

David A. Donahue

Partner

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Overview

“Before joining Fross Zelnick, I handled general commercial litigation at a multinational firm and clerked for two federal judges, so I know the Federal Rules of Civil Procedure as well as I know the U.S. Trademark and Copyright Acts. That comes in very handy at the bargaining table and in the courtroom.”

David Donahue brings the benefit of his extensive courtroom experience when advising clients on protection and enforcement issues relating to copyright, trademark, unfair competition, right of publicity, design patent, and related commercial matters. His commercial litigation experience also informs his approach to negotiating and drafting commercial agreements involving intellectual property matters.

David’s deep litigation experience includes successes in federal and state trial and appellate courts across the country and in matters before the USPTO’s Trademark Trial and Appeal Board. He advises and represents clients that reflect diverse

sectors, including new technologies, professional sports leagues, hotels and resorts, food and beverage, fashion, music, entertainment and celebrities, authors and literary works, fine art, and film.

Representative Experience

Beyond the reported decisions listed above, David has worked on the following matters:

- ***Vidal v. Elster***, Co-authored U.S. Supreme Court brief submitted by the International Trademark Association (INTA) as amicus curiae. INTA’s brief argues that Section 2(c) of the U.S. Trademark Act, which prohibits the registration of marks featuring the name of a living individual without their written consent, is constitutional as applied to Steve Elster’s rejected attempt to register the trademark TRUMP TOO SMALL for use on t-shirts.
- ***Jack Daniel’s Properties, Inc. v. VIP Products LLC***, Co-authored U.S. Supreme Court brief in this matter submitted by the International Trademark Association (INTA) as

amicus curiae. The case addresses the balance between the First Amendment and trademark law in the context of a dog toy imitating the trade dress and trademarks of Jack Daniel's.

- ***Romag Fasteners Inc. v. Fossil Inc.*** Co-authored U.S. Supreme Court brief in this matter submitted by the International Trademark Association (INTA) as amicus curiae. INTA's brief argues that while willfulness is an important equitable factor in determining whether to require a trademark infringer to disgorge profits, it should not be treated as a prerequisite to profit disgorgement under Section 35 of the U.S. Trademark (Lanham) Act.
- ***Iancu v. Brunetti.***, 139 S. Ct. 2294 (2019). Co-authored the Supreme Court of the U.S. brief submitted by the International Trademark Association (INTA) as amicus curiae. INTA's brief argues that Section 2(a) of the U.S. Trademark (Lanham) Act is unconstitutional under the First Amendment to the extent it prohibits registration of trademarks that constitute "immoral ... or scandalous matter."
- ***Belmora LLC v. Bayer Consumer Care AG***, 819 F.3d 697 (4th Cir. 2016). Co-authored an amicus brief submitted to the U.S. Supreme Court on behalf of the International Trademark Association (INTA) in support of the petition for a writ of certiorari seeking review of the U.S. Court of Appeals for the Fourth Circuit's decision in the FLANAX case. In the brief, INTA urged the Supreme Court to grant the petition so that it could resolve a split among various U.S. circuit courts as to whether and under what circumstances a foreign trademark owner who does not use its mark in the U.S. has standing to object to the use and registration of the mark by another in the U.S.
- ***Prada, S.A. v. Preferred Fragrance, Inc.***, No. 13-cv-07371-RA (S.D.N.Y.). Represented Prada S.A. ("Prada") in trademark and trade dress infringement litigation against sellers of PARTY CANDY perfume, a "knock-off" of Prada's PRADA CANDY fragrance.
- ***Pearson Education, Inc. et al v. Boundless Learning Inc.***, No. 12-cv-1986 (S.D.N.Y. 2013). Represented Defendant Boundless Learning, Inc. ("Boundless") in a recently settled case in the U.S. District Court for the Southern District of New York brought by three publishers of college-level textbooks in biology, economics and psychology, respectively. The publishers claimed Boundless infringed Plaintiffs' copyrights in violation of the U.S. Copyright Act and engaged in unfair competition and false advertising under the U.S. Trademark Act by creating free, electronic textbooks for students that covered the same factual concepts and topics as Plaintiffs' textbooks and were marketed as alternatives to their products.
- ***Edgar Rice Burroughs, Inc. v. Dynamic Forces, Inc., et al.***, No. 12 Civ. 1192 (S.D.N.Y.). Represented Plaintiff Edgar Rice Burroughs, Inc. ("ERB"), owner of all existing copyright and trademark rights relating to the literary works of Edgar Rice Burroughs, including the TARZAN and JOHN CARTER OF MARS series of stories. In the case, ERB claimed that the defendant comic book publishers who were using the marks LORD OF THE JUNGLE and WARLORD OF MARS (among others) for comic book series based on the TARZAN and JOHN CARTER OF MARS

stories were liable for (i) trademark infringement and unfair competition under the U.S.

Trademark (Lanham) Act and related state laws, and (ii) copyright infringement under the laws of the United Kingdom, France and the Netherlands. The parties settled their claims before trial.

- ***Datascope Corp. v. Mindray DS USA, Inc.***, No. 600561/10 (N.Y. Sup.); ***Datascope Corp. v. Mindray DS USA, Inc., Mindray Medical International Limited, and Shenzhen Mindray Bio-Medical Electronics Co. Ltd.***, No. 11-CV-3488 (VM) (S.D.N.Y.). Represented one of the world's largest manufacturers of patient monitoring equipment and its affiliates in breach of license and trademark infringement litigation brought by its licensor. Successfully defended against preliminary injunction motion seeking termination of trademark license and against summary judgment motion seeking specific performance and cease of manufacture of products by defendants' affiliate in China. Negotiated settlement before trial.
- ***Starwood (M) International, Inc. v. La Mer Hotel, S. de R.L. de C.V.***, No. 10 Civ. 9428 (PKC) (S.D.N.Y. 2010). Obtained temporary restraining order and preliminary injunction on behalf of plaintiff, owner of the LE MERIDIEN mark for hotels, preventing its licensee from de-branding the LE MERIDIEN hotel in Cancun, Mexico pending arbitration of the parties' license dispute.
- ***The Children's Place Retail Stores, Inc., et al. v. Kohl's Corp., et al.***, No. 09 CV 5247 (PAC) (S.D.N.Y.). Represented plaintiffs in design patent and trademark infringement litigation arising out of defendants' infringement

of plaintiff's back-pocket stitching design for children's jeans. Negotiated settlement before trial.

- ***Green Day, Inc. v. Miles-Bramwell Executive Services, Ltd.***, Opposition No. 91174725 (T.T.A.B.). Represented world-famous rock band in opposition proceedings before the Trademark Trial & Appeal Board of the U.S. Patent & Trademark Office. Negotiated settlement before trial.
- ***Universal Music – MGB NA LLC v. Killersound, Inc.***, 07 CV 8353 (NRB) (S.D.N.Y.). Represented plaintiff music publisher in trademark infringement action against competitor. Negotiated settlement before trial.
- ***The Hebrew University of Jerusalem v. Benefit Cosmetics, LLC***, No. CV 09 08711 PSW (C.D. Cal.). Represented defendant in right of publicity and unfair competition action arising out of defendant's use of a photograph of Albert Einstein in a tongue-in-cheek advertisement for cosmetics product. Negotiated settlement before trial.
- ***Photographic Illustrators Corp. v. The Gillette Co.***, No. 04-Civ-10913 (D. Mass.). Obtained partial summary judgment on Gillette's behalf in this copyright infringement and breach of photography license agreement dispute, resulting in dismissal of plaintiff's request for \$15 million in liquidated damages. The parties settled their remaining claims before trial.

Education

St. John's University School of Law (JD, *magna cum laude*, 1998)

St. Thomas More Institute Scholarship; Kenneth Wang Fellowship; *St. John's Law Review*, Associate Editor

University of Michigan (BA, 1994)

Admissions

Bar Admissions

New York

Court Admissions

U.S. Court of Appeals, 2nd Circuit

U.S. Court of Appeals, 9th Circuit

U.S. Court of Appeals, Federal Circuit

U.S. District Court, Eastern, New York

U.S. District Court, Southern, New York

Focus

- Publishing
- Entertainment Properties
- Celebrities, Bands & Athletes
- Fashion
- Food & Beverage
- Hospitality & Hotels
- Startup & Emerging Growth
- Sports

Services

- Trademark

- Litigation
- Copyright
- Social Media & Domain Names
- Design
- Publicity & Privacy Rights

Associations

International Trademark Association (International Amicus Committee, 2016-present; Right of Publicity Committee, 2020-22, past member of Internet Committee and Enforcement Committee)

Federal Bar Council (Intellectual Property Committee, 2014-present)

Association of the Bar of the City of New York (Sports Law Committee; past member of Copyright & Literary Property Committee and Entertainment Law Committee)

Copyright Society of the U.S.A. (past Assistant Secretary, Co-chair of Membership Committee, Co-chair of Annual Meeting Committee and member of the Board of Trustees)

American Bar Association

Recognition

Chambers USA Ranked Lawyers 2021-2023
World Trademark Review's WTR 1000 2014-25, "With more than two decades' experience, Donahue is a regular presence before the courts and at the TTAB."

Managing IP's IP STARS 2012, 2015-23

The Best Lawyers in America®, Copyright Law and Litigation – Intellectual Property 2021-25
Who's Who Legal IP – Trademarks 2013-14; Global

Leaders 2018-23; Thought Leaders – USA, IP – Trademarks 2024-25, “Peers describe David Donahue as a “first-rate trademark litigator” who provides clients with “strategic and commercial advice through difficult issues.”

World IP Review “WIPR Leader” 2020-2023

Super Lawyers® Intellectual Property Litigation, New York Metro 2013-23

Super Lawyers® Intellectual Property Rising Stars 2012

The Legal 500 2015-19

Decisions

- World Champ Tech, LLC v. Peloton Interactive, Inc.
- UMG Recordings, Inc. v. KG Music Center LLC
- APP Group (Canada) Inc. d/b/a Mackage and A.P.P. Group Inc. d/b/a Mackage v. Rudsak USA Inc.
- Saleh v. Sulka Trading Ltd., et al.
- Three Thirteen Licensing, LLC v. Marshall B. Mathers III
- Old Navy (Apparel), LLC v. Blissman
- UMG Recordings, Inc. v. Siggy Music, Inc.
- Regulatory Fundamentals Grp. LLC v. Governance Risk Mgmt. Compliance, LLC
- Revelations Perfume v. Prince Rogers Nelson
- De Beers LV Trademark Ltd. v. DeBeers Diamond Syndicate, Inc.
- Milne v. Stephen Slesinger, Inc.
- Missing Cougar Co. v. Edgar Rice Burroughs, Inc.

- Copp v. Ramirez
- UMG Recordings, Inc. v. O'Rourke
- Entrepreneur Media, Inc. v. EYGN Ltd.
- Video-Cinema-Films, Inc. v. Lloyd E. Rigler-Lawrence E. Deutsch Found.
- Cavalier v. The Jim Henson Co., Inc.

Clerkships

Law Clerk to the Hon. Joseph M. McLaughlin, U.S. Circuit Judge, Court of Appeals for the Second Circuit (2001-2002)

Law Clerk to the Hon. Milton Pollack, U.S. District Judge, Southern District of New York (1998-1999)

Speaking Engagements

Supreme Court IP Series: *Romag Fasteners v. Fossil, Inc.*, American University Washington College of Law, January 14, 2021

Advanced Trademark Law 2020: Current Issues, Practicing Law Institute, March 18, 2020

The Fashion Law Lookbook: Trends and Mixed Patterns Impacting the Fashion Industry (Panelist speaking on recent case law) NYC Bar Association, June 19, 2019

Mastering the Protection of Graphical User Interfaces (Panelist speaking on protection for GUIs under U.S. IP law), International Trademark Association Annual Convention, May 22, 2019

Ethics in Trademark Practice, CLE presentation at Fross Zelnick, September 25, 2019

Effective Strategies for Managing Global Trademark Portfolios and Tricks of the Trade

(moderator), MIP Global Trademark Roadshow, June 21 (Palo Alto) and June 23 (New York), 2017

Monetary Remedies for Trademark Infringement Under U.S. Law, European Community Trademark Association, Dubrovnik, Croatia, June 22, 2016

Copyright in Audiovisual Works After Garcia and 16 Casa Duse (sole panelist), Fordham Intellectual Property Law Institute, March 31, 2016

The Importance of Copyright Management Information (panelist focusing on claims for removal of CMI and use of false CMI under Section 1202 of the Copyright Act), Copyright and Technology NYC, January 19, 2016

News Flash - Garcia v. Google, The Copyright Society of the U.S.A. Annual Meeting, June 9, 2015

Supreme Court - IP Year in Review, New York State Bar Association IP Section Annual Meeting, February 9, 2015

Calculating Damages in Copyright and Trademark Infringement Cases, Nevada Bar Association IP Law Conference, November 1, 2013

Litigating a Trademark Dispute: Popular Motion Practice Strategies, Association of the Bar of the City of New York, May 12, 2009

Current Developments in Copyright Law: Termination After Superman & Steinbeck, Association of the Bar of the City of New York, March 12, 2009

Statutory Termination of Transfers, Practising Law Institute's Advanced Seminar on Copyright Law, May 12, 2008

Private Client Events:

Celebrity Bootcamp (private CLE for movie and television studio on trademark, copyright, and right of publicity issues involving use of celebrities in advertising and social media)

The Right of Publicity (private CLE for cosmetics company)

Aereo and the Public Performance Right Under the U.S. Copyright Act (private CLE for movie and television studio)

Termination of Copyright Transfers in the Music Industry (private CLE for record labels)

Intellectual Property Issues In Clothing Design (private CLE for clothing company)

Testing the Limits of the Safe Harbor: Recent Developments Under the DMCA (private CLE for record label)

Domain Names, Keywords & Private Labeling (private CLE for pharmaceutical company)

Publications

International Comparative Legal Guide to Copyright 2021, contributed the U.S. chapter with Jason Jones

International Comparative Legal Guide to Copyright 2020, contributed the U.S. chapter with Jason Jones

International Comparative Legal Guide to Copyright 2019, contributed the U.S. chapter with Jason Jones

International Comparative Legal Guide to Copyright 2015, contributed the U.S. chapter

Supreme Court Rules on TTAB Preclusion,



Managing IP, co-author with Jason Jones, May
2015