



NEIL B. FRIEDMAN

Partner

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Neil has extensive experience in intellectual property law. His practice concentration includes trademark prosecution, trademark management of international portfolios, trademark enforcement and anti-counterfeiting, licensing and transactional agreements, and intellectual property litigation before U.S. federal courts and the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office.

Neil regularly counsels clients and businesses regarding the adoption of their trademarks, branding techniques and strategies, advertising, and social media issues. Additionally, Neil regularly handles sending and responding to cease and desist letters, resulting settlement agreements, coexistence agreements, and letters of consent, as well as customs recordations and anti-counterfeiting work, including:

- creating brand manuals;
- trademark and copyright recordation program for IP owners;
- tracking counterfeit seizures for potential civil and criminal actions;
- investigations of counterfeiters and testing of counterfeit goods;
- cease and desist letter work that develops into civil court actions;
- assisting local authorities and prosecutors with search warrants and arrests;
- assisting U.S. Attorney's Office in Manhattan, New Orleans, and Los Angeles in the prosecution of counterfeiters of clients' products;
- preparation of victim impact statements and obtaining restitution for clients.

When disputes arise, Neil's experience, knowledge base, and hands-on and attentive approach render him well positioned to obtain cost-effective results for his clients.

Prior to joining Hodgson Russ, Neil was partner at an intellectual property law firm with offices in New York City and New Jersey. There, he was responsible for the management of the trademark portfolios for a variety of companies, both domestically and internationally. Neil also served for five years as a senior assistant

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Practices & Industries

Business Litigation
Copyrights
Food & Beverage
Intellectual Property & Technology
Intellectual Property Litigation
Intellectual Property Portfolio Management
Trademark & Domain Name Registration
Trademark Oppositions and Cancellations
Website Agreements, Cloud Computing & Social Media
Wine, Beer & Spirits

Admissions

New York
New Jersey
U.S. District Court, Eastern District

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district attorney in Suffolk County, New York, where he was responsible for the investigation and prosecution of trademark counterfeiting, computer crimes, and other white collar crimes.

Honors

- Notes and comments editor, *Touro International Law Review*
- American Jurisprudence Award for Academic Excellence in Contracts II
- West Publishing Corpus Juris Secundum Award for Excellence in Contracts II

Experience

Assist client in connection with trademark advice and strategy in dealing with Chinese trademark pirates.

Handled copyright (protect product packaging and artwork) and trademark (brand name and packaging designs) for a major international wine company and a large kosher food company.

Defeated motion for a preliminary injunction involving rival law firm advertising campaigns.

Defended client in a cancellation action involving a registration dating back from 1921 and simultaneously commenced a parallel opposition proceeding against adverse party.

Defended client in a trademark and copyright infringement action in New Jersey District Court. We were able to:

- Obtain insurance coverage for the client
- Commence a parallel Trademark Trial and Appeal Board action against the plaintiff
- Obtain a favorable settlement of all proceedings

Defended design patent infringement action involving jewelry designs for several large jewelry manufacturers and distributors.

Defended large clothing company against claims of trademark infringement and trade dress infringement and simultaneously sought to enforce an existing trademark coexistence agreement.

of New York

U.S. District Court, Southern District of New York

U.S. District Court, Western District of New York

U.S. District Court, District of New Jersey

U.S. Court of Appeals, Federal Circuit

U.S. Court of Appeals, Second Circuit

U.S. Court of Appeals, Third Circuit

Education

Queens College, City University of New York, B.A.

Touro College Jacob D. Fuchsberg Law Center, J.D., cum laude



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Defended sports & entertainment client against a cease and desist letter and threatened opposition from adverse party involving the client's signature trademark used in conjunction with the trademark portfolio. We were able to obtain a favorable settlement and coexistence.

Defended trademark infringement action for major clothing company in the Southern District of New York.

Development of trademark strategies and management of the international trademark portfolio for clients including a major alcohol beverage company, major sportswear company and major dairy company.

Obtained a favorable settlement involving a trademark applicant in connection with political speech website and a line of clothing. The case progressed from trademark watch services, to a cease and desist letter, negotiations, threatened opposition proceedings, an eventual settlement whereby the applicant transferred domains to our client, abandoned his applications and agreed to change the phrase.

Negotiated celebrity endorsement and co-branding agreement with a well-known celebrity.

Negotiated fragrance license agreement with clothing company.

Obtained a favorable settlement involving a trademark applicant in connection with education and entertainment services. The case progressed from trademark watch services, to a cease and desist letter, negotiations, threatened opposition proceedings, an eventual settlement whereby the applicant transferred his domains and trademark filings to our client.

Defended copyright infringement actions for large internet media company and obtained favorable settlements for client.

Obtained a preliminary injunction in the SDNY against an infringer that infringed upon our client's trademarks, copyrights and patents. Our client is a furniture designer that decorated the Green Room at the Oscars.

Assisted client in responding to a cease and desist letter, threatened and commenced opposition proceedings in the US and EU involving the client's decision to change its name. The adverse party claimed that their company name and the proposed new client name were likely to be confused on similar goods. As a result of our intervention and response, the adverse party withdrew all claims and dismissed all actions against our client in the United States and the European Union. The client went forward with its name change.

Prosecuted opposition proceeding for client. Adverse party had filed trademark applications in the US and EU. We negotiated favorable settlement and coexistence agreement.

Commenced enforcement action for copyright infringement in the Southern District of NY in connection with artwork on tableware and successfully defeated motion to dismiss.

Represented a large kosher wine company in connection with a trademark acquisition agreement.

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In the News

Thought Leaders: Employees can help protect a company's intellectual property
Buffalo Business First, May 9, 2022

Can China's fraudulent trademark registration in the United States eliminate subsidies?
VOA, June 27, 2021

Publications

Supreme Court Resolves Split Among The Circuits: No Time Limits on Monetary Recovery for any Timely Copyright Infringement Claim

Hodgson Russ Intellectual Property Litigation Alert, May 15, 2024

The Battle After *Warhol*: Tattoos as Artwork or Infringement?
Hodgson Russ Intellectual Property Litigation Alert, April 24, 2024

AI Lawsuit May Eclipse Claims of Fair Use
Hodgson Russ Intellectual Property Litigation Alert, April 5, 2024

New York State Liquor Authority Moves to Tackle Backlog of Items
Hodgson Russ Wine, Beer & Spirits Practice, November 29, 2023

Music Copyrights on a Roll – Read and Listen to Hear the Latest
Hodgson Russ Intellectual Property Litigation Alert, October 6, 2023

Taco Bell Throws Its Hat in the Ring to Free “Taco Tuesday” from Trademark Protection
Hodgson Russ Intellectual Property Litigation Alert, May 30, 2023

What’s in Your “Secret Sauce?” The FTC’s Proposed Rule to Ban Noncompetes and Considerations for Food and Beverage Businesses
Hodgson Russ Food & Beverage Alert, May 3, 2023

Copyright Claims of Cosmetic Company Continue to Trial
Hodgson Russ Intellectual Property Litigation Alert, March 23, 2023

Chick-fil-A Confirms Data Breach
Hodgson Russ Food & Beverage Alert, March 20, 2023

USPTO Warns of New Phone Scams Targeting Trademark Filers
Hodgson Russ Intellectual Property & Technology Alert, February 7, 2023

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Presentations & Events

Trademarks 101: Considerations to Keep in Mind when Forming a New Company or Food Establishment
March 11, 2021

What Nordic Companies Need to Know to Protect Their Intellectual Property Interests in the U.S.
November 8, 2018

NY Law School Fashion Law Symposium 2016: Fashion Brand Protection Initiatives and Anti-Counterfeiting in the Digital Age
New York Law School, 185 West Broadway, New York, NY, October 21, 2016

Intellectual Property Law Society & The Fashion Law Society: Trademarks and Anti-Counterfeiting
Touro Law Center, Long Island, New York, NY, April 13, 2016

Let Your Assets Shine: Diamonds, Jewelry, Patents, Trademarks™, and Copyrights ©
New York Diamond Dealers Club, 580 5th Ave, New York, NY, March 16, 2016

Professional Affiliations

- International Trademark Association

