



## Theodore C. Max

Partner

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### PRACTICE AREAS

- Entertainment, Media and Technology
- Intellectual Property
- Litigation

### INDUSTRIES

- Emerging Growth/Venture Capital
- Fashion, Apparel and Beauty

### OVERVIEW

Theodore C. Max is a member in the Entertainment, Media and Technology and Intellectual Property practice groups in the New York office, where he focuses on counseling clients on intellectual property issues and litigation. He is co-leader of the firm's Fashion and Apparel team. Mr. Max combines his skill and experience as a trial attorney with his knowledge of copyright, trademark and intellectual property law in servicing the firm's diverse clientele.

Mr. Max has counseled clients on and litigated numerous cases involving issues on the cutting edge of copyright and trademark law. He has assisted clients in identifying, protecting and preserving their intellectual property assets, including seeking registration of rights in the United States and internationally and taking action against infringements of copyrights, trademarks and trade dress. He also has experience developing and implementing anti-counterfeiting programs and pursuing civil and criminal enforcement remedies. Mr. Max has actively litigated intellectual property issues, as well as licensing and franchise disputes, and the rights of publicity and privacy. He successfully has represented clients in all types of civil litigation, including alternate dispute resolution proceedings and mediation, trials and appeals.

### EDUCATION

- J.D., New York University School of Law, 1983, Editor-in-Chief, *New York University Review of Law and Social Change*, Won NYU Moot Court Competition, *Mendes Herschmann Prize*
- B.A., Hobart College, 1980, *summa cum laude*, *high honors*, *Rhodes Scholar Finalist*, *Student Trustee*

### EXPERIENCE

#### Experience

He has counseled representatives of some of the world's finest designers of fashion apparel and accessories with respect to their intellectual property concerns and problems, including Louis Vuitton Malletier, Emilio Pucci, Celine, Donna Karan, Kooba, Tarina Tarantino and Daryl K. In addition, he has assisted such rising stars in the fashion world as Peter Som and Rafe. He also has extensive experience in litigating commercial disputes in New York state and federal courts.

### HONORS

- Named as one of the "Legal Elite Litigation List," *Avenue Magazine*, 2011

- New York Super Lawyer, Intellectual Property Litigation, 2008, 2009, 2010, 2011

## MEMBERSHIPS

- Chair, Publications Committee, International Trademark Association
- Past Editor-in-Chief, The Trademark Reporter®, 1999-2001
- Previous United States Original Articles Editor,
- Previous International Original Articles Editor,
- Subcommittee Chair, "International Annual Review of Developments in Trademark Law and Practice," The Trademark Reporter®
- Member, Copyright and Trademark Committee of the Entertainment and Sports Law Committee of the New York State Bar Association and the Federal Bar Council
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## ARTICLES

Mr. Max has lectured widely and authored numerous publications.

"Litigating Trademark And Copyright Cases In The Metaverse," *The Metropolitan Corporate Counsel*, January 25, 2012

"Congress Has Designs For Piracy Prevention Legislation," *Daily Journal*, August 9, 2011

"Charting A Safe Course In The Perfect Storm Of Consumer Privacy Laws," *The Metropolitan Corporate Counsel*, June 2011

Authored a chapter in the book, *"Inside the Minds: New Developments in Evidentiary Law in New York, 2011 ed."*, Aspatore Publishing, April 2011.

"Trademarks in the Veldt: Do Virtual Lawyers Dream of Electric Trademarks?" *The Trademark Reporter: The Law Journal of the International Trademark Association*, Vol. 101, No. 1, January-February, 2011.

Project Runway: The Am Law Daily Edition, *The AmLaw Daily*, February 19, 2009

House Okays Watered Down PRO IP Act, *World Law Media*, June 1, 2008

Designer Hotels Are In Fashion: But Care Should Be Taken To Avoid A Major Faux Pas, *Hotel Executive.Com*, May 1, 2008

When Copyright and Trademark Infringement Goes Online, *New York Law Journal*, October 29, 2007

When Keywords Trigger Sponsored Links, Be Mindful of WhenU and the Split in the Circuits Before Choosing Your Forum Court, *Bloomberg Law Reports*, September 10, 2007

Authored a chapter in the book, *Intellectual Property Assets in Mergers and Acquisitions*, which is entitled "Acquisitions and Licensing of Famous Name Trademarks and Rights of Publicity in the United States."

"Total Recall: A Primer on a Drastic Form of Equitable Relief," published in *The Trademark Reporter*®, in May-June 1994

"Dilution Act May Limit Commercial Parodies," published in *The National Law Journal*

Contributed a chapter in the book, *The New Role of Intellectual Property in Commercial Transactions*, entitled "Available Remedies For Dispute Resolution in International and Domestic Trademark Licenses."

### **Intellectual Property Law Blog Articles**

- "The Innovative Design Protection and Privacy Prevention Act: Will Design Protection Be In Vogue in Congress?," September 1, 2010
- "What Is the Jurisdictional Pre-Requisite for Copyright Litigation?:", July 14, 2009
- "Joseph Abboud Is Back: Personal Name Trademark Controversy Continues", July 13, 2009
- "Second Circuit Resolves Split Between the Circuits Regarding Sale of Keywords to Trigger Sponsored Links and "Use in Commerce" Under the Lanham Act", April 10, 2009
- "Gibson's Patent Action Against Activision Hits Wrong Chord With Court In "Guitar Hero" Dispute: Summary Judgment Granted", April 10, 2009
- "S.D.N.Y Holds eBay Not Liable in Closely Watched Trademark Case", July 14, 2008

### **Social Media Law Update Blog Articles**

- "How to Legally Protect Your Brand in the New Millennium," November 16, 2010

### **SPEECHES**

- "IP Enforcement and Litigation 2011: Civil and Criminal Update" Practising Law Institute, March 30, 2011

### **EVENTS**

- How to Legally Protect Your Brand
- Got GOTS?
- How to Legally Protect Your Brand in the New Millennium
- Digital Media Law Forum: Building Brands In a Digital World