

Rose Auslander

Retired Counsel

Partner 2015



contact

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Clients tell me that I'm unusually creative and imaginative, and that they come to me as their go-to attorney to help them explore options and find unique ways to achieve their goals. They appreciate that I take a collegial approach whenever possible, and am generally very pleasant and easy to work with, but am also unfailingly determined and assertive when it comes to defending and advancing my clients' interests. Many of my clients have been with me for a long time and keep coming back year after year, which I take as the highest compliment.

Drawing on her unique background in the arts and performance sports, Rose Auslander represents clients in intellectual property issues such as trademark, domain name, certification mark, and copyright clearance and protection—plus trademark and trade dress infringement; unfair competition, domain name, and dilution litigation; copyright litigation; and UDRP domain name arbitration.

Rose works with clients in a variety of industries, such as fine art, fashion, entertainment, financial and internet-related services, standards accreditation, and consumer-products. She has also helped clients protect character properties such as the HULK, the Muppets, and The Supreme Chicken, and special insignia such as Usain Bolt's Lightning Bolt trademark.

On the trademark side of her practice, Rose works with organizations to develop strategies for the development and protection of their brand portfolios, assisting

with the clearance and adoption of new brands; negotiations to obtain domain names; the filing and prosecution of trademark, certification mark, and copyright applications; and the negotiation and drafting of trademark and copyright licenses and assignments, and trademark co-existence agreements. Rose also vigorously polices clients' trademarks and copyrights, handling cease-and-desist letters, and disputes adjudicated in the courts and in the U.S. Patent and Trademark Office.

Rose also comes to the aid of companies that need help achieving swift take-down of infringing apps, Facebook pages, and Twitter feeds.

Serving clients located in countries around the world, Rose helps international entities protect their IP rights within the United States. Many overseas companies entering the US are unfamiliar with our crowded market and the complex, stringent requirements of the governing IP bodies here. Rose skillfully guides them in navigating these potentially treacherous waters. In addition, Rose handles issues brought by firm clients The American National Standards Institute (ANSI) and the International Organization for Standardization (ISO), which work to safeguard US and worldwide quality and accreditation standards.

Rose's clients benefit from her sharp writing and legal analysis skills, which she honed years ago as Articles Editor on New York University's Law Review. Early in her career she received rigorous training in intellectual property litigation while working at noted New York law firms Cravath, Swaine & Moore LLP and Fross Zelnick Lehrman & Zissu, P.C.

Experience

- Upon the instructions of the lead Jamaican attorneys for Usain Bolt, the six-time Olympic Gold Medalist known as the "world's fastest human," successfully stopped the infringement of the BOLT name and Lightning Bolt logo, shutting down an infringing electronic game, app, Facebook page, and Twitter feed, and obtaining payment of damages.
- Represented Citadel Capital SAE of Egypt, successfully mediating settlement of international trademark dispute with Citadel LLC of Chicago, Illinois.
- Assisted RJ Softwares of Kolkata, India in negotiating a settlement of the U.S. federal litigation brought by toy manufacturer Hasbro Inc. of Pawtucket, Rhode Island, USA against our clients' SCRABULOUS Internet social networking game, which, in its heyday (according to *Digital Media*), "boasted an astonishing half-million daily users on Facebook." As *The New York Times* reported: "Thanks to this agreement, neither Hasbro nor Scrabulous' developers, RJ Software, have to face a long and expensive legal battle, and RJ Software can still offer Wordscraper and Lexulous."
- Represented Marvel Characters, Inc. in achieving amicable resolution of a lawsuit with Terry Bollea over use of the marks HULK HOGAN, HULKAMANIA, HULKSTER. HOLLYWOOD HOGAN and HOLLYWOOD HULK HOGAN.
- Assisted the world's premier music video game developer Harmonix Music Systems as an independent legal consultant in the development of Dance Central II, and assisted MTV in the development of Dance Central I.
- For client Woolmark Americas, Inc., successfully stopped Garment Group Inc. from infringement of the famous WOOLMARK certification mark.
- Represented the plaintiff in TT Sounds Good AB v. Tommy Lee, MCA Records, Inc., and Universal Music & Video Distribution, Inc., a "reverse" trademark infringement and dilution case in the United States District Court for the Southern District of New York concerning the mark METHODS OF MAYHEM, which was amicably resolved.
- Represented Cosmos European Travels AG in its successful arbitration for the domain name cosmos.com and won summary judgment in the District Court appeal of that decision.
- Obtained an order for Honeywell International Inc. enforcing a trademark settlement in litigation against Notiplex Securite Incendie, Inc., in the United States District Court for the District of Connecticut.

- For the JRR Tolkien Estate, stopped distribution of storybooks that infringed the Lord of the Rings books, and had the infringing books destroyed.
- Successfully defended Sixty, Inc. and Seize S.A. in the United States District Court for the Southern District of New York, from claims that their watch design infringed and diluted TechnoMarine's TechnoDiamond watch.
- Successfully represented Stephen Webster in an appeal in the United States Copyright Office, obtaining copyright registration for its signature CRYSTAL HAZE jewelry line.
- Obtained registration of the color "bright green" for super-human action figures on behalf of client Marvel Characters, Inc.
- Negotiated a comprehensive co-existence agreement between a major records label and Experience Music Project – a museum designed by architect Frank Gehry and backed by Microsoft co-founder Paul Allen – achieving agreement in principle in time for the museum's nationally publicized June 2000 opening.
- In Lane Capital Management, Inc. (1999), successfully represented the plaintiff in its motion for summary judgment in the United States District Court for the Southern District of New York, and successfully argued the Second Circuit appeal. Central to the Lane case was the test for determining when a mark is "primarily merely a surname" – an issue of first impression in the Second Circuit.
- Represented the Carvel Corporation in its victory at trial before the Trademark Trial and Appeal Board of the United States Patent and Trademark Office in 1999, prevailing against a former licensee's attempt to register the mark The Ice Cream Bakery.
- Was a member of the team that successfully defended Jim Henson Productions against Hormel Food Corporation's well-publicized claims that SPA'AM, a wild boar Muppet in the movie Muppet Treasure Island, tarnished Hormel's mark SPAM. The team was victorious in the United States District Court for the Southern District of New York (1995) and the Second Circuit (1996) on cutting edge issues of dilution and First Amendment law.

Presentations

International Trademark Association 2011 Annual Meeting: Panelist, "Trademark Legal Research Using INTA Online Resources," May 16, 2011
2011 Mid-Winter Institute of the American Intellectual Property Law Association (AIPLA), Moderator on Copyright and Trademark Issues, February 2011
International Trademark Association 2007 Annual Meeting: "Keywords, Metatags, and Other Trademark Issues on the Web," May 2, 2007
PLI: Panelist, "Analysis of a Content License Agreement," March 25, 2010, March 26, 2009, March 28, 2008, March 30, 2007, March 7, 2006 and March 8, 2005
Center for International Legal Studies:

- "Internet Wars: Copyright versus Access," April 27, 2007
- "Is There Life After Grokster?," October 22, 2005

International Bar Association (IBA):

- Panelist, "Digital Rights Management -- Wishful Thinking or an (Upcoming) Revolution?," September 29, 2005
- Panelist, "Global Anti-counterfeiting Campaigns," October 27, 2004

U.S. Copyright Society:

- Panelist, "Law and Creativity," Mid-Winter Meeting, February 2011
- Moderator, "The 10th Anniversary of the DMCA, Part 1: Do We Digg DRM?," March 26, 2008
- Moderator, "Google Book Search: Mere Online Card Catalog, or Book Napster?," April 11, 2006
- Moderator, "Technology To the Rescue? Whether DRM and Free Markets Can Tame Illicit File Sharing, Without Compulsory Licensing or Other Legislative Intervention," December 16, 2004
- Moderator, "Are You Covered? Insurance Against IP Claims," March 22, 2002
- Introduction, "Latest Developments in International Copyright Law," December 8, 2002

United Business Media: "Smart Information Management," December 3, 2002 *Surtex*: Javits Center, "Protecting Your Art & Design," May 20, 2002 *The Woman's Connection*: Cable TV, "Domain Name Issues," Fall 2000, March 25, 2010, March 26, 2009

Outside the Office

I am passionate about my creative pursuits. I'm a published poet and a competitive figure skater—after years of early-morning ice dancing and freestyle skating, I'm a triple US Figure Skating Association Gold Medalist. I also love gourmet cooking.

Admissions

Bar Admissions

New York

Court Admissions

U.S. Court of Appeals, Second Circuit

U.S. Court of Appeals, Sixth Circuit

U.S. District Court for the Eastern District of New York

U.S. District Court for the Southern District of New York

Education

New York University School of Law (JD, *magna cum laude*, 1992)

- Articles Editor - *New York University Law Review*
- Order of the Coif
- Morton Geller Award
- American Jurisprudence Prize for Civil Procedure

The City University of New York, Queens College (BA in Political Science, *magna cum laude*, 1989)

Awards/Honors

The Best Lawyers in America®, 2017-2023

The Best Lawyers in America® – Lawyer of the Year – Trademark, 2021

World Trademark Review 1000, 2012-2020

Super Lawyers®, 2010-2018, 2021

Top 250 Women in IP, 2013

Alumni of the Month (ALMO), New York University School of Law, October 2003