



Mark I. Feldman

Retired Senior Counsel

Chicago

T: +1 312 368 7084

F: +1 312 630 7316

Mark Feldman's practice focuses on trademarks, patents, copyrights, trade secrets, domain names, the Internet, social media and technology law.

Mark has extensive experience counseling clients on domestic and international intellectual property registration, enforcement and licensing. His litigation experience includes oral arguments before the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board of the United States Patent and Trademark Office. He has litigated the protectability of color as a trademark in cases relating to low-calorie sweeteners, golf club shafts, and prescription pharmaceuticals; the enhanced scope of protection for famous trademarks like NutraSweet; trademark priority disputes; the genericness of a religious leader's name; and the protection of the distinctive interior design and exterior trade dress of franchised restaurants. He has litigated and conducted oral arguments before the Court of Appeals for the Federal Circuit, the Trademark Trial and Appeal Board of the USPTO, and various federal district courts.

RELATED SERVICES

- Intellectual Property and Technology
- Trademark and Copyright
- Litigation, Arbitration and Investigations
- Mergers and Acquisitions
- Corporate

RELATED SECTORS

- Life Sciences

EXPERIENCE

Representative Cases

- *Osho International Foundation v. Osho Friends International* (TTAB 2009). Successfully petitioned to cancel and opposed 13 trademark registrations and applications, with the Trademark Trial and Appeal Board finding that the term OSHO is a generic term that cannot be exclusively appropriated by anyone
- *MB Financial Bank v. MB Real Estate* (N.D. Ill 2003). Successfully defended preliminary injunction in trademark infringement case
- *NutraSweet Co. v. K&S Foods, Inc.*, 4 U.S.P.Q. 2d 1964 (TTAB 1987). Successfully upheld that NutraSweet is a famous mark and that Nutra Salt was confusingly similar and denied registration as a trademark

CREDENTIALS

Admissions

- Illinois
- United States Patent and Trademark Office

Recognitions

Mark is commended in the *WTR 1000: The World's Leading Trademark Professionals 2017*.

Chambers USA has ranked Mark at its highest level – Band 1 – and described Mark as "a recognized expert in the area of cross-border trademark ownership. He receives unanimously high praise from clients and peers" for "continually providing [them] with first-rate service." One client said of Mark, he "is one of the best trademark attorneys I have ever worked with. He's responsive, intelligent, funny and easy to work with." The publisher has also commented that Mark has a "wealth of experience" and "is well versed in counseling clients on domestic and international IP registration, enforcement and licensing." Clients have commented that "[h]is knowledge of the law is extensive but his communications are perfect for the non-specialist to understand" and they "praise Feldman's business and sector knowledge as well as his 'superb client service.'" He is regarded as "one of the premier trademark lawyers in the USA," a "top-notch attorney," "a respected litigator" and "a class act."

Mark was honored with the International Trademark Association's Volunteer Service Award in 2014.

Mark is also recommended in *The Legal 500 United States* as a lawyer in DLA Piper's trademark practice that "provide[s] key support." Clients have described him as "responsive, timely and fun to work with" in addition to being "one of the top trademark lawyers in the world. He is responsive, pleasant, interesting and always willing to go the extra mile." In addition, he was described as "extremely focused and proactive, with excellent legal acumen and practical knowledge."

Mark was recognized by *The World Trademark Review 1000*, a guide to the world's leading trademark practitioners, 2011- 2017. In 2014 he was among seven lawyers that received their highest "Gold" ranking at the national level for "prosecution and strategy" and was described by a client as "a first port of call in a conflict and has continued to be ranked "Gold" through 2017." Mark was nominated by his peers to appear in *An International Who's Who of Trademark Lawyers* (Law Business Research Ltd., 2003 - 2017) and the *Guide to the World's Leading Trademark Law Practitioners* in every edition since 2002. He has been recommended each year since 2012 in *The Legal 500 United States* and since 2011 in *World Trademark Review 1000*. He also has been selected as an Illinois Leading Lawyer in intellectual property law by the Leading Lawyers Network every year since 2003. Mark has been designated an Illinois Super Lawyer every year since 2006. He has been a charter member of the Judge Richard Linn American Inn of Court since 2007.

Education

- J.D., Georgetown University Law Center 1974
- B.S.I.E., University of Illinois at Urbana-Champaign 1971
with high honors

Courts

- United States Court of Appeals for the Federal Circuit
- United States Court of Appeals for the Seventh Circuit
- United States District Court for the Northern District of Illinois

Memberships

- Intellectual Property Law Association of Chicago—President (2005-2006), President-Elect (2004-2005), Vice President (2003 – 2004), Board of Managers (1996 – 1997)
- International Trademark Association
- American Intellectual Property Law Association—Chair, Franchising Subcommittee (1997 – 2000)

Civic and Charitable

- International Trademark Association's Saul Lefkowitz Trademark Moot Court Competition—National Chairperson (2001 – 2002),

Regional Coordinator (2009 – 2017)

- Appointed to serve on the National Public Advisory Committee for Trademark Affairs (1997 – 1999)

INSIGHTS

Mark has written a chapter on "Trademark Law for The Franchisor" in a course book from the Practising Law Institute and has published various articles on trademark law in the Franchise Legal Digest. He has been a speaker on due diligence, licensing and franchise issues and international trademark registration strategies.

Publications

- Author, chapter on "Trade Practices and Intellectual Property," MARC Exam Prep Book, Shop! Association (2017)
- Co-author, "Franchising and intellectual property: the inseparable disciplines," *World Trademark Review* (April/May 2012)

NEWS

29 DLA Piper lawyers in 10 countries ranked among *The World's Leading Trademark Professionals*

12 FEB 2019

WTR 1000: The World's Leading Trademark Professionals 2018 has named 29 DLA Piper lawyers from nine countries to its list of top trademark professionals.

DLA Piper lawyers and practices were highlighted in the 2017 directory of *Who's Who Legal*

22 DEC 2017

DLA Piper is pleased to announce *Who's Who Legal* designated us as both the Real Estate Firm of the Year and the Franchise Firm of the Year for 2017.
