



***FOLLOWERS, FANS  
AND FRIENDS:  
CURRENT  
INTELLECTUAL  
PROPERTY TRENDS  
SURROUNDING THE  
USE OF SOCIAL MEDIA***

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# Social Media = User Generated Content

- Figures
  - Facebook = 500 million users
  - Twitter = 175 million users
  - Linked In = 70 million users
- Most Trafficked Sites
  - 1 – Google
  - 2 – Facebook
  - 4 – YouTube
  - 8 – eBay

# Social Networking Sites

- Brand owners use social networking sites

The collage features several elements:

- Facebook Screenshot:** Shows the CNN Facebook page with the CNN logo, navigation tabs (Wall, Info, Events, Discussions, Video, Photos), and a news post about American missionaries.
- Twitter Screenshot:** Shows the CNN Twitter profile page with the CNN logo, a follower count of 6 of 765,502 fans, and a tweet retweeted from @CNNMoney.
- Virtual World:** A 3D environment with a sign that reads "Welcome to CNN iReport Island!" and "You've probably stopped by because you're interested in Second Life news and stories. That's what we're all about!". A character named "Lynn Wickentower" is visible, and a red "iReport" cube is on the ground.
- Promotional Banner:** A red banner with the CNN logo and text: "Hey there! CNN is using Twitter. Twitter is a free service that lets you keep in touch with people through the exchange of quick, frequent answers to one simple question: What's happening? Join today to start receiving CNN's tweets. Join today!"
- Twitter Profile Card:** A detailed view of the CNN Twitter profile, including the name "CNN", website "http://www.cnn.com", bio "Breaking News, U.S., World, Weather, Entertainment & Video News", 234 tweets, 924,797 followers, and 12,198 following.

# Social Media Issues

- Use of marks on pages or in apps
  - *Hasbro, Inc. v. RJ Softwares* (S.D.N.Y.)
  - *Grooms v. Legge* (S.D. Cal.)
- Unauthorized use in usernames
  - *Oneok, Inc. v. Twitter, Inc.* (N.D. Okla.)
  - *TDC International Corp. v. Burnham* (E.D. Mich.)
- Fake celebrity pages/impersonation
  - *La Russa v. Twitter, Inc.* (N.D. Cal.)
  - Twitter Verified Accounts  
(<http://twitter.com/help/verified>)
- Advertisements (keyword, content-based, other)
- Fan pages
- Gripe pages

# Virtual World Issues

- Lawsuits concerning trademark uses
  - Games
    - *E.S.S. Entertainment v. Rock Star Videos* (9<sup>th</sup> Cir.)
    - *Marvel Enterprises Inc. v. NCSoft Corp.* (C.D.Cal.)
  - Second Life issues
    - *Eros, LLC v. Simon* (E.D.N.Y.)
    - *Eros, LLC v. Doe* (M.D. Fla.)
    - *Minsky v. Linden Research, Inc.* (N.D.N.Y.)
- Consumer education campaigns



# Monitoring and Enforcement Issues

- What types of uses should be tolerated and for how long?
- What triggers monitoring or enforcement action?
- How aggressive should enforcement be?

# Build Social Media Into Brand Development Process

- Register mark in usernames
- Consider social media pages and groups that highlight the mark
- Plus trademark and domain name registrations

# Monitor Marks on Social Networking Sites

- Internal monitoring
- Services
  - Monitoring
  - Username registration
    - Some charge a flat fee for creating usernames with all of the available sites within a given range, for example, the top 50 or top 100 sites

# Decide Which Sites to Monitor

- Include the top five (Facebook, YouTube, Twitter, LinkedIn and MySpace)
- Include others as budget allows
- Monitoring services offer alternative packages covering different numbers of sites (for example, TM.biz offers packages like the top 50, 100 or 500)
- Monitor sites that offer the types of activities that may include relevant content:
  - Content-providing sites
  - Advertising sites
  - Blogs
  - Sites that sell products that might be counterfeit or gray market

# Enforcement - Prioritize

- Investigate and pursue
  - Posing as trademark owner's page
  - Infringements by competitors
  - Sale of counterfeit or gray market products
  - Seriously misleading content (e.g., "lead generators")
  - Clearly false statements
- Monitor and pursue if becomes more serious
  - Unauthorized but not clearly damaging
- Monitor but do not pursue
  - Fan pages
  - Critical sites but not false information
  - Other non-commercial information sites (e.g., reviews)

# Relevant Policies

## Facebook:

- *Advertising Guidelines*
- *Usernames: General Information*
- *Pages Terms*
- *Statement of Rights and Responsibilities*

## Twitter:

- *Trademark Policy*
- *Copyright and DMCA Policy*
- *Impersonation Policy*
- *The Twitter Rules*
- *Terms of Service*
- *Parody, Commentary and Fan Accounts Policy*

# Relevant Complaint Procedures

## Facebook:

- *How to Report Claims of Intellectual Property Infringement*
- *DMCA Notice of Copyright Infringement*
- *Notice of Intellectual Property Infringement (Non-Copyright Claim)*

## Twitter:

- *How To Report Violations*
- *How can we help? (impersonation, trademark and DMCA reports)*

# Documentation

- Communications with service provider and the direct actor
- Screen shots
  - Printout showing date of the print, and a screen capture showing greater detail
  - Page where offending content appears
  - Any linked site (relevant to content on landing page)
- Applies to content and advertisements

# Escalating the Issue

- Start with contacts at the service provider
- Cease and desist letter to the direct actor
  - Direct actor (often difficult to locate)
  - Service provider (secondary liability)
    - *Tiffany v. eBay* (Second Circuit), cert. denied by Supreme Court
- Lawsuit
  - Jurisdiction
  - Causes of action (infringement, unfair competition, dilution, false advertising, state claims such as right of publicity)
  - Defenses (First Amendment, fair use, CDA §230(c)(1) immunity)

# Recommendations

- Become familiar with the largest social media sites
- Establish a presence on key sites
- Develop a monitoring program
- Prioritize issues
- Start with the sites' policies and complaint procedures

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CURRENT INTELLECTUAL PROPERTY TRENDS SURROUNDING THE USE OF  
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**Appendix 1: List of cited cases**

*E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008)

*Eros, LLC v. Leatherwood, et al.*, Case No. 8:2007cv01158 (M.D. Fla. 2007)

*Eros, LLC v. Simon*, No. 1:07cv04447 (E.D.N. Y. filed Oct. 24, 2007)

*Grooms v. Legge*, No. 3:09-cv-00489-IEG-WVG (S.D. Cal. Apr. 8, 2009) (order on contempt petition)

*Hasbro, Inc. v. RJ Softwares*, No. 1:2008cv06567 (S.D.N.Y. 2008)

*La Russa v. Twitter, Inc.*, No. 3:09-cv-02503-EMC (N.D. Cal. 2009)

*Marvel Enterprises Inc. v. NCSOFT Corp.*, 74 U.S.P.Q.2d 1303 (C.D. Cal. 2005)

*Minsky v. Linden Research, Inc.* Case No. 1:08-cv-819-LEK-DRH (N.D.N.Y. 2008)

*ONEOK, Inc. v. Twitter, Inc.*, No. 4:09-cv-00597-TCK-TLW (N.D. Okla. 2009)

*TDC International Corp. v. Burnham*, No. 08-CV-14792 (E.D. Mich. Nov. 2, 2010) (order on renewed motion for order to show cause)

*Tiffany, Inc. v. eBay, Inc.*, 600 F.3d 93 (2d Cir.), cert. denied, 562 U.S. \_\_\_\_ (2010)

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**Appendix 2: Links to social media site policies and procedures**

**Sample Policies (Trademark, Advertising, Etc.)**

**Amazon:**

*Display Advertising Specifications and Format/Advertising Creative Policy*  
<http://www.amazon.com/Advertising/b/?node=276257011>

*Your Profile and Community Guidelines*  
<http://www.amazon.com/gp/help/customer/display.html?ie=UTF8&nodeId=14279631>

*Prohibited Content*  
[http://www.amazon.com/gp/help/customer/display.html/ref=hp\\_rel\\_topic?ie=UTF8&nodeId=200414300](http://www.amazon.com/gp/help/customer/display.html/ref=hp_rel_topic?ie=UTF8&nodeId=200414300)

**eBay:**

*Your User Agreement*  
<http://pages.ebay.com/help/policies/user-agreement.html>

*Community content policy*  
<http://pages.ebay.com/help/policies/member-created-content-ov.html>

*Rules about intellectual property – overview*  
<http://pages.ebay.com/help/policies/intellectual-property-ov.html>

**Facebook:**

*Advertising Guidelines*  
[http://www.facebook.com/ad\\_guidelines.php](http://www.facebook.com/ad_guidelines.php)

*Statement of Rights and Responsibilities*  
<http://www.facebook.com/terms.php?ref=pf>

*Pages Terms*  
[http://www.facebook.com/terms\\_pages.php](http://www.facebook.com/terms_pages.php)

*Usernames: General Information*  
<http://www.facebook.com/help/?page=897> Page

## **Google:**

### *Advertising Policies*

[http://adwords.google.com/support/aw/bin/static.py?hl=en&page=guide\\_toc.cs&path=policy](http://adwords.google.com/support/aw/bin/static.py?hl=en&page=guide_toc.cs&path=policy)

### *Misleading and inaccurate claims*

<https://adwords.google.com/support/aw/bin/static.py?hl=en&topic=28436&guide=28435&page=guide.cs&answer=190441>

### *AdWords Terms and Conditions*

<https://adwords.google.com/select/tsandcsfinder>

### *What is Google's trademark policy for resellers and informational sites?*

<https://adwords.google.com/support/aw/bin/answer.py?hl=en&answer=145626>

### *Google Groups Content Policy*

<http://groups.google.com/support/bin/answer.py?hl=en&answer=156856>

## **Twitter:**

### *Terms of Service*

<http://twitter.com/tos>

### *Twitter Rules*

<http://twitter.zendesk.com/forums/26257/entries/18311>

### *Trademark Policy*

<http://support.twitter.com/articles/18367-trademark-policy>

### *Copyright and DMCA Policy*

<http://support.twitter.com/groups/33-report-a-violation/topics/122-reporting-violations/articles/15795-copyright-and-dmca-policy>

### *Impersonation Policy*

<http://support.twitter.com/articles/18366-impersonation-policy>

### *Parody, Commentary, and Fan Accounts Policy*

<http://support.twitter.com/articles/106373-parody-commentary-and-fan-accounts-policy>

## **Sample Complaint Procedures**

## **Amazon:**

### *Report a Community Rules Violation*

[http://www.amazon.com/gp/help/customer/display.html/ref=hp\\_rel\\_topic?ie=UTF8&nodeId=200414340](http://www.amazon.com/gp/help/customer/display.html/ref=hp_rel_topic?ie=UTF8&nodeId=200414340)

*Report Form*

<http://www.amazon.com/gp/help/reports/contact-us>

**eBay:**

*Reporting Intellectual Property Infringement (VeRO)*

<http://pages.ebay.com/help/tp/vero-rights-owner.html>

**Facebook:**

*How to Report Claims of Intellectual Property Infringement*

[http://www.facebook.com/legal/copyright.php?howto\\_report](http://www.facebook.com/legal/copyright.php?howto_report)

*DMCA Notice of Copyright Infringement*

[http://www.facebook.com/legal/copyright.php?copyright\\_notice=1](http://www.facebook.com/legal/copyright.php?copyright_notice=1)

*Notice of Intellectual Property Infringement (Non-Copyright Claim)*

[http://www.facebook.com/legal/copyright.php?noncopyright\\_notice=1](http://www.facebook.com/legal/copyright.php?noncopyright_notice=1)

**Google:**

*AdSense Trademark Complaint Form (AdSense for Domains issues)*

[http://services.google.com/inquiry/afd\\_tmcomplaint](http://services.google.com/inquiry/afd_tmcomplaint)

*AdWords Trademark Complaint Form*

[https://services.google.com/inquiry/aw\\_tmcomplaint](https://services.google.com/inquiry/aw_tmcomplaint)

**Twitter:**

*How To Report Violations*

<http://twitter.zendesk.com/entries/15789-how-to-file-terms-of-service-or-rules-complaints>

*How can we help? (impersonation, trademark and DMCA reports)*

<http://twitter.com/help/escalate>



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J.D., University of Illinois College of Law, 1981

Georgetown University, School of Foreign Service, 1973-1975

B.A., Northwestern University, 1978

### ADMISSIONS

Illinois Supreme Court  
Supreme Court of the United States  
U.S. Court of Appeals, 2nd Circuit  
U.S. Court of Appeals, 7th Circuit  
U.S. Court of Appeals, 9th Circuit  
U.S. Dist. Court, C.D. Illinois  
U.S. Dist. Court, N.D. Illinois, Trial Bar

### PRACTICE SUMMARY

David S. Fleming, who chairs Brinks' Trademark Litigation Practice Group, handles trademark and unfair competition matters for clients in a wide range of service and manufacturing industries. His clients have included companies engaged in:

- Internet search engine services and other Internet-related businesses
- Motion picture services
- Consumer products
- Real estate brokerage services
- Travel-related services, such as, hotel and car rental services
- Financial services, including mortgage lending services, asset-based and other business lending services, and insurance and title services
- Cellular and other communications equipment manufacturing and marketing
- Truck manufacturing and automobile parts manufacturing services

Mr. Fleming is active in the International Trademark Association. Since January 2010, he has served on the Association's Board of Directors. He also serves on the Association's Programs Committee. Previously, he was co-chair of the team organizing INTA's 2007 Annual Meeting, which was held in Chicago. He also was co-chair of INTA's 2004 Trademark Administrators Program in Arlington, Virginia. In July, 2000, he served on the faculty for INTA's Trademark Trial Advocacy program in Chicago. He has been a member of the Editorial Board of The Trademark Reporter.

Mr. Fleming is one of two co-authors of *Trademark Litigation Practice*, which will be released by BNA Books in early 2011.

Mr. Fleming graduated from the University of Illinois College of Law in 1981, where he published in the University of Illinois Law Review. He began his career in commercial litigation, and since 1990, has concentrated his practice in trademark and unfair competition litigation.

### HONORS/DISTINCTIONS

- Illinois Super Lawyers, Intellectual Property Litigation, 2005-2010
- Leading Intellectual Property Lawyer, Leading Lawyers Network, Law Bulletin Publishing Company, 2004, 2005, 2007, 2009, 2010

Leading Lawyer, Computer & Technology Law, 2009

- Listed, "Guide To The World's Leading Trademark Law Practitioners," Euromoney Legal Media Group, 2002, 2009
- *University of Illinois Law Review*, University of Illinois College of Law

## REPRESENTATIVE MATTERS

### Federal and State Courts:

- *Dazzlesmile, et al. v. Epic Advertising, et al.*, Case No. 2:09-cv-01043-PMW (D. Utah). Represented Yahoo!, Inc. in trademark infringement suit relating to keyword advertisements. Settled.
- *NTN Corporation, et al. v. Mandas, et al.*, Case No. 2:10-cv-00257-JWS (D. Ariz.). Representing NTN Corporation in trademark infringement suit relating to counterfeit bearings.
- *Mary Kay, Inc. v. Yahoo! Inc.*, Case No. 3:09-cv-01278-M (N.D. Tex.). Represented Yahoo! in trademark infringement suit relating to shortcuts appearing in emails. Settled.
- *Yahoo! Inc. v. National Football League Players Association, Inc. et al.*, Case No. 09-cv-01272-PJS-FLN (D. Minn.). Represented Yahoo! Inc. in declaratory judgment action relating to right of publicity and fantasy football game. Settled.
- *International Information Systems Security Certifications Consortium v. Degraphenreed, et al.*, Case No. 2:07-cv-1195 (S.D. Ohio). Represented Yahoo! Inc. in trademark infringement dispute. Settled.
- *Heartbrand Beef, Inc. v. Lobel's of New York, LLC, et al.*, Case No. 6:08-cv-00062 (S.D. Tex.). Represented Yahoo! Inc., one of the defendants in a trademark infringement dispute. Dismissed.
- *Trilink Saw Chain, LLC, et al. v. Blount, Inc., et al.*, Case No. 1:07-CV-0409-CAP (N.D. Ga.). Represented Blount, Inc. in false advertising claim. Settled.
- *Bernini, Inc. v. Fragrancenet.com, Inc., et al.*, Case No. CV 06-4829 RGK (C.D. Cal.). Represented Yahoo! Inc. in trademark infringement dispute. Settled.
- *Munchkin, Inc. v. Wm. Wrigley Jr. Company*, Case No. CV 06-6342 PA (C.D. Cal.). Represented Wm. Wrigley Jr. Company in trademark infringement matter. Settled.
- *Children's Memorial Medical Center, Inc. v. Kid's Doc, S.C., et al.*, Case No. 1:06-cv-05844 (N.D. Ill.). Represented Children's Memorial Medical Center, Inc. in suit alleging trademark infringement. Settled.
- *JP Enterprises, Inc. v. Yahoo! Inc., et al.*, Case No. 06-cv-01046-REB-PAC (D. Col.). Represented Yahoo! Inc. in suit alleging trademark infringement. Settled.
- *Motorola, Inc. v. Razor USA, LLC*, Case No. 2198-N (Del. Chancery Ct. 2006). Represented Motorola in declaratory judgment action concerning license agreement. Settled.
- *Government Employees Insurance Company ("GEICO") v. Google, Inc. and Overture Services, Inc.*, Case No. 04-CV-507 (E.D. Va.). Represented Overture Services, Inc., an Internet search engine, in trademark infringement suit concerning bidding on search terms that include trademark of plaintiff. Settled.
- *R. J. Reynolds Tobacco Company, et al. v. Premium Tobacco Stores, Inc., et al.*, Case No. 99 C 1174 (N. D. Ill.), 462 F.3d 690,

(7th Cir. 2006). Gray market case; lead counsel for plaintiffs in trial of trademark claims, secured jury verdict finding, among other things, federal trademark infringement, unfair competition and willful dilution, and awarding \$3.5 million in defendant's profits; prejudgment interest later awarded. Affirmed on appeal.

- *Caterpillar, Inc. v. The Walt Disney Company*, Case No. 1:03-cv-01334 (C.D. Ill. 2003). Represented Caterpillar in connection with Disney's use of Caterpillar marks in film *George of the Jungle 2*. Settled.
- *Mark Nutritionals, Inc. v. Overture Services, Inc.*, Case No. SA-02-CA-0086 OG (W.D. Tex.). Represented Overture Services, Inc., an Internet search engine, in trademark infringement suit concerning bidding on search terms that include trademark of plaintiff. Settled.
- *Mark Nutritionals, Inc. v. AltaVista Company*, Case No. SA-02-CA-0087 EP (W.D. Tex.). Represented AltaVista Company, an Internet search engine, in trademark infringement suit concerning bidding on search terms that include trademark of plaintiff. Settled.
- *PlasmaNet, Inc. v. Overture Services, Inc.*, Case No. 02 CV 3075 (AGS) (S.D. N.Y.). Represented Overture Services, Inc., an Internet search engine, in trademark infringement suit concerning bidding on search terms that include trademark of plaintiff. Settled.
- *Robert Novak d/b/a Pets Warehouse, etc. v. Overture Services, Inc., et al.*, Case No. CB 02 5164 (E.D. N.Y.). Represented Overture Services, Inc., an Internet search engine, in trademark infringement suit concerning bidding on search terms that include trademark of plaintiff. Settled.
- *800-JR Cigar, Inc. v. GoTo.com, Inc., et al.*, Case No. 2:00 CV 03179 (D. N.J.). Represented Overture Services, Inc. (formerly GoTo.com, Inc.), an Internet search engine, in trademark infringement suit concerning bidding on search terms that include trademarks of plaintiff. Settled.
- *Federal Cartridge Co. v. Cyrus, Inc. d/b/a Federal Arms Corp. of Amer.*, Case No. 00-1569 (D. Minn., Fourth Division). Secured consent judgment on behalf of owner of FEDERAL mark in suit concerning use of name and mark FEDERAL ARMS for firearms.
- *GoTo.com, Inc. v. The Walt Disney Company, et al.*, 202 F. 3d 1199, 1207 (9th Cir. 2000). Secured preliminary injunction for GoTo.com, an Internet search engine, in trademark infringement suit concerning use of logo appearing on Web sites and television and in print media. Affirmed on appeal. Case settled for \$21.5 million following filing of contempt petition against defendants.
- *Sargent & Greenleaf, Inc. v. Masco Corporation, et al.*, Case No. 99-6 (E.D. Ky., Lexington Div. 1999). Secured preliminary injunction for manufacturer of dial and ring locks used on gun safes. Case subsequently settled.
- *R.J. Reynolds Tobacco Company, et al. v. Allstate Cigarette Distributors, Inc., et al.*, Case No. 99-348-CIV-T-25F (M.D. Fla., Tampa Div.). Secured consent judgments against various defendants in gray market cigarettes case.
- *Motorola, Inc. v. Fonorola Corporation*, Case No. 97 CV 9157 (RPP) (S.D. N.Y.). Trademark infringement action to prevent use of FONOROLA trademark for use with telephone services. Settled.

### **Recent Trademark Trial And Appeal Board Matters:**

- *Jonathan Drew, Inc. v. GMB, Inc.*, Opposition No. 91183057 (T.T.A.B.). Representing applicant for mark CAMEL CRUSH.
- *Danjaq, LLC v. Jason & Jean Products, Inc.*, Opposition No. 120,980 (T.T.A.B.). Represented owner of JAMES BOND and 007 service marks in opposition to application for registration of mark 007 HAIR WEAVING BOND. Summary granted in favor of client.
- *Danjaq, LLC v. Jason & Jean Products, Inc.*, Cancellation No. 31,532 (T.T.A.B.). Represented owner of JAMES BOND and 007 service marks in cancellation proceeding concerning registration of mark 007 WEAVING BOND. Summary judgment granted in favor of client.
- *Wm. Wrigley Jr. Company v. Lotte Co., Ltd.*, Opposition No. 115,237 (T.T.A.B.). Opposition to application for registration of mark LOTTE SPEAR MAX. Settled.
- *Wm. Wrigley Jr. Company v. Lotte Co., Ltd.*, Opposition No. 115,236 (T.T.A.B.). Opposition to application for registration of mark LOTTE JUICY MAX. Settled.
- *Danjaq, LLC v. LVIII Group, LLC*, Opposition No. 113,226 (T.T.A.B.). Represented owner of JAMES BOND and 007 service marks in opposition against application to register mark CLUB 007--A GENTLEMAN'S CLUB. Opposition sustained May 12, 1999.
- *Danjaq, LLC v. Double-O-Seven, Ltd.*, Cancellation No. 28, 013 (T.T.A.B.). Represented owner of JAMES BOND and 007 service marks in cancellation proceeding concerning registration of mark DOUBLE-OH-SEVEN, LTD. & Design. Cancellation granted August 16, 1999.
- *Navistar International Transportation Corp. v. Mack Trucks, Inc.*, Opposition No. 107,707 (T.T.A.B.). Opposition proceeding filed in 1997 against application to register truck grill design. Settled.

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- "eBay defeats Tiffany's counterfeit sales suit," *World Trademark*

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- "Second Circuit reignites US company's rights in COHIBA mark," *World Trademark Law Report*, Globe Business Publishing, April 14, 2005 (regarding *Empresa Cubana del Tabaco v. Culbro Corp.*).

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- “Honeywell’s circular shape mark given the cold shoulder,” *World Trademark Law Report*, Globe Business Publishing, August 1, 2003 (regarding *Eco Manufacturing LLC v. Honeywell International Inc.*).
- “Taxing ‘nominative fair-use’ issue forces district court to think again,” *World Trademark Law Report*, Globe Business Publishing, June 19, 2003 (regarding *JK Harris & Company LLC v. Kassef*).
- “Virginia dismisses Falwell’s cybersquatting suit,” *World Trademark Law Report*, Globe Business Publishing, May 22, 2003 (regarding *Falwell v. Cohn*).
- “Baby Bell company loses fight for ‘ebell’ domain names,” *World Trademark Law Report*, Globe Business Publishing, January 16, 2003 (regarding *SBC Communications Inc. v. eWorldWideWeb Inc.*).
- “Seventh Circuit overturns BEANIE BABY dilution decision,” *World Trademark Law Report*, Globe Business Publishing, December 12, 2002 (regarding *Ty Inc. v. Ruth Perryman*).
- “Copyright Law in the Digital Age,” Chapter 6, co-author, *Business, Law and the Internet: Essential Guidance For You, Your Clients and Your Firm*, Illinois Institute of Continuing Legal Education (ICLE), 2002.
- “IP: Trademarks/Unfair Trade Practice,” Chapter 7, co-author, *Business, Law and the Internet: Essential Guidance For You, Your Clients and Your Firm*, Illinois Institute of Continuing Legal Education (ICLE), 2002.
- “Wal-Mart Puts Pressure On Trade Dress Owners”, *Managing Intellectual Property*, May 2000, pp. 14-18.
- “Is U.S. Advertising Of Foreign Services ‘Use In Commerce’?” *Intellectual Property Worldwide*, Nov./Dec. 1998.
- “Intellectual Property Insurance,” *Managing Intellectual Property*, May 1998.
- Co-Author, Note, 84 *The Trademark Reporter* 620-621, September-October 1994, reviewing article entitled “Lever Bros. v. United States and the Legality of Gray Market Imports: A New Shield for United States Trademark Owners in Transnational Markets.”

## PRESENTATIONS

- "Trademark Issues with Social Networking Sites," (speaker), 12th Annual Utah IP Summit, Salt Lake City, Utah, February 12, 2010.
- "Commercialization of IP in China - Trademark Enforcement, Protection Strategies and Domain Names in China," (moderator), Intellectual Property Owners Association Annual Meeting, San Diego, California, September 23, 2008.
- Trial attorney in mock patent jury trial, John Marshall Law School trial program at China State Intellectual Property Office, Beijing, Peoples Republic of China, June 2008.
- "Keyword Advertising: Trademark Law in Flux," (panelist), AIPPI (US Group) Annual Meeting, San Francisco, California, October 26, 2007.
- "Trademarks in Internet Advertising: The Next 'Next Big Thing,'" (speaker), Trademark & Advertising Law, Law Seminars International, Seattle, Washington, September 21, 2007.
- "Beyond Keywords: Internet Trademark Issues," (speaker), Update on Intellectual Property Law and the Internet, Brinks Hofer Gilson & Lione Seminar, Chicago, August 1, 2007.
- "Use of Keywords in Internet Advertising," (speaker), Brinks Hofer Gilson & Lione Seminar, Glenview, Illinois, June 5, 2007.
- "Transactions Involving Use of Trademarks On the Internet," (speaker), Complex IP & Technology Transactions, Law Seminars International, Chicago, Illinois, March 22, 2007.
- "Trademark Law: US and International Update," (panelist), Update on Intellectual Property Law and the Internet, Brinks Hofer Gilson & Lione Seminar, Chicago, April 18, 2006
- "Runaway Jury: The Streets of San Diego," (trial attorney in mock jury trial), International Trademark Association Annual Meeting, San Diego, California, May 17, 2005
- "Trademarks in Internet Advertising: Banners, Pop-Ups, Paid Search," (speaker), Georgetown University Advanced Computer and Internet Law Program, Washington, D.C., March 17, 2005
- Trademark Administrator Forum, International Trademark Association, (co-chair), Arlington, Virginia, October 3-6, 2004
- "U.S. Dilution Law," (speaker), Famous and Well-Known Trademark Forum, International Trademark Association, Brussels, Belgium, September 20, 2004
- "Internet Update: Domain Name Disputes and Cyber Infringement," (speaker), IP Summer Conference, Michigan Institute of Continuing Legal Education, Mackinac Island, Michigan, July 23, 2004
- "Litigating Damages in Trademark Infringement Cases," (moderator), Roundtable, ABA Litigation Section, Intellectual Property Litigation Committee, Chicago, Illinois, March 18, 2004
- "Internet Advertising: Expanding Frontiers of Trademark Law," (speaker), Intellectual Property Law Association of Chicago and The John Marshall Law School Internet Law Seminar, Chicago, Illinois, November 21, 2003
- "Trademarks on the Internet: Expanding Frontiers," (speaker), LexisNexis Advanced Trademark Program, New York, New York,

October 23-24, 2003

- "Dilution: Open Issues After *Moseley*," (speaker), Intellectual Property Owners Association Annual Meeting, Chicago, Illinois, September 16, 2003
- "Trademarks and the Internet: Hot Topics," (speaker), Georgetown University Advanced Computer and Internet Law Program, Washington, D.C., March 6, 2003
- "Qualifying for Dilution Protection," (project team member and moderator), International Trademark Association Dilution Forum, Arlington, Virginia, March 6-7, 2003
- "Hot Topics In U.S. Trademark Law," (speaker), 2002 Chicago International IP Conference (co-sponsored by the University of Illinois), Chicago, Illinois, October 5, 2002
- "Effective Enforcement Strategies," (speaker), LexisNexis Advanced Trademark Program, Chicago, Illinois, April 15-16, 2002
- "Giving Away E-commerce Rights and How To Negotiate Them," (speaker), presented portion of program regarding trademark rights in e-commerce, HITEC (Hospitality Industry Technology Exhibition and Conference), Dallas, Texas, June 20, 2000
- "Trademarks On The Internet," (speaker), Chicago-Kent College of Law, Illinois Institute of Technology, Chicago, Illinois, April 25, 2000
- "Trademark Law Issues Associated With The Transfer Of Intangibles," (speaker), Deloitte & Touche Client Seminar, Chicago, Illinois, December 3, 1997
- International Trademark Law Developments Session, International Trademark Association Annual Meeting, (co-moderator), Seattle, Washington, May, 1994
- **Interviews**  
"Internet Trademark Law," Interview on SkyRadio, United Airlines, October 2005.
- Quoted in November 2002 *Managing Intellectual Property* article naming Brinks Hofer Gilson & Lione the #2 "Contentious Trademark" firm in the United States.
- Quoted in April 2000 *Managing Intellectual Property* article naming Brinks Hofer Gilson & Lione's trademark group the "US Team of the year."

## **MEMBERSHIPS & AFFILIATIONS**

- International Trademark Association  
Board of Directors, 2010-2012  
Co-Chair, 2011 Advanced Trademark Symposium  
Co-Chair, 2007 Annual Meeting  
Co-Chair, 2004 Trademark Administrators Program  
Programs Committee, 2007-present  
Past committee memberships: Trademark Reporter Editorial Board  
Oral argument judge, Saul Lefkowitz Moot Court Competition, Midwest Region, 2008-2010  
Faculty member, INTA Trial Advocacy Program, Chicago, Illinois, July 14-15, 2000
- Intellectual Property Law Association of Chicago  
Board of Managers, 2009-present  
Chair, Creative Achievement Award Committee, 2007-2009

Chair, Internet Law Committee, 2005-2006

- American Bar Association  
Annual Review Vice Chair, Trademark Division, Intellectual Property Law Section, 2010
- Intellectual Property Owners Association
- Richard Linn American Inn of Court  
Mentorship Chair, 2007-2008
- Chicago Bar Association

### **CIVIC ACTIVITIES**

The Illinois Saint Andrew Society  
Board of Governors, 2005-Present

Board of Education, Wheaton-Warrenville (Illinois) Community Unit  
School District 200  
Member 1995-1999  
Vice-President 1996-1997  
President 1997-1998

DuPage Intermediate Educational Cooperative  
Member, Board of Directors 1995-1997

### **LEGAL EXPERIENCE**

**Brinks Hofer Gilson & Lione**, Chicago, Illinois  
Shareholder  
Chair, Trademark Litigation Practice Group, 2009-2010  
Co-chair, Litigation Department, 2009  
Board of Directors, Executive Committee, 2007-2008  
Vice President, 2007-2008  
Treasurer, 2000-2005  
Co-chair, Internet Practice Group, 2001-2007



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### PRACTICE/INDUSTRY GROUPS

Trademarks & Unfair Competition  
Litigation  
International Trademark  
Copyright  
Licensing  
Anti-Counterfeiting  
Green Technology  
Trade Secrets

### EDUCATION

J.D., Georgetown University Law  
Center, 1998

B.A., History, Northwestern  
University, 1995

### STATE BAR ADMISSIONS

Illinois

### PRACTICE SUMMARY

Mr. Slavick's practice focuses primarily on trademark prosecution and trademark litigation. In connection with this, he maintains all aspects of his large corporate clients' trademark portfolios. His relevant experience includes litigation in numerous federal courts and before the Trademark Trial and Appeal Board. In addition, he analyzes trademark searches, drafts trademark clearance opinions and provides a great deal of client counseling.

In the last several years, Mr. Slavick has expanded his practice to include a growing expertise in trade secret law with a focus on its use in the employment arena in connection with non-compete agreements, confidentiality agreements and restrictive covenants. He has written several articles on the subject, conducted numerous trade secret audits and prepared several best practices manuals for his varied clients. Because of its many applications, Mr. Slavick continues to grow this area of his practice.

Mr. Slavick also possesses a great deal of experience in handling international trademark matters. His practice includes international trademark litigation, licensing and prosecution, including determination of international filing strategies, negotiating worldwide co-existence agreements and effective enforcement strategies to defend trademarks and prevent infringements. In connection with this area of his practice, Mr. Slavick often works with foreign associates around the world. Depending on the issue at hand, Mr. Slavick has the personal experience to decide who is best to work with anywhere in the world.

He has represented clients in the fields of air transportation, Internet search engines, financial services, toys, consumer products, restaurant and retail services, telecommunications, banking and health and fitness clubs. Mr. Slavick has also handled domain name dispute proceedings, counterfeit seizures, conducted many intellectual property audits, handled worldwide trademark licensing projects, filed numerous copyright applications and prepared several corporate intellectual property compliance manuals.

During his career at Brinks, Mr. Slavick has consistently sought out leadership positions. In doing so, he chaired the firm's U.S. Trademark Prosecution Committee, Co-Chaired the firm's U.S. Prosecution Division and currently serves as the youngest member of the firm's Conflicts and New Business Intake Committee. In addition, he has served on the firm's hiring, recruiting and docketing committees. He has also enjoyed

his numerous opportunities to serve as a mentor to several of the firm's associates.

## **HONORS/DISTINCTIONS**

- Leading Intellectual Property Lawyer, Leading Lawyers Network, Law Bulletin Publishing Company, 2009, 2010
- Illinois Super Lawyers, Rising Stars, 2009

## **REPRESENTATIVE MATTERS**

### **Federal Court Cases**

- *Bally Total Fitness Holding Corp. v. Kim2Bfit, LLC and Kim J. Garcia*, Civil Action No. 8:10-cv-01108-SDM-TBM (M. D. Fla. 2010). Representing plaintiff in dispute over use of and application to register KIM2BFIT for fitness services. Case pending.
- *Georgia-Pacific Consumer Products LP v. Kimberly-Clark Corp.*, Case No. 09 CV 0371 (Dist. N.D. Ga. 2009). Representing defendant in dispute over embossing of toilet paper. Case pending.
- *T7 Group, LLC v. Robert Sutton*, Case No. 07 CV 1956 (N.D. Ill. 2007). Represented footwear manufacturer in dispute over use of BALL'N trademark. Conducted court-aided mediation in an effort to resolve matter. Case successfully resolved with finding of infringement and award of monetary damages, injunctive relief, abandonment of defendant's trademark application and transfer of infringing domain name to plaintiff.
- *Native Am. Arts, Inc. v. Jewel Food Stores, Inc. a/k/a Jewel-Osco; E. Davis Int'l., Inc.*, Case No. 04 C 0277 (N.D. Ill 2005). Represented defendants in dispute involving the Indian Arts and Crafts Act of 1990 and the Indian Arts and Crafts Enforcement Act of 2000 involving the sale of alleged Native American products. Case resolved.
- *Fix-A-Dent, Inc. v. Qwikway Dent Tech., Inc., Progressive Casual Ins. Co.*, Case No. 04 CV 7490 (N.D. Ill. 2004). Represented defendant in trademark infringement dispute over use of plaintiff's FIX-A-DENT trademark. Case resolved.
- *Safe-T Products, Inc., Classroom Products, Inc., and Extra Measures, Inc. v. Learning Resources, Inc. and A. Daigger & Co., Inc.*, Case No. 01 C 9498 (N.D. Ill. 2004). Represented defendant in trade dress dispute over use of various educational toy designs. Case resolved.
- *The Edlong Corp. v. Cumberland Packing Corp., and Ronald F. Schifsky*, Case No. 02 CH 13349 (Circuit Court of Cook County, Illinois County Department - Chancery Division 2003). Represented plaintiff in enforcing a restrictive covenant and possible theft of trade secrets when former employee left to join competitor. Case resolved.
- *PlasmaNet, Inc. v. Overture Serv., Inc.*, Case No. 02 CV 3075 (S.D. N.Y. 2002). Represented Internet search engine in trademark infringement dispute over advertiser bids on Internet search terms. Case resolved.
- *Mark Nutritionals, Inc. v. AltaVista Co.*, Case No. SA-02-CA-0087 EP (W.D. Tex. 2002). Represented Internet search engine in trademark infringement dispute over advertiser bids on Internet search terms. Case resolved.

- *1-800 Contacts, Inc. v. JSJ Enter., Inc. d/b/a Contact Lens Connection*, Case No. 02 CV 0705 (D. Utah 2002). Represented plaintiff contact lense retailer in unfair competition and trademark dilution dispute over use of client's house mark as a meta tag in defendant's web site. Case resolved.
- *Ameritech Corp. v. Quaterra Commc'n Corp.*, 60 U.S.P.Q.2d 1603 (E.D. Wis. 2001). Represented plaintiff in trademark infringement dispute over defendant's use of infringing domain name. Summary judgment for plaintiff granted and plaintiff awarded attorneys' fees.
- *Northern Trust Corp. v. Cascade Tech., Inc.*, Case No. 01 CV 4181 (N.D. Ill. 2001). Represented plaintiff in trademark infringement dispute over use of plaintiff's mark. Case resolved.
- *Thomas & Betts Corp. v. Panduit Corp.*, 55 U.S.P.Q.2d 1698 (N.D. Ill. 2000). Represented defendant in trade dress infringement dispute over the trade dress of cable tie products. Case resolved.
- *800-JR Cigar, Inc. v. GoTo.com, Inc., et al.*, Case No. 00 CV 03179 (D. N.J.). Represented Internet search engine in trademark infringement dispute over advertiser bids on Internet search terms. Case resolved.
- *United Air Lines, Inc. v. Imex Model Co., Inc. d/b/a Phoenix Model Co.* (N.D. Ill. 2000). Represented commercial airline company in trademark infringement dispute over use of plaintiff's house mark on unauthorized model planes. Case resolved.
- *Fellowes Mfg. Co. v. Bankers Box Storage, et al.*, Case No. 00 CV 8093 (N.D. Ill. 2000). Represented office supply company in trademark infringement dispute over use of plaintiff's trademark. Case resolved.
- *Signature Financial/Marketing, Inc. v Jason Wiseman*, Case No. 99 CV 2449 (N.D. Ill. 1999). Represented plaintiff in trade secret misappropriation dispute against former employee. Case resolved.
- *Ty Inc. v. Treasure Yesterday*, Case No. 99 CV 25 (D. Mo. 1999). Represented plaintiff in trademark infringement dispute over use of plaintiff's trademark. Obtained Temporary Restraining Order and subsequent Consent Judgment.
- *Swanson Tool Co., Inc. v. Midwest Tool Dist.*, Case No. 98 CV 8239 (U.S. N.D. Ill. 1998). Represented plaintiff in counterfeiting dispute over sale of counterfeit construction products. Resolved with seizure and destruction of counterfeit products.

#### **Trademark Trial and Appeal Board Case Oppositions**

- *Showa Glove Co. v. JODA Enters., Inc.*, Opp. No. 91193939. Representing applicant in dispute over application to register BLACK KNIGHT for tools. Case pending.
- *Super Bakery Inc. v. Livelong-Gastro Gmbh*, Opp. No. 91192851. Representing applicatn in dispute over application to register SUPERGOOD for food products. Case successfully resolved.
- *T7 Group LLC v. Sutton*, Opp. No. 91173272. Represented opposer in dispute over application to register BALL'N for athletic apparel. Case successfully resolved when applicant was denied registration.
- *Bally Total Fitness Holding Corp. v. Garcia*, Opp. No. 91192301. Representing opposer in dispute over application to register KIM2BFIT for fitness services. Case currently pending.

- *Bally Total Fitness Holding Corp. v. Kovacs*, Opp. No. 91190286. Representing opposer in dispute over application to register BFIT and Design for fitness services. Case successfully resolved when applicant was denied registration.
- *Alacer Corp. v. Livelong-Gastro Gmbh*, Opp. No. 91188620. Representing applicant in dispute over application to register JUST FEELIN' GOOD for food products. Case pending.
- *The Coca-Cola Co. v. Bruno Van Gaver*, Opp. No. 91186774. Representing applicant in dispute over application to register MELLOW YELLOW for fashion items. Case resolved.
- *Kimberly-Clark Worldwide, Inc. v. Scott W. Jacobs*, Opp. No. 91182499. Representing opposer in dispute over application to register HUGGYBALL for clothing. Case successfully resolved when applicant was denied registration.
- *Bally Total Fitness Holding Corp. v. BeFit Enters., Inc.* Opp. No. 91184000. Representing opposer in dispute over application to register BEFIT for fitness products. Case successfully resolved when applicant was denied registration.
- *American Airlines, Inc. v. Am. Apparel, Inc.*, Opp. Nos. 91184480 and 91184941. Representing opposer in dispute over application to register AA and Design for sale of clothing. Case pending.
- *HBI Branded Apparel Enters., LLC v. Bally Total Fitness Holding Corporation*, Opp. No. 91183527. Representing applicant in dispute over application to register BALLY TOTAL FITNESS for clothing. Case pending.
- *JODA Enters., Inc. v. Harbin Measuring & Cutting Tool Group Co. Ltd.*, Opp. No. 91183018. Representing registrant in dispute over application to register LINKS for tools. Case successfully resolved when applicant revised its identification of goods.
- *J. Kinderman & Sons, Inc. v. Intermatic Inc.*, Opp. No. 91160366. Represented applicant in dispute over application to register YARDSCAPES for outdoor products. Case successfully resolved when applicant received registration.
- *Schrader Bridgeport Int'l, Inc. v. Greenball Corp.*, Opp. No. 91153015. Represented opposer in dispute over application to register SCHREDDER for tires. Case successfully resolved when applicant was denied registration.
- *Montgomery Ward & Co., Inc. v. Kingkraft, Inc.*, Opp. No. 9113818. Represented opposer in dispute over application to register SHIP N SHORE for hand bag. Case successfully resolved when applicant was denied registration.
- *Bally Total Fitness Holding Corp. v. Vectra Fitness, Inc.*, Opp. No. 91122839. Represented opposer in dispute over application to register PINNACLE for health club services. Case successfully resolved when applicant was denied registration.
- *QSC II, Inc. v. AIG Wine & Spirits Import Co., Inc.*, Opp. No. 91120109. Represented opposer in dispute over application to register LONG JOHN SILVER for alcohol. Case successfully resolved when applicant was denied registration.
- *General Mills, Inc. v. Bally Total Fitness Holding Corp.*, Opp. No. 91107638. Represented applicant in dispute over application to register BALLY TOTAL FITNESS NUTRITIONALS for energy bars.

Case successfully resolved when applicant received registration.

- *Hardee's Food Sys., Inc. v. Joanne Stathoulia d/b/a Frisco's Car Hop Drive-In*, Opp No. 91096552. Represented opposer in dispute over application to register FRISCO's for restaurant services. Case successfully resolved when applicant was denied registration.

### **Cancellation Actions**

- *Data Connection Ltd. v. Metafile Info. Sys., Inc.*, Cancellation No. 92049983. Representing respondent in cancellation action to cancel METAFILE for computer software. Case currently pending.
- *Paulie's Pizza, Inc. v. Deb Paul Corp.*, Cancellation No. 92048784. Representing movant in cancellation action to cancel PAULIE'S HOT DOG marks for restaurant services. Case successfully resolved when registrant's registrations were cancelled.
- *Paulie's Pizza, Inc. v. Sala Gruppi, Inc.*, Cancellation No. 92048760. Representing movant in cancellation action to cancel PAULY'S marks for restaurant services. Case successfully resolved when registrant's registrations were cancelled.
- *Northern Trust Corp. v. Apertus Tech., Inc.*, Opp. No. 92040820. Represented movant in cancellation action to cancel PASSPORT for financial services. Case successfully resolved when registrant's registration was cancelled.
- *AnsMar Publishers, Inc. v. The Excel Program, Inc.*, Cancellation No. 92040299. Represented movant in cancellation action to cancel THE EXCEL PROGRAM for educational services. Case successfully resolved when registrant's registration was cancelled.
- *DST Sys., Inc. v. Innovus Multimedia, Inc.*, Cancellation No. 92031905. Represented movant in cancellation action to cancel INNOVUS for consulting services. Case successfully resolved when registrant's registration was cancelled.

### **Concurrent Use Proceedings**

- *CP Acquisition Corp., LLC v. Madison Restaurant Acquisition Corp.*, Concurrent Use No. 94002130. Represented applicant in successfully securing a concurrent use registration for COCO PAZZO.

### **International Disputes**

- *Ternium Int'l, Inc. v. Quixote Trans. Safety, Inc.*, Opposition No. B1576134. Representing applicant in European Union in dispute over application to register TERMINUS. Case pending.
- *American Airlines, Inc. v. Affinion Publ'g, LLC*. Representing opposer in multijurisdictional dispute, including oppositions in CTM, Switzerland, Norway and Australia, over applications to register TRAVELER'S ADVANTAGE, BUYERS ADVANTAGE, and SHOPPERS ADVANTAGE for customer loyalty programs. Cases pending.
- *Turbochef Technologies, Inc. v. Klimatek Elektrikli ve Mekanik Chiazlar*. Represented opposer in Turkish dispute over application to register TURBOCHEF for ovens. Case successfully resolved when application was assigned to opposer and matured into registration in opposer's name.

- *American Airlines, Inc. v. America Air Táxi Aéreo LTDA.* Representing opposer in Brazil in civil action to annul trademark registration for the mark AMERICA AIR with a request for a preliminary injunction to suspend the effects of the registration and stop use of the mark. Case pending.
- *Brooks Automation, Inc. v. Fellowes, Inc.* Representing applicant in European Union invalidation action over application to register FUSION. Case pending.
- *DST Sys., Inc. v. DST Asia Pte. Ltd.,* Opposition No. T06/26701A. Representing opposer in Singapore dispute over application to register DST and two bar logo. Case pending.
- *American Airlines, Inc. v. Am. Apparel Deutschland GmbH.,* Opp. No. 003935335. Representing opposer in the European Union in dispute over application to register AMERICAN APPAREL AA. Case pending.
- *American Airlines, Inc. v. S.A. Spa Monopole.* Defending applicant in France and Germany in dispute over application to register SPAA. Case pending.
- *BASF Agro v. Intermatic Inc.,* Opp. No. B761330. Representing applicant in the European Union in dispute over application to register MALIBU. Case pending.
- *Alberto Culver Co. v. Technical Concepts,* Opp. No. 199,179. Representing applicant in India in dispute over application to register TC. Case pending.
- *DTS, Inc. v. DST Int'l Ltd.* Representing applicant in European Union dispute over application to register DST for billing software. Case successfully resolved when applicant obtained registration.
- *American Airlines, Inc. v. Westpac Banking Corp.* Representing opposer in Australian dispute over application to register MERCHANT ADVANTAGE. Case successfully resolved when opposer revised recitation of services.
- *Arctic Cooling Switzerland AG v. Fellowes, Inc.,* Opposition No. B1070798. Representing applicant in European Union dispute over application to register FUSION. Case successfully resolved when applicant obtained registration.
- *Bally Total Fitness Holding Corp. v. Martin Foerster.* Represented opposer in Germany in dispute over application to register BFIT. Case successfully resolved when applicant was denied registration.
- *Malibu Health Prod. Ltd. v. Intermatic Inc.,* Opp. No. B877037. Represented applicant in European Union in dispute over application to register MALIBU. Case resolved.

## **PUBLICATIONS**

- "Online False Advertising Risks," *Business Law Today*, October 26, 2010
- "WMA Insights on Intellectual Property Valuation and Economic Analysis," *BVWire News*, September 2010, (includes article "What to Do When Considering an Intellectual Property Purchase")
- "FTC's New Endorsement Guidelines Raise Questions," *Advertising Compliance Service*, July 5, 2010
- "What Companies Should Know about the FTC's Green Guides,"

*Executive Counsel*, April/May 2010

- "Employer Liability Under New FTC Endorsement Rules," *Law360*, March 2010
- "I Am Not a Spokesperson for My Company: How Instituting a Strong Social Media Policy Now May Help Your Company Stay on the Right Side of the FTC's New Endorsement Guidelines," *Chicago Lawyer*, March 2010, reprinted in *IPO Daily News*, July 7, 2010
- "What to Do When Considering an Intellectual Property Purchase," *Willamette Management Associates Insights*, Autumn 2009
- "What to Consider in an International IP Purchase," *Executive Counsel*, July/August 2009
- "The Devil is in the Details: Suggestions for a Successful and Affordable International Branding Campaign," *Fenton Report*, June 22, 2009
- "What to Do When Considering an International Intellectual Property Purchase," *Directors & Boards*, March 2009
- "Is Issuing IP Bonds a Good Move for Your Company?" *Executive Counsel*, November/December 2008
- "An Intellectual Property Checklist, Using IP to Make Your Company an Attractive Acquisition Target," *Boardroom Briefing*, Autumn 2008
- Quoted in "Beauty Industry Faces Up to E-Fencing Issue," *CostmeticNews*, February 2008
- "Integration is Key to Stopping Counterfeiting," *Brinks Hofer Gilson & Lione Client Publication*, September 2007
- "Keeping It Local," *The National Law Journal*, April 10, 2006
- "The Trademark You Save May Be Your Own," [www.inta.org](http://www.inta.org), June 2005
- "A Groundbreaking Case," *The National Law Journal*, Vol. 27, No. 30, April 4, 2005
- "Ma Bell's Dark Past," *The National Law Journal*, October 25, 2004
- "'Hear No Evil, Speak No Evil' Does Not Apply to New Employees' Knowledge," *BNA's Patent Trademark & Copyright Journal*, Vol. 68, No. 1676, June 18, 2004
- "Protecting Sudden Innovative Ideas as Trade Secrets," *Patent Trademark & Copyright Journal*, Vol. 67, No. 1668, April 23, 2004
- "The McKay Commission and Illinois: A Match Made in Heaven?," *Georgetown Journal of Legal Ethics*, Fall 1997

## **PRESENTATIONS**

- "IP Trends Surrounding the Use of Social Media, Including Twitter and Facebook," Brinks Hofer Gilson & Lione CLEArKnowledge Now Webinar, December 9, 2010
- "Just the FAQs: The Top 10 Most Frequently Asked Trademark Questions," Association of Corporate Counsel, Chicago Chapter, Chicago, Illinois, July 1, 2010
- "Trademark Application Basics: What Every Attorney Needs to Know about Trademark Applications," Brinks Hofer Gilson & Lione Internal Education Seminar, Chicago, Illinois, October 2009
- "Conflicts of Interest: Common Situations that all New Attorneys Should Know," Brinks Hofer Gilson & Lione Internal Education

Seminar, Chicago, October 2009

- "Professional Responsibility: Words to the Wise," Brinks Hofer Gilson & Lione Internal Education Seminar, Chicago, Illinois, September 2009
- "Trademark Prosecution Guide: What Does Your Client Want?" Brinks Hofer Gilson & Lione Internal Education Seminar, Chicago, Illinois, September 2009
- "Social Networking And Trademark Issues," Podcast presented on MITechNews.com, July 20, 2009
- "Non-Compete Contracts And Trade Secrets," Podcast presented on MITechNews.com, July 20, 2009
- "Job Change Challenge And Protecting Trade Secrets," Podcast presented on MITechNews.com, July 20, 2009
- "How to Draft and Implement Noncompete Agreements for Maximum Enforceability," Association of Corporate Counsel, Chicago Chapter, Chicago, Illinois, June 11, 2009
- "Trade Secrets: What is Protected?," American Conference Institute's Expert Forum, Chicago, Illinois, May 27-28, 2009
- "Is Issuing IP Bonds a Good Move for Your Company?," Podcast presented on MITechNews.com, March 2, 2009
- "What Can a Company Do to Strengthen a Historic Brand?," Podcast presented on MITechNews.com, March 2, 2009
- "How to Use IP to Make Your Company an Attractive Acquisition Target," Podcast presented on MITechNews.com, March 2, 2009
- "What Steps Can Businesses Take to Stop Counterfeiting?," Podcast presented on MITechNews.com, March 2, 2009
- "Common Ethical Issues Confronting IP Firms," Brinks Hofer Gilson & Lione Internal Education Seminar, Chicago, Illinois, April 2008
- "Filing Trademark Applications: A Practitioner's Guide to Getting What the Client Wants," Brinks Hofer Gilson & Lione Internal Education Seminar, Chicago, Illinois, April 2008
- "Client Conflicts: Firm Procedures & Common Situations," Brinks Hofer Gilson & Lione Internal Education Seminar, Chicago, Illinois, February 2008
- "Tackling Counterfeit and Gray Market Goods," Association of Corporate Counsel Annual National Meeting, Chicago, Illinois, October 2007
- "Trademarks and Keyword Advertising: The Ground-Breaking Past, the Conflicting Present and the Potentially Wide-Open Future," Brinks Hofer Gilson & Lione Client Seminar, Chicago, Illinois, August 2007
- "Trademark Application Basics," Brinks Hofer Gilson & Lione Client Seminar, Chicago, Illinois, March 2007
- "Challenges Due to Increased Globalization," Northwestern University School of Law, Chicago, Illinois, January 2007
- "Effective Strategies for Interacting with Foreign Associates," Brinks Hofer Gilson & Lione Client Seminar, Chicago, Illinois, September 2006
- "What's the Big Deal with Trademarks and Copyrights: What is Intellectual Property and Why You Should Care," Wilbert Funeral Services, Inc.'s Internal Education Series, Chicago, Illinois, April

2006

- “Innovative Ideas are Entitled to Trade Secret Protection,” Brinks Hofer Gilson & Lione Client Seminar, Chicago, Illinois, June 2005
- “INTA Roundtable Program – Madrid Protocol and the CTM: A Comparison of CTM and Madrid Protocol Trademark Applications,” Brinks Hofer Gilson & Lione Client Seminar, Chicago, Illinois, January 2004
- "Madrid Protocol: Changes for Firms," Brinks Hofer Gilson & Lione Client Seminar, Chicago, Illinois, October 2003
- “Madrid Protocol: New Strategies for Filing,” Brinks Hofer Gilson & Lione Client Seminar, Chicago, Illinois, September 2003
- “He Said, She Said – A Dialogue Regarding Intellectual Property Issues,” Wilbert Funeral Services, Inc.’s National Licensees’ Meeting, Charlotte, North Carolina, December 2002
- “Important Amendments to the Lanham Act,” Brinks Hofer Gilson & Lione Client Seminar, Chicago, Illinois, June 2002
- “Legal Technology and Cyberlaw,” Illinois State Bar Association's Standing Committee on Minority and Women Participation's Cyberlaw Seminar, May 2001

#### **MEMBERSHIPS & AFFILIATIONS**

- International Trademark Association
- Marques - The Association of European Trade Mark Owners
- Illinois State Bar Association
- Chicago Bar Association
- American Bar Association

#### **LEGAL EXPERIENCE**

**Brinks Hofer Gilson & Lione**, Chicago, Illinois

Shareholder, 2006-Present

Associate, 1998-2005