



ROB WALLACE
—BRANDING EXPERT—

Case Descriptions

Unlike academic experts, Rob Wallace has **+30 years of branding industry expertise** in developing brand names, brand imagery, brand messaging, package design, advertising and communications for the market-leading, global brands of more than 50 Fortune 500 consumer product and service companies. This gives him unique insight and credibility.

His core experience has been analyzing issues involving the **Lanham Act** and the **TTAB (Trademark Trial & Appeal Board)** rulings. He has strong expertise in analyzing and testifying to the following:

Trademark Infringement / Copyright Infringement

As one of the most common issues involving brand and IP infringement, this topic is a focus of many of my reports. My experience serving as an expert in trademark infringement and copyright infringement matters ranges from the infringement of consumer product marks, names, logos and package design elements (such as detailed in my **E. & J. Gallo Winery v. Trigo Corporation** report), to corporate identities and brand communications (such as detailed in my **ING Bank v. The PNC Financial Services Group** report), among many other claims under the Lanham Act.

I analyze exhibits against all **DuPont factors**. I help determine if the brands at issue are distinctive, have acquired the necessary secondary meaning to be protectable, or are “famous” for trademark dilution purposes. I similarly help determine if a particular mark is descriptive or has become a generic term. I examine the channels of trade and distribution for the goods and services at issue in the case to determine if and how the similarities or differences affect the likelihood-of-confusion analysis. I analyze both the individual elements of the marks at issue, as well as the overall commercial impressions they convey, to assess their similarities and differences. I assess the advertising and brand communications for the goods and services at issue, to determine how the manner of promotion affects the likelihood-of-confusion question.

I design and commission **surveys** to demonstrate whether use of an allegedly infringing mark causes confusion with the senior mark, whether consumers mistakenly assume a connection or association between two marks due to their similarities, and whether consumers mistake the source of two products or services based on the marks. I then confirm these findings in my report and defend them during cross examination in depositions and testimony.

Trade Dress Infringement / Brand Identity Infringement

Another common issue addressed in my reports, this topic involves a brand logo or elements of a brand’s identity infringing on an established trade dress. Many of my reports involve these issues including **John Deere v. MTD, Prince Lionheart v. Halo Innovations**, and others.

Again, I deconstruct the individual elements of these brand identities and I analyze them as a whole to compare their similarities and differences. I design and commission surveys to measure confusion as to source, sponsorship, or affiliation.

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Secondary Meaning / Brand Awareness / Brand Equity

Many of my cases have involved an analysis of a brand's awareness or its secondary meaning. I deconstruct the elements of a brand's identity and also analyze them as a whole in determining their specific association with the brand. I develop research to measure consumer awareness, perception of a brand, and the ability of a brand owner to successfully leverage these positive perceptions to new sub-brands or brand proliferations. In the branding industry, this term is often referred to as "brand equity" and can often be an important part of infringement cases. [*John Wayne Enterprises v. Duke University is among several cases I've worked on that involve this issue.*](#)

Package Design Infringement

A specific subset of trademark and trade-dress cases, this topic involves infringement of graphic and/or structural package design elements of a pre-established brand. In my 30+ year career as the Managing Partner of a global package design firm, this topic is part of my core expertise. Cases I have served on that include this analysis include

[*Johnson & Johnson v. Actavis Group, Pom Wonderful, LLC v. Ocean Spray Cranberries*](#), and numerous others.

In these cases, I analyze both the graphic and structural package design elements to determine whether there is a likelihood of confusion as to their source. I also determine if specific structural design elements serve a functional, i.e., non-protectable, purpose or are a "fanciful" or proprietary attribute of the brand.

Survey Development and Analysis

Many of my cases involve designing and commissioning specific surveys to measure likely confusion between marks, product packaging and design, or other indicia of source. My surveys also quantify other trademark-related issues such as secondary meaning, dilution, descriptiveness, and whether a mark has become generic. I also analyze and critique surveys conducted by opposing experts, and consult with trial counsel to develop cross-examination strategies for opposing experts. Samples of my survey work and detailed industry research include the [*River Light VLP and Tory Burch LLC v. Lin & J International*](#), and others.

I design the methodology, create the screener, establish the control stimuli, draft the survey questions, determine the sample size, locate and retain the firm to field the research, analyze the data, and prepare clear opinions based on the research.

Product Design Infringement

My expertise includes deconstructing the elements of product design that either serve as source identifiers for a specific brand or provide a functional benefit that cannot be protected under the Lanham Act.

My real-world experience in developing global product design for a wide range of companies puts me and my clients at a significant advantage, and allows me to provide considerable value in opining on infringement claims in product-design cases. [*Carson Optical Inc., v. Prym Consumer*](#) and [*River Light and Tory Burch v. Lin & J International*](#), are among the cases I've worked on that involve product-design issues.

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Counterfeit Claims

I have rendered opinions on whether trademarks and/or product designs are identical or substantially indistinguishable for purposes of a trademark counterfeiting claim under the Lanham Act. I have assessed a party's willful intent to infringe on well-established designs, and have opined on the damages that result from the sale of counterfeit products.

Brand Dilution

I have also assessed whether a particular brand is famous for purposes of trademark dilution under the Lanham Act, and have opined the likelihood that a trademark has been diluted.

My dilution cases include *Simone Kelly-Brown v. Oprah Winfrey, Harpo Productions*, and others.

Damages Assessment

When brand dilution is evident, I have also participated in determining the financial damages to the infringed brand that this dilution has caused. I work with accountants and economists, as needed, to help quantify brand damages both during the period of infringement and the longer term effects on potential brand value.

Corrective Advertising Assessment

In the reverse-confusion case, *Simone Kelly-Brown v. Oprah Winfrey*, I determined the relevance of corrective advertising as a remedy. Specifically, I determined and calculated the appropriate amount of corrective advertising required to restore consumer recognition in the rightful trademark owner's brand identity.

False or Deceptive Advertising and Advertising Infringement

I began my career as a copywriter and account manager for Grey Advertising, then the 9th largest ad agency in the world. In that role, I developed concepts and messaging for numerous advertising campaigns. This expertise gives me unique insights on deceptive advertising and how it impacts competitors.

I have also determined if an advertisement infringes on another previously established and aired advertisement's message. The *Mars, Inc. v. The Hershey Company* case, for example, compared the messaging, visuals, and sequencing of two competitive brands' advertisements to determine if one was infringing on the other's message with the intent to deceive consumers thinking that the brands were the same or coming from the same source.

Deceptive Web Sites and Cybersquatting

I have also assessed deceptive practices in website development and search engine optimization activities. *FDS Machine Repair v. Midwest Machine Service* featured this analysis. I was able to determine that consumers looking for services from one company were misdirected to a second company's web site. I was able to determine the dilution of the original brand as a result of the infringing brand's deceptive practices.

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Established Category Codes vs. Proprietary Product Segmentation

Some product categories use standardized conventions to differentiate the individual products within their brand architecture. For example, the color brown is often used to distinguish a chocolate flavor of a food brand. My 30+ years of expertise in the branding industry gives me unique insights on what devices are category conventions or category cues, and which elements are unique and proprietary to a brand. Examples of this are analyzed in [Dumond Chemicals, Inc., v. Chemique](#), and others.

Branding and Packaging Industry Best Practices and Evident Intent

My 30+ years of expertise in the branding and packaging industry gives me unique insights on best practices with respect to brand identity, brand communication, and package design beyond the Lanham Act issues. This knowledge helps me assess whether infringement was the result of negligence, or willful intent as outlined in the [CA Square v. A2](#), and [Devi Snacks v. HOS](#) and other cases. It also helps me quantify best practices such as my work in the [FTC v. Ardagh Group case](#).

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