

Robert N. Potter

Partner

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Services

Anti-Counterfeiting & Gray Markets
Copyright Litigation & Counseling
Intellectual Property
Online & Digital Enforcement
Trademark Litigation
Trademark, Copyright &
Advertising

Industries

Apparel, Accessories & Luxury
Goods
Consumer Goods
Electronics & Computer
Technology
Media & Entertainment
Retail & Consumer Goods

Rob Potter focuses his practice on trademark and copyright litigation and counseling, with an emphasis on anti-counterfeiting and Internet infringement. Mr. Potter routinely litigates disputes in state and federal courts around the country and before the Trademark Trial and Appeal Board, and advises clients on intellectual property matters across a wide range of industries including entertainment, luxury goods, and technology.

Mr. Potter has successfully represented clients in a broad array of copyright and trademark matters, including successful oral argument before the Second Circuit in affirming a summary judgment victory for client Sony Pictures Entertainment. Mr. Potter also has experience in obtaining and enforcing temporary and preliminary injunctive relief in trademark and anti-counterfeiting matters.

Mr. Potter was recognized in 2020 by *The Best Lawyers in America*[®] for Intellectual Property Litigation. He was recognized as a New York "Super Lawyer" in 2019 and the six years immediately preceding and as a New York "Rising Star" in 2012 and 2011 for Intellectual Property Litigation by *Super Lawyers* magazine. Mr. Potter was recognized as a 2014 Volunteer of the Year by the Pro Bono Partnership (PBP) of Atlanta for his representation of Positive Impact, an Atlanta-based non-profit, in federal trademark litigation in New York.

Experience

Represented Hachette Filipacchi Media US Inc., a leading publisher of fashion magazines, in connection with lawsuit arising from termination of license agreement in New York.



Represents a California-based *Fortune* 500 multinational corporation that designs and manufactures consumer electronics and computer software products in trademark enforcement work, including lead counsel representation of client in multiple proceedings before the Trademark Trial and Appeal Board.

Obtained summary judgment victory for Arista Records and recording artist Outkast against claims for joint authorship and copyright infringement.

Served as lead counsel in representing musician Aliza Hava for copyright infringement and related claims against defendant website asserting ownership over Ms. Hava's copyrighted recordings and compositions. Obtained favorable settlement agreement including declaration of Ms. Hava's full ownership in relevant songs.

Represented The National Academy of the Recording Arts & Sciences, the organization which administers the prestigious GRAMMY award ceremony, in connection with efforts to halt Christie's auction of the GRAMMY awarded to James Brown, the "Godfather of Soul," in 1986 for the song "Living In America." Christie's refused to heed the firm's demand that it call off the auction, asserting that there were no enforceable restrictions on the sale of the statuette. The firm responded by promptly commencing a lawsuit in New York state court. Faced with the cloud on title resulting from the lawsuit, Christie's ultimately pulled the GRAMMY award from the auction literally minutes before the bidding on the award was set to begin. Christie's subsequently confirmed that it has returned the statuette with no plans to auction it in the future.

Represented bar/restaurant owner in connection with numerous trademark and right of publicity issues, along with copyright analysis with regard to publicity and promotion.

Obtained a \$500,000 consent judgment and permanent injunction against C Lenu, Inc. and its principals. C Lenu operated a decoding facility that used tools, chemicals and other methods to remove codes and other quality-control and anti-counterfeiting measures from DAVIDOFF, CALVIN KLEIN and other Coty fragrance products. Under the injunction, C Lenu, as well as its customers and suppliers, are prohibited from trafficking in infringing Coty fragrances of any kind, including decoded Coty fragrances. *Coty Inc., et al. v. C Lenu, Inc., et al.*, No. 10-21812 (S.D. Fla. filed June 3, 2010).

Served as lead counsel in representing Sony Pictures Entertainment Inc., actor/writer Adam Sandler and writer Judd Apatow, et al., in a copyright, trademark and unfair competition suit in federal court in New York. The firm successfully obtained summary judgment of copyright and trademark rights on behalf of Sony Pictures Entertainment Inc., rejecting claims of film and advertising infringements and lighting the way for the movie *You*



Don't Mess With The Zohan . The Court of Appeals for the Second Circuit affirmed the district court's grant of summary judgment to our client. *Cabell v. Sony Pictures Entm't, Inc.* 714 F. Supp. 2d 452 (S.D.N.Y. 2010), aff'd, No. 10-2690-CV, 2011 U.S. App. LEXIS 13057 (2d Cir. June 24, 2011).

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

Obtained a \$6 million dollar default judgment and permanent injunction against online counterfeiters. Defendants operated a ring of at least 32 websites, many of which prominently featured counterfeits of the federally registered GED® marks, through which they offered sham diplomas from fictitious high schools to consumers throughout the U.S. The defendants' scam was highly sophisticated and included a bogus Wikipedia entry, promotional YouTube videos, Facebook community pages, and a fraudulent entity that purported to accredit their services.

The Court awarded plaintiffs \$6 million dollars in damages arising out of defendants' willful acts of trademark infringement, trademark counterfeiting, and unfair competition and, among other things, ordered that all of the domain names at issue be permanently transferred to plaintiffs, regardless of whether they included the GED® marks. This result was made possible by the extraordinary ex parte injunctive relief plaintiffs' obtained at the outset, in which the Court allowed plaintiffs to obtain information about defendants' true identities and to freeze defendants' financial assets, even prior to serving plaintiffs' complaint. *GED Testing Service LLC et al. v. Amjad Pervaiz et al.*, 12 Civ. 1157 (JPO) (S.D.N.Y.).

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.

Represented Clif Bar in a trade dress case brought by Kind. Kind filed suit and moved for an expedited preliminary injunction to prevent client Clif Bar from launching its new premium CLIF MOJO healthy snack bars in see-through packaging that allegedly infringed Kind's trade dress. Less than a week after the five-day hearing concluded, Judge Kimba Wood issued a 25-page written opinion denying Kind's motion in full. The judge found that Kind's alleged trade dress was not distinctive (and thus not protectable), that there was no likelihood of consumer confusion between the parties' packaging, and that Kind had not demonstrated irreparable injury or a balance of hardships tipping in its favor. Kind has taken an appeal to the Second Circuit. *Kind, LLC v. Clif Bar & Co.*, 2014 WL 2619817 (S.D.N.Y. June 12, 2014)

Obtained a temporary restraining order thwarting the misuse of the client's trademark by a loan services company seeking to enter into loan transactions with, *inter alia*, a world-famous boxing champion..



Represent the officers and directors of a publicly held company in a shareholder derivative action pending in the Business Court in the State of North Carolina filed by holders of preferred shares. The allegations center on an alleged breach of fiduciary duty by the officers and directors in mismanaging the company and using company funds to benefit an outside entity owned by them. Individual claims against the officers and directors were successfully dismissed. Counsel also successfully obtained orders compelling written discovery from the plaintiff and a deposition of counsel for plaintiff in the state courts of North Carolina and New York. They successfully resolved all remaining derivative claims. *Esquire Trade & Fin., Inc. v. Diversified Senior Serv., Inc.*, 08 CVS 6227 (Forsyth County filed Aug. 12, 2008).

Served as IP counsel in a case in the Delaware Chancery Court. Represented fashion design house, Tory Burch, LLC which brought claims against a former director alleging that its former director competed unfairly against the company by launching a knockoff version of the "Tory Burch" brand created with the company's confidential information and in violation of his fiduciary duties and contractual obligations. Negotiated the settlement agreement which resolved the case. *J. Christopher Burch v. Tory Burch LLC, et al.*, No. 7921-CS (Del. Ch., Nov. 5, 2012).

Education

University of Pennsylvania Law School (2005) *cum laude*

Florida State University, B.A., Communication (1997) *summa cum laude*

Admissions

New York

Court 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

U.S. District Court for the Eastern District of Michigan

Professional & Community Activities

Copyright Society of the USA (Co-Chair, New York Chapter)

International AntiCounterfeiting Coalition

New York State Bar Association, Intellectual Property Law Section

Bronx School of Law & Finance, Advisory Board



Insights

[News Releases](#)

Record Number of Kilpatrick Townsend Attorneys Named 2019 New York Metro Super Lawyers
November 1, 2019

[News Releases](#)

Record-Breaking Recognition for Kilpatrick Townsend in *The Best Lawyers in America*® 2020
August 15, 2019

[Webinars](#)

Anti-Counterfeiting Enforcement in the U.S. and China – Setting Priorities and Allocating Resources
August 14, 2019

[Perspectives](#)

4 Key Takeaways: The Use of Investigators in Litigation Matters
October 26, 2018

[Events](#)

The Use of Investigators in Litigation Matters
October 16, 2018

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Twenty Kilpatrick Townsend Attorneys Named 2018 New York Super Lawyers
September 28, 2018

[Alerts](#)

Advancing the Law Against Knock-Offs
November 20, 2017

[News Releases](#)

Kilpatrick Townsend Attorneys Named 2017 New York Super Lawyers
September 27, 2017

[News Releases](#)

Kilpatrick Townsend Attorneys Named 2017 New York Super Lawyers



September 27, 2017

[In The News](#)

KT is...Trending, December 10-23, 2016

December 28, 2016

[Alerts](#)

Key Takeaways from the Advanced Trademark Law Seminar

October 21, 2016

[Publications](#)

Top Takeaways from the 2016 Advanced Trademark Law Seminar

October 10, 2016

[News Releases](#)

Kilpatrick Townsend Attorneys Named 2016 New York Super Lawyers

October 5, 2016

[In The News](#)

Kilpatrick Townsend's Media Report September 2-8, 2016

September 9, 2016

[In The News](#)

Kilpatrick Townsend's Media Report April 22-28, 2016

April 29, 2016

[News Releases](#)

Kilpatrick Townsend Elects Rob Potter to Partner

January 6, 2016

[News Releases](#)

Kilpatrick Townsend Attorneys Named 2015 New York Super Lawyers

September 30, 2015

[News Releases](#)



Kilpatrick Townsend's Rob Potter Awarded for Positive Impact
March 16, 2015