



BANNOCKBURN, ILLINOIS

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Thomas M. Monagan

SENIOR COUNSEL

Tom delivers a unique blend of litigation experience and intellectual property counseling experience with a broad skill set developed over more than 22 years of practice. Tom's practice focuses on trademark, copyright, false advertising, and other marketing disputes; intellectual property counseling and asset management; and the development of various Internet and technology licensing agreements. In addition to his law degree, Tom has an MBA with a concentration in marketing, and he worked in advertising and corporate communications prior to going back to law school. Tom brings that business experience to bear when counseling clients, always approaching legal issues from a very practical perspective that puts the needs of the business first.

Tom has a vast array of litigation experience. He has litigated and tried cases in numerous state and federal courts across the country in various areas of the law. His litigation experience includes trademark, copyright, trade secret, unfair competition, defamation, rights of publicity, and other commercial and contractual matters. He recently served as a key member of a trial team that secured a \$15.7 million verdict in a trademark infringement suit, where he was responsible for numerous aspects of the case, including the successful damages claims. Early in his career, he was also involved on multiple trial teams in patent infringement litigation cases.

Tom has particular experience in advertising matters. He provides counsel on claim substantiation issues and substantiation testing. He has also litigated and tried numerous false advertising cases in U.S. federal courts to both successful verdicts and substantial "courtroom steps" settlements. Tom also has extensive experience with other advertising disputes forums, including disputes at the National Advertising Division of the Council of Better Business Bureaus.

Tom regularly provides counsel on all aspects of trademark clearance and registration, including the management of large international trademark portfolios involving thousands of registrations across the globe. He has an extensive network of foreign associate law firms across the globe on which he relies to provide global counseling to his clients.

Tom also regularly negotiates technology transactions and technology license agreements for clients in various industries.

ADMISSION TO PRACTICE:

Illinois – (2002)

U.S. District Court for the Northern District of Illinois – (2003)

U.S. District Court for the District of Columbia – (2016)

EDUCATION:

Juris Doctor, The Ohio State University (Moritz) College of Law (2002)

MBA, Fisher College of Business, The Ohio State University (2002)

Bachelor of Science (Journalism), Northwestern University (1993)

Tom, and his wife Bridget, are the parents of three sons. When Tom is not practicing law, he enjoys travelling, watching his son's sporting events, attending college football and basketball games, and enjoying a cold drink on the back porch with friends.

Experience

- Senior Counsel, Neal & McDevitt (2024 – Present)
- Of Counsel, Norvell IP llc (2014 – 2023)
- Partner, Kirkland & Ellis LLP (2008 – 2014)
- Associate, Kirkland & Ellis LLP (2002 – 2008)

Professional Accomplishments

- Listed in World Trademark Review 1000 (2012-2024)
- Recognized for Marketing and Advertising Law in *The Legal 500 U.S.* (Large Firms) (2011-2013)

Community

- Glenbrook South High School Titan Hockey Club (past Secretary and current member of Rules and Ethics Committee)

Professional Activities and Membership

- International Trademark Association (INTA)
- American Bar Association (ABA)

Representative Cases

District Court

- *Chicago Mercantile Exchange, Inc. v. ICE Clear U.S., Inc. et al.* (N.D. Ill.) — Secured \$15.7 verdict in trademark infringement suit on behalf of CME. Key member of trial team with responsibility for damages evidence and expert testimony. Four-week trial regarding infringement of SPAN trademark included in-person and remote testimony from locations in U.S. and Europe.
- *Chicore, LLC v. Core Business Interiors Corp.* (N.D. Ill.) — Negotiated favorable agreement for client after filing trademark infringement action in response to USPTO/TTAB petition to cancel client's trademark registration.
- *Generation Good, NFP v. Seventh Generation, Inc.* (N.D. Ill.) — Negotiated settlement agreement and significant payment for client following discovery in trademark infringement action relating to use of mark for household cleaning products.
- *PEI Licensing, Inc. v. Leg Resource, Inc.* (S.D. Fla.) — Represented plaintiff in action involving breach of trademark license agreement. Negotiated favorable settlement.
- *Parker v. PayPal, Inc., HostGator et. al.* (E.D. Pa.) — Represented defendant in trademark, copyright and right of publicity action. Plaintiff voluntarily dismissed lawsuit after defendant responded to motion for preliminary injunction.
- *Creative Circus v. HostGator* (Ariz. Sup. Ct., Maricopa County) — Represented defendant in breach of contract and negligence action. Suit resolved after discovery and submission of defendant's expert reports.

- *Gench v. HostGator.com et. al.* (S.D.N.Y.) — Represented defendant in trademark infringement and false advertising action. Prevailed on motion to dismiss all claims. Plaintiff’s appeal denied by Second Circuit.
- *Kubota Corp. et al v. Global Development Int’l et al.* (N.D. Ill.) — Represented plaintiff in litigation alleging trademark infringement, false designation of origin, false association and cybersquatting, among other claims. Achieved favorable settlement after filing motion for summary judgment.
- *Experian Information Solutions, Inc. v. Carfax, Inc.* (N.D. Ill.) — Represented defendant, Carfax, against claims of defamation, product disparagement, and tortious interference, all related to a customer contract negotiation. Carfax asserted counterclaims against Experian for false advertising, consumer fraud and deceptive business practices. Case resolved prior to trial.
- *Ultra Records, Inc. v. Ultra Enterprises, Inc.* (S.D.N.Y.) — Provided strategic counsel to Ultra Records throughout trademark and breach of contract trial, including assistance with witness and thematic strategy, jury selection, and opening and closing arguments. Negotiated favorable settlement agreement on behalf of client following closing argument.
- *Timelines, Inc. v. Facebook, Inc.* (N.D. Ill.) — Defeated motion for Temporary Restraining Order filed against client, Facebook, on issue of alleged trademark infringement, and filed counterclaims seeking cancellation of the plaintiff’s trademark.
- *Comcast Cable Communications, LLC v. DIRECTV, Inc.* (N.D. Ill.) — Defeated motion for TRO by Comcast seeking to stop DIRECTV’s NFL Sunday Ticket advertising, which argued that DIRECTV’s free offer was false and misleading. The case settled after DIRECTV defeated Comcast’s motion.
- *Humanly Possible, Inc. v. Manpower, Inc. et al.* (N.D. Ill.) — Represented defendant in trademark infringement suit. Defeated motion for preliminary injunction and won motion for summary judgment.
- *Arcadia Group Brands Ltd. et al. v. Studio Moderna S.A. et al.* (N.D. Ill.) — Represented defendant in trademark litigation brought by U.K.-based fashion designer and marketer of TOPSHOP clothing brand. Client operated TOPSHOP Internet and cable TV shopping network in Eastern Europe and U.S. After months of international discovery the case proceeded through two mediations, after which the parties negotiated and executed a comprehensive, global coexistence agreement.
- *Dyson, Inc. v. Oreck Corp. et al.* (E.D. La.) — Represented bagless vacuum cleaner company, Dyson, in false advertising lawsuit against key competitor accused of violating a settlement agreement and of false advertising. After winning a key motion for summary judgment and proceeding through fact and expert discovery, Dyson ultimately agreed to settle the case one day before trial.
- *Oreck Corp. et al v. Dyson, Inc.* (E.D. La.) — Successfully represented Dyson in Oreck’s appeal of the dismissal of another false advertising case. The dismissal of Oreck’s case on *res judicata* grounds was upheld by the United States Court of Appeals for the Fifth Circuit.
- *Covidien AG et al. v. CapitalSource, Inc.* (S.D.N.Y.) — In trademark infringement case, represented medical products company Covidien (formerly Tyco Healthcare) against commercial bank accused of using

registered and non-registered design marks. Negotiated favorable settlement for Covidien.

- *Sweet Leaf Tea Co. v. United American Indus., Inc.* (W.D.T.X.) — Represented iced tea and beverage maker in trademark infringement suit for declaratory judgment of non-infringement filed against maker of stevia-based sweeteners. The parties consented to a co-existence agreement prior to discovery.
- *DIRECTV, Inc. v. Comcast Corp. et. al.* (N.D. Ill.) — Represented DIRECTV in false advertising lawsuit related to high-definition picture quality. Directed technical discovery and examined witnesses at preliminary injunction hearing. This case settled after the preliminary injunction hearing and an appeal to the United States Court of Appeals for the Seventh Circuit.
- *Merisant Company v. McNeil Nutritionals, LLC., Inc.* (E.D. Pa.) — Conducted five-week trial in false advertising suit pitting client’s Equal® brand sweetener against Splenda®. After a full trial on the merits, secured a very significant settlement for Equal (Merisant) on the verge of the reading of the jury verdict.
- *Chrysalis Management Group et. al. v. Chrysalis Ventures, LLC* (E.D. Pa.)— Represented accused trademark infringer in dispute with another private investment fund. Secured favorable settlement on behalf of client.
- *Hill’s Pet Nutrition, Inc., v. Nutro Products, Inc.* (C.D. Cal.) — Represented Hill’s in false advertising lawsuit in federal district court in Los Angeles. Responsible for consumer survey experts.
- *Ken’s Foods Inc. v. Jays Foods, Inc.* — Represented Chicago snack food company as defendant in a trademark infringement suit related to its Sweet Baby Jay’s potato chips; resulted in confidential settlement.
- *Jays Foods, Inc. v. Frito-Lay, Inc.* (N.D. Ill.) — Represented Jays in false advertising case against snack food giant Lay’s®. Secured temporary restraining order prohibiting Lay’s use of advertising featuring its taste preference claims and then negotiated a confidential settlement.

USPTO/WIPO

- Many additional trademark oppositions, cancellations and other proceedings before the USPTO’s Trademark Trial and Appeal Board
- Numerous disputes before the World Intellectual Property Organization under the Uniform Domain Name Dispute Resolution Policy (UDRP)

National Advertising Division

- Handled numerous cases before the National Advertising Division of the Better Business Bureau, including for example:
- Hill’s Pet Nutrition, Inc. “Vets Recommend” Challenge — Represented Hill’s in NAD case against key competitor regarding competitor’s claim that its product was “recommended by Veterinarians.” NAD determined that competitor could not support its claim. NAD Case No. 4942.
- Merisant Company (Equal) “Natural” Sweetener Challenge — Represented Merisant against competitor that falsely claimed its alternative sweetener product was “natural.” NAD agreed that competitor could not substantiate its “natural” claim. NAD Case No. 4442.

*Matters listed include representations occurring prior to joining Neal & McDevitt.