



PAUL W. GARRITY

Partner

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PRACTICE AREAS

- Intellectual Property

INDUSTRIES

- Advertising
- Digital Business
- Fashion, Apparel and Beauty
- Outsourcing
- Social Media
- Video Game
- Wine

OVERVIEW

Mr. Garrity is a partner in the Intellectual Property Practice Group in the firm's New York office.

Areas of Practice Mr. Garrity concentrates his practice on intellectual property litigation. He has litigated disputes involving trademarks, patents, false advertising, trade secrets, copyrights, dilution, trade dress, parallel imports and counterfeiting. He has successfully represented clients in the areas of dietary supplements, pharmaceuticals, packaging systems, residential furnishings, power generation, luxury goods, cosmetics and consumer products, and a wide range of technologies, including digital video compression, on-line advertising networks, and financial services software. Mr. Garrity has substantial trial experience, having handled jury trials, bench trials, and evidentiary hearings for preliminary injunction motions, as well as Markman patent claim construction hearings. He has litigated intellectual property cases in courts throughout the country, including in the U.S. District Courts for the District of Delaware, the Southern District of New York, the District of Massachusetts, the Northern District of California, and the Eastern District of Texas. Additionally, Mr. Garrity has represented clients in matters before the Food and Drug Administration, the National Advertising Division of the Council of Better Business Bureaus, the United States Patent and Trademark Office and the World Intellectual Property Organization.

EDUCATION

- J.D., Vermont Law School, 1994
- B.A., College of the Holy Cross, 1989

ADMISSIONS

- New York, 1996
- Connecticut, 1996
- U.S. Court of Appeals – Federal Circuit
- U.S. District Court – Southern, Western, and Eastern Districts of New York

EXPERIENCE

Representative Experience:

Imaginal Systems v. Leggett & Platt, Simmons Bedding Co. (C.D. Cal. 2012)
Trial counsel for Imaginal in patent litigation involving manufacture of box springs. Won multimillion dollar verdict at jury trial; pursuing post-judgment remedies.

Goodrich Corp. v. Sojitz Aerospace America (Amer. Arb. Assoc. 2012)
Representing Goodrich in \$25mm claim arising from reconnaissance system for F-15 aircraft.

Alcon Pharmaceuticals Ltd. v. Perrigo Co. (N.D. Tex. 2012)
Lead counsel for Perrigo in ANDA litigation re PATANASE® (olopatadine hydrochloride).

Merial LTD and BASF Agro BV v. Cipla Limited, Velcera, Inc., Fidopharm, Inc. (Fed. Cir. 2011; M.D. Ga. 2011)
Appellate counsel for Cipla, largest Indian pharma, in dispute involving patent infringement and contempt issues concerning veterinary products containing fipronil and methoprene.

Bayer Healthcare LLC v. Cipla Limited et al. (S.D.N.Y. 2011)
Counsel for Cipla in trademark and unfair competition dispute involving veterinary products containing imidacloprid and permethrin.

Healthy Source LLC v. Atlantic Coast Media Group (Dist. NJ 2011) Defended nutritional supplement marketer in search engine advertising case. Case settled by plaintiffs after venue transfer.

CIF Licensing v. Lenovo Group (S.D.N.Y. 2011)
Represented Lenovo in patent infringement suit involving MPEG-2 digital video compression and transmission standards.

Cartier International AG v. Philippe's Watches (C.D. Cal. 2011)
Represented Cartier and Panarei in action against gray market retailer.

10th Avenue Hospitality v. AMC Entertainment (S.D.N.Y. 2010)
Defended leading theater operator and national real estate developer against trademark infringement claims. Case settled after denial of plaintiff's TRO motion.

Cartier International AG v. American Exchange (S.D.N.Y. 2010)
Represented Cartier in trade dress and design patent infringement litigation resulting in destruction of watches, injunctive relief, and disgorgement of profits.

Rexall Sundown Inc. v. Perrigo (E.D.N.Y. 2010)
Lead trial counsel for Perrigo, a manufacturer of OTC pharmaceutical and nutritional products, in a four week false advertising jury trial involving glucosamine chondroitin dietary supplements. Jury verdict in Perrigo's favor on all claims asserted by Rexall, and awarding monetary damages against Rexall on Perrigo's counterclaims.

Bayer Schering Pharma AG et al. v. Sandoz, Inc. et al. (S.D.N.Y., Dist. Nev.)
Counsel to Sandoz in ANDA litigations re YASMIN® and YAZ® (Drospirenone/Ethinyl Estradiol) oral contraceptives.

Wyeth v. Novartis Consumer Health (NAD 2009)
Represented Novartis in advertising challenge before the National Advertising Division of the Council of Better Business Bureaus.

Physician Formulas v. Orexis (C.D. Cal. 2009)
Defended nutritional supplement marketer in search engine advertising case. Case settled by plaintiffs at argument of client's motions *in limine* before trial.

DGG Properties v. Giovanni's (D. Conn. 2009)
Defended family-owned restaurant in trademark infringement action. Settlement following successful *Daubert* motion excluding plaintiff's expert testimony.

PortfolioScope v. Oracle (D. Mass. 2008)
Trial counsel to Oracle Financial Services Software Ltd. in a lawsuit alleging infringement of software source code. Case settled during Oracle's cross-examination of plaintiff's witnesses at jury trial.

Net Ratings, Inc. v. TACODA Inc. (S.D.N.Y. 2009)

Defended leading on-line behavioral targeting advertising network against patent infringement claims. Case dismissed before *Markman* briefing.

Valentino v. MGA Entertainment (E.D.N.Y. 2007)

Defended toy manufacturer in a trade dress and copyright infringement action. Case was dismissed by the plaintiff following early discovery and motion practice.

Illinois Tool Works v. Pactiv (S.D. Ind. 2007)

Defended manufacturer of packaging machinery against patent infringement claims. A global settlement was negotiated after *Markman* briefing and argument.

Google v. American Blind & Wallpaper (N.D. Cal. 2007)

Litigation counsel in closely-watched search engine advertising case. Case settled after successful oppositions to both Google's motion to dismiss Lanham Act counterclaims and a subsequent motion for summary judgment.

Levi Strauss v. Polo Ralph Lauren (S.D.N.Y. 2007)

Defended leading apparel company in trade dress infringement claims arising from pocket stitching designs.

Monster Cable v. Tecmo (T.T.A.B. 2006)

Represented a trademark owner in multiple consolidated proceedings before the Trademark Trial and Appeal Board. Petition to cancel client's registration was denied and oppositions to client's applications were dismissed.

CMSI, Inc. v. Pacific Cycle, Inc. (W.D. Wash. 2006)

Defended a distributor of SCHWINN motor scooters from claims of reverse passing off under the Lanham Act. Case was dismissed with prejudice after denial of plaintiff's preliminary injunction motion.

NFL Properties LLC v. AllAuthentic Corp. (S.D.N.Y. 2006)

Defended a sports memorabilia manufacturer in trade dress infringement suit. Settlement was entered upon conclusion of discovery and hearing on cross-motions for summary judgment.

Dixie NYC Inc. v. Leisure Holdings (S.D.N.Y. 2006)

Defended a national restaurant operator against trademark infringement claims made by a former partner. Settlement following denial of plaintiff's TRO motion and expedited discovery from plaintiff.

Tecmo Inc. v. Greiling et al. (N.D. Ill. 2005)

Lead counsel in the prosecution of copyright infringement and DMCA violations against computer hackers modifying client's video game computer software. Permanent injunctions were entered against individual hackers located through Web message board.

Tekni-Plex Inc. v. Tenneco Inc. et al. (W.D.N.Y. 2004)

Defended a polystyrene foam sheet manufacturer in patent infringement suit. Following *Markman* ruling construing claims in client's favor, summary judgment entered dismissing plaintiff's claims in their entirety.

Arch Personal Care Prods. v. Malmstrom et al. (D.N.J. 2004)

Intellectual property counsel to trial team representing plaintiff in six-week jury trial resulting in a \$7.1 million dollar verdict for, *inter alia*, trademark infringement and unfair competition. Case of first impression in New Jersey under the Computer Fraud and Abuse Act.

Sun Chlorella USA Corp. v. Swanson Health Prods., Inc. (S.D.N.Y. 2003)

Represented plaintiff in trademark infringement, unfair competition and false advertising action against former U.S. distributor. Following motion for preliminary

injunction, defendant changed name, packaging trade dress and advertising claims.

Honeywell Int'l Inc. v. ABB Inc. (Fed. Cir. 2003)

Obtained an emergency stay from the Federal Circuit followed by a judgment vacating preliminary injunction entered against defendant in patent infringement suit involving the design of a turbocharger.

HONORS

- Mr. Garrity was a member of the pro bono team at Sheppard Mullin receiving the *2011 Frankel Award* from Human Rights First for their successful representation of Abdalmageed Haroun, a prominent human rights activist and former Sudanese prisoner. In the Sudan, Mr. Haroun's work focused on women's rights, the plight of internally displaced refugees, and the victims of the conflict in Darfur. As a result of his selfless and heroic efforts, Mr. Haroun was detained for months, persecuted, tortured, and threatened with death by the Sudanese government, forcing him to flee the country. The firm represented Mr. Haroun in connection with his application for asylum in the United States.
- *Chambers USA: America's Leading Lawyers for Business* (Leading Individual, Intellectual Property), 2010, 2011
- *New York Super Lawyers*, 2009, 2010, 2011

MEMBERSHIPS

- Connor Inn of Court
- American Bar Association
- The Association of the Bar of the City of New York, IT Committee
- New York Intellectual Property Law Association, Chair, Committee on Trade Secrets Law and Practice
- International Trademark Association, Parallel Imports Committee, Roundtables Committee

ARTICLES

- "High Tide For False Patent Marking Claims?" *Metropolitan Corporate Counsel Magazine*, July 2011
- "Legal Ethics and The Social Network," *Social Media Law Blog*, November 2010
- "Advertising Regulation in the Web 2.0 World," *Metropolitan Corporate Counsel*, November 2010
- "Brand Protection on Social Networking Sites," *Search Engine Strategies*, August 2009
- "Valuing Brands: Trying to Make the Vague Precise," *The National Law Journal*, October 13, 2008
- "Did 'Roommates.com' Nix Consumer-Made Web Content?" *New York Law Journal*, May 23, 2008
- "Who Owns The Website?" *The Intellectual Property Strategist*, May 2008
- "Perfect Storm: Contributory Trademark Infringement in Electronic Commerce," *BNA's Patent, Trademark & Copyright Journal*, February 22, 2008
- "Search Engine Advertising 101," *Metropolitan Corporate Counsel*, March 2007
- "Keyword Advertising: The Second Circuit Stands Alone," *State Bar News*, Jan/Feb 2007
- "Avoid Getting Caught in the Web," *Bright Ideas*, Winter 2006
- "Online Trademark Infringement or 'Nominative Fair Use'?" *New York Law Journal*, October 16, 2006
- "Federal Circuit Decisions Place a Premium on Lawyering," *New York Law Journal*, October 17, 2005
- "The Use or Non-Use of Trademarks in Pop-Up Advertising and Keyword Advertising," *The NYIPLA Bulletin*, March/April 2005

Notable Quotes

- "Q&A with Sheppard Mullin's Paul Garrity," *Law360*, July 18, 2011

SPEECHES

- "Closing Argument, *Christian Louboutin v. Yves Saint Laurent*, The Functionality Doctrine," Inn of Court, Honorable William C. Conner, SDNY, April 24, 2012
- "Social Media Marketing," Stafford CLE Webinar, September 20, 2011
- "Is Grey the New Black? Parallel Imports and Counterfeits in the Online Marketplace," 1st Annual Fashion Law Institute Symposium: Global Growth and Legal Landscapes, Fordham Law, April 15, 2011
- "*Orphan Copyright Owners v. Goliath Book Publisher*," The Hon. William C. Conner Inn of Court, April 13, 2011
- Guest Lecturer, Georgetown University Law Center, "Law of Advertising," November 2010
- "Emerging Trademark Threat @ Twitter, Facebook, MySpace," Stafford CLE Webinar, October 28, 2010
- "Are You Protecting Your Trade Secret Assets," CLE Program, October 29, 2009
- "Live From the Courtroom - Trying Consumer Protection and Privacy Litigation," Spring Meeting of the American Bar Association Section on Antitrust Law, Washington, DC, March 26, 2008
- "Trademarks in Business Transactions," INTA Roundtable, January 23, 2008
- "Electronic Discovery in Practice," Cardozo Law School, October 8, 2007
- "Trademark Computer Systems," INTA Annual Meeting, May 2, 2007
- "Third Party Uses of Trademarks," Fordham Law Int'l IP Law and Policy Conference, April 13, 2007
- "Legal Issues in Marketing and Advertising," INTA Roundtable, January 24, 2007
- "The Great Keyword Debate," NYSBA, Intellectual Property Law Section, October 14, 2006
- "E-Discovery: Opportunities and Challenges," International Technology Law Association Bangalore, India, February 1, 2006
- "Internet Advertising," Computer Law Association, October 27, 2005
- "Is Your Brand Name at Risk," CLE Program, June 15, 2005
- "Corporations Sue Google Over Results for Competitors," NPR Radio, Morning Edition, February 8, 2005
- "False Advertising Under the Lanham Act and State Law," CLE Program, January 29, 2004

EVENTS

- Beware The New Patent Trolls - Strategies For Handling and Avoiding False Patent Marking Claims after *Forest Group v. Bon Tool*