

Michael G. Kelber

Partner & Chair | Intellectual Property

OVERVIEW

Michael, 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



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EDUCATION

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

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

ADMISSIONS

Illinois

valuable insight into how concise communication, risk assessment and pooling resources are critical to enabling clients to make sound business and legal decisions.

EXPERIENCE

Representative Matters:

- *Camarata v. McDonald's Corp.* (W.D. Wash.; D. Wash.; U.S. Court of Appeals for the Ninth Circuit) – Successfully represented defendant against a domain name squatter who registered domain names that mimicked client's email domain name suffixes and who thereby acquired incorrectly sent emails intended for employees. Won two UDRP proceedings awarding the transfer of the disputed domain names back to client. After the squatter subsequently appealed to the Washington federal district court, we prevailed on summary judgment, which was ultimately upheld by U.S. Court of Appeals for the Ninth Circuit.
- *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.
- *GI Sportz, Inc. v. Valken, Inc.* (D. N.J.) – Achieved favorable settlement in patent and trade dress enforcement of a paintball marker following Markman briefing.
- *Heartland Consumer Products LLC and TC Heartland LLC v. DineEquity, Inc.* (S.D. Ind.) – Mounted strong defense in a novel trademark lawsuit relating to the protectability of colored packaging, leading to a productive settlement.
- *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.
- *Coca-Cola Company et al. v. William S. Purdy et al.* (U.S. Court of Appeals for the Eighth Circuit) – Successfully enjoined domain name infringer from using client's trademarks in pursuit of a socially charged political purpose.
- *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.
- *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.
- 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.

RECOGNITIONS

- "Notable Leaders in Accounting, Consulting & Law," *Crain's Chicago Business*, 2024
- *Chambers USA: America's Leading Lawyers for Business*, recommended in "Intellectual Property," 2017-2020 and in "Intellectual Property: Trademark, Copyright & Trade Secrets," since 2021
- *World Trademark Review 1000*, recommended in "Trademark Enforcement and Litigation" and "Trademark Prosecution and Strategy" since 2014
- *World Trademark Review Global Leaders*, recommended since 2019
- *The Legal 500 United States*, recommended in "Trademark Litigation" since 2019
- *The Best Lawyers in America*, recommended in "Trademark Law" since 2016
- *Illinois Super Lawyers*, recommended in "Intellectual Property" since 2016

NEWS & INSIGHTS

January 31, 2025 Firm News

World Trademark Review 1000 Ranks Six Neal Gerber Eisenberg Attorneys

January 24, 2025 Firm News

Twenty-Two Neal Gerber Eisenberg Attorneys Recognized on 2025 Illinois Super Lawyers List



September 9, 2024 Firm News

Bobby Gerber, Michael Kelber and Leah Schleicher Named to *Crain's Chicago Business* 2024 Notable Leaders in Accounting, Consulting and Law

August 15, 2024 Firm News

60 Neal Gerber Eisenberg Attorneys Included in 2025 *Best Lawyers In America*

June 7, 2024 In The Media

Beware of Trademark Scammers Leveraging USPTO Data

June 6, 2024 Firm News

Neal Gerber Eisenberg Secures Nine Ranked Practice Groups and 23 Recognized Attorneys in *Chambers USA* 2024

March 7, 2024 Publication

USPTO and Trademark Services Fraud Schemes

February 8, 2024 Firm News

Neal Gerber Eisenberg Intellectual Property Practice Places Six Attorneys in *World Trademark Review 1000*

January 29, 2024 Firm News

Thirty-One Neal Gerber Eisenberg Attorneys Recognized on 2024 Illinois Super Lawyers List

August 17, 2023 Firm News

55 Neal Gerber Eisenberg Attorneys Included in 2024 *Best Lawyers In America*

July 19, 2023 Firm News

Michael Kelber Named as 2023 Global Leader by World Trademark Review

June 21, 2023 In The Media

Michael Kelber Quoted in *World Trademark Review* Article on USPTO Extended Wait Times

June 19, 2023 In The Media

Michael Kelber Quoted in *World Trademark Review* on Protecting IP in the Metaverse

June 14, 2023 In The Media

Michael Kelber Quoted in *Bloomberg Law* Article on U.S. Supreme Court's Ruling in *Jack Daniel's* Case

June 12, 2023 Firm News

The Legal 500 United States 2023 Edition Recommends Four Neal Gerber Eisenberg Practices and 23 Attorneys

June 9, 2023 In The Media

Michael Kelber Quoted in *World Trademark Review* Article on U.S. Supreme Court's Ruling in *Jack Daniel's* Case

June 8, 2023 Publication

Client Alert: SCOTUS Decides in *Jack Daniel's Properties Inc. v. VIP Products* that Parody Products Can Constitute Trademark Infringement

June 1, 2023 Firm News

Neal Gerber Eisenberg Secures 10 Ranked Practice Groups and 25 Recognized Attorneys in *Chambers USA* 2023



May 22, 2023 Publication

Client Alert: SCOTUS Rules Andy Warhol Foundation's Commercial License of "Orange Prince" Image Infringed Photographer's Copyright

02.13.2023 Firm News

Neal Gerber Eisenberg Intellectual Property Practice Places Five Attorneys in *World Trademark Review 1000*

December 22, 2022 In The Media

Michael Kelber Quoted in *Forbes.com* Article on Ownership of AI-Generated Content

October 17, 2022 Firm News

Michael Kelber Again Named to World Trademark Review Global Leaders 2022

August 18, 2022 Firm News

60 Neal Gerber Eisenberg Attorneys Included in 2023 *Best Lawyers*

August 8, 2022 Firm News

Michael Kelber Quoted in *Bloomberg Law* Article on Gibson Guitar-Shape Trademarks

June 10, 2022 Firm News

The Legal 500 United States 2022 Edition Recommends Four Neal Gerber Eisenberg Practices and 19 Attorneys

June 1, 2022 Firm News

Neal Gerber Eisenberg Secures 11 Ranked Practice Groups and 25 Recognized Attorneys in *Chambers USA* 2022

March 14, 2022 Publication

Client Alert: Biden Issues Executive Order on Ensuring Responsible Development of Digital Assets

February 28, 2022 Firm News

Neal Gerber Eisenberg Intellectual Property Practice Places Four Attorneys in *World Trademark Review 1000*

August 18, 2021 Firm News

52 Neal Gerber Eisenberg Attorneys Included in 2022 *Best Lawyers*

July 15, 2021 Firm News

Michael Kelber Named to World Trademark Review Global Leaders 2021

June 10, 2021 Firm News

The Legal 500 United States 2021 Edition Recommends Four Neal Gerber Eisenberg Practices and 15 Attorneys

May 20, 2021 Firm News

Neal Gerber Eisenberg Secures 11 Ranked Practice Groups and 20 Recognized Attorneys in *Chambers USA* 2021

February 15, 2021 Firm News

Neal Gerber Eisenberg Intellectual Property Practice Once Again Earns Gold Band Status in *World Trademark Review 1000*

September 11, 2020 Firm News

Michael Kelber Named to World Trademark Review Global Leaders 2020



August 19, 2020 Firm News

46 Neal Gerber Eisenberg Attorneys Included in 2021 Best Lawyers

June 15, 2020 Firm News

The Legal 500 United States 2020 Edition Recommends Five Neal Gerber Eisenberg Practices and 21 Attorneys

June 3, 2020 Publication

Update: USPTO Trademark Relief Under the CARES Act

April 30, 2020 Publication

USPTO Trademark Deadline Extensions Under the CARES Act

April 28, 2020 Publication

Client Alert: SCOTUS Resolves Circuit Split on Trademark Profit Awards and Intent, but Uncertainty Remains

April 23, 2020 Firm News

Neal Gerber Eisenberg Secures 10 Ranked Practice Groups and 16 Ranked Attorneys in Chambers USA 2020

February 17, 2020 Firm News

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

February 3, 2020 Firm News

Illinois Super Lawyers 2020 Recognizes 39 Neal Gerber Eisenberg Attorneys

September 17, 2019 Firm News

Michael Kelber Selected for World Trademark Review Global Leaders 2019

August 20, 2019 In The Media

Michael Kelber Quoted in World Trademark Review

August 15, 2019 Firm News

45 Neal Gerber Eisenberg Attorneys Included in 2020 Best Lawyers

August 12, 2019 Publication

Michael Kelber Quoted in World Trademark Review

August 5, 2019 In The Media

Michael Kelber Quoted in Associated Press Article on Katy Perry Lawsuit

June 11, 2019 Firm News

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

April 25, 2019 Firm News

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

April 16, 2019 In The Media

Michael Kelber Quoted in *World Intellectual Property Review*

March 21, 2019 Publication

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



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March 6, 2019 In The Media

Michael Kelber Quoted in *World Intellectual Property Review*

February 5, 2019 Firm News

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

August 15, 2018 Firm News

45 Neal Gerber Eisenberg Attorneys Included in 2019 Best Lawyers

August 13, 2018 In The Media

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

August 13, 2018 In The Media

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

August 1, 2018 Publication

Client Alert: Federal Circuit Upholds Joint Infringement Defense in On-Going Akamai Litigation

July 26, 2018 Publication

Offensive Marks and Free Speech

July 9, 2018 Firm News

46 Neal Gerber Eisenberg Attorneys Included in 2016 Best Lawyers

July 9, 2018 Firm News

41 Neal Gerber Eisenberg Attorneys Listed in 2016 Illinois Super Lawyers

July 9, 2018 Firm News

45 Neal Gerber Eisenberg Attorneys Included in 2017 Best Lawyers

July 6, 2018 Firm News

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

July 6, 2018 Firm News

Michael Kelber Honored with Keshet 2017 Guardian of Hope Award

July 6, 2018 Firm News

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

July 6, 2018 Firm News

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

July 6, 2018 Firm News

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

July 6, 2018 Firm News

44 Neal Gerber Eisenberg Attorneys Included in 2018 Best Lawyers

July 6, 2018 Firm News

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



June 26, 2018 Firm News

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

June 26, 2018 Publication

Blurred Lines and Divergent Views