



## Gregory J. Chinlund

Partner

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For start-up to multi-national companies with trademarks to develop and protect in the U.S. and internationally, Marshall Gerstein partner Greg Chinlund adeptly protects their brands—the ultimate value of a company. Similarly, for clients that gain a competitive advantage from novel product design, he counsels clients to capture maximum protection from design patents in order to enhance the value derived from industrial design. He also proactively counsels clients on copyrights, helping negotiate effective agreements and enforcing rights when necessary. Greg's balance, diverse experience, and pragmatic approach, together with an education and background in marketing and business, uniquely position him to serve as a critical legal resource for clients.

Greg holds a Martindale-Hubbell® AV Preeminent Peer Review Rating and was selected as a 2013 “Top Rated Lawyer in Intellectual Property” by *American Lawyer Media (ALM)* and Martindale-Hubbell. Since 2013, he has been recognized by the *World Trademark Review (WTR)*, and as an “IP Star” in the *Managing Intellectual Property IP Stars Survey*. He was selected for inclusion in the *Illinois Super Lawyers®* lists since 2014. Only five percent of the lawyers in the state are recognized each year. He has also been voted a “Leading Lawyer” by his peers since 2015. Since 2024, Greg has been selected for inclusion in *The Best Lawyers in America®* list in the practice area of Patent Law.



### Practices

- Copyrights
- Design Patents
- IP Litigation
- Trade Secrets
- Trademarks

### Industries

- Consumer Products

- Internet & Cyberlaw
- Medical Devices

## Representative Experience

- Counsels globally recognized airline on matters critical to its marketing functions such as trademark clearance, prosecution and enforcement. Greg assisted the client with protecting a family of marks born from a recent branding initiative internationally and provided strategic advice regarding filing strategy as to avoid possibly leaking the theme of the campaign prior to launch.
- Serves as primary trademark counsel to orphan drug company with proven track record for quickly bringing new pharmaceutical products to market. The client and Greg work closely to clear groups of proposed pharmaceutical names and to register and protect adopted marks, including for the client's flagship drug, in more than 100 countries around the world.
- Handles trademark matters designated "complex" by in-house counsel for global healthcare company operating in the fields of medical devices, pharmaceuticals and, biotechnology.
- For an industry-leader in the manufacture of electronic components for hearing aids, phones, and headsets; Greg counsels the client on all trademark matters—from conception and clearance to prosecution and enforcement—to ensure protection of the client's brands, which are synonymous with high quality.

## Background and Credentials

Greg counsels and assists clients with protecting goodwill that has been developed over many years and helps newer companies develop and protect brands that can become the most valuable assets of the business. During his years of trademark practice, more than 10 of those years serving as chair of Marshall Gerstein's Trademarks and Copyrights practice groups, he has provided hundreds of opinions to and prosecuted hundreds of applications on behalf of clients as well as represented clients in inter partes proceedings before the U.S. Patent and Trademark Office Trial and Appeal Board and trademark infringement cases. With many of the firm's clients conducting business internationally, he also assists with registering and enforcing trademark rights worldwide.

In the area of copyright law, he has helped clients—including marketing professionals, artists, musicians, movie producers, photographers, programmers and software developers, writers, and others—protect, enforce and derive economic benefit from their artistic endeavors throughout the creative process.

Greg's skill set is the result of these diverse work experiences as well as presentation of cases in the state Appellate and Illinois Supreme Court, which resulted in wins for clients in non-intellectual property related cases.

His education in marketing and personal business experience, as well as years of working with marketing professionals, has provided him with an intimate understanding of the business mind set. As a result, he understands the value of avoiding unnecessary legal posturing when a conflict arises so that the parties can resolve the matter and return to business as usual.

Greg received his J.D., *cum laude*, from Northern Illinois University College of Law and received his bachelor's degree in marketing from Iowa State University.

## Education

- Northern Illinois University College of Law (J.D., *cum laude*)

- Iowa State University (B.A.)
  - Marketing

## Bar Admissions

- Illinois
- U.S. District Court, Northern District of Illinois

## Publications and Presentations

- "[Analyzing the Supreme Court Ruling on the Time Bar and Copyright Infringement Claims](#)," *Today's General Counsel*, Co-Author, September 16, 2024.
- "[Supreme Court Rejects 'Judicially Invented Damages Limit' for Copyright Infringement](#)," *Marshall Gerstein Alert*, Co-Author, July 23, 2024.
- "What are the Copyright Implications of NFTs?," *Reuters Westlaw Today*, Co-Author, October 29, 2021.
- "[Hand It Over—Trademark Infringers' Profits at Risk Even Without Proof of Willfulness](#)," *Marshall Gerstein Alert*, Co-Author, April 28, 2020.
- "[Music to Your Ears: Best Practices for Prosecuting Sound Mark Applications](#)," *INTA Bulletin*, Vol. 74 No. 17, Co-Author, October 1, 2019.

*See Greg's additional thought leadership.*

## Community and Professional Involvement

- Member of the firm's Finance Committee and former member of the firm's Marketing & Business Development Committee.
- International Trademark Association.
- Pharmaceutical Trademark Group.
- Lawyers for the Creative Arts, a not-for-profit organization, providing counsel on a pro bono basis for starving artists in need of legal assistance but without the financial means to pay for it.
- Chicago Jets Tier II Ice Hockey Coach.
- Licensed Real Estate Broker in Illinois.
- Former National Football League Players Association (NFLPA) Certified Contract Advisor.

## Insights

September 16, 2024

### **"Analyzing the Supreme Court Ruling on Time Bar and Copyright Infringement Claims"**

Today's General Counsel

July 23, 2024

### **Supreme Court Rejects "Judicially Invented Damages Limit" for Copyright Infringement**

Marshall Gerstein Alert

October 29, 2021

**"What are the Copyright Implications of NFTs?"**

Reuters Westlaw Today

April 28, 2020

**"Hand It Over—Trademark Infringers' Profits at Risk Even Without Proof of Willfulness"**

Marshall Gerstein Alert

October 1, 2019

**"Music to Your Ears: Best Practices for Prosecuting Sound Mark Applications"**

INTA Bulletin Vol. 74 No. 17

June 21, 2017

**"U.S. Top Court Finds Law Banning Offensive Trademarks Unconstitutional" (featured quotes)**

Westlaw Journal Intellectual Property

June 20, 2017

**"'Simple and Correct' or 'Tremendous Damage to Minorities?' Opinion Split on Matal v. Tam Decision" (featured quotes)**

World Trademark Review

June 19, 2017

**"Viewpoint Discrimination in the Lanham Act: No More?"**

Marshall Gerstein Alert

March 28, 2017

**"Apart at the Seams – Copyright Protection for Apparel: Star Athletica, LLC v. Varsity Brands, Inc."**

Marshall Gerstein Alert

March 2, 2017

**"Lee v. Tam"**

Intellectual Property Magazine

February 16, 2017

**"From forum-shopping to the UPC: 10 IP issues to watch in 2017" (featured quotes)**

World Intellectual Property Review

January 23, 2017

**"Racial slurs, free speech at issue in 'Slants' trademark case (U.S.)" (featured quotes)**

Westlaw Journal, Intellectual Property

January 20, 2017

**"'The Slants' SCOTUS trademark battle hearing begins" (featured quotes)**

Intellectual Property Magazine

January 19, 2017

**"Lee v. Tam: SCOTUS Provides 'Scant' Insight into View on Case" (featured quotes)**

World Intellectual Property Review

October 15, 2015

**"Bull or Bully: His Airness and IP Rights and Wrongs"**

Trademark & Copyright Strategy Summit: Chicago

December 12, 2014

**“Be careful what you ask for: A cautionary tale for exclusive trademark licensees”**

InsideCounsel

September 9, 2011

**“E-enforcement: Confronting Online Offenses”**

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?”**

Served as panel speaker and discussed current copyright/trademark trends at the Law Bulletin Corporate IP Conference

January 2011

**“Helping Clients Stay a Few Steps Ahead in the Electronic World”**

Inside the Minds - Recent Trends in Trademark Protection: Leading Lawyers on Advising Clients, Reviewing Trademark Strategies, and Responding to Recent Fraud, Aspatore Books

December 3, 2010

**“The Growing Problem of Trademark Registration and Domain Name Scams”**

IPToday

## **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.

### **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.