



## JEFFREY A. WAKOLBINGER

Partner

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## BIOGRAPHY

Jeff Wakolbinger's practice focuses on intellectual property matters encompassing all aspects of trademark, copyright, trade secret, unfair competition, marketing and advertising matters. His practice often involves the enforcement of rights through both dispute and prosecution matters on companies of all scales, from startups to Fortune 100s, including those in consumer goods, technology, retail, fashion, hospitality, media and entertainment sectors.

Jeff represents owners and companies of well-known brands in litigation and appeals before federal courts and the Trademark Trial and Appeal Board (TTAB). He is credited for providing full-service support from the pre-litigation stage through trial and appeal, always seeking to secure the best and most efficient resolution for his clients. He also provides support through clearance opinions, registration and prosecution, corporate due diligence, and providing comprehensive counseling advice.

After many years advocating for clients in mediations and settlement conferences, Jeff decided to seek additional training to facilitate settlement of disputes as a neutral third-party mediator. He holds a certificate in Mediation Skills Training from Northwestern University and is listed in the International Trademark Association's (INTA's) Directory of Trademark Mediators.

Jeff previously served as a law clerk to a federal district court judge in the Northern District of Illinois. In law school, he was the symposium editor of the University of Illinois Law Review, and he has served as an editor of the Trademark Reporter, the law journal of the International Trademark Association. Jeff continues to be active with the University of Illinois College of Law, and regularly serves as a mentor for current law students. He is also active with INTA, where he has been a member of various committees over the years and has presented at the ANA/BAA Marketing Law Conference.

Jeff is also a former musician and recording engineer, previously based out of Los Angeles. He maintains a strong interest in the arts and regularly devotes time to pro bono matters for up-and-coming artists. He is a founder of the Administer Justice legal clinic at Covenant Presbyterian Church in Chicago, where he regularly provides legal counseling on a variety of matters to persons of limited means.

## CIVIC INVOLVEMENT & HONORS

- *WTR 1000: The World's Leading Trademark Professionals*, 2024

## RECOGNITIONS

- Super Lawyers Illinois, 2019–2023
- Super Lawyers Rising Stars Illinois, 2014–2018

## ADMISSIONS

- Illinois, 2008
- US Court of Appeals, Seventh and Ninth Circuits

US District Court, Northern District of Illinois, Trial Bar

US District Court, Southern District of Illinois

## EDUCATION

University of Illinois, J.D., Order of the Coif, 2008

University of Illinois, B.M., summa cum laude, 2000

## RELATED CAPABILITIES

- Intellectual Property & Technology Disputes
- Litigation & Dispute Resolution
- Regulation, Compliance & Advisory
- Healthcare & Life Sciences
- Business & Commercial Disputes
- Trade Secrets
- Copyrights
- Trademark Litigation
- Marketing & Advertising

## EXPERIENCE

### Litigation Matters

- *Edrington Distillers Group Limited v. Apogee 21 Holdings, Inc.* (D.Del.) – Defending Apogee 21 in this trademark, dilution, and counterfeiting matter regarding the Noble Oak mark associated with whiskey beverage labels.
- *Tribus LLC v. Tribus Home Warranty, LLC* (E.D.Mo.) – Defending Tribus Home Warranty in this trademark and cybersquatting action regarding trademark infringement, dilution, and cybersquatting claims.
- *The Breakfast Klub, Inc. v. 1600 Breakfast Club, LLC, et al.* (C.D. Cal.) – Defended 1600 Breakfast Club, LLC in this trademark infringement action regarding trademark infringement claims around the Breakfast Club marks for restaurant services. Defeated a motion for preliminary injunction.
- *Jump Operations, LLC v. Merryman* (D. Nev.) – Represented Jump Operations in this domain name suit involving breach-of-contract claims. Successfully moved for a TRO and then settled the matter soon after.

- **F21 OpCo, LLC v. AirWair International Ltd.** (C.D. Cal.) – Represented Forever 21 in a trademark suit regarding trade dress claims. Settled favorably within days of the final pretrial conference.
- **Chronic Disease Fund, Inc., d/b/a Good Days v. Castellanos, et al.** (N.D. Ill.) – Represented non-profit Chronic Disease Fund regarding claims of deceptive and unfair trade practice claims. The matter settled favorably.
- **InFlight Dublin, Inc. v. Astronics Corp., et al.** (N.D. Ill.) – Defended aerospace company Astronics in this false advertising and Lanham Act suit regarding avionics hardware. The matter settled favorably.
- **Riddle v. Ecowize, USA, et al.** (N.D. Ill.) – Appointed as counsel through N.D. Ill. Trial Bar to represent the plaintiff in this employment matter brought under § 1983. The matter settled favorably.
- **Boar's Head Provisions Co., Inc. v. Crystal Distribution Services, Inc.** (D. Iowa) – Represented Boar's Head Provisions in this breach of contract claims under Uniform Commercial Code Article 7 involving loss associated with food products stored at defendant's warehouse. The matter settled favorably.
- **Toni Basil v. Forever 21, et al.** (C.D. Cal.) – Represented retailer Forever 21, Kohl's, and the Walt Disney Company in this right of publicity matter that was favorably dismissed after a successful anti-SLAPP motion.
- **The Islamic Food and Nutrition Council of America (IFANCA) v. Bakesweet Corp d/d/a Libanais Sweets** (Ill. 1<sup>st</sup>) – Represented IFANCA in this trademark enforcement suit involving IFANCA's halal certification marks. Achieved a permanent injunction through a consent judgement. The matter settled favorably afterwards.
- **3D Systems Corp. v. Miller, Union Tech, Inc., and RP Sales America, Inc.** (S.D. Ind.) – Represented manufacturer and distributor of industrial 3D printers in suit involving claims of trade secret misappropriation by salesperson.
- **Adidas America, Inc., et al. v. Forever 21, Inc.** (D. Ore.) – Defended retailer Forever 21 in this trademark infringement suit regarding the use of marks. The matter was terminated by bankruptcy after filing of motions for summary judgment.
- **Zelgor, Inc. v. Sun Pharmaceutical Industries, Ltd.** (D. Mass.) – Defended Sun Pharmaceuticals in this trademark infringement suit regarding the use of marks, unfair competition and Lanham Act claims for branded vitamins and candies. The matter settled favorably.
- **Restoration Hardware, Inc., et al v. Haynes Furniture Co., Inc.** (N.D. Ill.) – Represented Haynes Furniture Company in this copyright and Lanham Act false advertising suit for campaigns in

print and online media. The matter settled favorably.

- ***The Estate of Marilyn Monroe, LLC v. Fashion Central, LLC*** (S.D.N.Y.) – Represented the Estate of Marilyn Monroe in the enforcement of trademarks, false destination of origin and Lanham Act claims for the use of image and likeness without permissions. The matter settled favorably.
- ***Logan Graphic Products, Inc. v. TCP Global Corp. et al.*** (N.D. Ill.) – Represented Logan Graphics Products in suit regarding trade dress for art and craft supplies. A permanent injunction was obtained against the defendant.
- ***Lopez v. Forever 21 Retail, Inc.*** (S.D.N.Y.) – Represented Forever 21 against claims of trademark infringement involving clothing. The matter settled favorably.
- ***Captain's Club Apparel, Inc. v. Aeropostale, Inc.*** (D.Mass.) – Defended clothing retailer Aeropostale regarding Lanham Act claims regarding “Stay Wavy” branding. The matter was favorably resolved.
- ***Motorola Trademark Holdings, LLC v. Pyskon Co., Ltd., et al.*** (N.D. Ill.) – Represented Motorola in this trademark enforcement suit involving cellphone accessories. The matter settled favorably.
- ***Dermfx, Inc. v. Obagi Medical Products, Inc.*** (C.D. Cal.) – Represented Dermfx, Inc. in this trademark enforcement matter regarding the use of namesake DermFX marks for personal care products. Settled case after winning summary judgment.
- ***ABS Entertainment, Inc. v. Cumulus Media, Inc.*** (C.D. Cal. & S.D.N.Y.) – Represented major media broadcast company Cumulus Media in this class action and copyright matter regarding the distribution, storage and play of pre-1972 sound recordings. The matter settled favorably.
- ***Meier v. Valeant Pharmaceuticals, N.A., LLC*** (S.D.N.Y.) – Represented Valeant in this copyright infringement suit regarding the use and distribution of images associated with skincare and cosmetic procedures. The matter settled favorably.
- ***UMG Recordings, Inc., et al. v. Centric Group, LLC, et al.*** (C.D. Cal.) – Defended the Centric Group in a copyright infringement matter regarding distribution and digital performance of sound recordings. The matter settled favorably.
- ***Berkley Networks Corporation v. Inmarket Media, LLC*** (S.D.N.Y.) – Defended internet and e-commerce company InMarket Media in a trademark infringement suit. Settled after successful opposition to a motion for preliminary injunction.

- ***Motorola Trademark Holdings, LLC v. UNORTH, LLC*** (N.D. Ill.) – Represented Motorola in this trademark enforcement suit regarding the protection of its popular brand and marks used for consumer electronics. The matter settled favorably.
- ***Aeropostale Procurement Company, Inc., et al. v. H&M Hennes & Mauritz, LP*** (S.D.N.Y.) – Represented the major retailer and clothing company in this trademark enforcement suit regarding the use of “Live Love Dream” marks in popular clothing products. The matter settled favorably.
- ***Motorola Trademark Holdings, LLC v. SafeMobile, LLC, et al.*** (N.D. Ill.) – Represented Motorola in this trademark enforcement suit regarding registration, dilution by blurring, false designation, and unfair business practice claims. The matter settled favorably within nine months of filing.
- ***Maxim Integrated Products, Inc., v. Motorola Trademark Holdings, LLC*** (N.D. Cal.) – Defended Motorola in this declaratory judgment action involving claims of trademark infringement involving Motorola’s famous “Circle-M” logo. The matter settled favorably.
- ***Twilight Records Inc., et al v. Raymond, et al.*** (N.D. Ill.) – Represented HBO Films in this copyright infringement matter regarding claims around the use, distribution, and play of musical recordings and compositions of many famed artists and record labels. The matter settled favorably.
- ***US Foods, Inc. v. Scripps Networks Interactive, Inc.*** (N.D. Ill.) – Defended television media company Scripps Networks, also known as The Food Network and The Cooking Channel, in a trademark infringement suit regarding the use of “Food Fanatics” mark in popular culture and media. The matter settled favorably after preliminary injunction hearing.
- ***Frank Brunckhorst Co., LLC v. Dietz & Watson, Inc.*** (E.D.N.Y.) – Represented Frank Brunkhorst and the Boar’s Head brand delicatessen in a trademark enforcement suit regarding deli products. The matter settled favorably.
- ***Peabody Management, Inc. v. LQ Management, LLC*** (M.D. Fla.) – Represented Peabody Management in a trademark enforcement suit between Peabody Hotels and La Quinta Inn’s use of motion trademark associated with hotel services. The matter settled favorably.
- ***FRAM Group Operations, LLC v. Purolator Filters NA, LLC*** (N.D. Ill.) – Represented one of the largest aftermarket auto part manufacturers against false advertising claims. The matter settled favorably.
- ***BP Products North America, Inc. v. Sadia Oil, Inc., et al.*** (W.D. Pa.) – Represented BP in this trademark enforcement and breach of contract suit regarding BP gas stations and their franchisors. The matter settled favorably.

- ***Navistar, Inc., et al. v. Pure Power, LLC*** (D. Idaho) – Represented plaintiffs manufacturer of truck engines against competing user of the “Pure Power” mark.
- ***Shield Technologies Corp. v. Paradigm Positioning, LLC, et al.*** (N.D. Ill.) – Represented Shield Technologies in this trade secret suit involving protective equipment. The matter settled favorably.
- ***Owens Corning Intellectual Capital, LLC v. Kingspan Insulation, Ltd.*** (N.D. Ga.) – Represented Owens Corning in a trademark infringement suit regarding the use of the famed “pink” color trademark associated with the building and construction sector. The matter settled favorably.
- ***Zimnicki v. Cornerstone Brands, Inc., et al.*** (N.D. Ill.) – Represented individual designer in an enforcement suit regarding the copyright and trademark infringement around holiday designs and displays. The matter settled favorably.

## TTAB Cases

- **Lenovo** Truscale LLC (TTAB) – Defended an opposition involving use of the TruScale mark for data-management services.
- **Lenovo** - various (TTAB) – Filed multiple successful opposition proceedings on behalf of computer manufacturer for trademarks similar to its LENOVO or THINK family of trademarks.
- **Motorola Trademark Holdings LLC** - various (TTAB) – Filed multiple successful opposition proceedings on behalf of cellphone marker involving its famous MOTOROLA, MOTO, and “Circle-M” trademarks.
- *Royal Chain, Inc. v. Masur Gavriel LLC* (TTAB) – Represented manufacturer of luxury leather goods in trademark opposition and obtained judgment after trial on the merits.

## RESOURCES

### PUBLICATIONS

- “[Dr. Martens Maker Moves To Keep Shein TM Fight Alive](#)”, *Law 360*, March 28, 2025

## RELATED INSIGHTS

News

Apr 01, 2024

**BCLP Recognized as a Leading Trademark Group by World Trademark Review**

News

Mar 19, 2024

**New study finds that NFT-specific legislation is not necessary**

News

Mar 13, 2024

**Penn State Suit Sets Off Debate Over Trademarks' Function**

News

Jan 04, 2024

**BCLP partner weighs in on trademark infringement**

News

Dec 18, 2023

**Making music makes a better lawyer**