

Marc A. Lieberstein

Partner

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Services

Brand Licensing & Related

Transactions

Clearance & Portfolio Management

Contracts & Commercial

Agreements

Copyright Litigation & Counseling

Franchising

Intellectual Property

Trademark, Copyright &

Advertising

Industries

Media & Entertainment

Retail & Consumer Goods

Marc is the co-chair of the Franchise Group and Retail & Consumer Goods industry team. His practice focuses on intellectual property licensing and franchising in the retail/consumer goods and services areas, fashion/apparel and accessories, food and beverage, and commercial/industrial design, including the drafting, negotiation, and enforcement of license and franchise documents and agreements, as well as implementation of branding and commercialization objectives for clients via licensing and franchising. In conjunction with the services above, Marc counsels clients on creating effective strategies for procuring, protecting, and enforcing their global intellectual property assets. Marc has also participated in and used alternative dispute resolution forums such as arbitration and mediation to enforce intellectual property rights and resolve license and franchise contractual disputes. Marc frequently lectures and writes on intellectual property and franchise issues for a variety of intellectual property and franchise organizations and publications, including International Trademark Association (INTA), New York State Bar Association Intellectual Property Section, and the American Bar Association Forum on Franchising, *The Franchise Lawyer*, *Franchise Law Journal*, *National Law Journal*, *IP Strategist*, *The New York Law Journal*, *Practical Law*, *The Licensing Journal*.

Marc is listed in the 2022 and the 11 immediately preceding editions of *World Trademark Review 1000 – The World's Leading Trademark Professionals*. He was recognized as a New York "Super Lawyer" in Intellectual Property by *Super Lawyers* magazine in 2022 and the 12 years immediately preceding, and he was named a Top 100 New York Metro "Super Lawyer" for Intellectual Property in 2020, 2021 and 2022 and also in 2018 and the six years immediately preceding. Marc was recognized in 2020, 2021, 2022 and 2023 by *The Best Lawyers in America*® for Franchise Law. He has been recognized as an "IP Star" in 2022 and the nine years immediately

preceding by *Managing Intellectual Property* magazine. In 2017, 2018, 2019 and 2020, Marc was recognized by *Who's Who Legal* as a Global Leader for Franchising and Trademarks. He was named a franchise "Legal Eagle" in 2022 and the four years immediately preceding by *Franchise Times*. Marc was also recommended by *Legal 500 US* in 2015, 2016, 2017 and 2018 for Copyright and in 2019, 2020 and 2021 for Non-Contentious Trademark Law. In 2013, he received the Lexology *Client Choice Guide - International 2013* Award and is the sole winner in the Intellectual Property: Copyright category for New York. Marc was also listed in the 2012 and the four years immediately preceding editions of *Chambers USA: America's Leading Lawyers for Business* for Intellectual Property: Trademark & Copyright. *Chambers* noted that Marc has "tremendous business savvy and is tenacious in his work ethic," according to his clients (2012).

INTA honored Marc with the Volunteer Service Award (VSA) in the Advancement of Committee or Subcommittee Objectives category. The VSA recognized Marc in 2015 for providing exemplary volunteer service to INTA. As a member of INTA's Alternative Dispute Resolution Committee's Neutral Standards & Measurement Subcommittee, Marc made a tremendous impact by volunteering both his time and expertise to support the Association's goals and objectives. Marc also received the 2015 Commitment to Justice Award presented by Her Justice recognizing his pro bono work in representing a client who sought help in terminating her arranged marriage. Through skillful negotiation, without any court intervention, Marc secured for the client a divorce on terms very favorable to her and to her children. He is a recipient of the Kilpatrick Townsend 2014 Pro Bono Justice Award. Marc is also a recipient of the 2015 Cardozo Law School Alumni of the Year Award recognizing Marc's leadership and dedication to Cardozo Alums and students.

Representative Clients: MOMOFUKU, FUKU, S'WELL BOTTLE, STETSON, HANESBRANDS, FIGS, FLOWERS FOODS, COMPASS GROUP, EXPRESS SERVICES, MAX BRENNER, RIVER STREET SWEETS-SAVANNAH'S CANDY KITCHEN, EPIC KITCHEN, ON THE BORDER, and BILLY REID.

Experience

Provide franchise advice and counsel, including preparation of Franchise Disclosure Document, Franchise Agreement, as well as related developer and other agreements, along with franchise registration, renewal and update services to numerous clients in the food beverage and consumer services areas. Representative clients include: FLOWERS FOODS; EXPRESS SERVICES; EPIC KITCHEN; THE JUICY CRAB; ZIPPY'S RESTAURANTS; FUKU; RIVER STREET SWEETS – SAVANNAH'S CANDY KITCHEN; MAXIMIZED LIVING, PUTT-PUTT.

Provide advice and counsel concerning licensing and related brand transactions, such as manufacturing, supply and distribution agreements, as well as provide global trademark, copyright and patent portfolio and enforcement services to S'well Bottle Company.

Provide global trademark, copyright and patent portfolio and enforcement services to Nuance Communication.



Provide global trademark and copyright portfolio and enforcement services to Helen Keller Services.

Provide advice and counsel concerning licensing and related brand transactions, such as manufacturing, supply and distribution agreements, as well as provide global trademark, copyright and patent portfolio and enforcement services to Hudson's Bay Companies.

Provide advice and counsel concerning licensing and related brand transactions, such as manufacturing, supply and distribution agreements, as well as provide global trademark, copyright and patent portfolio and enforcement services to John B. Stetson Company.

Provide advice and counsel concerning licensing and related brand transactions, such as manufacturing, supply and distribution agreements, as well as provide global trademark, copyright and patent portfolio and enforcement services to Momofuku Group.

Provide advice and counsel to a North American clothing manufacturer, designer, and retailer, including draft, revise and audit for international Retail and eCommerce Agreement templates, as well as provide counsel concerning disputes with licensees around the world, and draft and negotiate product supply and services agreements, social media influencer agreements, and trademark merchandise and co-branding license agreements.

Served as co-lead counsel in an international arbitration proceeding for plaintiff licensor JA Apparel Corp. against a Chinese licensee. After conducting a full trial on liability, we successfully obtained an arbitral award confirming the termination of the licensee, 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. The arbitration award was later formally recognized by the Shanghai Number One Intermediate People's Court.

Provide advice and counsel in areas of trademark and copyright to global manufacturer, designer and supplier of wallcovering products, including trademark and copyright licensing, registration and clearance.

Advice and counsel in areas of patent, trademark and copyright to Economic Development Resource Guide, a provider of state-of-the-art consulting services and software products, for measuring economic development performance, impact and opportunity for transportation and infrastructure projects, energy programs and projects, and commercial and industrial development.

Brand licensing and counsel to Osram Sylvania, one of the largest lighting and materials companies in the world with a long-standing reputation of providing solutions in homes, businesses, institutions, and automobiles, to



provide advice on brand licensing programs, audit and update license agreement terms, as well as brand licensing and protection strategy.

Brand licensing and counsel to one of the world's leading manufacturers and marketers of tissue, packaging, paper, pulp, building products and related chemicals, to provide advice on brand and technology licensing program, audit and update license agreement terms, as well as licensing and brand protection strategy.

Provide advice and counsel to Patty Madden Inc., leading designer of wallcovering patterns, including trademark and copyright counsel, licensing and clearance.

Provide patent, trademark and copyright advice and counsel to Mavenir Systems Inc. (formerly Comverse Technology Inc.), a leading mobile telecommunications software provider, including matters related to Open Source software.

Represented PayFlex Systems USA, Inc. in trademark infringement litigation against Sensei Inc., a health care technology company. PayFlex had previously hired Sensei as a software development consultant for PayFlex's new product, "HealthHub," a healthcare benefits planning and management mobile tool. A year later, PayFlex discovered that Sensei had launched its own nearly identical benefits management product, coincidentally named "Health Hub." Once we filed a complaint Sensei immediately agreed to stop use of the Health Hub mark and signed a consent judgment, including a permanent injunction. Case settled. PayFlex Systems USA, Inc. v. Sensei, Inc. et al., No. 8:11-cv-00265 (D. Neb. filed Aug. 2, 2011).

Retained to defend independent software developer on a pro bono basis against former law firm employer that alleged copyright infringement, fraud, breach of fiduciary duty and trade secret theft. Negotiated a favorable settlement for the software developer that resulted in a dismissal of all claims, as well as permitting the software developer to sell the accused software product. Esbin & Alter, LLP v. Zappier et al., No. 1:08-cv-00313 (S.D.N.Y. filed Jan. 14, 2008).

Successfully represented copyright owner and designer of wallcovering patterns against infringer manufacturer. After discovery, the matter was resolved with a monetary settlement agreement and a permanent injunction. RJF Int'l Corp., et al. v. U.S. Vinyl Mfg Corp., et al., No. 1:06-cv-04021 (S.D.N.Y. filed May 25, 2006).

Successfully represented Design Tex Group, Inc., copyright owner and designer of wallcovering patterns, against infringer manufacturer. The matter was quickly resolved with a settlement agreement that procured a monetary settlement and a permanent injunction. Design Tex Grp., Inc. et al. v. Fidelity Indus. et al., No. 1:05-cv-00008 (S.D.N.Y. filed Jan. 3, 2005).

Successfully represented Colour & Design, Inc., copyright owner and designer of wallcovering patterns, against



infringer manufacturer. After extensive discovery, the matter was resolved with a monetary settlement agreement, a permanent injunction on several designs, and a business arrangement for other designs. *Colour & Design, Inc. v. U.S. Vinyl Mfg Corp et al.*, No. 04-8332 (S.D.N.Y. filed Oct. 21, 2004).

Successfully represented Design Tex Inc. and designer Patty Madden in a copyright infringement action. The District Court granted summary judgment finding not only copyright infringement, but also finding the corporation and its president jointly and severally liable. Damages included not only the maximum \$150,000 statutory award allowed, but also attorney fees under the Copyright Act. *Design Tex Group, Inc. v. U.S. Vinyl Manufacturing Corp.*, 76 U.S.P.Q.2d 1946, 1949 (S.D.N.Y. 2005). *Laminating Serv. Inc. v. U.S. Vinyl Mfg. Corp. et al.*, No. 1:04-cv-07728 (S.D.N.Y. filed Sept. 29, 2004).

Successfully represented defendant, Andin International Inc., owned by Aya Azrialant, a jewelry designer accused of copyright infringement of a mother child pendant design copyrighted by the plaintiff. After a full trial on the merits, the court found no substantial similarity and ruled in favor of the defendant. *Sandberg and Sikorski Corp. v. Andin International, Inc.*, 51 U.S.P.Q.2d 1574 (S.D.N.Y. 1999).

Represented Chromalloy Gas Turbine Corp. in connection with an appeal of a district court ruling that the employee owned the invention. On appeal, the Federal Circuit reversed and found in favor of the employer because the employee was "employed to invent." *Chromalloy Gas Turbine Corp.*, the largest business unit of Sequa, provides the airline industry with a broad range of aftermarket services and ranks as the leading independent supplier of advanced repairs for jet engine parts. *Teets v. Chromalloy Gas Turbine Corp.*, 83 F.3d 403 (Fed. Cir. 1996).

Education

Benjamin N. Cardozo School of Law J.D. (1992)

State University of New York, University at Albany B.A. (1989) History, Minor in Business, *cum laude*

Admissions

Connecticut (1992)

New York (1993)

Court Admissions

U.S. Court of Appeals for the Federal Circuit (1995)

U.S. Court of Appeals for the Second Circuit (2000)

U.S. District Court for the Eastern District of New York (1992)

U.S. District Court for the Southern District of New York (1992)



U.S. Supreme Court (2005)

Professional & Community Activities

Benjamin N. Cardozo School of Law, Alumni Association Pro Bono Committee, Former Chair (2010-2014); Alumni Association, Former Chairperson (2006-2010); Career Development Committee, Former Chair

International Trademark Association (INTA), Commercialization of Brands Committee, Sub-Committee Chair for Licensing (2020-); Brands & Innovation Committee (2018); ADR Committee (2013-2017); Neutrals Standards and Measurements Sub-Committee, Chair (2014); Amicus Committee, Member (2012-2013); Law Firm Committee, Chair (2010-2011); Programs Committee, Member (2005-2010); Programs and Standards Subcommittee, Chair (2007-2010); E-Learning Committee, Member (2004); INTA Annual Meeting Project Team, Member (2003 and 2005)

New York State Bar Association, Intellectual Property Law Section, Honorary Member and Former Section Chair (2002-2004); Litigation Committee, Co-Chair (2006-present); Trademark Law Committee, Former Co-Chairperson (1998-2002); Business Law Section, Franchise, Distribution and Licensing Law Committee, Member (2014-present)

American Bar Association, Intellectual Property Section, ABA Forum on Franchising, Member (2013-present)

Association of the Bar of the City of New York, Fashion Law Committee, Member (2012-present), Chair (2014-2017); Intellectual Property Council Representative (2013)

Hebrew Academy of Nassau County (HANC), Board of Directors (2010-2012)

Young Israel of Plainview, Board of Trustees (2010-2012); Former Vice President of Fundraising (2007-2008); Little League Director (2004-present)

Unchained At Last, Board of Directors, Member (2018); Board of Directors, President (2022)

Foundation for Art & Healing, Board of Directors (2018)

Insights

Publication

Cybersecurity: Franchisors and Franchisees Beware

August 26, 2022

News Releases

Kilpatrick Townsend Earns Top Recognitions in 2023 Edition of The Best Lawyers in America®

August 18, 2022

Perspectives

5 Key Takeaways | Doing Business in the Metaverse: Everything Your Other CLEs Didn't Tell You

August 15, 2022



Perspectives

3 Key Takeaways | 2022 Edition: Is Franchising Doomed?

July 12, 2022

News

Webinar | Doing Business in the Metaverse: Everything Your Other CLEs Didn't Tell You

June 30, 2022