



Richard M. LaBarge

Partner

Tel 312.474.6646
rlabarge@marshallip.com

Richard M. LaBarge is the founder of the Firm's trademark practice. He was privileged to learn the fundamentals while working on cases with Saul Lefkowitz, for whom INTA's moot court competition is now named. The seven figure judgment he won early in his career for one client was, at the time, one of the largest ever issued in that circuit in a trademark infringement case. Now recognized for his efficient handling of unusual cases, he successfully opposed the registration of the "thumpa-thumpa" sound of motorcycles as a federal trademark, is one of the few lawyers to have successfully registered a color alone as a trademark (green for one client, blue for another), and once secured allowance of an application to register the taste of apples as a trademark. He is currently coordinating the international trademark portfolios of pharmaceutical companies and guiding another of the world's leading consumer products companies on portfolio management and graymarket issues.

In addition to his Martindale-Hubbell® AV Peer Review Rating™, he has been selected by the *Law Bulletin Publishing Company's* Leading Lawyers division as a "Leading Lawyer." In 2013, he was selected as a "Top Rated Lawyer in Intellectual Property" by *American Lawyer Media (ALM)* and Martindale-Hubbell. He was also recognized by the *World Trademark Review (WTR)* since 2014 in the *WTR 1000* rankings. He was also selected by his peers for inclusion in the 2018–2021 editions of *The Best Lawyers in America*® in his practice area.



Practices

- Design Patents
- Patent Prosecution
- Trademarks
- ITC 337 Investigations

Industries

- Consumer Products
- Industrial & Mechanical Technologies
- Insurance & Financial Services
- Pharmaceutical

Representative Matters

- Tailored an efficient suite of protection for a consumer goods company and its new style of paper packaging products. Under time pressure, he devised an effective strategy to consolidate the number of filings while also providing a broader scope of protection than commonly seen in the industry. This approach provided better control and market benefits for the company by making it tougher for competitors to copy without infringing, while also reducing client costs.
- In a litigious industry, combined utility patent and design patent filings for a world-leading manufacturer to provide broad protection for a new line of innovative sprayer products that help to prevent the spread of mosquito-borne diseases. This approach is helping to secure the client's line in the marketplace and may help to provide defenses or possible counterclaims if competitors assert unjustified claims against the client.

Background and Credentials

The patents and trademark registrations that he has helped to obtain cover a wide range of products, and Richard has gained particular experience with consumer products companies and pharmaceutical companies. His litigation practice has brought him before U.S. district courts throughout the nation as well as before the Trademark Trial and Appeal Board for the U.S. Patent and Trademark Office and the U.S. International Trade Commission.

Internationally, he works closely with foreign agents in obtaining and enforcing foreign trademark rights, efficiently coordinating resolution of issues on a multi-national basis.

Richard brings an engineer's mindset to his work. He is not just analytical, but also passionate about identifying the essence of what makes products and marketing valuable. He helps guides clients to portfolio of rights that efficiently and forcefully protects the most critical aspects of their business. In trademark counseling, he recognized—before “trademark bullying” became a buzzword—that overzealous trademark policing can damage something even more valuable than a company's mark: its reputation.

Education

- Wake Forest University School of Law (J.D.)
- University of Illinois, Urbana-Champaign (B.S.)
 - Civil Engineering

Bar Admissions

- Illinois
- U.S. Court of Appeals, Federal Circuit
- U.S. Court of Appeals, Second Circuit
- U.S. Court of Appeals, Seventh Circuit
- U.S. District Court, Central District of Illinois
- U.S. District Court, District of Colorado
- U.S. District Court, Northern District of Illinois
- U.S. International Trade Commission
- U.S. Patent and Trademark Office

Publications and Presentations

January 18, 2019

"Smells Like Trademark Infringement: Nirvana Sues Over Smiley Face Logo" (featured quotes)

IPWatchdog

January 11, 2019

"Marc Jacobs Accused of Copying Nirvana's Smiley Face" (featured quotes)

Intellectual Property Magazine

January 3, 2019

"Lawyers Cast Doubt on Nirvana Claims Against Marc Jacobs" (featured quotes)

World Intellectual Property Review

January 3, 2019

"Hey! Wait! Nirvana's Got a New Copyright Complaint" (featured quotes)

Managing Intellectual Property

November 15, 2018

"EU High Court Rejection of Copyrights for Food Tastes Worries Rights Holders" (featured quotes)

Intellectual Property Watch

July/August 2018 Issue

"Learning from Apple v Samsung"

Intellectual Property Magazine

June 18, 2018

"Samsung Fights Apple's \$539M 'Excessive' Award" (featured quotes)

Intellectual Property Magazine

December 7, 2016

"A Blunted Sword: Supreme Court Reverses \$400M Award in Samsung Electronics v. Apple"

Marshall Gerstein Alert

December 7, 2016

"Samsung v. Apple: SCOTUS decision 'only scratches the surface'" (featured quotes)

World Intellectual Property Review

December 7, 2016

"Samsung v. Apple: SCOTUS redefines article of manufacture" (featured quotes)

Managing Intellectual Property

December 7, 2016

"Lawyers weigh in on design patent defeat in Apple/Samsung smartphone case (U.S.)" (featured quotes)

Westlaw Journal, Intellectual Property

May 2011

"Patents Foster Innovation"

Medical Design Magazine

May 2015

"The teachings of Hana and B&B, the U.S. Supreme Court's two new trademark decisions"

IPPro The Internet

March 24, 2015

"Supreme Court Decision Will Impact Procurement and Enforcement of US Trademark Rights" "Getting From Bench-to-Bedside"

Marshall Gerstein Alert

March 24, 2015

"Attorneys React To Supreme Court's TTAB Preclusion Ruling" (featured quotes)

Law360

December 1, 2014

"SCOTUS to decide if lynchpin of trademark infringement cases can be decided by USPTO"

InsideCounsel

October 17, 2014

“SCOTUS considering arguments that will change the way you think about registering trademarks”

InsideCounsel

June 26, 2014

“Internet Companies Streaming Copyrighted Television Broadcasts to Subscribers Must Pay Retransmission Fees”

Marshall Gerstein Alert

January 10, 2014

“Federal Circuit Explains Significance of Deleting Drawings from Design Patent Applications”

Marshall Gerstein Alert

November 15, 2013

“Distinctive Visual Elements of CRACKER BARREL Logo Insufficient to Defeat Kraft Trademark Challenge”

Marshall Gerstein Alert

December 13, 2011

“Huffington Post.xxx. Could It Happen to You Too?”

Forbes

October 26, 2011

“‘BBX’ Spells Trouble for Research in Motion”

E-Commerce News