

Chester Rothstein

Partner



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Chester Rothstein's clients see him as a business advisor as well as a litigator. He gets inside the business of his clients—whether they are toy makers, shoemakers, restaurants, or celebrities; whether startups or retail giants. He identifies, obtains, and secures IP rights; enforces rights through negotiation and litigation; and defends infringement claims. He also negotiates brand licenses and conducts IP diligence and valuations in connection with transactions.

Identifying and obtaining IP rights: At the design and planning phase, Mr. Rothstein advises on the IP aspects of naming, product design, manufacturing, and marketing to maximize the strength of IP protections and limit vulnerability to competitor challenges. He counsels clients on identifying what can be protected through trademarks, utility or design patents, copyrights, and trade dress. Simultaneously, he assesses the protectable rights of third parties so that his clients' products or services do not infringe. For example, a number of his clients design and manufacture toys and consumer products. He advises them on available protection for innovative features as well as for the ornamental appearance, whether from patent, trademark, trade dress, or similar rights. A high-end shoe company's designs are often imitated. He worked with management to identify which new styles were most likely to be knocked-off, and obtained expedited design patents to prevent harm from imitations being sold and/or imported. In the hospitality and restaurant industry, which often pits local uses against national expansions, he helps clients choose and acquire marks and protect them from dilution and infringement. For a major U.S. retail department store, he handles private label brand counseling and enforcement.

In trademark practice before the US Patent and Trademark Office, he handles all aspects of the prosecution docket, where he routinely is able to successfully persuade the Examining Attorney to withdraw initial substantive rejections, for example where it is argued that a mark is merely descriptive or likely to be confused with a prior registered mark.

In the utility patent field, Mr. Rothstein works closely with engineers in his firm to advise clients on the protection of inventions and to strategically draft patent applications to obtain the broadest patents possible.

Enforcement and litigation: Mr. Rothstein is involved in all aspects of enforcing rights and defending claims, and has argued before numerous district courts and the Second Circuit Court of Appeals. For example, he has been involved in numerous litigations in the multibillion dollar jeans industry asserting and defending claims over issues such as the ornamental appearance of portions of the apparel. On behalf of European book publishers, he authored an amicus brief on the legal issue of whether procedural requirements under U.S. law violate the Berne (copyright) Convention. He handles enforcement of rights outside the United States to stop third-party competitors, vendors, and distributors from registering competing

designs and marks that might preclude manufacturing in certain foreign manufacturing centers. He negotiates, drafts, and advises on manufacturing, licensing, and distribution agreements to protect rights through the U.S. and international supply chain.

Due diligence and valuation: In financings, secured transactions, and mergers and acquisitions, intellectual property can be the most valuable collateral or asset. Mr. Rothstein advises borrowers, lenders, buyers, and sellers about the special issues that arise from assigning complete rights and perfecting security interests in intangible property. For instance, he was an advisor where hundreds of brands of beer were combined under single ownership; where venerable toy marks were acquired by companies intending to rejuvenate them; and where fashion and fragrance brands were used as collateral by lenders.

Rights of publicity, privacy and licensing: He counsels entertainers, designers, personalities and artists with regard to rights of publicity, copyright, trademarks, contractual terms and brand protection in the United States and internationally.

EDUCATION

- Albany Law School of Union University, Albany, New York
- Skidmore College, Saratoga Springs, New York

REPRESENTATIVE CLIENTS

- BR Guest Restaurants (Blue Water Grill, Ocean Grill, Ruby Foos, Dos Caminos, etc.)
- Dylan's Candy Bar
- Paco Sport, Ltd.
- ISI Brands (Twinlab)
- Stuart Weitzman
- Pepe Jeans London
- Town & Country Linen Corp.
- 4 Kids Entertainment
- Prime Time Toys

BAR ADMISSIONS

- New York, 1991
- U.S. District Courts for the Southern, Eastern, and Western Districts of New York

AMICUS BRIEFS

- **Brief of Amici Curiae, in *B & B Hardware, Inc. v. Hargis Industries, Inc.*, (U.S. October 31, 2014)**
October 31, 2014

IN THE PRESS

- **In The Press:**
IP Law 360 Quotes Partner Chester Rothstein as expert on recent case law: "Design Patent Law Still Murky Post-Egyptian Goddess"
Design Patent Law Still Murky Post-Egyptian Goddess, IP Law360, Wednesday, March 24, 2010

PUBLISHED WORKS

- **Lanham Act constitutionality affirmed as six federal REDSKINS-based trade marks are cancelled**
- Journal of Intellectual Property Law & Practice (2015) doi: 10.1093/jiplp/jpv199 First published online: November 27, 2015
- **Trade Mark Tacking A Factual Question For The Jury**
- Journal of Intellectual Property Law & Practice (2015) doi: 10.1093/jiplp/jpv041
- **ARE Trademark Law Alert: US Court of Appeals Finds Lanham Act Prohibition of Registration of Disparaging Trademarks to Be Unconstitutional**
- **ARE Trademark Law Alert: Supreme Court Holds TTAB Decisions May Have Preclusive Effects**
- **ARE Trademark Law Alert: Supreme Court Finds Trademark Tacking to be a Factual Question for the Jury**

PUBLISHED WORKS CONT.

- **ARE Copyright Law Alert: Aereo Raises A New Defense Following the Supreme Court Decision**
- **ARE Copyright Law Alert: Supreme Court Finds Aereo Performs Copyrighted Works Publicly As Prohibited Under The Copyright Act**
- **ARE Patent Law Alert: Supreme Court Holds FDA Labeling Regulations Do Not Preclude Lawsuits Under the Lanham Act**
June 12, 2014
- **ARE Trademark Law Alert: Supreme Court Outlines Rules for Standing to Sue Under the Lanham Act**
March 25, 2014
- **ARE Copyright Law Alert: Supreme Court Reverses Second Circuit, Holds "First Sale" Doctrine Applies To Copies Of Copyrighted Works Made Abroad**
March 19, 2013
- **ARE Trademark Law Alert: Louboutin v. YSL: Second Circuit Allows Single Color as a Fashion Trademark**
September 6, 2012
- **ARE Domain Name Alert**
June 20, 2012
- **Egyptian Goddess v. Swisa: Revising The Test**
- IP Law360, September 23, 2008