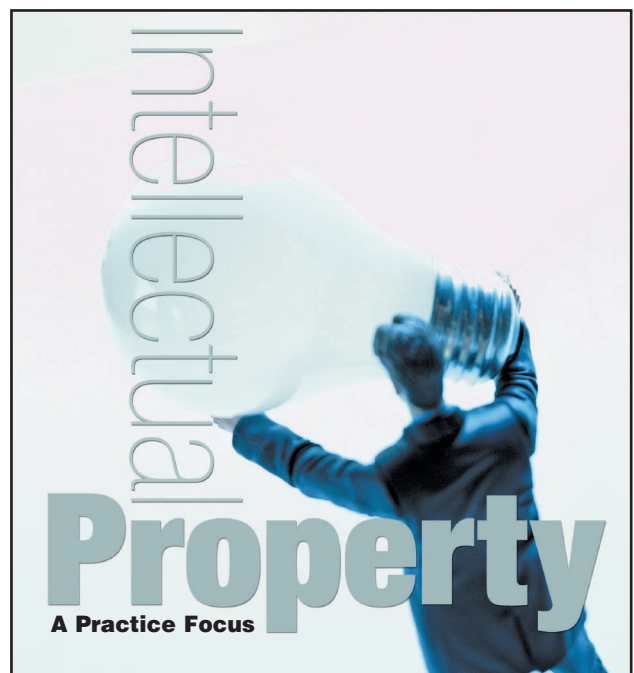


Identifying **10** Leading Copyright and Trademark Attorneys

Copyright and trademark law—some call them the softer side of intellectual property. Or wait! Does that infringe the Sears trademark? These 10 lawyers could answer that one in their sleep. (Answer: No. One-time use. Confusion highly unlikely.)

Theirs is an increasingly sophisticated practice area. Where copyright owners once fretted about photocopying, users now can make an infinite number of perfect digital copies. Trademark wars have also moved to cyberspace, where misspelling a domain name might lead children to hard-core porn.

Yet practitioners say their work is more interesting than ever, with issues of first impression



popping up everywhere. The big question remains the same: “If you can’t protect your IP, what do you own?”

Leading LAWYERS

Ten of the D.C. Area's Top Copyright and Trademark Attorneys

Charles Ossola

Dickstein Shapiro

If you want to punch out the Geico gecko, you'll have to get by Charles Ossola first.

The Government Employees Insurance Co. is one of Ossola's longtime clients, and protecting the company's English-accented spokes-lizard from trademark abuse—in one case, literal abuse—is his responsibility.

Ossola, a 54-year-old partner at Dickstein Shapiro, has a diverse intellectual property practice that includes copyright and patent litigation in addition to trademark work. Over the years, he's been tapped by clients, including PepsiCo. and General Electric Co., to handle precedent-setting litigation.

But one of his biggest tasks has been helping Geico build and protect its highly successful gecko and cavemen trademarks. "Chuck has been our point man on all of Geico's IP work," says assistant general counsel Jonathan Shafner.

According to Shafner, Ossola advises the company on protecting its trademarks, structuring related deals, and litigating a number of cases, most of them brought by Geico. "Some of the cases have been very significant ones," says Shafner, "and he's helped us protect the huge investment we've made."

Geico spends hundreds of millions of dollars a year on its trademarks, and the gecko was voted America's favorite icon in a 2005 *Advertising Week* poll.

Shafner describes Ossola himself as "very responsive" and "a great sounding board" who has "done a terrific job of guiding us."

In 2006, Ossola came to the gecko's rescue when a Texas insurance broker ran a commercial where he kicked and strangled a person in a gecko suit. Geico filed suit in Dallas federal court for trademark infringement. The broker, Alvin Boenker, argued the use was allowable because it was a parody, but as Ossola notes, "In a commercial setting, there's very little latitude to use someone else's trademark to promote your business." The case was resolved via consent order in 2007, with Boenker agreeing to stop the commercials.

The highest-profile matter Ossola has handled for Geico was a trademark infringement suit against Google Inc., filed in 2004 in U.S. District Court for the Eastern District of Virginia. The insurance company objected that when a user typed "Geico" into Google's search engine, the results included advertisements sponsored by Geico's competitors. "Essentially they were selling Geico's trademark to competitors to trigger their own ads," Ossola says.

The trial was ongoing when the case settled under confidential terms in 2005, but not before Judge Leonie Brinkema held that Google's practice did constitute "trademark use" within the meaning of the federal trademark statute.

"It was an important precedent which not only confirmed Google's use was actionable under the trademark laws, but also that the placement of the Geico mark in the sponsored listing was likely to confuse consumers," Ossola says.

Another case that presented an issue of first impression was *Kelly v. Arriba Soft Corp.* Ossola argued on behalf of commercial photographer Leslie Kelly that a Web site operator's unauthorized use of Kelly's full-sized images infringed his exclusive right to display his work under the Copyright Act. In 2002, the U.S. Court of Appeals for the 9th Circuit agreed, although the three-judge panel subsequently retreated from the decision in 2003 on procedural grounds.

Ossola also rode to a photographer's rescue in a dispute over an advertisement for Skyy Vodka. In 2000, he convinced the 9th Circuit that Joshua Ets-Hokin's photo—a blue bottle of vodka against a starkly lit background—was original enough to warrant copyright protection.

Victor Perlman, general counsel of the American Society of Media Photographers, says Ossola "has a great grasp of substantive law and a very strong sense of the practical realities and political realities." Perlman also praises him as "a great writer." For more than a decade, Ossola has been special copyright counsel to the group, offering strategic counseling and penning a series of amicus briefs.

Over the years, Ossola has handled a variety of copyright and trademark issues for Pepsi, including *Takeall v. PepsiCo.* In 1993, the 4th Circuit rejected a ventriloquist's assertion that the phrase "You Got the Right One, Uh-Huh," used by the ventriloquist in his act but made famous by Ray Charles in Pepsi commercials, was entitled to copyright protection.

Ossola received his law degree from Villanova University School of Law in 1978 and then clerked for U.S. District Judge Albert Bryan Jr. in the Eastern District of Virginia. After a brief stint with Hunton & Williams in Washington, D.C., he moved to the Justice Department in 1981 to work in the Civil Division's appellate section. He returned to Hunton & Williams in 1983, where he remained for 10 years until he joined now-defunct IP boutique Lowe, Price, LeBlanc & Becker. In 1998, he moved to Arnold & Porter, and in January 2008, he joined Dickstein. Colleagues there include Philip Hampton II, who was assistant commissioner for trademarks at the U.S. Patent and Trademark Office from 1994 to 1998.

