

Retail MVP: Gibson Dunn's Robert Weigel

By Aebra Coe

Law360, New York (November 12, 2015, 4:08 PM ET) -- Gibson Dunn & Crutcher LLP's Robert Weigel won more than \$1 billion in trademark judgments for retail clients in 2015, but perhaps more importantly secured precedential victories that pave the way for protecting U.S. intellectual property from counterfeiters abroad, earning him a spot on Law360's list of retail MVPs.

In August, Weigel and a team of Gibson Dunn litigators secured a \$1 billion judgment for Nike Inc. and Converse Inc. against 466 Chinese counterfeiters who had operated hundreds of websites targeting U.S. consumers. He also won three separate judgments against counterfeiters in China for Tiffany & Co. in the past year, totaling \$87.8 million.

Significantly, in addition to the dollar figures he pulled in for clients, Weigel went on to obtain judicial holds on the counterfeiters' bank accounts so that the money owed cannot simply disappear into thin air. By targeting where the money counterfeiters make flows — banks — Weigel has made strides in recouping damages for clients after winning judgments against often-elusive online global scofflaws

"The main challenge with all that is you're kind of grasping at fog when you're going after these counterfeiters because nothing on the website is true," Weigel said. "The pictures may be of real products, but they're likely taken from another site. The address is more than likely fake. The only thing that's real is where the money goes, because the money has to end up with the person selling the stuff."

After handing down the judgment in favor of Nike and Converse, a New York federal judge issued an opinion rejecting a motion by the Bank of China and several other Chinese banks asking him to reject a provision of the judgment requiring the counterfeiters' assets to be frozen on an ongoing basis, whether they are "located in the United States or abroad."

In another case, Weigel nabbed a precedential opinion from the Second Circuit affirming trademark judgments in favor of luxury brands like Tiffany and Gucci Group and affirming injunctions issued against the defendants, finding that the U.S. federal courts need not preliminarily establish personal jurisdiction over a nonparty bank, in this case the Bank of China, to restrain a defendant's assets.

The court found, among other things, that the United States' "powerful interest" in protecting intellectual property outweighed China's demonstrably limited interest in bank secrecy and that the bank's purported exposure to liability for producing the requested information was "unduly speculative."

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Robert Weigel
Gibson Dunn

According to Weigel, he's always been fascinated with how money moves and the incentives it provides. He participated in an economics program while in law school at the University of Chicago. He said he was able to see that the way counterfeiting on the Internet was previously being handled was not effective and wanted to come up with new strategies for clients.

"I looked at this and thought, there's got to be a better way," Weigel said. "We've come up with this idea of 'follow the money.' The money has to end up back at the person who sells the stuff."

He's been following the money for a number of years now by going after banks that aid and abet counterfeiters and the strategy has met with a good deal of success.

"Part of it is trying to figure out what you can do to stop these people if they're going to thumb their nose at the U.S. courts," he said. "I try and find creative solutions that actually have a chance of working. Something that might actually have an impact in terms of recovering damages for a client and causing the counterfeiters to think twice about doing it."

Right now Weigel is working on a case combating counterfeit goods involving Chinese Internet giant Alibaba Group. He brought litigation and obtained a temporary restraining order on behalf of Gucci America Inc. and several other companies against a group of online merchants allegedly selling counterfeit products through a family of websites.

But he didn't stop there. In May, Gibson Dunn brought an additional complaint on behalf of clients against Alibaba itself, asserting claims of contributory trademark infringement and counterfeiting for allegedly knowingly allowing the merchants to sell counterfeits, as well as direct federal trademark infringement and dilution claims related to Alibaba's use of the plaintiffs' trademarks.

"The internet has shrunk the world, people can sit anywhere in the world and sell things into the U.S. and, in case of Alibaba, using very sophisticated set of platforms," Weigel said. "What's going to be fascinating is how that plays out in terms of the things that merchants want to sell that are not permissible to sell in the U.S.: the impact of people using the analytical tools that big data provides to promote sales by counterfeiters."

--Editing by Kelly Duncan.

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