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GLOBAL LEADERS

Michael J Leonard
Partner | Fox Rothschild LLP

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INTERVIEWS WITH THE
PINNACLE OF THE
TRADEMARK PROFESSION

Michael J Leonard

WTR says: Leonard has the perspicacity to navigate through uncharted trademark waters internationally and is a sage counsellor and resourceful practitioner. He exercises keen strategic vision, aided by cultivated IP management and enforcement skills.

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Biography

Michael Leonard is a partner in the IP department at Fox Rothschild. Clients consistently rely on his strategic counsel on the availability of trademarks and the management and enforcement of national and global trademark portfolios. Mr Leonard also possesses extensive experience in the prosecution, defence and settlement of opposition and cancellation proceedings and trademark infringement actions. His education in Europe informs his unique understanding of the international needs of his clients.



What has been one of your biggest achievements over the past year?

My biggest achievement of the past year is likely similar to that of many other attorneys – I fully adapted to, and even embraced, working remotely. As someone who has worked five to six days a week in the office for many years, I was pleasantly surprised as to how easy the change was. I now realise that not only am I capable of working anywhere, but that this flexibility can benefit clients.

How do you procure the most cost-effective solutions for clients?

Providing practical and cost-effective representation is a key component of my practice. Before attending law school, I worked as an IP paralegal for more than five years. This experience has served me well in many aspects, but, in particular, it enabled me to become well acquainted with filing requirements in the United States and abroad. This experience has carried over throughout my career as I primarily handle my own filings. Thus, I can quote fees that are fully realistic as I am well aware of what is required to review and consider an issue, and what is required to satisfy filing requirements.

What advice would you offer SMEs and small business owners seeking to maximise the benefits of their trademark and brand rights?

The most important thing for SMEs to remember is that they must first secure IP protection in trademarks or names that are sufficiently distinctive or arbitrary so as to enable them to establish a high level of brand equity in that mark or name. If a small business is reluctant to pursue distinctive or arbitrary marks or names, it is unlikely to obtain a scope of rights that would enable it to even be in a position to maximise the benefits of its trademark rights. In addition, the

business must be prepared to allocate the funds necessary to adequately protect its trademarks and brands once it has committed to the adoption of such marks or names.

Which technologies/technological tools do you rely on most for your day-to-day role?

Day in and day out, I find myself using our firm's subscription to the Corsearch platform, as I am constantly asked by clients to formally and informally undertake trademark searches. The analytics on the Corsearch platform enable extremely accurate searching without having to use Boolean or other 'quirky' search commands. I find this platform to be highly user-friendly and valuable because it enables me to provide quick and accurate preliminary assessments as to the availability of a mark for use or registration.

Which recent US cases do you expect to have the biggest long-term impact on your clients' IP strategies?

In my opinion, the biggest US trademark-related case of the past year was the holding in *Booking.com*. The decision has fundamentally changed how people see trademarks. It allows you to turn a descriptive or generic term into a distinctive term and motivates individuals to promote the '.com' portion of their domain name as more than just an address. For some time, US case law has held that the gTLD portion of a trademark or name is merely generic as an address. Now, US courts must realise that even terms that may have initially been viewed as being descriptive or generic can still rise to the level of a protectable trademark due to extensive use and publicity by the owner. Thus, we will likely see many more online businesses using a descriptive or generic term and a gTLD to pursue and secure trademark registration rights to such names.