

## Georges Nahitchevansky

### Partner

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### Services

Brand Licensing & Related  
Transactions  
Clearance & Portfolio Management  
Copyright Litigation & Counseling  
Intellectual Property  
Online & Digital Enforcement  
Trademark Litigation

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. He has extensive experience in handling U.S. and worldwide trademark, copyright and Internet enforcement matters, including complex cross border and multi-jurisdictional disputes.

Mr. Nahitchevansky started his legal career as a commercial litigator at a major New York litigation firm, and has since 1994 exclusively focused on intellectual property. He has successfully litigated as lead counsel, both on behalf of plaintiffs and defendants, a wide array of trademark, copyright and Internet related disputes in federal and state courts in the United States, in opposition and cancellation proceedings before the Trademark Trial and Appeal Board, and in UDRP and other dispute resolution policies to recover domain names. Mr. Nahitchevansky also advises and counsels on online enforcement programs, domain name registration programs, and U.S. and worldwide strategies for brand enforcement.

Mr. Nahitchevansky is listed in the *World Trademark Review 1000 – The World's Leading Trademark Professionals* (2011-2021), which rated him as a one of the top trademark litigators in New York, and described him as "a discerning and helpful authority on internet-related questions" and "one of the firm's top litigators." Mr. Nahitchevansky is also recognized as a New York "Super Lawyer" in Intellectual Property (2011-2021) by *Super Lawyers* magazine, an "IP Star" (2013-2020) by *Managing Intellectual Property* magazine and a "WIPR Leader" in Trademarks (2017) by *World Intellectual Property Review*. He has also been recognized by Law Business Research in its *Who's Who Legal: Trademarks* (2016) and Legal Media in its *Guide to the World's Leading Trademark Law Practitioners* (2012, 2014), and has been recommended by *Legal 500 US* in the areas of



Copyright and Non-Contentious Trademark Law (2012, 2013). He is AV® Preeminent rated by Martindale-Hubbell.\*

Prior to joining the firm in 2005, Mr. Nahitchevansky practiced with Fross, Zelnick, Lehrman & Zissu, P.C. Mr. Nahitchevansky is fluent in French. He has also shot, directed and produced a number of films and videos on such diverse topics as family planning and healthcare issues in Africa, India and Russia, the civil wars in Central America, and hot air ballooning in Austria .\*

## **Representative Engagements**

### **Trademark**

*Deluxe Holding AG v. BYM International, Ltd.* Successfully represented Deluxe Holding, the owner of the POINTER mark for footwear and apparel, in a priority and trademark dispute against BYM, the owner of the POYNTER mark for footwear.

*General Electric Company and General Electric Capital Corporation v. Nantucket Funding LLC, et al.* 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.

*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 obtained a court order enjoining the plaintiffs from using the mark and name BLEST ARE WE.

*Lurzer GmBh v. American Showcase, Inc.* Successfully represented Lurzer Gmbh, the publisher of the advertising magazine LURZERS ARCHIVE, in a Second Circuit appeal concerning the ownership of the ARCHIVE trademark and infringement of such by American Showcase.

*Bank of America Corp. v. Banc of America Auto Sales.* 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.

*Pearson Education, Inc. and John Wiley & Sons, Inc. v. Anjum Sehgal, et al.* Successfully represented Pearson Education Inc. in obtaining a permanent injunction and damages 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.

*Elektra Entertainment Group Inc. v. Elektra Trading and Consulting Group, S.A. de C.V.* Successfully represented Elektra Entertainment in an opposition proceeding before the Trademark Trial and Appeal Board concerning the use of the ELEKTRA mark by Elektra Trading and Consulting (an affiliate of the Mexican financial and retail corporation Grupo Elektra) for retail services, including electronic goods. The opposition proceeding went through trial and resulted in a decision in favor of Elektra Entertainment.

*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.

*NBTY, Inc. v. USA Nutritionals, Inc. and Action Labs, Inc.* Successfully represented defendant USA Nutritionals Inc. for alleged trademark infringement of the mark U.S. NUTRITION based on its use of the mark USA NUTRITIONALS for vitamin and nutritional supplements.

*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.

*Edgar Rice Burroughs, Inc. v. Ultimate Video.* Obtained a preliminary injunction enjoining the distribution of a film entitled Jungle Heat based on the TARZAN character and story.

### **Internet and Domain Names**

*Ikeafans, Inc. v. Ikea Property Inc. et al.* Successfully represented IKEA in a dispute with an Internet fan site known as Ikeafans.com.

*Hexuan Cai v. Cerulean Studios LLC.* Successfully litigated matter in the US and China regarding the registration and use of the domain name TRILLIAN.COM obtained by the registrant through an online auction and used for an alleged agricultural site.

*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. Obtained a court order transferring the domain name from the Korean registrar to a U.S. registrar and then to NBC Universal and successfully defeated a motion to dismiss the in rem action in favor of the prior filed Korean action.

*General Media Communications, Inc. v. Heu.* Obtained ruling effectively reversing UDRP decision by National Arbitration Forum that GMCI, publisher of Penthouse magazine, had engaged in reverse domain name high-jacking in seeking transfer of domain name penthouseboutique.com to GMCI.

*Mariah Carey v. General Webgroup, et al.* Obtained a judgment transferring the MariahCarey.com domain name away from a purported fan site.

*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.

*Avon Products, Inc. v. Beth Stone Kim, et al.* Successfully represented Avon Products Inc. in shutting down a web site operated by a former Avon representative using the name and mark AVON CALLING that was reselling Avon products.

*Russell Boyd v. Julia Fiona Roberts, et al.* Successfully represented Ms. Roberts in an action concerning the domain name JULIAROBERTS.COM and obtained an order transferring the domain name to Ms. Roberts.

*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.

*Weightwatchers.com Inc. v. Ediets.com, Inc.* Successfully defended eDiets against pop up advertising claims by Weightwatchers.

## **Copyright**

*Citigroup Global Markets Inc. v. James Cass and Hedgeanalyst.com.* Obtained a permanent injunction and almost \$1M in damages and attorneys' fees against a web site delivering full copies of proprietary analyst reports online.

*Exceller Software Corporation v. Pearson Education, Inc. and Addison Wesley Longman, Inc.* Successfully defended Pearson Education and Addison Wesley in a joint authorship and copyright infringement dispute concerning a CD-ROM series for students studying English as a second language.

*iKindi, Inc. v. STW Fixed Income Management Ltd.* Successfully represented iKindi, a financial software developer, in affirming its ownership rights in a performance after tax financial software and platform it had

developed.

*Blackside Inc. v. 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. We immediately filed a motion to dismiss the lawsuit and entered into settlement discussions that raised nuanced and novel questions of copyright law.

*Edgar Rice Burroughs, Inc. v. Beukenoord Springboard-Video B.V., et al.* Working with Dutch counsel, 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. Video Marc Dorsel.* Working with French counsel, successfully represented Edgar Rice Burroughs Inc. in obtaining a permanent injunction and substantial damages in a copyright infringement action regarding a pornographic film based on the TARZAN character and story. The action went up to the Cour D'Appel in France and the court's decision reaffirmed the continuing copyright rights in the original 1912 story "Tarzan of the Apes."

#### **Other**

*30th Street Guitars, Inc. v. Jaco Pastorius, Inc., et al.* 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.

*JA Apparel Corp. v. The Judger Group Ltd.* Served as co-lead counsel in an international arbitration proceeding for plaintiff licensor JA Apparel Corp. against a Chinese licensee for the JOSEPH ABBOUD mark. After conducting a full trial on liability, we successfully obtained an arbitral award confirming the termination of the license, finding that the licensee materially breached the license agreement, enjoining the licensee's activities in China and dismissing the China licensee's counterclaim. We also obtained a damages award in the amount of \$1.2 million, a permanent injunction including an order to return or destroy all remaining inventory, and an award of attorneys' fees and costs. This arbitration award was later formally recognized by the Shanghai Number One Intermediate People's Court.

*Madison Apparel Group Ltd. v. Hachette Filipacchi Presse, S.A.* Successfully represented publisher Hachette in an action concerning the termination of a license agreement.

*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, UPC codes, 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.

Golden Venture Deportation Proceedings. Successfully represented pro bono a group of six Chinese juveniles that were aboard the Golden Venture cargo ship in their efforts to stay in the United States after the ship ran aground off of Queens, New York. The matter involved six asylum hearings, juvenile immigrant proceedings and appeals by the INS. All six individuals ultimately obtained Green Cards.

#### **Domain Names and Contested UDRP Proceedings**

Mr. Nahitchevansky has filed over 150 UDRP and other domain name dispute resolution proceedings, (for example, domain names with extensions such as .com.au, .co.ae, .eu, .me, .us and others) on behalf of numerous celebrities and Fortune 500 companies. The following are representative examples of UDRP cases that were contested and successfully resolved for the noted Complainants.

*Cerulean Studios LLC v. Hexuan Cai*, WIPO D2013-0902 (case involving an alleged agricultural web site and the use of fabricated evidence to create a legitimate interest);

*Expedia Inc. and Hotels.com LP v. Arabia Horizons Tours*, WIPO Case DAE2014-0005 (case involving Hotels.co.ae and Expedia.co. which were being used for competing travel web sites in the UAE);

*General Electric Company v. Edison Electric Corp. a/k/a Edison Electric Corp. General Energy*, WIPO Case No. D2006-0334 (copycat web site promoting other products using the domain name EDISONGE.COM);

*PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS COMPUTER INDUSTRY (a/k/a EMS)*, WIPO Case No. D2003-0696 (Italian group that was creating an alleged sports forum using the designation P.E.P.S.I. Respondent filed a lawsuit in Italy after losing the UDRP);

*PepsiCo, Inc. v. "The Holy See"*, WIPO Case No. D2003-0229 (anti-abortion group registered multiple communicative domain names based on the PEPSI mark to post web pages against abortion);



*General Electric Company, GE Osmonics Inc. v. Optima di Federico Papi*, WIPO Case No. D2007-0645 (vendor selling genuine GE MERLIN water filters, but giving impression of being a legitimate distributor)

*General Electric Company v. Prabish Thomas/Green Energy LLC*, WIPO Case No. D2007-1866 (Respondent group registered multiple domain names for an alleged company called Green Energy selling solar products and services in North Africa and Middle East);

*Avon Products Inc. v. Jongsoo Lee*, WIPO Case No. D2001-0272 (the proceeding concerned an Avon representative selling claimed genuine AVON products in Korea);

*Avon Products, Inc. v. Mary Ultes*, WIPO Case No. D2009-0471 (the matter involved an Avon representative building an entire business to promote sales of AVON products);

*Jay Leno v. Guadalupe Zambrano*, WIPO Case No. D2009-0570 (the matter involved the registration and use of thejaylenoshow.com where the Respondent contested rights and ownership of JAY LENO as a mark).

## **Experience**

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).

Successfully resolved contested UDRP proceeding for Complainant in case involving Hotels.co.ae and Expedia.co. which were being used for competing travel web sites in the UAE. *Expedia Inc and Hotels.com LP v. Arabia Horizons Tours*, WIPO Case DAE2014-0005

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).

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).

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).

Successfully represented eSpeed, a financial and technology company, in stopping the use and registration of the mark ESPEED FULFILLMENT for retail related services in Class 35. *eSpeed, Inc. v. Designers Collection, Inc, et al.*, 00 Civ 9560, U.S. District Court, S.D. New York (2001).

Successfully represented pro bono a group of six Chinese juveniles that were aboard the Golden Venture cargo ship in their efforts to stay in the United States after the ship ran aground off of Queens, New York. The matter involved six asylum hearings, juvenile immigrant proceedings and appeals by the INS. All six individuals ultimately obtained Green Cards.

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

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

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

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

Successfully resolved contested UDRP proceeding; proceeding concerned an Avon representative selling claimed genuine AVON products in Korea. *Avon Products Inc. v. Jongsoo Lee*, WIPOCase No. D2001-0272

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

Successfully resolved contested UDRP proceeding for Complainant in case involving copycat web site promoting other products using the domain name EDISONGE.COM. *General Electric Company v. Edison Electric Corp. a/k/a Edison Electric Corp. General Energy*, WIPO Case No. D2006-0334

Obtained a judgment transferring the MariahCarey.com domain name away from a purported fan site.

Successfully represented publisher Hachette in an action concerning the termination of a license agreement.

Successfully resolved contested UDRP proceeding for Complainant in case involving the registration and use of thejaylenoshow.com where the Respondent contested rights and ownership of JAY LENO as a mark. *Jay Leno v. Guadalupe Zambrano*; WIPO Case No. D2009-0570

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.

Successfully resolved contested UDRP proceeding; proceeding concerned an Avon representative building an entire business to promote sales of AVON products. *Avon Products, Inc. v. Mary Ultes*, WIPO Case No.



D2009-0471

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).

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).

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.

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).

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).

## **Education**

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

Northwestern University M.A. (1981) Film,

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

## **Admissions**

New York (1992)

## **Court Admissions**

U.S. Court of Appeals for the Second Circuit

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

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



## Professional & Community Activities

WIPO Panelist for cases brought under the UDRP

MARQUES, Member of the Cyberspace Team

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

American Bar Association, Member

Adjunct Professor, Brooklyn Law School (1992-2001)

## Insights

### [In The News](#)

Kilpatrick Townsend Attorneys Garner 37 Rankings on the 2021 International Who's Who of Business Lawyers  
October 29, 2021

### [News Releases](#)

Kilpatrick Townsend Partners Named 2021 World Intellectual Property Review Trademark and Patent Leaders  
September 15, 2021

### [News Releases](#)

Kilpatrick Townsend Earns Top Ranking from 2021 World Trademark Review  
February 17, 2021

### [News Releases](#)

Kilpatrick Townsend Attorneys Achieve 41 Individual Rankings on the 2019–2020 *International Who's Who of Business Lawyers*  
November 12, 2020

### [News Releases](#)

Eighteen Kilpatrick Townsend Attorneys Recognized as 2020 New York Super Lawyers and Rising Stars  
October 1, 2020

### [News Releases](#)

Kilpatrick Townsend Attorneys Named 2020 Managing Intellectual Property IP Stars  
June 1, 2020

### [In The News](#)

Kilpatrick Townsend's Trademark Team Earns Top Ranking From World Trademark Review



February 20, 2020

#### [News Releases](#)

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

#### [News Releases](#)

Kilpatrick Townsend Attorneys Named 2019 Managing Intellectual Property IP Stars  
June 17, 2019

#### [In The News](#)

INTA Volunteer Spotlight: Georges Nahitchevansky  
March 15, 2019

#### [News Releases](#)

Kilpatrick Townsend's Trademark Practice Receives Gold Level Recognition  
February 5, 2019

#### [News Releases](#)

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

#### [News Releases](#)

Kilpatrick Townsend Attorneys Named 2018 Managing Intellectual Property IP Stars  
June 19, 2018

#### [News Releases](#)

Kilpatrick Townsend's Trademark Practice Receives Gold Level Recognition in the 2018 World Trademark Review 1000  
January 25, 2018

#### [News Releases](#)

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



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

### [News Releases](#)

Kilpatrick Townsend Attorneys Named 2017 Managing Intellectual Property IP Stars  
June 27, 2017

### [News Releases](#)

Kilpatrick Townsend's Trademark Practice Receives Gold Level Recognition in the 2017 World Trademark Review 1000  
February 9, 2017

### [News Releases](#)

Kilpatrick Townsend Attorneys Named 2016 New York Super Lawyers  
October 5, 2016

### [News Releases](#)

Thirty-Two Kilpatrick Townsend Attorneys Named 2016 Managing Intellectual Property IP Stars  
May 26, 2016

### [Events](#)

New Developments in ICANN Domain Name System  
April 7, 2016

### [News Releases](#)

Kilpatrick Townsend Receives Top Recognition in 2016 World Trademark Review 1000  
January 21, 2016

### [News Releases](#)

Kilpatrick Townsend Attorneys Named 2015 New York Super Lawyers  
September 30, 2015

### [News Releases](#)

Twenty-Nine Kilpatrick Townsend Attorneys Named 2015 Managing Intellectual Property IP Stars  
May 6, 2015



[News Releases](#)

Kilpatrick Townsend Once Again Receives Top Recognition in 2015 World Trademark Review 1000

February 5, 2015