

# Adam S. Weiss

TRADEMARK, COPYRIGHT & BRANDING CHAIR

Chicago, IL | 312.873.3644

[aweiss@polsinelli.com](mailto:aweiss@polsinelli.com)



Adam S. Weiss represents small businesses and large corporations, as well as both plaintiffs and defendants, to secure, protect, monetize and litigate all types of intellectual property rights.

Adam honed his style and strategies while working with leading companies and their largest brands. He was instrumental as one of the lead counsel in an ITC case in which the Commission first recognized common law trade dress rights. Adam recently won a first-of-its-kind patent infringement case, invalidating all asserted patents under the *Alice* doctrine, despite the fact that some of the asserted patents had been examined and issued after the Patent Office's interim *Alice* guidance. He has a proven record of efficient and favorable client results in Federal court and before the Trademark Trial and Appeal Board.

Adam's experience as both outside and in-house counsel provides a unique and diverse business perspective and valuable insight into his client's needs, which contributes to well-rounded and practical advice. His experience on either side of the courtroom enables him to better understand his opponents' strategy, which allows for successful and efficient resolutions. As an Adjunct Professor teaching intellectual property research and writing courses, Adam further developed the ability to present and explain complex problems simply and clarify issues for optimal positioning. Regardless of a matter's scale or substance, clients quickly learn that they can depend on Adam's responsiveness, attention to detail, and thorough planning.

Adam has hands on experience partnering with Chicago's entrepreneurial and startup community, where he has been a long time member and contributor of Hyde Park Angels, and serves on the Advisory Board of the Chicago-Kent Entrepreneurship Program.

## Education

- Chicago-Kent College of Law (J.D., 1998)
  - with honors
- University of Illinois at Urbana-Champaign (B.S., 1995)
  - Chemical Engineering

## Capabilities

- Intellectual Property
- Intellectual Property Counseling & Opinions
- Litigation
- Trademark, Copyright & Branding
- Trademark, Copyright & Branding Litigation
- International Trademark & Clearance
- Technology
- Trademark Clearance & Prosecution

## Bar Admissions

- Illinois, 1998
- Admitted to practice before the United States Patent and Trademark Office

## Court Admissions

- U.S. District Court, Northern District of Illinois
- U.S. Court of Appeals, Federal Circuit

## Memberships

- American Bar Association
  - Intellectual Property Law Section
    - Special Committee on Trademarks and the Internet, Sub-Committee Co-Chair
- Chicago-Kent Entrepreneurship Program Advisory Board
- Hyde Park Angels
- International Trademark Association
  - Anti-Counterfeiting Committee
- RK Ventures

## Recognition

- World Trademark Review's 1000 List, Bronze - Illinois, 2024-2026
- Selected for inclusion in *Best Lawyers in America*® for Trademark Law, 2023-2024
- Judicial Intern for the Honorable Richard S. Kelly, Circuit Court of Cook County, Illinois
- Chicago-Kent College of Law, Four years as Adjunct Professor (Advanced Legal Drafting/Research, Intellectual Property)
- Selected for inclusion in the 2018 Trade Marks *Expert Guides*.

## Matters

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- Represented leading financial services company in dispute of empower.com domain name. *Great-West Life & Annuity Ins. Co. and Empower Retirement v. Empower Geographics Inc.*
- Represented toy manufacturer in TRO and preliminary injunction defense of trade dress, advertising and patent infringement litigation based on the look and packaging of the product. After a three day hearing, the Court denied Radio Flyer's Motion for Preliminary Injunction. *Radio Flyer Inc. v. American Plastic Toy, Inc.*
- Represented leading magic supply company in defense of dispute regarding trademarks. *Yigal Mesika v. Penguin Magic, Inc. et al.*
- One of the lead attorneys representing Sanford at the ITC against 15 Respondents, protecting registered trademark and common law trade dress rights in SHARPIE markers. The ITC judge issued its most powerful remedy: a General Exclusion Order barring markers that use a confusingly similar trademark and/or trade dress – the first time any party successfully enforced common law trade dress rights at the ITC. *In the Matter of Certain Ink Markers and Packaging Thereof*, Investigation No. 337-TA-522.
- Represented Sanford in numerous actions, successfully enforcing trademark/trade

dress rights in SHARPIE markers. Obtained favorable judgments or settlements in all cases. *Sanford, L.P. v. Triple Dragon et al*; *Sanford, L.P. v. East Ameroasis Import, Inc., et al*; *Sanford, L.P. v. Kole Imports, Inc.*; *Sanford, L.P. v. Illinois Industrial Tool, Inc. d/b/a JMK-IIT, Inc. and d/b/a JMK Sales*; *Sanford, L.P. v. Davro Products, Inc.*; and *Sanford, L.P. v. Economy Pencil Company, Incorporated a/k/a Economy Pen & Pencil Company, d/b/a www.jo-bee.com*.

- Represented leading specialty cheese company in defense of dispute regarding packaging trade dress. *BC-USA, Inc. and Alouette Cheese USA LLC v. Churny Company, Inc.*
- Represented market leading billiards company in trademark infringement and dilution action. *Brunswick Bowling & Billiards v. H. Betti Industries, Inc. d/b/a Imperial International.*
- Represented nutraceutical distribution company in defense of dispute regarding trademark infringement and defamation. *Derek W. Cornelius and SI03, Inc. v. Protein Customizer, Inc.*
- Represented Thermos in trademark infringement, dilution and cyberpiracy action. *Thermos L.L.C. v. B2M2 Systems, LLC.*
- Represented Irwin in trademark declaratory judgment action involving blue-handled tools. *Irwin Industrial Tools, Inc. v. Estwing Manufacturing Company, Inc.*
- Represented Sanford in trademark and domain name dispute regarding sanford.com. *Sanford, L.P. v. Sanford Consulting, Clive Sanford, and Kyle Cole.*
- Represented drug diagnostics companies in trademark dispute regarding VIRCO. *Virco Pharmaceuticals, LLC and Virco Pharmaceuticals, Inc. v. Virco Group, N.V. and Virco Lab, Inc.*
- Represented defendants in trademark infringement dispute involving JUICY trademark. *BBK Tobacco & Foods v. Juicy eJuice et al.*
- Represent plaintiff in trade dress dispute regarding tire tread design. *Toyo Tire & Rubber v. Atturo Tire.*
- Represent defendant in trademark infringement dispute involving ASCENSION trademark. *Ascension Health Alliance v. Ascension Insurance.*
- Represented Rubbermaid Commercial Products in trademark infringement dispute involving BRUTE trademark. *Rubbermaid Commercial Products v. Brute Outdoors.*
- Represent plaintiff in trademark infringement dispute involving PATHWAY trademark. *Pathway Senior Living v. Pathway Senior Living.*
- Represented plaintiff in dispute involving ownership of Duke Nukem intellectual property. *Gearbox Software v. Apogee Software et al.*
- Represent defendant in patent infringement dispute involving logistic tracking software. *MacroPoint v FourKites.*
- Rubbermaid Commercial Products LLC v. Brute Outdoors, LLC (W.D. N.C., Civil Action No. 3:14-cv-435)

#### **Representative Samples of Trademark Trial and Appeal Board Opposition/Cancellation Matters**

- Represented leading financial services company in various trademark oppositions involving EMPOWER trademark, including EMPOWER ENGAGE logo, EMPOWERING FAMILIES, TRUEMPower, EMPOWER PEOPLE TO MAKE DECISIONS, EMPOWERED DIVORCES, among others.
- Represented leading social media company in various trademark oppositions and cancellations, including TWEET WITH RESPECT, ONE TWEET AT A TIME, STREET TWEETZ, TOILET TWEET, TWEET THIS, TWEET, TWEEBLE, TWEET ON MR PRESIDENT, KEEPING AMERICA AWESOME ONE TWEET AT A TIME, TWEET LOVE, POWER TWEET, various crescent designs, CLOUDPERISCOPE, PEERISCOPE, PERISCAPE, FLEETLOCATE PERISCOPE, FROGVINE, LIQUID VINE, among others.

- Represented leading grocery store in various trademark oppositions and cancellations involving CLEARLY trademark.
- Represented Graco Children's Products in trademark opposition PACK 'N PLAY v. TAK-N-PLAY.
- Represented world's largest options exchange in defense of trademark opposition PULSE v. PULSE.
- Represented Irwin Industrial Tool in trademark oppositions ARMOR v. ARMORMAX and SPEED-LINE v. SPEED.
- Represented Rubbermaid in various trademark oppositions, including RUBBERMAID v. PAPERMAID , RUBBERMAID v. PAPERMAID, RUBBERMAID v. CATERMAID, RUBBERMAID v. PLASTICMAID, RUBBERMAID v. COVERMAID and RUBBERMAID v. RUBBERWARE.
- Represented leading jewelry company in trademark cancellation KALI v. KALI KALI and defense of trademark opposition PADI v. PADI.
- Represented Goody Products in trademark opposition GOODY v. HOOD GOODY.
- Represented leading food company in trademark opposition RITZ v. RITZBURY.
- Represented Parker Pen in various trademark oppositions, including PARKER 51 v. 51, PARKER v. PARKER MARKER, and PARKER v. MARKER-PARKER.
- Represented Thermos in trademark opposition THERMOS v. THERMOSPOT.
- Represent Frito-Lay and affiliated companies as both plaintiff and in defense in numerous Trademark Trial and Appeal Board Opposition/Cancellation matters.
- Represented Spring Air in various trademark oppositions and defenses of trademark oppositions, including NEVER-FLIP v. NEVERTURN, TRUE BALANCE v. TOTAL BALANCE, PERFECT BALANCE v. TOTAL BALANCE, SPRING AIR v. SPRINGTRONIC, SPINAL CONTOUR v. SPINAL CONTOUR, COMFORT FLEX v. COMFORTFLEX, NEVER-FLIP v. NEVERTURN, CLASSIC COMFORT v. CLASSIC COMFORT COLLECTION, CONFORMA v. CONFORMASEAT, and SPRING AIR v. SPRINGAIR.