

Michael G. Kelber

Partner / Co-Chair

OVERVIEW

Michael, co-chair of the firm's Intellectual Property practice group, provides strategic counsel to established enterprises and entrepreneurs concerning the development and protection of extensive global intellectual property portfolios. He represents clients from a wide range of industries, including consumer electronics, restaurants, retail housewares, beverage manufacturing, software, entertainment and a variety of technology-focused industries.

Michael has served as lead counsel in trials before state and federal courts throughout the country, and he represents clients in all phases of complex copyright, trademark and patent disputes. Michael also develops proactive risk management strategies that enable brand portfolios to successfully launch and evolve, avoid costly litigation, and overcome intellectual property attacks with a pre-designed litigation strategy.

Michael has prepared and prosecuted thousands of successful U.S. and foreign patent and trademark applications covering numerous brands, products and designs. He frequently negotiates and prepares critical agreements connected to his clients' portfolios, including patent, trademark and software development licenses, information technology and development agreements, music and book publishing agreements, and film production and distribution agreements.

Before his legal career, Michael worked for a large communications company for six years managing all of its Midwest and Northwest internal office telecommunications needs. This practical business experience has given him valuable insight into how concise communication, risk assessment and pooling resources are critical to enabling clients to make sound business and legal decisions.



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EDUCATION

Chicago-Kent College of Law (J.D., 1996)

University of Illinois at Urbana-Champaign (B.S., 1989)

RELATED SERVICES

Intellectual Property
Trademarks, Copyrights & Trade Secrets
Trademark Prosecution
Portfolio Management
Patents
Patent Prosecution
Advertising & Social Media
Advertising Clearances
Cobranding Agreements
Sweepstakes & Contest Counseling
Litigation & Disputes
Intellectual Property Litigation & Enforcement

EXPERIENCE

Representative Matters:

- *GI Sportz, Inc. v. APX Gear, LLC* (C.D. Cal.) – Upon appeal to the U.S. Court of Appeals for the Ninth Circuit, won complete reversal regarding a trade dress infringement claim, paving the way for pursuit of a preliminary injunction.
- *GI Sportz, Inc. v. Valken, Inc.* (D. N.J.) – Won a preliminary injunction against Valken Inc. prohibiting the sale or offer for sale of paintballs of similar appearance to GI Sportz's Marballizer® paintballs.
- *Beats Electronics LLC. v. Fanny Wang Headphone Company Inc.* (N.D. Cal.) – Obtained a favorable settlement in a product configuration trade dress infringement case over audio headphones.
- *Neuros Co., Ltd. et al. v. Kturbo, Inc.* (N.D. Ill.) – Obtained a favorable victory at trial on several counts for a supplier of turbo blowers against allegations of unfair competition and defamation.
- *Snap-On Incorporated v. Robert Bosch, LLC.* (N.D. Ill.) – Successfully defended a manufacturer of automotive technology products against a temporary restraining order in a patent infringement case.
- *World Impressions, Inc. v. Disney Enterprises, Inc. and McDonald's Corporation* (N.D. Ill.) – Prevailed on summary judgment and secured award of attorneys' fees in this case involving unfair competition, dilution, anticybersquatting, copyright infringement and related state claims case.
- *McDonald's Corporation v. Moses Samuel, d/b/a McFleishig's Express* (S.D. N.Y.) – Obtained preliminary injunction and consent judgment in a trademark infringement case.
- *R.P. Scherer Technologies, Inc.; R.P.S. Technical Services, Inc. and Pursuit Marketing, Inc. v. Brass Eagle, Inc.* (W.D. Ark.) – Argued for preliminary injunction against an infringer of a novel product configuration trade dress, forcing a settlement under which the defendant ceased all sales of the infringing paintball product.
- *McDonald's Corporation v. 2 Bell, N.V* (Trademark Trial and Appeal Board) – Obtained judgment sustaining opposition after trial, barring U.S. trademark registration of infringing mark.
- *Alexander Global Promotions v. McDonald's Corporation* (D. Wash.) – Successfully defeated plaintiff's attempt to halt major regional product promotion and ultimately reached favorable settlement on the eve of trial in a copyright infringement claim.
- *Sea-Watch v. Maptech, Inc.* (N.D. Ill.) – After Markman hearing briefing, forced dismissal with prejudice of patent infringement suit against our client.
- *Zenith Electronics Corp. v. Elo Touchsystems, Inc.* (N.D. Ill.) – Upon appeal to the U.S. Court of Appeals for the Federal Circuit, established right of a defendant to assert an unfair competition claim in response to a plaintiff's public claim of patent infringement.



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- *R+L Carriers, Inc. v. Pegasus TransTech Corporation* (S.D. Ohio) – Forced an early dismissal against the client in a multidistrict litigation patent infringement case.
- *Dixon v. State of Illinois Lottery* (Ill. State Ct.) – Successfully defended our client against an alleged violation of Illinois Right of Publicity Act claim.
- *Frankel v. RPG* (S. Ct. N.Y.) – Defeated right of publicity claim on summary judgment.

Intellectual Property Counseling Experience:

- Regularly manage the global trademark and patent portfolio for a famous electronics brand consisting of more than 1,000 domestic and foreign trademark registrations and 140 patents in more than 60 countries.
- Regularly advise several international restaurant chains regarding policing and maintaining their trademark rights in their family of famous marks.
- Regularly represent clients on issues relating to disseminating intellectual property and conducting promotional activity over the Internet.
- Regularly represent clients in the acquisition, sale or merger of businesses with respect to due diligence and deal points relating to intellectual property rights.
- Spearheaded a worldwide anti-counterfeiting program for a famous consumer electronics brand.
- Represented a significant online travel company in a multimillion-dollar outsourcing private label deal.
- Represented a major Illinois utility in negotiating a \$50 million enterprise resource management consulting agreement to integrate the software and hardware acquired from four different providers to create a comprehensive customer service, billing and technician-dispatch system.
- Represented a major IT consulting firm in negotiating over 20 consulting engagements with insurance and financial services companies. These engagements included master consulting agreements, specific project orders and change orders.
- Prepared and negotiated numerous trademark license agreements, including licenses for toys, food products, sporting goods and joint marketing agreements.
- Prepared and negotiated various book publishing agreements.
- Prepared patent clearance opinions related to automotive transmissions, e-commerce business method patents, sporting goods, numerous household goods, pneumatic equipment and other technologies.
- Prepared and prosecuted patents related to e-commerce platforms, computer equipment, home products, sporting goods and other technologies.



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RECOGNITIONS

- *Chambers USA: America's Leading Lawyers for Business*, 2017-present
- *The Best Lawyers of America*, 2016-present
- *World Trademark Review*, 2014-present
- *Illinois Super Lawyers*, 2016-present

NEWS/EVENTS

08.20.19 In The Media

Michael Kelber Quoted in *World Trademark Review*

08.15.19 Publication

45 Neal Gerber Eisenberg Attorneys Included in 2020 Best Lawyers

08.12.19 Publication

Michael Kelber Quoted in *World Trademark Review*

08.05.19 In The Media

Michael Kelber Quoted in Associated Press Article on Katy Perry Lawsuit

06.11.19 Firm News

The Legal 500 USA Recommends Five Neal Gerber Eisenberg Practices and 19 Attorneys in the 2019 Edition

04.25.19 Firm News

Neal Gerber Eisenberg Secures 11 Ranked Practice Groups and 20 Recognized Attorneys in the Chambers USA 2019 Edition

04.16.19 In The Media

Michael Kelber Quoted in *World Intellectual Property Review*

03.21.19 Publication

Client Alert: U.S. Supreme Court Mandates Copyright Registration to Litigate Infringement Claims

03.06.19 In The Media

Michael Kelber Quoted in *World Intellectual Property Review*

02.05.19 Firm News

Neal Gerber Eisenberg's Intellectual Property Practice Receives Top Ranking in *World Trademark Review* 1000

08.15.18 Firm News

45 Neal Gerber Eisenberg Attorneys Included in 2019 Best Lawyers

05.03.18 Firm News

Neal Gerber Eisenberg Secures 11 Ranked Practice Groups and 26 Recognized Attorneys in the Chambers USA 2018 Edition



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05.01.18 Publication

Blurred Lines and Divergent Views

01.25.18 Firm News

Neal Gerber Eisenberg's Intellectual Property Practice Receives Top Ranking in World Trademark Review 1000

08.15.17 Firm News

44 Neal Gerber Eisenberg Attorneys Included in 2018 Best Lawyers

06.20.17 In The Media

Michael G. Kelber Quoted in *World Trademark Review* and *World Intellectual Property Review*

06.16.17 Firm News

Neal Gerber Eisenberg Recognized for the Information Technology and Telecom Deal of the Year Award at 9th Annual International M&A Awards

05.26.17 Firm News

Chambers USA Ranks 11 Neal Gerber Eisenberg Practice Groups and 21 Attorneys in the 2017 Edition

05.03.17 In The Media

Michael G. Kelber Quoted in *World Intellectual Property Review*

04.05.17 Firm News

Neal Gerber Eisenberg Secures Trademark Win for Vacation Rental Partners, LLC

03.22.17 Firm News

Michael Kelber Honored with Keshet 2017 Guardian of Hope Award

01.25.17 Firm News

World Trademark Review 1000 Recognizes Three Neal Gerber Eisenberg Attorneys, IP Practice

12.07.16 Publication

Offensive Marks and Free Speech

ADMISSIONS

Bar Admissions

- Illinois

Court Admissions

- U.S. Supreme Court
- U.S. Court of Appeals for the Federal Circuit
- U.S. Court of Appeals for the Seventh Circuit
- U.S. Court of Appeals for the Ninth Circuit
- U.S. District Court for the Northern District of Illinois



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- U.S. District Court for the Northern District of Illinois (Trial Bar)
- U.S. District Court for the Northern District of California
- U.S. District Court for the Central District of California
- U.S. District Court for the Southern District of California
- U.S. District Court for the Southern District of Ohio
- U.S. District Court for the District of Colorado
- U.S. District Court for the Southern District of Florida
- U.S. District Court for the Eastern District of Michigan
- U.S. District Court for the District of Minnesota
- U.S. District Court for the Southern District of New York
- U.S. District Court for the Eastern District of Texas