

Jeffrey C. Katz

Partner

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Areas of Focus

Intellectual Property + Media | Trademark and Brand Management | Advertising + Marketing | Advertising Review, Production and Media

"I focus on getting the best results for clients quickly, efficiently and without great cost. Litigating should be a last resort, not a standard approach, in managing trademarks. Persistence, sometimes threats, and other times a carrot along with a stick can be highly successful strategies."

Overview

Jeff Katz, a partner in the Intellectual Property + Media and the Advertising + Marketing Practice Groups, helps his clients build, protect and enforce trademarks and optimize the value of brands worldwide. He represents some of the world's largest companies and most iconic brands, including clients in the music and entertainment, education, food and restaurant, transportation, and advertising and marketing communication industries.

Jeff counsels individuals and businesses on the full range of trademark issues, from name selection, registration, and use in traditional and digital advertising and marketing communications through global protection and enforcement. Clients also rely on him to handle domain name protection and enforcement proceedings, and day-to-day trademark, copyright and licensing issues that can enormously impact their business operations.

Regarded as responsive, erudite and pragmatic, Jeff knows his clients' businesses and personalities. He develops practical solutions based on each client's needs, risk profile and how trademark matters may play out and interface with corporate goals, franchising, or other marketing and business considerations. Recognizing that relatively small matters can be disruptive to a company if not managed promptly, Jeff resolves issues quickly, streamlines processes, minimizes costs, mitigates risks, and helps clients avoid costly litigation, whenever possible.

Whether advising on international portfolios, protecting Ivy League marks or TV, radio and new media interests, Jeff avoids contention, always striving for effective working relationships with opposing counsel to achieve the best outcome for his clients.

Representative Experience

- Protected trademarks of a worldwide provider of transportation and logistics services and won over \$6 million in statutory damages and attorneys' fees in litigation concerning defendants' willful infringement. Overcame resistance from the magistrate judge and prevailed on summary judgment, giving our client relief sooner. Also obtained injunctive relief to end defendants' infringement and for our client to use in deterring other infringers.
- Represented the Estate of a late rock icon and the company that owns the intellectual property rights globally involving the rock icon, in a matter concerning the unauthorized use of personas and trademarks in connection with a line of sneakers. Rights to these elements/branding elements are valuable assets of the Estate, which regularly licenses them in connection with clothing, including sneakers. Resolved this matter on confidential terms with a favorable outcome for our clients, without the matter escalating into major litigation.
- Counseling a national pizza chain on brand protection strategies in connection with its sports arena. Prosecuting applications for the name and logo in the USPTO in multiple merchandise and service categories and are involved with the necessary license agreements.
- Representing a top university in trademark matters, handling clearance, prosecution, maintenance and enforcement in the use and registration of the university's name in the U.S. and across the globe. For cross border issues, we retain and coordinate with local trademark counsel in each jurisdiction to take the necessary action locally.
- Working with a leading restaurant chain to protect its key brands internationally, including several that are considered descriptive and often difficult to protect, and trying to accomplish this without litigation except as a last resort.
- Protected the trademark and copyright rights of a rock and roll band client whose silhouette and lyrics were used to market a beer without their consent. Sent a cease and desist letter and, within a matter of days, the brewery agreed to stop any further production of the beer, as well as any use of trademarks, personas or song lyrics.
- Defended a Trademark Trial and Appeal Board opposition proceeding related to an application for a major international media agency network that just rebranded and adopted a new name.

Insights + Events

Alert

The Impact of COVID-19 on U.S. Trademark Applications and Registrations

April 2, 2020

Alert

Brexit's Impact on European Union Trademarks

February 25, 2020

Press Mention

Crain's Detroit Business | Ilitches Seek Trademark Protections for Potential Tigers-Red Wings Sports Networks

October 29, 2018

Credentials

Education

New York University School of Law (J.D., 1979)

University of Rochester (B.A., 1976)

Distinctions

- *Chambers USA: America's Leading Lawyers for Business*® "Leading Lawyer" 2013-2023, New York Intellectual Property: Trademark, Copyright & Trade Secrets

Bar Admissions

New York

Court Admissions

U.S. District Court Southern District of New York

U.S. District Court Eastern District of New York

U.S. Court of Appeals Second Circuit

U.S. Court of Appeals Eleventh Circuit

Associations

Member, New York City Bar Association

Member, New York State Bar Association

Member, International Trademark Association