



Keith Medansky

Partner

CO-CHAIR, CHICAGO INTELLECTUAL PROPERTY PRACTICE

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Keith Medansky has over 30 years of experience in all facets of trademark, advertising and copyright law. Keith protects intellectual property portfolios for all kinds of businesses, from small start-up companies to large multinationals. He has broad experience in complex IP issues relating to licensing, tax holding companies, M&A and bankruptcy. With a focus on anti-counterfeiting and piracy matters, Keith has built and managed global brand protection programs for some of the world's largest businesses. He has also successfully litigated trademark and copyright lawsuits in the US and abroad. Keith represents hospitality, leisure, technology, sports, fitness, apparel, education, food, franchise, real estate, and consumer companies. He is routinely called upon to assist clients in their most complex and important matters and looked to as a trusted advisor and thought leader in the areas of trademarks, copyrights and advertising law.

- Intellectual Property and Technology
- Litigation, Arbitration and Investigations
- Trademark and Copyright

- Hospitality and Leisure

Keith has broad experience in assisting clients in addressing complex intellectual property issues relating to licensing, intellectual property holding companies and arising out of mergers, acquisitions, divestitures and bankruptcy.

Keith also handles litigation matters before the Trademark Trial and Appeal Board and various federal and state courts. He litigates on behalf of computer component companies in connection with counterfeiting matters and the protection and enforcement of copyright, trademark and other intellectual property rights in software and other products. Keith obtained one of the first trial decisions under the Dilution Revision Act.

Representative cases include:

- *Nike, Inc. v. Nikepal*: Successfully represented Nike at trial in one of the first trial decisions under the Trademark Dilution Revision Act. The case involved the famous NIKE mark and a rare appeal of a Trademark Office opposition decision to a district court and

claims seeking injunctive relief

- *Contessa Foods v. Lockpur*: Successfully defended copyright and trade dress infringement dispute invalidating the plaintiff's copyright and dismissing plaintiff's other claims on summary judgment. Also represented our client on appeal and in resisting the plaintiff's petition for certiorari
- *MB Financial Bank v. MB Real Estate*: Successfully defended preliminary injunction in trademark infringement case
- *Chattanooga Mfg. v. Nike, Inc. and Michael Jordan*: Obtained summary judgment defending Nike, Inc. who was sued for trademark infringement and unfair competition by a blouse manufacturer who had obtained a federally registered trademark for and claimed exclusive rights to the name JORDAN. Keith also represented Nike in the successful appeal before the Seventh Circuit
- *Microsoft Corp. v. Logical Choice Computers*: Obtained \$1.54 million judgment against defendant in a computer software counterfeiting case. Keith has also successfully handled dozens of other software counterfeiting cases on behalf of Microsoft

CREDENTIALS

Admissions

- Illinois

Recognitions

Keith is commended in the *WTR 1000: The World's Leading Trademark Professionals 2019*.

The respected English research firm, Chambers & Partners has recognized Keith in *Chambers USA* for his Intellectual Property practice. Chambers has said that he is "truly an expert with great experience and vast knowledge of both trademark law and developments in the trademark area" with "a successful track record litigating trademark and copyright lawsuits for large companies." Clients have said that "[y]ou can always rely on him to provide a range of options and sound recommendations." Keith is "good at making us feel like his only client." "He is the prime example of the very best you can expect from service in an outside law firm partner. I feel like I can be anywhere in the world and reach him any time. He really understands our business and treats all of our matters as if he's in our shoes," stated one source.

The Legal 500 United States has highlighted Keith as a recommended lawyer in his field, and has reported that he "is able to summarize complex legal issues into realistic risk assessments," as well as "extremely focused and proactive, with excellent legal acumen and practical knowledge." Keith was also recognized in the 2011 inaugural edition of the *World Trademark Review 1000*, a guide to the world's leading trademark practitioners and has been recognized each year since for both contentious and non-contentious trademark matters. He is one of the few lawyers in Illinois who has been recognized in both categories. World Trademark Review has said Keith "is the perfect combination of commercial lawyer and IP litigator. His instincts and judgment are impeccable."

Keith has been named in *The Best Lawyers in America* for Intellectual Property Law, *Euromoney Institutional Investor Expert Guides* for Trademarks, and by *Managing Intellectual Property Magazine* as a national "IP Star."

Keith has been listed a Leading Lawyer in Intellectual Property Law by the Leading Lawyers Network and designated an Illinois Super Lawyer, as the result of research projects conducted jointly by *Law & Politics* and *Chicago* magazines. He has also been recognized as one of the world's leading trademark practitioners in *Who's Who Legal USA: Trademarks*, *Who's Who Legal Illinois: Trademarks* and the *Guide to the World's Leading Trade Mark Law Practitioners*.

In the 2019 Acritas Stars Stand-Out Talent Survey, Keith was described by a client as "one of the most amazing client relationship partners that I've ever worked with... Keith will make it happen. He is just constantly helping his clients, he's amazing."

Education

- J.D., University of Illinois at Urbana-Champaign 1987
magna cum laude
- B.A., Northwestern University 1984

Courts

- Supreme Court of the United States
- United States Court of Appeals for the Federal Circuit
- United States Court of Appeals for the Ninth Circuit
- United States Court of Appeals for the Seventh Circuit
- United States Court of Appeals for the Tenth Circuit
- United States District Court for the Central District of Illinois
- United States District Court for the District of Arizona
- United States District Court for the Eastern District of Wisconsin
- United States District Court for the Northern District of Illinois
- United States District Court for the Southern District of Illinois
- United States District Court for the Western District of Wisconsin

Memberships

- Lawyer's for the Creative Arts, Board of Directors
- International Trademark Association, Internet Committee
- American Bar Association
- Intellectual Property Law Association of Chicago

INSIGHTS

Publications

The Lanham Act's makeover – Congress gives new clarity and tools to trademark owners and applicants

30 March 2021

The Trademark Modernization Act of 2020 gives new certainty for litigants and new tools for challenging current registrations.

Federal Circuit reshapes the rules for color marks on product packaging

14 April 2020

The Federal Circuit decision changes the rules for adjudging the ability to register color marks.

Events

Previous

Trade dress and unconventional trademarks

20 October 2021 | 2:00 - 3:00 ET

Consumer Goods and Retail speaker series

Webinar

- Speaker, “Dot ASIA Sunrise - Overview, Strategies & Best Practices,” International Trademark Association
- Speaker, “Software Licenses in Bankruptcy Proceedings,” Association of Corporate Counsel
- Speaker, “Recent Trends in Trademark Infringement and Dilution Litigation Law,” Seminars International presentation
- Speaker, “Recent Trends in Trademark Litigation,” Law Seminars International and the Intellectual Property Association of Chicago
- Speaker, “Intellectual Property Issues in Real Estate,” International Association of Attorneys and Executives in Corporate Real Estate (AECRE), New Orleans
- Panelist, “Alternative Dispute Resolution in Intellectual Property Cases,” Central American Secretariat for Harmonization of Laws Intellectual Property Program, sponsored by United States Agency for International Development (USAID), San Jose, Costa Rica
- Panelist, “Prosecuting and Defending Trademark Dilution Claims,” Seminar for Advanced Trademark Practitioners, International Trademark Association, New York City
- Speaker, “Trademark Licensing,” Seminar for Advanced Trademark Practitioners, International Trademark Association, San Francisco
- Presenter, “Exploring E-Legal Issues with a Legal Eagle,” Association for High Technology Distribution Annual Meeting, Memphis, Tennessee
- Speaker, “Fair Use and Copyright Issues in Education,” Chicago Public Schools Principal's Association program
- Speaker, “Piracy on the High (C)'s: Software Piracy and Counterfeiting,” Chicago Bar Association Young Lawyer's Division presentation, Chicago
- Speaker, “Nuts and Bolts of Filing a Copyright Infringement Complaint,” Chicago Bar Association presentation, Chicago
- Speaker, “Software Piracy and the Internal Auditor,” Institute of Internal Auditors, Dearborn, Michigan
- Presenter, “Software Piracy ... It's No Laughing Matter,” Chief Information Officers meeting, Des Moines, Iowa

NEWS

36 DLA Piper lawyers in 11 countries ranked among *The World's Leading Trademark Professionals*

24 February 2021

World Trademark Review 1000: The World's Leading Trademark Professionals has named 36 DLA Piper lawyers from 11 countries to its 2021 list of top trademark professionals.
