

Neil M. Zipkin Partner



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Neil M. Zipkin, a mechanical engineer by training, assists clients in obtaining and enforcing mechanical and design patents, trademarks and copyrights; negotiating complex licenses, non-disclosure agreements and employment agreements; and monetizing their intellectual property rights.

He has litigated patent, trademark and copyright cases in federal courts throughout the United States and in state courts in New York and New Jersey. Recognizing that most cases in the intellectual property area are resolved by settlement, Mr. Zipkin is also certified as a mediator.

In the fashion and apparel industry, he represents clients on IP issues involving e-commerce and information systems as well as the design and distribution of merchandise. He won the landmark case establishing that designs incorporated into apparel could be protected by copyright, a case that went to the Second Circuit and set the standard for copyright infringement of designs in the clothing industry. In a recent reported case involving copyright and trade secrets, he represented a retailer in a dispute over the pricing algorithm used on an Internet site to undercut in real time the prices charged by a competitor.

Toys—especially the ones that interact, spin, light up, make noise, calculate and emit sound—are as interesting to a mechanical engineer/IP lawyer as they are to their intended audience. Patent, trademark and copyright issues abound. He represented the largest publisher of children’s books, including musical and sound books, in numerous cases where competitors attempted to infringe copyright, mechanical and design patents, and trademarks.

His experience encompasses products ranging from heavy manufacturing, consumer electronics, printing, food processing, decorative lighting, clothing, dental products and processes, chinaware and flatware, technical fabrics, air conditioner compressors installed in automobiles, boat hull designs, parachutes, home décor items to pickles—he was a key player in the pickle wars in lower Manhattan when a company bought the lease, but not the trademark GUSS’, for a store selling pickles, and proceeded to do business under that iconic brand name.

His advocacy enabled a china manufacturer to compete with an established manufacturer and distributor of china used in hotels following a dispute over whether a basket-motif design is protectable, a case that went to the U.S. Court of Appeals. He prevailed on summary judgment in a case in which he represented a manufacturer asserting its patent for “twinkling” holiday lights.

He was a key player in a complex dispute between the Communications Workers of America and Verizon and Verizon Wireless regarding the “can you hear me now” trademark; a dispute over which dressage horses may be called a “Holstein” horse; design patents over cell phone chargers; and method and business patents involved in the distribution of highly precise copiers relying on heat-transfer printing imported to the United States from Japan. Mr. Zipkin also represents clients before governmental agencies to prevent the importation of goods bearing counterfeit trademarks or copyrights.

EDUCATION

- St. John’s University School of Law, Queens, New York, 1973, J.D.
- St. John’s University Law Review 1971-73, Associate Notes Editor, 1972-1973
- Long Island University, Greenvale, New York, 1970, M.S., Management Engineering/Operations Research
- Rensselaer Polytechnic Institute, Troy, New York, 1967, BME, Mechanical Engineering

CERTIFICATION AND SPECIALTIES

- Certified Mediator, International Institute for Conflict Prevention and Resolution, 2006
- Registered Patent Attorney, United States Patent and Trademark Office, 1974

PROFESSIONAL ASSOCIATIONS & MEMBERSHIPS

- American Bar Association, Intellectual Property, Litigation Sections
- New York State Bar Association, Nassau County Bar Association
- Nassau County Bar Association
- New York Intellectual Property Law Association

PROFESSIONAL EXPERIENCE

- Hazeltine Electronics, Mechanical Engineer, 1967-1970

AWARDS & HONORS

- Intellectual Property, Intellectual Property Litigation, Alternative Dispute Resolution, *Super Lawyer*, 2013, 2014
- Robert C. Watson Award of the AIPLA (formerly known as the APLA) for patent literature, 1974

BAR ADMISSIONS

- U.S. Court of Appeals for the Federal Circuit 1990
- U.S. Court of Appeals for the Second Circuit, 1989
- U.S. District Courts for the Southern and Eastern Districts of New York, 1974
- New York, 1974

REPRESENTATIVE CASES

- *Allure v Ulu*, 104 U.S.PQ 2d 1131 (SD Ohio 2012) Represented defendant Goldia and Ulu in successful motion to dismiss copyright, trade secret and unfair competition action
- *Sienna LLC v. CVS Corp. and Everstar Merchandise Co., Ltd.*, 2007 U.S. Dist. LEXIS 2 (Jan. 3, 2007). Represented Sienna in patent infringement action against competitor and customer. Sienna granted summary judgment of patent infringement and defendants consented to a permanent injunction.
- *Dan-Dee International, Ltd. v. Atico et al.* (EDNY 2003). Represented plaintiff copyright owner in action charging defendants with infringement; case settled with defendants discontinuing sale of

REPRESENTATIVE CASES CONT.

- product and paying damages.
- *Knitwaves Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (2d Cir. 1995). Represented successful plaintiff in copyright infringement action relating to designs on wearing apparel. Defendant enjoined and recovery of damages and counsel fees awarded to client.
- *Matsushita Electric Industrial Co. Inc. v. Solar Sound*, 381 F.Supp. 64 (SDNY 1974). Represented successful plaintiff in unfair competition action establishing that use in commerce satisfied by defendant’s use of deceptive trade dress.
- *Cellco Partnership v. Communication Workers of America*. 2003 U.S. Dist. LEXIS 26823 (DNJ 2003). Represented defendant Union charged with trademark infringement based on use of “Can You Hear Us Now?”; defendant’s motion to dismiss granted.
- *Western Publishing v. Rose Art (DNJ)*. Represented plaintiff Western Publishing (Golden Books) in litigation charging patent, trademark and copyright infringement and trade dress violation; case settled with defendant removing product from market.
- *Ivy Hill (Time Warner) v. Gerald Design (SDNY)*. Represented plaintiff in trade secret case; case settled defendant discontinued conduct.

REPRESENTATIVE CLIENTS

- Altech Co., Ltd.
- Citrus and Allied Essences Ltd.
- Dan Dee International
- KidDesigns, Inc.
- Panasonic
- Rainforest, Inc.
- Robert Bowne Foundation, Inc.
- Sango Corp.
- Sienna LLC.
- Stanley Blacker Inc.
- SYMS
- Time Warner
- Whiteflash, Inc.
- World of Golf

PUBLISHED WORKS

- **Infringement and Assembly Abroad**
47 St. Johns L.Rev. 662

IN THE PRESS

- **In The Press:**
5 ARE Attorneys Named *Super Lawyers* Again
- Super Lawyers, October 8, 2014