

Brian P. O'Donnell

Counsel

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Services

Intellectual Property
ITC Section 337
Patent Litigation
Trade Secrets

Industries

Apparel, Accessories & Luxury
Goods
Chemicals
Consumer Goods
Electronics & Computer
Technology
Energy
Financial Services
Fintech
Food, Restaurant & Beverage
Health & Life Sciences
Home Furnishings
Media & Entertainment
Medical & Surgical Devices
Oil & Gas
Retail & Consumer Goods
Technology



Brian O'Donnell is an intellectual property lawyer focusing on patent and trademark litigation and all phases of intellectual property counseling, including clearance, acquisition, licensing, transfer and pre-litigation enforcement of rights. Mr. O'Donnell has represented companies in numerous litigations in courts across the country. With respect to patents, he has litigated in a wide range of fields, including food, packaging, software, automotive, semiconductor, gaming, television and other consumer products. On the trademark side, he has litigated and counseled clients in such diverse industries as food and beverage, entertainment and hospitality, airlines, pharmaceuticals, tissue banks, software, energy, sporting goods, museums, educational and financial services, construction and medical associations. He also has experience managing international trademark and patent portfolios and representing clients in copyright, right of publicity, trade secret, data privacy, and domain name dispute resolution matters.

Prior to joining the firm, Mr. O'Donnell was counsel at Kellogg Company in Battle Creek, Michigan, where he was responsible for managing its global IP assets, technology transactions, and intellectual property litigation. He previously worked as an associate in the Washington, D.C. office of an international law firm.

Mr. O'Donnell has been committed throughout his career to providing *pro bono* legal services to non-profit and charitable organizations and persons of limited means. He also served in the formation, and as inaugural Chair, of the International Trademark Association's Pro Bono Committee. While attending law school, Mr. O'Donnell was managing editor of the *Loyola Consumer Law Review*.

Representative Matters

Patent

Intellectual Ventures LLC v. Motorola Mobility LLC (S.D. Fla.), Represent Motorola in patent infringement case involving smartphones.

Wi-LAN USA Inc. v. Toshiba Corp. (S.D. Fla.), Represented Wi-LAN in patent infringement case involving video display technology.

Rambus Inc. v. LSI Corp. (N.D. Cal.), Represented LSI in patent infringement case involving DRAM technology.

Brandeis University v. Keebler Co. et al. (N.D. Ill.), Represented Keebler in patent infringement case involving food oils affecting low and high density lipoprotein cholesterol.

Cryovac, Inc. v. Pechiney Plastic Packaging, Inc. (D. Del.), Represented Pechiney in patent infringement case involving multi-layer polymer films.

Automotive Technologies Int'l, Inc. v. Mitsubishi Electric Corp. (E.D. Mich.), Represented Mitsubishi in patent infringement case involving piezoelectric automotive airbag sensors.

Douglas Press, Inc. v. Universal Mfg. Co. (N.D. Ill.), Represented Universal in patent and trademark infringement case involving gaming technology.

IP Learn, LLC v. Skillsoft Corp. (N.D. Ill.), Represented Skillsoft in patent infringement case involving software directed at an automated learning system with pre-test.

DeVlieg-Bullard v. Ivan Doverspike (N.D. Ill.), Represented DeVlieg in patent infringement case involving direct drive spindle technology.

Seb S.A. v. Sunbeam Corp. (S.D. Fla.), Represented Sunbeam in patent infringement case involving deep fryers.

Trademark

Dale and Thomas Popcorn, LLC v. Kellogg Co. et al (D. N.J.), Represented Kellogg in trademark infringement case involving POP-TARTS POPSTERS crackers and POPSTER popcorn marks.

Kellogg North America Co. v. Tribe Mediterranean Foods, Inc. (W.D. Mich.), Represented Kellogg in trade dress infringement case involving Kellogg's MORNINGSTAR FARMS packaging design.

Cross Country Home Services, Inc. v. Home Service USA, Inc. et al. (S.D. Fla.), Represented Home Service in trademark infringement case involving marks HOMESERVE and HOME SERVICE USA for home repair and maintenance warranty services.

Smith Mountain Industries, Inc. v. McCall's Country Canning, Inc. (W.D. Va.), Represented Smith Mountain in trade dress infringement case involving the shape and design of jar candles.

Brooklyn Information & Culture vs. The Brick Theater, Inc. (E.D. N.Y.), Represented The Brick Theater *pro bono* in trademark infringement case involving BRIC and THE BRICK trademarks for entertainment services.

Elkay Mfg. Co. v. Medallion Cabinets, Inc. (W.D. Tex.), Represented Elkay in trademark infringement and dilution case involving MEDALLION trademarks for cabinetry.

Nabisco, Inc. v. Brach's Confections, Inc. (M.D. Tenn.), Represented Brach's in trademark infringement and dilution case involving FROOT LOOPS fruit snacks and Nabisco's trademark for product design of LIFE SAVERS candies.

Food & Friends, Inc. v. Curves Int'l, Inc. (D. D.C.), Represented Food & Friends *pro bono* in trademark infringement case involving marks FOOD & FRIENDS and FOOD FOR FRIENDS for charitable services.

Mr. O'Donnell has also handled numerous proceedings before the U.S. Trademark Trial & Appeal Board,

including: *SAGroup in Debt Restructuring Litigation v. Swiss International Air Lines, Ltd.*; *Sonafi S.A. v. Judd*; *Kellogg North America Co. v. Gardenchef Paul Co.*; *Bear Naked, Inc. v. Chicago Custom Foods, LLC*; *Kashi Co. v. The Fresh Market, Inc.*; *Kellogg North America Co. v. KMCH Natural Foods, Inc.*; *Kellogg North America Co. v. Kraft Foods Global Brands, LLC*; *Kellogg North America Co. v. Wise Foods, Inc.*; *Remico Enterprise, Inc. v. Herbal Water, Inc.*; *Mauskop v. Valeant Pharmaceuticals North America*; *McCall's Country Canning, Inc. v. Smith Mountain Industries, Inc.*; *Nfinance, Inc. v. Mastercard International Inc.*; *Southwest Women Working Together v. Spirit of Women Foundation, Inc.*; *Zisook v. Nutri/System IPHC, Inc.*; *Kutler et al. v. F&C Management Limited*; *Southern DataComm, Inc. v. Transaction Network Services, Inc.*; *Universal Manufacturing Company, Inc. v. Milton Sales, Inc.*

Copyright

ApplicationsOnline, LLC v. ApplyYourself, Inc. (E.D. Va.), Represented ApplyYourself in copyright infringement case involving online college application software.

Metro-Goldwyn-Mayer, Inc. v. Beauty Shop, LLC (C.D. Cal.), Represented Beauty Shop and producer Mark Brown in copyright and trademark infringement case involving release of motion picture.

Milton Sales, Inc. v. Universal Mfg. Co. (W.D. Va.), Represented Universal in copyright and trademark infringement case involving numerous trademarks/copyrights for gaming pieces.

Kennelsource, Inc. v. AST Networks, Inc. et al. (N.D. Ill.), Represented AST in copyright infringement case involving website design.

Criminal

Illinois v. Calloway (Ill.), Represented Calloway *pro bono* in murder case.

Illinois v. Garcia (Ill.), Represented Garcia *pro bono* in burglary case.

Illinois v. Robinson (Ill.), Represented Robinson *pro bono* in armed robbery case.

Civil Rights

Thompson v. Village of Robbins et al. (N.D. Ill.), Represented Thompson *pro bono* in Section 1983 unlawful imprisonment case.

International Child Abduction



Marquez v. Contreras (D. Colo.), Represented Marquez in Hague Convention international child abduction case.

Experience

Successfully represented a Mexican mother *pro bono* in proceedings under the Hague Convention on the Civil Aspects of International Child Abduction. Obtained a verdict ordering return of the child to Mexico following a trial on the merits.

In re the Application of Raquel Fabiola Marquez Avila v. Rolando Contreras Gallegos, 14-cv-00230 (D. Colo. filed January 27, 2014).

Defending Broadcom and its six downstream customers Technicolor, HTC, Comcast, Arista, NETGEAR, and ARRIS in patent infringement and importation investigation brought against them by Tessera Technologies, related to semiconductor chip packaging technology. Trial set for March 2017 before Administrative Law Judge Dee Sandra Lord, with related actions in D. Delaware and Europe.

In re Certain Semiconductor Devices, U.S. ITC Investigation No. 337-TA-1010

Education

Loyola University Chicago School of Law, J.D. (2001)

The London School of Economics, M.S., International Relations (1995)

University of Illinois, B.A., Political Science (1994)

Ruprecht-Karls-Universität Heidelberg, Kurzzeitstudiumzertifikat (1993)

Admissions

Colorado (2013)

Michigan (2011)

District of Columbia (2007)

Illinois (2001)

Court Admissions

U.S. Supreme Court (2006)

U.S. Court of Appeals for the Seventh Circuit (2004)

U.S. District Court for the Eastern District of Wisconsin (2005)

U.S. District Court for the Eastern District of Michigan (2002)



U.S. District Court for the Northern District of Illinois (2001)

Illinois Supreme Court (2001)

Professional & Community Activities

International Trademark Association, Member

Law Firm Committee, Project Leader (2014-2015)

Pro Bono Committee, Chair (2012-2013)

Enforcement Committee (2010-2011)

Pro Bono Project Team (2010-2011)

Emerging Issues Committee (2009)

Illinois Bar Association, Member

Insights

[Publications](#)

Trademark Law and the Cannabis Industry: Six Things That Will Separate Brand Winners from Brand Losers
August 22, 2019

[In The News](#)

Kilpatrick Townsend's Media Report January 23-29, 2015
January 30, 2015

[In The News](#)

Brian O'Donnell Quoted by Law Week Colorado re: "Going In-House"
January 26, 2015