



JEROME GILSON SHAREHOLDER EMERITUS

One of the most respected names in trademark and unfair competition law, Jerry Gilson provided wise counsel to Brinks Gilson & Lione clients for more than 50 years. As the original author of the renowned treatise *Gilson on Trademarks* (LexisNexis), he helped shape the law, the business trajectories of his clients and the careers of hundreds of lawyers.

Throughout his distinguished career, Jerry handled significant trials and appeals in federal court, as well as proceedings before the Trademark Trial and Appeal Board. He also mediated federal court trademark infringement actions, and counseled clients on a wide variety of trademark litigation and expert witness matters.

He is still active as a Life Director of the Public Interest Law Initiative, and mentors law students who aspire to careers in public interest law.

During his illustrious career, Jerry received virtually every major honor available in his field, including Lifetime Achievement Awards from *World Trademark Review* and *Managing Intellectual Property*. In 2007, he joined such luminaries as Thomas Jefferson, James Madison and Thomas Edison when inducted into the IP Hall of Fame, sponsored by *Intellectual Asset Magazine*. But the one he prizes most is the 2001 International Trademark Association (INTA) President's Award for "outstanding and lasting contributions to the international trademark community."

EXPERIENCE | LEGAL EXPERIENCE

- **Brinks Gilson & Lione**, Chicago, Illinois
1963-Present
- **Stevenson, Conaghan, Valde & Hackbert** (now Dykema Gossett PLLC), Chicago, Illinois
1958-1963

EXPERIENCE | CIVIC ACTIVITIES

- Life Trustee, Luminarts Cultural Foundation
- Life Director, Public Interest Law Initiative

EXPERIENCE | MILITARY EXPERIENCE

- **United States Army**, 1952-1955
Army Security Agency (Top Secret Code Word Clearance)

EXPERIENCE | TEACHING EXPERIENCE

- **The John Marshall Law School**, Chicago, Illinois
Adjunct Professor, 1960-1962
Course on Wills, Trusts and Estates.

EXPERIENCE | OVERVIEW

- Jerry is the original author of the 40-year-old treatise *Gilson on Trademarks (formerly Trademark Protection and Practice)*(LexisNexis), cited in numerous court decisions, the latest one by the United States Supreme Court in 2015. In 2006 his daughter, Anne Gilson LaLonde, succeeded him as Editor, and they now co-author the annual LexisNexis trademark law articles published to coincide with the Annual INTA Meeting.
- Jerry served as Reporter on INTA's Trademark Review Commission, a Blue-Ribbon group whose analysis of the Lanham Act in the Trademark Law Revision Act of 1988 led to far-reaching changes. Jerry also testified before the United States Congress at the time and assisted in drafting the legislation.
- From 1988 to 1993 Jerry was an Advisor on the American Law Institute project that led to the publication of the authoritative *Restatement (Third) of the Law of Unfair Competition*.
- For more than 10 years, Jerry was a Panelist on the INTA Panel of Mediators. He participated in establishing the Lanham Act Mediation Local Rule for the United States District Court for the Northern District of Illinois.
- Jerry has long been a leader at Brinks Gilson & Lione, the firm that has borne his name since 1983. He has served the firm as Managing Partner, Board of Directors member, Chair of the Trademark Practice Group and a member of many firm committees. He is especially proud of revitalizing the firm's Pro Bono Committee and helping make it a viable, effective public interest force in the Chicago community.

PRACTICE GROUPS

Litigation

Trademarks & Unfair Competition

Copyright

FORWARD THINKING

Presentations

- "[Trade Marks: The Future of the Advertising Function](#)," University College of London's Institute of Brand and Innovation Law, London, England, March 23, 2011
- "Anything Goes: The Lanham Act at 60 Spawns Sensory Trademarks," West Virginia University Research Corporation and the College of Law's conference *From Coal to Content: The Role of Intellectual Property and Technology in the New Economy*, Morgantown, West Virginia, September 19, 2006
- "The Lanham Act Turns 60, Amid Cinnamon Buns, Quacking Ducks and Cherry-Scented Racecar Exhaust," The Institute of Continuing Legal Education Intellectual Property Law Summer Institute, Acme, Michigan, July 22, 2006
- "The Lanham Act Turns 60, Amid Cinnamon Buns, Quacking Ducks and Other Non-Traditional Trademarks," The Annual Massachusetts Continuing Legal Education Intellectual Property Law Conference, Boston, Massachusetts, June 7, 2006
- "The Lanham Act Turns 60, Amid Cinnamon Buns, Quacking Ducks and Other Non-Traditional Trademarks," The John Marshall Law School 50th Annual Conference on Developments in Intellectual Property Law, Chicago, Illinois, May 26, 2006
- "The Lanham Act Turns 60, Amid Cinnamon Buns, Quacking Ducks and Cherry-Scented Racecar Exhaust," 8th Annual Richard C. Sughrue Symposium On Intellectual Property Law and Policy, Akron, Ohio, March 13, 2006
- "The Lanham Act Turns 60, Amid Cinnamon Buns, Quacking Ducks and Cherry-Scented Racecar Exhaust," Arizona State Bar Association Intellectual Property Section, Phoenix, Arizona, February 24, 2006
- "Ethical Issues for Trademark Practitioners," co-presenter, a distance-learning workshop in conjunction with the International Trademark Association and University of Akron School of Law, December 10, 2004
- "Canadian and U.S. Trademark Hot Topics: Dilution, Functionality, Fair Use, Trade Dress, Protection of Colour and Other Non-Traditional Marks," University of Victoria International Intellectual Property Law Conference, Vancouver, British Columbia, Canada, July 17, 2004

- "Nontraditional Trademarks: Legal and Marketing Opportunity or Just Plain Bizarre?" Arizona State Bar Association Intellectual Property Section, Phoenix, Arizona, March 26, 2004
- "LexisNexis: Advanced Trademark Strategies," chair and moderator, The Ritz-Carlton, Battery Park, New York, October 23-24, 2003
- "Copyright and Trademark Infringement, Anti-Counterfeiting, and Parallel Importation," St. Peter's Oxford/College University Summer 2003 Intellectual Property Conference, Oxford, England, July 25, 2003
- "LexisNexis Presents: Trademark Law: Beyond The Basics," chair and moderator, The Westin Hotel, Chicago, Illinois, April 15, 2003
- "Law Firm Strategies Under The Madrid Protocol," (panelist, IIT Chicago-Kent College of Law, Chicago, Illinois, March 31, 2003
- "Dilution Protection For Non-Traditional and Design Marks," panelist, INTA Trademark Dilution Forum, Arlington, Virginia, March 6, 2003
- "Copyright and Trademark Infringement, AntiCounterfeiting and Illegal Imports," panelist at the Joint International Intellectual Property Summer Program in Victoria, British Columbia, Canada, July 11, 2002
- "Advanced Trademark Strategies," chair and speaker, LexisNexis/Mealey Publications, a two-day program, speech "The Lanham Act: Time For A Face Lift," Chicago, Illinois, April 15-16, 2002
- "The United States Patent and Trademark Office Presents 2001: The Trademark Office Goes E-Commerce – A Timely Dialogue With Commissioner for Trademarks Anne H. Chasser and Other Top USPTO Officials," panelist, IIT Chicago-Kent College of Law, Chicago, Illinois, February 16, 2001
- "The Northern District of Illinois Trademark Mediation Program: A Panel Discussion of its Progress and Ideas for Improvements or Alternative Approaches," panelist, American Intellectual Property Law Association Spring Meeting, Chicago, Illinois, April 23, 1999
- "Trademarks And Countdown 2000: Is There A Limit To Protection?" Oregon Patent Law Association (OPLA) and Washington State Patent Law Association (WSPLA), Gleneden Beach, Oregon, April 9, 1999
- "Identifying the Identifiers: What Qualifies as a Trademark?" panelist, International Trademark Association Evolution and Revolution In Trademark Law, an Interactive Symposium for Advanced Practitioners, New York, New York, March 4, 1999
- "U.S. Trademark Law," Hikaku Ho Kenkyu Center, Osaka, Japan, June 6, 1997
- "U.S. Trademark Law," Osaka Trademark Association, Osaka, Japan, June 5, 1997
- "U.S. Trademark Law," Benrishi Club, Tokyo, Japan, June 3, 1997
- "Cyberspace And Dilution: The New Trademark Frontiers," Oregon and Washington Patent Law Associations Joint Conference, Gleneden Beach, Oregon, April 25, 1997
- "Global Trademark Challenges: What's New, What's Hot!," panelist, Price Waterhouse Intellectual Property Leadership Forum, Tucson, Arizona, February 13, 1997
- "Federal Trademark Dilution Act of 1995," Chicago Bar Association, The Young Lawyers Section, Chicago, Illinois, May 1, 1996
- "Staking Claims to the Future," panelist on workshop "The Consumer Survey Battle: What's Old, What's New, What Wins," Price Waterhouse Intellectual Property Leadership Forum, Phoenix, Arizona, February 16, 1996

HONORS

- *The Best Lawyers in America*, Litigation - Intellectual Property and Trademark Law with special mention as one of a distinguished group of attorneys who have been listed for ten years or longer, 2005-2020
- *Chambers USA: America's Leading Lawyers for Business*, Leading Illinois Intellectual Property Lawyers, 2004-2017
- Illinois Super Lawyers, Intellectual Property Law, 2005-2017

- Regular appearances in *Who's Who in America*, *Who's Who in American Law*, *Who's Who in the World*, *Who's Who Legal USA: Trademarks*, *Who's Who Legal: Illinois*, *Who's Who Legal - Trademarks*, and *International Who's Who of Business Lawyers*, 1994-2017
- *Expert Guides to the World's Leading Lawyers*, *Best of the Best*, 2007, 2015
- Leading Lawyers Network, 1999-2005, 2007, 2009-2014
- *World Trademark Review 1000 – The Definitive Guide to Trademark Legal Services*, 2011, 2012, Tier 1, 'Individuals - Contentious', 2013, Luminary, 2013, 2017-2018
- Trademark Law Lawyer of the Year - Chicago, *The Best Lawyers in America*, 2012
- Lifetime Achievement Award, *World Trademark Review*, 2011
- Burton Award for Legal Achievement (with Anne Gilson LaLonde), 2003, 2005, 2006, 2011
- *PLC Which Lawyer?*, Recommended Intellectual Property Lawyer in Chicago, 2010
- Lifetime Achievement Award, *Managing Intellectual Property*, 2008
- Inducted into the Intellectual Property Hall of Fame, 2007
- Ranked in top 25 in *Managing Intellectual Property's 2006 Guide to the World's Leading Trade Mark Law Practitioners*
- *Best of the Best Expert Guide*, 2005
- Ranked one of the top 5 U.S. attorneys by Euromoney's *Best of the Best Expert Guide*. Received the most votes worldwide, June 2003
- International Trademark Association President's Award, 2001
- Top Trademark Lawyer in the World, Euromoney *Managing Intellectual Property*, 1998
- America's Top Lawyers

AFFILIATIONS

- International Trademark Association
Counsel, 1991-1994
Board of Directors, 1978-1980
Reporter, Trademark Review Commission of International Trademark Association, 1985-88. Negotiated and drafted portions of Trademark Law Revision Act of 1988, the first comprehensive revision of 1946's Lanham Act.
Chairman, *Ad Hoc* Committee on Alternative Forms of Dispute Resolution, 1983-1985
Publications Committee, 1980-1983
Lawyers Advisory Committee, 1976-1978
Federal Legislation Committee, 1975-1976
- American Bar Association
- Intellectual Property Owners Association
- Mediator, CPR Institute for Dispute Resolution/INTA Alternative Dispute Resolution Joint Venture, 1994-2008
- Advisor, American Law Institute project on the *Restatement (Third) of the Law of Unfair Competition*, 1986-1991
- Admitted to practice law in U.S. Supreme Court and eight U.S. Courts of Appeals

REPRESENTATIVE MATTERS

- *R.J. Reynolds Tobacco Company and GMB, Inc. v. Premium Tobacco Stores, Inc., d/b/a Cigarettes Cheaper*, 99C1174. Jury verdict for plaintiffs federal trademark infringement, dilution and related counts. Damages of \$3,560,002 awarded (May 6, 2004) (affirmed on appeal).
- *Zimmerman v. National Association of Realtors*, 70 U.S.P.Q.2d 1425 (TTAB 2004).
- *Freeman v. National Association of Realtors*, 64 U.S.P.Q.2d 1700 (TTAB 2002).

Biographies | Jerome Gilson

- *Hershey The Tin Man v. Avon Products Inc.*, 59 U.S.P.Q.2d 1520 (D. Mont. 2001). Affirmed and remanded for findings of fact (9th Cir. 2001).
- *MicroStrategy Inc. v. Motorola Inc.*, 58 U.S.P.Q.2d 1278 (4th Cir. 2001).
- *GoTo.com, Inc. v. Walt Disney Co.*, 53 U.S.P.Q.2d 1652 (9th Cir. 2000).
- *The BF Goodrich Company v. Tire Deals Inc.*, CV 2607-ODE, consent judgment (N.D. Ga. 2000).
- *Navistar International Transportation Corp. v. Freightliner Corp.*, 49 U.S.P.Q.2d 1116 (N.D. Ill. 1998).
- *Navistar International Transportation Corp. v. Freightliner Corp.*, 49 U.S.P.Q.2d 1108 (N.D. Ill. 1998).
- *Danjaq LLC v. Sony Corp.*, 49 U.S.P.Q.2d 1341 (C.D. Cal. 1998).
- *Lone Star Steakhouse & Saloon, Inc. v. Longhorn Steaks, Inc.*, 44 U.S.P.Q.2d 1217, 122 F. 3d 1379 (11th Cir. 1997).
- *Navistar International Transportation Corp. v. Freightliner Corp.*, 44 U.S.P.Q.2d 1382 (N.D. Ill. 1997).
- *SunAmerica Corp. v. Sun Life Assurance Co. of Canada*, 77 F. 3d 1325 (11th Cir.), *cert. denied* (1996).