



Jess M. Collen

MEMBER

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"Jess and his team have helped us immensely in the areas of enforcement and international trademark protection. They have handled major litigation for us efficiently and within budget, and are a pleasure to work with."

- Michael Hermann, Director of Licensing, The Andy Warhol Foundation

OVERVIEW

For organizations including professional sports teams, nonprofits, a wide variety of luxury brands, and media clients, Jess Collen provides guidance, counsel, and advocacy on trademarks and brand protection, copyrights, social media, and all aspects of intellectual property protection, enforcement, and monetization. He has litigated hundreds of cases for U.S. and foreign clients in the federal trial courts, courts of appeal, administrative tribunals, and even the U.S. Supreme Court. Few U.S. trademark lawyers have handled as many trademark office registrations and Trademark Trial and Appeal Board (TTAB) cases as Jess. With over 35 years of experience, and client relationships measured in decades, he brings strategic thinking, professionalism, and continuity to the development and management of what are often a company's most valuable asset: its brands.

Jess is also highly involved in the IP professional community in many capacities. He's a member of the Executive Committee and Board of Directors of the International Trademark Association (INTA), as well as a featured Forbes.com contributor. "What's Your Trademark?", his ongoing commentary, focuses on current intellectual property trends. Jess practices out of the firm's New York and Boston offices.

Practices

Advertising and Marketing
Alternative Dispute Resolution
Anti-Counterfeiting Litigation
Brand Protection
Copyright Litigation
Copyright Prosecution
Customs Trademark and Copyright Recordations and Enforcement
Design and Trade Dress Counseling
Domain Names and Website Content
Due Diligence
Ex Parte Trademark Expungement and Reexamination
False Advertising and Unfair Competition Litigation
Industrial Designs, Patents, and Trade Dress Infringement
International Filings

Exceptionally experienced at putting a client's case in the strongest possible light, Jess is skilled at creating optimal conditions for resolution, settlement, and if necessary, success in court. His knowledge and experience brings to these disputes an early and keen sense of where a conflict is headed, and how to leverage that information for a successful outcome.

His extensive experience in anti-counterfeiting has led to important and precedent-setting court rulings for his luxury brand clients. These have included successful seizures of and injunctions against counterfeit goods, and long-running enforcement partnerships with U.S. Customs and law enforcement.

Countless clients have protected their copyrights and have successfully litigated important copyright cases with Jess's help. They have been in diverse industries involving publications, photographs, design features of watch cases, and fabric designs. Jess has also represented clients in numerous utility and design patent disputes.

Over decades of practice, Jess has developed close, trusted working relationships with lawyers and associated law firms all over the world. This enables him to effectively represent clients in every part of the globe. He has devoted considerable time and effort to maintaining and enhancing these ties, frequently traveling, meeting, and speaking outside of the U.S. and overseas. To Jess, it is vitally important to understand the challenges clients face and to communicate with them clearly.

Finally, and perhaps most importantly, Jess brings a boundless loyalty to his clients. As a successful business owner and entrepreneur, he excels at both understanding his clients' corporate needs and knowing how to integrate that knowledge into an effective, long-term strategy.

EXPERIENCE

Levi Strauss & Co. v Yves Saint Laurent tab design litigation, Case No. 3:18-cv-06977, represented defendant Yves Saint Laurent in trademark and trade dress matter.

V-Label v. Wholesome, et al. (19-CV-20826) SDFL, represented plaintiff in trademark matter.

Licensing and Transactions

Opinions, Freedom to Operate, and Patentability Analysis

Portfolio Management

Privacy, Data Protection, and Cybersecurity

Trade Secret Litigation

Trademark Litigation

Trademark Oppositions and Cancellations

Trademark Searching and Watching

Education

J.D., Western New England University School of Law

B.A., Boston College (*magna cum laude*)

Bar Admissions

New York

District of Columbia

Massachusetts

Utah

Court Admissions

U.S. Court of Appeals for the Federal Circuit

U.S. Court of Appeals for the Second 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 District of Massachusetts

Zinus, Inc. v Classic Brands, LLC 2:19-cv-05455 USDC CD-CA Western Division, represented defendant in patent infringement matter.

Car-Freshner Corp. & Julius Sämann Ltd v Balenciaga America, SDNY, represented defendant Balenciaga in trademark and trade dress matter.

Yves Saint Laurent v Steve Madden, represented plaintiff Yves Saint Laurent in design patent and trademark matter.

Fromageries Bel v Emmi Roth USA, 18-cv-7217 USDC-ND ILL, represented plaintiff Fromageries Bel in trademark and trade dress matter.

Scotch & Soda B.V. v Famous Photos/Russell Taylor, 1:17-cv-04561, represented plaintiff Scotch & Soda B.V. in trademark matter.

Sisters of Charity of Leavenworth v Blue Cross & Blue Shield Assoc., represented plaintiff Sisters of Charity of Leavenworth in trademark matter.

PGI Polymer, Inc. v Karmin Group, et al., USDC WDNC, Charlotte Division, Civil Action No. 3:15-cv-00214, represented defendant Karmin Group in trade dress matter.

Mitchell v FJerry, LLC, et al., USDC CD-CA 2:19-cv-04620, represented defendant FJerry, LLC in copyright matter.

Norseland, Inc. v. Fromageries Bel S.A., represented defendant Fromageries Bel in trade dress matter involving claims under the Lanham Act and under federal and state antitrust law.

The Velvet Underground v. The Andy Warhol Foundation for the Visual Arts, represented defendant, The Andy Warhol Foundation, in a lawsuit over the licensing rights to Warhol's famous "banana design."

Northstar Balloons LLC v. Amscan Inc. and Party City Companies, represented the plaintiff, Northstar Balloons, in patent infringement and unfair competition matter.

DSPA.nl.bv v. ARA Safety, Inc., represented the plaintiff DSPA.nl.bv, in a trademark and unfair competition matter, obtaining an award of over \$1.4 million in damages and attorney's fees in favor of our client.

Lakim Industries, Inc. v. Linzer Products Corp., represented the defendant Linzer Products Corp., in a patent matter.

Archie Comic Publications, Inc. v. Penders, represented the plaintiff, a comic book publisher, in a declaratory judgment action against a former independent contractor in a matter of copyright ownership.

BC-USA v. Bel Brands USA, represented the defendant, Bel Brands USA, in a trade dress matter.

Omega SA v. Xie Zhenmin, represented the plaintiff Omega SA, in a leading-edge anti-counterfeiting lawsuit directed against websites selling “replicas” of our client’s brand name watches.

The Swatch Group Management Services Ltd. v. Bloomberg L.P., represented the plaintiff, Swatch, in a copyright matter.

Umami Café, Inc. v. Umami Burger, represented the plaintiff, Umami Café, Inc., in a trademark matter. Costco Wholesale Corp. v. Omega S.A., represented defendant, Omega, in copyright matter. Judged in our favor before the Ninth Circuit, affirmed by an equally divided U.S. Supreme Court.

Audi AG and Volkswagen of Am., Inc. v. Shokan Coachworks, Inc., represented defendant, Shokan Coachworks, Inc., in a trademark matter.

Balenciaga Corporation v. Steve Madden, Ltd., represented plaintiff Balenciaga in copyright, unfair competition, and deceptive trade practices matter.

Edward B. Beharry & Co., Ltd. v. Bedessee Imports Inc., represented the plaintiff, Edward B. Beharry & Co., Ltd., in trademark matter.

Loris Azzaro, B.V. v. Del Laboratories, Inc., represented the plaintiff, Loris Azzaro, B.V., in a trademark and trade dress matter.

Maax Spas (Arizona), Inc. v. Hydromax Industries Inc., represented plaintiff, Maax Spas, in a trademark matter.

The Swatch Group (U.S.) Inc. v. New Tang Dynasty TV (NTDTV), represented the plaintiff, Swatch, in a trademark matter.

Smartpros, LTD. v. Bisk Education, Inc., represented the plaintiff Smartpros, LTD., in a trademark matter.

Exxon Mobil Corporation v. Dexxon Digital Storage Inc., represented the defendant, Dexxon, in a trademark matter.

Fifty-Six Hope Road Music, Ltd. v. Mayah Collections, Inc., represented the defendant, Mayah Collections, Inc., in a trademark and right-of-publicity matter pertaining to Bob Marley.

Honeywell International Inc. v. Trolex Corp., represented the defendant, Trolex, in a trademark and copyright matter.

Biella Collezioni S.R.L. v. Standard Merchandising Co., represented the plaintiff, Biella Collezioni S.R.L., in a trademark matter.

State of Wisconsin v. Fromageries Bel, Inc., represented defendant, Fromageries Bel, against false advertising claims filed by Wisconsin State Attorney General.

United States Tennis Association Inc. v. Robert Bowen, represented the plaintiff, United States Tennis Association Inc. (“USTA”), in a trademark matter.

Carl Karcher Enterprises, Inc. v. Iberostar Hoteles y Apartamentos, S.L., represented the defendant, Iberostar, in a trademark matter before the USPTO Trademark Trial and Appeal Board.

Morinaga & Co. Ltd. v. Crown Confectionary Co. Ltd., represented the plaintiff, Morinaga, in a trademark matter before the USPTO’s Trademark Trial and Appeal Board.

Mapei Corporation v. AWI Licensing Company, represented the plaintiff, Mapei, in a trademark matter.

Yves Saint Laurent Fashion B.V. v. Goldfinger Hawaii, Inc., represented the plaintiff, Yves Saint Laurent, in a trademark matter.

L.F.P., Inc. v. John De Mol Produkties B.V., represented defendant, John De Mol Produkties B.V., in a trademark matter.

HONORS & RECOGNITIONS

New York Super Lawyers (2012-present)