

David K. Caplan

Partner

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Services

Anti-Counterfeiting & Gray Markets

Class Action Defense

Copyright Litigation & Counseling

Intellectual Property

Litigation

Online & Digital Enforcement

Trademark Litigation

Trademark, Copyright &

Advertising

Industries

Apparel, Accessories & Luxury

Goods

Media & Entertainment

David Caplan leads Kilpatrick Townsend's online enforcement team. He has spent 25 years protecting clients' intellectual property rights against infringements online. Mr. Caplan has designed and implemented intellectual property enforcement programs for companies across industries, including many of the world's largest media, technology, and consumer products companies. Mr. Caplan partners with his clients to implement specially tailored programs designed to address the issues they face.

Mr. Caplan's practice involves protecting brands and creative works against all types of copyright and trademark infringement, including counterfeiting, infringement, phishing, cybersquatting, false advertisement, and piracy, through non-litigation enforcement efforts, litigation, and through ICANN's domain name dispute resolution policy.

Mr. Caplan's practice also involves counseling regarding Internet business issues and intellectual property issues raised by the Internet. Mr. Caplan advises clients about copyright and trademark issues raised by new media businesses, including implementation of Digital Millennium Copyright Act (DMCA) compliance programs.

Mr. Caplan regularly speaks to client legal and marketing departments and trade associations regarding online enforcement issues, and has been interviewed for publications and broadcasts on these issues.

Mr. Caplan was recommended by *Legal 500 US* in 2019 for Copyright and in 2018 and the four years



immediately preceding for Trademark Litigation. From 2004 to 2008, Mr. Caplan was recognized as a Southern California “Super Lawyer” by *Los Angeles* magazine, ranking him in the top 2.5 percent of Southern California lawyers age 40 or younger.

Experience

Represented Zynga in litigation against a network of individuals and entities which sold guidebooks containing “secrets” to Zynga’s games to unwitting consumers. In reality, the guidebooks merely replicated elements from Zynga’s games, and misused Zynga’s trademarks in an effort to dupe consumers. We disrupted the networks and recovered dozens of domain names used by the network.

Represented Overture Services (Yahoo!’s predecessor in the paid search business) in a group of a fourteen separate lawsuits brought by Los Angeles car dealerships who claimed that paid search ads featuring the dealers’ names infringed their common trademark rights. The plaintiffs also alleged various state law business torts. Overture was concerned that the lawsuits could set a costly precedent if Overture could be held liable for the conduct of online advertisers. We resisted the state law claims using the Communications Decency Act’s immunity for ISPs, and through aggressive discovery established the weakness of the dealerships’ trademark rights. We were then able to obtain settlements at a nuisance value for Overture.

Defended Burberry Group, PLC, Burberry Limited (NY) and Burberry Limited (UK) against right of publicity, trademark infringement, unjust enrichment, quantum meruit and common law unfair competition claims brought by the Estate of Humphrey Bogart. Our client had created a historical timeline depicting the evolution of Burberry’s culture, products and people, which was made available by Burberry on the Facebook social networking platform. The timeline included an image of Humphrey Bogart from 1942 wearing a Burberry trench coat from the final scene of the motion picture, “Casablanca.” In connection with this image, Burberry included the following description: Humphrey Bogart wearing a Burberry trench coat in the final scene of Casablanca (1942). A few hours before Bogart LLC, filed this action in California, we filed a declaratory relief action in the Southern District of New York. After litigating two cases on opposite coasts, the cases were settled on terms favorable to our clients.

Represented a manufacturer of a liquid and tablet herbal supplement in a false advertising class action. We successfully opposed certification of the class as to the tablet product, which significantly narrowed the available damages to the plaintiffs. We were then able to settle the case on favorable terms for the client.

Represented Philips in a trademark infringement case brought against manufacturers of infringing DVD recorders. We obtained a \$120 million judgment and permanent injunction. In addition, we obtained contempt sanctions of millions of dollars, incarceration of the defendant’s U.S. based executive, seizures at various

locations, and orders to freeze all of the defendants' assets and repatriate millions of dollars transferred overseas.

Represented Overture, Yahoo!'s predecessor in the paid online search business, in an action for computer trespass and violation of the federal Computer Fraud & Abuse Act. The defendants had been allowed access to Yahoo!'s data feed to manage advertiser accounts and, when Overture shut off access, Defendants claimed that Overture had intentionally interfered with their contracts. In advance of the claim being filed, Overture preemptively filed a complaint for computer trespass alleging that defendants had used robotic agents to invade Overture's computer system and manipulate its bidding system. The case settled favorably after filing of Overture's summary judgment motion.

Represented Saban Entertainment, Inc. against a complaint for copyright infringement, breach of contract, inducing breach of contract, and various associated state law claims against owners and broadcasters of the Mighty Morphin Power Rangers, alleging that the Power Rangers infringed a property which the plaintiff allegedly owned. The plaintiff sought \$1 billion and injunctive relief. We filed a motion to dismiss all of plaintiff's claims and the district court granted the motion, dismissing all of the plaintiff's claims. Plaintiff chose only to pursue its inducing breach of contract on appeal. In our appeal, we argued that the claim was preempted by the Copyright act. The case was then settled on terms favorable to the client.

Represent Summit Entertainment in this copyright infringement and computer fraud and abuse act case brought against a hacker who had breached servers for Summit's "Twilight" films and leaked video and images online. After identifying an earlier online "Tweet" of the leaked images, we worked with investigators and local counsel across the world, including Australia, Poland, Brazil, Italy, France, Florida, and New Jersey, to trace the distribution chain up to the original source, the hacker. We filed civil and criminal cases in Argentina against the hacker, and are litigating this case in the Central District of California.

Represented Zynga in a litigation enforcement program targeting high value resellers of virtual chips used in Zynga's online poker game, with the goal of disrupting chipseller website networks, obtaining money judgments, and canceling or transferring ownership of high value domain names. This coordinated effort included 22 lawsuits, with 33 judgments in Zynga's favor, and the transfer or cancellation of hundreds of domain names that had been the primary vehicles for the illicit businesses.

Represented MGA Entertainment Inc., the owners of the Bratz property, in one of the first cases to address allegations of a wrongful ISP takedown notice under the DMCA. After extensive discovery, we filed a summary judgment motion and argued that our client's takedown notice was sent in good faith. The court granted our motion for summary judgment.



Dudnikov v. MGA Entertainment, Inc., 410 F.Supp.2d 1010, (D. Colo. 2005).

Represented Paramount Pictures Corporation in copyright litigation. Paramount and Universal had plans to launch trailers for summer tent-pole films during the Super Bowl. An unknown subject created a YouTube account and posted the trailers online. We worked with our clients to identify the subject and prevented any further violations by this infringer.

Successfully filed a World Intellectual Property Organization (WIPO) complaint on behalf of Yahoo!. The firm prevailed in a WIPO proceeding through panel appointment which resulted in the transfer of an important domain name for Yahoo!.

Represented Paramount Pictures Corporation just weeks before the release of its holiday blockbuster motion picture, "Varsity Blues," the registrant of the domain name VARSITYBLUES.COM made good on a prior threat and launched a web site depicting partial birth abortions at that domain name location. In representing Paramount, we obtained a Preliminary Injunction ordering the immediate transfer of the domain name to Paramount.

Defended one of the earliest online gaming companies against a claim that its web site design infringed the trade dress of the plaintiff's web site. We filed a motion for summary judgment and argued that the plaintiff's alleged trade dress, for a lotto game, was functional and had not developed secondary meaning. Based on the strength of the motion, the plaintiff dismissed its trade dress claim with prejudice.

Education

Northeastern University, J.D. (1995)

Williams College, B.A., Economics (1992)

Admissions

California (1995)

Massachusetts (2008)

Court Admissions

U.S. District Court for the Central District of California

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

U.S. District Court for the Northern District of California

U.S. District Court for the Southern District of California

U.S. District Court for the District of Colorado



U.S. Court of Appeals for the Ninth Circuit

U.S. Supreme Court

Professional & Community Activities

International Anti-Counterfeiting Coalition, Member

Insights

[News Releases](#)

Kilpatrick Townsend Receives Top Rankings from 2019 Legal 500 US
July 10, 2019

[News Releases](#)

Kilpatrick Townsend Receives Top Rankings from 2018 Legal 500 US
June 11, 2018

[News Releases](#)

Kilpatrick Townsend Recognized by Prestigious 2017 Legal 500 US
October 2, 2017

[News Releases](#)

Kilpatrick Townsend Recognized by Prestigious 2016 Legal 500 US
June 20, 2016

[News Releases](#)

Kilpatrick Townsend Recognized by Prestigious 2015 Legal 500 US
July 15, 2015

[In The News](#)

Kilpatrick Townsend's Media Report March 27 - April 2, 2015
April 3, 2015

[In The News](#)

Kilpatrick Townsend's Media Report February 27-March 5, 2015
March 6, 2015