



DAVID S. FLEMING SHAREHOLDER

455 N. Cityfront Plaza Drive | Suite 3600
Chicago, IL 60611

P 312.321.7734
F 312.321.4299
dfleming@brinksgilson.com

EDUCATION

J.D.,
University of Illinois College of Law, 1981
B.A.,
Northwestern University, 1978

Georgetown University, School of Foreign Service, 1973-1975

BAR ADMISSIONS

Illinois
Supreme Court of the United States
U.S. Dist. Court, N.D. Illinois, Trial Bar
U.S. Dist. Court, C.D. Illinois
U.S. Court of Appeals, 7th Circuit

Dave has over 35 years of litigation experience, focusing on intellectual property issues for clients in many different industries. He also advises clients with complex branding, clearance, licensing, due diligence and similar intellectual property rights issues. Dave also counsels clients with complex issues with global portfolios.

Much of Dave's experience is in cases involving cutting-edge Internet search and social media issues. Dave's clients in these areas have included Internet startups as well as well-established multinationals with Internet and social media issues.

Dave has served in leadership roles in the global trademark community. For example, he has served as Counsel to the Board of the International Trademark Association, and he also has served INTA on its Board of Directors and as chair of Annual Meeting and other programs. INTA recognized Dave with its President's Award in 2016. Dave also speaks frequently on trademark issues, and he is a co-author of a trademark book, Trademark Litigation Practice, published by Bloomberg BNA.

Dave has been a leader in his firm, serving on its Board and Executive Committee, and currently as its General Counsel.

EXPERIENCE | LEGAL EXPERIENCE

- **Brinks Gilson & Liono**, Chicago, Illinois
Shareholder
General Counsel, 2014-present
Co-General Counsel, 2012-2013
Chair, Trademark Litigation Practice Group, 2009-2011
Board of Directors, Executive Committee, 2007-2008
Vice President, 2007-2008
Treasurer, 2000-2005, 2014-present
Co-chair, Internet Practice Group, 2001-2007

PRACTICE GROUPS

Trademarks & Unfair Competition
Litigation

FORWARD THINKING

Alerts

- Eleventh Circuit Solidifies Viability of Contributory Liability for False Advertising Claims, August 31, 2015
- Mission Products v. Tempnology: SCOTUS Holds that Rejection of Trademark License in Bankruptcy Does Not Terminate the Right to Use the Mark, May 22, 2019

Presentations

- "Pre-Trial and Trial Issues in Trademark Cases," (speaker), Intellectual Property Law Dinner, Association of Corporate Counsel, Chicago, August 24, 2017
- "Ten Trademark Hot Topics," (speaker), IP Symposium, Intellectual Property Law Association of Chicago, November 2, 2012
- "Drafting and Negotiating Sponsorship Agreements," (moderator), Trademarks in Transactions Conference, International Trademark Association, Chicago, October 11, 2012
- "Protecting Privacy and IP in Social Media," 2012 National Summit of Black Women Lawyers, Chicago, April 13, 2012
- "Using U.S. Trade and Competition Laws to Protect the Value of Brand Names and Other Trademarks in a Global Economy," Chicago International Trade Commissioners Association, Chicago, October 4, 2011
- "Fighting Infringing Online Content & Sales," Corporate Intellectual Property Law Conference, Chicago, IL, February 8, 2011
- "IP Trends Surrounding the Use of Social Media, Including Twitter and Facebook," Brinks Gilson & Lione CLearKnowledge Now Webinar, December 9, 2010
- "Trademark Issues with Social Networking Sites," (speaker), 12th Annual Utah IP Summit, Salt Lake City, Utah, February 12, 2010
- "Commercialization of IP in China - Trademark Enforcement, Protection Strategies and Domain Names in China," (moderator), Intellectual Property Owners Association Annual Meeting, San Diego, California, September 23, 2008
- Trial attorney in mock patent jury trial, John Marshall Law School trial program at China State Intellectual Property Office, Beijing, Peoples Republic of China, June 2008
- "Keyword Advertising: Trademark Law in Flux," (panelist), AIPPI (US Group) Annual Meeting, San Francisco, California, October 26, 2007
- "Trademarks in Internet Advertising: The Next 'Next Big Thing,'" (speaker), Trademark & Advertising Law, Law Seminars International, Seattle, Washington, September 21, 2007
- "Beyond Keywords: Internet Trademark Issues," (speaker), Update on Intellectual Property Law and the Internet, Brinks Gilson & Lione Seminar, Chicago, August 1, 2007
- "Use of Keywords in Internet Advertising," (speaker), Brinks Gilson & Lione Seminar, Glenview, Illinois, June 5, 2007
- "Transactions Involving Use of Trademarks On the Internet," (speaker), Complex IP & Technology Transactions, Law Seminars International, Chicago, Illinois, March 22, 2007
- "Trademark Law: US and International Update," (panelist), Update on Intellectual Property Law and the Internet, Brinks Gilson & Lione Seminar, Chicago, April 18, 2006
- "Runaway Jury: The Streets of San Diego," (trial attorney in mock jury trial), International Trademark Association Annual Meeting, San Diego, California, May 17, 2005
- "Trademarks in Internet Advertising: Banners, Pop-Ups, Paid Search," (speaker), Georgetown University Advanced Computer and Internet Law Program, Washington, D.C., March 17, 2005
- Trademark Administrator Forum, International Trademark Association, (co-chair), Arlington, Virginia, October 3-6, 2004

- "U.S. Dilution Law," (speaker), Famous and Well-Known Trademark Forum, International Trademark Association, Brussels, Belgium, September 20, 2004
- "Internet Update: Domain Name Disputes and Cyber Infringement," (speaker), IP Summer Conference, Michigan Institute of Continuing Legal Education, Mackinac Island, Michigan, July 23, 2004
- "Litigating Damages in Trademark Infringement Cases," (moderator), Roundtable, ABA Litigation Section, Intellectual Property Litigation Committee, Chicago, Illinois, March 18, 2004
- "Internet Advertising: Expanding Frontiers of Trademark Law," (speaker), Intellectual Property Law Association of Chicago and The John Marshall Law School Internet Law Seminar, Chicago, Illinois, November 21, 2003
- "Trademarks on the Internet: Expanding Frontiers," (speaker), LexisNexis Advanced Trademark Program, New York, New York, October 23-24, 2003
- "Dilution: Open Issues After *Moseley*," (speaker), Intellectual Property Owners Association Annual Meeting, Chicago, Illinois, September 16, 2003
- "Trademarks and the Internet: Hot Topics," (speaker), Georgetown University Advanced Computer and Internet Law Program, Washington, D.C., March 6, 2003
- "Qualifying for Dilution Protection," (project team member and moderator), International Trademark Association Dilution Forum, Arlington, Virginia, March 6-7, 2003
- "Hot Topics In U.S. Trademark Law," (speaker), 2002 Chicago International IP Conference (co-sponsored by the University of Illinois), Chicago, Illinois, October 5, 2002
- "Effective Enforcement Strategies," (speaker), LexisNexis Advanced Trademark Program, Chicago, Illinois, April 15-16, 2002
- "Giving Away E-commerce Rights and How To Negotiate Them," (speaker), presented portion of program regarding trademark rights in e-commerce, HITEC (Hospitality Industry Technology Exhibition and Conference), Dallas, Texas, June 20, 2000
- "Trademarks On The Internet," (speaker), Chicago-Kent College of Law, Illinois Institute of Technology, Chicago, Illinois, April 25, 2000
- "Trademark Law Issues Associated With The Transfer Of Intangibles," (speaker), Deloitte & Touche Client Seminar, Chicago, Illinois, December 3, 1997
- International Trademark Law Developments Session, International Trademark Association Annual Meeting, (co-moderator), Seattle, Washington, May, 1994

Interviews

- "Internet Trademark Law," Interview on SkyRadio, United Airlines, October 2005
- Quoted in November 2002 Managing Intellectual Property article naming Brinks Gilson & Lione the #2 "Contentious Trademark" firm in the United States.
- Quoted in April 2000 Managing Intellectual Property article naming Brinks Gilson & Lione's trademark group the "US Team of the year."

HONORS

- International Trademark Association President's Award, 2016
- Illinois Super Lawyers, Intellectual Property Litigation, 2005-2017
- *World Trademark Review 1000 – The Definitive Guide to Trademark Legal Services*, 2011, 2012, Tier 1, Illinois, 'Individuals - Contentious,' and 'Enforcement and Litigation', Gold Band, 2013, 2016-2018, National, 'Individuals - Enforcement and Litigation', Silver Band, 2017-2018
- Leading Intellectual Property Lawyer, Leading Lawyers Network, Law Bulletin Publishing Company, 2004, 2005, 2007, 2009-2012, 2014

Biographies | David S. Fleming

- *Who's Who Legal - Trademarks*, 2012, 2014
- *Leading Lawyer, Computer & Technology Law*, 2009
- Listed, "Guide To The World's Leading Trademark Law Practitioners," Euromoney Legal Media Group, 2002, 2009
- *University of Illinois Law Review*, University of Illinois College of Law

AFFILIATIONS

- International Trademark Association
Counsel, 2014-2015
Board of Directors, 2010-2012
CEO Search Committee, 2011-2013
Co-Chair, 2011 Advanced Trademark Symposium
Co-Chair, 2007 Annual Meeting
Co-Chair, 2004 Trademark Administrators Program
U.S. Amicus Committee, 2016-present
Programs Committee, 2007-2011
Past committee memberships: Trademark Reporter Editorial Board
Oral argument judge, Saul Lefkowitz Moot Court Competition, Midwest Region, 2008-2018
Faculty member, INTA Trial Advocacy Program, Chicago, Illinois, July 14-15, 2000
- Intellectual Property Law Association of Chicago
Board of Managers, 2009-2011
Chair, Creative Achievement Award Committee, 2007-2009
Chair, Internet Law Committee, 2005-2006
- American Bar Association
Annual Review Vice Chair, Trademark Division, Intellectual Property Law Section, 2010-2011
- Richard Linn American Inn of Court
Mentorship Chair, 2007-2008

REPRESENTATIVE MATTERS

- **Federal and State Courts:**
- *Progressive Casualty Insurance Company v. All Web Leads, Inc.*, Case No. 1:12-cv-01545-JG (N.D. Ohio). Represented Progressive in trademark infringement suit relating to keyword advertisements. Settled.
- *eSolar Inc. v eSolar Exchange LLC*, Case No. 2:12-cv-04134-MRW (C.D. Cal.). Represented plaintiff in trademark infringement action. Settled.
- *Dazzlesmile, et al. v. Epic Advertising, et al.*, Case No. 2:09-cv-01043-PMW (D. Utah). Represented Yahoo!, Inc. in trademark infringement suit relating to keyword advertisements. Settled.
- *NTN Corporation, et al. v. Mandas, et al.*, Case No. 2:10-cv-00257-JWS (D. Ariz.). Represented NTN Corporation in trademark infringement suit relating to counterfeit bearings. Settled.
- *Mary Kay, Inc. v. Yahoo! Inc.*, Case No. 3:09-cv-01278-M (N.D. Tex.). Represented Yahoo! in trademark infringement suit relating to shortcuts appearing in emails. Settled.
- *Yahoo! Inc. v. National Football League Players Association, Inc. et al.*, Case No. 09-cv-01272-PJS-FLN (D. Minn.). Represented Yahoo! Inc. in declaratory judgment action relating to right of publicity and fantasy football game. Settled.
- *International Information Systems Security Certifications Consortium v. Degraphenreed, et al.*, Case No. 2:07-cv-1195 (S.D. Ohio). Represented Yahoo! Inc. in trademark infringement dispute. Settled.
- *Heartbrand Beef, Inc. v. Lobel's of New York, LLC, et al.*, Case No. 6:08-cv-00062 (S.D. Tex.). Represented Yahoo! Inc., one of the defendants in a trademark infringement dispute. Dismissed.

- *Trilink Saw Chain, LLC, et al. v. Blount, Inc., et al.*, Case No. 1:07-CV-0409-CAP (N.D. Ga.). Represented Blount, Inc. in false advertising claim. Settled.
- *Bernini, Inc. v. Fragrancenet.com, Inc., et al.*, Case No. CV 06-4829 RGK (C.D. Cal.). Represented Yahoo! Inc. in trademark infringement dispute. Settled.
- *Munchkin, Inc. v. Wm. Wrigley Jr. Company*, Case No. CV 06-6342 PA (C.D. Cal.). Represented Wm. Wrigley Jr. Company in trademark infringement matter. Settled.
- *Children's Memorial Medical Center, Inc. v. Kid's Doc, S.C., et al.*, Case No. 1:06-cv-05844 (N.D. Ill.). Represented Children's Memorial Medical Center, Inc. in suit alleging trademark infringement. Settled.
- *JP Enterprises, Inc. v. Yahoo! Inc., et al.*, Case No. 06-cv-01046-REB-PAC (D. Col.). Represented Yahoo! Inc. in suit alleging trademark infringement. Settled.
- *Motorola, Inc. v. Razor USA, LLC*, Case No. 2198-N (Del. Chancery Ct. 2006). Represented Motorola in declaratory judgment action concerning license agreement. Settled.
- *Government Employees Insurance Company ("GEICO") v. Google, Inc. and Overture Services, Inc.*, Case No. 04-CV-507 (E.D. Va.). Represented Overture Services, Inc., an Internet search engine, in trademark infringement suit concerning bidding on search terms that include trademark of plaintiff. Settled.
- *R. J. Reynolds Tobacco Company, et al. v. Premium Tobacco Stores, Inc., et al.*, Case No. 99 C 1174 (N. D. Ill.), 462 F.3d 690, (7th Cir. 2006). Gray market case; lead counsel for plaintiffs in trial of trademark claims, secured jury verdict finding, among other things, federal trademark infringement, unfair competition and willful dilution, and awarding \$3.5 million in defendant's profits; prejudgment interest later awarded. Affirmed on appeal.
- *Caterpillar, Inc. v. The Walt Disney Company*, Case No. 1:03-cv-01334 (C.D. Ill. 2003). Represented Caterpillar in connection with Disney's use of Caterpillar marks in film *George of the Jungle 2*. Settled.
- *Mark Nutritionals, Inc. v. Overture Services, Inc.*, Case No. SA-02-CA-0086 OG (W.D. Tex.). Represented Overture Services, Inc., an Internet search engine, in trademark infringement suit concerning bidding on search terms that include trademark of plaintiff. Settled.
- *Mark Nutritionals, Inc. v. AltaVista Company*, Case No. SA-02-CA-0087 EP (W.D. Tex.). Represented AltaVista Company, an Internet search engine, in trademark infringement suit concerning bidding on search terms that include trademark of plaintiff. Settled.
- *PlasmaNet, Inc. v. Overture Services, Inc.*, Case No. 02 CV 3075 (AGS) (S.D. N.Y.). Represented Overture Services, Inc., an Internet search engine, in trademark infringement suit concerning bidding on search terms that include trademark of plaintiff. Settled.
- *Robert Novak d/b/a Pets Warehouse, etc. v. Overture Services, Inc., et al.*, Case No. CB 02 5164 (E.D. N.Y.). Represented Overture Services, Inc., an Internet search engine, in trademark infringement suit concerning bidding on search terms that include trademark of plaintiff. Settled.
- *800-JR Cigar, Inc. v. GoTo.com, Inc., et al.*, Case No. 2:00 CV 03179 (D. N.J.). Represented Overture Services, Inc. (formerly GoTo.com, Inc.), an Internet search engine, in trademark infringement suit concerning bidding on search terms that include trademarks of plaintiff. Settled.
- *Federal Cartridge Co. v. Cyrus, Inc. d/b/a Federal Arms Corp. of Amer.*, Case No. 00-1569 (D. Minn., Fourth Division). Secured consent judgment on behalf of owner of FEDERAL mark in suit concerning use of name and mark FEDERAL ARMS for firearms.
- *GoTo.com, Inc. v. The Walt Disney Company, et al.*, 202 F. 3d 1199, 1207 (9th Cir. 2000). Secured preliminary injunction for GoTo.com, an Internet search engine, in trademark infringement suit concerning use of logo appearing on Web sites and television and in print media. Affirmed on appeal. Case settled for \$21.5 million following filing of contempt petition against defendants.
- *Sargent & Greenleaf, Inc. v. Masco Corporation, et al.*, Case No. 99-6 (E.D. Ky., Lexington Div. 1999). Secured preliminary injunction for manufacturer of dial and ring locks used on gun safes. Case subsequently settled.

- *R.J. Reynolds Tobacco Company, et al. v. Allstate Cigarette Distributors, Inc., et al.*, Case No. 99-348-CIV-T-25F (M.D. Fla., Tampa Div.). Secured consent judgments against various defendants in gray market cigarettes case.
- *Motorola, Inc. v. Fonorola Corporation*, Case No. 97 CV 9157 (RPP) (S.D. N.Y.). Trademark infringement action to prevent use of FONOROLA trademark for use with telephone services. Settled.
- **Trademark Trial And Appeal Board Matters:**
- *Jonathan Drew, Inc. v. GMB, Inc.*, Opposition No. 91183057 (T.T.A.B.). Represented applicant for mark CAMEL CRUSH. Settled.
- *Danjaq, LLC v. Jason & Jean Products, Inc.*, Opposition No. 120,980 (T.T.A.B.). Represented owner of JAMES BOND and 007 service marks in opposition to application for registration of mark 007 HAIR WEAVING BOND. Summary judgment granted in favor of client.
- *Danjaq, LLC v. Jason & Jean Products, Inc.*, Cancellation No. 31,532 (T.T.A.B.). Represented owner of JAMES BOND and 007 service marks in cancellation proceeding concerning registration of mark 007 WEAVING BOND. Summary judgment granted in favor of client.
- *Wm. Wrigley Jr. Company v. Lotte Co., Ltd.*, Opposition No. 115,237 (T.T.A.B.). Opposition to application for registration of mark LOTTE SPEAR MAX. Settled.
- *Wm. Wrigley Jr. Company v. Lotte Co., Ltd.*, Opposition No. 115,236 (T.T.A.B.). Opposition to application for registration of mark LOTTE JUICY MAX. Settled.
- *Danjaq, LLC v. LVIII Group, LLC*, Opposition No. 113,226 (T.T.A.B.). Represented owner of JAMES BOND and 007 service marks in opposition against application to register mark CLUB 007--A GENTLEMAN'S CLUB. Opposition sustained May 12, 1999.
- *Danjaq, LLC v. Double-O-Seven, Ltd.*, Cancellation No. 28, 013 (T.T.A.B.). Represented owner of JAMES BOND and 007 service marks in cancellation proceeding concerning registration of mark DOUBLE-OH-SEVEN, LTD. & Design. Cancellation granted August 16, 1999.
- *Navistar International Transportation Corp. v. Mack Trucks, Inc.*, Opposition No. 107,707 (T.T.A.B.). Opposition proceeding filed in 1997 against application to register truck grill design. Settled.