

Trademarks

Trademark Services — Strengthening Brands and Protecting Reputations

Communication technologies and channels have evolved quickly, but the power of a positive reputation remains the same. As reliance on e-commerce and social media have grown and public opinion changes faster than the wind, today's brands are more valuable—and more vulnerable—than ever before. To protect their good names and market positions, businesses and organizations around the world choose Marshall, Gerstein & Borun LLP.

Decades of experience, focus and depth

Marshall Gerstein has maintained an exclusive focus on intellectual property issues since our Firm was founded more than 60 years ago. We have extensive knowledge of all aspects of trademark selection, registration, transactions, and enforcement. Attorneys in our group have nearly two decades of experience on average in trademark law, enabling us to develop and deliver practical, innovative strategies, and achieve efficiencies that can only result from a long and successful practice. No issue is too small or too large: drawing on our deep bench, we handle large portfolios and business-critical deals with the same skill and responsiveness that we provide when managing day-to-day client concerns.

As IP-focused litigators, we have achieved major victories in scores of cases before the Trademark Trial and Appeal Board and in U.S. district courts. We handle all forms of trademark advocacy, including infringement proceedings, opposition, cancellation, and concurrent use proceedings, and Uniform Dispute Resolution Policy proceedings against cybersquatters.

Market leaders

Marshall Gerstein has been ranked among the world's leading trademark firms by *Managing IP* and *World Trademark Review 1000*. Our trademark lawyers are sought-after writers and speakers who regularly provide thought leadership on emerging issues such as trademark tacking, offensive marks, and the eroding presumption of irreparable harm.

Comprehensive services

We serve as strategic business partners through every phase of branding strategy and protection, including:

- Advertising review and sponsorship
- Domain name acquisition, enforcement, registration, and maintenance
- E-commerce and social media issues
- Global brand strategies
- Litigation of trademark infringement and dilution cases
- Portfolio management
- Privacy and publicity rights
- Trade dress and design rights
- Trademark applications, opposition, and cancellation proceedings
- Trademark clearance, registration, and counseling
- Trademark licensing, due diligence, and transfers
- Trademark policing and enforcement

- Trademark Trial and Appeal Board proceedings
- Uniform Dispute Resolution Policy (UDRP) issues

To ensure comprehensive, international brand protection, we work with a network of trusted foreign associates to manage global trademark portfolios and enforcement programs in key jurisdictions around the world.

Lean staffing, value-added service

We believe that law firm services should align with client needs and business objectives. Our trademark teams provide top-quality legal services efficiently and with a clear understanding of internal deadlines and budget priorities. We have implemented numerous methodologies to streamline our overall processes, improve responsiveness, reduce overhead, offer alternative billing arrangements, and enhance value.

Leveraging technology

To protect our clients' brands and reputations from threats near and far, we employ sophisticated online systems and databases available for worldwide availability searches, application filings, and monitoring and maintenance of registered marks. We have developed proprietary, automated systems that improve client service and manage costs. These in-house systems allow us to report USPTO activity faster, accelerate document preparation for applications, amendments, and responses, and enable immediate access to client files and documents whenever questions arise.

Representative clients

- Amgen Inc.
- Baxter Healthcare Corp.
- BioMarin Pharmaceutical, Inc.
- CDW Corp.
- Crosman Corp.
- Emerson Electrical Co.
- Ivy Kirzhner New York
- Generation Brands
- Goss International Corp.
- JRS Pharma LP
- Knowles Electronics, LLC
- Maria Pinto Licensing, LLC
- Medela
- The Estate of Vivian Maier
- Onyx Pharmaceuticals
- Parrot SA
- Reliv International, Inc.
- Shop-Vac Corp.
- Splits59
- The Smoke Daddy
- Warner/Chappell Music, Inc.
- Zenith Electronics, LLP

Representative matter

- **Protecting an Orphan Drug**

We handled Raptor Pharmaceutical Corp.'s worldwide registration and defense of all trademarks covering PROCYSBI, a revolutionary drug that offers hope for sufferers of nephropathic cystinosis, a severe and often fatal metabolic disorder.

Client Successes

The Estate of Vivian Maier and John Maloof Reach Agreement

Vivian Maier, a prolific amateur photographer who has achieved international posthumous fame and acclaim, died intestate in 2009. John Maloof, a former real estate agent in Chicago, obtained thousands of Maier's photographic negatives and other works, in most cases, the only known copies of the works Maier created. After Maier's death, Mr. Maloof created a significant enterprise promoting, marketing, and selling prints of Maier's works, including the production and distribution of the Oscar-nominated motion picture, "Finding Vivian Maier." In 2014, the Estate of Vivian Maier, which is being administered by the Public Administrator of Cook County David A. Epstein, issued citations to discover assets to Maloof and his company to obtain information concerning possible copyright claims held by the Estate. Thereafter, the Estate entered into extensive settlement negotiations with Mr. Maloof and the gallery representing Mr. Maloof concerning the past and future exploitation of Maier's works.

In March 2016, Marshall, Gerstein & Borun LLP's Partner [Gregory J. Chinlund](#) successfully completed negotiations on behalf of the Estate with Mr. Maloof, resulting in a confidential settlement agreement. In May 2016, the Probate Court of Cook County approved the settlement.

The agreement between the Estate of Vivian Maier and Mr. Maloof establishes a cooperative structure that allows Mr. Maloof to continue to bring Ms. Maier's extraordinary photography to light while preserving her legacy.

Vanguard Approach to Protect IP Rights in Bankruptcy

Marshall, Gerstein and Borun LLP's [Tiffany D. Gehrke](#), Maureen Beacom Gorman and Julianne M. Hartzell forged new law in a recent intellectual property counterfeiting case. After the team had obtained a multi-million dollar judgment and an injunction, two of the defendants sought discharge of the injunction and financial judgment in bankruptcy court. Finding no published decisions, the team successfully argued that the injunction could not be discharged, analogizing intellectual property injunctions to environmental protection injunctions that prevent further pollution. The team argued that the IP injunctions should be excluded from discharge in bankruptcy because they do not constitute debts. The California bankruptcy court agreed with this novel argument and entered summary judgment in favor of the Firm's client, ruling that the injunction entered in the district court would be unaffected by the opposing party's bankruptcy filing and any resulting discharge.

This innovative application of bankruptcy law is Marshall Gerstein's most recent example of its vanguard approach to intellectual property enforcement. Over 50 years, Marshall Gerstein has had highly regarded experience in complex intellectual property litigation, enjoying a distinguished history before courts, including the United States Supreme Court in the landmark cases *Blonder-Tongue Labs, Inc. v. University of Illinois Foundation*, establishing the fundamental principle of offensive collateral estoppel, and *Walker Process Equipment, Inc. v. Food Machinery & Chemical Corporation*, setting forth the basic principles for antitrust liability under the patent laws.

Marshall Gerstein Successfully Defends Trademark of Clothing Company

In 2013, the Spanish fashion company Desigual opposed registration of the trademark DISIDUAL, owned by a growing Washington-based lifestyle company seeking to protect its "distinct individual" apparel for outdoors enthusiasts and active free spirits. Marshall Gerstein has dedicated hundreds of pro bono hours to defending Disidual's mark in the trial and recently secured a favorable decision from the Trademark Trial and Appeal Board (TTAB).

The TTAB dismissed Desigual's likelihood of confusion claim. Notably, the TTAB focused on the different pronunciation of the marks. The TTAB noted that "desigual" is a Spanish word with a known pronunciation (dezy-GWAL) and DISIDUAL is a coined term, likely to be pronounced "di-SID-jew-uhl," similar to the term "individual." "When a mark is a recognized word, even in a foreign language, the principle that there is no correct pronunciation of a mark does not apply," the opinion stated. The TTAB also noted that, when a mark is not a recognized word and the weight of the evidence suggests that consumers would pronounce it a particular way, it is error to ignore such evidence. The distinct pronunciation of the marks, combined with other factors, led the TTAB to conclude that Desigual had failed to prove that a likelihood of confusion existed.

Zebra Technologies Accelerates Strategic Growth with Deal to Acquire Matrox Imaging

When Zebra Technologies Corporation, a world leader in designing, manufacturing, and selling innovative software, hardware, and digital solutions, decided to accelerate its strategic growth in machine vision by acquiring the imaging division of Matrox, it turned to Marshall Gerstein to handle the complex IP issues involved in the carve-out acquisition. Executing an interdisciplinary approach, Marshall Gerstein assembled a small team with deep subject matter experience within our IP transactions, electrical engineering patent prosecution, and trademark practice groups to ensure a smooth and successful deal that protected Zebra's interests, particularly with respect to use of IP assets with applicability across multiple businesses.

Zebra notes that "the acquisition of Matrox Imaging expands the portfolio of machine vision products, software and services Zebra can offer customers to help them thrive in the on-demand economy that is constrained by both labor shortages and limited supply of upstream goods and materials," according to the company's press release.

[Read Zebra's press release on this intended acquisition made in part with the counsel of Marshall Gerstein.](#)