

Brand Protection Counseling and Litigation

The attorneys of the Theodora Oringher Brand Protection Counseling and Litigation Practice Group have prosecuted more than 30 federal lawsuits against the importers of counterfeit consumer products over the past several years.

Through decades of hard work — at a cost of billions of dollars — owners of famous U.S. brands have built enormous goodwill in their trademarks. To counterfeiters, however, this hard work presents an opportunity to get rich at the expense of others. By flooding the marketplace with cheaply-made look-alikes, counterfeiters steal profits and cause companies to lose customers, risk serious damage to their brands, and become exposed to costly lawsuits filed by consumers injured by inferior counterfeit goods.

Counterfeiters succeed only because brand owners allow them to — often because they are simply not aware of the extent to which they are being ripped off. Many brand owners have recorded their trademarks with the United States Bureau of Customs and Border Protection. This helps Customs to recognize and seize knock-offs at the border. But this is just a first step.

Because Customs cannot hope to detect and seize every shipment of counterfeit goods, trademark owners must take the initiative to protect their valuable brands. To determine the best course of action, brand owners first need to obtain accurate information about the scope of their problem and then conduct cost/benefit analysis of the various potential responses. Companies should not base their decisions on the misleadingly small quantity of counterfeit goods seized by Customs or other law enforcement agencies.

Rather, brand owners must consider the value of the much larger volume of counterfeit goods that make it past Customs inspectors and into the marketplace. These are the goods that displace sales of genuine merchandise and thus provide the basis for a valid analysis. Of course, counterfeiting organizations do not make their sales records public. Affected brand owners must therefore develop this information on their own. But how?

Our attorneys have mastered the techniques of "auditing" the entities named as importers of record on Customs' Notices of Seizure and identifying all other shipments those entities have imported into the United States that escaped detection and seizure. Armed with this knowledge, our attorneys can help companies design and implement cost-effective brand protection strategies. In many cases, our attorneys have been able to exploit this information to forecast incoming shipments of counterfeit goods in time for them to be seized by Customs before they have had a chance to enter the marketplace.

Over the past several years, our litigation efforts have resulted in the following leading precedents in the area of counterfeit enforcement:

- Obtained maximum statutory damages under the Lanham Act for shipments seized even before the counterfeit product was distributed in the U.S
- Proved defendants' willful counterfeit trafficking in contested summary judgment proceedings
- Established unlawful importation alone as sufficient to justify permanent injunction and maximum statutory damages

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- Established presumptions of willfulness in cases involving large scale counterfeit importation
- Obtained maximum statutory damages for knowing infringement by demonstrating defendants' "willful blindness" on summary judgment
- Established standards for multi-million dollar awards of statutory damages in counterfeit importation cases
- Established that civil judgments for intentional trafficking in counterfeit goods are not dischargeable in Chapter 7 bankruptcy

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