Stephen Feingold

Retired Partner

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Services

Anti-Counterfeiting & Gray Markets

Brand Licensing & Related Transactions

Clearance & Portfolio Management

Copyright Litigation & Counseling

Cybersecurity, Privacy & Data Governance

Intellectual Property

Online & Digital Enforcement

Trademark Litigation

Trademark, Copyright & Advertising

Industries

Automotive

Consumer Goods

Food, Restaurant & Beverage

Home Furnishings

Retail & Consumer Goods

Stephen Feingold focuses his practice on trademark, copyright, advertising and Internet law. Trained as a litigator, Mr. Feingold currently divides his time between litigation and transactional projects advising clients with their most complicated trademark, copyright and Internet issues.

On the litigation front, Mr. Feingold has extensive knowledge in the area of trademark fair use and argued before the Third Circuit Court of Appeals in the case leading to that Circuit's first definitive ruling on the standards for establishing the fair use defense. He has also successfully obtained injunctive relief against John Doe defendants perpetuating consumer fraud and trademark on the Internet.

Mr. Feingold's transactional practice is similarly involved with many emerging issues. He is currently advising several clients with respect to the implementation of social networks and the integration of other new media into their business plans. He has also handled complicated licensing agreements with respect to online gaming, merchandising and the implementation of dealer networks to combat the unauthorized sale of gray market goods. In connection with his Internet practice, Mr. Feingold has also advised many clients with respect to privacy related issues and has counseled clients with respect to data breach and notification issues.

Mr. Feingold also leads several teams of lawyers handling the worldwide portfolios of several global companies and in connection with that work has advised clients on international enforcement and registration issues. A hallmark of his approach to portfolio maintenance is to assist clients to reduce costs by restructuring their portfolios so that there is a symmetry between the amount of legal spend for each brand that relates to how

much that brand contributes to the clients' bottom line. One client was able to reduce its trademark budget by more than 50 percent after transferring its portfolio from another firm.

While his practice is not limited to any one industry, he has significant experience with the hospitality, gaming, real estate and educational publishing industries. He also has represented several major entertainment brands and in the past has done extensive work for both financial and pharmaceutical companies. Reflecting his commitment to the public interest, he has provided pro bono services to several not-for-profit companies including the American Conference for Diversity and Moving Traditions.

In 2011, Kilpatrick was awarded the prestigious *IP Magazine Domain Name/Online Strategy of the Year Award* for its innovative patent-pending domain name evaluation tool – the *Namealizer™.* The *Namealizer™* is the brainchild of Mr. Feingold, who oversaw the creation of a Web application that provides an easy and quick way to determine if a particular domain name is causing actual injury to a brand or is merely an annoyance. It also provides a record of the client's enforcement efforts, thereby avoiding arguments against selective enforcement. In 2011, Mr. Feingold also co-edited and co-authored two chapters on trademark law and the Internet in the recently released "Intellectual Property Law in Cyberspace" published by BNA.

Mr. Feingold is active in many bar associations and has chaired various committees for the IP Section of the ABA, the New York Intellectual Property Law Association, and INTA. In 2002, he was awarded INTA's Volunteer of the Year Award. He is also a Fellow of the American Bar Foundation. Mr. Feingold was a recipient of the Vanderbilt Prize upon graduation and was recognized as a New York "Super Lawyer" in the area of Intellectual Property by *Super Lawyers* magazine in 2024 and each of the 15 years immediately preceding. Mr. Feingold was listed in the 2018 and the three immediately preceding editions of *World Trademark Review 1000 – The World's Leading Trademark Professionals*. In 2014 and 2015, he was listed in *Who's Who Legal: Trademarks*. In 2010, 2011 and 2015, Mr. Feingold was recommended in the area of Non-Contentious Trademark Law by *Legal 500 US*. He is AV® rated by Martindale-Hubbell.*

*CV, BV, and AV are registered certification marks of Reed Elsevier Properties Inc., used in accordance with the Martindale-Hubbell certification procedure's standards and policies.

Experience

Represented Pearson Education Inc., the world's largest educational publisher, in obtaining an injunction to prevent the use of mymathlabhelp.com, as a site offering to use a student's user name and password to complete homework assignments on Pearson Education Inc.'s popular mymathlab.com website. In addition to claims under the Lanham Act, the complaint was also based on violations of the Computer Fraud and Abuse Act as well as state claims. The defendants agreed to stop providing this service and to transfer the domain name to our client.

Represented Park Place Entertainment in 2000 when it announced its intent to build a multimillion dollar new entertainment venue on its landmark Caesars Palace property which it announced would be known as The Colosseum. While the convention center at Caesars Palace had always been known as the Colosseum, Park Place did not own any federal registration for that mark. Shortly after the announcement a trademark squatter filed an intent-to-use application for Colosseum for various services related to the operation of an entertainment venue. When Park Place announced that the Colosseum at Caesars Palace would open in February 2003, the intent-to-use application had already been published and a notice of allowance had issued. The trademark squatter then contacted Park Place threatening to sue for violation of his rights. We met with this person and explained that Park Place's rights in Colosseum went back to the very beginning of the Hotel but it quickly became clear that the individual was not interested in settling but in waiting until the opening was about to occur

and then seek to file court papers knowing the damage that such publicity would do, even if his claim lacked any merit. Park Place filed a declaratory judgment action and moved for an expedited trial so that a decision could be rendered more than 90 days before the opening. After a full bench trial, the court granted Park Place all the relief it sought, including cancellation of the trademark squatter's application and monetary damages. When the monetary damages were not paid, we successfully argued for the issuance of a bench warrant. On appeal the Ninth Circuit affirmed.

Represented the owner of the rights to the famous Dick and Jane reading primer, a Pearson Education subsidiary, in trademark and copyright litigation against the authors of *Yiddish With Dick and Jane*. When efforts to settle the case prior to filing a complaint were not successful, we filed a complaint against the New York based publisher in California where the individual authors and illustrators resided. In response to the defendants request to transfer the case to New York, we agreed provided the parties entered into non-binding mediation. This creative approach ended successfully.

Represented Chippendales in trademark infringement suit against manufacturer and distributor of Chickendales slot machine. Resulted in a successful settlement of the case, including a monetary recovery.

Represented declaratory judgment plaintiff, Pearson Education, accused of trademark infringement and dilution. Successfully defended against efforts by defendants to litigate matter in New York as opposed to Maryland, including favorable ruling on appeal to the Fourth Circuit. Supervised drafting of papers to successfully prevent production of plaintiff's search report and opinion letter.

Represented Banque Audi, one of the largest consumer banks in Lebanon that also does business in the U.S. and whose name is identical to a major car manufacturer. Shortly after the passage of the U.S Federal Trademark Dilution Act, the car manufacturer sued the bank for both trademark infringement and dilution. We developed a defense that revolved around showing that since the majority of the Banks' customers in the U.S. were natives of the Middle East, their use of the Banks' name did not dilute the strength of the manufacturer's mark because this population based on its middle eastern roots would distinguish between the bank and the car company. A survey commissioned by our team substantiated these findings. On the eve of trial the court granted the car manufacture summary judgment on its dilution claim but *sue sponte* reversed his decision during trial when he heard the testimony of the bank's survey's expert. The case settled on an amicable basis after trial.

Represented the owner of a landmark Art Deco skyscraper in New York City in connection with multiple licenses for use of the image of this property in commercials, movies, plays, catalogues and photo shoots.

Negotiated co-existing licensing agreement between one of the largest U.S. commercial banks and an U.K. investment group with respect to worldwide rights in and to an identical mark used by each party as its corporate name.

Negotiated international apparel company’s exclusivity multimillion primary sponsorship of a major racing series event including resolution of complex issues where the apparel company and racing association might have different perspectives on what type of secondary sponsorships are appropriate in light of cultural differences in racing and apparel industries.

Represented large metropolitan health care provider that included four suburban hospitals in complex negotiations with acclaimed medical school over creation of enlarged health system network combining resources of both. The deal involved complex mechanisms for deciding issues when the two original parties did not agree. Towards the end of the negotiations the medical school suggested that the new network use its name as the name of the new network and offered a royalty free license. As trademark counsel for the health care provider we recognized, however, that this trademark license which would include “standard quality control” provisions would allow the medical school to circumvent the highly negotiated terms for resolving issues when the two parties did not agree and were able to obtain appropriate assurances that blocked the medical school from using the trademark license to essentially negate the highly negotiated deadlock provisions.

Served as special counsel to a *Fortune* 100 financial services company with respect to it's change of name arising out of a merger and supervised the introduction of seven expert survey reports in a expedited trial in the district of New Jersey leading to published decision finding no infringement.

Successfully obtained summary judgment for provider of video services to horse racing association stating that its retention of union work force and non-union supervisors previously employed by plaintiff did not constitute theft of trade secrets or breach of covenant not to compete.

Successfully represented a large financial company in trademark litigation against a defendant for using our client’s trademark as part of a fraudulent money laundering scheme.

Represented a large apparel company in favorable settlement of claim that it was not infringing a trademark troll's registered mark by using it as a "style" name for various items of clothing.

Education

New York University School of Law J.D. (1985)

University of California at Los Angeles B.A. (1979) *magna cum laude*

Admissions

New York (1986)

New Jersey (1989)

District of Columbia (1988)

Court Admissions

U.S. Court of Appeals for the Federal Circuit (2001)

U.S. Court of Appeals for the Fourth Circuit (2001)

U.S. Court of Appeals for the Ninth Circuit (2001)

U.S. Court of Appeals for the Third Circuit (1987)

U.S. Supreme Court (2003)

Professional & Community Activities

American Bar Association, Fellow, Member of the Intellectual Property Section and Former Chair of the Trademark Subcommittee

American Management Association, Sales and Marketing Executive Council

Fordham University Law School, Adjunct Professor of Trademark Law (since 2002)

The Intellectual Property Strategist, Editorial Board Member

International Trademark Association, Member and Past Meetings Board Member

Internet Law & Strategy, Editorial Board Member

New York Intellectual Property Law Association, Member, Trademark Committee, Former Chair

The Privacy and Data Protection Legal Reporter, Editorial Board Member

Insights

News Releases

Eighteen Kilpatrick Townsend Attorneys Recognized as 2020 New York Super Lawyers and Rising Stars

October 1, 2020

News Releases

Record Number of Kilpatrick Townsend Attorneys Named 2019 New York Metro Super Lawyers

November 1, 2019

Perspectives

Kilpatrick Townsend's New York Office is Pro Bono

September 17, 2019

News Releases

Twenty Kilpatrick Townsend Attorneys Named 2018 New York Super Lawyers

September 28, 2018

News Releases

Kilpatrick Townsend’s Trademark Practice Receives Gold Level Recognition in the 2018 World Trademark Review 1000

January 25, 2018