



→ Paul Bost

Special Counsel
1901 Avenue of the Stars
Suite 1600
Los Angeles, CA 90067

T: +1.310.228.2249
F: +1.310.228.3960
pbost@sheppardmullin.com

Paul Bost is special counsel in the firm's Intellectual Property Practice Group in the firm's Century City office.

Areas of Practice

Paul manages and participates in all aspects of federal and state court pre-litigation and litigation. The vast majority of these cases are trademark, copyright, and right of publicity actions. Additionally, Paul manages trademark portfolios, clearance, and prosecution for clients in a variety of industries.

Honors

2011 Man of the Year Runner-Up, Leukemia & Lymphoma Society, Los Angeles Chapter

Experience

- *Fifty-Six Hope Road Music Ltd. v. Sandal Factory, Inc.* – Prevailed in TTAB proceeding opposing registration of defendant's GNARLY MARLEY'S mark.
- *James Todd Smith v. Guerilla Union, Inc.* – Obtained default judgment in favor of plaintiff pka LL Cool J for infringement of his ROCK THE BELLS mark.
- *In re Shabby Chic Brands, LLC* – Effectively obtained reversal of Trademark Trial & Appeal Board's refusal to register client's mark based on 15 U.S.C. § 1052(b).
- *Concorde Battery Corporation v. Air 1st Aviation Companies, Inc.* – Trademark Trial & Appeal Board case; obtained settlement on behalf of client whereby defendant agreed to abandon a trademark application and amend the goods of its registration.
- *Mycoskie, LLC v. Ebuys, Inc. d/b/a Shoe Metro* – Settled case for defendant internet shoe retailer – accused of copyright infringement – for a fraction of plaintiff's original demand.
- *Huf Worldwide, LLC v. Wal-Mart Stores, Inc.* – Successfully obtained dismissal pursuant to FRCP 12(b)(6) on plaintiff shoe manufacturer's trademark infringement and counterfeiting claims.
- *Scat Enterprises, Inc v. FCA US LLC* – Defended Big 3 automaker against infringement claims brought by performance auto parts manufacturer.
- *Verwest v. T-Mobile USA, Inc.* – Represented DJ Tiesto in proceeding against T-Mobile before the Trademark Trial & Appeal Board.
- *Icon Laser Solutions v. Macy's* – Obtained successful and efficient settlement of patent claims against client at the advent of litigation.

- *Rohn v. CafePress* – Obtained successful and efficient settlement of trademark claims against client at the advent of litigation.
- *Fifty-Six Hope Road Music Limited v. A.V.E.L.A., Inc.* – Successfully obtained jury verdict on Lanham Act false endorsement claim for client, the heirs of Bob Marley, against defendant for its unauthorized use of Bob Marley's image on clothing and other merchandise.
- *Summit Entertainment, LLC v. B.B. Dakota, Inc.* – Successfully obtained summary judgment for client, the producer of the *Twilight* motion pictures, on claims of trademark infringement, false endorsement, and copyright infringement against clothing manufacturer for its use of the TWILIGHT trademark and movie artwork in conjunction with one of its products.
- *Bath & Body Works Brand Management, Inc. v. Summit Entertainment, LLC* – Successfully defeated summary judgment motion filed by declaratory judgment plaintiff claiming non-infringement of client's *Twilight* series of motion pictures by plaintiff's brand TWILIGHT WOODS.
- *Summit Entertainment, LLC v. Topics Entertainment, Inc.* – Successfully obtained preliminary injunction of infringing motion picture.
- *Matheu v. Wood* – Defended musician and painter Ron Wood against allegations of copyright infringement.
- *Summit Entertainment, LLC v. Preferred Fragrance, Inc.* – Obtained judgment for client against seller of infringing fragrance products.
- *RCRV, Inc. v. Express, Inc.* – Defended national clothing retailer and clothing designer against allegations of trademark infringement.
- *Lions Gate Entertainment Inc. v. Yagoozon, Inc.* – Obtained settlement, including stipulated judgment with permanent injunction, on behalf of client against online seller of infringing merchandise.

Mr. Bost has been counsel of record on a number of cases that have been the subject of reported decisions, including:

- *Fifty-Six Hope Road Music, Ltd. v. A.V.E.L.A., Inc.*, 778 F.3d 1059 (9th Cir. 2015) (affirming jury verdict for client on Lanham Act claims based on infringement of Bob Marley's identity and persona)
- *Paleteria La Michoacana, Inc. v. Productos Lacteos Tocumbo S.A. de C.V.*, 247 F. Supp.3d 76 (D.D.C. 2017) (disposing of defendant's various post-trial motions)
- *Paleteria La Michoacana, Inc. v. Productos Lacteos Tocumbo S.A. de C.V.*, 188 F. Supp.3d 22 (D.D.C. 2016) (order on bench trial entering judgment for client for claim of declaratory judgment of non-infringement and claim that defendant infringed client's design mark)
- *Bath & Body Works Brand Management, Inc. v. Summit Entertainment, LLC*, 7 F. Supp.3d 385 (S.D.N.Y. 2014) (summary judgment denied in favor of client Summit Entertainment, LLC)
- *Fifty-Six Hope Road Music, Ltd. v. A.V.E.L.A., Inc.*, 915 F. Supp.2d 1179 (D. Nev. 2013) (client Fifty-Six Hope Road Music, Ltd. awarded attorneys' fees on Lanham Act claims)
- *Summit Entertainment, LLC v. B.B. Dakota, Inc.*, 2011 U.S. Dist. LEXIS 151582 (C.D. Cal. Nov. 21, 2011) (summary judgment granted in favor of client Summit Entertainment, LLC on claims for trademark infringement, false designation of origin, unfair competition, and copyright infringement)
- *Fifty-Six Hope Road Music, Ltd. v. A.V.E.L.A., Inc.*, 688 F. Supp. 2d 1148 (D. Nev. 2010) (client Fifty-Six Hope Road Music, Ltd.'s Lanham Act claims based on infringement of Bob Marley's identity and persona upheld)

Articles

- Persona Rights on Trial: Inside the Nevada Litigation by Bob Marley's Heirs Against the Unauthorized Use of Marley's Image, *Entertainment Law & Finance*, March 2011

Intellectual Property Law Blog Posts

- "U.S. Supreme Court Rules that Profits Available Even from Non-Willful Trademark Infringers," April 23, 2020
- "The Federal Circuit Reconsiders the Inherent Distinctiveness of Color Marks in *In re Forney*," April 21, 2020
- "Cesari S.R.L. v. Peju Province Winery L.P.: Relying on Supreme Court Precedent, District Court Holds that Trademark Trial & Appeal Board Finding of Likelihood of Confusion has Preclusive Effect," December 26, 2017
- "*Warren Distribution, Inc. v. Royal Purple, LLC* – What's in a Name?" January 25, 2016
- "Summary of Recent Precedential Trademark Trial and Appeal Board Decisions," October 13, 2015
- "Summary of recent Precedential Trademark Trial and Appeal Board Decisions," September 29, 2015
- "Summary of Recent Precedential Trademark Trial and Appeal Board Decisions," September 15, 2015
- "Summary of Recent Precedential Trademark Trial and Appeal Board Decisions," June 2, 2015
- "Are Circuit Courts of Appeal Split as to the Preclusive Impact Accorded to Prior Trademark Trial and Appeal Board Decisions?" January 27, 2014
- "*Kraft v. Cracker Barrel*: A Summary of Judge Posner's Opinion and an Alternative Reverse Confusion Theory of Liability," December 2, 2013

Speaking Engagements

"Brunetti & Beyond: Deciphering the SCOTUS Decision on Scandalous & Immoral Trademarks," Beverly Hills Bar Association, August 15, 2019

"Survey of Recent Developments in Trademark Law," Mattel, February 21, 2019

"Intellectual Property in 2018: A Practical Survey of Recent Developments, Pending Issues, and Gray Areas in Trademark, Copyright, and Right of Publicity Law," Fullscreen Media, March 22, 2018

"False Endorsement by Bob Marley and Issue Preclusion Based Upon TTAB Decisions," SoCal IP Institute, March 30, 2015

Memberships

Former Chair, Copyright and Trademark Committee – Los Angeles Intellectual Property Law Association

Member, Right of Publicity Committee – International Trademark Association

International Trademark Association

ELIPS – Entertainment Law and Intellectual Property Section of the Los Angeles County Bar Association

Practices

Intellectual Property

Copyrights

False Advertising, Lanham Act and Unfair Competition

IP Licensing, Technology and Commercial Transactions

Trademark Applications and Prosecution

Trademarks and Trade Dress

Education

J.D., Vanderbilt University Law School, *Scholastic Excellence Awards in Wills and Trusts and Advanced Copyright Seminar, Dean's List*

B.A., Pepperdine University

Admissions

California