

Thomas M. Williams

Partner



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Practices/Industries

- IP Litigation
- Trademark/Copyright Litigation
- Trademark/Copyright Prosecution & Portfolio Management
- Advertising, Marketing & Promotions

Education

University of Wisconsin at
Madison
(B.A., 1993)

University of Illinois
(J.D., 1996)

*University of Illinois Law
Review*

Overview

An internationally recognized litigator, Tom litigates trademark and false advertising disputes on behalf of a number of the world's largest and most sophisticated brands. He also manages prosecution and maintenance of trademark portfolios. He has extensive experience representing clients in all aspects of trademark law, including trade dress. He represents clients before federal district and appellate courts, and in proceedings before the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office.

Tom specializes in competitor false advertising disputes under the Lanham Act and authored a book, which is published by Lexis-Nexis and updated annually, entitled "False Advertising and the Lanham Act." Tom's book received a highly favorable review from the International Trademark Association (INTA) in *The Trademark Reporter*, July-Aug. 2012, vol. 102 no. 4. Tom is a member of the International Trademark Association (INTA), where he serves on the Trademark Enforcement Committee.

Experience

- Obtained permanent injunction in trademark and trade dress infringement and dilution action involving an iconic advertising spokesperson used by one of the nation's largest automotive insurance providers.
- Successfully opposed competitor's applications to register similar trademarks covering hair care products in consolidated opposition proceeding before the USPTO Trademark Trial and Appeal Board.
- Represented automobile dealerships in false advertising and unfair competition litigation in federal district court.
- Obtained permanent injunction and \$2 million statutory damages award in trademark counterfeiting civil action against fraudster offering fictitious loans to consumers under client's federally registered financial services marks.
- Represented a multinational manufacturer of welding, cutting, and joining products in a domain name dispute filed under the UDRP against a serial cyber squatter engaged in "typosquatting" use of the client's trademarks.
- Represented payment processing services provider in false advertising and unfair competition litigation in federal district court.
- Successfully defended opposition to client's pending service mark application covering its distinctive house mark after full trial on the merits in USPTO Trademark Trial and Appeal Board.
- Manages global trademark portfolio of leading materials processing and distribution company.
- Successfully represented power tool manufacturer in civil action involving product configuration trade dress and color.
- Obtained Temporary Restraining Order barring defendants from using, promoting, or displaying infringing trademark during industry's largest trade show.

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Experience (Cont)

- Successfully represented a consumer products manufacturer in civil action involving product packaging trade dress claim asserting colors, images, and word marks.
- Obtained summary judgment and permanent injunction for plaintiff challenging defendant's unauthorized use of plaintiff's famous marks on merchandise bags sold to plaintiff's independent dealerships.
- Obtained reversal of product configuration trade dress verdict against defendant on appeal to the U.S. Court of Appeals for the Sixth Circuit.
- Successfully represented trademark owner in civil action involving competitor's use of infringing marks as meta tags on website.
- Successfully represented plaintiff in civil action challenging literally false and misleading statements by competitor in commercial truck manufacturing industry.
- Obtained permanent injunction against competitor's use of infringing and dilutive color trademark in connection with medical products.
- Obtained permanent injunction against competitor's infringing and dilutive product configuration trade dress for game puzzle.
- Successful *ex parte* appeal of genericness and descriptiveness refusal in connection with major online retailer's service mark.
- Representation of applicant in *inter partes* oppositions involving audible sound marks used in connection with telecommunications devices.
- Numerous successful UDRP actions against bad faith registration and use of brand owners' trademarks as domain names.
- Successfully represented plaintiff in JAMS arbitration involving product configuration trade dress and breach of contract.
- Successfully represented defendant in unfair competition mediation under the Northern District of Illinois district court's Lanham Act Mediation Program.

Presentations

- "Lanham Act Update: Non-Traditional Trademarks and False Advertising Claims," A Closer Look: Trademarks and False Advertising Claims Client CLE Seminar (October 2016)
- "Winning the Branding Battle: Everything (Almost) Is a Trademark," The Secrets of Winning (August 2014)
- "Top 10 Tips for Developing Protectable Trade Dress," Association of Corporate Counsel, Webinar (May 2014)
- "Trademark Law for Attorneys: A 2012 Perspective. Non-Traditional Trademarks," The Knowledge Group/The Knowledge Congress Live Webcast Series (August 2012)
- "False Patent Marking – Recent Case Law Developments," The New York Intellectual Property Association (November 2010)
- "Social Media and the Law: Brand Protection," Emerging Trends in Business, Chicagoland Chamber of Commerce (February 2010)

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Presentations (Cont)

- “Social Media Pros and Legal Cons: Legal Issues in Social Media,” ICLA Webinar (November 1999)
- “Litigation Alternatives: TTAB and UDRP,” Practising Law Institute (June 2008)
- “ICANN Proceedings: A Cost-Effective Alternative to Litigation,” Northwestern University (2001)
- “WIPO Bodyslams Cybersquatter,” Seminar, Chicago (2000)

Publications

- “Coffee dispute brews,” Intellectual Property Magazine, Co-Author (May 2019)
- “Federal Circuit Maintains Full-Court Press on Converse’s Chuck Taylor Trade Dress,” IP Watchdog (December 2018)
- “Q&A: Trademark expert Tom Williams on Converse shoe design fight,” Westlaw Journal Intellectual Property (November 2018)
- Book: “False Advertising and the Lanham Act: Litigating Section 43(a)(1)(B),” *Lexis-Nexis* (2012-2016) (updated annually)
- “Comment: USPTO and TTAB Treatment of ‘Green’ Trademarks,” *World Trademark Review*, No 28 (December/January 2011)
- “False Patent Marking Claims Under the Lanham Act,” *Patent Trademark & Copyright Journal* (BNA)79, No. 607 (March 2010)
- “Fed.Circ. Stance on ‘The Cold War Museum’ Mark,” *Law360* (December 2009)
- “Winter v. NRDC: A Stricter Standard for Irreparable Harm in Trademark Cases?,” *Journal of the Patent and Trademark Office Society* 91, No. 10, 11, 12 (October-December 2009)
- “The Bell Tolls for Inherently Distinctive Sound Trademarks,” *Patent Trademark & Copyright Journal* (BNA) 77, No. 685 (April 2009)
- “The Sound of Unconventional Marks in the U.S.,” *World Trademark Review*, Vol. 8, Co-Author (July 2007)
- “Thinking of Updating Your Trademark? Think Again,” *Managing Intellectual Property* (July/August 2000)

Involvement

Professional Affiliations

- International Trademark Association (INTA) (*Enforcement Committee*)

Honors & Distinctions

- *World Trademark Review 1000 – The World’s Leading Trademark Professionals* “WTR 1000” (2012-2018)
- Named to the Illinois Super Lawyers List (2010-2019)
- Named to *The Best Lawyers in America*®, Advertising Law (2018-2020)
- Named a “Leading Lawyer” in a survey of lawyers by the *Law Bulletin Publishing Company* (2013-2019)

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Admissions

- State of Illinois
- U.S. Court of Appeals, Seventh Circuit
- U.S. District Court, Northern District of Illinois
- U.S. District Court, Eastern District of Wisconsin