, 1991-1992.

Professional Activities

Copyright Society of the U.S.A.: Trustee and Executive Committee Member (2014-present); Co-Chair, New York Chapter (2011-2014). American Bar Association (Intellectual Property Section); International Trademark Association (INTA); International Anti-Counterfeiting Coalition (IACC). Speaker on copyright, trademark, anti-counterfeiting and online infringement issues at events including for Copyright Society of the U.S.A. annual meeting; California CPA Education Foundation's Entertainment Industry Conference; American Conference Institute's Corporate Counsel's Guide to Anti-Counterfeiting & Brand Integrity Protection conference.

Honors

Selected for *Best Lawyers in America*® in the field of Litigation-Intellectual Property (2019 - 2017); recognized as a copyright specialist and in the trademark litigation and dispute resolution category in the Legal 500 US Guide; also recognized in Who's Who Legal Trademarks; WTR 1000 (World Trademark Review); Managing IP; New York Super Lawyers®, Intellectual Property Litigation (2018 - 2009); Named one of the "Top 50 under 45" intellectual property lawyers by IP Law & Business (2007).

Admissions

New York State
United States District Court for the Southern and Eastern Districts of New York
United States Court of Appeals for the Second, Sixth and Ninth Circuits

Selected Cases

[Entrepreneur Media, Inc. v. EYGN Ltd.](#)

Case No. SA-CV-08-0608 DOC (MLGx), 2008 WL 11338010 (C.D. Cal. Dec. 17, 2008)

In a trademark case concerning the ENTREPRENEUR OF THE YEAR mark, the Firm won a motion to dismiss declaratory judgment action against one Ernst & Young ("E&Y") party for lack of personal jurisdiction, and won motion to transfer the action against the remaining E&Y parties and consolidate with E&Y's infringement action in New York, ultimately leading to a favorable settlement for our clients.

[Troll Co. A/S v. Uneeda Doll Co.](#)

483 F.3d 150 (2d Cir. 2007)

In case of first impression involving restored copyrights in works of foreign authors, won affirmance of preliminary injunction on behalf of owner of U.S. copyright in the famous Good Luck Troll doll against distributor of Wish-nik dolls, successfully arguing that defendant was not a reliance party entitled to continue selling copies of the Good Luck Troll because 9-year gap in sales showed it did not make continuous exploitation of the work from before it was restored.

[Rhino Entertainment Co. v. DomainSource.com, Inc.](#)

Case No. D2006-0968 (WIPO Oct. 18, 2006); *Rhino Entertainment Co. v. Suk Min Jun*,
Case No. D2006-0948 (WIPO Oct. 25, 2006)

Recovered BEEGEE.COM and BEEGEES.COM domain names in Uniform Domain Name Dispute Resolution Policy ("UDRP") proceedings from two parties using the names for websites linking to BeeGees-related sites (and others) of third parties to generate advertising or click through revenue.

[Atari Interactive Inc. v. Frontier Developments Ltd.](#)

Case No. 05-CV-10300 (JES) (S.D.N.Y. 2005) (w/E. Gourvitz)

Defending copyright and contract action by videogame publisher to enjoin U.K. game developer; negotiated favorable settlement to permit distribution of challenged games.

[Honeywell Int'l, Inc. v. Board of Trustees of the Univ. of Arkansas](#)

3:04 cv 1844 (RNC) (D. Conn. 2005) (w/M. Chiappetta)

Brought declaratory judgment action for Honeywell and defended against sovereign immunity claim by University of Arkansas, which objected to client's use of an AIRHOG air filter design mark alleged to infringe University's registered RAZORBACK mascot logos. Obtained favorable settlement.

[Wyeth v. 3D Group, Inc. et al.](#)

Case No. JFM02CV2034 (D. Md. 2002)

Secured ex parte order to seize shipments of "Centumz" branded vitamins held to infringe client's CENTRUM mark. (w/M.

Chiappetta)

[Times Mirror Magazines, Inc. v. Field & Stream Licenses Company](#)

103 F. Supp. 2d 711 (SDNY 2000), aff'd, 294 F.3d 383 (2d. Cir. 2002)

Plaintiff owned the trademark Field & Stream for publications, and defendant owned the Field & Stream trademark for clothing and other products. The parties had co-existed for decades and had more recently entered into concurrent use and settlement agreements specifying the products reserved to each. We won summary judgment dismissing plaintiff's trademark infringement claims seeking to invalidate the concurrent use agreements based on allegations of breach of contract and likelihood of public confusion. At a trial on defendant's counterclaim for breach of a covenant not to sue, we won a judgment of \$1.8 million which was affirmed by the U.S. Court of Appeals for the Second Circuit.

[Play Industries v. Columbia House Company](#)

No. CV-98-1158-GEB, aff'd 187 F.3d 648 (9th Cir. 1999) (w/M. Driscoll and R. Zissu)

Defeated preliminary injunction motion by video technology company that owned PLAY trademark to stop client's launch of a positive option PLAY FROM COLUMBIA HOUSE music club.

[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.

Published Works

Hey They're Playing My Song! - Litigating Music Copyrights

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

Deconstructing Music Sampling

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

Madonna and Audio Streaming: Copyright Infringement on the Internet Music Sampling: More Than Digital Theft?

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

How the High Court Sliced the Safety Net against Knockoffs Internet Links Raise Issues of Trademark, Other Liability Recent Copyright and Trademark Decisions Analyzed

Co-author: [David A. Donahue](#)

When Copyright and Trademark Rights Overlap