



NEWSLETTER

A quarterly update on intellectual property topics.

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January 2012

Firm Seminar on “Brand Power Through Strategic IP Management”

On September 23, 2011, the Firm hosted a seminar for corporate counsel at Northwestern University’s Kellogg School of Management in Chicago. In keeping with the venue, the program presented marketing viewpoints on creating and managing high-value, sustainable brands. It also included ways in which a company’s lawyers and its marketing people could better communicate with each other on brands and branding, given the differences in how their respective professional disciplines tend to consider the subject. The program also included legal perspectives from the United States, Canada and Europe on the benefits and potential pitfalls of using multiple forms of IP protection to foster long-term trade identity. As a day-long seminar cannot be condensed into a short newsletter article, this will only touch upon some highlights.

The author of this article served as moderator of the program, introduced its four speakers, managed Q&A, and provided transition and summary comments (and takes full responsibility for any mistakes herein in summarizing the participants’ remarks). Our first speaker was Professor James G. Conley, Clinical Professor of Technology at the Center for Research in Technology & Innovation, Kellogg School of Management, Northwestern University. He is also a member of the Trademark Public Advisory Committee which advises the U.S. Patent & Trademark Office.

Professor Conley laid the management foundation for dealing with the increasing economic importance of intellectual property as tangibles depreciate on many of the world’s exchanges. He explained the concepts of value transfer, a term coined about ten years ago, design, semiotics (the science of signs and sign systems) and market opportunity, among others, as they are taught in business school marketing curricula.

He spoke of innovation as choosing to perform activities differently than one’s competitors. As reverse engineering can produce copies faster than it takes to create an original, the competitive challenge is to perform activities differently while establishing a difference that can be preserved. Professor Conley suggested intellectual property law as the main toolbox for preserving difference and uniqueness, and noted there are a number of “intellectual property machines” which are only broadly summarized to business school management students, due to their aggregate uncertainty and complexity.

He compared certain points of IP protection, and graphed out time-limited patent rights versus trademark rights as shark-fin versus ascending curves. And he explained value transfer as the premeditated management of patent functionality and advertising that functionality into mental association with a trademark. These are just some of his examples of the business school marketing approach to managing valuable brands strategically.

Uli Widmaier, our second speaker, is a partner in the Pattishall, McAuliffe Firm and a Lecturer in Law at the University of Chicago Law School. Uli surveyed the legal IP landscape in the United States as somewhat distinct from Professor Conley’s marketing framework. Mr. Widmaier noted certain contractions of IP rights resulting from Supreme Court decisions, and discussed more generally how the courts (and IP owners themselves) often reach the wrong result or encourage it by emphasizing the wrong facts. As an example, he cited the court’s failure to recognize the widespread commercial symbolism and magnetism – and the powerful trademark significance – of the Louboutin red shoe soles in the recent Yves Saint Laurent litigation. Several utilitarian functionality cases in the Seventh Circuit also signal a resurgence of the functionality doctrine which is the enemy of trademark rights (“A design that produces a benefit other than source identification is functional”).

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Noting a disconnect between lawyers' and marketers' views of brands and their functions, Mr. Widmaier stated the IP lawyer's mission is to bridge that gap. He also identified Constitutional divisions between different IP rights, and misguidance from certain Supreme Court cases: patents vs. copyrights vs. trademarks, design patents vs. utility patents, trademarks or trade dress vs. copyrights. He concluded that the law's central view of brands is empirically incorrect, at least in recent times, and urged convergence between the marketing and legal theories of brands and trademarks.

Our third speaker was Gervas Wall, a founding partner in the Deeth Williams Wall LLP firm in Toronto, and a Fellow of the Intellectual Property Institute of Canada. Mr. Wall presented a Venn Diagram of overlapping IP rights under the Canadian scheme and an extensive comparison and contrast of the various applications, advantages and limitations, with examples ranging from Crocs to Coca-Cola and Bud-Lite Lime Beer to Lego Blocks.

Gerhard Bauer was our final speaker. Mr. Bauer is President of the International Trademark Association (INTA), and Chief Trademark Counsel at Daimler AG in Stuttgart, Germany. He explained how at his company, in designing and producing Mercedes-Benz and other high-quality prestige automobiles, facilitating both design excellence and legal protection are concurrent considerations that go hand-in-hand. A seat adjustment switch, for example can be subject to patent, industrial design, and trademark protection. He emphasized the scope and availability of European designs as an important IP vehicle and how they can be used in protecting many details of the product design process.

The program was well-attended and generated interesting discussion. The Firm thanks its speakers and attendees and plans further events to explore the important issues surrounding the topics. Questions from our readers are welcome, and will be answered.

– Robert W. Sacoff

TOP 10 PATTISHALL BLOG POSTS of 2011, Based on Viewer Metrics

Click on the titles below to go to the full posts.

Subscribe at <http://blog.pattishall.com> for email notification of new posts.

Light Blue Color Mark for Tennis Racket Overgrips Held Valid but Not Infringed by Slightly Different Shade of Light Blue Grip Tape

IAN J. BLOCK, NOVEMBER 10, 2011

If You Build It, Will the Lawyers Come? 3D Printing and Copyright Infringement

GUEST POST BY JAKE LINFORD, ASSISTANT PROFESSOR, FLORIDA STATE UNIVERSITY COLLEGE OF LAW, NOVEMBER 18, 2011

Trademark Protection in ICANN's New Generic Top-Level Domain ("gTLD") Space Will Require Diligence by Trademark Owners

PHILLIP BARENGOLTS, NOVEMBER 8, 2011

District Court Denies Preliminary Injunction because Plaintiff Failed to Introduce Evidence of Irreparable Harm – Declares Presumption of Irreparable Harm in Trademark Cases Dead

PHILLIP BARENGOLTS, OCTOBER 12, 2011

E-Discovery In The Board: A Reasoned Approach

PHILLIP BARENGOLTS, DECEMBER 1, 2011

Green Day Awarded Attorneys' Fees Against Artist After Defeating Copyright Infringement and Unfair Competition Claims With Fair Use Defense

PHILLIP BARENGOLTS, NOVEMBER 30, 2011

Protecting Your Company Brands Against Sexually Explicit and Pornographic .XXX Domain Names – Deadline for Sunrise Period for Blocking Registrations is October 28, 2011

BELINDA J. SCRIMENTI, OCTOBER 26, 2011

Copying a Photograph Openly Available Over the Internet Constitutes Copyright Infringement, Despite Attempted Fair Use Defense by Appropriation Artist

PHILLIP BARENGOLTS, JULY 8, 2011

First Circuit: Supreme Court Decision Calls into Question Presumption of Irreparable Harm in Trademark Infringement Preliminary Injunction Cases

JANET A. MARVEL, JUNE 20, 2011

Total War: General Mills Successfully Opposes Registration of "TOTAL" for Yogurt

JANET A. MARVEL, NOVEMBER 28, 2011

FIRM UPDATE & ANNOUNCEMENTS

NEWEST ADDITIONS TO THE FIRM

The Firm is pleased to welcome the most recent additions to its legal team, **Demetra Merikas**, **Jeffrey A. Wakolbinger** and **Elisabeth O'Neill**.

Demetra Merikas has rejoined the firm as Senior Counsel, after serving as Senior Trademark Counsel at Kraft Foods. **Demetra** received her undergraduate degree from the University of Chicago and her J.D. from Loyola School of Law.

Jeff Wakolbinger has joined the Firm as an associate, after concluding a two-year clerkship for a federal judge of the United States District Court for the Northern District of Illinois. **Jeff** graduated *summa cum laude* from the University of Illinois College of Law in 2008, where he served as Symposium Editor of the *University of Illinois Law Review*. Before going to law school, he earned a Bachelor of Music degree from Millikin University.

Elisabeth O'Neill has joined the Firm as an associate after graduating from Northwestern University School of Law in 2011, where she was a John Henry Wigmore Scholar. **Libby** also graduated from Yale University in 2004, *cum laude*, with a B.A. in English.

APPOINTMENTS

Phillip Barengolts will Chair the Subcommittee on Defining Counterfeiting in ABA Intellectual Property Law ("IPL") Section Committee 201 - Trademark Legislation this year. **Phil** was also appointed to serve on the INTA Parallel Imports Committee.

Ashly Iacullo Boesche was appointed to the Chicago Bar Association (CBA) Nominating Committee.

Thad Chalomentiarana will Co-Chair the Promotion Subcommittee in the ABA IPL Section Diversity in the Profession Action Group (DPAG).

Jonathan S. Jennings has been reappointed to the Advisory Board for the DePaul University College of Law's Center for Intellectual Property Law & Information Technology for 2012. **Jonathan** has also been appointed to the inaugural INTA Pro Bono Committee, and to be an associate member of the Pharmaceutical Trade Marks Group (PTMG).

Belinda Scrimenti was sworn in to continue serving as a Director of the Women's Bar Association of Illinois (WBAI). She was also appointed Chair of WBAI's Corporate Committee, and Co-Chair of the Bylaws Committee.

Uli Widmaier will Co-Chair AIPPI Special Committee Q212 (Trade Mark Law).

PRESENTATIONS

Phil Barengolts presented "The U.S. Perspective on Parallel Imports" at a conference in Moscow, Russia, on December 1, 2011, entitled "Parallel Imports and Trademark Protections in the Common Economic Zone of the Customs Union," held jointly by the INTA Parallel Imports and Anti-Counterfeiting Committees and the Coalition for Intellectual Property Rights.

On October 4, 2011, **Ashly Iacullo Boesche** moderated a panel discussion on e-discovery for the CBA Intellectual Property Committee. **Ashly** will also moderate a CBA panel discussion of "Ethics for the Intellectual Property Lawyer" on February 1, 2012. **Ashly** will also speak on "Trademarks in Practice: Searching, Clearance and the Application Process in the U.S." at PLI's "Understanding Trademark Law in the Global Marketplace" Program in Chicago, on June 15, and in New York, on July 17, 2012.

Bradley Cohn and **Belinda Scrimenti** spoke on October 20, 2011, at a Texas Bar CLE program for Firm client AMD in Austin. **Bradley** presented the "Most Educational 5-Minute CLE Program EVER!*" (*or, "Good Things to Know for Advertising Claim Review") and **Belinda** spoke on "It's Not Your Grandfather's Trademark - It's a Theme, It's Colorful, It's Noisy, It Moves, It's Shapely, It Lights Up, etc. ("The Creative World of Trade Dress and Non-Traditional Marks")."

Alexis E. Payne gave a presentation at the PMA's 33rd Annual Promotion Marketing Law Conference entitled "Out With the Old - Technology's Impact on Promotions," in Chicago, on November 16, 2011.

Robert W. Sacoff moderated the Firm seminar in Chicago on September 23, 2011, as described in the article above. **Bob** also gave a workshop presentation on "Border Measures and Goods in Transit" at the AIPPI Forum & ExCo 2011, in Hyderabad, India, on October 14, 2011. **Bob** also spoke on a panel discussion of "Register Clogging and Goods/Services Designations: U.S. versus European Models," at the FICPI ExCo Meeting & 13th Open Forum, in Rome, Italy, on November 10, 2011.

Belinda Scrimenti will speak at the ABA 27th Annual Intellectual Property Law Conference, March 28-30, 2012, on a panel covering "The Rise and Fall of Aesthetic Functionality." **Belinda** spoke at the Women's Business Development Center's "Connection Points" event on December 6, 2011, on "How Do Small Women-Owned Businesses Protect Intellectual Property?"

Joseph N. Welch II gave a presentation on "Why Betty Boop Is/Isn't a Functional Component and Other Legal Conundrums: 2010-2011 Trademark and Unfair Competition Cases" at AIPLA's Annual Meeting 2011, in Washington, D.C.

Uli Widmaier spoke on "Bridging the Gap: Legal Impediments to Integrated Brand Development, and How to Overcome Them" at the Firm Seminar on September 23, 2011, as described in the article above. On February 23, 2012, **Uli** will conduct an ABA webinar on keywords and domain names. On April 27, 2012, **Uli** will give a presentation on "Contraction of Trademark Rights in the U.S. - a Healthy Evolution or a New Monopoly Phobia?" at the 12th International Trademark Conference, held at the OHIM offices in Alicante, Spain.

PUBLICATIONS

Phillip Barengolts co-authored "The Anti-Counterfeiting Trade Agreement (ACTA): What It Is and How It Will Affect Intellectual Property Enforcement," published in the November/December 2011 issue of the ABA publication, *Landslide Magazine*. **Phil** was also quoted in the December 2011, issue of *Inside Counsel Magazine* in an article entitled "Is Your Company Considering a Domain Name Change?"

David C. Hilliard wrote "The Art of Mediation: The Terra Museum War," which was published in the July/August 2011 issue of *Landslide Magazine*.

Jonathan S. Jennings is updating the Illinois chapter of the International Trademark Association's book *State Trademark and Unfair Competition Law*, which will be published online in 2012.

Joseph N. Welch II wrote "Crash Dummies, Cyber-Ads, and the Internet Troika: Recent US Trademark and Unfair Competition Cases," which was published in *The Computer & Internet Lawyer*, Volume 28, Number 10 (October 2011).

Uli Widmaier's article, "From Metatags to Sponsored Ads - The Evolution of Internet-Related Trademark Infringement Doctrine," will be published in the January/February 2012 issue of the ABA publication, *Landslide Magazine*.

FIRM UPDATE & ANNOUNCEMENTS

HONORS AND AWARDS

The American College of Trial Lawyers recognized **Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP** for exceptional work in achieving an outstanding result in the trade identity case of *Givens v. American College of Trial Lawyers* (Case No. 1:07-cv-1024) in the Middle District of Alabama, Southern Division. A plaque was presented to **David C. Hilliard** and **Ashly Iacullo Boesche**, who represented the American College of Trial Lawyers in the case, at the 2011 Annual Meeting in La Quinta, California, on October 21, 2011.

The Chicago Bar Association and The Chicago Bar Foundation presented **David C. Hilliard** with the Justice John Paul Stevens Award at their 12th Annual Award Luncheon on November 15, 2011. The prestigious Justice Stevens Award is bestowed on attorneys who have demonstrated extraordinary integrity and service to the community throughout their careers.

On October 26, 2011, at their Annual Benefits Luncheon, the Lawyers for the Creative Arts honored **David C. Hilliard** for Distinguished Service to the Arts.

The Illinois Institute for Continuing Legal Education awarded **Bradley L. Cohn** the 2011 Above and Beyond Award in recognition and appreciation of his contributions to *pro bono* legal services.

The 2011 edition of Chambers USA recognized **Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP** as “one of the most well-established and respected names in the business for trademark protection and litigation....” It singled out **David Hilliard** as “a senior partner and hugely experienced figure. He handles all manner of IP matters and recently represented PepsiCo in several trademark infringement matters.”

Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP received recognition as a Tier 1 Trademark Law Firm in Chicago by U.S. News – Best Lawyers® “Best Law Firms.” Rankings are based on a rigorous evaluation process that includes the collection of client and lawyer evaluations, peer review from leading attorneys in relevant practice areas, and review of additional information provided by law firms as part of the formal submission process.

Illinois Super Lawyer Magazine has recognized **David C. Hilliard** on its 2012 Illinois “Super Lawyers Top 100” list. The publication also selected **Brett A. August, Bradley L. Cohn, David C. Hilliard, Jonathan S. Jennings, Janet A. Marvel, Robert W. Sacoff** and **Joseph N. Welch, II** as Illinois “Super Lawyers” in Intellectual Property Law and/or Intellectual Property Litigation for 2012. **Phillip Barengolts** and **Ashly Iacullo Boesche** were named as Illinois “Rising Stars” for 2012.

NOTEWORTHY

David C. Hilliard served as Mediator in November and December in U.S. District Court cases in Charlotte, North Carolina, Minneapolis, Minnesota and Chicago, Illinois. **David** also was interviewed for a feature article on civic service, entitled “Boards: Gaining Valuable Experience From Nonprofit Boards,” which appeared in the December 2011/January 2012 edition of *Chicago Lawyer Magazine*.

TEACHING

Phillip Barengolts and **David Beeman** are teaching a class on Trademark and Copyright Litigation at The John Marshall Law School.

David Hilliard and **Uli Widmaier** will be co-teaching their annual Seminar on Advanced Trademarks and Unfair Competition at the University of Chicago Law School in the Winter 2012 Quarter.

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