



Georges Nahitchevansky

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Services

Trademark; Copyright; Internet; Green Economy; Anti-counterfeiting & Gray Market

Georges Nahitchevansky concentrates his practice in litigation and counseling on trademark, copyright and Internet matters across a broad spectrum of industries both in the U.S. and internationally. His experience ranges from handling U.S. and worldwide enforcement of trademarks and copyrights, including complex cross border disputes and multi-jurisdictional priority disputes, to counseling on registration programs and the negotiating, advising and drafting of licensing, acquisition and Internet related agreements.

Mr. Nahitchevansky has successfully litigated as lead counsel, both on behalf of plaintiffs and defendants, a wide array of trademark and copyright disputes. His experience includes the successful representation of numerous celebrities and *Fortune* 500 companies in hundreds of Internet related disputes, including website content, domain name and advertising disputes. Mr. Nahitchevansky has also handled numerous "grey market" goods cases that have resulted in awards of injunctive relief and monetary damages. He has extensive international and U.S. trademark and copyright portfolio counseling, licensing and management experience.

Prior to joining the firm, Mr. Nahitchevansky practiced with Fross, Zelnick, Lehrman & Zissu, P.C. In addition, Mr. Nahitchevansky is fluent in French and has shot, directed and produced a number of films and videos that have been distributed and released throughout the world.

Mr. Nahitchevansky is listed in the 2012 and 2013 editions of *World Trademark Review 1000 — The World's Leading Trademark Professionals*. In 2012, he was recommended by *Legal 500 US* in the areas of Copyright and Non-Contentious Trademark Law and was again recommended for Non-Contentious Trademark Law in 2013. Mr. Nahitchevansky was recognized as a New York "Super Lawyer" in 2011, 2012 and 2013 by *Super Lawyers* magazine. He was named a 2013 "IP Star" by *Managing Intellectual Property* magazine. Mr. Nahitchevansky was named by Legal Media to its 2012 *Guide to the World's Leading Trademark Law Practitioners*. He is AV[®] rated by Martindale-Hubbell.*

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Experience Highlights

Hollywood Stock Exchange, Ltd. v. Pavel Ektov, et al. *

Successfully represented Hollywood Stock Exchange, which owns and operates the popular HSX.COM simulated entertainment securities trading game on the Internet, in obtaining a permanent injunction and damages against the operator of a competing trading game under the mark and name Hollywood Virtual Stock Exchange.

Hollywood Stock Exchange, Ltd. v. Pavel Ektov, et al., 02 CV 9267, U.S. District Court, S.D. New York (2003).

Formula One Licensing B.V. v. Purple Interactive Ltd. *

Represented plaintiff in obtaining, through mediation, the return of more than 400 domain names based on the marks FORMULA 1 and F1 used in connection with an unauthorized commercial website dedicated to FORMULA 1 racing.

Formula One Licensing, B.V. v. Purple Interactive Limited, Formula1.com Limited, et al., No. 3-2222 (N.D. Cal. filed June 21, 2000).

International Liturgy Publications d/b/a Vince Ambrosetti Ministries and Vince Ambrosetti v. Silver Burdett Ginn and Pearson Education, Inc. *

Successfully opposed a preliminary injunction for alleged infringement of plaintiffs' claimed BLEST ARE WE mark based on the use of the mark BLEST ARE WE by publishers SBG and Pearson Education for a religious education series. Ultimately we obtained a court order enjoining the plaintiffs from using the mark and name BLEST ARE WE.

International Liturgy Publications d/b/a Vince Ambrosetti Ministries and Vince Ambrosetti v. Silver Burdett Ginn and Pearson Education, Inc. 03 CV 3557, U.S. District Court, New Jersey (2003).

Lynch, Jones & Ryan, Inc. v. Standard & Poor's *

Represented Lynch securities broker, in "hot news" misappropriation case involving market research, resulting in a reported decision strongly reaffirming vitality of "hot news" claims under New York law.

Lynch, Jones & Ryan, Inc. v. Standard & Poor's, 47 U.S.P.Q. 2d 1759 (N.Y. Sup. Ct. 1998).

Market Corner Realty Assocs. v. CGM-GH LLC

Defeated preliminary injunction motion brought by competitor seeking to prevent well-known restaurateur Jeffrey Chodorow and his company from opening a Japanese restaurant named ONO in the newly opened Hotel Gansevoort in New York City's Meatpacking District.

Market Corner Realty Asso. v. CGM-GH, LLC, 71 U.S.P.Q.2d 1061 (S.D.N.Y. May 13, 2004).

Trademark counsel for a global music label

Serves as counsel to one of the largest music labels in the industry on trademark enforcement, prosecution and Internet issues.

NBTY, Inc. v. USA Nutritionals, Inc. and Action Labs, Inc. *

Successfully represented defendants, USA Nutritionals Inc., sued for alleged trademark infringement of the mark U.S. NUTRITION based on their use of the mark USA NUTRITIONALS for vitamin and nutritional supplements.

NBTY, Inc. v. USA Nutritionals, Inc. and Action Labs, Inc., 02 Civ. 1685, U.S. District Court, E.D. New York (2002).

Trademark and dilution action for Bank of America Corporation

Successfully represented Bank of America in a trademark and dilution action involving the use of the name Banc America Auto Sales for a reseller of cars on the Internet and in a brick and mortar business in Florida.

Copyright protection for Edgar Rice Burroughs Inc. *

Successfully represented Edgar Rice Burroughs Inc. in reaffirming its copyright rights under the Berne Convention in the TARZAN character and obtaining a permanent injunction in a copyright infringement action against a Dutch-language video cartoon under the name "Tarzan van de Apen ("Tarzan of the Apes").

Edgar Rice Burroughs, Inc. v. Beukenoord Springboard-Video B.V., et al, No. 492100 KG Court of Appeals, Amsterdam (2000) (reprinted at 2001 E.C.D.R. 15).

USA Nutritionals, Inc. v. Innovative Labs LLC, et al. *

Successfully represented USA Nutritionals, a vitamin and supplement manufacturer, in obtaining damages in an action against a former manufacturer using identical marks and labels on competing products and obtaining the dismissal of a parallel breach of contract action in state court initiated by the manufacturer against USA Nutritionals.

USA Nutritionals, Inc. v. Innovative Labs LLC, et al., 02 Civ. 8345, U.S. District Court, E.D. New York (2002).

Trademark and copyright counseling for a global financial services firm *

Provides trademark, copyright and Internet counseling, litigation and other enforcement representation management for a global financial firm.

PayFlex Systems USA Inc. v. Sensei Inc. et al.

Represented PayFlex Systems USA, Inc. in trademark infringement litigation against Sensei Inc., a health care technology company. PayFlex had previously hired Sensei as a software development consultant for PayFlex's new product, "HealthHub," a healthcare benefits planning and management mobile tool. A year later, PayFlex discovered that Sensei had launched its own nearly identical benefits management product, coincidentally named "Health Hub." Once we filed a complaint Sensei immediately agreed to stop use of the Health Hub mark and signed a consent judgment, including a permanent injunction. Case settled.

PayFlex Systems USA, Inc. v. Sensei, Inc. et al., No. 8:11-cv-00265 (D. Neb. filed Aug. 2, 2011).

Pearson Education, Inc. and John Wiley & Sons, Inc. and Thompson Learning, Inc. v. Thomas Lewis, Pelican Bookshop, Inc., et al. *

Successfully represented Pearson Education Inc. in obtaining a permanent injunction and damages arising out of the unauthorized sale of foreign editions of their books in the United States.

Pearson Education, Inc. and John Wiley & Sons, Inc. and Thompson Learning, Inc. v. Thomas Lewis, Pelican Bookshop, Inc., et al., 04 CV 3626, U.S. District Court, SD New York (2004).

Trademark litigation for subsidiary to a Fortune 100 global infrastructure and financial services corporation

Obtained, in less than one week's time, a temporary restraining order on behalf of a lender subsidiary to a Fortune 100 global infrastructure and financial services corporation thwarting the misuse of the client's trademark by a loan services company seeking to enter into a loan transaction with a world-famous boxing champion.

iKindi, Inc. v. STW Fixed Income Management Ltd.

Successfully represented iKindi, a financial software developer, in affirming its rights in and to performance after tax financial software and platform it had developed.

iKindi, Inc. v. STW Fixed Income Management Ltd., 07 Civ 00185, SD New York (2007).

Trademark, copyright and Internet counseling for financial management and advisory company

Provides trademark, copyright and Internet counseling, litigation and other enforcement representation and portfolio management for a financial management and advisory company.

Pearson Education, Inc and John Wiley & Sons, Inc. v. Anjum Sehgal, et al.

Successfully represented Pearson Education Inc. in obtaining a permanent injunction out of the unauthorized sale of foreign editions of their books in the United States and in a contempt proceeding brought against the defendants which resulted in a significant damages award.

Pearson Education, Inc and John Wiley & Sons, Inc. v. Anjum Sehgal, et al., 03 CV 8307, U.S. District Court, SD New York (2004-05).

Trademark counsel for heirs of Jaco Pastorius

Representing the heirs of Jaco Pastorius, the celebrated bass guitarist, in obtaining the return of the well-known "Bass of Doom" bass guitar, twenty years after it was stolen from Jaco Pastorius.

Brought trademark infringement claims for well-known U.S. fashion brand

Brought trademark claims in the SDNY against foreign competitor and obtained successful settlement for well-known U.S. clothing brand and foreign parent.

Copyright infringement action for Washington University in St. Louis

Brokered an advantageous settlement agreement for Washington University in St. Louis in a complex copyright infringement action. The case involved the University's acquisition of a film and media archive in 2001 consisting of various documentary film materials that were collected by the late Henry Hampton, the documentary filmmaker famous for his critically acclaimed television series on civil rights in America, "Eyes on the Prize." Six years after acquiring and housing the archive materials in the University's Film and Media Archive, the late Henry Hampton's media company sued the University in Boston, Massachusetts for copyright infringement, conversion and various other claims based on the University's possession and use of the archive. The firm immediately filed a motion to dismiss the lawsuit and entered into settlement discussions that raised nuanced and novel questions of copyright law.

Trademark counsel for a leading financial institution

Provide trademark, copyright and Internet counseling, litigation and other enforcement representation, and portfolio management for a leading financial institution.

Trademark litigation for a financial and technology company *

Successfully represented a financial and technology company in stopping the use and registration of a mark related to their name being used for retail related services in Class 35.

Janet Jackson v. Janetjackson.com *

Obtained a judgment in this *in rem* action transferring the domain name JANETJACKSON.COM to the well known entertainer Janet Jackson.

Janet Jackson v. Janetjackson.com, Civil Action No. 00-773-A, U.S. District Court, E.D. Virginia (2000).

Avon Products, Inc. v. Beth Stone Kim, et al. *

Successfully represented Avon Products Inc. in shutting down a web site using the name and mark AVON CALLING that was reselling Avon products.

Avon Products, Inc. v. Beth Stone Kim, et al., 0 Civ. 4163, U.S. District Court, S.D. New York (2001).

Trademark counsel for major soft drink manufacturer *

Internet counseling and litigation, including content and domain name disputes and enforcement actions.

Trademark and copyright counseling for a voice and electronic brokerage firm

Provides trademark, copyright and Internet counseling, litigation and other enforcement representation and trademark portfolio management for a voice and electronic brokerage firm.

NBC Universal Inc. v. NBCUNIVERSAL.COM

Obtained summary judgment in an *in rem* action regarding the domain name NBCUniversal.com, which was registered to a Korean national using a Korean registrar and was being used for an alleged protest website. The firm obtained a court order transferring the domain name from the Korean registrar to a U.S. registrar and then to NBC Universal. We also successfully defeated a motion to dismiss the *in rem* action in favor of the prior filed Korean action.

NBC Universal, Inc. v. NBCUNIVERSAL.COM, No. 1:2005-cv-00268-LMB-TCB (E.D. Va. filed Mar. 10, 2005).

Russell Boyd v. Julia Fiona Roberts, et al. *

Successfully represented Ms. Roberts in action concerning the domain name JULIAROBERTS.COM and obtained an order transferring the domain name to Ms. Roberts.

Russell Boyd v. Julia Fiona Roberts, et al., CA No. 00-968-A, U.S. District Court, E.D. Virginia (2001).

International trademark representation for client in environmental credit industry

Counseled multinational corporate client on international trademark issues in the environmental credit industry.

Internet counsel for one of the world's largest home products retailer

Provide Internet and social media advice and counseling to the holding company of one of the world's largest home products retailer.

*Experience gained by attorney prior to joining Kilpatrick Townsend

Publications, Articles and Speaking Engagements

Online Copyright Issues for Websites Offering User-Generated Content
Intellectual Property Desk Reference, January 01, 2009

How to Squeeze into a Crowded Field of Trademarks
Intellectual Property Desk Reference, January 01, 2009

An Overview of Legal Remedies Against the Trafficking in Goods Bearing Counterfeit Trademarks
Intellectual Property Desk Reference, January 01, 2009

An Overview of Trademark Anticounterfeiting and Gray Market Goods Law in the United States
Intellectual Property Desk Reference, January 01, 2006

Newfound Assets and Liabilities in Cyberspace
Korean Invention Promotion Association and Licensing Executives Society Japan, June 30, 2003

Professional & Community Activities

American Bar Association, Member

Association of the Bar of the City of New York, Member

MARQUES, Member of the Membership Team

Russian Children's Welfare Society, Inc., Member of the Board of Directors

Education

Brooklyn Law School, J.D. (1991)
magna cum laude

Georgetown University School of Foreign Service, B.S. (1979)

Northwestern University, M.A. (1981)

Bar Admissions

New York (1992)

Admissions

U.S. Court of Appeals for the Second Circuit

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

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