

# Merchant & Gould

An Intellectual Property Law Firm



## Scott W. Johnston

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Scott practices general Intellectual Property law with an emphasis on trademark litigation. He represents clients involved in domestic and foreign trademark oppositions and cancellation proceedings, and litigates trademark infringement, unfair competition, false advertising, trademark counterfeiting, cybersquatting and trademark dilution cases in state and federal courts. Scott also has experience with Internet law, including UDRP actions and domain name acquisitions.

In addition, Scott has experience in all phases of trademark prosecution, including the preparation of trademark clearance and availability opinions, preparation and prosecution of domestic and international trademark applications, and conducting appeals before the Trademark Trial and Appeal Board. Scott also has a degree in Electrical Engineering, is a registered patent attorney, and provides client counseling in the areas of patent, trademark, trade secret and copyright law. Scott's practice areas include: General practice - Patent, Trademark and Copyright and Cyberlaw with an emphasis on trademark litigation.

### Education

University of Colorado  
*B.S., Electrical Engineering, 1989*

Illinois Institute of Technology, Chicago - Kent College of Law  
*J.D., high honors, 1994*

### Bar Admissions

Minnesota State Bar, 1994  
U.S. District Court, 1995  
U.S. Patent and Trademark Office, 1995  
Court of Appeals for the Eighth Circuit, 1999  
Court of Appeals for the Federal Circuit, 2007

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# Scott W. Johnston (continued)

## Professional Affiliations

International Trademark Association  
American Intellectual Property Association  
Minnesota Intellectual Property Association  
Minnesota State Bar Association

## Professional Listings

Best Lawyers in America 2009, 2010, 2011  
"Top 50 Under 45" *IP Law & Business* (May, 2008)  
Minnesota SuperLawyers 2008, 2009, 2010, 2011  
Minnesota Rising Stars 2004

## Quoted

"A Trademark Win in China" *Twin Cities Business* (April 2009)

"Protecting Voss Water" *Minnesota Law & Politics* (August/September 2008)

"Reviews Revisited: Court demands more substance from opinion-of-counsel defense in trademark disputes." *Inside Counsel* (May, 2008)

"Competing Retailers Dispute Wal-Mart Trademark Request" *Wall Street Journal* (November 7, 2006)

## Publications and Speaking Engagements

"Pre-Filing Litigation Strategies -- An International Perspective," INTA Annual Meeting (May 20, 2009).

"The New TTAB Rules in Practice," IP Institute (Sept. 26, 2008)

"Protecting Voss Water" *Minnesota Law & Politics* (August/September 2008)

"TTAB Dramatically Changes Rules of Practice Before Trademark Trial & Appeal Board," *IP Today* (September 2007)

"Changes to TTAB Rules of Practice" (July 2007)

"Section 2(a) and the Trademark Act and Eliminating Bias," William Mitchell College of Law (June 6, 2007)

"Proposed Changes to TTAB Practice" (March 7, 2006)

"Ethical Issues For Trademark Practitioners," The MIPLA CLE Stampede (May 5, 2005)

"Trademark Essentials, Learning to Work Effectively With Trademarks" (July 16, 2004)

"The Madrid Protocol and New International Trademark Strategies" (February 24, 2003) Program Chair, Trademark Litigation CLE (June 2002)

"Similarities and Differences Between Trademark Practice in Federal District Court and the Trademark Trial and Appeal Board", MILE Trademark CLE (April 2001)

"News From the U.S.," *Intellectual Property Journal*, V. 15 (Carswell, December 2000)

"Trademark Surveys," ALI/ABA Advanced Trademark Litigation seminar (December 2000)

"Trademark Oppositions," Los Angeles Intellectual Property Law Association, Trademark Practice CLE (January 2000)

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"News From the U.S.," *Intellectual Property Journal*, V. 14 (Carswell September 2000)

Co-Author: "Prosecuting Trade Dress Cases," *Trade Dress Law, Second Edition*, (Aspen Law and Business 1999)

### Notable Cases

*Odom's Tennessee Pride Sausage Company v. FF Acquisition, LLC* (Fed. Cir. 2010) -- Defended appeal of TTAB Order before the Court of Appeals for the Federal Circuit.

*George & Co., LLC v. Xavier Enterprises, Inc.* (D. Minn. 2009) -- Prosecuted trademark counterfeiting, trademark infringement, unfair competition and copyright infringement claims; secured temporary restraining order against defendants.

*3M Company v. Masimo Corporation* (TTAB 2010) -- Prosecuted trademark opposition to RED mark for medical devices, namely, patient monitoring sensors and cables.

*Ecolab Inc. v. EcoSure Pest Control* (D. Minn. 2009) -- Prosecuted trademark infringement and unfair competition action relating to ECOSURE mark.

*Xcel Energy v. Delta Faucet* (D. Minn. 2009) -- Prosecuted trademark infringement and unfair competition action relating to RESPONSIBLE BY NATURE mark.

*Polaris Industries v. Polaris Inc.* (D. Minn 2009) -- Prosecuted trademark infringement and unfair competition action relating to POLARIS mark.

*CHS Inc. v. AgPro Industries, LLC* (N.D. Ga 2009) -- Prosecuted trademark, unfair competition and cybersquatting action relating to AGPRO mark.

*Genmar v. Rinker Boat Company* (D. Minn. 2009) -- Prosecuted trademark and unfair competition action relating to Glastron Spear design mark.

*Odom's Tennessee Pride Sausage Company v. FF Acquisition, LLC* (TTAB April 17, 2009) -- Defended trademark opposition and prevailed on summary judgment that there was no likelihood of confusion between the design marks at issue.

*ADC Telecommunications, Inc. v. Ad.C. Technologies* (D. Minn. and ICANN 2009) -- Prosecuted trademark infringement and cybersquatting claims relating to ADC mark.

*ADC Telecommunications, Inc. v. Changzhou New Jiexum Electric Co., Ltd.* (Beijing High Court Sept. 2008) -- Successfully appealed adverse decision on trademark opposition in China to Beijing High Court relating to registration of client's house mark and logo.

*CHS Inc. v. Sun Country Seeds* (D. Minn. 2008) -- Prosecuted trademark and unfair competition action in the U.S. and Canada relating to FEATHERED FRIENDS mark.

*Waymouth Farms, Inc. v. Jill Frechtman* (TTAB March 19, 2007) -- Prosecuted trademark opposition; prevailed on summary judgment and defended appeal to the Court of Appeals for the Federal Circuit.

*Featherlite v. Sundowner Trailers, Inc.*, (D. Iowa 2007) - Prosecuted trademark infringement action in federal court involving SUPERSTOCK trademark. Resulted in settlement whereby defendant phased out use and paid plaintiff's attorney fees.

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*NameProtect, Inc. v. Brand Protect, Inc. and Brandimensions, Inc.*, (D. Wis. 2007) - Prosecuted trademark and unfair competition action regarding NAMEPROTECT and BRANDPROTECT marks.

*SUPERVALU INC. et. al v. Wal-Mart, Inc.*, Opposition No. 91173727 (TTAB 2007) - Prosecuted trademark opposition involving Wal-Mart's effort to register EDLP (Every Day Low Prices).

*BioScan, Inc. v. Biolight Patent Holding AB*, Cancellation No. 92027044 (TTAB April 25, 2007) -- Prosecuted trademark cancellation action on behalf of Petitioner, BioScan, Inc., involving the mark BIOLIGHT for light therapy products. The Board found that Registrant had failed to prove use in commerce prior to its filing date, and that Petitioner had proven use or analogous use of the BIOLIGHT mark prior to Registrant's filing date. The Board therefore awarded priority to Petitioner and found that a likelihood of confusion exists. Accordingly, the Board granted the petition and ordered that Registrant's registration be cancelled.

*Kohler Co. v. Baldwin Hardware Corporation*, Cancellation No. 92041434 (TTAB Jan. 11, 2007) -- Prosecuted trademark cancellation action against decorative hardware manufacturer using the trademark DEVONSHIRE on door hardware, based on Kohler's prior common law rights in the same mark for toilets and lavatories. The Board found Kohler had priority, the goods were related, and there was a likelihood of confusion. Accordingly, the petition was granted and the registration ordered to be cancelled.

*Platinum Performance, Inc. v. Farnam Companies, Inc.*, Civil Action No. CV05 2041-RGK (C.D. Cal. 2005)- Prosecuted trademark infringement and unfair competition action to enforce Platinum Performance's PLATINUM PERFORMANCE name and mark for nutritional supplements for horses against Farnam Companies' PLATFORM PERFORMANCE mark for horse feed and nutritional supplements.

Atlanta

*Schwan's IP, LLC and Schwan's Consumer Brands v. Kraft Pizza Company*, Civil Action No. 04-125 (MJD/JGL) (D. Minn. 2004) — Prosecuted unfair competition claim relating to use of the marks BRICK OVEN and BRICK OVEN STYLE in connection with frozen pizza.

Denver

*B&K Industries, Inc. v. Kohler Co.*, Case No. 04 C 03454 (N.D. Ill. 2004) — Trademark infringement dispute regarding B&K's use and attempted registration of the mark CALLISTO in view of Kohler's KALLISTA mark.

Knoxville

*Saint Mary's Press of Minnesota v. DeVore & Sons, Inc. d/b/a Fireside Catholic Publishing and Fireside Bible Publishers*, Civil Action No. 04-01561-DWF-SRN (D. Minn. 2004) — Defended trademark and trade dress infringement action alleging that DeVore & Sons' Catholic Your Bible infringed on Saint Mary's Press' Catholic Youth Bible. Successfully defeated preliminary injunction motion and obtained dismissal of all claims with prejudice. See *Saint Mary's Press of Minnesota v. DeVore & Sons, Inc.*, 2004 U.S. Dist. LEXIS 12255 (D. Minn. 2004).

Madison

*Exxon Mobile Corporation v. Ecolab, Inc.*, Civil Action No. H-04-4236 (S.D. Tex. 2004) — Defended trademark infringement, unfair competition, dilution and related claims alleging that Ecolab's EXXELRATE mark violates Exxon's rights in its EXXON mark and other "EXX" marks.

Minneapolis

*Kohler Co. v. Jacuzzi Inc. and Jacuzzi Brands Inc.*, Civil Action No. 03C 5377 (N.D. Ill. 2003) — Trademark infringement dispute regarding Jacuzzi's use of Kohler's VINTAGE and COMFORT HEIGHT marks in connection with plumbing products.

New York

*Tissuelink Medical, Inc. v. Waldemar GmbH*, (Germany 2002) — Managed defense of trademark infringement action and oppositions in Germany brought by Waldemar against Tissuelink based on Waldemar's claims that Tissuelink's TISSUELINK mark violated Waldemar's rights in the LINK mark.

Seattle

Washington DC

*For Your Ease Only, Inc. v. Image Matters, Inc.*, Civil Action No. 02C 0826 (N.D. Ill. 2002) — Prosecuted trademark infringement, unfair competition and related claims arising out of Image Matters' use of the designation FILL-A-FRAME for decorative home furnishings in view of For Your Ease Only's rights in the marks FILL-A-BOWL, FILL-A-JAR, FILL-A-TRIVET, FILL-A-TRAY and FILL-A-FRAME marks.

## Scott W. Johnston (continued)

*Northern States Power Company v. PECO Energy Company*, Civil Action No. 00-302 (PAM/JGL) (D. Minn. 2001) — Defended trademark infringement, unfair competition and related claims against Northern States Power Company's new name and mark Xcel Energy asserted by PECO Energy Company based on its Exelon name and mark.

*Audio Research Corporation v. RadioShack Corporation*, No. 01-CV-1151 DWF/SRN (D. Minn. 2001) — Prosecuted trademark infringement, unfair competition and breach of contract action relating to RadioShack's use of Audio Research's HIGH DEFINITION trademark.

*McGuire Furniture Company, Inc. v. Market Trade Ltd.*, Civil Action No. 3-01-00507-FR (D. Or. 2001) — Prosecuted trade dress, trademark infringement, unfair competition and design patent infringement action relating to furniture designs.

*ADC Telecommunications, Inc. v. ADC Information Technologies, Inc.*, Civil Action NO. C-2—01-868 (S.D. Ohio 2001) — Prosecuted trademark infringement, unfair competition and related claims relating to use of ADC mark.

*U.S. Bancorp and U.S. Bank National Association v. Empire Bancshares, Inc. and United Southwest Bank*, Civil Action No. 99-CV-985 MJD/JGL (D. Minn. 2000) — Defended trademark infringement action brought by U.S. Bank contending that United Southwest Bank's US BANK mark infringes U.S. Bank's trademark rights.

*Corbis Corporation v. Corbis Group LLC and Corbis Insurance Services, Inc.*, Case No. C99-2066R (W.D. Wa 2000) — Prosecuted trademark infringement, unfair competition, and related claims for use of the name and mark CORBIS.

*Gary W. Polzin d/b/a/ Polzin Glass v. Tom Polzin d/b/a Polzin Auto Glass*, Appeal No. 99-2615 (8th Cir. May 18, 2000). Represented defendant in trademark infringement and unfair competition matter. Successfully defeated a motion for a preliminary injunction and obtained summary judgment for the defendant on the basis of claim preclusion. Affirmed on appeal.

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

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