

**IP COMMITTEE MINUTES --September 3, 2011**  
**Ritz Carlton, Naples**

**I. INTRODUCTION**

Bob Thornburg welcomed everyone to the Business Law Section retreat and the IP Committee meeting, and introduced Co-Vice Chairs, Leora Herrmann and Ury Fisher. Attendees then introduced themselves. The minutes were corrected and approved.

**II. ATTENDEES**

Those in attendance were Robert Thornburg, Leora Herrmann, Ury Fischer, Michael Tschupp, Jorge Espinosa, Will Trueba, Michael Chesal, Doug Cherry, Lawrence Kolin, Kevin Levy, Stephen Luther, Jim Matulis, Julie Milham, Steve Peretz, Sim Singh (law student), Soraya Vagas (law student), Doug McDonald, Darren Spielman, Robert Kain, Carly Hammond, Steph Nagin, Sam Lewis, Jeanne Seewald, Bob Pershes, Dineen Pashoukos Wasylik and Oliver Ruiz.

**III. DIVERSITY COMMITTEE ANNOUNCEMENT**

Bob introduced Leisa Blanco, Co-Vice Chair of the Diversity Committee, announcing that the IP Committee is looking for one or more volunteers to join the Diversity Committee. Leisa explained that the Diversity Committee is implementing the Section's strategic plan of (1) recruiting diverse members to the section and (2) promoting diverse members to positions of leadership including through a mentoring program. Members of the IP Committee who are interested in joining the Diversity Committee can contact Bob or Leisa.

**IV. CLE PRESENTATION**

Michael Tschupp gave a CLE presentation on Green Intellectual Property and Advertising. Mike's presentation included a description of a series of pilot programs in the US Patent and Trademark Office to handle green technology patent applications that are likely to result in a permanent accelerated examination program for green technology. Mike also addressed green trademarks, which face distinctiveness issues and how the PTO's treatment of such marks has evolved, and false/misleading advertising issues raised by green advertising claims. The Florida Bar CLE number for this program is 84041. Mike mentioned the FTC Green Guide, which is under revision.

Carly Hammond gave a short presentation on the Southern District of New York ruling in *Marval Worldwide, Inc. v. Kirby*, which held that Jack Kirby's contributions to various comic book characters were works for hire under the 1909 Act so that Kirby's heirs could not invoke Section 304(c) of the 1976 Act to terminate an assignment contained in an employment agreement Kirby had executed which transferred any rights he may have had in his work product to Marval.



## **V. VISIT FROM SECTION LEADERSHIP**

Mindy Mora, Section Chair, Brian Gart, Chair Elect, and Steph Nagin, Secretary/Treasurer, stopped by with Section lobbyist, Bill Wiley, web master Tracey Eller and Eugene Petis, a member of the Board of Governors who is exploring candidacy for Bar President Elect. Petis is a civil litigator in Orlando. Mindy Mora described some of the events scheduled for the retreat. Eugene Petis spoke to the Committee about his anticipated candidacy, so far unopposed. Bill Wiley explained that the legislative session starts early, in January 2012. The covenant not to compete statute is under consideration for legislation.

Mindy informed the IP Committee there would be a fly-in midyear meeting in Tampa December 1.

## **VI. IP CERTIFICATION**

Jeanne Seewald, Vice Chair of the IP Certification Committee asked Committee members to urge attorneys to apply for IP Certification. The due date for applications is October 31. Six attorneys applied for certification last year. Five were eligible to sit for the exam, of whom four passed and have been certified.

As scheduled at the last Committee meeting, the Committee heard presentations for and against the proposed increase of the substantial involvement requirement from 30% to 50% of the applicant's practice be IP during the three years prior to certification. The rule change has been approved by the Board of Legal Certification. However, the Board of Governors asked for further input from the IP Committee. The discussion and vote at today's meeting was scheduled at the Committee's April meeting to ensure adequate notice to IP Committee members of our reconsideration of the issue.

Michael Chesal presented arguments in favor of the proposal, which originated with the Certification Committee three years ago, and Steph Nagin presented arguments against it. Both presentations were excellent and very thorough. Bob explained that the 30% requirement means 30% aggregate over the entire three year period.

Committee members were given an opportunity to speak in favor or against the proposed change. Several members spoke in favor of the change, including former Certification Committee Chair Robert Kain. Jorge Espinosa pointed out a growing problem of non-IP attorneys holding themselves out as doing IP with the result that an experienced IP attorney needs to clean up their mistakes later. Leora Herrmann expressed a concern that a 6-year attorney could be certified with only 30% involvement over three years. In response to an inquiry from Will Trueba, Bob Kain explained that it was not realistic to increase the length of practice years beyond five years. Jeanne Seewald explained she would not have qualified initially because she was active in M&A at the time, but still supports the increase. She would have just waited few years to apply. Sam Lewis also spoke in favor of the proposal, citing how difficult it is to keep up with new developments in the field.

Mike Chesal moved to approve the proposed amendment to the rules for certification to increase the substantial involvement requirement for initial certification from 30% to 50%. The motion was seconded by Jorge Espinosa. It passed 20 to 1.

The IP Symposium scheduled for March 1-2 at Doubletree in downtown Orlando. Chairers for the IP Symposium are Woody Pollack and Michael Colitz. Dineen Wasylik is also working on the Symposium, along with many others. The organizers are looking for additional topics and speakers. Bob urged all present to publicize the Symposium to encourage high attendance.

## **VII. STATE TRADEMARK PROCEDURE TASKFORCE**

Darren Spielman reported that he, Michael Chesal, Heather Schwartz and Keith Lipscomb are working on an unofficial general practice guide for state trademark review. The taskforce will start by updating the 1986 Florida Manual for Trademark Procedures and then meet with the personnel in the Division of Corporations who process State Trademark applications. Committee members who are interested in participating can contact Darren or Michael. Michael Chesal asked that the task force's charter be expanded to propose new changes to the State Trademark Act, including a provision to allow marks to be amended as permitted under Section 7 of the Lanham Act.

## **VIII. ADDITIONAL BUSINESS**

Bob Pershes suggested holding telephonic meetings with CLE credit to increase involvement in the Committee. He will head a task force to implement this.

Sam Lewis announced Judge Moreno has appointed a subcommittee of the Rules Committee to draft patent rules.

Doug McDonald announced there is a 50 day period from Sept 7-October 28 to prevent use of a trademark as a XXX domain name.