

# Michael G Kelber

**WTR says:** Michael Kelber acquits himself with rare distinction in prosecution and litigation. Not only is the quality of his work extremely high, but he elevates those around him through his outstanding leadership abilities and personal qualities.

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## Biography

Michael G Kelber, co-chair of Neal Gerber Eisenberg's IP group and a member of its executive committee, helps enterprises and entrepreneurs to strategically develop and protect extensive global IP portfolios. He has prepared and prosecuted thousands of successful US and foreign trademark and patent applications and has served as lead counsel in trials before state and federal courts throughout the country. He represents clients in all phases of complex trademark, copyright and patent disputes.



**Before your legal career, you worked for a large communications company. What key skills did you develop in this role that have helped you in the field of intellectual property?**

Working at a global telecoms corporation taught me how large companies are organised and run, which from day one as a lawyer helped me to understand and navigate client pressures, deadlines and priorities, and learn how to make and implement decisions. These lessons were further honed in several stints working on secondment in the IP group of a top 50 worldwide brand owner. These experiences have greatly helped in navigating business issues and providing productive counsel that retains focus on both the current and future needs of my clients. Knowing how all the different facets of a large organisation interrelate – from marketing and legal to R&D and accounting – provides me with a valued view of the bigger picture. I can devise helpful strategies and tactics that in-house leaders may not have previously seen from within the organisation.

**What is the secret to negotiating a watertight licensing agreement?**

If there is a secret, it is understanding your client's business and the business objectives it wants to achieve through the licence agreement. Understanding what is at stake (eg, the possible commercial contingencies) is key to drafting and negotiating the licence. The interests of the licensor are different, but not always diametrically opposed, to those of the licensee. As a licensor, your focus is to protect the brand at all costs. As a licensee, you will want to maximise a return on your investment. One thing that benefits both sides is clear and concise drafting, particularly on risk allocation and exit terms.

**How do you build and maintain long-lasting client relationships?**

Our approach is to tailor each relationship to each client, thoroughly learning its business so that we can offer value by anticipating its needs. This is the best way to understand, meet and exceed clients' expectations. When they see that you can concisely, efficiently and effectively address their issues, particularly their complex long-term strategic goals, you foster trust and lay the cornerstone for a long-

term relationship. You also need to establish trust by explaining the potential downsides of strategies or actions they may be considering.

**You represent clients in a range of technology-related industries. What are the biggest challenges that these companies currently face, particularly online, and how can they be overcome?**

Right now, and for the foreseeable future, the spectre of covid-19 is affecting all clients. In addition to the negative toll taken on communities, families and individuals, the epidemic has changed the outlook, priorities and strategies of our clients. Some clients have taken advantage of government loan programmes. For many other businesses, supply chains have been upended or disrupted, and getting products to market has been a struggle. Finally, the havoc wreaked on the hospitality industry has been profound. On the growth side, however, online commerce has exploded, which increases the focus on counterfeiting and other online hazards. We are seeing leading global e-commerce presences taking the threat of counterfeiting much more seriously and considering – or already taking actions to protect – their retailers' and suppliers' brands and products. Keeping a close watch on evolving online marketplace brand protections will continue to be key going forward.

**How do you see your practice changing in the next five years?**

The implementation of the remote work environment is reverberating throughout the legal field and legal practice. It has changed how attorneys interact with clients. It is my hope that in the not too distant future we will regain the ability to meet face to face with our clients, but there are many constraints in place at present. At my firm, we are lucky, because we have a high comfort level with telecommunications, and we had the technological infrastructure in place to immediately adapt. But meeting the needs of our clients and fostering and maintaining those long-term relationships is crucial. Also, in the short term, the pace of litigation has slowed, but we anticipate courts adapting, perhaps through the use of virtual/video depositions and other legal telecoms applications, for legal practice to keep up with the times. What will not change is the importance of strong communications at the heart of our client relationships.