

Merchant & Gould

An Intellectual Property Law Firm



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Jack has a general practice of patent, trademark and copyright law, with an emphasis on trademark and advertising law. He served as the Chairman of Merchant & Gould's Trademark Practice Section for six years and celebrated his twenty-fifth anniversary with the firm on June 1, 2006. Jack counsels clients with large portfolios of Intellectual Property, and with complex business issues involving patents and trademarks, including litigation. He is responsible for worldwide portfolios of trademarks for many clients. He also is the filing correspondent on almost 4,000 U.S. Trademark and Service Mark applications. Jack is a specialist in large portfolio trademark clients, both domestically and internationally, including many private label manufacturers. He also serves as an expert witness in trademark matters, as a qualified neutral for alternative dispute resolution, and has an active practice in trademark oppositions and cancellations, having handled over 600 such proceedings. Jack has three grown children, and enjoys downhill skiing, golf, painting and making wine. Many of Jack's clients are Europeans, and Jack travels to Europe frequently.

Jack was named each year between 2006 through 2011 a Super Lawyer in the Minnesota Journal of Law and Politics and has earned the AV peer review rating from Martindale-Hubbell for many years.

Education

Creighton University
B.S., Physics, 1978; J.D., 1981
Member, Creighton Law Review

Bar Admissions

Minnesota State Bar, 1981
U.S. Patent and Trademark Office, 1981
U.S. District Court, District of Minnesota, 1982
U.S. Court of Appeals for the Federal Circuit, 1982
U.S. Court of Appeals for the Eighth Circuit, 1983
U.S. Court of Appeals for the Tenth Circuit, 1988

Atlanta

Denver

Knoxville

Madison

Minneapolis

New York

Seattle

Washington DC

John A. Clifford (Continued)

U.S. Supreme Court, 1991
U.S. District Court, District of Colorado, 1999
U.S. Court of Appeals for the First Circuit, 2004
Arizona State Bar, 2006
U.S. District Court, Western District of Wisconsin, 2008
U.S. District Court, District of Arizona, 2010
Nebraska State Bar, 2010
U.S. District Court, District of Nebraska, 2010

Professional Affiliations

International Trademark Association (INTA)

- *Member, Panel of Neutrals 2005-2011*
- *Attendee at numerous International Trademark Association (INTA) meetings*
- *Host of several INTA Roundtable meetings on trademark topics*
- *Member, Publications Committee*
- *Member, ADR Committee*

European Communities Trade Mark Association (ECTA)

American Bar Association (ABA)

American Intellectual Property Law Association (AIPLA)

Minnesota Intellectual Property Law Association

Atlanta

- *Trademark and Unfair Competition Committee Chair, 1996-1998*

International Federation of Industrial Property Attorneys (FICPI)

Denver

Minnesota Bar Association

Hennepin County Bar Association

Arizona Bar Association

Knoxville

Nebraska Bar Association

The French-American Chamber of Commerce (FACC)

Madison

Honors

On November 5, 2010, Jack was inducted as a Chevalier into the Ordre des Coteaux de Champagne, an honorary fraternity for the champagne industry first founded in the 1600's.

Minneapolis

Publications

Protecting Voss Water
Minnesota Law & Politics, August/September 2008.

New York

Co-author of the Minnesota State section of INTA publication State Trademark and Unfair Competition Law for the last twenty-five years.

Seattle

Author of Merchant & Gould's *Trademark Clearance and Usage Guide*.

Beware the Many Faces of a Trademark Scam, IPLaw 360, May 12, 2008

Washington DC

John A. Clifford (Continued)

Speaking Engagements

Trademark Bullying: Fact or Fiction

Institute of Intellectual Property and Social Justice CLE at Howard University on March 10, 2011

Strategies for Dealing with Trademark Bullies

Minnesota State Bar CLE on March 2, 2011

Navigating Private Label and Store Brand Issues and Disputes

Minnesota State Bar CLE on March, 2, 2011

Branding v. Genericide: Advertising Gone Wild

Minnesota State Bar Association CLE on April 7, 2005

All That Glitters Is Not Gold: A comparative review of colour, sound, and three-dimensional trademarks

Intellectual Property Institute of Canada Annual Meeting on October 16, 2004

Mastering Section 2(d) of the Lanham Act: Strategies for Overcoming Likelihood of Confusion Refusals in the USPTO

Minnesota State Bar Association CLE on March 5, 2004

Madrid Protocol 101

INTA CLE on December 10, 2003

Opposition/Cancellation Grounds, Burden of Proof and Pleadings

Minnesota State Bar Association CLE on May 6, 2002

Atlanta

Notable Decisions

Wind Turbine Industries Corp., v. Jacobs Wind Electric Company, Inc., Civil No. 09–36 (MJD/SRN), Obtained summary judgment on priority of use and abandonment of trademark rights issues in a complex trademark case involving over thirty years of alleged trademark usage.

Denver

Champagne Louis Roederer v. J. Garcia Carrion, S.A.: Friends Wine Marketing, Inc., d/b/a CIV USA, 569 F.3d 855 (2009), United States Court of Appeals, Eighth Circuit. Represented plaintiff in trademark action in successful appeal.

Knoxville

Krause Publications, Inc. v. Chester L. Krause, (C.A.F.C, 2007). case number 2007-1364, decided December 7, 2007, download and listen to the actual oral argument given by Mr. Clifford to the Court of Appeals for the Federal Circuit in the appeal of this opposition proceeding.

Madison

Eniva Corp. v. Global Water Solutions, Inc., 440 F. Supp. 2d 1042 - US: Dist. Court, D. Minnesota 2006.

Minneapolis

Fforg Inc. v. Infinite Campus, Inc., Civ.06-2448 (Mn. Dist. Ct., Fourth D. Feb. 14, 2006). Mr. Clifford led a team of lawyers to successfully respond within less than 24 hours to a temporary restraining order request. The motion was denied based on the showing and oral argument made by the Merchant & Gould team.

New York

Chester L. Krause v. Krause Publications, Inc., Cancellation No. 92041171 (T.T.A.B., Nov. 18, 2005), In one of the few citable decisions of 2005, the TTAB granted the petition for cancellation filed by Mr. Clifford under Section 2 (c) of the Trademark Act.

Seattle

Northwest Airlines, Inc. v. NWA Federal Credit Union, US: Dist. Court, D. Minnesota 2004. Represented defendant in trademark action.

Washington DC

The Valspar Corporation v. Sirius Products, Inc., Opposition No. 107,846 (T.T.A.B. Jan. 30, 1995). Successfully opposed registration of ZAP! on cleaning and restoring compounds based on prior rights in ZAPZ for stain sealing primer paint.

John A. Clifford (Continued)

Library Publications v. Heartland Samplers, 825 F. Supp. 701 - US: Dist. Court, ED Pennsylvania 1993.

The Post Office v. Portec, Inc., 913 F.2d 802 (1990), United States Court of Appeals, Tenth Circuit.

International Sausage Corporation v. Old Dutch Foods, Inc., 904 F.2d 46, United States Court of Appeals, Federal Circuit, May 24, 1990.

We Care, Inc. v. Ultra-Mark Intern. CORP., 741 F. Supp. 743 - US: Dist. Court, D. Minnesota, 3rd Div. 1989. Represented plaintiff in matter obtaining a preliminary injunction.

Jury Trials

The British Post Office v. Portec, Inc. Represented the plaintiff in a trade secret case to a successful verdict, in Federal Court in Denver, Colorado.

Jackson A. Smith v. Condux International, Inc. Represented the defendant in a license agreement case with patent, unfair competition and trade secret issues to a successful verdict in State Court in Mankato, Minnesota.

Voss of Norway A.S.A v. Revtech, Inc. Represented the plaintiff in a license agreement case with patent, trade secret and contract issues to a successful verdict in the Southern District of New York.

Bench Trials

The First National Bank in Sioux Falls v. First National Bank South Dakota, et al, (Civ. Action No. 06-4101, D.S.D. 2009) Represented the plaintiff in a trademark dispute, obtaining an expanded injunction. Atlanta

Champagne Louis Roederer v. J. Garcia Carrion and Friend Wine Marketing, Inc. d/b/a CIV USA, (Civ. Action No. 06-213 D. MN 2010) Represented the plaintiff in a trademark dispute, obtained an injunction. Denver

Listings

Who's Who in America, 1998-2008 Knoxville

Who's Who Legal: USA - Trademarks 2006

Martindale-Hubbell International Dispute Resolution Directory 2006

Martindale-Hubbell AV Peer Review Rating Madison

Expert Witness Engagements

Available upon request Minneapolis

Mediations

Jack has participated as a Neutral or Mediator on a number of occasions. In most cases the parties have requested that the matter not be disclosed. A list of lawyers who have used Jack as a mediator is available upon request. New York

Seattle

Washington DC