

# PATTISHALL

*insights*

JULY 2022

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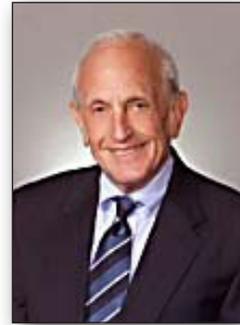
## IN MEMORIAM Robert M. Newbury

We are sad to report the passing of our longtime Partner and friend, Bob Newbury.

Bob's introduction to trademark, unfair competition, and copyright law (now subsumed into the terminology, "Intellectual Property law") began when he was a student at Yale Law School, and interviewed for a job at our firm. William Woodson, our Senior Partner at the time, recognized Bob's intellect and quick wit, and offered him a position on the spot. Bob hesitated because he didn't know much about IP law, and wasn't sure he would like it enough to work for a specialized firm. But he took a course to find out and was pleasantly surprised. He accepted Mr. Woodson's offer, and started as an Associate when he graduated in 1959.

Throughout his 60+ year career, Bob became a consummate expert in IP law, and a brilliant trial and appellate lawyer. Bob represented AT&T in over 700 cases, as well as Johnson Wax, NCR, and Jewel Foods in major IP litigation, to name just a few prominent clients. When asked his favorite case, Bob would say it was hard to pick just one, but easy to pick his favorite year, when he tried three cases, lost them all, but then had all three reversed on appeal. He said that year was "an amazing, exhausting, and exhilarating time."

In one of those cases he represented Johnny Carson, legendary host of "The Tonight Show," who Ed McMahon introduced every night on TV with a booming, "Here's Johnny." A portable toilet company was advertising and selling porta-potties under the phrase "Here's Johnny," and Carson was not amused. He hired Bob to enjoin the tarnishing and damaging impact this was causing to his name and reputation, and Bob filed suit. This was very early in the development of "right of publicity" cases, and the trial judge did not think the phrase was actionable because it was not exactly Mr. Carson's name, so he ruled against him. On appeal, however, the reviewing court disagreed, accepted Bob's arguments, and right of publicity law changed as a result.



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APPELLATE LAWYER. ”

Bob was a generous and supportive mentor to the firm's younger lawyers. However, he never compromised his high standards of legal knowledge, intellectual integrity, concise writing, and persuasive presentation. He was always "generous" with critiques and "suggested" revisions to Associates' work product, and they always handed drafts to him with more or less trepidation. Bob believed strongly in the importance of mentoring and its benefits for the lawyer, the firm, the clients, and our profession.

Bob's passionate devotion to professional excellence extended far beyond the firm itself. He was an active and energetic bar leader and speaker in the major local and national professional associations that dealt with IP law and lawyers, such as the American Bar Association's Section of Intellectual Property Law, the American Intellectual Property Law Association, and the Copyright Society of the USA. In the ABA IPL Section, he was proud to have served, at different times, as Chair of both the Trademark and Copyright Divisions. In the AIPLA, he was a member of the Board, and was also proud to have co-authored a draft intent-to-use procedure amendment to the U.S. Trademark Act. The draft was shorter and simpler than the statutory amendment eventually enacted by Congress, but it had its own influence.

Bob's guiding principles in the practice of law for 60+ years were ethical integrity, civility, and mutual professional respect. He believed aggressive advocacy and civility with your opponent were not mutually exclusive, and that embracing both behaviors promotes professionalism, respect of judges, and results for clients.

Bob Newbury was a brilliant lawyer, a true gentleman, and a great friend, and we will miss him very much. ■

“ BOB'S PASSIONATE DEVOTION  
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EXTENDED FAR BEYOND THE  
FIRM ITSELF. ”

## *firm* UPDATE

### APPOINTMENTS

#### ■ Ashly Boesche



Ashly has become a certified mediator in the Chicago Bar Association Mediation Service.

#### ■ Novaira Paul



Novaira was appointed Co-Chair of Intellectual Property Law Association of Chicago's Diversity, Equity, and Inclusion Committee.

#### ■ Robert Sacoff



Bob is a member of the Organizing Committee for the 2022 AIPPI Global IP Congress in San Francisco from September 9-13.

### PRESENTATIONS

#### ■ Jonathan Jennings



Jonathan spoke about right of publicity and trademark disputes involving identities used in social media and NFTs during a Strafford Live Webinar panel on June 28.

### PUBLICATIONS

#### ■ Jonathan Jennings

In May, 2022, PMTG's *Law Lore & Practice* published Jonathan's analysis of the USPTO's implementation of expungement, reexamination and letter of protest provisions

# *firm* NOTEWORTHY

## **America's Top 100 High Stakes Litigators**

**David Hilliard** has been selected among America's Top 100 High Stakes Litigators for Illinois.

## **Chambers USA-2022**

“**[Pattishall]** represents clients in a variety of industry sectors, including retail, energy, technology, and food and drink. The group brings a wealth of knowledge and experience to the areas of trademarks, copyright and unfair competition cases. Regularly engaged for trademark portfolio management needs, including registrations, clearance searches and the development of protection strategies.’ Clients find the team to be ‘very highly specialized, very knowledgeable and very experienced. They know what they are doing, they have a great rapport with the US Patent and Trademark Office and know all the people. They are a go-to firm if you want the work done thoroughly, I would recommend them anytime.’ One client says ‘They are focused on delivering value for the customer, connecting and understanding what the challenges are, and delivering flexible advice.’ Other sources describe the firm as ‘extremely responsive, creative and extremely knowledgeable about the law.’”

“**[David Hilliard]** has substantial experience in trademark, copyright and trade dress disputes. He provides expert advice to clients across a range of sectors.”

## **IP Stars, Managing Intellectual Property Magazine**

**David Hilliard** and **Bradley Cohn** have been recognized as Copyright stars and Trade mark stars Nationally and in Illinois by *Managing Intellectual Property* Magazine, and **Brett August**, **Jonathan Jennings**, **Janet Marvel** and **Phil Barengolts** have been recognized as Trade mark stars Nationally and in Illinois.

## **The Legal 500 United States**

Pattishall McAuliffe has again been recognized for its experience in trademark litigation and “non-contentious” trademark work. “With a strong record in intellectual property litigation, Chicago-based boutique firm Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP represents major global brands in high-profile trademark, dilution, counterfeit goods and trade dress lawsuits at the state and federal levels. Managing partner **Bradley Cohn** acts for clients across the automotive, food, tourism and telecoms sectors. **Jonathan Jennings** litigates contentious matters in energy and pharmaceuticals. **Phillip Barengolts** represents household names as a lead appellate counsel in the 2nd, 4th, 5th and 7th circuit courts. **Ashly Boesche** handles complex disputes for entertainment and fashion brands.”

Testimonials: “They are easy to work with and are incredibly knowledgeable. They are very responsive and provide detailed recommendations, which helps us in making proper decisions!” “I have been working with the Pattishall team for a long time now. My main contacts are **Jonathan Jennings** and **Phil Barengolts**. The team is unique as one complements each other in a perfect manner, in terms of specialism and in terms of method of working.” “Pattishall is unique because its sole focus and expertise is on soft-IP, primarily trademark law, which allows them to offer direct and pragmatic advice quickly and efficiently.”



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