



## Jason D. Rosenberg

Partner

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### *Related Services*

Intellectual Property ■ Trademark & Copyright ■ Intellectual Property Litigation ■ Marketing & Promotions ■ Trademark, Copyright & False Advertising Litigation ■ Advertising ■ Trademark Prosecution & Portfolio Management ■ Retail ■ Food, Beverage & Agribusiness ■ Gray Market & Counterfeit Goods

As co-leader of Alston & Bird's Intellectual Property Litigation Group, Jason's clients call on his experience to help them protect some of the most famous brands in the world, and he has represented them in trademark, false advertising, and domain name matters against infringers and cybersquatters globally. He also has substantial experience representing clients in false advertising and copyright matters in a wide variety of industries.

Jason focuses his practice on trademark, copyright, and advertising enforcement, litigation and counseling, and adversarial matters before the Trademark Trial & Appeal Board of the U.S. Patent and Trademark Office. Named Georgia's 2022 "IP Litigator of the Year" by Managing IP®, Jason also has considerable experience representing both plaintiffs and defendants in high-stakes copyright litigation.

Jason is ranked by *Chambers USA* and was selected by his peers for inclusion in *The Best Lawyers in America*®, and has been repeatedly named to the "World Trademark Review 1000," a list of the top 1,000 trademark professionals worldwide. In 2023, he was awarded the Distinguished Service Medal by the Linn Inn Alliance in recognition of his efforts to bring the American Inns of Court experience to Atlanta's intellectual property community.

### *Representative Experience*

#### **Trademark/False Advertising**

- Defending Buffalo Wild Wings and its parent Inspire Brands in a putative class action in which the plaintiff alleges he was harmed by his purchase of "boneless wings," which are not de-boned wings but rather all white meat chicken; they have been a popular menu item for 20 years. (*Halim v. Buffalo Wild Wings*, N.D. Illinois).
- Defending Dunkin' Brands in trademark infringement litigation concerning its use of the phrase GREAT TASTE PLANT-BASED in connection with a breakfast sandwich. (*Sonate v. Dunkin' Brands et al.*, D. Mass.).
- Numerous ongoing and concluded representations of Nutramax Laboratories in various matters regarding false advertising, trademark infringement, counterfeiting, and licensing disputes relating to health and wellness supplements for humans and animals, including *Nutramax v. Zesty Paws* (M.D. Fla.), *Nutramax v. Lintbells* (M.D. Fla.), and *Nutramax v. Candioli SRL* (D.S.C.).
- Representing Rise Brewing Company in its trademark infringement case against PepsiCo concerning PepsiCo's MTN DEW RISE caffeinated beverage (S.D.N.Y.).
- On behalf of National Geographic, obtained a rare dismissal with prejudice of the plaintiff's trade dress claims after the court granted National Geographic's motion to dismiss. *Marty Stouffer Productions v. National Geographic* (D. Colo.).

- Representing Inspire Brands' portfolio of companies including Dunkin', Baskin-Robbins, Arby's, Buffalo Wild Wings, Jimmy Johns, and Sonic in trademark, copyright, and advertising matters.
- Representing Kids2 in trademark and copyright enforcement, and brand protection matters worldwide.
- On behalf of renowned fragrance house Coty, and world-famous designer Marc Jacobs, won a motion to dismiss claims of trademark infringement. misappropriation, later affirmed on appeal to the Eleventh Circuit. *Mobley v. Coty and Marc Jacobs* (S.D. Ga.) (11th Cir.).
- Defending client CC Wellness, owner of the trademark PLAYON for personal lubricants, in a trademark infringement action brought by a competitor alleging infringement of its TURN ON trademark. *Trigg Laboratories Inc. v. CC Wellness* (C.D. Cal.).
- Defended Zazzle, an industry-leading online retailer of custom-made products, against allegations of trademark infringement and counterfeiting asserted by Atari. *Atari Interactive Inc. v. Zazzle Inc.* (N.D. Cal.).
- Represented plaintiff Mimedx in false advertising litigation against a competitor over claims relating to the parties' wound care products, defeating the defendant's motion to dismiss before resolving the matter. *Mimedx v. Osiris* (S.D.N.Y.).
- Defended client At Battery against trademark claims relating to online reseller agreements. *Noco Company v. At Battery Company Inc.* (N.D. Ohio).
- Defended Trilogy Education Services, a leading provider of skills-based training programs, in a trademark infringement action brought by Trilogy Enterprises. *Trilogy Enterprises v. Trilogy Education Services* (W.D. Tex.).
- Counsel for the plaintiff in a trademark and tortious interference matter against a competitor in the oilfield services industry.
- Counsel for ISC, owner of the famous DAYTONA 500 trademark, in a trademark opposition proceeding concerning the defendant's application to register a DAYTONA1 and checkered flag design trademark for use on fuel additives and related automotive products. Case was settled during discovery. *International Speedway Corp. v. Magellan International* (TTAB).
- Counsel for a declaratory judgment plaintiff in a Lanham Act false advertising matter concerning the marketing of flea and tick medication for pets. *Merial Ltd. v. Elanco* (M.D. Ga.).
- Represented the defendant biotechnology company in a trademark and false advertising case concerning claims made in the marketing and sale of recombinant thrombin, a topical hemostat; the case was resolved. *King Pharmaceuticals Inc., et al. v. ZymoGenetics Inc.* (E.D. Tenn.).
- Counsel for Merial, the makers of Frontline Plus flea & tick medication, in trade dress claims concerning the packaging of the defendants' PETARMOR brand products. *Merial Limited, et al. v. Velcera Inc., et al.* (M.D. Ga.).
- Represented a large health facility in a three-week jury trial of a trademark, copyright, and Digital Millennium Copyright Act case in federal court in Tampa, resulting in permanent injunctive relief, six-figure damages, and recovery of \$550,000 in attorneys' fees on trademark claims. *St. Luke's Cataract & Laser Institute P.A. v. Sanderson, et al.* (M.D. Fla.).
- Represented NASCAR in a trademark infringement action involving a stock car racing magazine. *NASCAR v. Mainstream Media International LLC* (M.D. Fla.).
- Defended Aflac against claims of alleged trademark infringement and motion for preliminary injunction; the case was resolved. *Jellyvision Inc. v. AFLAC* (N.D. Ill.).

- Represented the defendants in trademark litigation; defeated the plaintiff's motion for preliminary injunction and, later, obtained summary judgment in the clients' favor on all counts. *Brown Bark II L.P. v. Dixie Mills LLC, et al.* (N.D. Ga.).
- Obtained judgment for Travelocity in a federal cybersquatting action against an infringing domain name. *Travelocity.com LP v. TravelocityIndia.com* (E.D. Va.).
- Represented the plaintiff in a declaratory judgment action for noninfringement of alleged trade dress rights in the defendant's MP5 submachine gun; the case was resolved. *Crosman Corporation v. Heckler & Koch Inc.* (M.D. Ga.).
- Obtained an injunction against, and significant monetary payment from, the defendant in a trademark infringement case. *Kids II Inc. v. Bright Start Furniture, et al.* (N.D. Ga.).
- Obtained an injunction against the defendants' further use of a disputed trademark. *Kids II Inc. v. KidVid Inc., et al.* (N.D. Ga.).
- Represented a trademark licensee in an action against the unauthorized user of a trademark. *Armstrong McCall L.P. v. CHI Home LLC* (W.D. Tex.).
- Represented the defendants against claims of alleged trade dress infringement of security camera housings. *Videolarm Inc. v. ASC-USA Inc., et al.* (N.D. Ga.).

## Copyright

- In what *Law360* named one of the top 10 copyright cases of the year, represented, pro bono, defendant Public.Resource.org against copyright infringement claims asserted by the State of Georgia. After losing at the district court level, our team obtained a unanimous reversal by the Eleventh Circuit, which held that the state could not own any copyright interest in the Official Code of Georgia Annotated, and therefore our client was free to publish the entirety of the code online. Certiorari was granted by the U.S. Supreme Court. *Code Revision Commission of the State of Georgia v. Public.Resource.Org Inc.* (N.D. Ga.) (11th Cir.).
- On behalf of National Geographic, obtained a Rule 12(b)(6) dismissal of the plaintiff's copyright claims at the pleadings stage. *Marty Stouffer Productions v. National Geographic* (D. Colo.).
- Defended client Narrative Content Group against claims of copyright infringement asserted by a photographer. *Martinka v. Narrative Content Group LLC* (N.D. Ga.).
- Representing multinational insurer Hiscox in a copyright infringement matter concerning the parties' foodborne illness policies. *Professional Liability Insurance Services Inc. v. Hiscox* (W.D. Tex.).
- Represented Herald House, a publisher, in a copyright infringement matter brought by one of its former authors. The matter was settled after a mediation. *The Cenaps Corporation v. Herald House* (M.D. Fla.).
- On behalf of Marvel Entertainment, obtained a dismissal with prejudice of claims of copyright infringement concerning myriad well-known characters in the Marvel Cinematic Universe. *Bennett v. Marvel Entertainment* (N.D. Ga.).
- Represented the plaintiff in a copyright infringement and trade secret misappropriation matter against former employees. *The John Hardy Group Inc. v. Galunas, et al.* (N.D. Ga.).
- Represented the defendant in a copyright infringement matter alleging unauthorized use of sound recordings in the VH1 program Master of the Mix. The case was resolved before discovery. *UMG Recordings Inc. v. Je T'aime LLC* (C.D. Cal.).
- Lead counsel for the defendant in a suit alleging copyright infringement and breach of contract relating to the use of Microsoft software. *Microsoft Corp. v. EBIX Inc.* (N.D. Ga.).

- Helped secure a major victory for client Twentieth Century Fox by obtaining a summary judgment order that Fox owned the right to distribute the *Watchmen* motion picture. The case settled on favorable terms shortly before a hearing to determine whether the release of Warner Bros.'s film would be enjoined. *Twentieth Century Fox Film Corp. v. Warner Bros. Entertainment Inc., et al.* (C.D. Cal.).
- Lead counsel for Viacom and production company defendants in a copyright infringement lawsuit alleging unauthorized use of the plaintiffs' song on the popular VH1 program *Love & Hip Hop: Atlanta*. The case was resolved following the defendants' submission of summary judgment briefing. *Hinkle, et al. v. Viacom International Inc., et al.* (N.D. Ga.).
- Obtained an emergency temporary restraining order preventing the defendants from further misappropriation of the client's trade secrets and copyrighted materials. *C5 Advisors LLC v. Debartolo Development LLC* (N.D. Ga.).
- Obtained an injunction on behalf of a copyright owner preventing further unauthorized use or copying of the client's automotive repair software. *ALLDATA LLC v. Mesuwan* (S.D. Tex.).

## **Publications & Presentations**

### **Publications**

- "The First Amendment Wins Again: Supreme Court Holds 'Immoral' and 'Scandalous' Trademarks Are Registrable," *Cyberspace Lawyer*, Vol. 24, No. 7, August 2019.
- "Supreme Court Holds That Juries Decide Issues of Trademark Tacking," *Intellectual Property & Technology Law Journal*, Vol. 27, No. 4, April 2015.

### **Education**

- Northwestern University (J.D., 2001)
- Emory University (B.A., 1997)

### **Admitted to Practice**

- Georgia
- Virginia
- Illinois