



## Maureen Beacom Gorman

Partner

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Maureen Beacom Gorman regularly advises clients with global intellectual property rights in a multi-disciplinary approach on all aspects of intellectual property portfolio management strategy, including acquisition and protection of intellectual property rights, investigation of counterfeit and other infringing uses of trademarks and copyrights, and enforcement in federal, state, and foreign courts, international arbitration bodies such as WIPO, and administrative bodies including U.S. Customs and Border Patrol and the Trademark Trial and Appeal Board. Maureen's invaluable familiarity with the inside workings of the United States Patent and Trademark Office as a former trademark examining attorney and her twenty years of practice form the background for her comprehensive understanding of the nuances of global portfolio strategy and guidance in trademark and copyright prosecution, enforcement, litigation, and licensing in the United States and internationally. She has handled trademark prosecution and/or protection for goods and services in all International Classes. She has extensive experience in consumer goods as well as the food, beverage, and hospitality industries. She was also a member of the International Trademark Association's U.S. Subcommittee on Anti-Counterfeiting and led the Internet enforcement task force for that committee.

In 2017, Maureen was named the exclusive winner in the International Law Office (ILO) Client Choice Awards "Intellectual Property–Trademarks" category for Illinois, an honor also bestowed upon her in 2015. She was named to the 2016 list of Litigation Trailblazers and Pioneers published by the *National Law Journal*, a list which identifies litigation professionals who bring about meaningful change through their work. Maureen has also been selected by her peers as a "Leading Lawyer" since 2016, and recognized by the *World Trademark Review (WTR)* in the *WTR 1000* rankings since 2014.



## Practices

- Copyrights
- IP Litigation
- Trademarks

## Industries

- Consumer Products
- Insurance & Financial Services
- Internet & Cyberlaw

## Representative Experience

- Led team that developed the Firm's copyrighted social media take down database to better enable clients' brand protection online.
- Secured transfer of domain name for software company through successful Uniform Dispute Resolution procedure.
- Successfully secured trademark protection for consumer goods company, overcoming merely descriptive refusal.
- Counseled consumer goods company in prosecution of consumer brand name and enforcement issues in nearly 150 countries worldwide.

Maureen has handled matters for a wide variety of industries and organizations, such as:

- Consulting Firms
- Clothing retailers and manufacturers
- Consumer goods and health products
- Food, beverage, and hospitality
- Media
- Religious organizations
- Educational institutions
- Advertising
- Software
- Insurance Companies

## Background and Credentials

From 2000 to 2002, Maureen worked as a trademark examining attorney in the United States Patent and Trademark Office. She focused on food and electronic products and all service classes.

After her departure from the USPTO, she continued to build her proficiency in the intellectual property field, founding her own trademark/copyright law practice in 2002. The guiding principles of her successful practice incorporated affordability, personal service, and ethical behavior. Her private practice began in insurance and commercial litigation.

Maureen has been selected as a trademark consultant in numerous Trademark Trial and Appeal Board (TTAB) actions as well as district court matters in numerous U.S. jurisdictions. Her litigation experience includes handling Opposition and Cancellation matters, *ex parte* appeals to the TTAB, and infringement and unfair competition actions in Illinois.

Maureen earned her J.D. from John Marshall Law School in 1997 and received a bachelor of arts degree from Marquette University in 1993.

## Education

- The John Marshall Law School (J.D.)
- Marquette University (B.A.)

## Bar Admissions

- District of Puerto Rico
- Illinois
- Michigan
- New Jersey
- Northern District of Illinois
- Southern District of New York
- U.S. Bankruptcy Court of Eastern District of California
- U.S. Bankruptcy Court of Western District of Washington
- Western District of Missouri

## Publications and Presentations

November 29, 2020

**"What is in a (Domain) Name? The Importance of Consumer Perception"**

*HotelExecutive*

November 12, 2020

**"Survival of the Fittest: Enforcement for the 2020 COVID-19 Trademarks"**

*Thomson Reuters Westlaw*

August 28, 2020

**"Panel Discussion on the Booking.com Supreme Court Discussion"**

*Chicago Women in IP (ChiWIP)*

June 30, 2020

**Your Internet Street Address is Safe: Generic.com Can Function as a Trademark if your Consumers Say So**

*Marshall Gerstein Alert*

September 1, 2015

**"The budgeting piece of the business of law" (featured quotes)**

*InsideCounsel*

September 9, 2011

**"E-commerce and Social Media: Defensive Strategies and Enforcement Options"**

*ICANN's New Generic Top-Level Domain (gTLD) Program*

August 24, 2011

**"Not All Endorsements Are Alike"**

*Medical Device + Diagnostic Industry*

February 8, 2011

**"Consumer Confusion or Profitable Promotion?"**

*Law Bulletin Corporate IP Conference*

February 3, 2011

**"The Future's So Green, I Gotta Wear Shades: 'Greening' Your Brand Without 'Greenwashing' It"**

*American Intellectual Property Law Association (AIPPLA) Mid-Winter Meeting Plenary Session*

April 9, 2010

**"What Does It Mean to Be Green: A Short Analysis of Emerging IP Issues in 'Green' Marketing"**

*John Marshall Law School's Green Issue Symposium + John Marshall Review of Intellectual Property Law*

February 27, 2009

**"It Isn't Easy Being Green - 'Green' Trademark Issues"**

*John Marshall Law School's 53rd Annual Intellectual Property Law Conference Developments in Patent, Trademark, Copyright & Trade Secrets Law*

July 14, 2008

**"Trademarks for Entrepreneurs"**

*Dominican University - Guest Speaker*

### Community and Professional Involvement

- Women's Bar Foundation (WBF), Vice President–External Affairs and Vice President–Fundraising
- Member of INTA's U.S. Subcommittee on Anti-Counterfeiting, 2013–2015
- International Trademark Association (INTA)

### Representative Matters

- *Universal Protein Supplements Corporation vs. Dalech LLC*, NAF Claim No. FA0908001278030 (2009) (Pfeuffer, Arb.). Attorney for petitioner in contested Uniform Dispute Resolution Action before the National Arbitration Forum (UDRP). Award: Domain name transferred.
- *General Council of the Assemblies of God vs. DomCollect Worldwide Intellectual Property AG*, NAF Claim No. FA0904001259727 (2009) (Yachnin, Arb.). Attorney for petitioner in contested Uniform Dispute Resolution Action before the National Arbitration Forum (UDRP). Award: Domain name transferred.
- *AFN Broker LLC vs. Champion Performance Products, Inc.* Attorney for petitioner in likelihood of confusion dispute. Settled.
- *The General Council of the Assemblies of God, DBA Gospel Publishing House vs. GPH Investments Incorporated.* Attorney for opposer in likelihood of confusion dispute. Application withdrawn. Case dismissed.
- *The General Council of the Assemblies of God, DBA Gospel Publishing House vs. GPH Partners, LLC.* Attorney for potential opposer in likelihood of confusion dispute. Settled.
- *Linda S. Potter vs. Stephanie Flanagan*, NAF Claim No. FA0801001139692 (2008) (Johnson, Arb.). Attorney for petitioner in Uniform Dispute Resolution Action before the National Arbitration Forum (UDRP). Award: Domain name transferred.

- *In re Surveys & Forecasts, LLC*. Attorney for appellant in ex parte appeal of genericness refusal. Refusal withdrawn. Appeal terminated.
- *Los Angeles Lakers, Inc. vs. Margaret Kilbane*. Attorney for potential defendant in likelihood of confusion dispute. Settled.
- *CAPSIM Management Simulations, Inc. formerly Park Li Management Simulations, Inc. vs. The Fund for American Studies*. Attorney for opposer in likelihood of confusion dispute. Opposition sustained.
- *Universal Protein Supplements Corporation d/b/a Universal Nutrition vs. Natural Organics Inc.* Attorney for petitioner in likelihood of confusion dispute. Settled.
- *CAPSIM Management Simulations, Inc. vs. Sharon Bender*. Attorney for opposer in likelihood of confusion dispute. Opposition sustained.
- *Universal Protein Supplements Corporation DBA Universal Nutrition vs. Discovery Communications, Inc.* Attorney for potential opposer in likelihood of confusion dispute. Settled.
- *Hormel Foods Corporation vs. The Creative Concept*. Attorney for potential defendant in likelihood of confusion dispute. Settled.
- *Entoleter LLC vs. Grain Machinery Mfg. Corp.* Attorney for defendant in likelihood of confusion dispute. Opposition withdrawn pursuant to settlement.
- *Park Li Management Simulations, Inc. d/b/a Management Simulations vs. Interpretive Software, Inc.* Attorney for opposer in likelihood of confusion dispute. Settled.
- *Park Li Management Simulations, Inc. v. Interpretive Software, Inc.*, Case No. 1:05-cv-06627 (N.D. Ill. Settled May 16, 2007). Attorney for plaintiff/counter-defendant in suit alleging trademark infringement with Anti-Cybersquatting Act counterclaim.
- *In re James J. O'Brien*. Attorney for appellant in ex parte appeal of likelihood of confusion refusal. Refusal withdrawn. Appeal terminated.
- *Park Li Management Simulation, Inc. vs. LaPorte Holdings, Inc.*, NAF Claim No. FA0411000363984 (2005) (Yachnin, Arb.). Attorney for petitioner in Uniform Dispute Resolution Action before the National Arbitration Forum (UDRP). Award: Domain name transferred.
- *In re Donna Lee Murphree*. Attorney for appellant in ex parte appeal of identification refusal. Amendment filed. Appeal terminated.
- *Revolution, Incorporated v. Revolution Bodywear, Incorporated et al.*, Case No. 4:05-cv-40083 (E.D. Mich. Settled August 3, 2005). Subsequent attorney for defendant in suit alleging breach of prior settlement of Lanham Act suit.
- *The North Face Apparel Corp. vs. Xueyan Liu*. Attorney for defendant in likelihood of confusion dispute. Settled.
- *K-2 CORPORATION vs. Xueyan Liu*. Attorney for defendant in likelihood of confusion dispute. Settled.
- *Universal Nutrition v. Carbolite Foods, Inc., et al.*, Case No. 3:03-cv-03265 (D. N.J. Stipulated Dismissal September 20, 2004). Member of plaintiff's team of attorneys in Lanham Act suit.

- *In re Robert J. Dunn*. Attorney for appellant in *ex parte* appeal of likelihood of confusion refusal. Refusal withdrawn. Appeal terminated.
- *In re Continuum Care Corp.*, App. No. 75026799 (TTAB 2001). Attorney for USPTO in *ex parte* appeal of USPTO's genericness refusal. TTAB affirmed USPTO genericness refusal.