



Jeffrey A. Lindenbaum

MEMBER

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OVERVIEW

Jeffrey Lindenbaum is a litigator with a broad knowledge of every aspect of the management of IP-related disputes. His appellate and trial court experience includes advising clients and leading litigation of complex disputes involving trademarks, patents, right of publicity, copyright, false advertising, trade dress, trade secrets, and a host of other issues. He is also one of the nation's most experienced litigators in disputed proceedings at the U.S. Trademark Trial and Appeal Board (TTAB).

Jeffrey has years of trademark and counterfeit enforcement experience, particularly for luxury goods, such as high fashion and the watch and jewelry industry. For luxury brands, Jeffrey sees his role as integral to protecting a brand's prestige, reputation, and fame. In combatting counterfeiting, he leverages a broad range of procedural tools, such as securing emergency seizures of counterfeit goods, obtaining temporary restraining orders and preliminary injunctions, as well as attacking the financial channels upon which counterfeiters rely.

Working with associated attorneys and firms in Canada, Europe, Asia, and South America, Jeffrey protects and enforces his clients intellectual property rights worldwide for consumer goods, industrial products, iconic food brands, services, and entertainment properties, and also ensures legal protections are in place in the United States for his clients located abroad.

Practices

Anti-Counterfeiting Litigation
Appellate Litigation
Copyright Litigation
False Advertising and Unfair Competition Litigation
Industrial Designs, Patents, and Trade Dress Infringement
Patent Litigation
Trade Secret Litigation
Trademark Litigation
Trademark Oppositions and Cancellations
Trademark Prosecution

Education

J.D., University at Buffalo School of Law

B.A., Binghamton University

Bar Admissions

New York

Court Admissions

U.S. Court of Appeals for the

Jeffrey's ability to counsel clients is widely recognized by his clients, services which he provides across the complete spectrum of IP-related work, including analysis and assessment of each client's specific business and legal needs and development of customized, highly strategic solutions. For disputed matters, he identifies the strengths and weaknesses of a client's position, determines the risks and benefits of alternative actions (including taking no action), and develops plans to achieve each client's goals within budget, while balancing their other needs, including financial and reputation-related goals. His clear and direct advice is always welcomed and appreciated by his clients.

EXPERIENCE

Patent Litigation

- Lead counsel for supplier of surgical and dental infrared-controlled lighting products in a lawsuit against competitor that was selling products that infringed client's utility patent and trademark. Secured \$100,000 judgment against defendant including injunctive relief, destruction of remaining inventory and expedited discovery of damages. (W.D.N.Y. 2021).
- Lead counsel for defendant in patent infringement lawsuit involving bedroom furniture. After prevailing on motion to transfer the case from California to our client's home district of Maryland, and after presenting irrefutable evidence of invalidating prior art, we secured dismissal of all claims. (C.D. Cal. and D. Maryland 2020).
- Lead counsel for defendant in patent infringement lawsuit involving remote control toy helicopters. Following mediation, a settlement was reached resulting in dismissal of all claims against our client. (S.D.N.Y. 2020).
- Co-counsel for inventor and owner of patent relating to social media platform in lawsuit involving challenge of inventorship. (E. D.N.Y. 2020).
- Lead counsel for famous French fashion house and owner of design patent and trade dress in iconic shoe design. After defeating other side's motion to dismiss, settlement resolving all claims was secured. (S.D.N.Y. 2019).
- Lead counsel for defendant in patent infringement lawsuit involving a touchless operating mechanism for a surgical headlamp utilizing an active infrared detection transmitter.

Federal Circuit

U.S. Court of Appeals for the Fourth Circuit

U.S. District Court for the Southern District of New York

U.S. District Court for the Eastern District of New York

U.S. District Court for the Northern District of New York

U.S. District Court for the Western District of New York

U.S. District Court for the Eastern District of Michigan

U.S. District Court for the Western District of Michigan

U.S. District Court for the Eastern District of Texas

Favorable settlement was reached resulting in dismissal of all claims against client. (S.D.N.Y. 2018).

- Lead counsel for famous French fashion house accused of infringing two design patents. Successfully secured an Order transferring the lawsuit from Federal Court in Texas to New York. (Southern District of New York 2017).
- Lead counsel for paint roller manufacturer accused of infringing two patents. Successfully dismissed all claims and secured a finding of non-infringement at summary judgment. Obtained an Order finding case “exceptional,” and recovering client’s attorney’s fees and costs. Successfully argued appeal at the Court of Appeals for the Federal Circuit, securing affirmance of summary judgment and attorney’s fees rulings. Published decisions at 2013 U.S. Dist. LEXIS 10499 and 2013 U.S. Dist. LEXIS 58958 .(U.S. District Court, Central District of Cal.; U.S. Court of Appeals, Federal Circuit 2014).
- Lead counsel in patent infringement lawsuit alleging that aspects of client’s web-based online ordering system infringed software patents owned by plaintiff. The court granted our motion to dismiss plaintiff’s claims for contributory and induced patent infringement before favorable settlement was reached. Published decision at 2013 U.S Dist. LEXIS 116577. (U.S. District Court, District of Utah 2013).
- Lead counsel for EM-Microelectronics-US, Inc. in patent infringement suit involving semiconductor chips using embedded flash memory. Obtained dismissal of all claims against EM-US. Published Decision at 2011 U.S. Dist. LEXIS 102618. (U.S. District Court, Eastern District of Tex. 2011).
- Lead counsel for Defendant and Declaratory Judgment Plaintiff in two patent infringement actions involving external batteries for the Apple iPhone. Favorable settlement reached. (U.S. District Courts, Northern District of N.Y. and Central District of Cal. 2011).
- Counsel for Plaintiff in patent infringement suit for a multi-functional transaction processing system for the delivery of pre-paid phone and gift cards. After favorable Markman ruling and briefing on summary judgment, settlement agreement was reached. (U.S. District Court, Southern District of Fla, 2007).
- Obtained Summary Judgment in favor of client on its claims of willful patent infringement involving infringing sales of magnetic eyewear. Published decision at 2004 U.S. Dist. LEXIS 27493. (U.S. District Court, District of Nev. 2004).

Trademark and Anti-counterfeiting Litigation

- Lead counsel for Swiss cheese maker in lawsuit to protect client’s trade dress in packaging for its snack cheese product. Following significant litigation over ESI discovery, secured a Consent Judgment in favor of our client enjoining all future marketing and sales of competing snack cheese product in net bag packaging. (N.D. Ill. 2020).
- Lead counsel for financial services company and hedge fund to enforce its trademark against another financial service’s company that adopted a similar mark. (W.D. Mich 2020). Secured early favorable settlement protecting client’s trademark rights.
- Lead counsel for famous French fashion house Saint Laurent, defending claims filed by Levi Stauss & Co. regarding Levi’s alleged rights in trade dress for its jeans pocket tab. Following mediation, secured settlement and dismissal of all claims against our client. (C.D. Cal. 2019).

- Lead counsel in dispute involving protection of trademark in the field of sports. Favorable settlement secured protecting client's brand. (D. Mass 2018).
- Lead counsel for energy drink beverage manufacturer that was sued for trademark infringement by Bourbon Street (New Orleans) chain of bars/restaurants. Secured dismissal of lawsuit in Louisiana based on lack of personal jurisdiction. Commenced Declaratory Judgment action in District Court in Connecticut, and settled the dispute. (E.D. Louisiana and D. Conn. 2016).
- Lead counsel in trade dress infringement lawsuit in the Western District of North Carolina directed to reusable nonwoven cleaning cloths (Handi-Wipes). Represented ten defendants including Church & Dwight (ARM & HAMMER), Boscov's Department Stores, Winn-Dixie, BI-LO and Delhaize supermarkets. After successfully defeating plaintiff's motion for summary judgment, secured settlement dismissing all claims. (W.D. North Carolina 2016).
- Lead counsel for famous Swiss watch manufacturer in lawsuit against the owners of 29 counterfeit websites. Obtained ex-parte temporary restraining order, preliminary injunction and seizure of all 29 websites, along with an Order seizing financial accounts related to the websites. (Southern District of New York 2013).
- Prevailed at Summary Judgment in trademark infringement suit against Audi AG and Volkswagen of America, securing client's right to vanity telephone number 1-800-ALL-AUDI. Published Decisions at 2006 U.S. Dist. LEXIS 70201, 2007 U.S. Dist. LEXIS 10054 and 592 F. Supp. 2d 246 (Eastern District of Michigan and Northern District of New York 2009).
- Lead counsel responsible for obtaining Permanent Injunction, Cancellation of adversary's trademark registrations, and Award of over \$1.4 million in damages and attorney's fees in favor of Dutch manufacturer of fire suppression products in suit for trademark infringement and unfair competition (Southern District of New York 2012).
- Lead counsel for defendant, a company that harvests and distributes sea vegetables, in suit involving claims of trademark infringement, unfair competition and cybersquatting. Obtained dismissal of all claims, cancellation of adversary's trademark registration, and award of attorney's fees. (District of Arizona 2013).
- Lead counsel for defendant in lawsuit involving claims of trademark infringement and right of publicity relating to late Reggae performer Bob Marley. Prior to favorable settlement, successfully defended motion for preliminary injunction and obtained dismissal of right of publicity claim, and claims brought against individual defendant. Published decisions at 2006 U.S. Dist. LEXIS 40685, 2007 U.S. Dist. LEXIS 35034, and 2007 U.S. Dist. LEXIS 43012 (District of Nevada 2007).
- Lead counsel for famous Swiss watchmaker Swatch, S.A. in lawsuit involving gray market sales of watches. Secured Consent Judgment and Permanent Injunction against further sales of watches. (Southern District of Florida 2011).
- Counsel for Plaintiff in suit involving counterfeit curry powder. Obtained preliminary injunction and Court Order permitting ex-parte seizure of counterfeit products. Seizure resulted in acquisition and destruction of 22,000 counterfeit products, leading to entry of a Consent Judgment and Permanent Injunction against further infringement. Published decision at 2006 U.S. Dist. LEXIS 79332 (Eastern District of New York 2007).

- Counsel for Plaintiff in suit involving counterfeit cosmetic products. Secured a Temporary Restraining Order and Order permitting ex-parte seizure of counterfeit products. Seizure resulted in confiscation of counterfeit products along with banking records which led to freezing of financial assets. (Eastern District of New York 2003).
- Counsel for Plaintiff in ex-parte seizure of gray market watches at Manhattan jewelry store. Seizure resulted in confiscation of 65 OMEGA, RADO and TISSOT watches, and related business records. (Southern District of New York 2005).

Copyright Litigation

- Lead counsel for national chain of barbershops whose advertising materials were accused of infringing photographer's copyright protected images. (S.D. TX 2016).
- Counsel for Plaintiff in trademark and copyright infringement lawsuit involving distribution of competitor's infringing product catalogue. Following briefing on summary judgment, favorable settlement reached. (Southern District of Florida).
- Lead counsel for licensor of vintage movie poster artwork and movie production still photographs. Defended claims of copyright infringement, trademark infringement and right of publicity related to certain characters and scenes from the movies *The Wizard of Oz* and *Gone with the Wind*. (Eastern District of Missouri 2008).
- Counsel for Defendant, a publicly traded company, that was accused of copyright infringement related to continuing legal education programming that was streamed over the Internet and sold on DVDs. Following settlement, all claims against client were dismissed. (Northern District of Illinois 2008).

Trade Secret and False Advertising

- Lead counsel for computer programmer accused of misappropriation of trade secrets and breach of employment agreement. Secured dismissal of all claims. (SDNY 2017).
- Counsel for Plaintiff in lawsuit involving misappropriation of trade secrets by former employee of corporation. Obtained preliminary injunction enjoining defendant from unfairly competing with former employer. Published decision at 2006 U.S. Dist. LEXIS 85988. (U.S. District Court, Southern District of N.Y. 2009).
- Counsel for plaintiff in lawsuit involving breach of contract and misappropriation of trade secrets related to a corporate-branded amusement park ride and "consumer experience" to be developed in Times Square, New York. Litigated dispute through motion practice and discovery. (U.S. District Court, D. of Conn. 2010).
- Lead Counsel for Plaintiff in lawsuit for defamation and false advertising involving competitor's disparaging remarks in publication directed to parties' customers. (U.S. District Court, Eastern District of N.Y.).

Right of Publicity Litigation

- Lead counsel for defendant in lawsuit involving claims of trademark infringement and right of publicity relating to late Reggae performer Bob Marley and claims related to Jazz performer Miles Davis. Prior to favorable settlement, successfully defended motion for preliminary injunction and obtained dismissal of right of publicity claim, and claims brought against individual defendant. (U.S. District Court, District of Nev.).
- Lead counsel for licensor of vintage movie poster artwork and movie production still photographs. Defended claims of copyright infringement, trademark infringement and right of publicity related to certain characters and scenes from the movies The Wizard of Oz and Gone with the Wind. (U.S. District Court, Eastern District of Mo. 2008).

Domain Name Disputes

- Prevailed at Summary Judgment in trademark infringement suit against Audi AG and Volkswagen of America, securing client's right to vanity telephone number 1-800-ALL-AUDI, and successfully defending cyberpiracy claim. (U.S. District Court, Eastern District of Mich. and Northern District of N. Y.).
- Lead counsel for defendant, a company that harvests and distributes sea vegetables, in suit involving claims of trademark infringement, unfair competition and cybersquatting (related to domain name seaveg.com). Obtained dismissal of all claims, cancellation of adversary's trademark registration, and award of attorney's fees. (U.S. District Court, District of Ariz.).
- Counsel for G4S plc. involving several U.S. domain name disputes. Secured termination of infringing domains and websites.

Federal Appeals

- Lead counsel in appeal of Trademark Office refusal of a word + design mark. Drafted briefs and argued before Federal Circuit that the Trademark Office's finding that the design element was descriptive was erroneous because the applied-for design employed fanciful elements that were arbitrary and unnaturally positioned. (US Court of Appeals, Federal Circuit 2015).
- Lead counsel for paint roller manufacturer accused of infringing two patents. Successfully dismissed all claims and secured a finding of non-infringement at summary judgment. Obtained an Order finding case "exceptional," and recovering client's attorney's fees and costs. Successfully argued appeal at the Court of Appeals for the Federal Circuit, securing affirmance of summary judgment and attorney's fees rulings. Published decisions at 2013 U.S. Dist. LEXIS 10499 and 2013 U.S. Dist. LEXIS 58958 (U.S. District Court, Central District of Calif.; U.S. Court of Appeals, Federal Circuit).
- Lead counsel for Opposer in successful Opposition against an application to register the mark iWATCH for watches. In a precedential decision issued after trial and oral argument, the TTAB held that applicant had failed to establish it had a bona fide intent to use the mark in commerce. Briefed and argued appeal at the US Court of Appeals for the Federal Circuit in Washington, D.C. (2014) securing favorable decision and opinion addressing an issue of first impression before this Court as to the standard for challenging a trademark registration on the basis of lack of bona fide intent to use a

mark.

- Briefed and argued appeal of descriptiveness refusal of registration of mark that combined a word and design. (United States Court of Appeals, Federal Circuit 2015).
- Our client challenged registration and use of a similar mark at the Trademark Trial and Appeal Board (Opposition) and the Eastern District of Virginia (infringement lawsuit and appeal of TTAB decision). Argued appeal of the District Court's decision to the United States Court of Appeals for the Fourth Circuit. (2014).

TTAB Oppositions and Cancellations

- Lead counsel for one of the world's largest retail department stores in dozens of Oppositions against competing brands, including for apparel goods, retail store services and accessories. Secured multiple favorable Judgments and settlements. (TTAB 2014-present).
- Lead counsel for Swiss watch maker in opposition against an application for a stylized version of client's mark in Classes 14, 16, 25, 35, 36, and 41. After full trial, the Board issued favorable ruling finding client's mark was strong and famous and sustained opposition for all goods and services in Classes 14, 16, 25 and 41 and for partial list of services in Classes 35 and 36. (TTAB 2015).
- Lead counsel in Opposition where following trial and final hearing, successfully opposed registration of the trademark SW:TCH. In its decision, the Board endorsed our arguments that our client's mark is famous and entitled to a broad scope of protection. The Board concluded that the applicant's mark was likely to cause confusion, and sustained the Opposition under Section 2(d) of the Lanham Act. (TTAB 2014).
- Lead counsel in successful Opposition against an application to register the mark iWATCH for watches. In a decision issued after trial and oral argument, the TTAB held that applicant had failed to establish it had a bona fide intent to use the mark in commerce. The TTAB's opinion is one of the limited Precedential Decisions issued by the TTAB that year. (TTAB 2013).
- As lead counsel, successfully litigated through trial and final hearing a Trademark Opposition, and secured a ruling from the Trademark Trial and Appeal Board that Korean competitor's MYCHEW mark is confusingly similar to Japanese client's HI-CHEW mark for candy. (TTAB 2011).
- As lead counsel for an entertainment company, defended a Petition to Cancel brought by national cable television channel. After discovery and trial, favorable settlement was reached. (TTAB 2009).
- As lead counsel, litigated through trial and obtained a ruling from the Trademark Trial and Appeal Board that denied registration to competing mark which was confusingly similar to client's BROAD ARROW trademark for watches. (TTAB 2003).
- Lead Counsel for international television production company in trademark dispute involving rights to the mark BIG BROTHER (highly-successful, long-running reality television show on CBS). Favorable settlement reached. (TTAB 2002).

HONORS & RECOGNITIONS

In June 2014, Jeffrey was honored as the recipient of Westchester County's prestigious Above the Bar Award as the Leading Attorney Under the Age of 40. In 2009, the international legal organization Consulegis awarded Jeffrey in Manchester, England, the Dr. Thomas Marx Award for his paper, "Fifteen Minutes of Fame can Generate Fifteen Decades of Royalties." In 2019 he was honored with the Outstanding Professional Support Award for his *pro bono* work with the charitable organization Careers Support Solutions.